

FY09 Restriction Petition Update; Comparison of US and National Stage Restriction Practice



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TC 1600 Filings and Restrictions

In FY09, TC1600

- mailed 33,191 first Office actions on the merits
- mailed 11,871 restriction requirements
- received about 75 restriction petitions

National stage filings of a PCT application under 371

- account for 29% of TC1600 applications
- yet result in 34% of the petitions

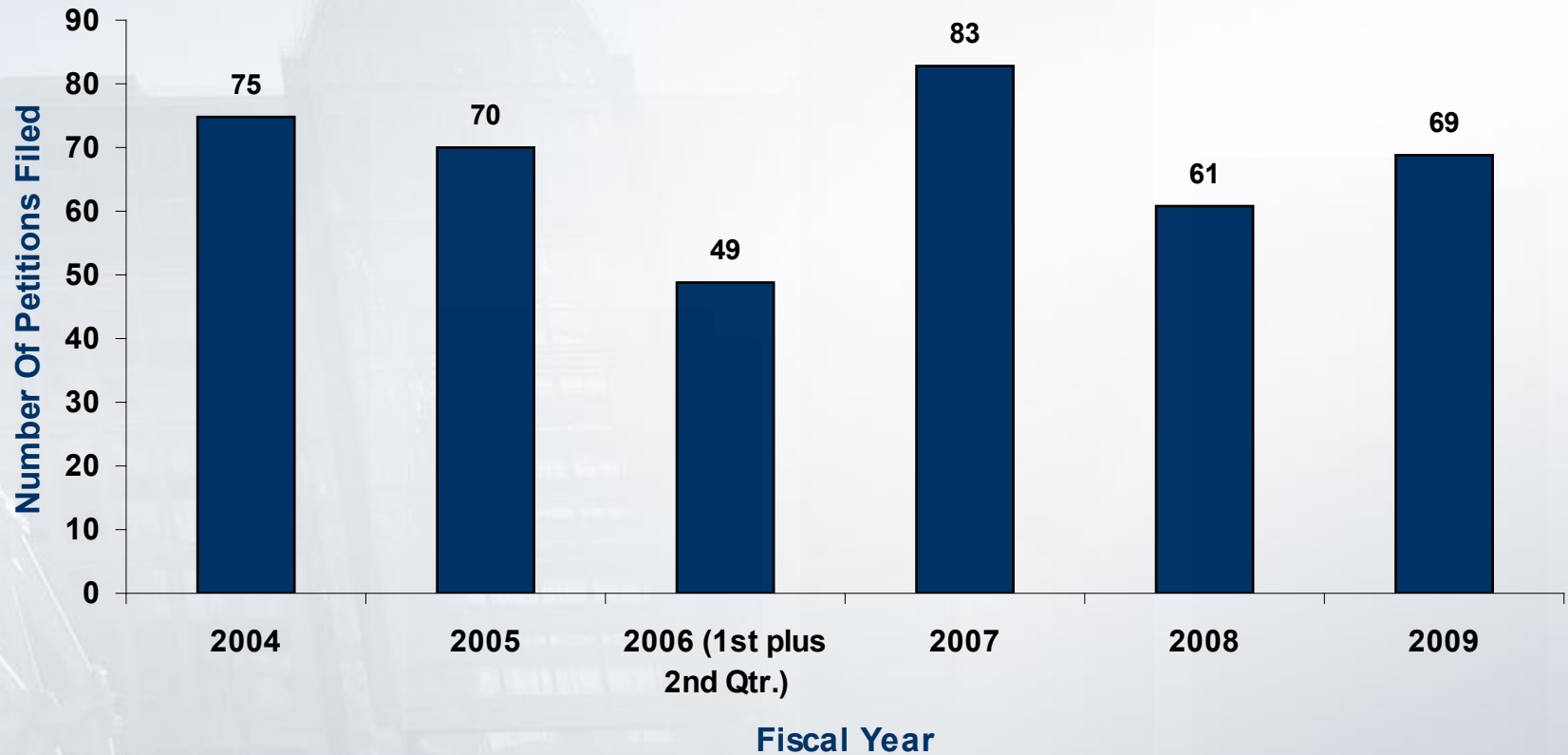
In FY09

- 78% of the Restriction Petitions were granted in full or in part
- 34% of the petitions applications were filed under 35 USC 371

