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9.

DIVISION; GENUS AND SPECIES

9-1.

Introduction

A requirement to divide or a requirement to elect a species is an action by the examiner which rules that two or more inventions or species of an invention are claimed in a single application, which invention or species of invention must be presented, if at all, in separate applications.

9-2.

Basis for Practice-Statutes, Rules

The basis of division and election practice is found in the following statutes and rules:

Sec. 4886, R.S. Any person who has invented or discovered any new and useful art _____ may _____ obtain a patent therefor.

Sec. 4888, R.S. Before any inventor or discoverer shall receive a patent for his invention or discovery _____ he shall particularly point out and distinctly claim the part, improvement or combination which he claims as his invention or discovery.

Rule 11.1 Different inventions in one application. Two or more independent inventions can not be claimed in one application; but (a) where several distinct inventions are dependent upon each other and mutually contribute to produce a single result they may be claimed in one application, and (b) more than one species of an invention, not to exceed three, may be specifically claimed in different claims in one application, if the application also includes an elected species to all the claimed species.

Rule 11.2 Requirement for division. If two or more inventions are claimed in a single application, and they are of such a nature that a single patent may not be issued to cover them, the applicant is required to limit the claims to whichever invention he may elect, this official action being an administrative one for division. If the divisibility of the inventions is clear, such a requirement shall be made before any other action merits; otherwise it shall be made at any time before final action in the case is at the discretion of the examiner.

Claims to the invention or invention are

elected if not cancelled are nevertheless withdrawn from further consideration by the examiner, by the election, subject however to reinstatement in the event the requirement for division is withdrawn or overruled.

Rule 11.3 Reconsideration of requirement. If the applicant disagrees with the requirement for division, he may request reconsideration, giving the reasons therefor (see rule 15.1). In requesting reconsideration the applicant must indicate a provisional election of one invention for prosecution, which invention shall be the one elected in the event the requirement becomes final.

The requirement for division will be reconsidered on such a request, but will not be repeated and made final without the written approval of an Examiner of classification, a copy of which approval shall be supplied to the applicant. If the requirement is repeated and made final, the Examiner will at the same time act on the claims to the elected invention.

Rule 11.4 Appeal from requirement for division. After a final requirement for division the applicant, in addition to any response due on the remainder of the action, may appeal from the requirement. The prosecution of claims to the elected invention may be continued during such appeal. Appeal may be deferred until after final action on or allowance of the claims to the invention elected. Appeal may not be taken if reconsideration of the requirement was not requested.

Rule 11.6 Subsequent presentation of claims for different invention. If, after an office action on an application, the applicant presents claims directed to an invention divisible from the invention previously claimed such claims, if the amendment is entered, will be rejected and the applicant will be required to limit the claims to the invention previously claimed. Such rejection and requirement will not be repeated and made final without the written approval of an Examiner of classification.

Rule 11.7 Election of species. In the first action on an application containing a generic claim and claims restricted separately to each of more than one species embraced thereby, the Examiner, if of the opinion after a complete search that no generic claim presented is allowable, shall require the applicant in his response to that action to elect that species of his invention to which his claim shall be restricted if

to a single claim in the original application. However, if such an application contains a claim directed to more than three species, the Examiner requires restriction of the claims to not more than three species and is taking any further action in the case.

Rule 11.8 Divisional Applications. The number of additional claims, the scope of the claims, and the subject matter of division (rule 11.2), are all subjects of substantive restrictions, which must conform to the rules applicable to original applications and which will be examined in the same manner as original applications. If such an application is filed before the original application is patented or becomes abandoned, and if it is identical with the original application as filed, the drawings being identical and the papers substituted copy of the original papers which were signed and executed by the inventor (except that its claims are the original claims to the separate invention and matter irrelevant thereto may be deleted), signing and execution by the inventor may be omitted; a certified copy of the original papers may be required to be put in the file and such certification may consist in a copy of the drawings conforming to rules relating to drawings and a certified typewritten copy of the original application as filed, together with an amendment cancelling the irrelevant claims or other matter.

9-3. Discretion of Office in Requirements to Divide

As held in *Steinatz v. Allen*, 1904 220 F.2d 863-866, arbitrary reasons to division are invalid.

The policy of the Office is that division is never proper if the division of a patent would be subject to a rejection on the ground of double patenting. Sometimes, inventions are so closely related and the state of the art is such that division is in violation of the patent, and the Office should not insist on it. (See 9-10)

Rule 11.1 provides that a patent may be divided into claims in a division. Any such claim or claims patented by division of a patent invention cannot be void because of that fact. No decision is known in which a patent has been found void by reason of improper joinder of inventions.

9-4.

Determination of Distinctness
or Independence of Claimed Inventions

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

(1) Where there is no disclosed relation between inventions, the inventions are independent; in such a case division is compulsory.

(2) Where inventions are related as disclosed, but are distinct as claimed, division may be proper.

(3) Where inventions which as disclosed are related, and are not distinct as claimed, division is never proper.

The criteria relative to patentability of claimed inventions over prior disclosures are the same criteria that are applied relative to double patenting, if double patenting may result as a consequence of the requirement for division, the requirement should not be made.

Rule 11.1 draws a distinction between the two terms "independent" and "distinct" by setting forth the criteria 1, that independent inventions can not be claimed in one application and 2, that distinct but mutually dependent inventions may be so claimed. As used in this rule the term "independent" means that there is no disclosed relationship between the two or more subjects disclosed, i.e. they are unconnected in design, operation or effect, e.g. species under a genus which species are not usable together as disclosed. The contrasting term "distinct" means that two or more subjects as disclosed are connected in design, operation or effect, for example as combination and part (subcombination) thereof, process and apparatus for its practice, process and product made, etc., but are capable of separate manufacture, use or sale, as claimed.

In passing upon the question of division, it is the claimed subject matter that is considered and such claimed subject matter must be compared in order to determine the question of distinctness or independence.

ANY REASONABLE DOUBT AS TO INDEPENDENCE AND DISTINCTNESS SHOULD BE RESOLVED IN APPLICANT'S FAVOR.

