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Examiner : Inge, Joseph N.
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Honorable Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

RESPONSE TO RESTRICTION REQUIREMENT

Sir:

On 10/26/2022 the Examiner issued an Office communication with a restriction requirement, at section 2 starting on page 2. The Examiner requires that the claims be restricted to one of 9 inventions, as required under 35 U.S.C. 121. Each of the 9 inventions is grouped as one independent claim and the corresponding dependent claims (pages 2-3). At section 3 the 9 inventions are asserted to be independent or distinct, referencing MPEP § 806.05(j), at sections 3-39 (pages 3-18). It is respectfully noted that this is a misstatement, the inventions must be independent and distinct for a proper restriction requirement. Additionally, Applicant submits that the Examiner's restriction requirement is incomplete and is missing several required sections in which the Examiner is required to explain the reasoning behind the Examiner's requirement. The missing sections are discussed further below. Without these explanations Applicant is unable to fully understand the Examiner's perceived need for restriction. Applicant respectfully disagrees that the instant claimed inventions identified by the Examiner are independent

or distinct, traverses the restriction and specifically points to what Applicant believes are errors and omissions in the restriction requirement as set forth in more detail in the response below.

RESPONSE

In presenting this response Applicant points to the specification (including drawings) and claim elements and features, including, but not limited to, elements and features of the claims by which the claimed inventions are related. Because some of those use somewhat different language in the different claims, Applicant uses generalized language to draw attention to elements and features which, for example, are common to and/or related in the claims.

As just one of many examples, in claim 1 the wording “A.C. power having a controlled, known frequency” is used and in claim 23 the wording “control the frequency of the output A.C. power” is used. Each claim further recites details about the control. The claim language is somewhat different, however the frequency of the AC power is controlled in both claims such that it conveys information. The generalized language such as for example “A.C. power which has a frequency conveying information” is used in portions of Applicant’s response below without going into the specific detail of the wording, claiming the particulars of the control of the frequency, whether it be the frequency of A.C. power or output A.C. power. The point being made is in regard to frequency, not the particular A.C. power which has that frequency parameter. Applicant’s general language pointing to these features is intended solely to aid in understanding Applicant’s argument.

In using this generalized language Applicant does not, and does not intend to, make or provide any sort of disavowal, limitation or broadening of scope, definition, explanation of terms, claim construction, or the like. In respect to the instant examination of the application, the specification including the drawings as well as the claims are to be interpreted and examined as set out in the MPEP, including MPEP § 2111.

As set out in more detail below in respect to MPEP Chapter 800, including 802.01, restriction is only proper if the inventions are independent and distinct. Additionally, in respect to distinctness as set out at MPEP § 806.05(j) pointed to by the

Examiner, “The burden is on the examiner to provide an example to support the determination that the inventions are distinct. ... If Applicant either proves or provides convincing evidence that the example suggested by the examiner is not workable, the burden is on the examiner to suggest another viable example or withdraw the restriction requirement.” Underlining added. If the Examiner’s reference to Applicant’s specification paragraphs It is further noted that this example pertains to support “that the inventions are distinct” and again, restriction is only proper if the inventions are both independent and distinct.

It is further respectfully submitted that the Examiner has failed to provide a complete and proper restriction requirement. The Examiner merely reproduces the suggested wording of MPEP § 806.05(j) which paraphrases the 37 C.F.R. 1.142 requirement for restriction and only speaks to distinctness (i.e. “The related inventions are distinct if: ...”). The Examiner follows with a conclusory statement “In the instant case, the inventions as claimed have a materially different design, mode of operation, function, and effect.” The Examiner does not explain any of what, why, where and/or how each of the materially different design, and mode of operation and function and effect pointed to by the Examiner are present in the claims. If any are missing, the condition to support restriction is not met.

It is quickly noted here that several of the claimed inventions are easily seen as related. In just one of many examples, claims 1-4 which claim “a power source which provides output A.C. power having a controlled, known frequency” can be combined with the load coupler of claims 5-10 such that the “output A.C. power” of claims 1-4 is the “line connected A.C. power” of claims 5-10. The result is the load coupler of claims 5-10 may relieve an overload of the power source of claims 1-4. Many other such combinations of claimed inventions are readily apparent to the person of ordinary skill.