Average restriction petition turn around time about 100 days



Restriction and Unity of Invention Petitions Filed in FY04 – FY09

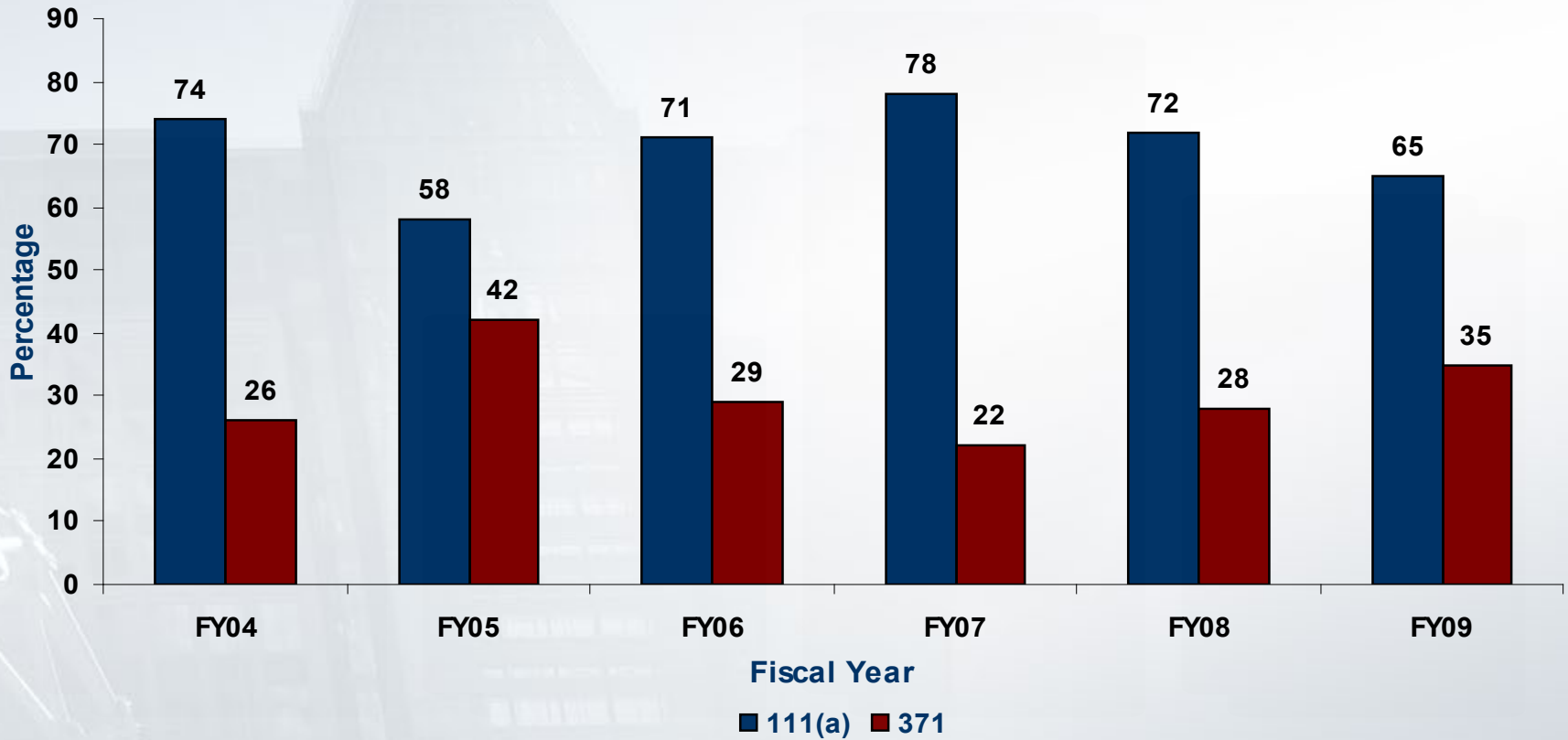


■ Petitions Filed

Final 12/08/09

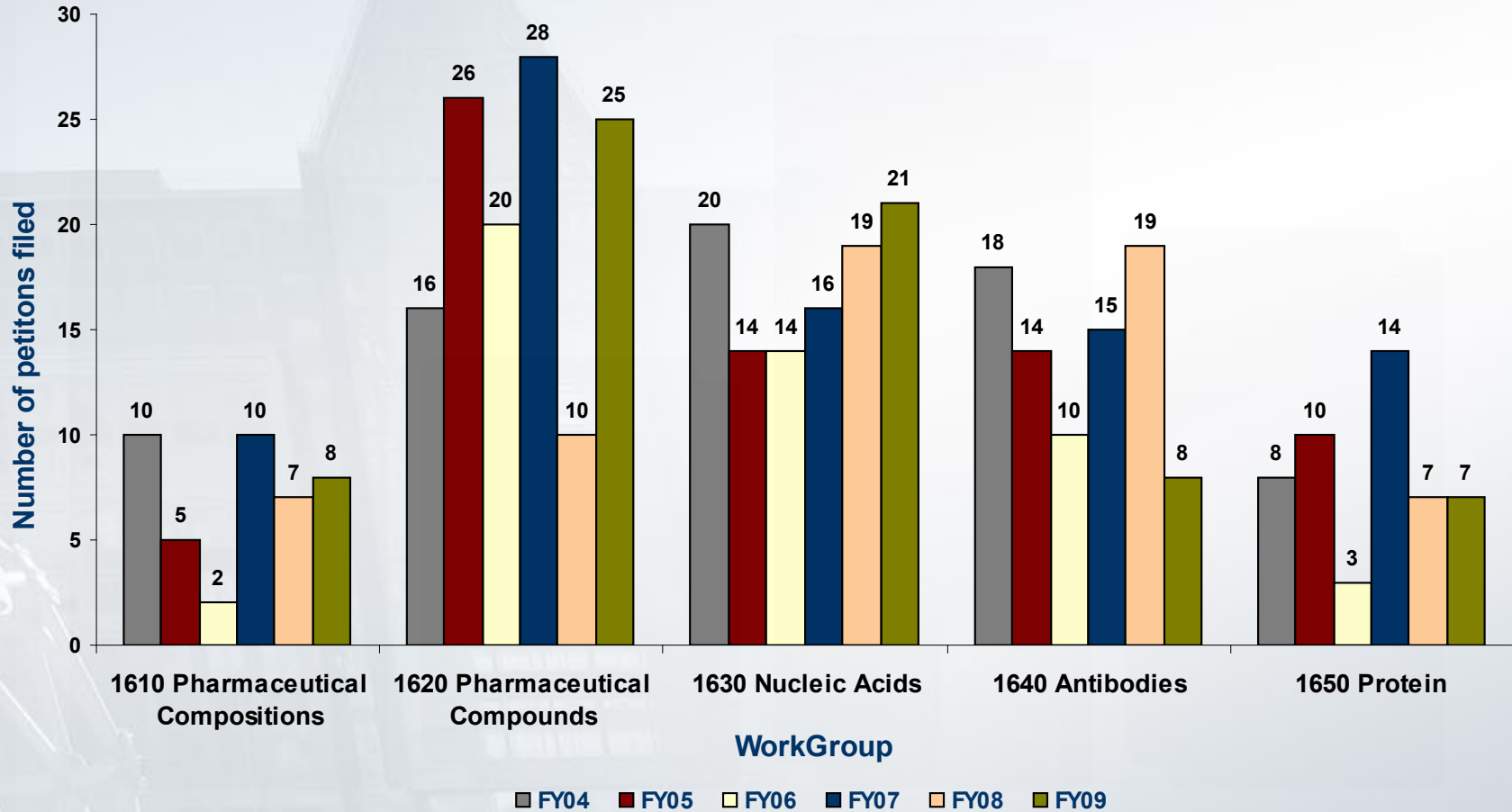


Restriction in 111 (a) and Unity of Invention in 371 For FY04 - FY09



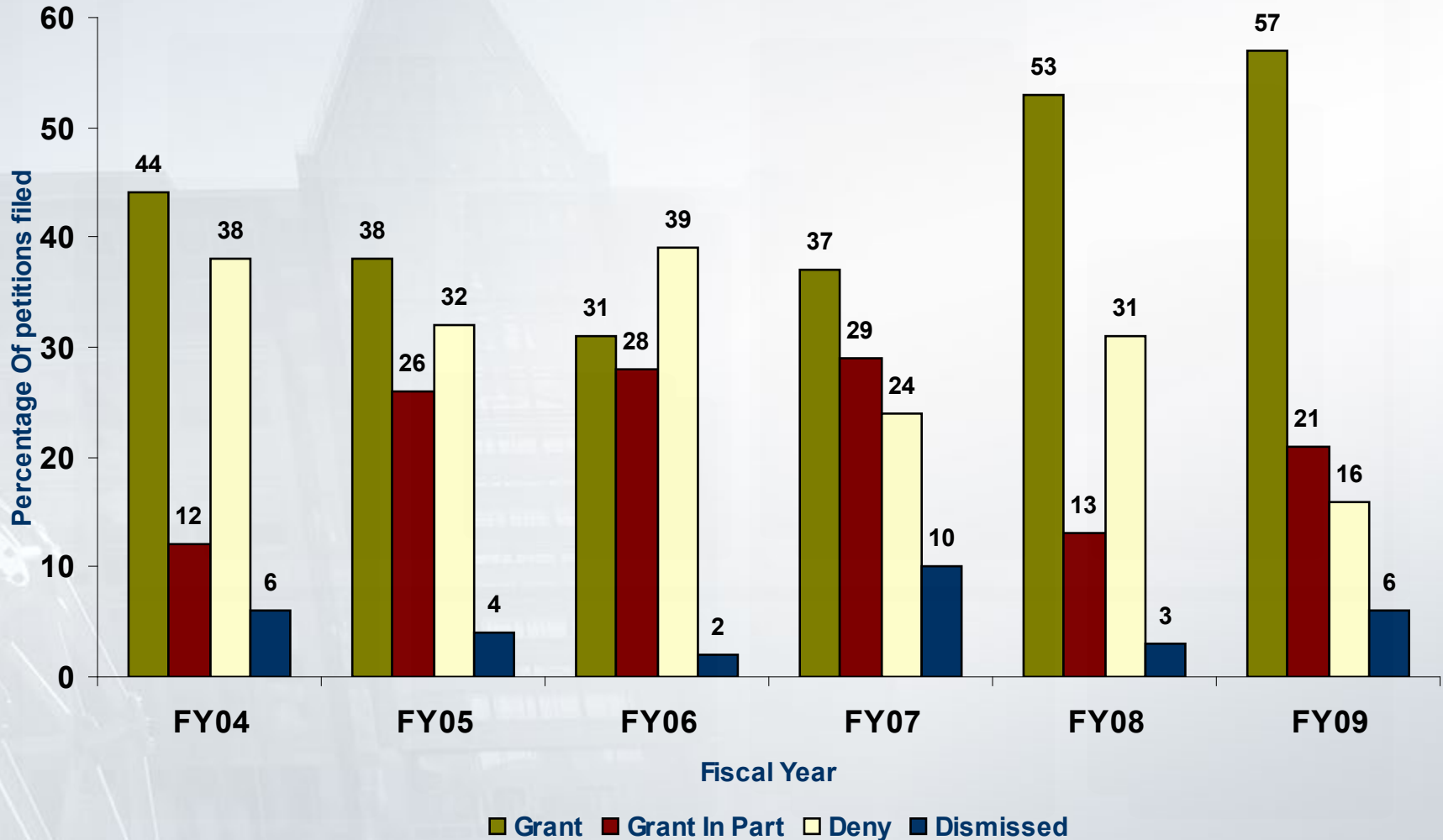


Restriction Petitions by Workgroup Filed in FY04 to FY09



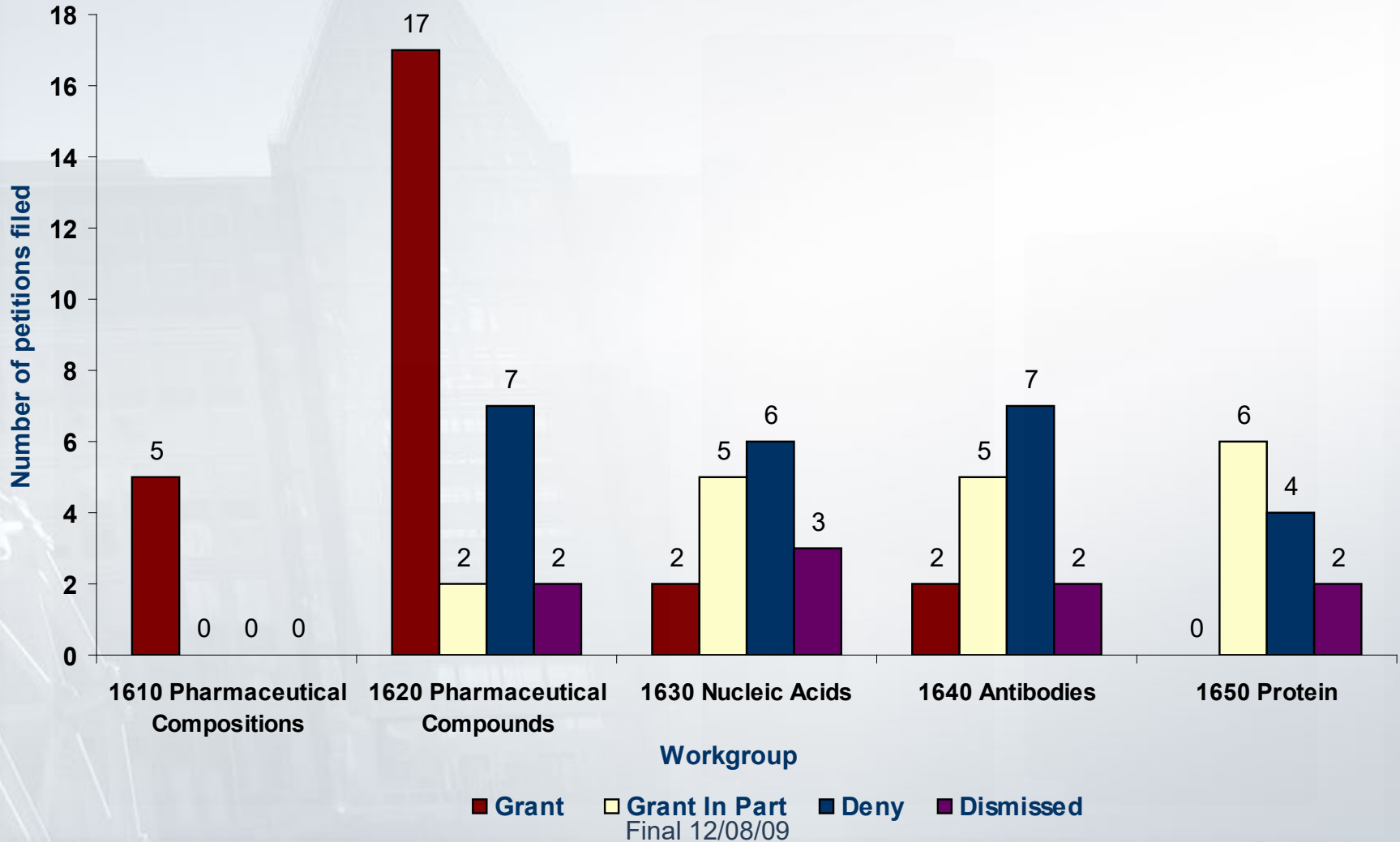


Petition Outcome by Fiscal Year



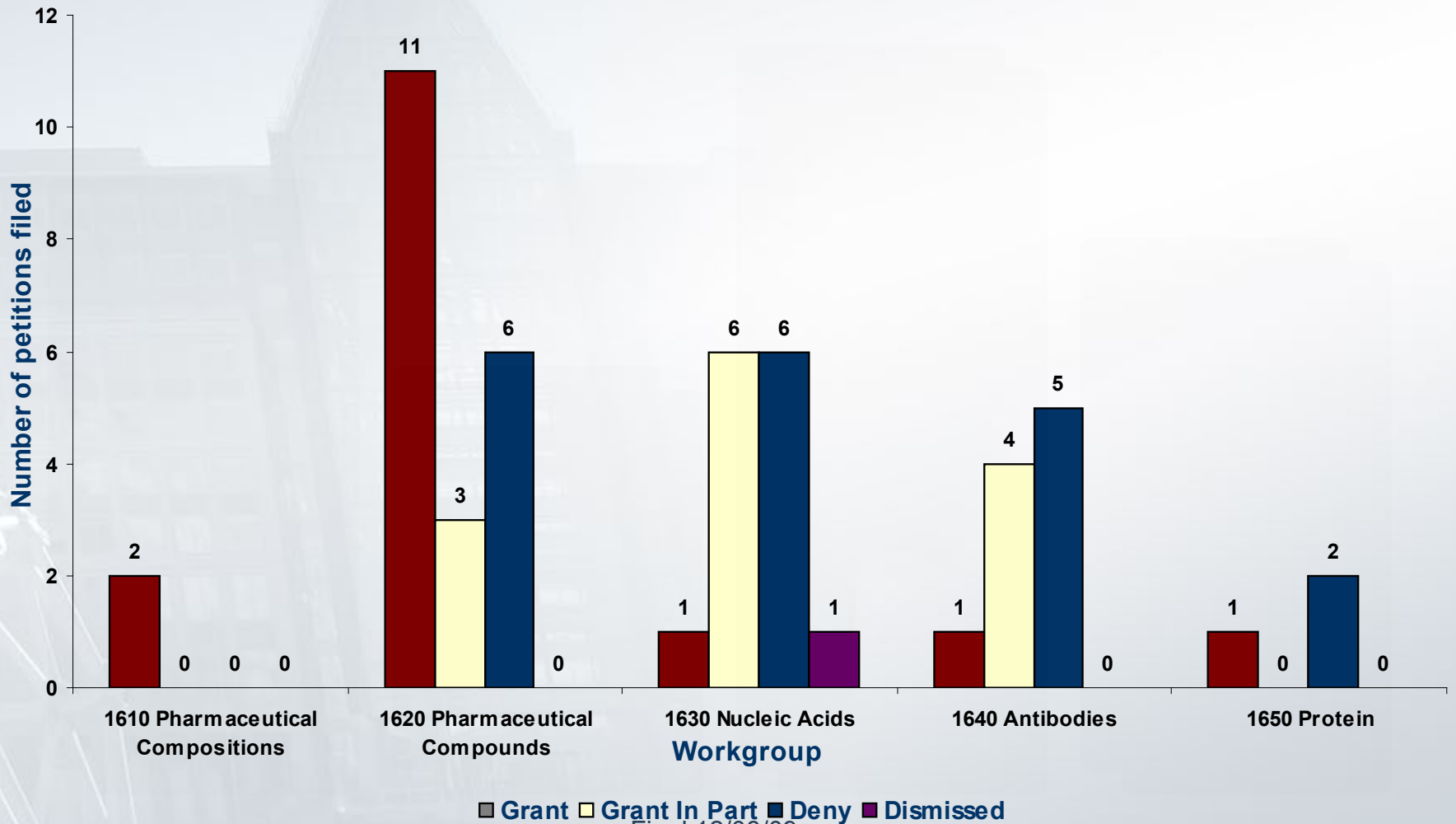


Petition Outcome by Workgroup For FY05





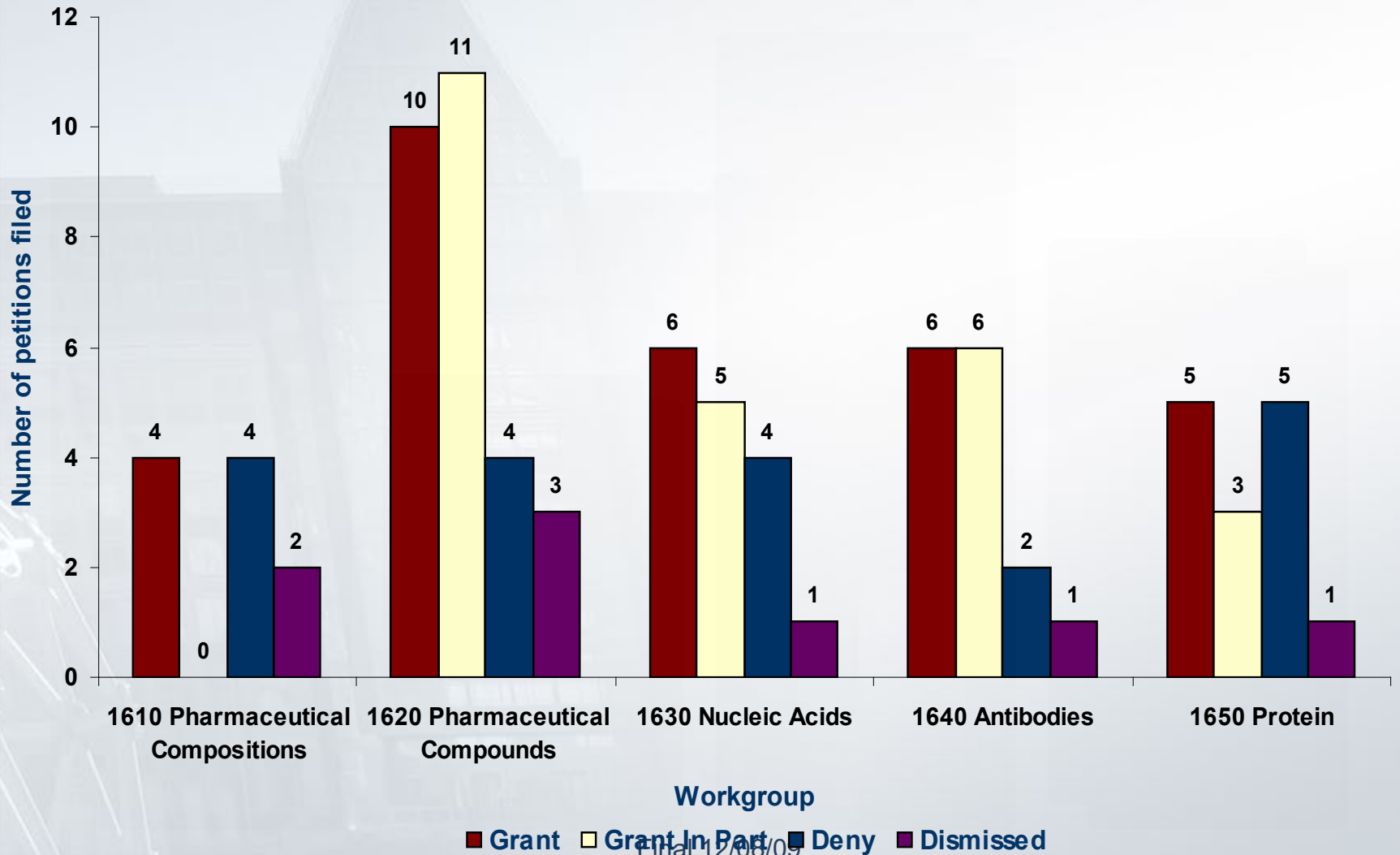
