Chapter 800 Restriction; Double Patenting

801 Introduction

The subject of restriction and double patenting are herein treated under U.S.C. Title 35, which became effective January 1, 1953, and the revised Rules of Practice that became effective January 1, 1953.

802 Basis for Practice in Statutes and Rules [R–45]

The basis for restriction and double patenting practice is found in the following statute and rules:

35 U.S.C. 121. Divisional applications. If two or more independent and distinct inventions are claimed in one application, the Commissioner may require the application to be restricted to one of the inventions. If the other invention is made the subject of a divisional application which complies with the requirements of section 120 of this title it shall be entitled to the benefit of the filing date of the original application. A patent issuing on an application with respect to which a requirement for restriction under this section has been made, or on an application filed as a result of such a requirement, shall not be used as a reference either in the Patent and Trademark Office or in the courts against a divisional application or against the original application or any patent issued on either of them, if the divisional application is filed before the issuance of the patent on the other application. If a divisional application is directed solely to subject matter described and claimed in the original application as filed, the Commissioner may dispense with signing and execution by the inventor. The validity of a patent shall not be questioned for failure of the Commissioner to require the application to be restricted to one invention.

Rule 141. Different inventions in one application. Two or more independent and distinct inventions may not be claimed in one application, except that more than one species of an invention, not to exceed five, may be specifically claimed in different claims in one application, provided the application also includes an allowable claim generic to all the claimed species and all the claims to each species in excess of one are written in dependent form (rule 75) or otherwise include all the limitations of the generic claim.

Rule 142. Requirement for restriction. (a) If two or more independent and distinct inventions are claimed in a single application, the examiner in his action shall require the applicant in his response to that action to elect that invention to which his claims shall be restricted, this official action being called a requirement for restriction (also known as a requirement for division). If the distinctness and independence of the inventions be clear, such requirement will be made before any action on the merits; however, it may be made at any time before final action in the case, at the discretion of the examiner.

(b) Claims to the invention or inventions not 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 restriction is withdrawn or overruled.

Rules 141 through 146 outline Office practice on questions of restriction.

802.01 Meaning of "Independent", "Distinct" [R–45]

35 U.S.C. 121 quoted in the preceding section states that the Commissioner may require restriction if two or more "independent and distinct" inventions are claimed in one application. In rule 141 the statement is made that two or more "independent and distinct inventions" may not be claimed in one application.

This raises the question of the subjects as between which the Commissioner may require restriction. This in turn depends on the construction of the expression "independent and distinct" inventions.

"Independent," of course, means *not dependent.* If "distinct" means the same thing, then its use in the statute and in the rule is redundant. If "distinct" means something different, then the question arises as to what the difference in meaning between these two words may be. The hearings before the committees of Congress considering the codification of the patent laws indicate that section 121: "enacts as law existing practice with respect to division, at the same time introducing a number of changes."

The report on the hearings does not mention as a change that is introduced, the subjects between which the Commissioner may properly require division.

The term "independent" as already pointed out, means *not dependent.* A large number of subjects between which, prior to the 1952 Act, division had been proper, are dependent sub-

jects, such, for example, as combination and a subcombination thereof; as process and apparatus used in the practice of the process; as composition and the process in which the composition is used; as process and the product made by such process, etc. If section 121 of the 1952 Act were intended to direct the Commissioner never to approve division between dependent inventions, the word "independent" would clearly have been used alone. If the Commissioner has authority or discretion to restrict independent inventions only, then restriction would be improper as between dependent inventions, e.g., such as the ones used for purpose of illustration above. Such was clearly, however, not the intent of Congress. Nothing in the language of the statute and nothing in the hearings of the committees indicate any intent to change the substantive law on this subject. On the contrary, joinder of the term "distinct" with the term "inpendent", indicates lack of such intent. The law has long been established that dependent inventions (frequently termed related inventions) such as used for illustration above may be properly divided if they are, in fact "distinct" inventions, even though dependent.

INDEPENDENT

The term "independent" (i.e., not dependent) means that there is no disclosed relationship between the two or more subjects disclosed, that is, they are unconnected in design, operation or effect, for example, (1) species under a genus which species are not usable together as disclosed or (2) process and apparatus incapable of being used in practicing the process.

DISTINCT

The term "distinct" means that two or more subjects as disclosed are related, 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, AND ARE PATENTABLE OVER EACH OTHER (though they may each be unpatentable because of the prior art). It will be noted that in this definition the term "related" is used as an alternative for "dependent" in referring to subjects other than independent subjects.

It is further noted that the terms "independent" and "distinct" are used in decisions with varying meanings. All decisions should be read carefully to determine the meaning intended.

802.02 Definition of Restriction [R-45]

Restriction, a generic term, includes that practice of requiring an election between distinct inventions, for example, election between combination and subcombination inventions, and the practice relating to an election between independent inventions, for example, an election of species.

803 Restriction—When Proper [R-45]

Under the statute an application may properly be required to be restricted to one of two or more claimed inventions only if they are able to support separate patents and they are either independent (§§ 806.04–806.04(j)) or distinct (§§ 806.05–806.05(g)).

If it is demonstrated that two or more claimed inventions have no disclosed relationship ("independent"), restriction should be required. If it is demonstrated that two or more claimed inventions have a disclosed relationship ("dependent"), then a showing of distinctness is required to substantiate a restriction requirement.

Where inventions are neither independent nor distinct, one from the other, or they are not sufficiently different to support more than one patent, their joinder in a single application must be permitted.

