

## REMARKS/ARGUMENTS

### **I. Statement of Facts**

In the Office Action mailed January 22, 2016, the Examiner set forth a species election requirement that restricted the claims into the following alleged Species:

Species I: A method for presenting alert according to the first embodiment (Fig. 5, Claims 1-6);

Species II: A method for presenting alert according to the second embodiment (Fig. 6, Claims 7-15; and

Species III: A method for presenting alert according to the third embodiment (Fig. 7, Claims 16-20).

Applicant's Response dated March 21, 2016 elected Species II, claims 7-15, but traversed and requested reconsideration of the species election requirement at least because the species election requirement, or alternatively a restriction requirement, was improper.

The Office Action dated June 2, 2016 attempted to justify the alleged need for a species election by stating that "Applicant admits in the specification that 'FIGS. 5-7 illustrate example flow diagrams showing processes 500, 600, and 700 for managing alerts of computing devices.'" *Office Action*, p. 3. Additionally, the Office states that "Embodiments are not 'sub-combinations' ... because they (Fig. 5-7) [sic] are not usable together in a single combination." *Id.* The Office then goes on to state that "Applicant also describes each embodiment separately in a separate paragraph," and that "[s]ince each embodiment requires different [sic] number of steps and not all steps are the same, ... the species are independent or distinct and not obvious variants of each other." *Id.*

Applicant's Response dated March 21, 2016 pointed out flaws in the Office's species election requirement and/or restriction requirement, whichever is more appropriate, and explained why the Office failed to make a *prima facie* showing that restriction or species election are appropriate.

Still, the Office Action dated June 2, 2016 made the species election requirement final. *Id.*

## II. Points To Be Reviewed – The Office Did Not Meet Its Burden

The Office alleged that each independent claim (claims 1, 7, and 16), and their respective dependent claims, comprises its own species. As an initial matter, Applicant submits that this is effectively a restriction requirement, as opposed to a species election requirement. As such, Applicant will address the Office's failure to make a *prima facie* showing that restriction is appropriate. Still, even if, *arguendo*, this were an appropriate species election requirement, Applicant further submits that the species election requirement is improper because the Office has failed to show that there would be a serious burden if the election were not required.

As noted, Applicant respectfully submits that the Office has failed to make a *prima facie* showing that restriction is appropriate. The Office asserts that the claims of Species I-III are "independent or distinct because claims to the different species recite the mutually exclusive characteristics of such species," and that "these species are not obvious variants of each other based on the current record." *Office Action*, p. 3. However, the Office provides no reasoning or analysis regarding these allegations, nor does the Office provide any evidence of mutually exclusive characteristics.

MPEP 806.05 requires that to be restrictable, different sub-combinations must be "**mutually exclusive**" (i.e., non-overlapping in scope) such that "a first invention would not infringe a second invention, and the second invention would not infringe the first invention." To establish the groups are non-overlapping in scope, the Office must demonstrate that the combination does not require the particulars of the sub-combination as claimed for patentability (e.g., to show novelty and non-obviousness). Here, the Office Action fails to contain any analysis showing that the claims are non-overlapping in scope and simply glosses over this requirement. While the Office Action dated June 2, 2016 attempts to provide some rationale for the requirement, the analysis simply indicates that each claim is allegedly directed to a different figure and described in a different paragraph. However, this still fails to meet the requirement of demonstrating that the combinations do not require the particulars of the sub-combinations. Further, on its own admission, the Office has indicated that the characteristics of the claims are "mutually exclusive." Thus, the Office clearly was attempting to make a restriction requirement as opposed to a species election requirement, yet the requirements of MPEP 806.05 were not met with regard to restriction requirements.

Further, the Office Action fails to make the required showing under MPEP 806.05(d) as to why there would be a serious burden if restriction/species election were not required. For example, the MPEP states that “[e]xaminers must provide reasons and/or examples to support conclusions” when making restriction requirements and that a “serious burden on the examiner may be *prima facie* shown by appropriate explanation of separate classification, or separate status in the art, or a different field of search.” MPEP 803. However, the Office’s attempt at showing this point is by merely stating that a serious burden would exist as a conclusion without any reasons or explanation at all. Thus, Applicant submits that merely stating that a burden exists is not sufficient to show a serious burden and that, therefore, the Office has not met its burden of showing that restriction or species election are required.

Additionally, Applicant respectfully submits that, in the course of properly searching claims of Species II, the Office would likely search in substantially the same classes and subclasses, and using the same or similar queries as for at least some claims of Species I or III as evidenced by the independent claim features. Therefore, the Office’s search of the additional claims of the other species would likely require little or no additional searching.

However, even if, *arguendo*, the restriction were proper, Applicant respectfully asserts that at least claim 7 and some of claims 8-15 (Species II) are generic to at least claims 1-6 (Species I). Claim 1 recites, among other things, (i) presenting a first alert via the display device, (ii) storing a matrix of alert rules, and (iii) receiving a second alert. Applicant asserts, for example, that claim 7 is generic to claim 1 because claim 7 recites “a user interface to present electronic content” (e.g., item (i) mentioned above in claim 1), “receiv[ing] a data structure comprising a plurality of rules” (e.g., item (ii) mentioned above in claim 1), and “receiv[ing] information that identifies an incoming alert” (e.g., item (iii) mentioned above in claim 1). To clarify some of the features of generic claim 1, Applicant added new claims 21-23 in the Response to Office Action filed March 21, 2016, which recite that “the user interface is configured to be presented on the display device,” that “the data structure comprises a matrix,” and that “the electronic content comprises a first alert, [while] the incoming alert comprises a second alert.”

Nevertheless, and although Applicant did not (and still does not) agree with the alleged groupings identified by the Office Action dated January 22, 2016 and/or the need for species election requirement or, in the alternative, a restriction requirement, Applicant elected to

prosecute the claims of Species II in the Response to Office Action filed March 21, 2016, in order to advance prosecution.

Additionally, in an attempt to facilitate prosecution of the current application, Applicant has prepared for concurrent filing, a substantive response to the rejections imposed in the June 2, 2016 Office Action, and illustrate therein that none of the examined claims are in fact either anticipated by or obvious over the cited references. A copy of that response is included herewith.

### **III. Action Requested**

Applicant respectfully petitions the Director to review the species/restriction requirement and, for at least the reasons stated above, instruct the Examiner to withdraw the improper requirement. The Examiner should search and examine the entirety of pending claims 1-23. If the Director agrees with Applicant that the species/restriction requirement is improper, Applicant further requests withdrawal of the Office Action dated June 2, 2016, since the Office Action is incomplete for failure to examine the improperly withdrawn claims.

**CONCLUSION**

In view of the foregoing, Applicant believes that the species election/restriction requirement should be reversed.

Except for the issue fees payable under 37 C.F.R. § 1.18, the Director is authorized to charge any additional fees during pendency of this application, including any required extension of time fees, or credit any overpayment to Deposit Account Number 20-1430. This paragraph is intended to be a constructive petition for extension of time in accordance with 37 C.F.R. § 1.136(a)(3).

If the Director or the Examiner believes a telephone conference would expedite prosecution of this application, please contact the undersigned at (206) 224-2856 or [jbennett@kilpatricktownsend.com](mailto:jbennett@kilpatricktownsend.com).

Respectfully submitted,

/Jesse S. Bennett/  
Jesse S. Bennett  
Registration No. 62,647

KILPATRICK TOWNSEND & STOCKTON LLP  
:lkg  
Attachments