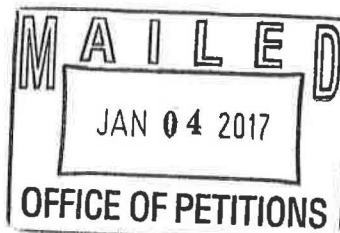




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In re Application of
Phillip Douglas
Application No. 13/999,396
Filed: February 21, 2014
Attorney Docket No.: 001001010100
For: MATERIAL SEPARATOR FOR A
VERTICAL PNEUMATIC SYSTEM

DECISION ON PETITION

This is a decision on the petition under 37 CFR 1.181(a)(3) filed September 19, 2016, requesting that the Director exercise her supervisory authority and overturn the decision the Director of Technology Center 3600 (Technology Center Director) dated July 18, 2016, which decision refused to withdraw the restriction requirement made final in the Office action mailed November 27, 2015.

The petition is **GRANTED** with respect to withdrawing the restriction requirement between Invention I and Invention II.

The petition is **DENIED** with respect to withdrawing the restriction requirement as to Invention III.

BACKGROUND

The present application was filed on February 21, 2014 with claims 1 through 30.

A preliminary amendment was filed on March 30, 2015 amending claims 1, 3, 4, 6 through 10, 13, 14, 18 through 21, and 28 through 30.

A non-final Office action (restriction requirement) was mailed on July 27, 2015, requiring a restriction between: (1) Invention I (claims 1 through 5) drawn to a method, classified in 406/197; (2) Invention II (claims 6 through 25) drawn to a conveyor, classified in 406/168; and (3) Invention III (claims 26 through 30) drawn to supports, classified in 248/62.

A reply to the Office action of July 27, 2015 was filed August 10, 2015, in which petitioner elected Invention II (claims 6 through 25) with traverse. Petitioner argued that the inventions were not properly classified and that the examiner did not provide reasonable examples that recite material differences between Inventions I and II and between Inventions I and III. Petitioner acknowledged that Inventions II and III were patentably distinct, but argued that there was no search and/or examination burden to examine Inventions I, II, and III together.

A non-final Office action was mailed on November 27, 2015. The non-final Office action of November 27, 2015: (1) rejected claims 6 through 25; and (2) treated claims 1 through 5 and 26 through 30 as withdrawn from considered as being directed to a non-elected invention (37 CFR 1.142). The non-final Office action of November 27, 2015 made the restriction requirement final.

A reply to the non-final Office action of November 27, 2015 was filed on January 4, 2016. The reply of January 4, 2016: (1) canceled claims 5, 7, 11, 13 through 16, 19, 21, 25, and 30; (2) amended claims 1 through 4, 6, 8 through 10, 12, 17, 18, 20, 22 through 24, and 26 through 28; and (3) added new claims 31 through 41.

A petition was also filed on January 4, 2016 under 37 CFR 1.181 requesting the finality of the restriction requirement to be vacated and the restriction requirement to be withdrawn.

A decision by the Technology Center Director dismissing the petition of January 4, 2016 was mailed on July 18, 2016.

A final Office action was mailed on August 3, 2016. The final Office action of August 3, 2016: (1) rejected claims 6, 8 through 10, 12, 17, 18, 20, 22 through 24, 31, 32, and 34; (2) objected to claims 36 through 41 as being dependent upon a rejected claims; and (3) treated claims 1 through 4, 26 through 29, 33 and 35 as withdrawn from considered as being directed to a non-elected invention (37 CFR 1.142).

A request for continued examination under 37 CFR 1.114 was filed on September 19, 2016.

The instant petition under 37 CFR 1.181 was also filed on September 19, 2016 (certificate of mailing dated September 14, 2016), requesting supervisory review of the Technology Center Director's decision mailed July 18, 2016.