PRACTICE RE MARKUSH-TYPE CLAIMS

This sub-section deals with Markush-type claims which include a plurality of alternatively usable substances or members. In most cases this recitation by enumeration is used because there is no appropriate or true generic language.

Where an application claims two or more independent and distinct inventions, the Commissioner, under the provisions of 35 U.S.C. 121, may require the application to be restricted to one of the inventions.

A Markush-type claim is directed to "independent and distinct inventions," if two or more of its members are so unrelated and diverse that a prior art reference anticipating the claim with respect to one of the members would not render the claim obvious under 35 U.S.C. 103 with respect to the other member(s).

If the claim is of that nature, the examiner is authorized to reject it as an improper Markush claim and for misjoinder under 35 U.S.C. 121 and to require the applicant to restrict the application to a single invention. In making such a requirement, the examiner will (1) clearly delineate the members or groups of members believed to constitute improperly joined inventions, and (2) state reasons fully explaining why they are independent and distinct. Applicant's response to such a requirement should be an election of a single adequately disclosed

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and supported invention, with or without restriction of the claim(s) to that invention. Of course, the response must not introduce new matter into the application. See 35 U.S.C. 132 and *In re Welstead*, 59 CCPA 1105, 463 F. 2d 1110, 174 USPQ 449 (1972). A refusal to elect a single invention will be treated as a non-responsive reply.

If the members of the Markush group are sufficiently few in number or so closely related that a search and examination of the entire claim can be made without serious burden, the examiner is encouraged to examine it on the merits, even though it is directed to independent and distinct inventions. In such a case, the examiner will not follow the procedure outlined in the preceding paragraph and will not require restriction.

Where the examiner has rejected the claim and required restriction and the applicant has responded without restricting the claim(s) to a single invention, the examiner shall, if the position is adhered to, again reject the claim and any other Markush claims not restricted to the elected invention. No further examination of these claims is required unless and until such rejection has been overcome. However, if the search of the single elected invention develops prior art which would render both the elected invention and the improper Markush claim(s) unpatentable, such prior art may be applied in rejections of both without a complete search of the subject matter of the improper Markush claim(s). Otherwise, only true generic claims and those restricted to the elected invention will be examined in the usual manner.

The primary examiner is responsible for and must sign the action making a requirement for restriction between inventions recited in a Markush-type claim final.

Review of the rejection will be by appeal to the Board of Appeals under 35 U.S.C. 134.

803.01 Review by Primary Examiner [R–45]

Since requirements for restriction under Title 35 U.S.C. 121 are discretionary with the Commissioner, it becomes very important that the practice under this section be carefully administered. Notwithstanding the fact that this section of the statute apparently protects the applicant against the dangers that previously might have resulted from compliance with an improper requirement for restriction, IT STILL REMAINS IMPORTANT FROM THE STANDPOINT OF THE PUBLIC INTEREST THAT NO REQUIREMENTS BE MADE WHICH MIGHT RESULT IN THE ISSUANCE OF TWO PATENTS FOR THE SAME INVENTION. Therefore to guard against this possibility, the primary examiner must personally review and sign all final requirements for restriction.

804 Definition of Double Patenting [R–45]

There are two types of double patenting rejections. One is the "same invention" type double patenting rejection based on 35 U.S.C. 101 which states in the singular that an inventor "may obtain a patent." This has been interpreted as meaning only one patent.

The other type is the "obviousness" type double patenting rejection which is a judicially created doctrine based on public policy rather than statute and is primarily intended to prevent prolongation of monopoly by prohibiting claims in a second patent not patentably distinguishing from claims in a first patent. In re White et al., 160 USPQ 417; In re Thorington et al., 163 USPQ 644. Note also §§ 804.01 and 804.02.

The Court of Customs and Patent Appeals has held that a terminal disclaimer is ineffective in the first type, where it is attempted to twice claim the same invention. However, the "obviousness" type double patenting rejection may be obviated by a terminal disclaimer.

The term "double patenting" is properly applicable only to cases involving two or more applications and/or patents having the same inventive entity and where an invention claimed in one case is the same as, or not patentably distinct from, an invention already claimed. The term "double patenting" should not be applied to situations involving commonly owned cases of different inventive entities. Commonly-owned cases of different inventive entities are to be treated in the manner set out in § 804.03.

The inventive entity is the sole inventor or the joint inventors listed on a patent or patent application. A sole inventor in one application and joint inventors in another application cannot constitute a single or the same entity, even if the sole inventor is one of the joint inventors. Likewise, two sets of joint inventors do not constitute a single inventive entity if any individual inventor is included in one set who is not also included in the other set.

804.01 Nullification of Double Patenting Rejection [R–20]

35 U.S.C. 121, third sentence, provides that where the Office requires restriction, the patent of either the parent or any divisional application thereof conforming to the requirement cannot be used as a reference against the other.

This apparent nullification of double patenting as a ground of rejection or invalidity in such cases imposes a heavy burden on the Office to guard against erroneous requirements for restriction where the claims define essentially the same inventions in different language and which, if acquiesced in, might result in the issuance of several patents for the same invention.

The apparent nullification of double patenting as a ground of rejection or invalidity raises many troublesome questions as to meaning and situations where it applies.

A. Situations Where the Double Patenting Protection Under 35 U.S.C. 121 Does Not Apply

(a) The applicant voluntarily files two or more cases without requirement by the examiner.

(b) The claims of the different applications or patents are not consonant with the requirement made by the examiner, due to the fact that the claims have been changed in material respects from the claims at the time the requirement was made.

(c) The requirement was made subject to the nonallowance of generic or other linking claims and such linking claims are subsequently allowed.

