

REMARKS

Claims 1-17 are pending in the application.

Requirement

The Examiner has required restriction under 35 U.S.C. 121 to one of the following inventions:

- I Claims 1-12, drawn to a method of making particles, classified in class 423, Subclass 311.
- II Claims 13-17, drawn to particles and a sintered body made from these particles, classified in class 423, subclass 304.

Election

In order to be responsive to the Invention Restriction Requirement, Applicants elect, with traverse, Invention I, claims 1-12.

Traverse

Notwithstanding the election of Group I, Applicants respectfully traverse the requirement for restriction. The Examiner asserts that Inventions of groups I and II are related as process of making and product made, and that the inventions are distinct under M.P.E.P. §806.05(f) because the product as claimed can be made by another and materially different process (Office Action, page 2).

While the Examiner has alleged the inventions are distinct, Applicants respectfully submit that this alone is not sufficient to support a Restriction Requirement. In particular, Applicants note that the Examiner's restriction fails to identify one of the two criteria for a

proper restriction requirement established by the U.S. Patent and Trademark Office policy. As set forth in MPEP §803, “an appropriate explanation” must be advanced by the Examiner as to the existence of a “serious burden” if restriction were not required. Applicants acknowledge that the Examiner states that there would be a serious burden if restriction were not required because one or more of the reasons (a)-(e) set forth on page 3 of the Office Action would apply. However, for the reasons discussed in further detail below, Applicants respectfully submit that this is insufficient to support a restriction requirement in this case.

First, Applicants submit that the Examiner's assertion of a serious burden is a generic ‘form paragraph’ that fails to set forth an appropriate explanation as to why a serious burden exists *in this particular case*. That is, the Examiner contends that there would be a serious burden “because one or more of the following reasons apply....” Applicants respectfully submit that this general allegation does not explain which of the listed reasons actually applies. Moreover, the allegation fails to explain why or how any of the reasons would apply if restriction were not required in this particular case.

Second, notwithstanding that the Examiner has asserted that the identified inventions would be classified differently, there is no appropriate explanation that the search areas required to examine the invention of Invention I would not *overlap* into the search areas for examining the invention of Invention II, and *vice versa*. Moreover, Applicants respectfully submit a complete and adequate search for the method recited in claims 1-12 cannot avoid the classes directed to the particles in claims 13-17. Thus, whether the Restriction Requirement is maintained or withdrawn, a complete and adequate search for the recited method will require the Examiner to search the relevant classes where both the method (*i.e.*, Invention I) and the product (*i.e.*,


Invention II) would be classified. Thus, the search for the combination of features recited in the above-identified inventions, if not totally co-extensive, would appear to have a very substantial degree of overlap.

Because the search for the inventions is substantially the same, Applicants submit that no undue or serious burden would be presented in concurrently examining Inventions I and II. Thus, for the above-noted reasons, and consistent with the office policy set forth above in MPEP §803, Applicants respectfully request that the Examiner reconsider and withdraw the restriction and species requirement in this application.

For all of the above reasons, the Examiner's restriction is believed to be improper, and Applicants request that the restriction requirement be withdrawn and all pending claims examined on the merits. However, in order to fully comply with the restriction requirement, Applicants have elected, with traverse, the invention defined by Invention I, *i.e.*, claims 1-12, in the event that the Examiner chooses not to reconsider and withdraw the restriction requirement.

If there should be any questions, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,
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