



IV - SUITER SWANTZ PC LLO
14301 FNB PARKWAY , SUITE 220
OMAHA NE 68154

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DEC 20 2011

OFFICE OF PETITIONS

In re Application of :
Bran Ferren et al. :
Application No. 11/217,111 : **ON PETITION**
Filed: August 31, 2005 :
Attorney Docket No. 0504-004-002L-CIP001 :

This is a decision on the PETITION PURSUANT TO 37 CFR 1.182 REQUESTING REVIEW OF TC 3700 DIRECTOR'S DECISION ON PETITION UNDER 37 CFR 1.181, filed January 19, 2011, requesting that the Director exercise his supervisory authority to review and overturn the decision of the Director, Technology Center 3700 (Technology Center Director), dated November 19, 2010, which denied the petition filed October 13, 2010.

The petition under 37 CFR 1.181, to overturn the decision of the Technology Center Director dated November 19, 2010 is **DENIED**¹.

BACKGROUND

A first requirement for restriction was mailed April 3, 2009.

A response to the restriction requirement was filed on May 8, 2009.

A second, revised requirement for restriction was mailed September 8, 2009.

A response to the revised restriction requirement was filed November 9, 2009.

A petition from the restriction requirement to the Technology Center Director was filed April 29, 2010.

A petition decision by the Technology Center Director, dismissing the April 29, 2010 petition was mailed August 13, 2010.

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

A renewed petition was filed October 13, 2010.

A petition decision by the Technology Center Director, denial of the renewed petition was mailed November 19, 2010.

The instant petition to the Director was filed January 19, 2011.

STATUTE, REGULATION, AND EXAMINING PROCEDURE

37 CFR 1.181 states in part:

- (a) Petition may be taken to the Director:
 - (1) From any action or requirement of any examiner in the ex parte prosecution of an application, or in ex parte or inter partes prosecution of a reexamination proceeding which is not subject to appeal to the Board of Patent Appeals and Interferences or to the court;
 - (2) In cases in which a statute or the rules specify that the matter is to be determined directly by or reviewed by the Director; and
 - (3) To invoke the supervisory authority of the Director in appropriate circumstances. For petitions involving action of the Board of Patent Appeals and Interferences, see § 41.3 of this title.

35 USC 121 states:

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. If the other invention is made the subject of a divisional application which complies with the requirements of section 120 of this title 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. If a divisional application is directed solely to subject matter described and claimed in the original application as filed, the Director may dispense with signing and execution by the inventor. The validity of a patent shall not be questioned for failure of the Director to require the application to be restricted to one invention.

OPINION

Petitioner's request for review of the Technology Center Director's decision of November 19, 2010 has been considered. It is emphasized that this is a review of the Technology Center Director's petition decision, as petitioned, not a review of the examiner's restriction requirement.

Petitioners raise two questions with respect to the Technology Center Director's decision on page 2 of the petition and espoused upon those questions for the remainder of the petition. The questions are (1) Does the PTO have legal authority to restrict an applicant's claims based solely on disclosed figures, without providing any reference to it's claims and (2) when the PTO fails to identify claims that are to be restricted, does the PTO have legal authority to force an applicant to state what specific embodiments it's claims cover and do not cover. In this regard, the Technology Center Director's decision has been reviewed and no error is found in the decision.

To clarify the record, petitioner's questions are addressed below. In answer to both questions, the USPTO has the legal authority to require applicants elect an invention without resort to applicants' claims. 35 USC § 121 gives the USPTO the authority to "require" the application to be restricted to one of the inventions. (underlining added) Hence an applicant will be required to elect an invention for prosecution in accordance with 35 USC § 121. The examiner may refer to the portions of the written specification or the drawings or both, as being indicative of the species but not to the claims. As provided for in 35 USC 112, 2nd paragraph, it is the province of the applicant to set forth what the claimed invention is, and in particular,

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention. (underlining added)

Thus, it is not the examiner that gets to choose the claims that are directed to the applicants' invention but, as required by the statute, it is applicant that must choose. See In re Weber, 198 USPQ 328, 331 (CCPA 1978)

[2] An applicant is given, by the statute, the right to claim his invention with the limitations he regards as necessary to circumscribe that invention, with the proviso that the application comply with the requirements of §112. We have decided in the past that §112, second paragraph, which says in part "[t]he specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention," allows the inventor to claim the invention as he contemplates it. In re Wolfrum, 486 F.2d 588, 179 USPQ 620 (CCPA 1973).

[3] As a general proposition, an applicant has a right to have each claim examined on the merits. If an applicant submits a number of claims, it may well be that pursuant to a proper restriction requirement, those claims will be dispersed to a number of applications.

Such action would not affect the right of the applicant eventually to have each of the claims examined in the form he considers to best define his invention.

If the examiner were to specify the claims as suggested by petitioner, it would not be in conformance with the statute.

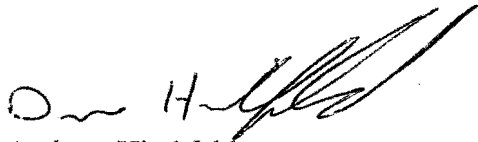
Petitioners' complaints with regard to USPTO procedure set forth in the Manual of Patent Examining Procedure are noted. No change in procedure is warranted at this time.

DECISION

The petition is granted to the extent that the decision of the Technology Center Director of November 19, 2010 has been reviewed; however, the petition is **denied** with respect to making any change or otherwise disturbing the Technology Center Director's decision of November 19, 2010.

The application is being returned to Technology Center Art Unit 3769 for consideration by the examiner in due course.

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



Andrew Hirshfeld
Associate Commissioner for
Patent Examination Policy

ak/cf