Stated another way, the Examiner does not explain how the Examiner believes the claimed inventions (1) are either not capable of use together or can have a materially different design, mode of operation, function, or effect; and (2) do not overlap in scope, i.e., are mutually exclusive; and (3) the inventions as claimed are not obvious variants as required for restriction of any pairs (or more) of the claims. Applicant believes that at a

minimum, the Examiner should be able to explain how the above described combination of claims 1-4 used with claims 5-10 is faulty or otherwise will not work.

Applicant respectfully submits that the Examiner has not met the “burden [which] is on the examiner to provide an example to support the determination that the inventions are distinct, ...” for any pairs of the 9 independent inventions the Examiner asserts are present with only mere conclusory statements. Applicant must guess as to how the Examiner believes the inventions are independent and distinct in order to attempt to prove or provide convincing evidence that the restriction should not be required.

In the event the restriction requirement is maintained for any claims, Applicant respectfully requests, as set out in MPEP § 707.07(f), that the example(s) required by MPEP § 806.05(j) be provided for each of the pairs (or more) of 9 asserted inventions which the Examiner believes are independent and distinct.

Additionally, at section 41 on page 20 of the Office communication the Examiner also asserts a corresponding Figure for each of 9 patentably distinct species stating “The species are independent or distinct because the claims to different species recite the mutually exclusive characteristics of such species (see, for example, paragraphs 0037-0051, etc. of the Applicant's specification which disclose the differences between the respective species).” However, the Examiner does not say what these mutually exclusive characteristics are. This section 41 appears to assume that each of the claims is written to cover only one Figure. Further, paragraphs 0037-0051, etc. do not recite the supposed different species, rather they merely briefly describe the Figures, their relationships and the elements thereof. As just one of many examples of the failure of this supposed support, paragraph 0037 points to Fig. 4 which includes load control 25a. Paragraph 0038 points to Fig. 5 which “shows a circuit diagram of load control 25a ...” How can these two paragraphs be said to support the Examiner's position that Figures 4 and 5 are independent or distinct species, let alone mutually exclusive characteristics thereof when load control 25a is present in both Figures, with Figure 5 simply being a detailed circuit diagram of load control 25a shown in Figure 4? And, it is again pointed out that MPEP 806.05(j) states “The burden is on the examiner to provide an example to support the determination that the inventions are distinct ...” Simply referring to paragraphs 0037-0051, etc. falls far short of fulfilling that burden. Clarification is respectfully requested in

that many different elements of many claims are shown in multiple Figures, or not explicitly shown or numbered but are present in one or more Figure.

Restriction is discussed in Chapter 800 of the MPEP. 35 U.S.C. 121 states that the Director may require restriction if two or more "independent and distinct" inventions are claimed in one application. MPEP § 802.01, underlining added.

At MPEP § 802.01 I. INDEPENDENT:

The term "independent" (i.e., unrelated) means that there is no disclosed relationship between the two or more inventions claimed, that is, they are unconnected in design, operation, and effect.

Here, if there is a disclosed relationship between the claimed inventions they are not independent. The two inventions must be unconnected in all three of design, operation and effect to be considered independent (i.e. unrelated). How can the above pointed to relationship between Figures 4 and 5, Fig. 4 showing 25a and Fig. 5 showing a circuit diagram of 25a, support the assertion that these are independent and distinct species, each with related claims for which restriction can be properly required? Clarification is respectfully requested.

At MPEP § 802.01 II. RELATED BUT DISTINCT:

Two or more inventions are related (i.e., not independent) if they are disclosed as connected in at least one of design (e.g., structure or method of manufacture), operation (e.g., function or method of use), or effect. Examples of related inventions include combination and part (subcombination) thereof, process and apparatus for its practice, process and product made, etc. In this definition the term related is used as an alternative for dependent in referring to inventions other than independent inventions.

Here any one of the connections between two or more (claimed) inventions, those connections being at least one of design, operation, or effect, will mean that the inventions are related (i.e. not independent). Applicant mentions here just one example of many, that all of the 71 instant claims are related by the wording AC power (and similar wording) and the use of its frequency to convey information. Every single one of the instant claims use frequency of the AC power wording in conjunction with conveying loading (or overloading) information.