For the purpose of a decision on the question of division, and for this purpose only, the claims are considered as being in proper form and as being patentable. This assumption, of course, is not continued after the question of division is settled and the question of patentability of the several claims is taken up.

The question of independence and distinctness of invention may arise in applications disclosing a single embodiment or a number of embodiments.

9-4-1. Single Embodiment,
Claims Defining Same Essential Features

Where the claims of an application define the same essential characteristics of a single disclosed embodiment of an invention, they should never be divided since there would result a holding of double patenting. This is obviously because the claims are but different definitions of the same disclosed subject matter.

Claims drawn to the same process or apparatus which recite the same essential steps or means and differ only in a statement of the function performed or the result obtained, should not be divided for if divided, the second issued patent may be void.

9-4-1.2 Differing in Use or Property Stated

Where a composition or compound defined in two claims is the same, the allegation in the one claim of a use or property not mentioned in the other does not make it a different composition or compound. Thus where claims to a composition or compound, some of which differ from the others only by a statement of use or property, are in the same application, division is not proper.

Division may be proper between a composition or compound and a process of using the same.

Differing in Title

Closely allied with the situation of the preceding section is where the same inventive characteristics are given a different name or title. The different names ordinarily connote different uses or functions that the subject matter may have, and division should not be required.

Differing in Breadth or Scope Only

Where claims are drawn on a single disclosed embodiment, and differ only in themselves only in the breadth or scope of definition of such embodiment, division is never proper.

9-4-2. Independent Inventions

Rule 111 contains the provision "Two or more independent inventions cannot be claimed in one application,

Independent embodiments necessitate at least two different subjects, and lack of any disclosure of relationship due to structure, operation, function or effect.

Two different combinations, not disclosed as capable of use together, having different modes of operation, different functions or different effects are independent. An article of apparel such as a shoe, and a locomotive bearing would be an example. A process of painting a house and a process of boring a well would be a second example. Obviously, where two independent combinations are disclosed, a subcombination of one of them which is incapable of use with the second, would be independent of the second.

Where the two embodiments are process and apparatus, and the apparatus can not be used to practice the process or any part thereof, they are independent. A process of burning oil is independent of an oil burner which cannot be caused to operate in such a manner as to practice the process.

A manufacturing process is independent of an article of manufacture when it does not produce or use such an article. A process of painting a house which does not use a magnetic compass.

Similarly a manufacturing apparatus is independent of an article of manufacture that cannot be made by the apparatus.

Species of an Unclaimed Genus

Where claims to two embodiments are each related to a single unclaimed subject matter, the claims may be for independent inventions, even though the embodiments may be disclosed as related to each other. Thus in a particular disclosure several species of inventions may be related as belonging to an unclaimed genus. In such a case the claims are regarded as drawn to independent inventions and a requirement for division is proper. Also, subcombinations usable with each other may be species of some generic invention, as in ex parte Healy 1898 C.D. 157, where a clamp for a handle bar stem and a specifically different clamp for a seat post for use on a bicycle were claimed and were held to be properly divisible since no combination claim was presented.

As a further example, one species of carbon compound may have such chemical characteristics as to spontaneously convert into a second species of carbon compound. These species would obviously be quite closely related, but nevertheless be independent in the sense of the rule and therefore divisible.

Species May be Related;
Closely Related to
Combination - Subcombination

The relation "combination - subcombination" presents the situation where plural claims are all readable upon a single embodiment, where the relation is not specific claim to genus, but the relation of a whole to a part thereof. A claim to a subcombination is not generic to the combination in which it is used.

Further, a claim to a combination is not generic to alternative elements that may be used in the combination. For example, a claim to an organized machine which has a cutting tool generically recited, is not a generic claim that would permit the claiming of three species of cutting tool per se.

Definition of a Generic Claim

In an application presenting three species illustrated, for example, in Figures 1, 2 and 3 respectively, a generic claim should read on each of these views; but the fact that a claim does so read is not conclusive that it is generic. It may define only an element common to the several species.

It is not possible to define a generic claim with that precision existing in the case of the sciences, such as biology. A generic claim must be for the same combination as the species claims and must define broadly the element or elements which are variants in the several species, though the generic claim may set forth in greater detail than is done in the species claims, those elements which are common to all the species.

Once a claim that is determined to be generic is allowed, claims restricted respectively to the species embraced within the generic claim will be examined even though they do not include every limitation of the generic claim as to the features which are common to each species.

Thus, where a claim is drawn which recites the species variants (B₁, B₂) generically but is specific as to characteristics (A) common to the several species, claims restricted to the species may be present with A recited either broadly or specifically. For example, claims analyzed as follows are proper: -

- | | |
|--|-------------------------------|
| 1. A specific, B generic | |
| 2. A and B ₁ | 4. A and B ₂ |
| 3. A and B ₁ and B ₂ | 5. A specific, B ₂ |

In such cases it is to be noted that the patentability of claims 2 and 4 restricted to the species (A broad, B₁ and A broad, B₂) does not necessarily follow from the allowability of the generic claim 1 (A specific, B generic).

The illustration assumes the situation where the broader statement of the genus, A broad, B generic, is not present, either because it has been shown by the examiner to be unpatentable or because applicant has failed to present such a claim.

The subject matter A is common to the two species (A B₁) and (A B₂). The claim drawn to (A specific, B generic) includes within its scope each of the two species and is thus generic thereto, and this is true regardless of the detail with which the common features A are defined, since the variant features that determine species B₁ and B₂ are generically defined.

The claims (A broad, B₁) and (A broad, B₂) are restricted respectively to the two species, since each claim recites the detailed features (either B₁ or B₂) which are found in the one embodiment and exclude the second.

Species of invention are usually independent, and come under the first provision of Rule 11.1 since there is usually no disclosure of relationship therebetween. The fact that a genus for two different embodiments is capable of being conceived and defined, does not affect the independence of the embodiments, where the case under consideration contains no disclosure of any community of operation, function or effect.

How Species Claims are Recognized

Claims to be restricted to different species must be mutually exclusive. The general test as to when claims are restricted respectively to different species is the fact that one claim recites limitations which under the disclosure are found in a first species but not in a second, while a second claim recites limitations disclosed only for the second species and not the first.