STATUTE AND REGULATION

35 U.S.C. § 121 provides that:

If two or more independent and distinct inventions are claimed in one application, the Director may require the application to be restricted to one of the inventions. If the other invention is made the subject of a divisional application which complies with the requirements of section 120 it shall be entitled to the benefit of the filing date of the original application. A patent issuing on an application with respect to which a requirement for restriction under this section has been made, or on an application filed as a result of such a requirement, shall not be used as a reference either in the Patent and Trademark Office or in the courts against a divisional application or against the original application or any patent issued on either of them, if the divisional application is filed before the issuance of the patent on the other application. The validity of a patent shall not be questioned for failure of the Director to require the application to be restricted to one invention.

37 CFR 1.141 provides that:

(a) Two or more independent and distinct inventions may not be claimed in one national application, except that more than one species of an invention, not to exceed a reasonable number, may be specifically claimed in different claims in one national application, provided the application also includes an allowable claim generic to all the claimed species and all the claims to species in excess of one are written in dependent form (§ 1.75) or otherwise include all the limitations of the generic claim.

(b) Where claims to all three categories, product, process of making, and process of use, are included in a national application, a three way requirement for restriction can only be made where the process of making is distinct from the product. If the process of making and the product are not distinct, the process of using may be joined with the claims directed to the product and the process of making the product even though a showing of distinctness between the product and process of using the product can be made.

37 CFR 1.142 provides that:

(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.

37 CFR 1.143 provides that:

If the applicant disagrees with the requirement for restriction, he may request reconsideration and withdrawal or modification of the requirement, giving the reasons therefor. (See § 1.111). In requesting reconsideration the applicant must indicate a provisional election of one invention for prosecution, which invention shall be the one elected in the event the requirement becomes final. The requirement for restriction will be reconsidered on such a request. If the requirement is repeated and made final, the examiner will at the same time act on the claims to the invention elected.

37 CFR 1.144 provides that:

After a final requirement for restriction, the applicant, in addition to making any reply due on the remainder of the action, may petition the Director to review the requirement. Petition may be deferred until after final action on or allowance of claims to the invention elected, but must be filed not later than appeal. A petition will not be considered if reconsideration of the requirement was not requested (see § 1.181).

37 CFR 1.145 provides that:

If, after an office action on an application, the applicant presents claims directed to an invention distinct from and independent of the invention previously claimed, the applicant will be required to restrict the claims to the invention previously claimed if the amendment is entered, subject to reconsideration and review as provided in §§ 1.143 and 1.144.

OPINION

Petitioner requests the Director to vacate the decision of the Technology Center Director of July 18, 2016; vacate the finality of the requirement for restriction; and withdraw the restriction requirement. Petitioner further asks for the subsequent examination of claims 1 through 4, 26 through 29, 33, and 35, which are the claims that have been withdrawn from consideration by the examiner.

Petitioner traverses the restriction requirement on the bases that the examiner failed to establish distinctness for Inventions I and II and Inventions I and III,¹ and the examiner failed to establish serious burden for Inventions I, II, and III.

MPEP § 808 specifically provides that:

Every requirement to restrict has two aspects: (A) the reasons (as distinguished from the mere statement of conclusion) why each invention as claimed is either independent or distinct from the other(s); and (B) the reasons why there would be a serious burden on the examiner if restriction is not required, i.e., the reasons for insisting upon restriction therebetween as set forth in the following sections.

Distinctness Between Inventions I and II:

The restriction requirement set forth in the Office action mailed July 27, 2015 states that Inventions I and II are related as process and apparatus for its practice.

MPEP § 806.05(e) specifically provides, in part, that:

Process and apparatus for its practice can be shown to be distinct inventions, if either or both of the following can be shown: (A) that the process *as claimed* can be practiced by another materially different apparatus or by hand; or (B) that the apparatus *as claimed* can be used to practice another materially different process....

The burden is on the examiner to provide reasonable examples that recite material differences.

If applicant proves or provides convincing argument that there is no material difference or that a process cannot be performed by hand (if examiner so argued), the burden is on the examiner to document another materially different process or apparatus or withdraw the requirement.