Petition Outcome by Workgroup For FY06



Final 12/08/09

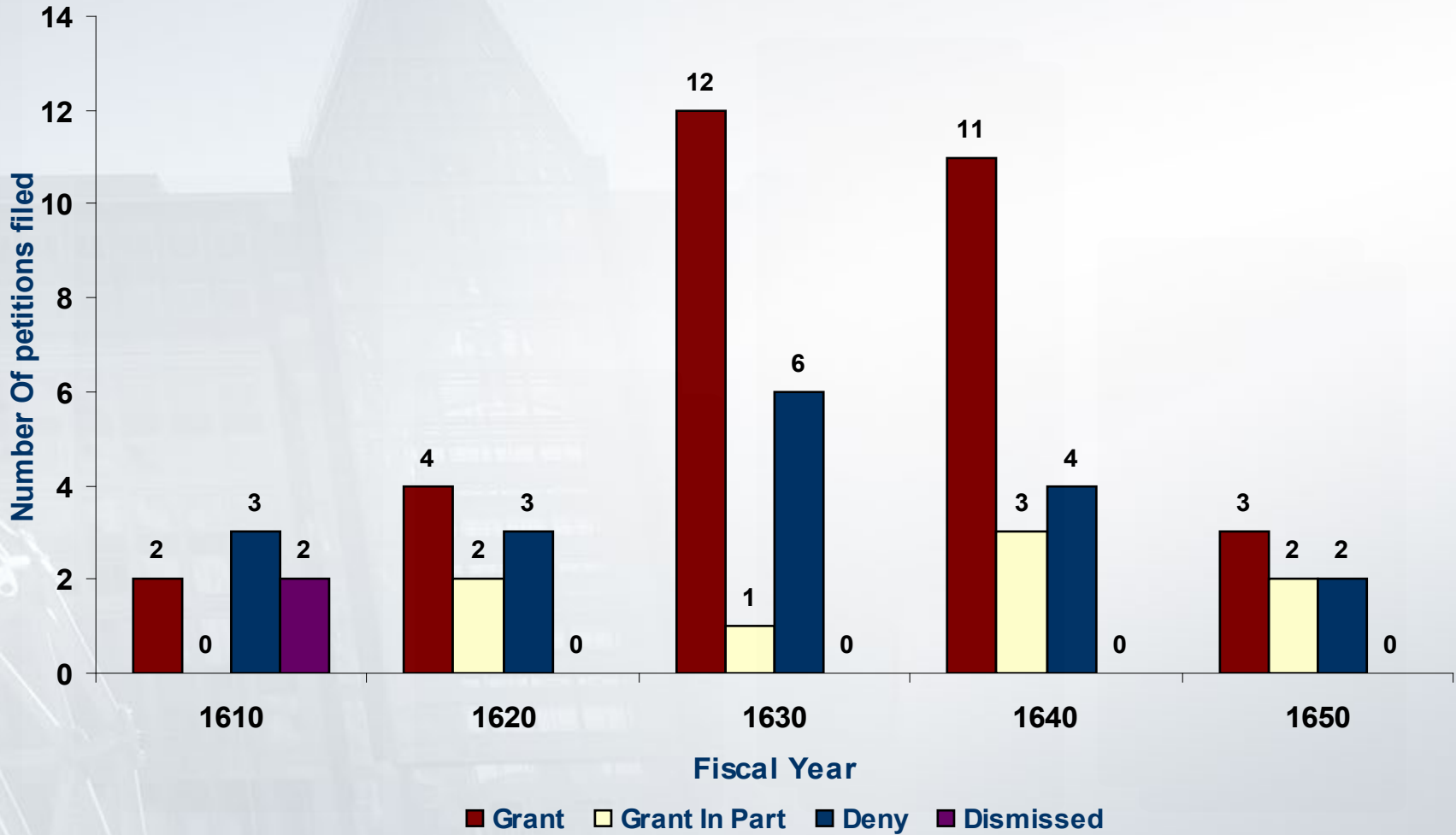


Petition Outcome By Workgroup FY07



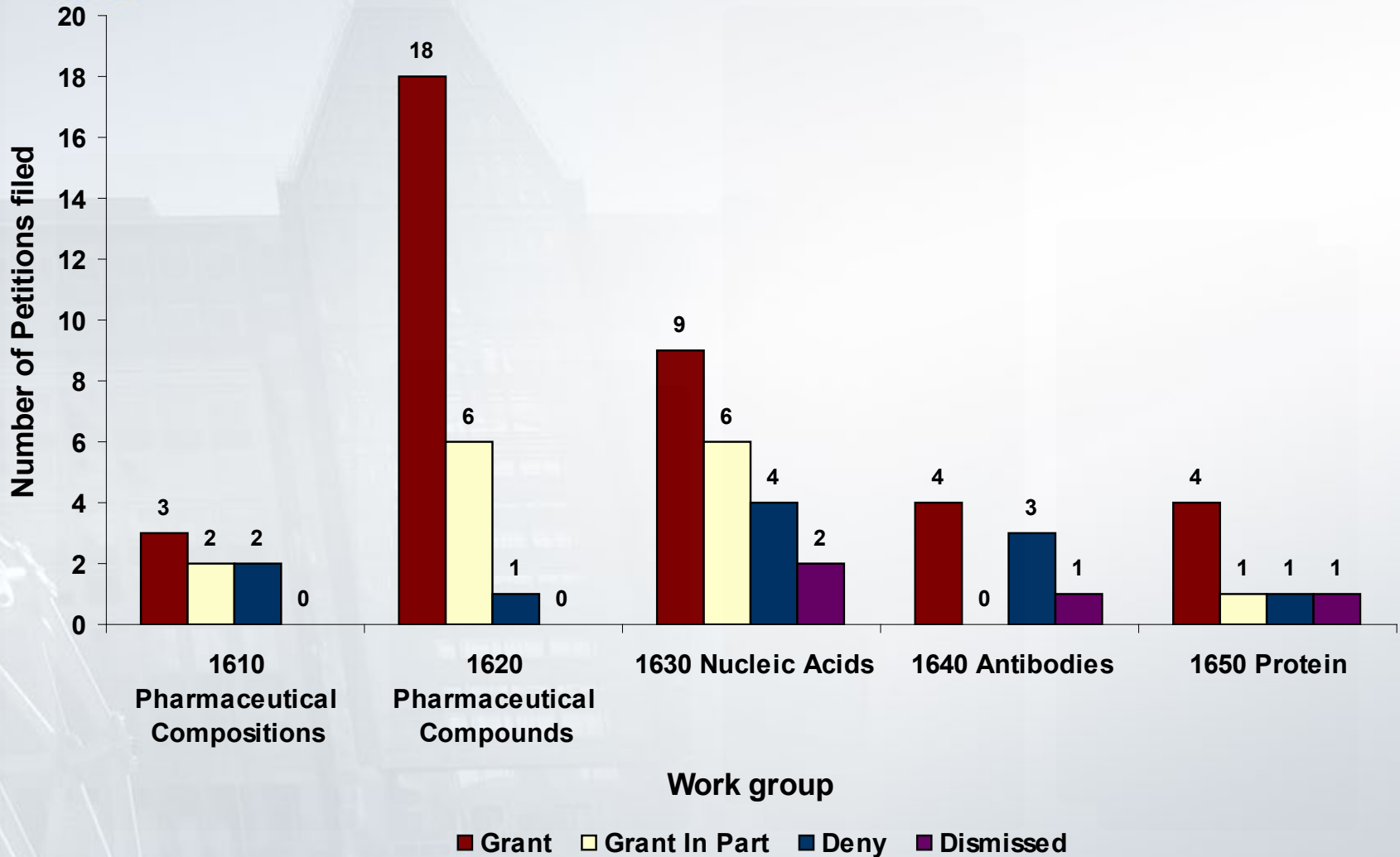


Petition Outcome By Workgroup For FY08



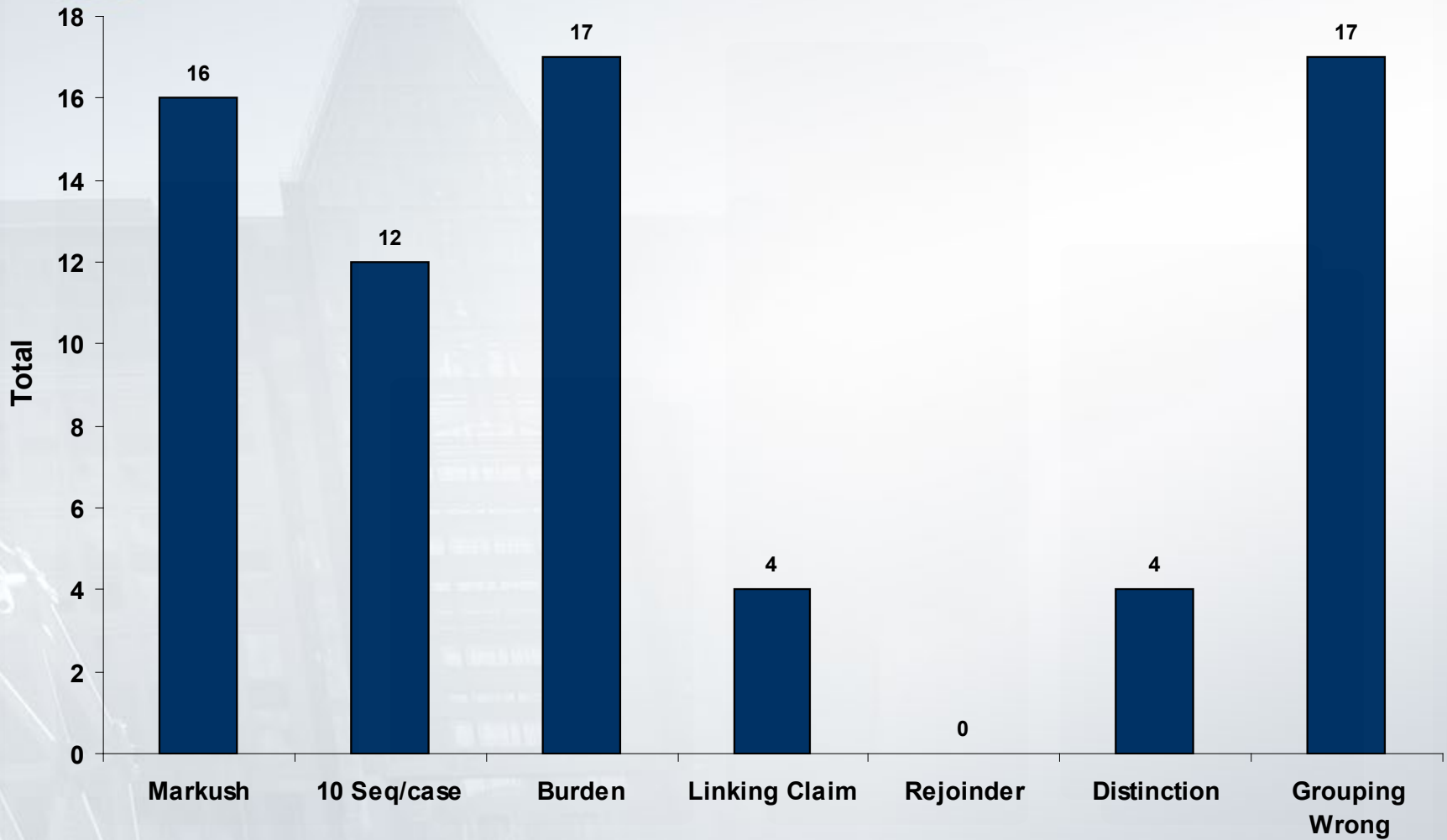


Petition Outcome By Workgroup For FY09



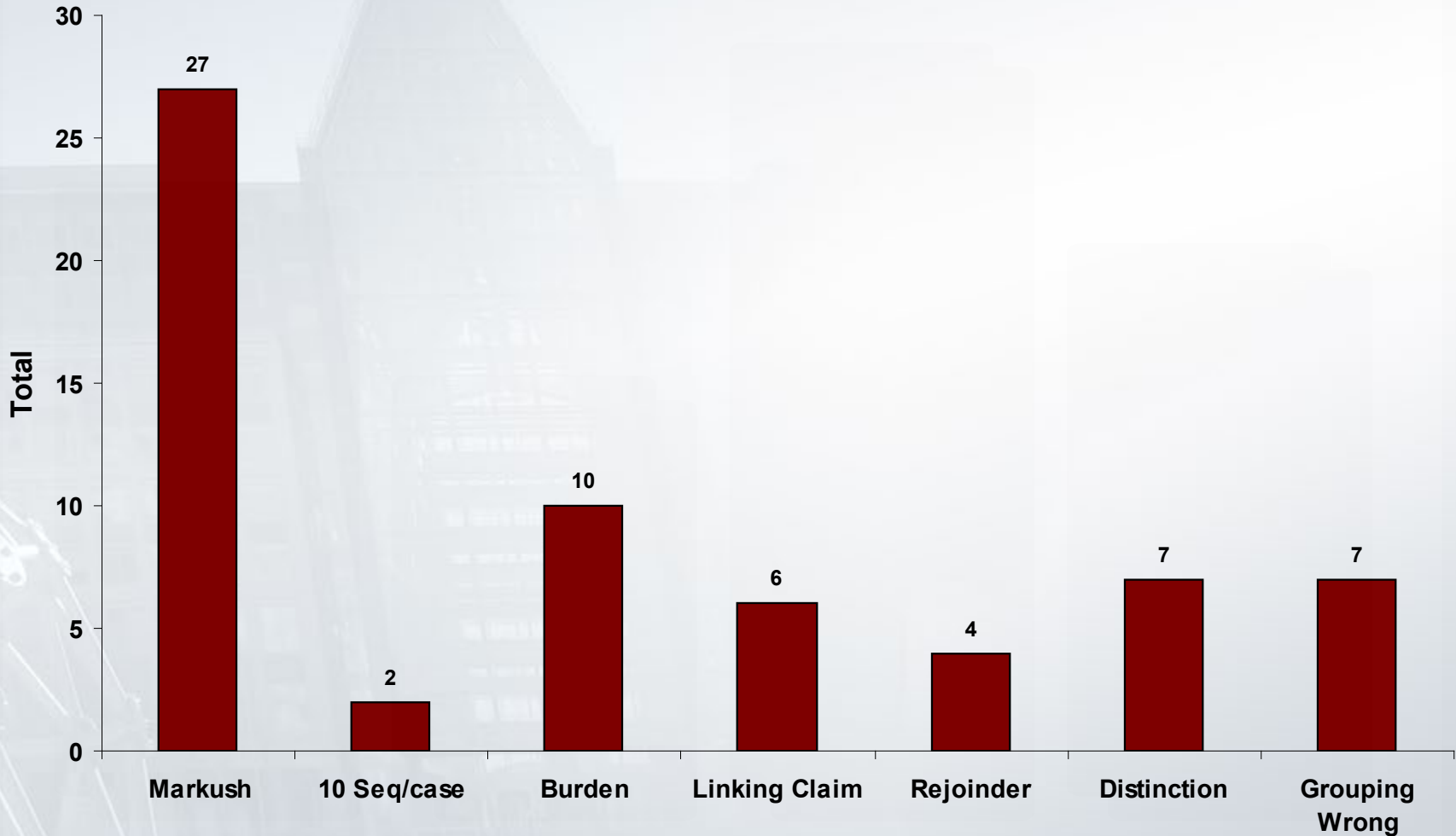


TYPES OF CONCERNS FY04



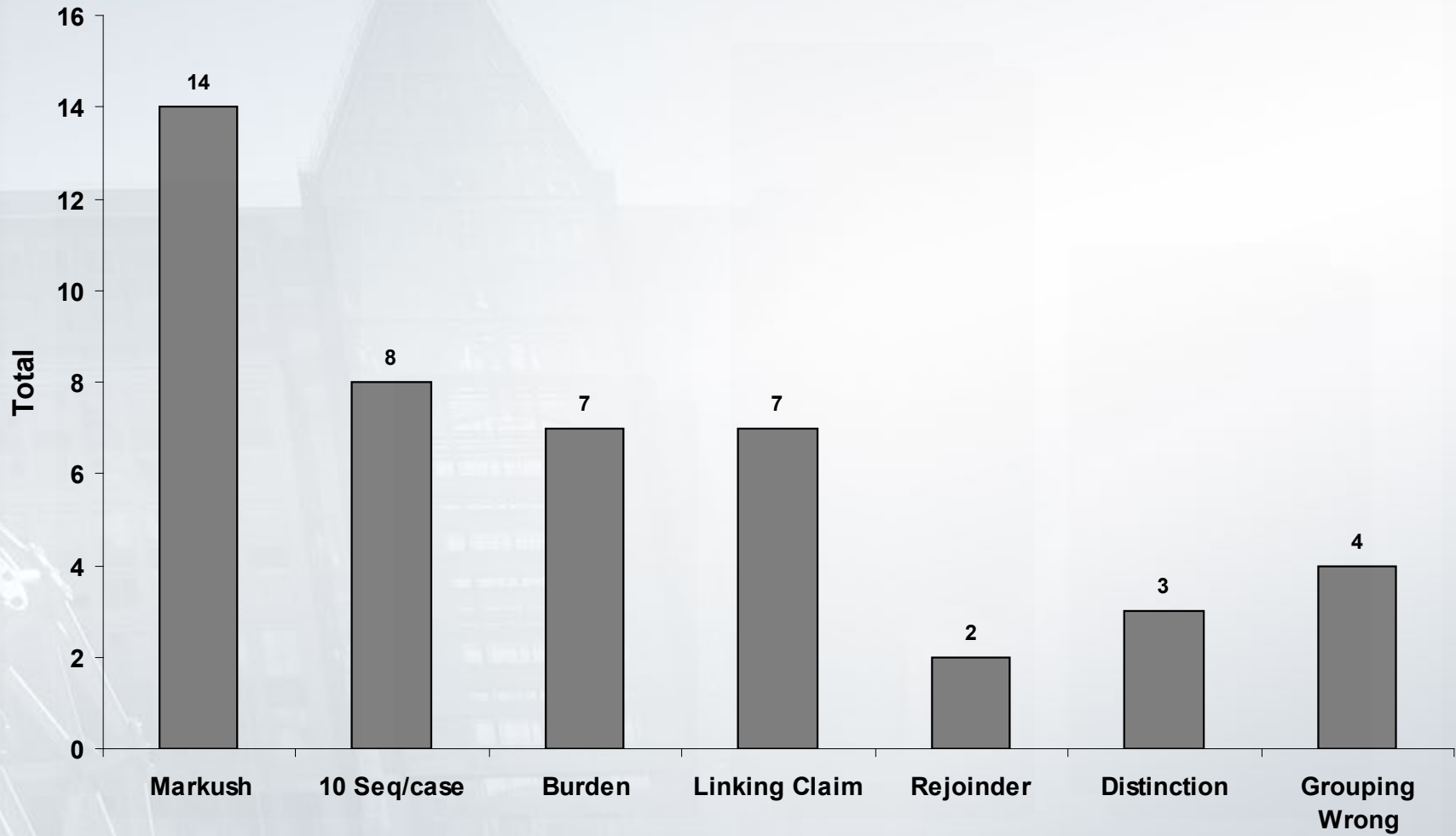


TYPES OF CONCERNS FY05



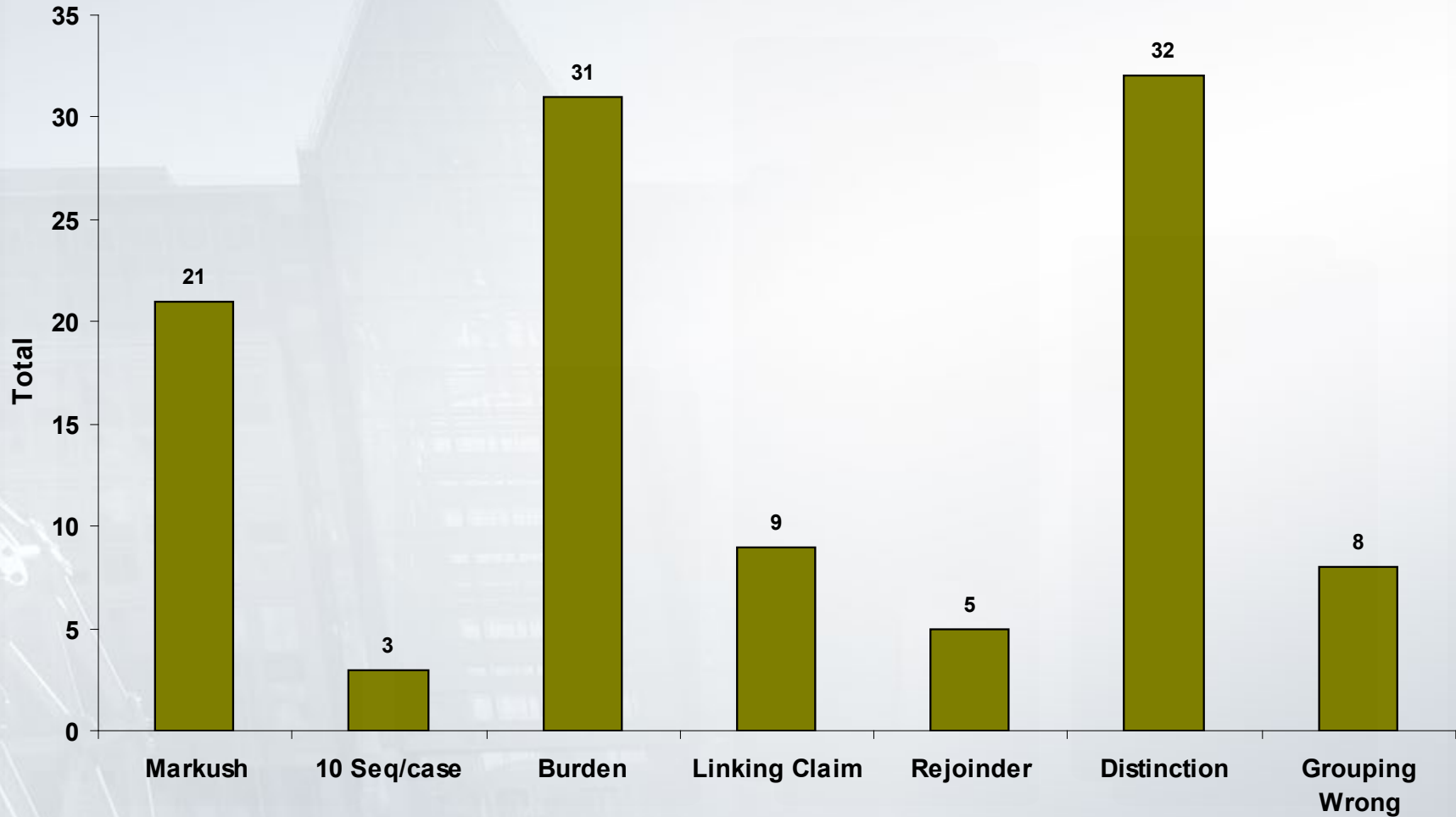


TYPES OF CONCERNS FY06



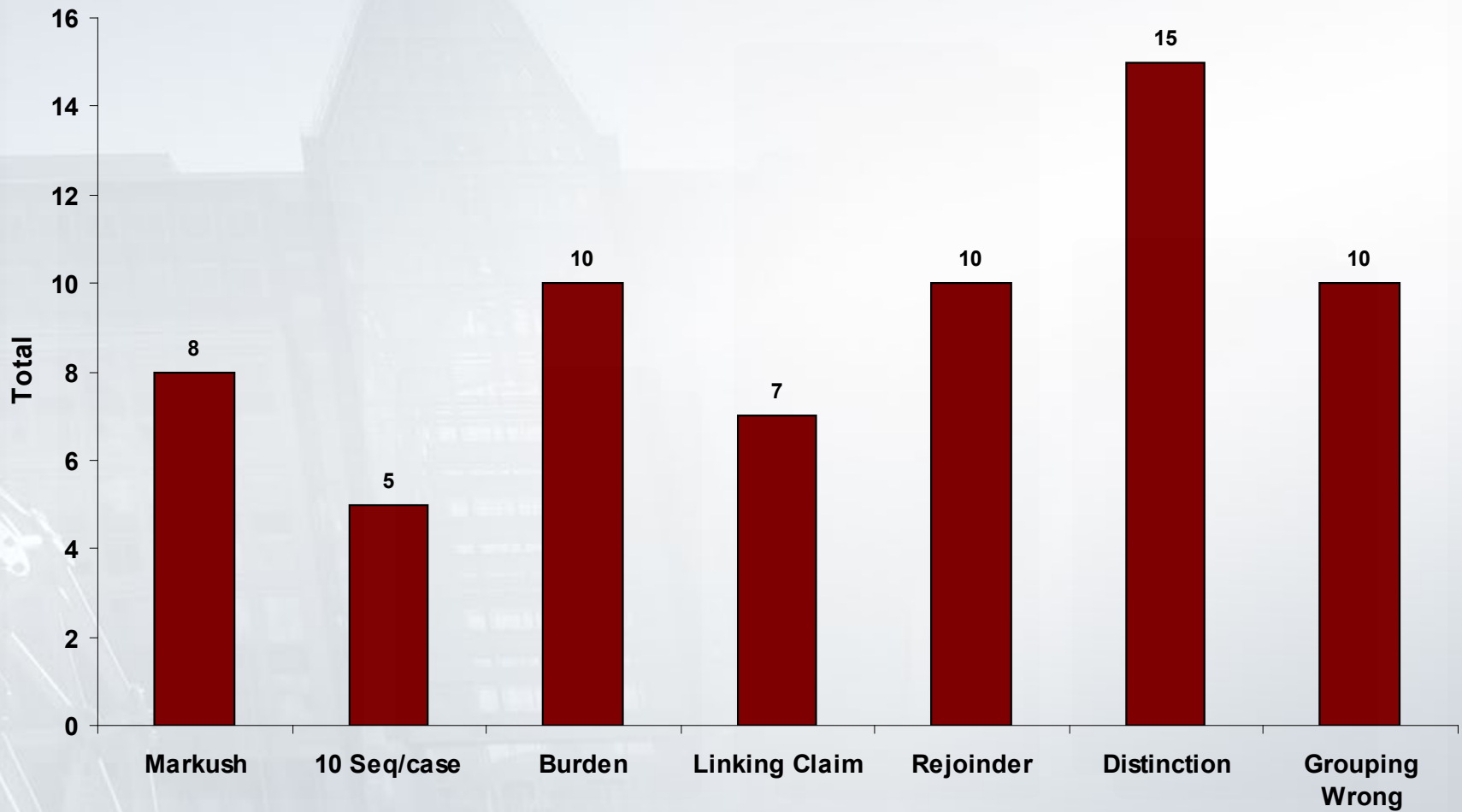


TYPES OF CONCERNS FY07



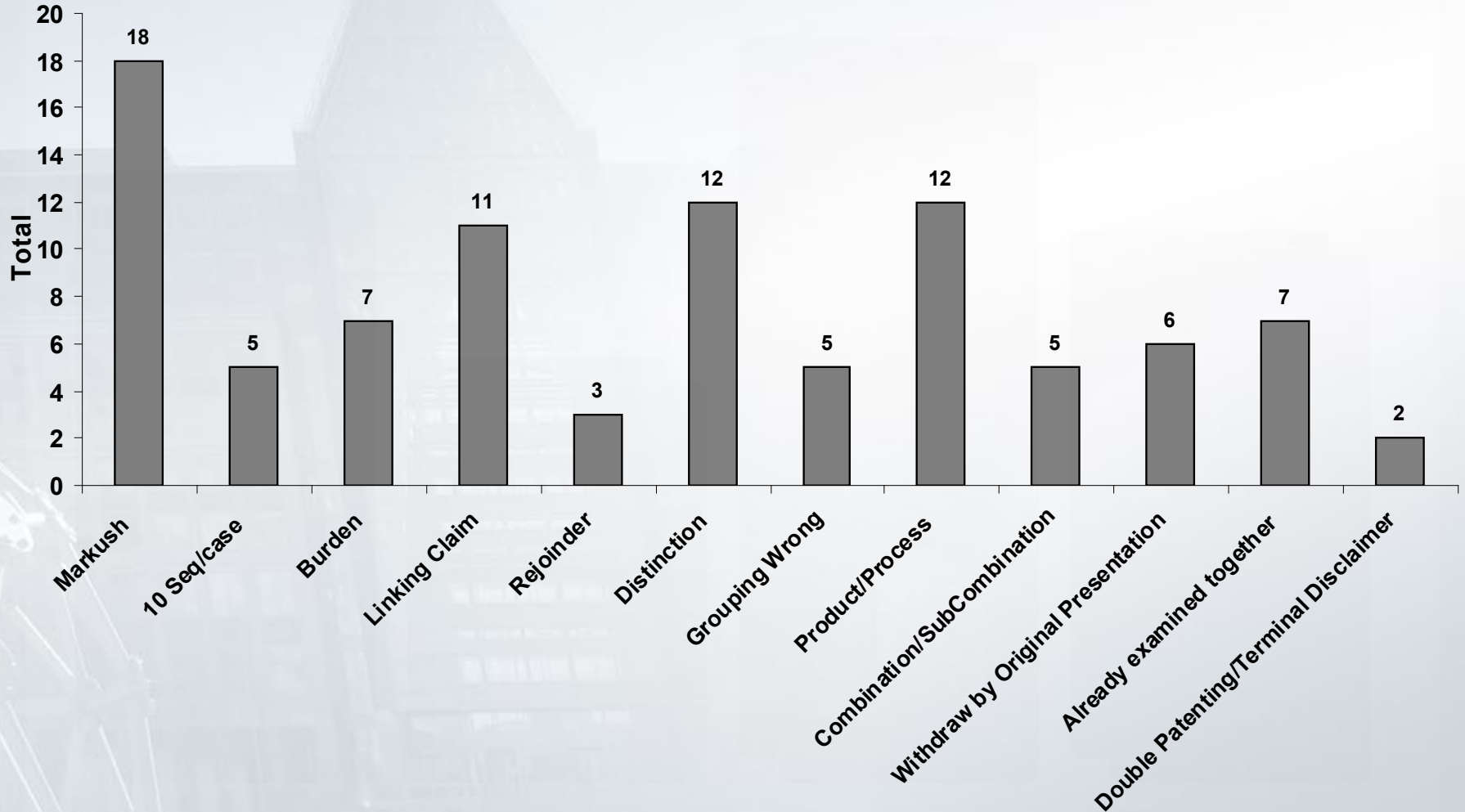