Claiming of Plural Species

Rule 11.1 provides that "more than one species of invention, not to exceed three, may be specifically claimed in different claims in one application, if that application also includes an allowable claim generic to all claimed species."

This constitutes an exception to the first proviso of the rule that independent inventions cannot be claimed in one application.

A definition can be drawn to embrace within its breadth or scope any two or more subjects that come within the patent statutes, no matter how diverse their specific characteristics may be. If such a definition is presented in an application as a claim, it is a generic claim and must be treated on that basis.

Where additional claims are presented, respectively restricted to two or more of the different embodiments coming within the breadth or scope of the generic claims, treatment must be on the basis of plural claimed species with a claimed genus.

9-4-2.1. Patentability of Species and Genus Claims

It was early held (when the practice was to permit the claiming of but a single species) that when no patentable difference exists between the several disclosed species, an application could claim one species and such generic claims as may be allowable, but that no claims restricted to the other species could be allowed either in the same or in separate applications.

The above practice is still in force, as modified by the change in the rule permitting the claiming of three species.

Where generic claims are allowed, a applicant may claim in the same case species not to exceed three if the species are patentably distinct.

Other applications presented claiming additional species under the genus claimed in the first are closely investigated to determine if the differences are in fact patentable. The claimed subject matter of the application or later issued copending patent to the same inventor must be patentable over the species claimed in the earlier issued patent either alone or combined with the prior art.

Species Must Be Patentably Distinct from Genus Claimed

A species claim must also be patentably distinct from the genus claim.

Where the species and genus are claimed in the same application and where the lack of patentable distinction is clear, the species claim must be rejected on the generic claim.

Where the genus has been allowed and patented, species claims in an application (copending with the

application that resulted in the patent containing generic claims) are properly rejected on the generic claims when not patentably distinct therefrom.

Generic Claims not Allowable
When Presented for First Time After
Issue of Species Patent

Where an applicant has separate applications for plural species, but presents no generic claim until after the issue of a patent for one of the species, the generic claims cannot be allowed, even though applications were copending, and even though the genus is patentable over the patented species, since by failure to present generic claims until after issue of a patent on one species, the genus is dedicated to the public.

Generic Claims in One Patent Only
(generic claims in application rejected)

Generic claims covering two or more species which are separately claimed in two or more patents to the same inventor issued on copending applications must all be present in a single one of the patents.

Where generic claims are allowed in a patent, generic claims in an application by the same inventor are properly rejected on the ground of double patenting.

Where Applications are Copending,
Generic Claims May be Placed in
the One Applicant Elects

As between plural copending applications for different species, each of which is capable of supporting generic claims applicant may elect any one in which to present his generic claims. However, applicant may not elect to have generic claims in one application, without species claims and claims to a species in another application. Applicant should be advised to take the generic claims out in the first issued of a series of patents to the same inventor for different species under the genus. If this is done, and the courts subsequently hold that the difference between the claimed subjects of the several patents is unpatentable (courts hold double patenting), the lesser patents covering additional species are void, not the more important first issued patent covering the genus.

C-4-3

Combination or Aggregation
and Subcombination

A combination is an organization of which a subcombination (or element) is a part. An aggregation is also

an organization of which a subcombination (or element)
is a part.

The distinction between combination and aggregation
is not material to questions of division. Where a combi-
nation is alleged, it must be assumed to be allowable.
Therefore, in the following remarks, the term "combination"
will be used to mean both combination and aggregation for
ease of referring to the same.

Old Combination - Novel
Subcombination

Division is never proper between a combination (AB)
that the Examiner holds to be old and unpatentable and the
subcombination (B) in which the Examiner holds the novelty,
if any, to reside.

Combination with Subcombination Broad
(AspBbr - Bsp)

Where in an application, a combination as claimed
does not set forth the details of the subcombination as
separately claimed, the inventions are distinct and divi-
sion may be proper. Division, however, is proper only if a
separate status in the art as a separate subject of invent-
ive effort can be shown for the subcombination, or, stated
another way, if it can be demonstrated by appropriate cita-
tion of art that the subcombination is of utility alone or
in other and different combinations.

Subcombination Essential to Combination
(AprBsp - Bsp)

Where claims are related such that the separately
claimed subcombination constitutes the essential distin-
guishing feature or features of the combination as claimed
the inventions are not distinct.

Subcombination Recites Features
Having Utility Only in Combination

Where the claim to the subcombination recites features
which, under the disclosure, are of utility only in the com-
bination, division is not proper unless it can be clearly
shown (usually by citation of art) that such features are of
more general utility or is a subject matter of invention
separate and distinct from the combination, as by separate
classification in the Office.

Combination Recites Specific Subcombination.
Evidence Shows Subcombination not Essential
(AspBsp - Bsp)

The situation where the combination recites particular characteristics of the subcombination but there is evidence that the particular characteristics of the subcombination are not essential to the combination, may be diagrammed as AspBsp - Bsp.

The best evidence that the subcombination Bsp is not essential is one or more allowed claims in the case at the time division is required, which claims the combination with the subcombination recited as AspBbr.

Subsequent Search May Show Combination
to be Old

Where sound reasons are advanced to clearly demonstrate distinctness of invention between combination and subcombination and reasons exist for compelling division, division is proper. A subsequent search of the prior art may demonstrate that the combination is not allowable.

Since, however, at the time division was required, two distinct and properly divisible inventions were claimed, the fact that one or both are found not to be allowable because of prior art does not make the requirement improper.

Combinations and Plural
Subcombinations (AB-A;B)

Where an application has combination claims AB and also claims to two or more different subcombinations A and B, each of the subcombinations must be tested separately against the combination to determine whether it is divisible from the combination.

Composition or Compound

Relative to combination and subcombination, the principles of division and double patenting in the chemical arts are the same as in the mechanical and electrical arts when the facts to which those principles are applied are analogous.

Where chemical facts are involved not analogous to facts in the mechanical and electrical arts, the law relative to division and double patenting has developed taking cognizance of those specialized facts.