B. Situations Where the Double Patenting Protection Under 35 U.S.C. 121 Apparently Applies

It is considered that the prohibition against holdings of double patenting applies to requirements for restriction between the related subjects treated in §§ 806.04 through 806.05(g), namely, between combination and subcombination thereof, between subcombinations disclosed as usable together, between process and apparatus for its practice, between process and product made by such process and between apparatus and product made by such apparatus, etc., *so long as the claims in each case filed as a result of such requirement are limited to its separate subject.*

804.02 Terminal Disclaimer Avoiding Double Patenting Rejection [R–53]

If two or more cases are filed by a single inventive entity, and if the expiration dates of the patents, granted or to be granted, are the same, either because of a common issue date or by reason of the filing of one or more terminal disclaimers, two or more patents may properly be granted, provided the claims of the different cases are not drawn to the same invention as defined for double patenting purposes (In re Knohl, 155 USPQ 586; In re Griswold, 150 USPQ 804; In re Vogel and Vogel, 164 USPQ 619).

Claims that differ from each other (aside from minor differences in language, punctuation, etc.), whether or not the difference is obvious, are not considered to be drawn to the same invention for double patenting purposes. In cases where the difference in claims is obvious, terminal disclaimers are effective to overcome rejections on double patenting. However, such terminal disclaimers must include a provision that the patent shall be unenforceable if it ceases to be commonly owned with the other application or patent. Note 37 CFR 1.321(b).

Where there is no difference, the inventions are the same and a terminal disclaimer is ineffective.

37 CFR 1.321(b). A terminal disclaimer, when filed in an application to obviate a double patenting rejection, must include a provision that any patent granted on that application shall be enforceable only for and during such period that said patent is commonly owned with the application or patent which formed the basis for the rejection. See § 1.21 for fee.

See § 1403 for form.

804.03 Terminal Disclaimer Not Applicable—Commonly Owned Cases of Different Inventive Entities [R–53]

37 CFR 1.78(c). Where two or more applications, or an application and a patent naming different inventors and owned by the same party contain conflicting claims, the assignee may be called upon to state which named inventor is the prior inventor. In addition to making said statement, the assignee may also explain why an interference should be declared or that no conflict exists in fact.

In view of 35 U.S.C. 135, it is necessary to determine priority of invention whenever two different inventive entities are claiming a single inventive concept, including variations of the same concept each of which would be obvious in view of the other. This is true regardless of ownership and the provision of 37 CFR 1.201(c) that interferences will not be declared or continued between commonly owned cases unless good cause is shown therefor. A terminal disclaimer can have no effect in this situation, since the basis for refusing more than one patent is 35 U.S.C. 102 or 103, and is not connected with any extension of monopoly.

Accordingly, the assignee of two or more cases of different inventive entities, containing conflicting claims must maintain a line of demarcation between them. If such a line is not maintained, the assignee should be called on

to state which entity is the prior inventor of that subject matter and to limit the claims of the other application accordingly. If the assignee does not comply with this requirement, the case in which the requirement to name the prior inventor was made will be held abandoned.

An application in which a requirement to name the prior inventor has been made will not be held abandoned where a timely response indicates that the other application is abandoned or will be permitted to become abandoned. Such a response will be considered sufficient since it renders the requirement to identify the prior inventor moot because the existence of conflicting claims is eliminated.

If after taking out a patent, a common assignee presents claims for the first time in a copending application not patentably distinct from the claims in the patent, the claims of the application should be rejected on the ground that the assignee, by taking out the patent at a time when the application was not claiming the patented invention, is estopped to contend that the patentee is not the prior inventor.

If a patent is inadvertently issued on one of two commonly owned applications by different inventive entities which at the time when the patent issued were claiming inventions which are not patentably distinct, the assignee should be called on to make a determination of priority as in the case of pending applications. If the determination indicates that the patent issued to the senior entity a rejection under 35 U.S.C. 102 or 103 should be made. An election of the applicant (senior entity) as the first inventor should not be accepted without a complete (not terminal) disclaimer of the conflicting claims in the patent.

804.04 Submission to Group Director [R–38]

In order to promote uniform practice, every action containing a rejection on the ground of double patenting of either a parent or a divisional case (where the divisional case was filed because of a requirement to restrict by the examiner under 35 U.S.C. 121, including a requirement to elect species, made by the Office) must be submitted to the group director for approval prior to mailing. When the rejection on the ground of double patenting is disapproved, it shall not be mailed but other appropriate action shall be taken. Note § 1003, item 4.

805 Effect of Improper Joinder in Patent [R–16]

35 U.S.C. 121, last sentence provides: "The validity of a patent shall not be questioned for failure of the Commissioner to require the application to be restricted to one invention." In other words, under this statute, no patent can be held void for improper joinder of inventions claimed therein.

806 Determination of Distinctness or Independence of Claimed Inventions [R–53]

The general principles relating to distinctness or independence are elementary, and may be summarized as follows:

1. Where inventions are independent (i.e., no disclosed relation therebetween), restriction, to one thereof is ordinarily proper, §§ 806.04–806.04(j), though up to 5 species may be claimed when there is an allowed claim generic thereto, 37 CFR 1.141, §§ 809.02–809.02(e). ←

2. Where inventions are related as disclosed but are distinct as claimed, restriction may be proper.

3. Where inventions are related as disclosed but are not distinct as claimed, restriction is never proper. Since, if restriction is required by the Office double patenting cannot be held, it is imperative the requirement should never be made where related inventions as claimed are not distinct. For (2) and (3) see §§ 806.05–806.05(g) and 809.03.

