

Memorandum



To: PSAS

From: EROgden

Re: Method for Terminal Boar Improvement

Date: 3 October 2008

Introduction

The patent application for Method for Genetic Improvement of Terminal Boars has not yet been examined on its merits. Instead, there are five (5) claims that are currently withdrawn from consideration because they are written improperly. Claims 10, 14, 15, 16, and 17 are written as multiple dependent claims and must be amended in order to be included. A multiple dependent claim refers back to two or more dependent claims. If these claims are not amended, they will not be included in the patent. Each withdrawn claim can be easily amended by breaking them into several different claims.

Restriction and Election Requirement

The rest of the claims are subject to a restriction and election requirement. This means the applicant must choose a single invention to be examined and the rest must be either abandoned or pursued in a separate application. The examiner identifies six (6) distinct groups of claims from which the applicant must choose. Therefore, there is the potential for six (6) separate patent applications to pursue each group. The six groups are as follows:

Group I. Methods for producing terminal swine parents having improved germplasm (claims 1-42)

Group II. Target herd (claims 43-52)

Group III. Swine production herd (claim 53)

Group IV. Genetic nucleus herd (claims 54-61)

Group V. Methods for making rapid change in the frequency of an allele in a target herd while concomitantly maintaining optimal long-term selection pressure for the allele in a genetic nucleus (GN) herd (claims 62-65)

Group VI. Methods of producing swine offspring (claims 66-69)

The examiner separated the application into these groups because the groups do not relate to a single general inventive concept as required, because they lack the same or corresponding special technical features and, thus, have no "unity of invention." Unity of

invention exists when there is a technical relationship between inventions which involve one or more of the same or corresponding special technical feature(s). Special technical features are those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art. If what unites the separate inventions does not make a contribution over the prior art, then there is no unity of invention.

Lack of a Unifying Technical Feature

In this application, the examiner found that the unifying technical feature was “providing at least one genetic nucleus or target herd for which improvement is desired, selecting trait(s) for which improvement is desired, proving semen aliquots from an elite sire, using the semen aliquots to impregnating breeding females in a target herd; producing half-sib offspring with improved germplasm, and providing at least one of the half-sib offspring as the terminal swine parent in a swine production herd, or as a replacement animal for the genetic nucleus herd.” The examiner goes on to say that this feature does not make a contribution over the prior art and, therefore, does not provide any unity of invention.

This alone just says that the applicant must choose which group to pursue with this application. There is not a direct statement regarding the patentability of any particular group, but rather states that the applicant must decide which group should be examined for patentability. Each of them may eventually be rejected or registered separately.

However, the examiner describes the “unifying technical feature” and says it “does not make a contribution over the prior art.” This would mean that it is not patentable. This is interesting because that description of the “unifying technical feature” is nearly identical to Claim 1 of the application. This implies that there will be difficulties with Claim 1 that possibly extends to the many claims that build on Claim 1. Therefore, the future examination of the patent will be interesting to follow.

The applicant’s absolute deadline for response to the Office Action is December 26, 2008.

This document provides general guidance about the titled subject, is not to be regarded as legal advice, and does not create an attorney-client relationship between Murphy Desmond S.C. or Erin R. Ogden and the reader. Because the information herein may become outdated or may not apply to your specific circumstance, it should not be relied upon or used in place of a detailed consultation with a professional advisor. If you would like to know how this could apply to your specific circumstances, please consult a licensed attorney in the correct jurisdiction.