In some types of cases which involve questions of chemical action, the Board of Appeals holds division is proper between a combination which involves a composition or compound as the sole distinguishing characteristic and such

material claimed per se, where it can be shown that the composition or compound has other and different uses. The decisions of the Board are not, however uniform, and at times they refuse division where the composition or compound is the sole distinguishing feature of the combination.

9-4-4. Subcombinations Usable Together

Subcombinations disclosed as usable together (in some combination which is not claimed) are generally distinct from each other, particularly where there is no adaptation of one to the other. In such cases the Office does not insist upon division where a separate field of search cannot be shown by citation of appropriate art.

Are Not Necessarily Distinct

Where subcombinations disclosed as usable together are separately claimed, it is necessary to clearly establish separate and independent utilities for each as a basis for a holding of distinctness of invention. Lack of such a showing may lead to the conclusion that they are usable only together and thus are not distinct inventions.

9-4-5. Process and Apparatus
for its Practice

Steinmetz v. Allen 1704 C.D. 703; O.G. gives a broad general discussion of the principles to be applied relative to division and double patenting amongst inventions related as process and apparatus for its practice. This is one of the basic decisions which every Examiner should read and comprehend in principle thoroughly.

Process can be Practiced
by other Apparatus

In the discussion of combination and subcombination, it was pointed out that (with but very few exceptions) where the combination involved the subcombination as an essential part thereof, division is never proper even though the subcombination had utility by itself or in other and different relations. In other words, as between combination and subcombinations with very few exceptions, one way dependency was enough to defeat division.

The same is not true relative to process and apparatus for its practice. Division is never if there is either one way distinctness or if there is two way distinctness (usually called mutually distinct). Thus, if it can be shown by appropriate evidence that the process as claimed can be practiced by other apparatus or that the apparatus as claimed can be used to practice another and

different process or both of these, the inventions are distinct. The alternative process or apparatus must not be included within the scope of the claimed process or apparatus.

In cases where the process and apparatus are mutually dependent, the apparatus claim is usually drawn in functional terms, the apparatus features being either broadly one or more means for performing the function or various devices specified by type for performing the function, or the process claim recites the apparatus characteristics quite as particularly as do the apparatus claims. In all of these cases, the inventions, as claimed, are mutually dependent on each other and, as claimed, neither can be practiced without the other. Each requires the other for its practice under the terms of the claims. The inventions so claimed are not distinct. Division is not proper, and if divided double patenting may result.

Where the process is the necessary function of the apparatus as claimed, process and apparatus are mutually dependent. The inventions are not distinct.

Where the process recites particulars of the apparatus that is separately claimed, the two are never distinct.

A process and the apparatus for its practice where the apparatus claim is drawn in terms of means or a series of means to practice the several process steps, should not be allowed in one application. In In re Arendt 1935 C.D. 455 O.G. 7, claims to a process of motor vehicle propulsion were held unpatentable over the apparatus as claimed in appellants prior patent granted on a pending application. The court quoted and approved the statement of the solicitor of the Patent Office in his brief (1935 C.D. at page 252).

"The true test of independence of the subject matter of the method claims and the apparatus claims lies not in the disclosures in the specifications, but in comparison of the things enumerated in the respective claims themselves. The method claims state the doing of certain acts. The apparatus claims claim broadly "means for" doing the same acts, without reference to any specific means. The apparatus claims are intended to cover all means for doing the acts specified. That being so, there is no other apparatus for doing the acts specified, or the method can be carried out only by the apparatus claimed. The case, of course, might be different if the apparatus claims involved any particular structure of means for performing the functions indicated. As before indicated,

it is conceivable that a variety of specifically different means might be used to perform the same function. But that is not the case, because here the apparatus is not limited to any particular structure of means. In other words, there is but a single inventive idea, with no patentable distinction, in setting forth a series of steps of process or in setting forth means for doing the same series of steps."

9-4-6.

Process and Product Made

In this situation, claims for process and product made are for distinct invention where there is no dependency between them or where there is but one way dependency.

It is noted that a blank, stock material or intermediate is treated as a subcombination and a process that operates thereon to convert or change it, is treated as a combination. Whether or not division should be required depends on whether the inventions are distinct or not.

There is two way dependency between a product and a process of making the same which process is claimed is either the necessary way of making the product or is obvious from a consideration of the characteristics of the product. If the process claimed is obvious, it is immaterial that there are additional, different processes obvious or unobvious. In such a case, the inventions are not distinct.

Where the process as claimed necessarily produces the product, and it cannot be demonstrated that the product as claimed can be made by other processes, the inventions are dependent.

Where the product claim recites the particular process of making it, it is never distinct from the process, since, under the terms of the claims, the product can not be made by other processes.

When the product can be made by other processes, and the process claimed is not an obvious way of making the product or it is not obvious from a consideration of the characteristics of the product how it was made, the inventions are distinct. Such other process must not be embraced within the scope of the process as claimed.

In cases of one way dependency, namely where the process necessarily produces the product, but it can be shown that the product as claimed can be made by other processes, division is proper.

Where process and product are mutually distinct, namely, where the process will produce other articles and the article can be produced by other processes, division is proper.

9-4-7. Apparatus and Product Made

The question of division or double patenting between manufacturing apparatus and the product made thereby, seldom arises. In all situations, it should be tested in the same manner for distinctness as between process and product made.

9-5. Mixed Questions of Division

In the preceding, the various relationships between claimed inventions were broken down into several types coupled together two at a time. Many applications involve mixed questions. Applicant will disclose two or more species of an invention. He may claim these species generically and specifically. Each of the species may be for a combination and relative to each species one or more subcombinations may be claimed. The several species may be processes and he may disclose for each process species a different species of apparatus for its practice and claim the apparatus both generically and specifically and also claim one or more subcombinations of each type of apparatus. Where the process is a manufacturing process and the apparatus is a manufacturing apparatus, two or more different intermediates, stock materials or blanks may be disclosed which may be claimed both generically and specifically. The product made by each of the species of process utilizing the corresponding species of apparatus may be claimed and the several species of process may produce several species of final product so that the several final products may be claimed both generically and specifically.