806.01 Compare Claimed Subject Matter

In passing upon questions of double patenting and restriction, 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.

806.02 Patentability Over the Prior Art Not Considered [R–29]

For the purpose of a decision on the question of restriction, and for this purpose only, the claims are ordinarily assumed to be in proper form and patentable over the prior art.

This assumption, of course, is not continued after the question of restriction is settled and the question of patentability of the several claims in view of prior art is taken up.

806.03 Single Embodiment, Claims Defining Same Essential Features [R–45]

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.

Where such claims appear in different applications optionally filed by the same inventor, disclosing the same embodiments, see §§ 804–804.02.

806.04 Independent Inventions [R–45]

If it can be shown that the two or more inventions are in fact independent, applicant should be required to restrict the claims presented to but one of such independent inventions. For example:

1. 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.

2. Where the two inventions are process and apparatus, and the apparatus cannot be used to practice the process or any part thereof, they are independent. A specific process of molding is independent from a molding apparatus which cannot be used to practice the specific process.

3. Where species under a genus are independent. For example, a genus of paper clips having species differing in the manner in which a section of the wire is formed in order to achieve a greater increase in its holding power.

SPECIES ARE TREATED EXTENSIVELY IN THE FOLLOWING SECTIONS

806.04(a) Species—Genus [R–38]

The statute (35 U.S.C. 121) lays down the general rule that restriction may be required to one of two or more independent inventions. Rule 141 makes an exception to this, providing that up to five species may be claimed in one application if the other conditions of the rule are met.

806.04(b) Species May Be Related Inventions [R–45]

Species, while usually independent may be related under the particular disclosure. Where inventions as disclosed and claimed, are both (a) species under a claimed genus and (b) related, then the question of restriction must be determined by both the practice applicable to election of species and the practice applicable to other types of restrictions such as those covered in §§ 806.05–806.05(g). If restriction is improper under either practice, it should not be required.

For example, two different subcombinations usable with each other may each be a species of some common generic invention. In ex parte Healy 1898 C.D. 157; 84 O.G. 1281, a clamp for a handle bar stem and a specifically different clamp for a seat post both usable together on a bicycle were claimed. In his decision, the commissioner considered both the restriction practice under election of species and the practice applicable to restriction between combination and subcombinations.

As a further example, species of carbon compounds may be related to each other as intermediate and final product. Thus these species are not independent and in order to sustain a restriction requirement, distinctness must be shown. Distinctness is proven if it can be shown that the intermediate product is useful other than to make the final product. Otherwise, the disclosed relationship would preclude their being issued in separate patents.

806.04(c) Subcombination Not Generic to Combination

The situation is frequently presented where two different combinations are disclosed, having a subcombination *common to each.* It is frequently puzzling to determine whether a claim readable on two different combinations is generic thereto.

This was early recognized in Ex parte Smith 1888 C.D. 131; 44 O.G. 1183, where it was held that a subcombination was not generic to the different combinations in which it was used.

To exemplify, a claim that defines only the subcombination, e.g., the mechanical structure of a joint, is not a generic or genus claim to two forms of a combination, e.g., two different forms of a doughnut cooker each of which utilize the same form of joint.

806.04(d) Definition of a Generic Claim [R–45]

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 or subcombination common to the several species.

It is not possible to define a generic claim with that precision existing in the case of a geometrical term. In general, a generic claim should include no material element additional to those recited in the species claims, and must comprehend within its confines the organization covered in each of the species.

For the purpose of obtaining claims to more than one species in the same case, the generic claim cannot include limitations not present in each of the added species claims. Otherwise stated, the claims to the species which can be included in a case in addition to a single species must contain all the limitations of the generic claim.

Once a claim that is determined to be generic is allowed, all of the claims drawn to species in addition to the elected species which include all the limitations of the generic claim will ordinarily be obviously allowable in view of the allowance of the generic claim, since the additional species will depend thereon or otherwise include all of the limitations thereof.

When all or some of the claims directed to one of the species in addition to the elected species do not include all the limitations of the generic claim, then that species cannot be claimed in the same case with the other species, see § 809.02(c) (2).

806.04(e) Claims Restricted to Species [R–45]

Claims are definitions of inventions. *Claims are never species.* Claims may be restricted to a single disclosed embodiment (i.e. a single species, and thus be designated *a specific species claim*), or a claim may include two or more of the disclosed embodiments within the breadth of scope of definition (and thus be designated *a generic or genus claim*).

Species are always the specifically different embodiments.

Species are *usually* but not always independent as disclosed (see § 806.04(b)) 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.

806.04(f) Claims Restricted to Species, by Mutually Exclusive Characteristics

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. This is frequently expressed by saying that claims to be restricted to different species, must recite the mutually exclusive characteristics of such species.

806.04(h) Species Must Be Patentably Distinct From Each Other and From Genus [R–38]

Where an applicant files a divisional application claiming a species previously claimed but nonelected in the parent case, pursuant to and consonant with a requirement to restrict, there should be no determination of whether or not the species claimed in the divisional application is patentable over the species retained in the parent case since such a determination was made before the requirement to restrict was made.

In an application containing claims directed to more than five species, the examiner should not require restriction to five species unless he is satisfied that he would be prepared to allow claims to each of the claimed species over the parent case, if presented in a divisional application filed according to the requirement. Restriction should not be required if the species claimed are considered clearly unpatentable over each other.

In making a requirement for restriction in an application claiming plural species, the examiner should group together species considered clearly unpatentable over each other, with the statement that restriction as between those species is not required.

