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PLM
Paper Number 18

In re Application of:
Leslie I. Gold, et al.
Serial No. 08/283,857
Filed: August 1, 1994
For: FIBRIN-BINDING PEPTIDES, DNA CODING THEREFOR AND USES THEREOF

DECISION ON PETITION

This is a decision on the petition under 37 CFR 1.181 and 37 CFR 1.144, filed November 4, 1996, to withdraw the restriction requirement with respect to Groups I/II and VI. Note, petitions from restriction requirements are properly considered under 37 CFR 1.144. Therefore, the petition is being treated as a petition under 37 CFR 1.144.

On April 7, 1995, an Office action was mailed that required restriction between claims 1-9 and 13 (Group I), claims 10-12 (Group II), claims 14-15 (Group III), claim 16 (Group IV), claim 17 (Group V), claim 18 (Group VI), and claims 19 and 20 (Group VII). With an election of Group II, applicant was further required to elect one of two patentably distinct species of the invention. In response to the Office action, applicants timely filed a response on August 7, 1995 in which applicants canceled claims 14-17 drawn to Groups III, IV and V, elected Group I, claims 1-9 and 13, and traversed the restriction requirement insofar as the claims of Groups II, VI and VII were deemed to be independent and distinct from the elected invention. On November 28, 1995, an Office action was mailed which withdrew the requirement for restriction between Groups I and II and maintained and reaffirmed the restriction between Groups I/II and Groups VI and VII. In applicants' response filed May 28, 1996, a request for reconsideration of the requirement for restriction with respect to Groups VI and VII was made. On September 4, 1996, a final Office action was mailed which reaffirmed the requirement for restriction. The present petition was filed on November 4, 1996 requesting that the restriction requirement between Groups I and VI be withdrawn as least to the extent of considering claim 5 to be a linking claim so that claim 18 will be considered at the time that claim 5 is allowable.

Petitioner asserts that applicants have conceded that if the protein of claim 5 (from Group I/II) is anticipated or obvious then the antibody of claim 18 (Group VI) would also be obvious as it would be obvious to make an antibody to any known peptide. Thus, petitioner contends that if a patent issues containing a claim drawn to the protein of claim 5, and a divisional application is filed resulting in the issuance of a claim of the scope of claim 18, two patents will have issued drawn to inventions which are not patentably distinct. Absent 35 U.S.C. 121, a double-patenting rejection would have to be made on the antibody claim because it is admittedly obvious from the protein. Thus, petitioner concludes that the restriction requirement between Groups I/II and VI should be withdrawn.

As argued by petitioner, MPEP § 803 is appropriate here where it states:

> If there is an express admission that the claimed inventions are obvious over each other within the meaning of 35 U.S.C. 103, restriction should not be required, *In re Lee*, 199 USPQ 108 (Deputy Asst. Comm'r. For Pats 1978).

The decision in *In re Lee* was based not only on the presence of an admission that the claimed inventions are obvious over each other within the meaning of 35 U.S.C. 103 but also on the fact that the issue of "patentable distinctness" between the two groups was close and the Office policy:

> [T]hat it is important from the standpoint of public interest that no restriction requirements be made which might result in the issuance of two patents for the same invention. The nullification of double patenting as a ground of rejection provided for in the third sentence of 35 U.S.C. 121 imposes a heavy burden on the Office to guard against erroneous requirements for restriction where the claims define essentially the same invention and which if acquiesced in, might result in more than one patent for essentially the same invention with attendant prolongation of patent monopoly.

Here, the Office policy is the same as when *In re Lee* was decided and like in *In re Lee,* the "patentable distinctness" issue between the peptide of Group I/II and the antibody of Group VI is close. Lastly, while the admission in this case does not explicitly state that the antibody is obvious over the peptide "within the meaning of 35 U.S.C. 103", the admission certainly implies this and that is how the admission is hereby interpreted. Therefore, like in *In re Lee,* it is concluded that the public interest is better served by withdrawing the restriction requirement and permitting both inventions to be prosecuted in the same application. At this point it is noted that the fact that there is an admission that the antibody is obvious in view of the peptide but not an admission that the peptide is obvious over the antibody would not change this decision because the Office policy that "no restriction requirements be made which might result in the issuance of two patents for the same invention" would still control.

In conclusion, the petition is granted and the examiner is directed to withdraw the requirement for restriction between Groups I/II and VI. Group VII remains restricted from Groups I/II/VI. The application is being returned to the examiner for appropriate action in a timely manner.

PETITION GRANTED.

Mary C. Lee, Deputy Director
Patent Examining Group 1800

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