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In re Application of :
Michael D. Novack :
Application No. 12/130,954 : **ON PETITION**
Filed: May 30, 2008 :
Attorney Docket No. 23681-002001 :

This is a decision on the “Petition To Director Himself To Withdraw Requirement For Restriction”, filed August 4, 2011, which is being treated as a petition filed under 37 CFR 1.181, requesting that the Director exercise his supervisory authority and overturn the decision of the Director, Technology Center 3600 (Technology Center Director), dated June 23, 2011, which refused to grant the request to withdraw the restriction requirement mailed January 22, 2010.

The petition under 37 CFR 1.181 to overturn the decision of the Technology Center Director dated June 23, 2011, is **DENIED**¹.

The authority to decide petitions has been delegated to various USPTO officials in accordance with 37 CFR 1.181(g). See Manual of Patent Examining Procedure (M.P.E.P.) §§ 1001.01 and 1002.02. The Office of Petitions under the Deputy Commissioner for Patent Examination Policy has been delegated authority to decide petitions for invoking the supervisory authority of the Director of the USPTO under 37 CFR 1.181. See M.P.E.P., § 1002.02(b). While a higher-level USPTO official may further review a decision rendered pursuant to delegated authority, such review is a matter which lies within the sound discretion of the higher level official and is not a matter of right. See *In re Staeger*, 189 USPQ 284, 285 (Comm’r Pat. 1974). The instant petition presents no unusual or exceptional circumstances warranting higher-level review.

BACKGROUND

A restriction requirement was mailed January 22, 2010. The application as filed contained 40 claims, all claims being drawn to methods and systems for candidate recruiting. The restriction identified six distinct subcombinations disclosed as usable together in a single combination.

¹ This decision is a final agency action within the meaning of 5 U.S.C. § 704 for purposes of seeking judicial review. See MPEP 1002.02.

Applicant responded on February 19, 2010 with an election of the group I invention and traverse of the restriction. The traverse was based on the arguments that the examiner had not shown the claims in each group were patentable over the other groups and that the examiner had not shown convincing search burden.

A non-final Office action was mailed May 6, 2010 which acknowledged the election and responded to applicant's traverse of the restriction. The examiner stated that the claims in each group could have patentability over the claims in other groups and that each group has separate utility from the other. Search burden was explained in that a different search strategy would be used for each set of independent claims, including a separate search string for each group. The examiner concluded that the restriction requirement was proper.

A petition to the Technology Center Director under 37 CFR 1.144 was filed January 25, 2011, requesting withdrawal of the requirement for restriction. Petitioner's arguments against the restriction were based on search burden, specifically that the claims were closely related in subject matter and five of the six inventions are classified in the same class and subclass.

This petition was Denied in a decision mailed June 23, 2011.

The instant petition was filed August 4, 2011.

STATUTE, REGULATION, AND EXAMINING PROCEDURE

37 CFR 1.142 states:

1.142 Requirement for restriction.

(a) If two or more independent and distinct inventions are claimed in a single application, the examiner in an Office action will require the applicant in the reply to that action to elect an invention to which the claims will be restricted, this official action being called a requirement for restriction (also known as a requirement for division). Such requirement will normally be made before any action on the merits; however, it may be made at any time before final action.

(b) Claims to the invention or inventions not elected, if not canceled, are nevertheless withdrawn from further consideration by the examiner by the election, subject however to reinstatement in the event the requirement for restriction is withdrawn or overruled.

MPEP 808.01 states in part:

808.01 [R-3] Reasons for Holding of Independence or Distinctness

The particular reasons relied on by the examiner for holding that the inventions as claimed are either independent or distinct should be concisely stated. A mere statement of conclusion is inadequate. The reasons upon which the conclusion is based should be given.

MPEP 806.05(d) states in part:

806.05(d) [R-5] Subcombinations Usable Together

Two or more claimed subcombinations, disclosed as usable together in a single combination, and which can be shown to be separately usable, are usually restrictable when the subcombinations do not overlap in scope and are not obvious variants.

MPEP 808.02 states in part:

808.02 [R-5] Establishing Burden

Where the inventions as claimed are shown to be independent or distinct under the criteria of MPEP § 806.05(c) - § 806.06, the examiner, in order to establish reasons for insisting upon restriction, must explain why there would be a serious burden on the examiner if restriction is not required. Thus the examiner must show by appropriate explanation one of the following:

(C) **A different field of search:** Where it is necessary to search for one of the inventions in a manner that is not likely to result in finding art pertinent to the other invention(s) (e.g., searching different classes /subclasses or electronic resources, or employing different search queries, a different field of search is shown, even though the two are classified together. The indicated different field of search must in fact be pertinent to the type of subject matter covered by the claims. Patents need not be cited to show different fields of search.