Where generic claims are allowed, applicant may claim in the *same application* additional species as provided by rule 141. As to these, the patentable distinction between the species or between the species and genus is not rigorously investigated, since they will issue in the same patent. However, the practice stated in § 706.03 (k) may be followed if the claims differ from the allowed genus only by subject matter that can be shown to be old by citation of prior art.

Where, however, an applicant optionally files another application with claims to a different species, or for a species disclosed but not claimed in a parent case as filed and first acted upon by the examiner, there should be close investigation to determine the presence or absence of patentable difference. See §§ 804.01 and 804.02.

806.04(i) Generic Claims Rejected When Presented for First Time After Issue of Species [R–45]

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 the applications were copending, In re Blattner, 114 USPQ 299, 44 C.C.P.A. 994 (CCPA 1957).

806.04(j) Generic Claims in One Patent only [R–45]

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.* If present in two or more patents, the generic claims in the later patents are void. Thus generic claims in an application should be rejected on the ground of double patenting in view of the generic claims of the patent, Ex parte Robinson, 121 USPQ 613, (Bd. App., 1956).

806.05 Related Inventions. [R–45]

Where two or more related inventions are being claimed, the principal question to be determined in connection with a requirement to restrict or a rejection on the ground of double

patenting is whether or not the inventions as claimed are distinct. If they are distinct, restriction may be proper. If they are not distinct, restriction is never proper. If non-distinct inventions are claimed in separate applications or patents, double patenting must be held, except where the additional applications were filed consonant with a requirement to restrict.

The various pairs of related inventions are noted in the following sections.

806.05(a) Combination or Aggregation and Subcombination or Element [R–45]

A combination or an aggregation is an organization of which a subcombination or element is a part.

The distinction between combination and aggregation is not material to questions of restriction or to questions of double patenting. Relative to questions of restriction where a combination is alleged, the claim thereto must be assumed to be allowable as pointed out in § 806.02, in the absence of a holding by the examiner to the contrary. When a claim is found in a patent, it has already been found by the Office to be for a combination and not an aggregation and must be treated on that basis.

806.05(b) Old Combination—Novel Subcombination [R–25]

Restriction is ordinarily not 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, ex parte Donnell 1923 C.D. 54, 315 O.G. 398. (See § 820.01.)

806.05(c) Criteria of Distinctness for Combination, Subcombination or Element of a Combination [R–45]

In order to establish that combination and subcombination inventions are distinct, two-way distinctness must be demonstrated.

To support a requirement for restriction, both two-way distinctness and reasons for insisting on restriction are necessary.

If it can be shown that a combination, as claimed

(1) does not require the particulars of the subcombination as claimed for patentability, and

(2) the subcombination can be shown to have utility either by itself or in other and different relations, the inventions are distinct. When these factors cannot be shown, such inventions are not distinct.

The following examples are included for general guidance.

1. Subcombination not Essential to Combination

$$\frac{A\ B_{br}}{B_{sp}}$$ Restriction proper

Where a combination as claimed does not set forth the details of the subcombination as separately claimed and the subcombination has separate utility, the inventions are distinct and restriction is proper if reasons exist for insisting upon the restriction, i.e. separate classification, status, or field of search.

This situation can be diagramed as combination $A\ B_{br}$, and subcombination B_{sp}. B_{br} indicates that in the combination the subcombination is broadly recited and that the specific characteristics set forth in the subcombination claim B_{sp} are not set forth in the combination claim.

Since claims to both the subcombination and combination are presented and assumed to be patentable, the omission of details of the claimed subcombination B_{sp} in the combination claim $A\ B_{br}$ is evidence that the patentability of the combination does not rely on the details of the specific subcombination.

2. Subcombination Essential to Combination

$$\begin{matrix} A\ B_{sp} \\ B_{sp} \end{matrix}$$ No restriction

If there is no evidence that combination $A\ B_{sp}$ is patentable without the details of B_{sp}, restriction should not be required. Where the relationship between the claims is such that the separately claimed subcombination B_{sp} constitutes the essential distinguishing feature of the combination $A\ B_{sp}$ as claimed, the inventions are not distinct and a requirement for restriction must not be made, even though the subcombination has separate utility.

3. Some Combination Claims Recite Specific Features of the Subcombination but Other Combination Claims Give Evidence That the Subcombination is Not Essential to the Combination.

$$\begin{matrix} A\ B_{sp} \\ A\ B_{br} \\ \hline B_{sp} \end{matrix}$$ (Evidence claim) Restriction proper

Claim $A\ B_{br}$ is an evidence claim which indicates that the combination does not rely upon the specific details of the subcombination for its patentability. If claim $A\ B_{br}$ is subsequently found to be unallowable, the question of rejoinder of the inventions restricted must be reconsidered and the letter to the applicant should so state. Therefore, where the combination evi-

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dence claim A B_{br} does not set forth the details of the subcombination B_{sp} and the subcombination B_{sp} has separate utility, the inventions are distinct and restriction is proper if reasons exist for insisting upon the restriction.

In applications claiming plural inventions capable of being viewed as related in two ways, for example, as both combination-subcombination and also as different statutory categories, both applicable criteria for distinctness must be demonstarted to support a restriction requirement. See also § 806.04(b).

806.05(d) Subcombinations Usable Together [R–45]

Two or more claimed subcombinations, disclosed as usable together in a single combination, and which can be shown to be separately usable, are usually distinct from each other.

Care should always be exercised in this situation to determine if the several subcombinations are generically claimed. (See 806.04(b).)

806.05(e) Process and Apparatus for Its Practice—Distinctness [R–45]

In applications claiming inventions in different statutory categories, only one-way distinctness is generally needed to support a restriction requirement. However, see § 806.05(c).

