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In re Application of :
S. Mill Calvert :
Application No. 14/221,052 : ON PETITION
Filed: March 20, 2014 :
Attorney Docket No.: calvert052 :

This is a decision on the petition, filed August 22, 2014, under 37 CFR 1.181 requesting supervisory review of the decision by the Director, Technology Center 3600 (Technology Center Director), dated August 18, 2014, that upheld the restriction requirement made final in the Office action dated July 31, 2014.

The petition to set aside the restriction requirement made final in the Office action dated July 31, 2014 is **DENIED**.

BACKGROUND

On May 20, 2014, the Office issued an election of species requirement setting forth two patentably distinct species—Species A (figs. 1 and 2) and Species B (fig. 3).

On May 20, 2014, Applicant filed a response electing with traverse Species A.

On July 31, 2014, the Office issued a non-final Office action that withdrew claims 2-3 as being drawn to the non-elected species and made the election of species requirement final.

On July 31, 2014, Applicant filed a petition to the Technology Center Director requesting withdrawal of the election of species requirement.

On August 18, 2014, the Office issued a petition decision ("TC Decision") by the Technology Center Director dismissing the petition filed July 31, 2014.

On August 22, 2014, Applicant filed the instant petition requesting supervisory review of the TC Decision.

STATUTE, REGULATION, AND PROCEDURE

35 U.S.C. 121 states, in pertinent part:

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.

37 C.F.R. 1.146 states:

In the first action on an application containing a generic claim to a generic invention (genus) and claims to more than one patentably distinct species embraced thereby, the examiner may require the applicant in the reply to that action to elect a species of his or her invention to which his or her claim will be restricted if no claim to the genus is found to be allowable. However, if such application contains claims directed to more than a reasonable number of species, the examiner may require restriction of the claims to not more than a reasonable number of species before taking further action in the application.

MPEP 808.02 states, in pertinent part:

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.

OPINION

Petitioner requests reversal of the TC Decision affirming the election of species requirement, and requests withdrawal of the election of species requirement. Petitioner argues that the TC Decision did not address the correctness of the reasons provided by the examiner in support of the election of species requirement.

The Petitioner's arguments have been considered, but are not found to be persuasive.

In the petition (pages 3-7) to the Technology Center Director dated July 31, 2014, Petitioner argued that the election of species requirement should be reversed because: (i) the species are not distinct; and (ii) there is no serious burden.

Regarding argument (i), the TC decision explains that the Petitioner's argument that claims 2-3 are not distinct from claim 1 is not persuasive because claims are not species; rather species are the different embodiments of the invention, which in this case are depicted in figures 1-3. For example, the TC decision (page 3) states the following:

...These arguments are not persuasive because in discussing the withdrawn claims 2-3 instead of non-elected species B depicted in figure 3, petitioner failed to make the case for related and non-distinct species. Because species are the different embodiments of the invention, they are generally depicted in the drawing figures or disclosed in the specification. In the instant application, species A is depicted in figures 1-2, and species B is depicted in figure 3. Contrary to applicant's assertion, claims are never species according to MPEP § 806.04 (e) cited above. Therefore, even though claims 2-3 may recite some features of non-elected species B and the scope of claims 2-3 may encompass species B, claims 2-3 are not themselves species B.

...Since claims are not species according to MPEP § 806.04 (e), and each of the species claims must require all the limitations of the generic claim as specified in MPEP § 806.04(d), comparing and contrasting claims 2-3 to generic claim 1

would not serve as convincing evidence in petitioner's arguments that non-elected species B is not patentably distinct from elected species A, and should be examined together with the elected species A.

In addition, the TC Decision (page 3) further explains that the examiner provided sufficient evidence that the inventions are independent or distinct by detailing the structural differences between the species. For example, the TC Decision (page 3) states the following:

...By providing detailed structural differences between the species, the examiner has provided clear evidence that Species B of figure 3 and 6 is an independent or distinct embodiment from Species A of figures 1-2.

In view of the above, the TC Decision sufficiently addresses Petitioner's argument (i) and the correctness of the reasons provided by the examiner in support of the election of species requirement.

Moving on to Petitioner's argument (ii), the TC Decision (page 4) notes that this argument is not persuasive because under MPEP 803(II), the examiner sufficiently explained why there would be a serious burden on the examiner if restriction is not required by "indicating that the species require a different field of search such as searching different classes/subclasses or electronic resources, or employing different search queries; and the prior art applicable to one species would not likely be applicable to another species."

In view of the above, the TC decision sufficiently addresses Petitioner's argument (ii) and the correctness of the reasons provided by the examiner in support of the election of species requirement.

It is noted that in the petition (pages 5-6) dated July 31, 2014, Petitioner asserts that there is no serious burden because "the presence of a mere 2 claims adding single components to the independent claim is the antithesis of 'serious burden'" and "the added components of claims 2 and 3 should not force a separate classification..."

However, the number of claims is not relevant to the issue of whether there would be a serious burden on the examiner to search and examine the two species. Instead, serious burden can be established when the examiner appropriately explains separate classification thereof, a separate status in the art when they are classifiable together, or a different field of search. See MPEP 808.02. Similarly, the argument that the added claim components should not force a separate classification is also not relevant because the examiner is required to apply the USPTO's classification scheme. Accordingly, for at least the reasons noted above, the election of species requirement previously set forth by the examiner was proper and thus, there is no basis for rejoinder.

It is further noted that Petitioner appears to suggest that the inventions are not patentably distinct from each other. For example, in the response (page 3) dated May 20, 2014, Petitioner states "Thus, the various components shown are related (not independent) and do not make the figures describe patentably distinct inventions, as claimed." Also, in the petition (page 4) dated July 31, 2014, Petitioner states "Therefore, they are not distinct by the standard specified in MPEP 802.01."

In response to these statements, the TC Decision (page 1) notes "applicant argues that the species are not patentably distinct." However, a careful review of the record shows that Petitioner did not **clearly and unambiguously** admit that the inventions are not patentable over each other. *Cf. In re Lee*, 199 USPQ 108, 109 (Comm'r Pat. 1978) (withdrawing a restriction requirement in light of Petitioner's clear and unambiguous admission that the inventions are not patentable over each other).

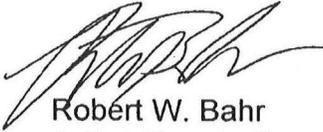
DECISION

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 TC decision. The record establishes that the Technology Center Director had a reasonable basis to support her findings and conclusion.

The petition is granted to the extent that the TC Decision has been reviewed, but is **denied** with respect to making any change therein. This decision is without prejudice to Petitioner submitting, prior to a final Office action, a clear and unambiguous statement admitting that the inventions are not patentable over each other. The Office would withdraw the election of species requirement should Petitioner file such statement. See MPEP 803. However, if the examiner finds one of the inventions unpatentable over the prior art, the admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention. See MPEP 809.02(a).

Otherwise, no further requests for reconsideration of the election of species requirement will be entertained. Judicial review of this petition decision may be available if the USPTO issues a final agency action adverse to the petitioner in the underlying proceeding or examination to which it relates.

Telephone inquiries concerning this decision should be directed to Christopher Bottorff at (571) 272-6692.

A handwritten signature in black ink, appearing to read 'RWB', is positioned above the typed name.

Robert W. Bahr
Acting Deputy Commissioner for
Patent Examination Policy/
Petitions Officer

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