OPINION

The restriction requirement, mailed January 23, 2010, identified six subcombinations usable together. The examiner indicated that all the subcombinations had separate utility and set forth these separate utilities in the requirement. The examiner concluded that the six subcombinations were independent or distinct. The examiner further stated that there would be a serious search and examination burden. The restriction set forth that all six subcombinations were classified in class 705 and subcombinations I-V were classified in subclass 1. The six inventions as set forth by the examiner in the restriction requirement were:

- I. Method and system for recruiting candidates comprising receiving and processing trait signals and weight signals to determine score signals.
- II. Method for recruiting candidates comprising receiving an interest signal, generating a query signal, receiving a response signal and determining a measure of competency by comparing the response signal with a template signal.
- III. Method for recruiting candidates comprising filtering use profile data and ordering user profiles according to scores.

IV. Method comprising determining score signals, producing an information signal, and deriving a revenue from a third party in exchange for transducing the signal into an observable form for display.

V. Method comprising a user accessing a list of candidates from an online system, which are ranked according to a measure of qualification for a career role, and compensating a provider of the online system.

VI. Method for recruiting candidates comprising generating statistical information from user profile data and generating a direct marketing list based on the statistical information which is available for purchase.

Petitioner argues that the examiner's position that the subcombinations are related as subcombinations usable together in a single combination, suggests that the subcombinations can therefore not be independent and distinct. Petitioner argues that inventions that are classified in the same class and subclass cannot be independent and distinct. The examiner addressed these issues in the response to petitioner's restriction traversal. The Technology Center Director, in her petition decision, reviewed the examiner's position and confirmed that the examiner had shown appropriate distinctness and search burden.

Petitioner argues that inventions that are related as subcombinations disclosed as usable together in a single combination cannot be classified as independent and distinct. Yet MPEP 806.05(d) clearly sets forth that subcombinations usable together in a single combination are restrictable when the subcombinations do not overlap in scope and are not obvious variants. The Technology Center Director indicated in her decision where the examiner had shown no overlap in scope and indicated the subcombinations are not obvious variants.

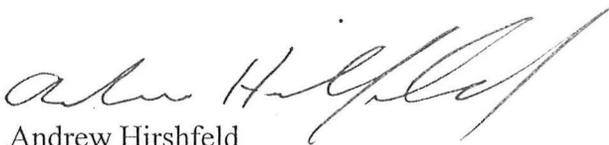
Petitioner also argues that inventions that are classified in the same class and subclass cannot be considered as independent and distinct as they are identically classified and therefore have the same search. The assumption is that there is no search burden as required by MPEP 808.02. In this regard, subcombinations I-V were indicated by the examiner to all be classified in class 705, subclass 1. However, the examiner indicated there would be a search burden between subcombinations even though they were all identically classified (subcombination VI was classified in class 705, subclass 14.52). The examiner explained how identically classified inventions would still require separate search strategies and search strings. The Technology Center Director discussed in her decision where the examiner had shown burden due to separate searches, even with identical classification and determined the examiner was correct in her indication of burden. Initial classification alone is not a determinant of the search required for each indicated invention. Clearly MPEP 808.02(C) establishes that different searches can be shown by different electronic resources, search queries, different fields of search "even though the two are classified together." This is in fact what the examiner indicated in both the restriction requirement and the response to applicant's traversal of the restriction. The Technology Center Director stated as much in her petition decision.

DECISION

A review of the record indicates that the Technology Center Director did not abuse her discretion or act in an arbitrary and capricious manner in the petition decision of June 23, 2011. The record establishes that the Technology Center Director had a reasonable basis to support her findings and conclusion. It is emphasized that this is a review of the Technology Center Director's petition decision, not a review of the examiner's restriction requirement.

The petition is granted to the extent that the decision of the Technology Center Director of June 23, 2011 has been reviewed, but is denied with respect to making any change therein. As such, the decision of June 23, 2011 will not be disturbed. The petition is denied.

Telephone inquiries concerning this decision should be directed to Carl Friedman at (571) 272-6842.



Andrew Hirshfeld
Deputy Commissioner
For Patent Examination Policy/
Petitions Officer

jc/cf