Claim 1 is directed to a method of delivering material being transported by a conveyor entraining the material within a flow of fluid and specifically provides—

A method of delivering material being transported by a conveyor entraining the material within a flow of fluid, wherein said method comprises:
flowing the fluid flow entraining the material into a separator, comprising an inlet, a first outlet, and a second outlet, through the inlet of the separator;

¹ Petitioner does not argue that Examiner failed to establish distinctness for Inventions II and III.

separating the material from the fluid flow within the separator; and depositing the material from said separating out of the separator through the first outlet.

Claim 6 is directed system for delivering material being transported by a conveyor entraining the material within a flow of fluid and specifically provides—

A system for delivering material being transported by a conveyor entraining the material within a flow of fluid, wherein said system comprises:
a tube for receiving the fluid flow entraining the material; and
a separator, wherein said separator comprises an inlet for the fluid flow entraining the material, means for separating the material from the fluid flow within said separator, means for depositing the material from said separating means out of said separator, and an outlet;
wherein said tube transmits the fluid flow entraining the material into said separator through said inlet.

The restriction requirement of July 27, 2015 indicates “the process as claimed can be practiced by hand.”

Petitioner, however, argues that the claimed process of Invention I (claim 1) cannot be reasonably practiced by hand because it would be impractical and dangerous. *See* Reply of August 10, 2015 at pages 13-14.

Claim 1 recites the steps of “flowing the fluid flow entraining the material into a separator;” “selectively separating the material from the fluid flow within the separator;” and “depositing the material, from the selectively separating, out of the separator.”

The examiner explains that the claimed “inlet” and “separator” could be a trough and a laborer could manually separate materials. *See* Office action dated 11/27/15 at page 3. The Technology Center Director further adds that the “flowing” step can be done by use of a trough and the “separating” and “depositing” steps can then be done by the laborer. *See* Technology Director Decision dated July 18, 2016, at page 5.

In this example, both the examiner and the Technology Center Director recognize that a trough would be required to perform the “flowing” step. Assuming that the claimed “separating” and “depositing” steps can be performed by hand, it does not appear that the claimed “flowing” step may be performed by hand. Therefore, it does not appear that the process of Invention I **as claimed** may be practiced by hand.

The restriction requirement of July 27, 2015 also indicates “the apparatus as claimed can be used to practice another and materially different process, such as one conveying fluid only.”

Petitioner argues that using the apparatus of Invention II (claim 6) to convey fluid only, as described by the examiner and Technology Center Director,² fails to consider the subject matter **as claimed**.

Claim 6 recites “means for selectively separating the material from the fluid flow within said separator” and “means for depositing the material...” Because there is no material to separate and deposit when conveying fluid only, the “means for selectively separating” and “means for depositing” would not be used in the fluid only example described by the examiner and Technology Center Director. Hence, the fluid only example does not consider the “means for selectively separating” and “means for depositing” recited in claim 6. Therefore, reliance on the fluid only example is inadequate to show that the apparatus of Invention II **as claimed** can be used to practice a process that is materially different from Invention I.

Under 35 U.S.C. § 121, restriction is appropriate only if the separate groups of claims are able to support separate patents. *See* MPEP § 803. 35 U.S.C. § 121 (third sentence) prohibits the use of a patent issuing on an application in which a requirement for restriction has been made, or on an application filed as a result of such a requirement, as a reference against any divisional application in a nonstatutory double patenting rejection, if the divisional application is filed before the issuance of the patent.

