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EXAMINER	
KNAPP, JUSTIN R	

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In re Application of: MATEESCU, et al.	)	
Application No. 13/649,098	)	DECISION ON PETITION FOR
Attorney Docket No. HSJ9-2012-0032-US1	)	SUPERVISORY REVIEW REGARDING
Filed: 10/10/2012	)	FINALITY OF RESTRICTION
For: ENCODING AND DECODING DATA TO ACCOMMODATE MEMORY CELLS HAVING STUCK-AT FAULTS	)	REQUIREMENT UNDER 37 CFR §1.144

This is in response to the petition under 37 CFR §1.144 filed on May 04, 2015, requesting supervisory review of the finality of a restriction requirement mailed in the Non-final Office action on August 28, 2014.

The petition is **GRANTED**.

RELEVANT PROSECUTION HISTORY

(1) A restriction requirement was mailed in the Non-final Office action on August 28, 2014, in which claims 1-21 were subject to restriction requirement. During a telephone conversation with Applicant on July 09, 2014, a provisional election was made with traverse to prosecute the invention of Group I, drawn to claims 1-8 and 14-19. Group II claims 9-13, 20 and 21 were withdrawn.

(2) On November 13, 2014, an amendment and response to the restriction requirement was filed in which Applicant provided reasons in support of the traversal, including a discussion regarding a proper restriction for inventions disclosed as subcombinations usable together in a single combination as well as a request for reconsideration of the requirement.

(3) On March 12, 2015, the Examiner issued a final Office action on the merits, in response to Applicant's amendment, wherein claims 9-13, 20 and 21 were again withdrawn. This office action effectively held the requirement for restriction to be proper and therefore made the Office action final.

(4) On May 04, 2015, the instant petition was filed by Petitioner.

RELIEF REQUESTED

The instant petition under 37 CFR § 1.144 requests the following relief:

(1) withdrawal of the restriction requirement of August 28, 2014; and

(2) as a result of item (1), examination of all pending claims (1-21).

BASIS

Petitioner provides various arguments in support of the withdrawal of the restriction requirement.

Attention is directed to M.P.E.P. § 803 which states in part:

> If 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.

Note, M.P.E.P. § 806.05(a) states:

> Combination and Subcombination**
> ***A combination is an organization of which a subcombination or element is a part.***

M.P.E.P. § 806.05(d), sets forth:

> 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<.
> To support a restriction requirement where applicant separately claims plural subcombinations usable together in a single combination and claims a combination that requires the particulars of at least one of said subcombinations, both two-way distinctness and reasons for insisting on restriction are necessary.

In addition, § MPEP 806.05(j) states:

> To support a requirement for restriction between two or more related product inventions, or between two or more related process inventions, both two-way distinctness and reasons for insisting on restriction are necessary, i.e., separate classification, status in the art, or field of search. See **MPEP § 808.02**. See **MPEP § 806.05(c)** for an explanation of the requirements to establish two-way distinctness as it applies to inventions in a combination/subcombination relationship. For other related product inventions, or related process inventions, the inventions are distinct if
>
> (A) the inventions *as claimed* do not overlap in scope, i.e., are mutually exclusive

Further, M.P.E.P. § 806.03 sets forth:

> Where the claims of an application define the same essential characteristics of a single disclosed embodiment of an invention, restriction therebetween should never be required. This is because the claims are but different definitions of the same disclosed subject matter, varying in breadth or scope of definition.

OPINION

Petitioner states that inventions of: Group I (elected claims 1-8 and 14-19), drawn to "a data storage system and method for encoding data bits"; and Group II (non-elected claims 9-13, 20 and 21), drawn to "a data storage system and method for decoding data bits accessed from memory cells" are not disclosed as subcombinations usable together in a single combination, as stated by the Examiner. In addition, Petitioner argues that although the claims vary in scope from one another and that they also clearly overlap in scope (particularly when considering the dependent claims). As a result, Applicant disagrees with the Examiner's conclusion that the alleged Inventions of Groups I and II have separate utility from each other.

A review of the instant claims reveals that the identified independent claims are in fact set forth in the instant application as *combination-type* claims, rather than *subcombination-type* claims, as stated by the Examiner. For example, note claims 1-8 and 14-19, which recite "A data storage *system* ..." and "A method for a data storage *system* comprising ..." and each of which set forth *a combination of elements and/or steps therein*, are clearly representative of a *combination-type* claims. Further, a review of instant claims within the identified Groups show that the claims contain similar limitations and are of similar specificity, as clearly identified by Petitioner on page 2 of the instant petition, thus they clearly overlap in scope. Note, the "memory circuit", "control circuit", "first matrix" and "second matrix" are common elements of claims 1 and 9 for instance. Therefore, the claims within Groups I and II, as identified by the Examiner, clearly overlap in scope.

CONCLUSION

Therefore, for at least those reasons stated above and in accordance with M.P.E.P. §806.03 and §806.05(a), (d) and (j), the restriction requirement of February 28, 2014 between Groups I and II (claims 11-45), for "subcombinations disclosed as usable together in a single combination" is deemed to be improper.

The petition is **GRANTED**. The restriction requirement mailed August 28, 2014 is hereby **WITHDRAWN** and a new office action on all of the pending claims will be forthcoming.

The application is being forwarded to the Examiner for appropriate action i.e. prosecution of all pending claims, consistent with this decision.

Any inquiries related to this decision may be directed to the undersigned at (571) 272-3595.

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