This use of frequency to convey loading information may be demonstrated by contrast with prior art AC power which is maintained at a standard frequency (e.g. such as 60 Hz in North America). There is no loading information being conveyed by the frequency. As a simple example consider a service entrance circuit breaker in a lower 48 states utility grid powered house. The frequency of the A. C. power remains the same standard 60 Hz and is not affected by or responsive to the load connections in the house. This loading may increase until it creates an overload and the circuit breaker trips. The AC power frequency remains the same throughout the overload. In Applicant's claimed invention the AC power frequency conveys information which may be used to prevent or relieve an overload.

Various ones of the instant claims recite an apparatus for causing the AC power frequency to convey loading information and/or apparatus responsive to the AC power frequency to prevent and/or relieve an overload. Applicant respectfully submits that the instant claims in fact explicitly recite related inventions and thus the restriction requirement is improper.

It is also noted that the above MPEP § 802.01 I & II definitions do not make any mention or suggestion that all of the claims must be related in the same exact manner. As just some of many examples, one claim or set, of related claims might specify the structure and arrangement of elements which cause AC frequency to convey loading or other information related to an overload. One claim or set of related claims, might specify the structure and arrangement of elements which is responsive to AC frequency which conveys loading information to prevents an overload. Another claim or set, of related claims might specify the structure and arrangement of elements, which is responsive to AC frequency to alleviate an overload. One claim or set of related claims may specify the structure and arrangement of elements which incorporate one or more of causing AC frequency to convey information, prevent overload and/or alleviate overload.

Applicant next points to section 41 of the Office communication at the bottom of page 20. The Examiner states that each of the independent claims is generic. Applicant questions here if the Examiner is merely pointing out independent and dependent claims where each dependent claim contains all of the elements of the independent claim(s) from which it depends. In any event, the presence of a generic claim is only one of 4 general

principals set forth in MPEP 806 Determination of Distinctness or Independence of Claimed Inventions [R-08.2012]:

The general principles relating to distinctness or independence may be summarized as follows:

- (A) Where inventions are independent (i.e., no disclosed relation therebetween), restriction to one thereof is ordinarily proper, MPEP § 806.06.
- (B) Where inventions are related as disclosed but are distinct as claimed, restriction may be proper.
- (C) Where inventions are related as disclosed but are not distinct as claimed, restriction is never proper.
- (D) A reasonable number of species may be claimed when there is an allowable claim generic thereto. 37 CFR 1.141, MPEP § 806.04.

Principles (A), (B) and (C) make no mention of a generic claim. In the instant claims of the application principal (C) applies, the inventions are related as disclosed and are not distinct as claimed. Restriction is never proper.

Asserting that there are patentably distinct species, in the Office communication section 41 at the bottom of page 20 the Examiner points to “distinct species” to which claims are directed and to a corresponding Figure. As set out above, Applicant disagrees and further points out that none of the claims is written to verbally recite all of what is shown in only one Figure, or to only recite elements which are all present in that figure. Many claims include elements from a plurality of Figures and elements which are present but not explicitly shown or numbered in any Figure (as one example, parameters which are stored in load control 25). Perhaps the claimed AC power frequency which is present but not explicitly labeled or shown in the Figures in the claims has been overlooked by the Examiner. There is however a frequency measurement 90 in Figure 18.

In any event, the Examiner goes on to state “The species are independent or distinct because the claims to different species recite the mutually exclusive characteristics of such species (see, for example, paragraphs 0037-0051, etc. of the Applicant's specification which disclose the differences between the respective species).” Applicant respectfully submits that this statement, which is based on the above assertion of unrelated inventions, and seems to imply that the claims are directed to individual Figures, is misstated and merely conclusory.

MPEP 808.01 Reasons for Holding of Independence or Distinctness states
(underlining added):

The particular reasons relied on by the examiner for holding that the inventions as claimed are either independent or distinct should be concisely stated. A mere statement of conclusion is inadequate. The reasons upon which the conclusion is based should be given.

For example, relative to a combination and a subcombination thereof, the examiner should point out the reasons why he or she considers the subcombination to have utility by itself or in other combinations, and why he or she considers that the combination as claimed does not require the particulars of the subcombination as claimed.

Each relationship of claimed inventions should be similarly treated and the reasons for the conclusions of distinctness or independence set forth. Form paragraphs 8.01, 8.02, and 8.14 - 8.20.02 may be used as appropriate to explain why the inventions as claimed are independent or distinct. See MPEP § 806.05 - § 806.06.