TYPES OF CONCERNS FY08





TYPES OF CONCERNS FY09





Other Outcomes from Petition Decisions in FY09

	Number of Petitions
Previous Office Action on Merits is withdrawn as incomplete	16
Objection to claims for reciting non-elected subject matter is withdrawn.	9
Restriction is turned into a provisional election of species.	6
Notice(s) of non-responsive amendments are replaced with miscellaneous communication regarding bona fide response	4



Overview of Common Concerns For FY09 US (111) & National Phase (371) Applications

- Compounds and Compositions
- Products and Processes
- Rejoinder
- Restriction AFTER an Office action on the merits
- Election of Species permitted for new claims
- Withdrawn via Election by Original Presentation
- Requirement to remove non-elected subject matter
- Notice of Non-Compliant Amendments versus Notice of Non-Responsive Amendments
- Getting applications back on track



Compounds and Compositions- 111

Claim 1: Compound A.

Claim 2: An insecticide composition comprising Compound A and a carrier.

“Where inventions are related as disclosed but are not distinct as claimed, *restriction is never proper.*” MPEP 806

“Where the claims of an application define the same essential characteristics of a single disclosed embodiment of an invention, *restriction there between should never be required.* This is because the claims are not directed to distinct inventions; rather they are different definitions of the same disclosed subject matter, varying in breadth or scope of definition.” MPEP 806.03



Compounds and Compositions- 371

“Claim 1: Compound A.

Claim 2: An insecticide composition comprising compound A and a carrier.

Unity exists between claims 1 and 2. The special technical feature common to all the claims is compound A.”

ISPE Guidelines, Example 15



Products and Processes- 111

Does the process of making or the process of using require the product *as claimed*?

Tip: does the process claim depend from or otherwise require all the limitations of the product claim?

If yes, then distinction is possible only if the examiner can provide a materially different way to make or to use the product.

MPEP 806.05(f) and (h)



Product & Process Reconsideration - 111

“The burden is on the examiner to provide an example, but the example need not be documented.

If the applicant either proves or provides a convincing argument that the alternative use suggested by the examiner cannot be accomplished, the burden is on the examiner to support a viable alternative use or withdraw the requirement.”

