

FY08 Restriction Petition Update and Burden



Julie Burke
Quality Assurance Specialist
Technology Center 1600



TC 1600 Filings and Restrictions

- In FY08, TC1600
 - mailed 42,018 first actions on the merits
 - mailed 21,911 restriction requirements
 - received about 75 restriction petitions
- National stage filings of a PCT application under 371
 - account for 15% of TC1600 applications
 - yet result in 28% of the petitions
- Average restriction petition turnaround time
 - 91 days in FY04-FY07
 - 103 days in FY08
- 66% of Restriction Petitions were granted in full or in part in FY08

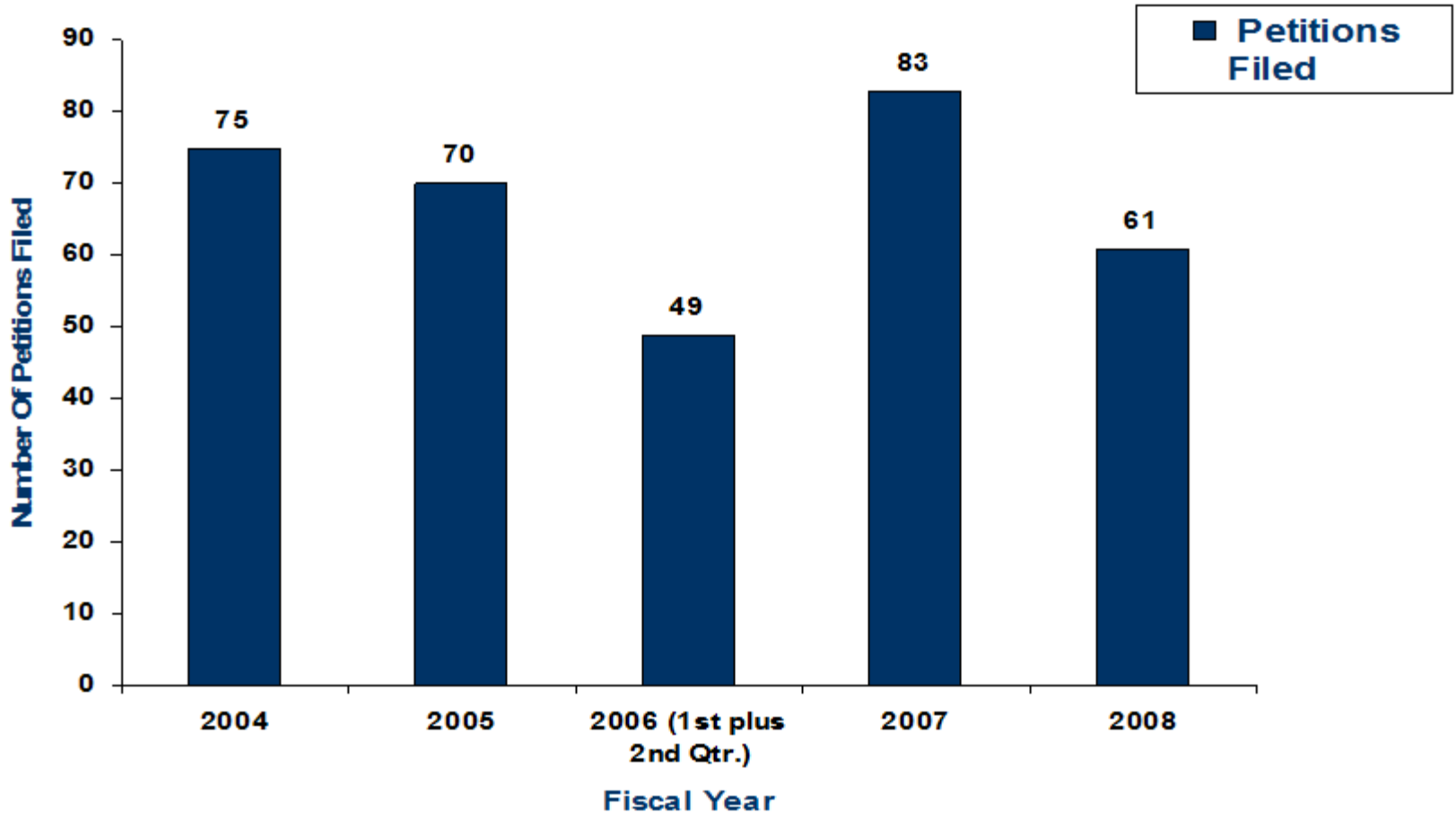


Contents

- FY08 Restriction Petition Update
- Overview of Burden