Some only, or all, of these situations may be present. The case must be studied. Each character of relationship must be properly classified and then treated on the basis of the principles appropriate to it.

One common mixed question of division is where species of inventions are presented, each separately claimed with the genus also claimed. In addition there are presented claims to a second character of invention not distinct from and thus not divisible from each of the several species, but with no claim to a genus for the second character of invention, either due to failure to present such claims or due to cancellation of such generic claims after a rejection thereof. This situation may be diagrammed relative to process and product made as follows:

Method Generic

Method Species I _____ Product Species I

Method Species II _____ Product Species II

Method Species III _____ Product Species III

When the generic method is allowable, division is not proper amongst the three species of method (Rule 11.1). Thus the applicant is entitled to prosecute in that single application the three species of method due to the presence of an allowable genus, whether or not he is also entitled to claim the three species of product depends upon the principles set forth in Section 9-4-6. The generic method is, of course, not generic to the products.

Effect of Dual Prosecution on Division

Dual prosecution practice (see Section 10-4) by which inventions (which as claimed, are not divisible) are acted upon by different examining divisions of the Office, has no bearing upon the propriety of a requirement to divide. Such practice does not modify in any way the practice of division, being designed merely to facilitate the handling of cases in which division can not properly be required where consideration in two or more examining divisions is considered necessary.

9-7.

Elements of Office Action Requiring Division

Every requirement to divide has two aspects, (1) the reasons (as distinguished from the mere statement of conclusion) why the invention as claimed are either independent or distinct, and (2) the reasons for insisting upon division therebetween.

The criteria that determine whether or not division should be insisted upon are different for independent inventions and for inventions which, though distinct, are related under the disclosure of the application.

9-7-1.

Independent Inventions

Where the inventions claimed are independent, i.e. where they are not connected in design, operation or effect under the disclosure of the particular application under consideration, the facts relied upon for this conclusion are in essence the reasons for insisting upon division, since under Rule 11.1 division is mandatory. This situation, except for species is but rarely presented, since few persons will file an application containing disclosure of independent things.

Where there is no disclosure of relationship between species, they are independent inventions, and division therebetween is mandatory, even though there is no patentable distinction between the species as claimed. Thus the reasons for insisting upon division between species, are the facts relied upon for the conclusion that there are claims restricted respectively to two or more different species that are disclosed in the application.

An exception was made by the amendment to the rules permitting the claiming of three species when a claim generic thereto is allowed. The mandatory requirement to divide applies to all claims restricted to species in excess of three included within the allowed genus, even though these additional species are not allowable over either the other species or the allowed genus.

Even though the Examiner rejects the generic claims, and even though the applicant cancels the same and thus admits that the genus is unpatentable, 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 division.

9-7-2.

Related Inventions

Where, as disclosed in the application, the several inventions claimed are related, and such related inventions are not patentably distinct as claimed, division is never proper.

Where the related inventions as claimed are shown to be distinct, it is the Office policy to permit them to be claimed in one application where they are classified together and involve the same field of search. The Examiner must show by appropriate citation of art at least one of the following, in order to establish reasons for insisting upon division:

- (1) Separate classification thereof;

This shows that each distinct subject has attained a separate status in the art as a separate subject for inventive effort, and also a separate field of search.

- (2) A separate status in the art when they are classifiable together;

Even though they are classified together, by citing appropriate art from the single subclass, each subject can be shown to have formed a separate subject for inventive effort when

some of the art pertains to the one subject in relation to the other subject.

(3) A separate field of search;

Where it is necessary to search for one of the distinct subjects in which there no pertinent art to the other subject exists, a separate field of search is shown, even though the two are classified together. The art cited to show a separate field of search must in fact be pertinent to the type of subject matter covered by the claims.

Where, however, the classification is the same and the field of search is the same and there is no clear indication of separate future classification and field of search, no reasons exist for dividing among related inventions. This is particularly true in the manufacturing arts where manufacturing processes and the resultant product are classified together, e.g. Carbon Compounds Class 260.

9-7-3. When Linking Claims Rejected - Proper

There are a number of situations which arise, in which an applicant has claims to two or more properly divisible inventions, but presented in the same case are one or more claims to invention (generally called "linking" claims) indivisible from each and every one thereof. These claims thus link together inventions otherwise divisible.

Where the situation exists, and it is found after a complete examination of the linking claims that they are not allowable, such claims should be rejected and division required among the several different inventions claimed. Such requirement should be made as early in the prosecution of the case as possible, whether or not soon as the propriety for it is ascertained or develops. An early disapproved requirement for division may be repeated where the prosecution identifies the independence or distinctness of the inventions.

No action on novelty and patentability need be made on the claims to the distinct inventions, but it should be pointed out to the applicant why the inventions are distinct or independent and in cases not involving genus and species, the reasons for the divisional requirement. However, even where action on novelty and patentability is not necessary to a requirement to divide for elect a species, it is not objectionable to act on all of the remaining claims. Should the Examiner act on a group of claims of his own selection, the applicant should be advised that he is not

bound to accept this group of claims for prosecution in the instant application.

The Examiner is bound to act on the claims relating to the elected invention at the time that he makes final the requirement for division or election.

After election, linking claims if presented again, either in its original or in an amended form, must be examined with the invention elected, and should any linking claim subsequently be allowed, rejoinder of the divided inventions must be permitted. The divisional practice has been carried over into the class of claims involving genus and species. However, as stated by Rule 11.7, no more than three species may be claimed in any event, in one application. The last sentence of the rule, that the Examiner may require restriction of the claims so that not more than three species are separately claimed, is permissive. It should be used only when a claim is allowed on the first action that is generic to three or more of the disclosed species, and more than three species are separately claimed.

Rule 11.1 and 11.7 require that election must be of one, two or three of the disclosed species, not of claims, and the elected species must be clearly identifies.

In requiring election of species the Examiner will note that the application contains claims restricted to more than one, or more than three disclosed species that he must clearly identify, as for example, the species of Figs. 1, 2 and 3 or the species of examples I, II and III respectively. Or, in the absence of distinct figures or examples to identify the several species, the mechanical means, or the particular substance, or other distinguishing characteristic of the species should be stated for each species noted. Grouping of claims for the respective species should not be made unless the species cannot be otherwise identified. The requirement in each case should be for an applicant to elect the particular disclosed species.