Process and apparatus for its practice can be shown to be distinct inventions, if either or both of the following can be shown: (1) that the process *as claimed* can be practiced by another materially different apparatus or by hand, or (2) that the apparatus *as claimed* can be used to practice another and materially different process.

806.05(f) Process and Product Made—Distinctness [R–18]

A process and a product made by the process can be shown to be distinct inventions if either or both of the following can be shown: (1) that the process *as claimed* is not an obvious process of making the product *and* the process *as claimed* can be used to make other and different products, or (2) that the product *as claimed* can be made by another and materially different process.

806.05(g) Apparatus and Product Made—Distinctness [R–45]

An apparatus and a product made by the apparatus can be shown to be distinct inventions if either or both of the following can be shown: (1) that the apparatus as claimed is not an obvious apparatus for making the product and the apparatus as claimed can be used to make other and different products, or (2) that the product as claimed can be made by another and materially different apparatus.

807 Patentability Report Practice Has No Effect on Restriction Practice [R–25]

Patentability report practice (§ 705), has no effect upon, and does not modify in any way, the practice of restriction, being designed merely to facilitate the handling of cases in which restriction can not properly be required.

808 Reasons for Insisting Upon Restriction

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

808.01 Independent Inventions [R–25]

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 (§ 806.04), *the facts relied upon for this conclusion are in essence the reasons for insisting upon restriction.* This situation, except for species, is but rarely presented, since persons will seldom file an application containing disclosures of independent things.

808.01(a) Species [R–38]

Where there is no disclosure of relationship between species (see § 806.04(b)), they are independent inventions and election of one following a requirement for restriction is mandatory even though applicant disagrees with the examiner. There must be a patentable distinction between the species as claimed, see § 806.04(h). Thus the reasons for insisting upon election of one species, are the facts relied upon for the conclusion that there are claims restricted respectively to two or more patentably different species that are disclosed in the application, and it is not necessary to show a separate status in the art or separate classification.

A single disclosed species must be elected as a prerequisite to applying the provisions of → 37 CFR 1.141 to four additional species if a generic claim is allowed.

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 restriction, in order to establish the propriety of restriction.

Election of species should not be required if the species claimed are considered clearly unpatentable over each other. In making a requirement for restriction in an application claiming plural species, the examiner should group together species considered clearly unpatentable over each other, with the statement that restriction as between those species is not required.

Election of species should be required prior to a search on the merits (1) in all applications containing claims to a plurality of species with no generic claims, and (2) in all applications containing both species claims and generic or Markush claims.

In all applications in which no species claims are present and a generic claim recites such a multiplicity of species that an unduly extensive and burdensome search is required, a requirement for an election of species should be made prior to a search of the generic claim.

In all cases where a generic claim is found allowable, the application should be treated as indicated in §§ 809.02(b), (c) or (e). If an election is made pursuant to a telephone requirement, the next action should include a full and complete action on the elected species as well as on any generic claim that may be present. [R–50]

808.02 Related Inventions [R–45]

Where, as disclosed in the application, the several inventions claimed are related, and such related inventions are not patentably distinct as claimed, restriction under 35 U.S.C. 121 is never proper (§ 806.05). If applicant optionally restricts, double patenting may be held.

Where the related inventions as claimed are shown to be distinct under the criteria of §§ 806.05(c–g), the examiner, in order to establish reasons for insisting upon restriction, must show by appropriate explanation one of the following:

(1) Separate classification thereof:

This shows that each distinct subject has attained recognition in the art as a separate subject for inventive effort, and also a separate field of search. Patents need not be cited to show separate classification.

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

Even though they are classified together, as shown by the appropriate explanation each subject can be shown to have formed a separate subject for inventive effort when an explanation indicates a recognition of separate inventive effort by inventors. Separate status in the art may be shown by citing patents which are evidence of such separate status.

(3) A different field of search:

Where it is necessary to search for one of the distinct subjects in places where no pertinent art to the other subject exists, a different field of search is shown, even though the two are classified together. The indicated different field of search must in fact be pertinent to the type of subject matter covered by the claims. Patents need not be cited to show different fields of search.

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.

809 Claims Linking Distinct Inventions [R–45]

Where, upon examination of an application containing claims to distinct inventions, linking claims are found, restriction can nevertheless be required. See § 809.03 for definition of linking claims.

A letter including only a restriction requirement or a telephoned requirement to restrict (the latter being encouraged) will be effected, specifying which claims are considered linking. See § 812.01 for telephone practice in restriction requirements.

No art will be indicated for this type of linking claim and no rejection of these claims made.

A 30-day shortened statutory period will be set for response to a written requirement. Such action will not be an "action on the merits" for the purpose of the second action final program.

To be complete, a response to a requirement made according to this section need only include a proper election.

The linking claims *must* be examined with the invention elected, and should any *linking* claim be allowed, rejoinder of the divided inventions *must be* permitted.

809.02 Generic Claim Linking Species [R–50]

Under 37 CFR 1.141, an allowed generic claim may link up to five disclosed species embraced thereby.

The practice is stated in 37 CFR 1.146.

37 CFR 1.146. 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 on the generic claims 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 claims shall be restricted if no generic claim is finally held allowable. However, if such application contains claims directed to more than five species, the examiner may require restriction of the claims to not more than five species before taking any further action in the case.

The last sentence of 37 CFR 1.146, that the examiner may require restriction of the claims so that not more than five species are separately claimed, is permissive. It may be used in aggravated cases of a multiplicity of species, without acting on generic claims, to narrow the issues down to five species. But see § 806.04(h).