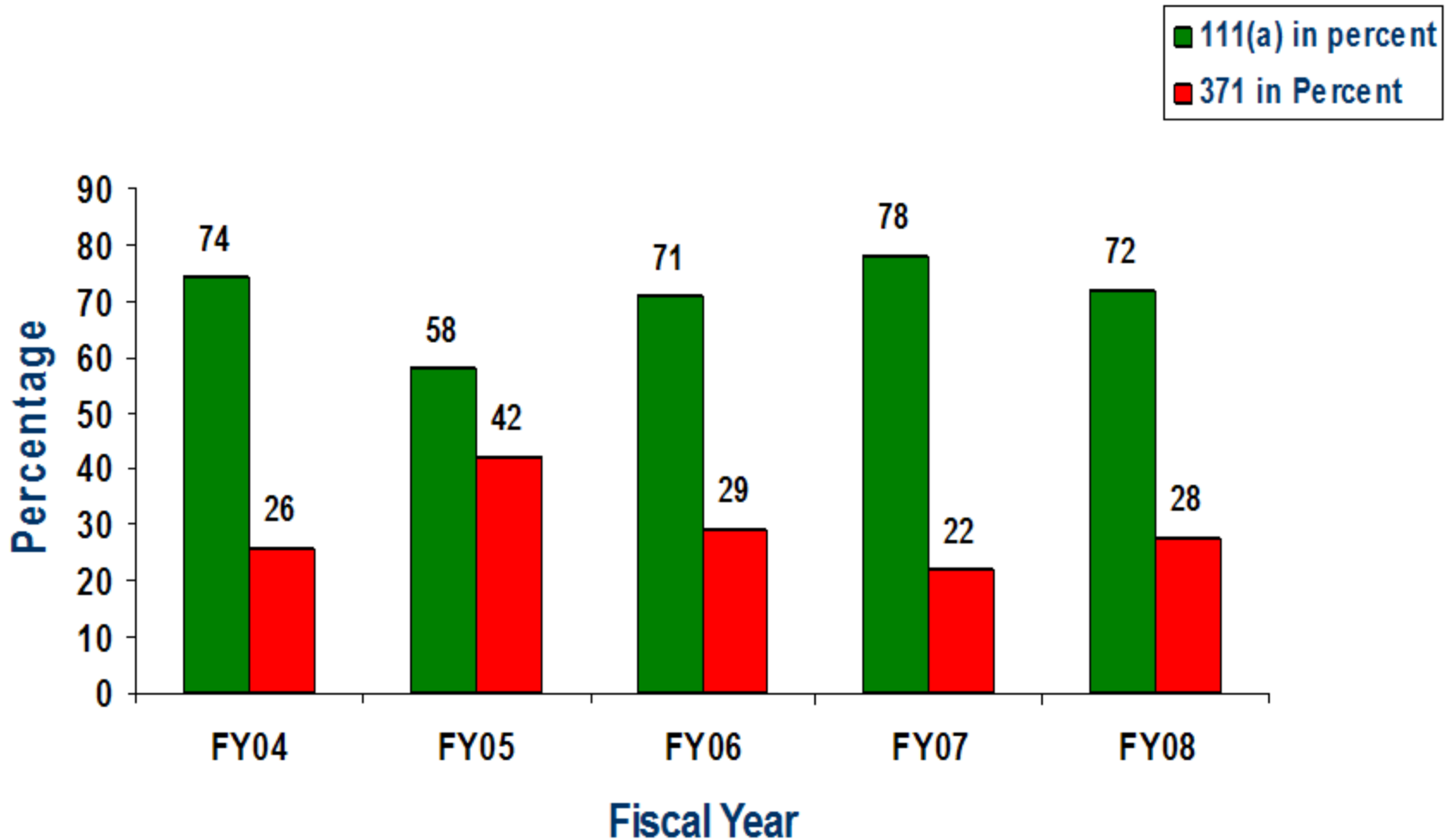


Restriction and Lack of Unity Petitions Filed in FY04 – FY08



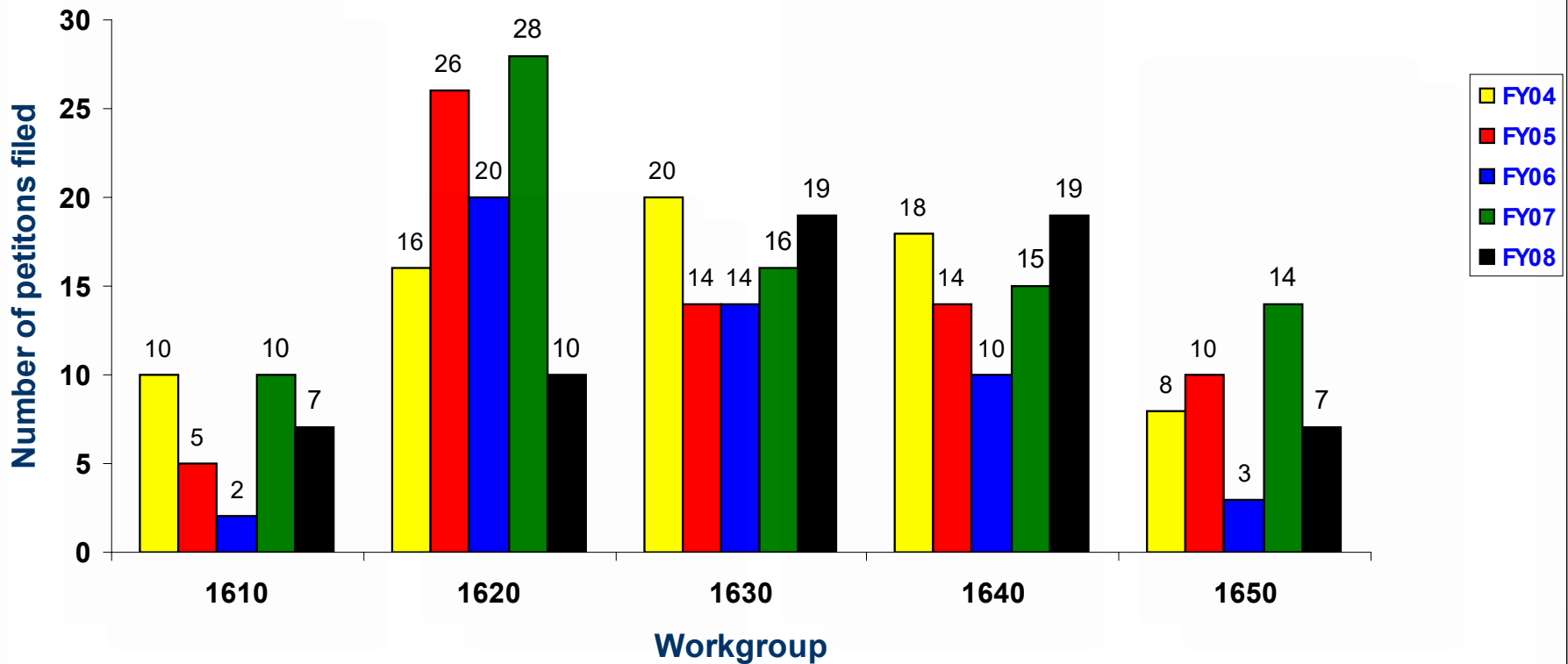


Restriction in 111 (a) and Lack of Unity in 371 For FY04 - FY08



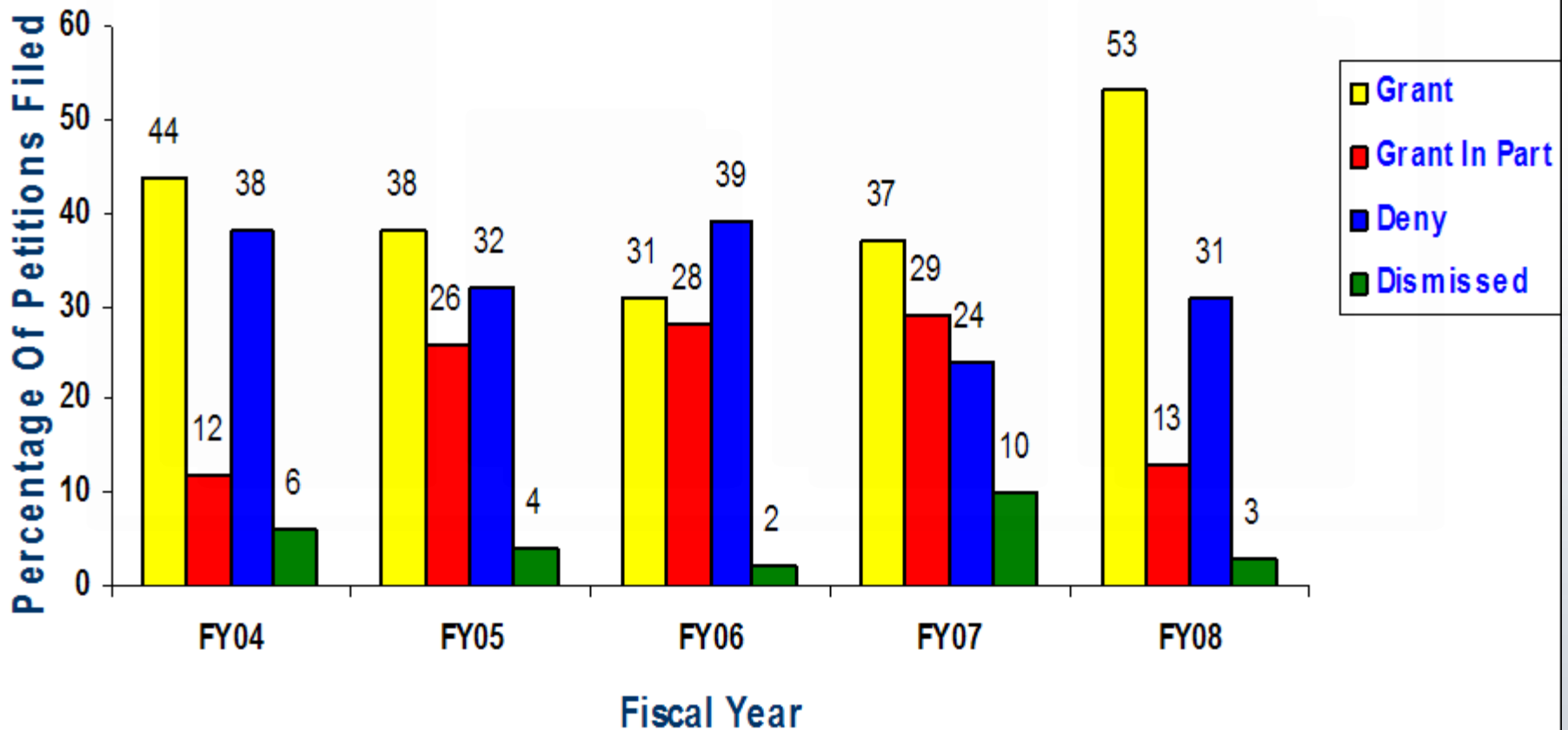


Restriction Petitions by Workgroup Filed in FY04 to FY08



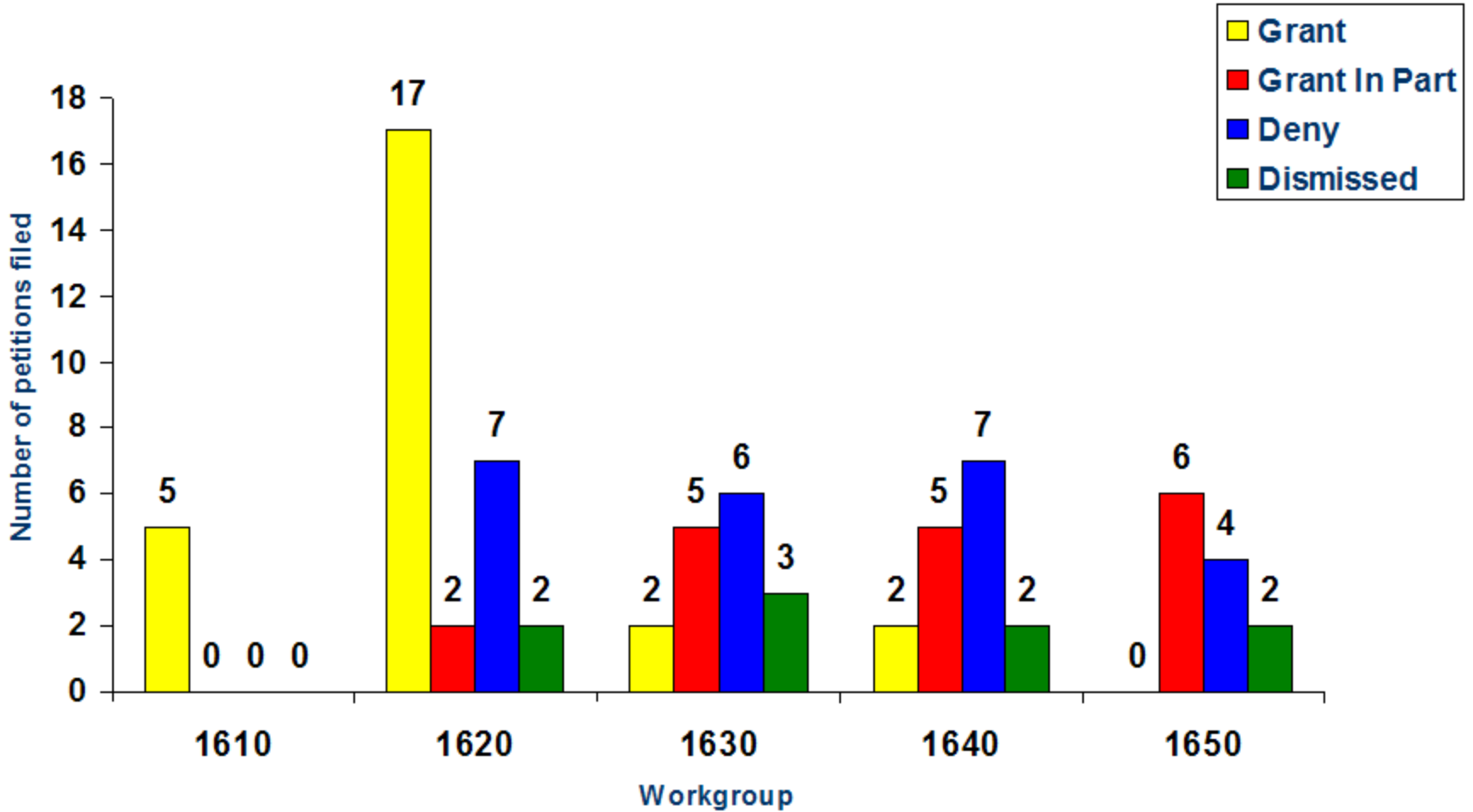


Petition Outcome by Fiscal Year



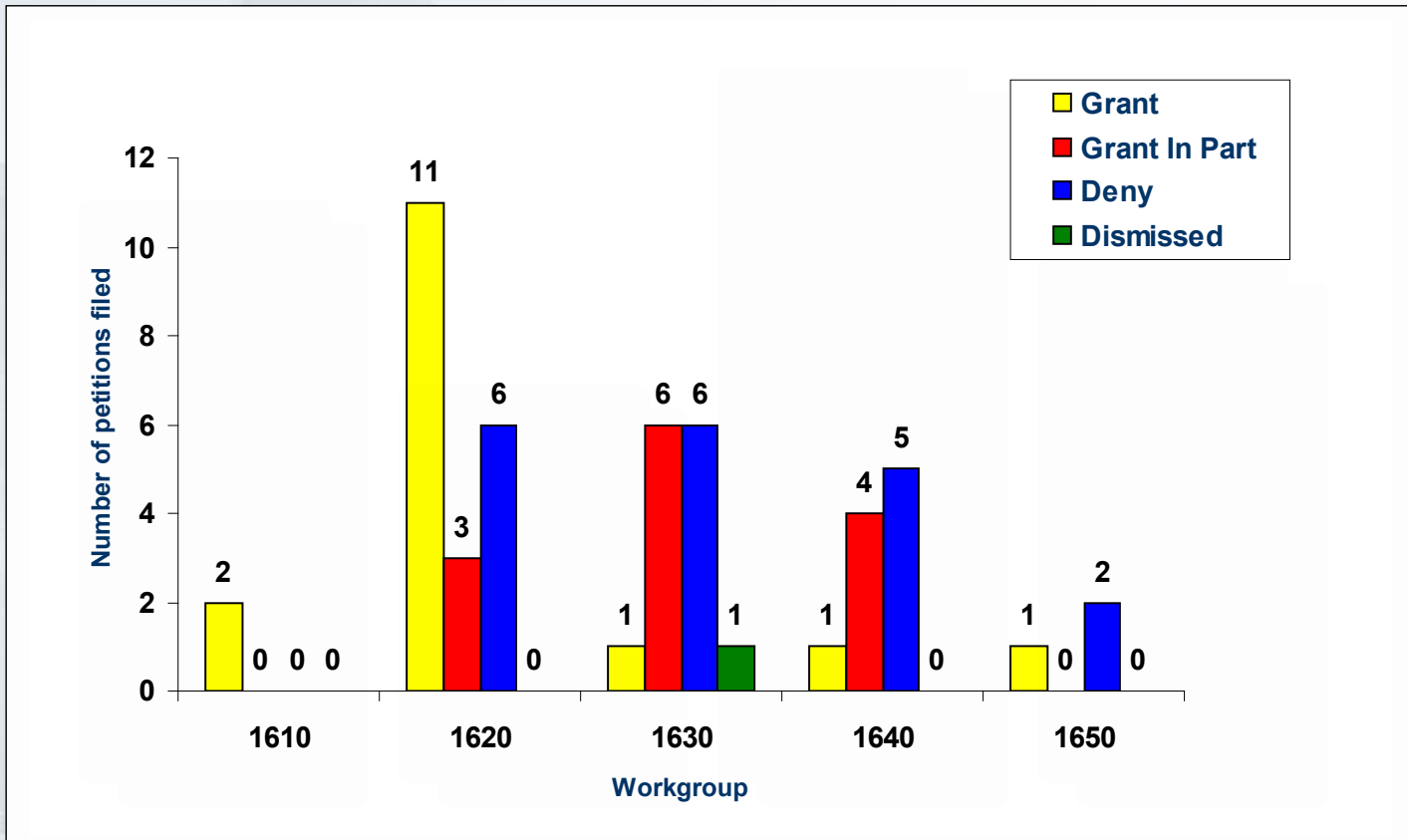


Petition Outcome by Workgroup For FY05



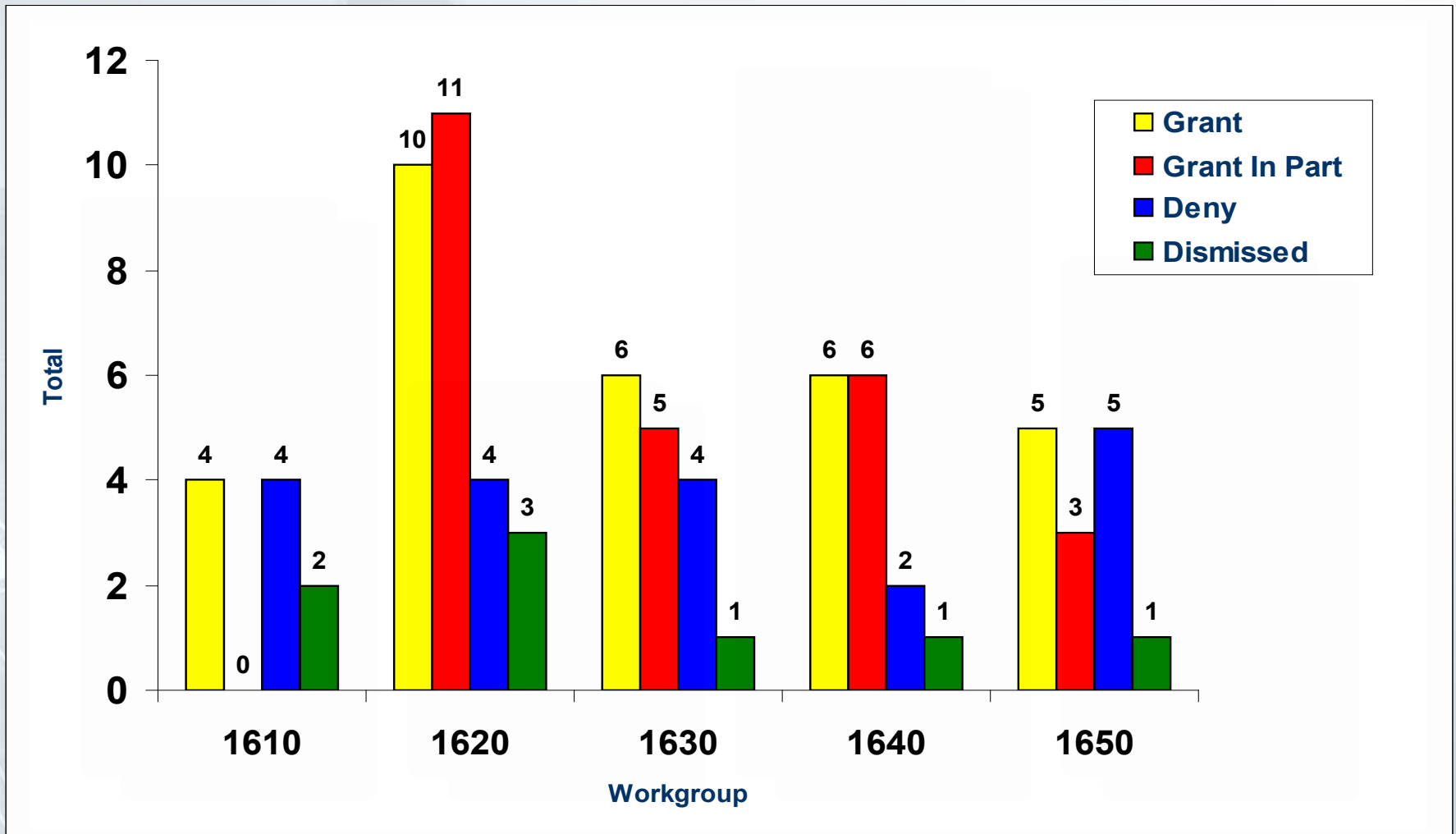


Petition Outcome by Workgroup For FY06



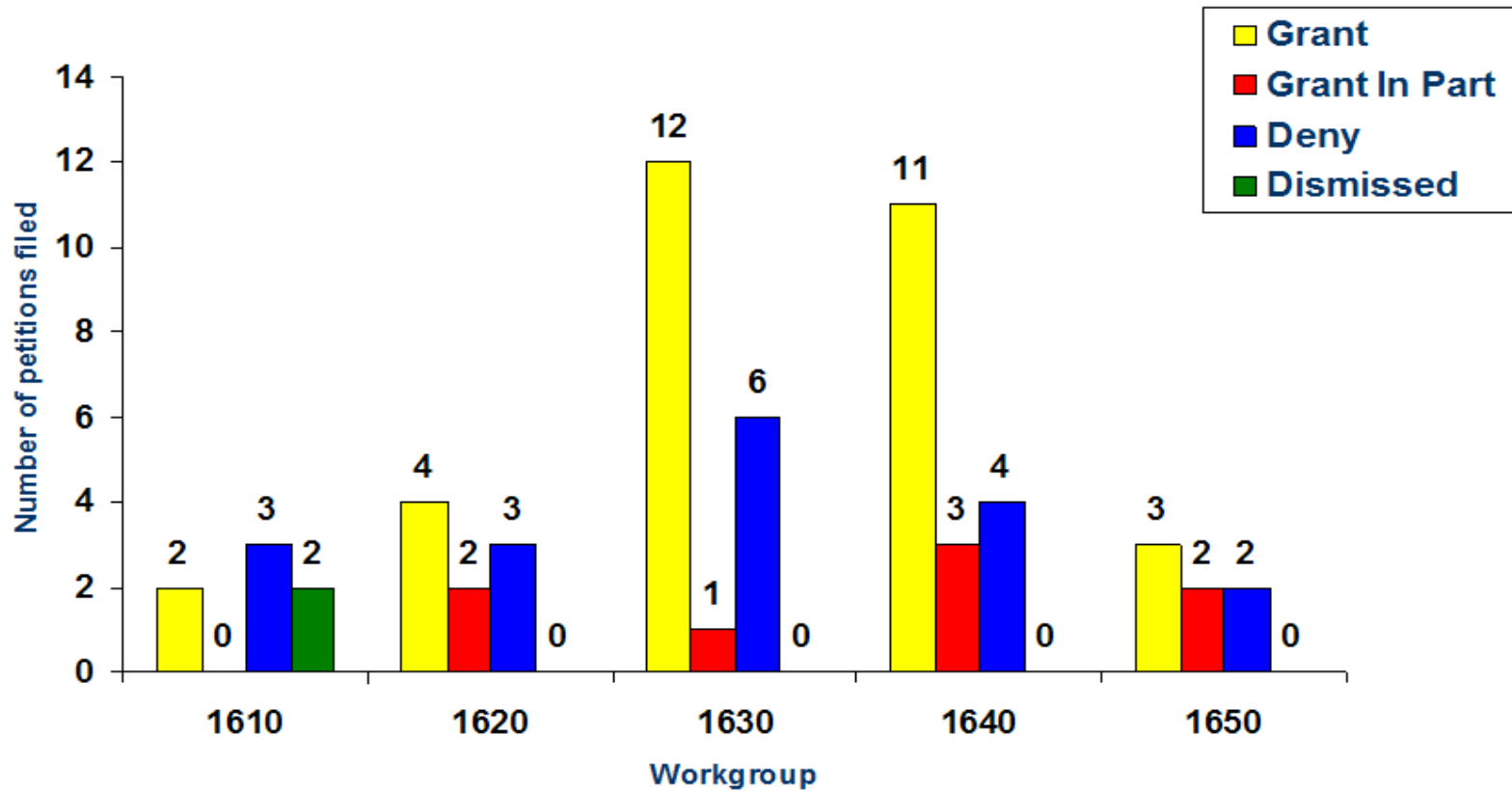


Petition Outcome By Workgroup FY07



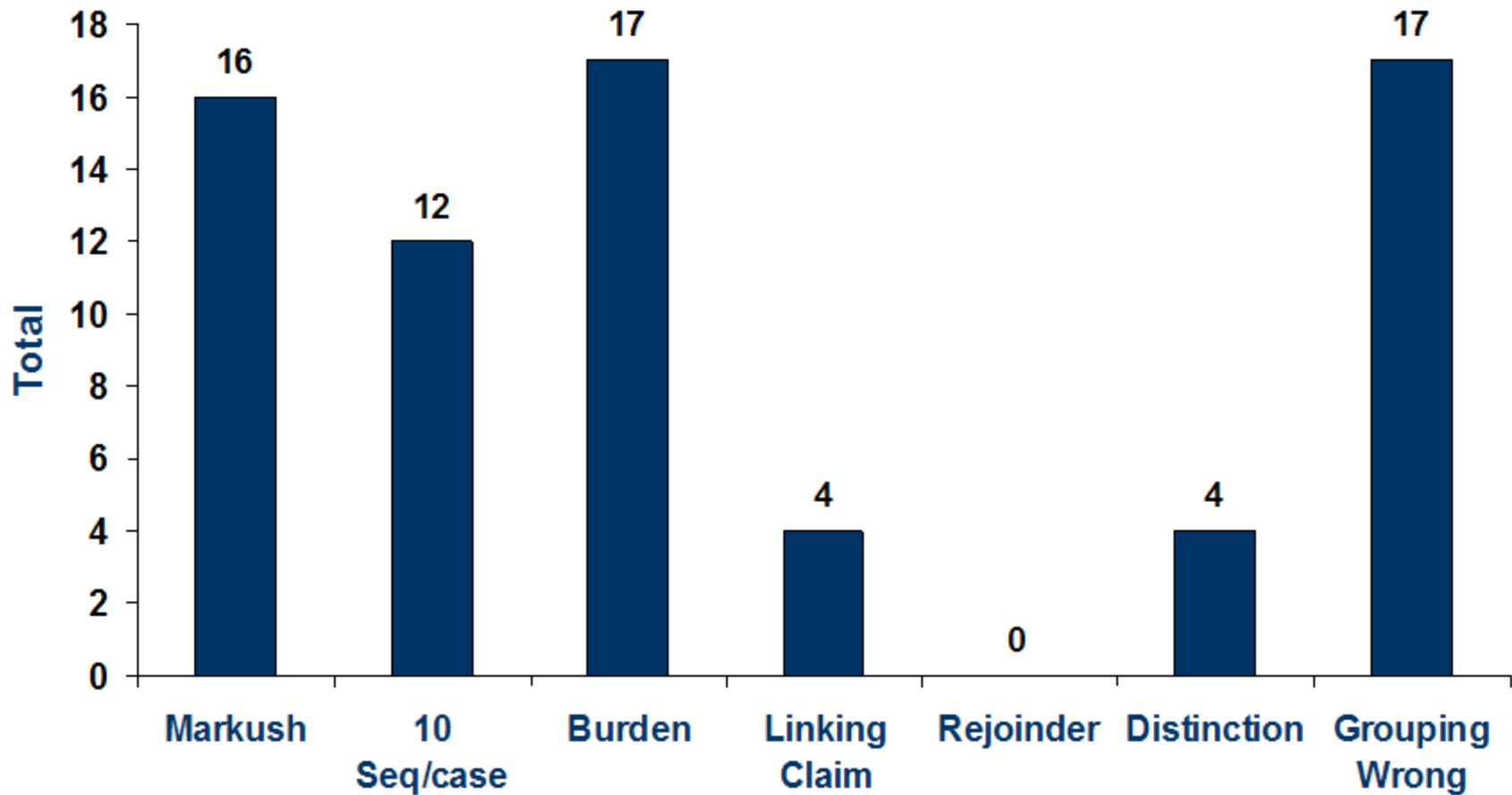


Petition Outcome By Workgroup For FY08