Applicant should be advised that his response to be complete under Rules 11.3 and 15.1 must include an identification of the disclosed species that he elects consonant with the requirement, and a listing of all claims restricted or generic thereto. An argument that the generic claims are allowable, or that all claims are generic, or amended to be generic, unless accompanied by an election, is non-responsive.

An Examiner's action subsequent to an election of species should include a complete action on the merits of all claims which are readable on the elected species. All other claims should be rejected as not readable on the

elected species. Should there be a disagreement as to the listing, the Examiner shall point out the reason therefor.

Whenever a generic claim is found to be allowable in substance, even though it is objected to or rejected on merely formal grounds, action on the species claims shall thereupon be given as if the generic claim had been allowed.

Since rejection of the generic claims is a prerequisite to the requirement to elect (except where generic claims are allowed and more than three species are separately claimed) the rejection should be on the best art to anticipate the generic claims that a complete search makes available, and for the best reasons that the Examiner can present.

Where division is required predicated upon the non-allowability of generic or other type of linking claims, applicant is entitled to retain in the case claims to the non-elected invention or inventions so long as he prosecutes a generic or other type of linking claim.

If a linking claim is allowed, the Examiner must thereafter, without further request from the applicant, examine species not to exceed three if the linking claim is generic thereto, or he must examine the claims to the non-elected inventions that are linked to the elected invention by such allowed linking claim.

Obviously, since the requirement to divide is predicated on the non-allowability of the linking claims, appeal should not be immediately taken as provided for by Rule 11.3. If the Examiner allows a linking claim, he will then act on the non-elected inventions linked. If he finally rejects the linking claims, the Board can then pass upon the propriety of the final rejection. If the Board allows the linking claims, the requirement is made void.

An Examiner should not require division in an application none of the claimed subject matter of which is classifiable in his division. Such an application should be transferred to a division to which at least some of the subject matter belongs.

However, if one or more claims belong to the Examiner having the case, and he believes that division is proper, he should retain the case and make the requirement to divide even though the claims that control classification belong in another division. If the subject matter elected belongs to him, a needless double transfer is avoided.

9-7-3.1

Citation of Art

As pointed out in general previously the Examiner must cite art to substantiate his requirement to divide:

Where generic or other type linking claims are rejected the best art and the best reasons should be given for the rejection.

Art resulting from a cursory search pertinent to the several inventions is cited. It is not necessary to cite art to show separate classification, a separate status in the art or a separate field of search, where it is shown that the inventions as disclosed in that particular case are in fact independent.

A cursory search should be made and the most pertinent art found should be cited that shows separate classification, a separate status in the art or a separate field of search. It is the claimed subject matter of U.S. patents that shows the first two. Any disclosure pertinent to the claimed subject matter of the application shows the third.

9-7-3.2.

Precise Division Required

The indication of how to divide between species is set forth early in Section 9-7-3.

As pointed out in ex parte Ljungstrom 1905 C.D. 541, 119 O.G. 2235 the particular limitations in the claims and the reasons why such limitations are considered to restrict the claims to a particular disclosed species should be mentioned if necessary to indicate clearly the line of division.

Whether the claims are directed to different species of invention or different inventions, it is necessary to read all of the claims in order to determine what the claims cover. When doing this, the claims directed to each separate genus, species or subject may be noted on a separate sheet of paper along with a statement of the matter to which they are drawn or in tabular form. Then, in writing to the applicant, the subject matter of one invention and its associated claims should be set apart from the subject matter of another invention and its associated claims.

While every claim should be accounted for, the omission to group a claim, or placing a claim in the wrong group will not affect the essentiality of the requirement where the requirement was otherwise proper and the correct

disposition of the omitted or erroneously grouped claim is clear.

The generic or other linking claims should not be associated with any one of the linked inventions since such claims must be combined with any one of the linked inventions that may be elected. This fact should be clearly stated.

9-7-3.3. Requirement Complete

When making a requirement to divide, every effort should be made to have the requirement to divide complete. If one of the claims or inventions is claimable in another division and the Examiner has any doubt as to the proper line for division along the same, he should refer the application to the Examiner of the other division for information on that point and such Examiner should render the necessary assistance.

9-7-3.4. Clear Reasons

The particular reasons relied upon by the Examiner for his 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, in holding that plural species are claimed, the particular limitations recited which are readable upon one disclosed species should be referred to and the reason why under the disclosure, the other species are excluded.

Relative to combination and a subcombination thereof, the Examiner should point out the reasons why he considers the subcombination to have utility by itself or in other combinations, and why he considers that the combination as claimed depends upon the subcombination as its essential distinctive element.

Each other relationship of a claimed invention should be clearly stated and the reasons for the conclusion of distinctness of invention as claimed set forth.

9-7-3.5 Outline and Sample Letter

Relative to species, it is thought that the matter in the early part of Section 9-7-3 is adequate indication of the form of letter when election of species is required, there being no allowable generic claims.

The following outline for a requirement to divide

and sample letter is intended to cover every type of division requirement as to form, including those having linking claims between related inventions, except species because they are treated in Section 9-7-3 and other characters of independent inventions because they rarely occur.

OUTLINE AND SAMPLE LETTER

A Citation of art

Preferably two patents for each type of invention
Group by spacing
Identify groups by Roman numerals
Give original classification (not X or UX)

B Statement of the requirement

Identify each group by Roman numeral
Same as corresponding patent groups
List claims in each group
Check accuracy of numbering
Look for same claim in two groups
Look for omitted claims
Take into account claims not grouped, indicating their disposition

C Statement of facts

Give short description of total extent of the subject matter claimed in each group
Point out critical claims of different scope
Identify whether combination, subcombination, process, apparatus or product
Classify each group and refer to corresponding patent for evidence

(Note B and C are usually worked in together, see form letter)

D Special treatment of ungrouped claims

Linking claims

Reject

Make complete rejection, giving reasons therefor

Statement on groups to which linking claims may be assigned for examination

Other ungrouped claims

Indicate disposition

eg: previously non-elected, non-statutory, canceled, etc.