MPEP 808.01(a) recites in part (underlining added):

Where there is a relationship disclosed between species, such disclosed relation must be discussed and reasons advanced leading to the conclusion that the disclosed relation does not prevent restriction, in order to establish the propriety of restriction.

Applicant respectfully submits that the Examiner has failed to provide the particular reasons and discussions, the reasons advanced leading to the conclusions for each of the plurality (or more) of claims (or species) such as those in sections 2-39 of the Office communication.

As another example, MPEP 806.05(d) states in part (underlining added): “Two or more claimed subcombinations, disclosed as usable together in a single combination, and which can be shown to be separately usable, are usually restrictable when the subcombinations do not overlap in scope and are not obvious variants.” As set forth above the combination of claims 1-4 with claims 5-10 overlap in scope, that is, they have

the same AC power having variable frequency which conveys loading information, and is required by both sets of claims.

It is pointed out that for each pair of the Examiner's identified inventions I through IX discussed in Office communication sections 4-39 the Examiner recognizes that one of the considerations for restriction is "(2) the inventions do not overlap in scope, i.e., are mutually exclusive;" and points to MPEP § 806.05(j). The Examiner makes the conclusory statements "In the instant case, the inventions as claimed have a materially different design, mode of operation, function, and effect. Furthermore, the inventions as claimed do not encompass overlapping subject matter and there is nothing of record to show them to be obvious variants."

Applicant respectfully submits that for each of these sections 4-39 the Examiner has failed to consider and provide "The particular reasons relied on by the Examiner for holding that the inventions as claimed are either independent or distinct should be concisely stated. A mere statement of conclusion is inadequate. The reasons upon which the conclusion is based should be given." Applicant respectfully submits that, rather than providing "the particular reasons relied on by the examiner ..." the Examiner has instead, only given "A mere statement of conclusion [which] is inadequate." as warned against in MPEP 808.01 discussed above.

In the event the restriction requirement is maintained for any claims, Applicant respectfully requests, as set out in MPEP § 707.07(f), the "... examiner must provide clear explanations of all actions taken ..." and "... the examiner should, if he or she repeats the rejection, take note of the applicant's argument and answer the substance of it." Further, Applicant requests the "mere statement[s] of conclusion ..." be withdrawn and the reasons and discussion required by MPEP § 808.01 and 808.01(a) set forth and discussed above be provided for each of the pairs (or more) of 9 asserted inventions which the Examiner believes are independent and distinct and subject to restriction.

At the Office communication section 40 the Examiner points to the restriction being proper and there being a serious search and/or examination burden because of several reasons I – V but does not provide any details. The reasons I – IV appear to be taken from MPEP form paragraph § 8.21 which is part of the MPEP § 817 Outline Of Restriction Requirement, however reason V is not part of that group. In any event,

Applicant points out that at MPEP § 817 (A) the outline includes items (1) – (4). Applicant respectfully points out that items “(3) Give short description of total extent of the subject matter claimed in each group, pointing out critical claims of different scope and identifying whether the claims are directed to a combination, subcombination, process, apparatus, or product.” and “(4) Classify each group” have not been complied with.

In the event the restriction requirement is maintained for any claims, Applicant respectfully requests, as set out in MPEP § 817 (A), that the above “(3) Give short description of total extent of the subject matter claimed in each group, pointing out critical claims of different scope and identifying whether the claims are directed to a combination, subcombination, process, apparatus, or product.” and “(4) Classify each group” be provided for any of those claim groups for which restriction requirement remains and further that some indication or suggestion of the issues pointed to in the Office communication reason V. of section 40 be provided for those claims.

SUMMARY

Applicant respectfully submits that the Election/Restriction Requirements given in the 10/26/2022 Office communication are incomplete in that the communication is missing several required sections (set out above) and thus Applicant does not here have the information needed to properly respond to and traverse the election requirement. Applicant thus should not be required to make an election without having the full amount of required information as to the Examiner’s requirement. However, under protest based on incomplete information provided as set out above, and preserving Applicant’s right to petition and any further action which might be necessary, elect claims 29-44 as required by (37 CFR 1.143).

Respectfully Submitted,

/ J. Carl Cooper/

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