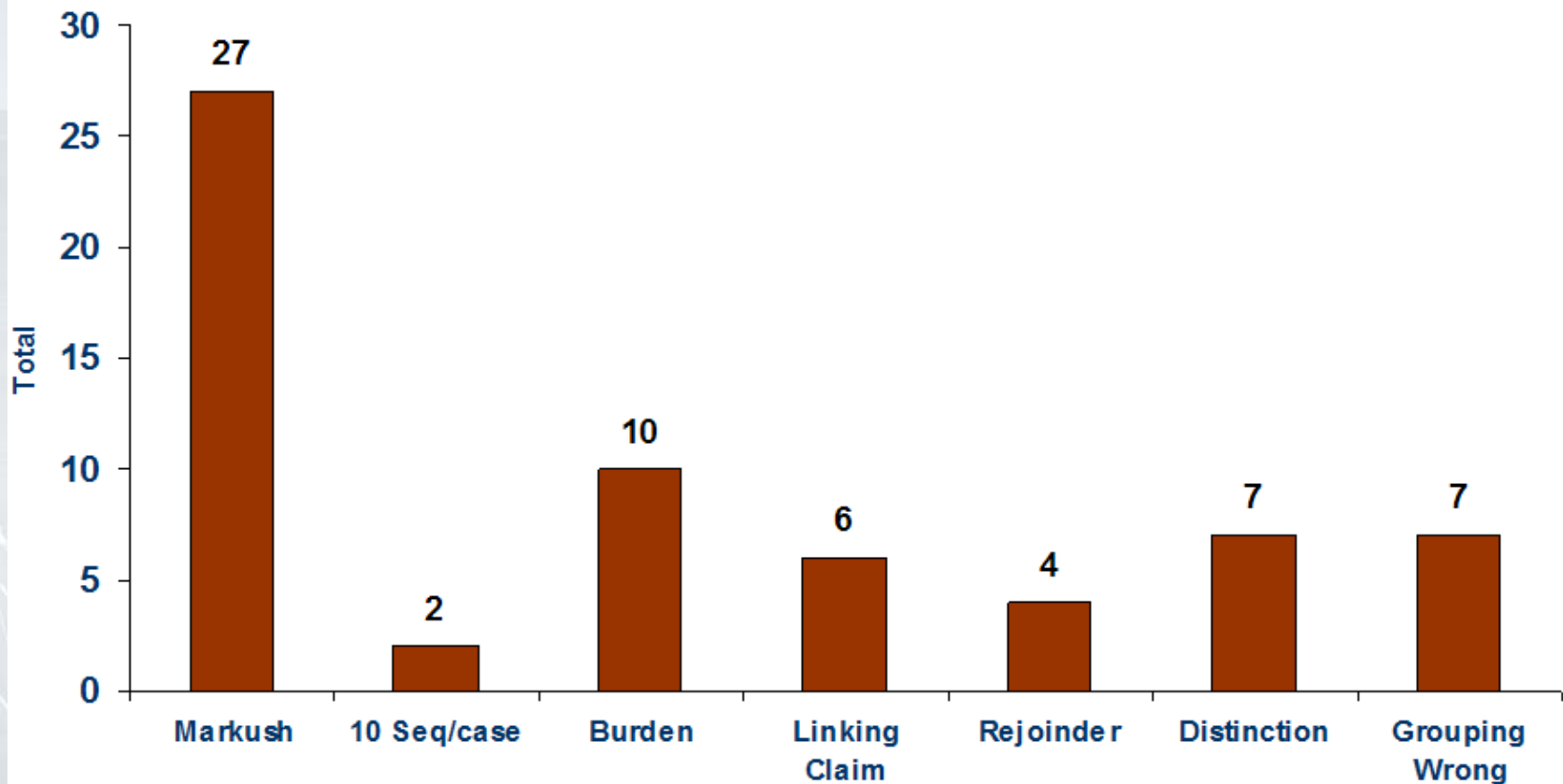


TYPES OF CONCERNS FY04



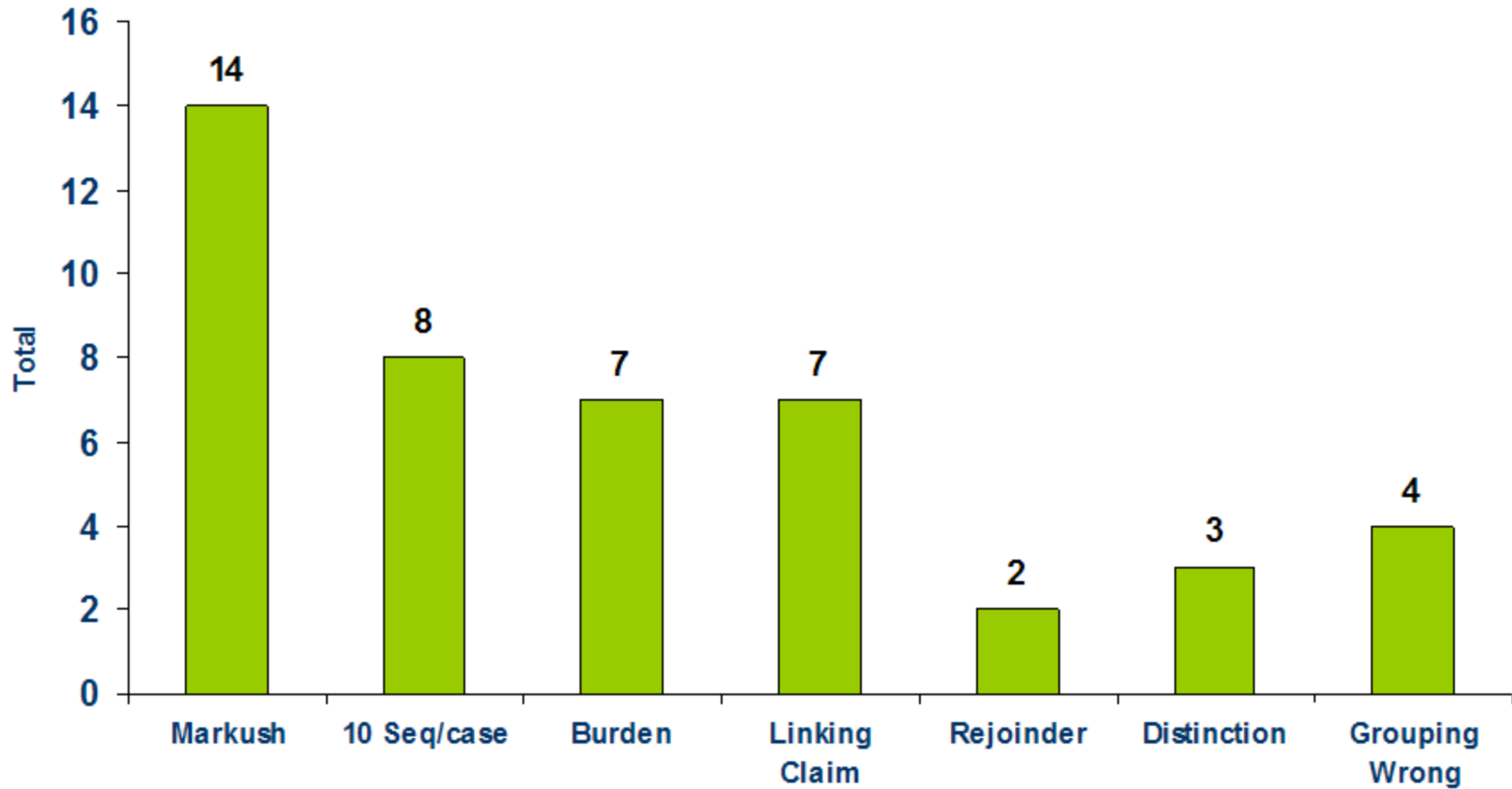


TYPES OF CONCERNS FY05



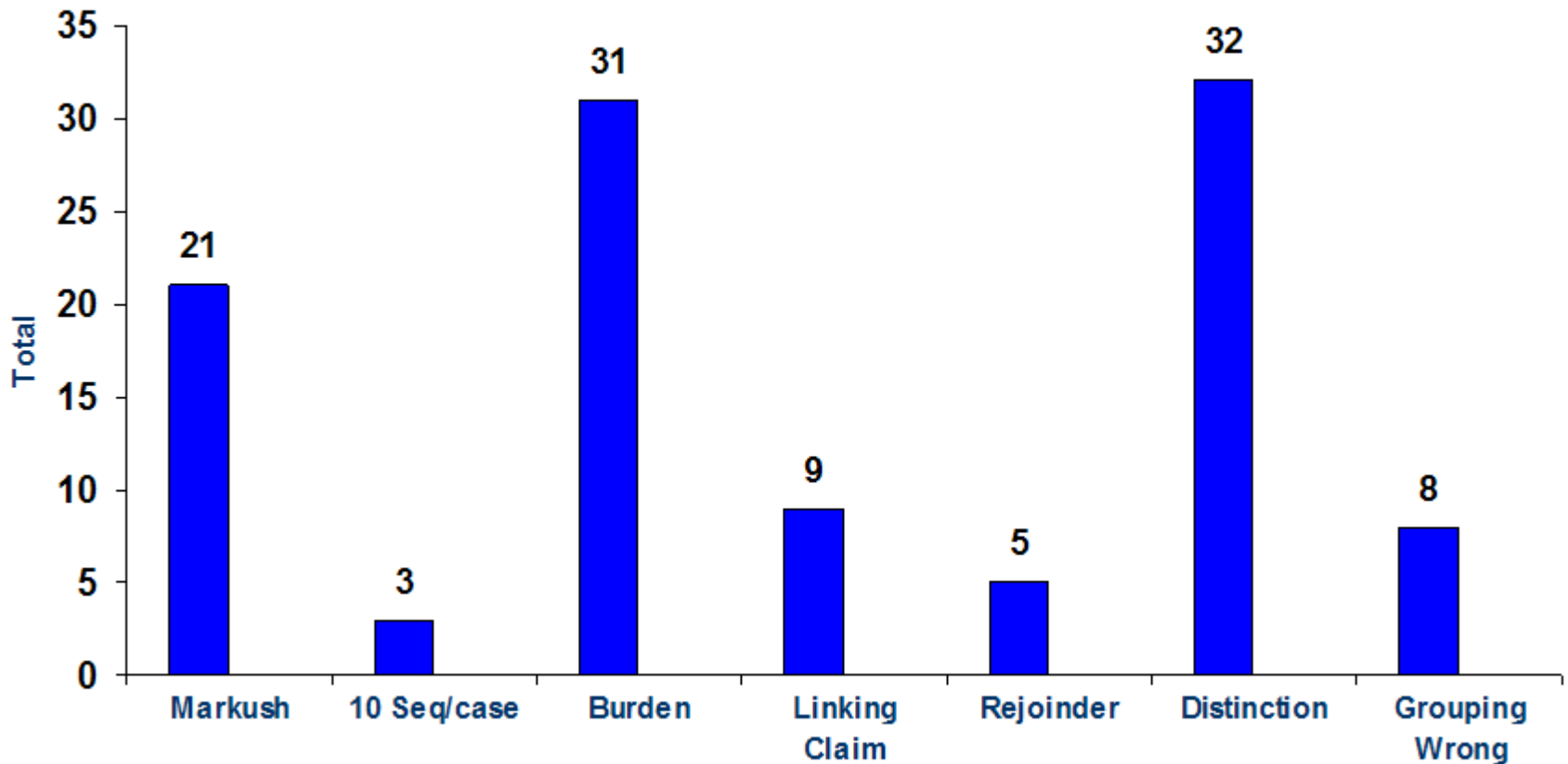


TYPES OF CONCERNS FY06



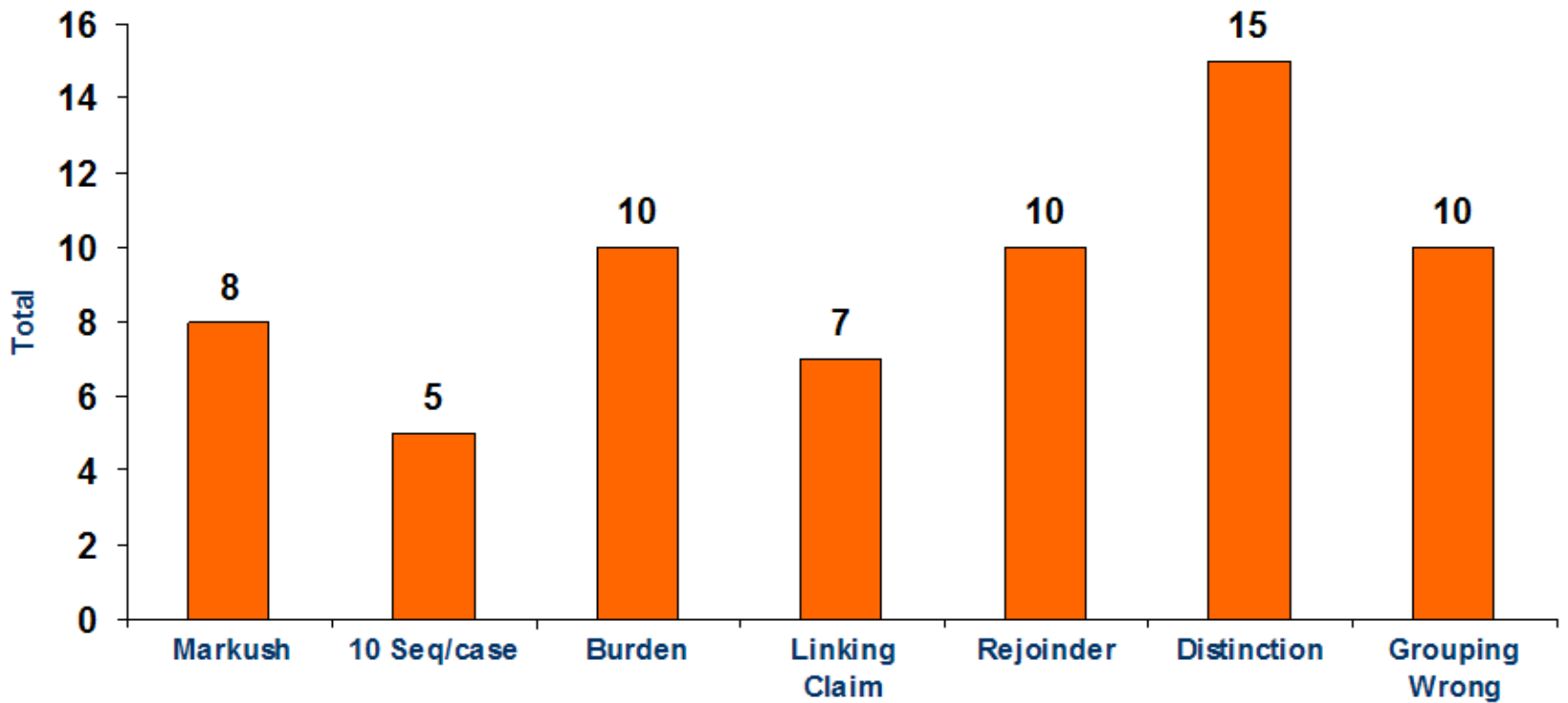


TYPES OF CONCERNS FY07





TYPES OF CONCERNS FY08





Contents

- FY08 Restriction Petition Update
- Overview of Burden



Burden

There are two criteria for a proper requirement for restriction between patentably distinct inventions:

- (A) The inventions must be independent (see MPEP § 802.01, § 806.06, § 808.01) or distinct as claimed (see MPEP § 806.05 - §806.05(j)); and
- (B) There would be a serious burden on the examiner if restriction is not required (see MPEP § 803.02, § 808, and § 808.02).