E Allegation of distinctness

Sample Letter

A sample letter follows:

This application has been examined.
References cited:

I	Smith	3,236,517	Dec. 25, 1960	123-31
	Jones	3,698,521	Nov. 27, 1966	123-31
II	Doe	3,210,456	July 4, 1976	261-39
	Roe	3,336,860	Oct. 12, 1992	261-39
III	X	3,456,789	Feb. 29, 1990	123-69
	Y	3,000,001	May 30, 1966	123-69

Division is required as follows:

- I Claims 1-6 which recite an internal combustion engine combination and would be classified with the Smith and Jones patents.
- II C
- II Claims 7-12 which recite a carburetor subcombination and would be classified with the Doe and Roe patents
- III Claims 13-18 which recite a spark plug subcombination and would be classified with the X and Y patents.

Claim 19, which recites the specific details of both the carburetor and the spark plug and is thus not divisible from either, is rejected on the ground of aggregation (give statement of reasons). For purposes of examination it may be retained with either Group II or Group III, and if a combination of this type is found allowable the question of rejoinder of Groups II and III will be considered.

Claim 20, which is rejected as indefinite and not in compliance with Revised Statutes 4888, may be retained with any group for purposes of examination.

Claim 21 drawn to a bearing structure, is rejected as being for a previously non-elected invention.

The several inventions are distinct, each from the others, because (1) the engine combination, as defined in the claims of Group I, does not recite nor does the engine require either the specific carburetor subcombination as defined in the claims of Group III, and (2) the carburetor and spark plug subcombinations have separate utility in other and different combinations. For example, the carburetor of Doe and the spark plug of X could be used in the combination defined by the claims of Group I. The carburetor and spark plug as defined in Groups II and III could equally well be used in a furnace combination.

Point out facts which show distinctness

Treat the inventions as claimed, do not merely state your conclusion that inventions in fact are distinct

- (1) Subcombination - Subcombination (disclosed as usable together)

Each usable alone or in other identified combination

Demonstrate by cited patent

Demonstrate by Examiner's suggestion

- (2) Combination - Subcombination

Combination as claimed does not require subcombination

and

Subcombination usable alone or in other identified combination

Demonstrate by cited patent

Demonstrate by Examiner's suggestion

- (3) Process - Apparatus

Process can be carried out by hand or by other apparatus

Demonstrate by cited patent

Demonstrate by Examiner's suggestion

or

Demonstrate apparatus can be used in other process (rare)

- (4) Process and /or apparatus - product

Demonstrate claimed product can be made by other process (or apparatus)

By cited patent

By Examiner's suggestion

or

Process (or apparatus) can produce other product (rare)

- F Allocation of reasons for insisting upon division (Section 9-7-3.4)

Must be demonstrated by citation of art

Separate status in the art

Different classification

Refer to exemplary patents

Same classification

Refer to exemplary patents

Divergent fields of search

Search required for one group not required for the other

Refer to exemplary patents

Since these distinct inventions have each acquired a separate status in the art as shown by the different classifications of the above cited exemplary art, and since the fields of search for the respective inventions are not coextensive, division is proper.

9-8. Election and Response

Rule 11.2 authorizes the Examiner to require applicant to limit the claims to whichever invention the applicant elects.

The expression "limit the claims" does not mean that all reference to the non-elected inventions must be eliminated from the application.

Election is the designation of the particular one of divisible inventions that will be prosecuted in the application. Election may be made in other ways than expressly in response to the requirement.

A response is the reply to each point raised by the Examiner's action, and may be a compliance or, in accordance with Rule 11.3, include a traverse.

A traverse of a requirement to divide is a statement of the reasons upon which the applicant relies for his conclusion that the requirement is in error and must be complete as required by Rule 15.1.

Election becomes fixed when after either an implied or express election on the part of applicant, the claims in an application have received an action on their merits by the Office. Applicant must make his own election, whether of his own motion or because of a requirement to divide. The Examiner will not make the election for him.

Where claims to another invention are properly added and entered in the case before an action is taken, insofar as election is concerned, they are treated as original claims.

Only when claims originally presented have been acted upon by the Office on their merits has the invention elected by an applicant been fixed. Subsequently presented claims to a divisible invention should be entered but required to be cancelled; in other words, they should be rejected as being for an invention other than elected.

Where the originally presented claims are still generic to the several disclosed species, no election of a single species has been made.

Where applicant is claiming two or more inventions which may be species or various types of related inventions, and as a result of Office action on the claims he cancels the claims to one or more of such inventions, leaving claims to at least one, and which claims are acted upon by the Examiner, the claimed inventions that remain in the case are elected.

Under former practice, some requirements to divide required an election even though accompanied with a traverse, others did not. Rule 11.3 makes the practice uniform. An election must be made in response to all requirements to divide even though accompanied by a traverse of the requirement. Requirements to divide, if traversed, will not be repeated without the written approval of the Examiner of Classification. From this repeated requirement, and not otherwise may applicant appeal. Thus, in order to appeal the requirement to divide, the applicant must traverse the requirement, an Examiner of Classification must approve the requirement and the Examiner must repeat it and make it final.

As first stated in *ex parte Higinbotham* 1922 C.D. 29, an election following a requirement to divide, which election is made without traverse of the requirement results in loss of right to appeal from the requirement. This results from the fact that applicant has acquiesced in the accuracy of the holding so that the question is not twice acted upon; and appealable questions must be twice acted upon to give the Board its jurisdiction.

A traverse of the rejection of the linking claims is not a traverse of the requirement to divide, it is a traverse of a holding of non-patentability.

Election combined with a traverse of the rejection of the linking claims only is an agreement with the position taken by the Office that division is proper if the linking type claim is not allowed and improper if they are allowed. The *Higinbotham* doctrine does not apply so long as linking claims are urged to be allowable since Rule 11.3 makes an election mandatory, and, if the Office allows such a claim, it is bound to withdraw the requirement and to act on all linked inventions. But once all linking claims are canceled the doctrine would apply, since the record would be one of agreement as to the propriety of division.