This apparent nullification of nonstatutory double patenting as a ground of rejection or invalidity in divisional applications imposes a heavy burden on the Office to guard against erroneous requirements for restrictions where the claims define essentially the same invention in different language and where acquiescence to the restriction requirement might result in the issuance of several patents for the same invention. “[I]f an examiner issues a restriction requirement between patentably indistinct claims, two patents may issue and prolong patent protection beyond the statutory term on obvious variants of the same invention. This prolongation would occur because § 121 would immunize the restricted application against nonstatutory double patenting rejections.” *Geneva Pharmaceuticals Inc. v. GlaxoSmithKline PLC*, 349 F.3d 1373, 1379, 68 USPQ2d 1865, 1869 (Fed. Cir. 2003). “[W]hen the existence of multiple patents is due to the administrative requirements imposed by the Patent and Trademark Office, 35 U.S.C. 121 provides that the inventor shall not be prejudiced by having complied with those requirements. Thus when two or more patents result from a PTO restriction requirement, whereby aspects of the original application must be divided into separate applications, section 121 insulates the ensuing patents from the charge of double patenting.” *Applied Materials Inc. v. Advanced Semiconductor Materials*, 98 F.3d 1563, 1568, 40 USPQ2d 1481, 1484 (Fed. Cir. 1996) (citing *Studiengesellschaft Kohle mbH v. Northern Petrochemical Co.*, 784 F.2d 351, 354, 228 USPQ 837, 840 (Fed. Cir. 1986)).

² *See* Restriction Requirement dated July 27, 2015 at page 2 and Technology Center Director decision dated July 18, 2016 at page 3.

See MPEP § 804.01.

The conveyor (system for delivering material being transported by a conveyor entraining the material within a flow of fluid) of Invention II requires a tube for receiving the fluid flow entraining the material, and a separator (including a means for separating the material from the fluid flow within said separator, means for depositing the material from the separating means out of the separator, and an outlet), wherein the tube transmits the fluid flow entraining the material into the separator through the inlet. The process (method of delivering material being transported by a conveyor entraining the material within a flow of fluid) of Invention I as claimed in claim 1 does not recite any distinct “process” of using the conveyor of Invention II beyond the use of the claimed element of the conveyor. That is, the process as claimed in claim 1 (flowing the fluid flow entraining the material into a separator, separating the material from the fluid flow within the separator, and depositing the material from the separating out of the separator through the first outlet) is directed only to the nominal use of the conveyor of Invention II as claimed in claim 6.

In view of the above, the process of Invention I and the apparatus of Invention II have not been shown to be distinct inventions. Therefore, the restriction requirement between Inventions I and II is withdrawn.³

Distinctness Between Inventions I and III:

The restriction requirement in the Office action of July 27, 2015 also states that Inventions I and III are related as process and apparatus for its practice. The examiner states that both the process as claimed can be practiced by another and materially different apparatus and the apparatus as claimed can be used to practice another and materially different process.

Claim 26 is directed to a support for an outlet of a conveyor and specifically provides—

A support for an outlet of a conveyor depositing material to a storage having a wall, wherein the outlet is within the storage, and wherein said support comprises:

³ The United States Patent and Trademark Office (USPTO) has now migrated to the Cooperative Patent Classification (CPC) system. The CPC classification(s) for Invention I (class 406 and subclass 197) is B65G51/00, B65G53/00, and B65G53/30. The CPC classification(s) for Invention II (class 406 subclass 168) is B65G51, B65G53/00, and B65G53/60. The search for Invention I under the CPC would include B65G51/00, B65G53/00, B65G53/30, and B65G53/60. The search for Invention II under the CPC would include B65G51/00, B65G53/00, B65G53/60, A01C7/081, A01C7/082, A01C7/084, B65G69/0441, and A01F25/186. Thus, as there is considerable overlap in both the classification and search of Invention I and II under the CPC, there does not appear to be a serious search burden in searching Inventions I and II under the CPC.

at least one clamp assembly mounted on the outlet; and
a set of braces connected to each respective said clamp assembly for
suspending the outlet within the storage.

As noted above, the process of Invention I (claim 1) requires the steps of “flowing the fluid flow entraining the material into a separator;” “selectively separating the material from the fluid flow within the separator;” and “depositing the material, from the selectively separating, out of the separator”. The apparatus of Invention III (claim 26) is directed to a support for an outlet.