809.02(a) Election Required [R–50]

Where generic claims are present, a letter including only a restriction requirement or a telephoned requirement to restrict (the latter being encouraged) should be effected. See § 812.01 for telephone practice in restriction requirements.

Action as follows should be taken:

(1) Identify generic claims or indicate that no generic claims are present. See § 806.04(d) for definition of a generic claim.

(2) Clearly identify each (or in aggravated cases at least exemplary ones) of the disclosed species, *to which claims are restricted.* The species are preferably identified as the species of figures 1, 2 and 3 or the species of examples I, II and III, respectively. In the absence of distinct figures or examples to identify the several species, the mechanical means, the particular material, or other distinguishing characteristic of the species should be stated for each species identified. If the species *cannot be more conveniently identified*, the claims may be grouped in accordance with the species to which they are restricted.

(3) Applicant should then be required to elect a single disclosed species under 35 U.S.C. 121, and advised as to the requisites of a complete response and his rights under 37 CFR 1.141.

For generic claims, a search should not be made and art should not be cited.

A 30-day shortened statutory period will be set for response when a written requirement is made without an action on the merits. Such action will not be an "action on the merits" for purpose of the second action final program.

To be complete, a response to a requirement made according to this section need only include a proper election.

In those applications wherein a requirement for restriction is accompanied by an action on all claims, such action will be considered to be an action on the merits and the next action should be made final.

The following form paragraphs are suggested:

"Generic claims . . . (identify) are present in this application. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species to which his claims shall be restricted if no generic claim is finally held allowable."

"Applicant is advised that his response must include, an identification of the *disclosed* species that he elects consonant with the requirement, and a listing of all claims readable thereon. An argument that a generic claim is allowable, or that all claims are generic or amended to be generic, unless accompanied by an election, is nonresponsive."

"Upon the allowance of a generic claim applicant will be entitled to consideration of claims to not more than four species in addition to the single elected species, provided all the claims to each additional species are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141."

If claims are added after the election, applicant must indicate which are readable on the elected species.

How Expressed

The following text is ordinarily sufficient in requiring election of species:

"Applicant is required (1) to elect a single disclosed and claimed species under 35 U.S.C. 121, even though this requirement be traversed and (2) to list all claims readable thereon, including any claims subsequently added. Section 809.02(a) Manual of Patent Examining Procedure."

This may be used instead of the three quoted paragraphs in part (3) of this section except where applicant is prosecuting his own case or there are other reasons for believing that the short form would not be understood.

It is necessary to (1) identify generic claims or state that none are present, and (2) to clearly identify each species involved.

809.02(b) Election Required—Generic Claim Allowable [R–18]

When a claim generic to two or more claimed species is found to be allowable on the first or any subsequent action on the merits *and election of a single species has not been made*, applicant should be informed that the claim is allowable and generic, and a requirement should be made that applicant elect a single species *embraced by the allowed genus* unless the species claims are all in the form required by rule 141 and no more than five species are claimed. Substantially the following should be stated:

"Applicant is advised that his response to be complete must include an identification of the single, *disclosed* species *within the allowed genus* that he elects and a listing of all claims readable thereupon. Applicant is entitled to consideration of claims to not more than *four* disclosed species in addition to the elected species, *which species he must identify* and list all claims *restricted to* each, provided *all* the claims to each additional species are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by rule 141."

809.02(c) Action Following Election [R–18]

An examiner's action subsequent to an election of species should include a complete action on the merits of all claims readable on the elected species.

(1) When the *generic claims are rejected*, all claims not readable on the elected species should be treated substantially as follows:

"Claims _____ are held to be withdrawn from further consideration under rule 142(b) as not readable on the elected species."

(2) When a *generic claim* is subsequently found to be *allowable*, and not more than 4 additional species are claimed, treatment should be as follows:

When any claim directed to one of said additional species *embraced* by an allowed generic claim is not in the required form, *all* claims to that species should be held to be withdrawn from further consideration by the examiner. The holding should be worded somewhat as follows:

"Claims _____ directed to species _____ are withdrawn from further consideration in this case, since *all* of the claims to this species do not depend upon or otherwise include all of the limitations of an allowed generic claim as required by rule 141."

When the case is *otherwise ready for issue*, an additional paragraph worded somewhat as follows should be added to the holding:

"This application is in condition for allowance except for the presence of such claims. Applicant is given one month from the date of this letter to amend the claims in conformance to rule 141 or take other action (rule 144). Failure to take action during this period will be treated as authorization to cancel claims to the nonelected species by Examiner's Amendment and pass the case to issue. The prosecution of this case is closed except for consideration of the above matter."

Claims directed to species *not embraced* by an allowed generic claim should be treated as follows: Claims _____ are for species not embraced by allowed generic claims _____ as required by rule 141 and are withdrawn from further consideration in this case, rule 142(b).

809.02(d) No Species Claims [R–18]

Where only generic claims are presented no restriction can be required except in those cases where the generic claims recite such a multiplicity of species that an unduly extensive and burdensome search is necessary. See § 808.01(a). If after an action on only generic claims with no restriction requirement, applicant presents species claims to more than one species of the invention he must at that time indicate an election of a single species.

809.02(e) Generic Claim Allowable in Substance [R–18]

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 were allowed.

The treatment of the case should be as indicated in §§ 809.02 (b), (c), or (d).

809.03 Linking Claims [R–45]

There are a number of situations which arise in which an application has claims to two or more properly divisible inventions, so that a requirement to restrict the application to one would be proper, but presented in the same case are one or more claims (generally called "linking" claims) inseparable therefrom and thus linking together the inventions otherwise divisible.