MPEP 803



Prima Facie Showing of Burden

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 803



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.
- MPEP 808.02



Establishing Search Burden

Thus the examiner must show by appropriate explanation one of the following:

- (A) Separate classification thereof
- (B) A separate status in the art when they are classifiable together or
- (C) A different field of search

MPEP 808.02



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.

MPEP 808.02



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.

MPEP 808.02



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.

MPEP 808.02



Examination Burden

- (d) the prior art applicable to one invention would not likely be applicable to another invention

- (e) the inventions are likely to raise different non-prior art issues under 35 U.S.C. 101 and/or 35 U.S.C. 112, first paragraph



When Burden Cannot be Shown

Where, however, the classification is the same and the field of search is the same and there is no clear indication of separate future classification and field of search, no reasons exist for dividing among independent or related inventions.

MPEP 808.02



Markush Claims

A Markush-type claim recites alternatives in a format such as “selected from the group consisting of A, B and C.” See *Ex parte Markush*, 1925 C.D. 126 (Comm’r Pat. 1925).

The members of the Markush group (A, B, and C in the example above) ordinarily must belong to a recognized physical or chemical class or to an art-recognized class.

MPEP 803.02



Burden Analysis for Markush Claims

If the members of the Markush group are sufficiently few in number or so closely related that a search and examination of the entire claim can be made without serious burden, the examiner must examine all the members of the Markush group in the claim on the merits, even though they may be directed to independent and distinct inventions.

In such a case, the examiner will not follow the procedure described below and will not require provisional election of a single species. See MPEP § 808.02.

MPEP 803.02



37 CFR 1.146 Election of Species

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.



37 CFR 1.146 Election of Species

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.



When Generic Claims are Present

In applications where only generic claims are presented, restriction cannot be required unless the generic claims recite or encompass such a multiplicity of species that an unduly extensive and burdensome search would be necessary to search the entire scope of the claim. See MPEP § 803.02 and § 809.02(a).

MPEP 808.01 and 818.02(b)



When Species Claims are Later Added

If applicant presents species claims to more than one patentably distinct species of the invention after an Office action on only generic claims, with no restriction requirement, the Office may require the applicant to elect a single species for examination.

MPEP 808.01 and 818.02(b)



An Instance of Rejoinder Predicated on Lack of Burden

Where the combination is allowable in view of the patentability of at least one of the subcombinations, the restriction requirement between the elected combination and patentable subcombination(s) will be withdrawn;

furthermore, any subcombinations that were searched and determined to be allowable must also be rejoined.

MPEP 806.05(d)



Contents

- FY08 Restriction Petition Update
- Overview of Burden

Questions?



Julie Burke

Quality Assurance Specialist, TC 1600

571-272-0512

julie.burke@uspto.gov