

## **OVERCOMING LATE RESTRICTION REQUIREMENTS**

Historically, it was conventional wisdom that petitioning to overcome a restriction requirement was not worthwhile, as they were seldom granted. The only showing that needed to be made was that the restriction was necessary to avoid a "serious burden" on the examiner. Petitions were typically denied as that standard was seen as easy to meet. Recently, however, we filed petitions in three applications to overcome restriction requirements issued on previously examined claims. We saw success in each of these petitions.

MPEP §808.02 states that "[w]here 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." The examiner can establish a "serious burden" by a showing in one of the following areas: 1) Separate classification thereof, 2) A separate

status in the art when they are classifiable together, or 3) A different field of search. MPEP §808.02.

Additionally, MPEP §803 states that "[i]f the search and examination of \*\*>all the claims in an< application can be made without serious burden, the examiner must examine \*>them< on the merits, even though \*\*>they include< claims to independent or distinct inventions."

Our recent petition decisions demonstrate that the examiner's ability to establish a "serious burden" after at least one examination on the merits was undermined by the examiner's previous searching and examination of those claims. This reasoning held true even when amendments were introduced into the claims, provided the amendments themselves did not introduce a new invention.

Although petitioning a late restriction requirement may not be appropriate in every case, a petition should be considered if the petition issues after an examination of those claims.

## **PROVING INVENTORSHIP IN COURT**

A recent ruling in [\*University of Pittsburgh\*](#) illustrates the potential importance of documenting inventorship.

University of Pittsburgh researchers Katz and Llull began studying the isolation, culturing and transformation of liposuctioned adipose (fat) cells in 1996, and by 1997 explored the idea that these cells could transdifferentiate into other cells such as bone, cartilage and muscle. In July 1997, UCLA's Hedrick joined Katz and Llull for a one year fellowship. Hedrick assisted Katz and Llull in their ongoing research before returning to UCLA with Benhaim, Lorenz, and Zhu.

The University of Pittsburgh then filed an international application listing Katz, Llull, Futrell, Hedrick, Benhaim, Lorenz, and Zhu as inventors. The application issued and the University of Pittsburgh later filed an action in the district court seeking to remove Futrell, Hedrick, Benhaim, Lorenz and Zhu as inventors.

The Federal Circuit affirmed the district court's determination that Katz and Llull had conceived of the invention before Hedrick's arrival at Pittsburgh, and that Katz's laboratory notebook would have enabled a scientist of skill in the field to isolate and differentiate his adipose-

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derived cells into the lineages claimed in the '231 patent.

In the decision, the Federal Circuit reiterated that conception is “the formation in the mind of the inventor, of a definite and permanent idea of the complete and operative invention . . .” and that “[t]he test for conception is whether the inventor had an idea that was definite and permanent enough that one skilled in the art could understand the invention; the inventor must prove his conception by corroborating evidence, preferably by showing contemporaneous disclosures.”

The district court had relied on recordings by Katz and Llull that their cells could transdifferentiate into multiple lineages including bone, cartilage, muscle and nerve in lab notebooks, letters, a January 1997 invention disclosure, and a February 1997 article titled “What’s So Great About Fat?,” all before Hedrick’s arrival in July 1997. The district court also relied on a proposal that, while published after Hedrick’s arrival, did not mention Hedrick. While not scientifically certain that they were observing a nerve cell, Katz and Llull did have the

firm and definite idea that nerve cells were present, and ordered further confirming tests.

The excluded researchers did not attack these factual findings, but rather argued that Katz and Llull's research was inconclusive until Hedrick and the other researchers added their efforts. They argued that other evidence showed that Katz and Llull's work remained "highly speculative" through the end of Hedrick's fellowship, and the additional work helped achieve scientific certainty. The district court found that Katz's laboratory notebooks sufficiently described to those skilled in the art how to isolate the cells from adipose-tissue, at which point they would be in possession of the invention. Thus, they had disclosed a "completed thought expressed in such clear terms as to enable those skilled in the art to make the invention."

At all stages of an invention, there can be disagreements over inventorship. This case serves as a reminder of the importance of properly documenting and establishing inventorship, whether it be for inventor awards, removal or addition of inventors, or future litigation.

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