MPEP 806.05(h)



Products and Processes- 371

Does the process of making or the process of using require the product *as claimed*?

Tip: does the process claim depend from or otherwise require all the limitations of the product claim?

If yes, then lack of unity is possible only if the examiner can provide prior art that anticipates or renders obvious the product, *as claimed*.

PCT Rule 13.2 and ISPE Guidelines Example 1.



Products and Processes- 371

“Claim 1: A method of manufacturing chemical substance X.

Claim 2: Substance X.

Claim 3: The (method of) use of substance X as an insecticide.

Unity exists between claims 1, 2 and 3. The special technical feature common to all the claims is substance X.

However, if substance X is known in the art, unity would be lacking because there would not be a special technical feature common to all the claims.”

ISPE Guidelines, Example 1.



Rejoinder Practice Applies to 371s

“If an examiner (1) determines that the claims lack unity of invention and (2) requires election of a single invention, when all of the claims drawn to the elected invention are allowable (i.e., meet the requirements of 35 U.S.C. 101, 102, 103 and 112), the nonelected invention(s) should be considered for rejoinder.

Any nonelected product claim that requires all the limitations of an allowable product claim, and any nonelected process claim that requires all the limitations of an allowable process claim, should be rejoined. See MPEP § 821.04. Any nonelected processes of making and/or using an allowable product should be considered for rejoinder.”

MPEP 1893.05(d)



Rejoinder for 371s and 111s

“The propriety of a restriction requirement should be reconsidered when all the claims directed to the elected invention are in condition for allowance, and the nonelected invention(s) should be considered for rejoinder.

Rejoinder involves withdrawal of a restriction requirement between an allowable elected invention and a nonelected invention and examination of the formerly nonelected invention on the merits.”

MPEP 821.04



Restriction is improper after an Office action on merits- 111 & 371

If the subject matter was already examined together on the merits, it would not be a burden on the examiner to continue to examine the subject matter, even if it is directed to independent and distinct inventions.

MPEP 803: Restriction is permitted only when “There would be a serious burden on the examiner if restriction is not required.”



Example of an Improper Restriction After an Office Action- 111 or 371

Claims 1-10, directed to product and Claims 11-20, directed to a process of using the product, were examined together in a first action on the merits and a final action.

No restriction or election of species had been required.

Applicants filed a Request for Continued Examination and added 5 new product claims 21-25 which depended from claim 1.

The same examiner then set forth a restriction requirement between:
Group I, the product, Claims 1-10 and 21-25 and
Group II, process of use, Claims 11-20.

This restriction is generally improper, regardless of whether the restriction was required by the same or different examiner.



Full Faith and Credit Given to a Previous Examiners' Search

“When an examiner is assigned to act on an application which has received one or more actions by some other examiner, full faith and credit should be given to the search and action of the previous examiner unless there is a clear error in the previous action or knowledge of other prior art.

In general the second examiner should not take an entirely new approach to the application or attempt to reorient the point of view of the previous examiner, or make a new search in the mere hope of finding something.”

MPEP § 704.01.



Time to Require Restriction

37 CFR 1.142(a), second sentence, indicates that a restriction requirement

“will normally be made before any action upon the merits; however, it may be made at any time before final action.”

“This means the examiner should make a proper requirement *as early as possible in the prosecution*, in the first action if possible, otherwise, as soon as the need for a proper requirement develops.

Before making a restriction requirement after the first action on the merits, the examiner will consider whether there will be a serious burden if restriction is not required.”

MPEP 811



Election of Species is Permitted for Newly Added Claims- 111 & 371

“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



Example of an Election of Species for Newly Added Claims

Claim 1. A composition comprising Compound X and a pain reliever.

Claim 1 was examined and rejected over prior art teaching a composition of Compound X and Aspirin.

In addition to arguments, Applicants add new Claim 2:

Claim 2. (new) The composition of Claim 1 where the pain reliever is morphine, ibuprofen, or novacain.

The examiner may require applicants to elect one of the newly presented species of pain relievers using Form Paragraph 8.01.

MPEP 808.01



Subsequent presentation of claims for different invention

35 U.S.C. 121. Divisional applications.

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 CFR 1.145. Subsequent presentation of claims for different invention.

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....

Emphasis added



Reasons are Required to Restrict Out Newly Added Claims - 111

Form Paragraph 8.04:

“Newly submitted claim [1] directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: [2]”

Form Paragraph 8.26

“The remaining claims are not readable on the elected invention because [2].”

MPEP 821.03



Reasons include Independence, Distinction and Burden - 111

"I. CRITERIA FOR RESTRICTION BETWEEN PATENTABLY DISTINCT INVENTIONS

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



Reasons are Required to Restrict Out Newly Added Claims - 371

Form Paragraph 18.21:

“Newly submitted claim [1] directed to an invention that lacks unity with the invention originally claimed for the following reasons: [2]”

MPEP 1893.05(d)



Election By Original Presentation Markush Claims- 111 & 371

Election by original presentation “is not applicable where a provisional election of a single species was made in accordance with MPEP § 803.02 and applicant amends the claims such that the elected species is cancelled.”

MPEP 821.03, last paragraph.



Amended Markush Claim

Claim 1 (original) A composition comprising compound A, compound B or compound C.

The examiner required an election of species. The Applicant provisionally elected Compound A. In the first Office action, the examiner applied prior art that anticipated elected Compound A.

In response, applicants amended claim 1 as follows:

Claim 1 (amended) A composition comprising compound A, compound B or compound C.

The examiner then withdrew Claim 1 from consideration as being directed to a non-elected invention.

The resulting petition to withdraw this requirement was granted. Claim 1 must be examined according to MPEP 821.03.



Election By Original Presentation Non-restrictable Claims- 111 & 371

Election by original presentation is not applicable “where applicant presents claims that could not have been restricted from the claims drawn to the other elected invention had they been presented earlier.”

MPEP 821.03, last paragraph.



New claims that cannot be restricted after an Office Action-111 & 371

Product Claims 1-10 were examined together in a first action on the merits.

Applicants added 5 new product claims 11-15 that depended from and further limited claim 1.

The examiner then withdrew claims 11-15 from consideration citing MPEP 821.03.

Had they been originally filed together, dependent claims 11-15 could not have been properly restricted from the independent claims 1-10.

The resulting petition to withdraw this requirement was granted.



Improper Requirements to Remove Non-Elected Alternatives from Markush Claims

“Following election, the Markush-type claim will be examined fully with respect to the elected species and further to the extent necessary to determine patentability.

Should the examiner determine that the elected species is allowable, the examination of the Markush-type claim will be extended.”

MPEP 803.02



Improper Requirements to Cancel Linked Claims

“Where the requirement for restriction in an application is predicated upon the nonallowability of generic or other type of linking claims, applicant is entitled to retain in the application claims to the nonelected invention or inventions.”

MPEP 809



Improper Requirements to Cancel Potentially Rejoinable Claims

“In order to be eligible for rejoinder, a claim to a nonelected invention must depend from or otherwise require all the limitations of an allowable claim...

In order to retain the right to rejoinder, applicant is advised that the claims to the nonelected invention(s) should be amended during prosecution to require the limitations of the elected invention. Failure to do so may result in a loss of the right to rejoinder.”

MPEP 821.04



Applicants may file new claims to non-elected inventions

“An amendment presenting additional claims that depend from or otherwise require all the limitations of an allowable claim will be entered as a matter of right if the amendment is presented prior to final rejection or allowance, whichever is earlier.

Amendments submitted after final rejection are governed by 37 CFR 1.116; amendments submitted after allowance are governed by 37 CFR 1.312.”

MPEP 821.04(a)



Getting Applications Back on Track

When a petition is granted, the decision may also address, among other things, whether

- the previous Office action should be withdrawn as incomplete, if improperly withdrawn claims had not been examined;
- claims filed after final should have been entered, if they were improperly refused entry as being directed to a non-elected invention and/or;
- improperly mailed Notice of Non-Compliant Amendments should be vacated.



NNCA versus NNRA

Notice of Non-Compliant Amendment (NNCA)

- Amendment format requirements of 37 CFR 1.121
- MPEP 714 provide options and leeway
- Sent out on a PTOL-324 form

Notice a Non- Responsive Amendment (NNRA)

- For otherwise Bona fide response under 37 CFR 1.135(c)
- MPEP 714.03 provides options and leeway
- Sent out on a PTOL-90 form



Getting Applications Back on Track

If there have been extensive delays in prosecution, in order to help ensure compact prosecution, the Supervisory Patent Examiner may be required to review next Office action:

“The supervisory patent examiners are expected to personally check on the pendency of every application which is up for the third or subsequent Office action with a view to finally concluding its prosecution.”

MPEP 707.02

Questions?



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