

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

Paper No. 24

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* BENOIT HEINRICHS,  
JEAN-PAUL PIRARD and RENE PIRARD

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Appeal No. 1997-3351  
Application 08/490,573

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HEARD: February 13, 2001

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Before KIMLIN, PAK and WARREN, *Administrative Patent Judges*.

WARREN, *Administrative Patent Judge*.

*Decision on Appeal and Opinion*

This is an appeal under 35 U.S.C. ' 134 from the decision of the examiner finally rejecting claim 11, the sole claim in the application.

The threshold issue in this appeal is the whether the examiner's rejection of claim 11 under the judicially created doctrine of obviousness type double patenting over United States Patent 5,538,931 (answer, page 2) is proper in view of the manner in which the invention encompassed by this claim was restricted from other claimed inventions under the authority of 35 U.S.C. ' 121 by the examiner in parent application 08/258,627 (Paper No. 6), which matured into said Patent and which is the parent of this divisional application. A copy of the restriction requirement is found in appellants' brief (appendix AB<sup>®</sup>). We agree with appellants that, on this record, the ground of rejection cannot stand.

In pertinent part, ' 121 prohibits the use of A[a] patent issuing on an application with respect to which a requirement for restriction has been made, . . . as a reference . . . against a divisional application . . . filed before the issuance of the patent on the other application.<sup>@</sup> Thus, the prohibition against a double patenting rejection stated in this statutory provision applies where it is clear that the

divisional application was filed in response to a requirement for restriction made pursuant to the authority of ' 121, but not where a divisional application is voluntarily filed by applicant. Indeed, this distinction is found in the examples of A situations where the prohibition of double patenting rejections under 35 U.S.C. ' 121 does not apply@ in the Manual of Patent Examining Procedure (MPEP) ' 804.01 (6th ed., Rev. 2, July 1996). The following situation pertains here:

(C) The restriction requirement was *written in a manner which made it clear to applicant* that the requirement was made subject to the nonallowance of generic or other linking claims and such linking claims are subsequently allowed. Therefore, if a generic or linking claim is subsequently allowed, the restriction requirement should be removed. [*Id.*; emphasis supplied.]

The practice and procedure for determining the presence of linking claims and requiring restriction where such claims are present is set forth in MPEP ' 809 (6th ed., Rev. 2, July 1996). This section provides that A[t]he linking claims must be examined with the invention elected, and should any linking claim be allowed, rejoinder of the divided inventions must be permitted.@ MPEP ' 809.03 (6th ed., Rev. 2, July 1996) provides that where restriction is required between A claims to two or more properly divisible inventions,@ the linking claims must merely be specified, as in Form Paragraph 8.12 (A[c]laim . . . link(s) . . . invention . . . and . . . .@), and directs applicants to MPEP ' 818.03(d) A[f]or traverse of rejection of linking claims.@ MPEP ' 818.03(d) (6th ed., Rev. 2, July 1996) provides that A[a] traverse of the non-allowance of the linking claim is not a traverse of the requirement to restrict@ and notes that A[i]f the Office allows such a claim, it is bound to withdraw the requirement and to act on all linked inventions@ (6th ed., Rev. 2, July 1996; see also 7th ed., Rev. 1, Feb. 2000).

We find no practice and procedure outlined in the MPEP (6th ed., Rev. 2, July 1996) at the time the briefs and answers in this appeal were prepared, which instructs the examiner to write the restriction requirement A in a manner which made it clear to applicant that the requirement was made subject to the nonallowance of generic or other linking claims and such linking claims are subsequently allowed.@ However, the Form Paragraph 8.12 appearing in the subsequent revision of MPEP ' 809.03 (7th ed., Rev. 2, July 1997) was substantially augmented to provide clear notice to applicants that the restriction requirement between

the linked inventions is **subject** to the nonallowance of the linking claim(s) . . . . Upon the allowance of the linking claim(s), the restriction requirement as to the linked inventions **shall** be withdrawn and any claim(s) depending from or otherwise including all the limitations of the allowable linking claim(s) will be entitled to examination in the instant application. Applicant(s) are advised that if any such claim(s) depending from or including all the limitations of the allowable linking claim(s) is/are presented in a continuation or divisional application, the claims of the continuation or divisional application may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application. Where a restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable.

The requirement for restriction pursuant to 35 U.S.C. ' 121 made by the examiner in parent

application 08/258,627 (Paper No. 6, page 2; emphasis supplied) contained the following statement:  
Claim 9 is *linking* among the inventions of Groups I, II, III and IV, and will be examined along with the invention of Group I, II, III or IV, whichever is elected.

Present claim 11 was the invention of **A**Group II<sup>@</sup> as was not elected. No other reference to claim 9 appears in the requirement for restriction, which claim was subsequently allowed.

We must agree with appellants that this statement is plainly interpreted as specifying that claim 9 would be examined *only* with whichever *one* of the four identified inventions is elected for examination. Thus, we find that appellants *involuntarily* filed the present divisional application in order to obtain examination of an invention non-elected pursuant to this requirement for restriction made under 35 U.S.C. ' 121, with the reasonable expectation that the now claimed invention would not be rejected on the grounds of double patenting over the patent issuing on the parent application as prohibited by ' 121. Indeed, the requirement for restriction as written does *not* advise appellants that the same was made subject to the nonallowance of linking claim 9 such that upon the allowance of this claim, the restriction requirement would be removed. Therefore, the facts of this case do not fit situation (C) of MPEP ' 804.01 (6th ed., Rev. 2, July 1996). *Cf.* Form Paragraph 8.12 in MPEP ' 809.03 (7th ed., Rev. 2, July 1997).

We are not persuaded otherwise by the examiner's argument that **A**subparagraph (C) of M.P.E.P. 804.01 operates to permit the double patenting rejection in the instant case, since applicant [sic, applicants] had constructive knowledge of the contents of M.P.E.P. 809.03<sup>@</sup> (supplemental answer, pages 1-2). Even if appellants did review MPEP ' 809.03 (6th ed., Rev. 2, July 1996), they would *not* have found therein any notice of the effect of the allowance of a linking claim, and if they had continued on to MPEP ' 818.03(d) (6th ed., Rev. 2, July 1996) as well as MPEP ' 809 (6th ed., Rev. 2, July 1996), there is no indication in either section that the examiner's requirement for restriction relying on 35 U.S.C. ' 121 made in parent application 08/258,627 (Paper No. 6, page 2) implicitly included the notice that the examiner now alleges to have been clearly intended.<sup>1</sup>

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<sup>1</sup> The practice and procedure set forth in MPEP ' 804.04 (6th ed., Rev. 2, July 1996) provides that **A**every action containing a rejection on the ground of double patenting of a divisional . . . application (where the divisional application was filed because of a requirement to restrict by the examiner under 35 U.S.C. 121 . . . ) must be submitted to the Group Director for approval prior to mailing.<sup>@</sup> We find no indication in the record that the Group Director approved of the examiner's ground of rejection in this application.

The examiner's decision is reversed.

*Reversed*

EDWARD C. KIMLIN  
Administrative Patent Judge

CHUNG K. PAK  
Administrative Patent Judge

CHARLES F. WARREN  
Administrative Patent Judge

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