It is clear from reviewing the process of claim 1 that a support for an outlet, as recited in claim 26, is not necessary to practice any of the steps recited in claim 1: *i.e.*, the process as claimed in claim 1 may be practiced without a support for an outlet including a clamp assembly mounted on the outlet and a set of braces connected to the clamp assembly for suspending the outlet. Therefore, the process of Invention I could be practiced by an apparatus that is materially different from the apparatus of Invention III (*i.e.*, does not include the support for an outlet). Further, as explained by the Technology Center Director, the support for the outlet of the conveyor as recited in claim 26 can be used in a process where only deposited material is supported, without the need to include flowing fluid as required by claim 1. Accordingly, the apparatus of Invention III can be used to practice a process that is materially different from the process of Invention I (*i.e.*, does not flow fluid).

It has been sufficiently shown that the process of Invention I can be practiced by an apparatus that is materially different from Invention III, and the apparatus of Invention III can be used to practice a process that is materially different from Invention I. Therefore, Inventions I and III are considered distinct inventions.

Serious Burden:

Petitioner argues that a serious search burden has not been established.

Pursuant to MPEP § 803, “a serious burden on the examiner may be *prima facie* shown by appropriate explanation of separate classification, or separate status in the art, or a different field of search as defined in MPEP § 808.02.”

MPEP § 803 specifically provides, in part, that:

For purposes of the initial requirement, a serious burden on the examiner may be *prima facie* shown by appropriate explanation of separate classification, or separate status in the art, or a different field of search as defined in MPEP § 808.02. That *prima facie* showing may be rebutted by appropriate showings or evidence by the applicant.

MPEP § 808.02 states:

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:

(A) **Separate classification thereof:** This shows that each invention has attained recognition in the art as a separate subject for inventive effort, and also a separate field of search. Patents need not be cited to show separate classification.

(B) **A separate status in the art when they are classifiable together:** Even though they are classified together, each invention can be shown to have formed a separate subject for inventive effort when the examiner can show a recognition of separate inventive effort by inventors. Separate status in the art may be shown by citing patents which are evidence of such separate status, and also of a separate field of search.

(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.

The Technology Center Director decision (page 4) explains that the search for Invention II would involve searching in additional areas—class 406 and subclass 168—compared to Invention I, and the search for Invention III would involve searching in areas—class 248, subclass 62—that are not required in the search for Inventions I and II. The Technology Center Director decision (page 4) also points out that the examiner identified separate classifications for the three groups of inventions—class 406/197 for Invention I; class 406/168 for Invention II, and class 248/62 for Invention III.⁴

A review of the search areas identified in the Technology Center Director decision indicates that there is no showing of error in the determination that Inventions I, II, and III require a different field of search. In view of the appropriate explanations showing that Inventions I, II, and III have been accorded a separate classification and require a different field of search, it is reasonable to

⁴ In addition, the CPC classification(s) for Invention III (class 248 subclass 62) is F16L3/137 and F16L3/233. The search for Invention III would include F16L3/137 and F16L3/233. Because the search for Invention III under the CPC diverges from the search for Inventions I and II as there is no overlap in search, there would be a serious burden on the examiner to search Invention III with Inventions I and II.

conclude that there would be a serious burden on the examiner if restriction is not required between Inventions I, II, and III.

In conclusion, the requirement for restriction between the Inventions I and III, and Inventions II and III is considered proper because distinctness and serious burden has been established according to MPEP § 808. The requirement for restriction between Inventions I and II is **not** considered proper because Inventions I and II are not distinct inventions.

DECISION

The petition is **GRANTED** to the extent that the restriction requirement between Invention I and Invention II is withdrawn.

The petition is **DENIED** to the extent that the restriction requirement between Invention I and Invention III and between Invention II and Invention III will **not** be withdrawn.

This constitutes a final decision on this petition. No further requests for reconsideration will be entertained. Judicial review of this petition may be available upon entry of a final agency action adverse to the petitioner in the instant application (e.g., a final decision by the Patent and Trial Appeal Board). *See* MPEP § 1002.02.

This application is being returned to Technology Center 3600 for further proceedings in accordance with this decision. An Office action on the merits of Claims 1 through 4, 6, 8 through 10, 12, 17, 18, 20, 22 through 24, 31, 32, 34, 35, and 36 through 41 will follow in due course.



Robert W. Bahr
Deputy Commissioner for
Patent Examination Policy