Such a rejection is a requirement to divide, but does not give applicant a second right of election since he had previously made his election.

Where the inventions are distinct and of such a nature that the Office compels division, an election is not waived even tho the Examiner gives action upon the patentability of the claims to the non-elected invention. The benefits received by an applicant through an Examiner's oversight are not such as would compel the Office to continue a mistake after its discovery.

9-8-1. Species, with or without Genus

Where generic claims are rejected, a traverse of the rejection is not a traverse of the requirement to divide between the species, and is not reviewable except on appeal.

Where there is no difference of opinion between the Examiner and applicant that the sole question is one of species, and since division between species is mandatory there is nothing to be reviewed by an Examiner of Classification.

Even though the claimed subjects are species, and even though the generic claim is rejected, when the traverse is on the ground that there is some relation other than or in addition to the fact that plural species are claimed, the case is submitted for review by an Examiner of Classification.

For example:

(1) Where linking claims are rejected and division required but the Examiner fails to hold that the rejected linking claims are generic.

(2) Where the Examiner holds claims to be generic and rejects same, and applicant traverses on the ground that the claims are not generic but are for a subcombination common to the inventions claimed.

(3) Where the traverse is on the ground that the species are disclosed as used in a single combination and are indivisible for that reason, even though the generic claims are rejected.

All mixed requirements to divide should be submitted for review.

Where, however, there is a traverse on the ground that there is some relationship (other than and in addition to the linking type claim) that also prevents division, the merits of the requirement are contested and not admitted. Assume a particular situation of process and product made where the claim held linking - is a claim to a product limited by the process of making it. The traverse may set forth particular reasons for the conclusion that division is improper since the process necessarily makes the product and that there is no other present known process by which the product can be made. If division is approved and made final in spite of such traverse, the right to appeal is preserved even though all linking claims are canceled.

The Higginbotham doctrine does not apply in connection with species where the generic claims are rejected.

While an election without traverse of the requirement results in loss of right of appeal, it does not result in loss of right of review by an Examiner or Classification on the question of identity of invention of subsequently presented claims.

Once an election is made in response to a requirement to divide, all claims retained in the case drawn to the so divided and non-elected inventions should be finally rejected on the ground of misjoinder.

Where an interference is instituted prior to an applicant making an election the subject matter of the interference issues is not elected. An applicant may, after the termination of the interference, elect any one of the inventions not so elected.

The general policy of the Office is not to permit the applicant to shift to claiming another invention after an election is once made. While applicant, as a matter of right, may not shift from claiming one invention to claiming another, the Office is not precluded from permitting a shift, if any do so where the shift results in no additional work or expense, and particularly where the shift reduces work as by simplifying the issues. Having once accepted and acted upon the amendment which shifted the invention the Examiner may not thereafter hold the shift is improper as hold the case abandoned for that reason. A change from a method setting forth only the necessary or obvious way of making a product to the product is not a shift.

When claims are presented which the Examiner holds are drawn to an invention other than elected he should reject the claims on that ground.

A traverse of the rejection of linking claims only is not a traverse of the requirement, and is not reviewed by an Examiner of Classification.

When there is an additional traverse (other than such rejection) that sets forth reasons why the inventions among which division is required is improper, it must be submitted to an Examiner of Classification before being made final.

Where an Examiner makes a complete requirement to divide, fully stating his reasons as to why the inventions as claimed are considered to be either independent or distinct and fully giving his reasons for compelling division, there is ordinarily no reason for the Examiner in submitting the case for review to write a memorandum. His reasons are already on record, to accompany the traverse of the applicant.

However, where claims are added, a memorandum should be submitted to point out how the added claims should be disposed of in the light of the requirement to divide.

Also, where the claims are amended in substance the Examiner may want to submit a memorandum. If such changes affect the requirement to divide, the Examiner should submit a memorandum pointing out how it affects the requirement. If such amendments do not affect the requirement to divide, no memorandum is necessary.

Finally, where some of the arguments in the traverse have not been anticipated, the Examiner may wish to submit a memorandum answering the same.

Where an Examiner of Classification renders a decision which approves, either in whole or in part, a requirement to divide, he will supply the Primary Examiner with both an original copy and a carbon copy of his decision. These copies will be attached to the original and carbon copies respectively of the Office action making the requirement final so as to become parts thereof. The necessity of quoting the decision in the Office action is thereby removed. In the body of the Examiner's action should appear the statement that the requirement to divide, as approved in the attached decision, is made final. The decision and action will thus have the same paper number and will be entered together in the "Contents" section of the file wrapper.

Where the requirement to divide is entirely disapproved, the decision should not be entered in the file. The next Office action, however, should either withdraw the requirement, hold it in abeyance, or modify it, as the facts warrant.

9-9. Claims to Inventions that are not Distinct
In Plural Applications of same Inventor

Several applications may be filed by the same applicant or owned by the same party with conflicting claims. Rule 10.7, in such cases requires elimination of such claims from all but one of the applications, in the absence of good and sufficient reason for their retention in more than one application.

Here, treatment is given of only applications of a single inventor, not the applications of different inventors that are all owned by one party.

The application of the rule in three different situations is given hereinafter.

Under Rule 10.7 the practice relative to applications both pending before the Examiner and where both claim either the same invention or inventions that are not distinct, is:

Where claims in an application are unpatentable over claims of an earlier application of the same inventor, (either because they recite the same subject matter, or because the prior art shows that the differences do not impart a patentable distinction) reject the claims of the later application on the claims of the earlier one, whether the earlier application be in issue or not or whether the claims of the earlier one are allowed or not. Should the later application be in issue with claims unpatentable over the claims in the earlier application, the claims in the earlier application should be rejected. Also, claims unpatentable over each other in cases one of which is in interference should be treated by rejecting the claims in the application not in interference.

The claims in the earlier application should not be rejected on the claims in the later application.

No other rejection should be entered on the claims held unpatentable over the claims of the earlier application. However, any additional claims in the later application that are patentably distinct over the claims of the earlier one should be fully treated.

Where an application is in issue, a proper line of division may be established under Rule 34.2 without withdrawing the allowed case from issue.