The most common types of linking claims which, if allowed, act to prevent restriction be-

tween inventions that can otherwise be shown to be divisible, are:

Genus claims linking species claims.

A claim to the necessary process of making a product linking proper process and product claims.

A claim to "means" for practicing a process linking proper apparatus and process claims.

Where linking claims exist, a letter including a restriction requirement only or a telephoned requirement to restrict (the latter being encouraged) will be effected, specifying which claims are considered to be linking.

For traverse of rejection of linking claim see § 818.03(d).

809.04 Retention of Claims to Non-Elected Invention [R–34]

Where the requirement is 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.

If a linking claim is allowed, the examiner must thereafter examine species if the linking claim is generic thereto, or he must examine the claims to the nonelected inventions that are linked to the elected invention by such allowed linking claim.

When a final requirement is contingent on the non-allowability of the linking claims, applicant may petition from the requirement under rule 144 without waiting for a final action on the merits of the linking claims; or he may defer his petition until the linking claims have been finally rejected, but not later than appeal, rule 144, § 818.03(c).

810 Action on Novelty [R–18]

In general, when a requirement to restrict is made, no action on novelty and patentability is given.

810.01 Not Objectionable When Coupled With Requirement [R–45]

A basic policy of the present examining program is that the second action on the merits should be made final whenever proper, § 706.07(a). In those applications wherein a requirement for restriction or election is accompanied by a complete action on the merits of all the claims, such action will be considered to be an action on the merits and the next action by the examiner should be made final. When preparing a final action in an application where applicant has traversed the restriction requirement, see § 821.01.

Although an action on novelty and patentability is not necessary to a requirement, it is not objectionable, ex parte Lantzke 1910 C.D. 100; 156 O.G. 257.

However, *except* as noted in § 809, if an action is given on novelty, *it must be given on all claims.*

810.02 Usually Deferred

The Office policy is to defer action on novelty and patentability until after the requirement is complied with, withdrawn or made final.

Ex parte Pickles, 1904 C.D. 126; 109 O.G. 1888

Ex parte Snyder, 1904 C.D. 242; 110 O.G. 2636

Ex parte Weston, 1911 C.D. 218; 173 O.G. 285

810.03 Given on Elected Invention When Requirement Is Made Final

Rule 143 last sentence states: "If the requirement is repeated and made final, the examiner will at the same time act on the claims to the elected invention." Thus, action is ordinarily given on the elected invention in the action making the requirement final.

811 Time for Making Requirement

Rule 142(a), 2nd sentence: "If the distinctness and independence of the inventions be clear, such requirement (i.e. election of the invention to be claimed as required by 1st sentence) will be made before any action upon the merits; however, it may be made at any time before final action in the case, at the discretion of the examiner."

This means, make a proper requirement as early as possible in the prosecution, in the first action if possible, otherwise as soon as a proper requirement develops.

811.02 Even After Compliance With Preceding Requirement

Since the rule provides that restriction is proper at any stage of prosecution up to final action, a second requirement may be made when it becomes proper, even though there was a prior requirement with which applicant complied (Ex parte Benke, 1904 C.D. 63; 108 O.G. 1588).

811.03 Repeating After Withdrawal—Proper

Where a requirement to restrict is made and withdrawn, because improper, when it becomes proper at a later stage in the prosecution, restriction may again be required.

811.04 Proper Even Though Grouped Together in Parent Case

Even though inventions are grouped together in a requirement in a parent case, restriction thereamong may be required in the divisional case if proper.

812 Who Should Make the Requirement [R–45]

The requirement should be made by an examiner who would examine at least one of the inventions.

→ An examiner should not require restriction in an application *none* of the claimed subject matter of which is classifiable in his group. Such an application should be transferred to a group to which at least some of the subject matter belongs.

812.01 Telephone Restriction Practice [R–34]

If an examiner determines that a requirement for restriction should be made in an application, he should formulate a draft of such restriction requirement including an indication of those claims considered to be linking or generic. No search or rejection of the linking claims should be made. Thereupon, he should telephone the attorney of record and ask if he will make an oral election, with or without traverse if desired, after the attorney has had time to consider the restriction requirement. The examiner should arrange for a second telephone call within a reasonable time, generally within three working days. If the attorney objects to making an oral election, or fails to respond, the usual restriction letter will be mailed, and this letter should NOT contain any reference to the unsuccessful telephone call. See §§ 809 and 809.02(a).

When an oral election is made, the examiner will then proceed to incorporate into his letter a formal restriction requirement including the date of the election, the attorney's name, and a complete record of the telephone interview, followed by a complete action on the elected claims including linking or generic claims if present.

If on examination the examiner finds the elected claims to be allowable and no traverse was made, the letter should be written on POL–37 (Examiner's Amendment) and should include cancellation of the non-elected claims, a statement that the prosecution is closed and that a notice of allowance will be sent in due course. Correction of formal matters in the above-noted situation which cannot be handled by a telephone call and thus requires action by the applicant should be handled under the *Ex parte* Quayle practice, using POL–326; these would usually be drawing corrections or the like requiring payment of charges.

Should the elected claims be found allowable in the first action, and an oral traverse was noted, the examiner should include in his action a statement under § 821.01, making the restriction final and giving applicant one month to either cancel the non-elected claims or take other appropriate action (rule 144). Failure to take action will be treated as an authorization to cancel the non-elected claims by an examiner's amendment and pass the case to issue. Prosecution of this application is otherwise closed.

In either situation (traverse or no traverse), caution should be exercised to determine if any of the allowed claims are linking or generic before cancelling the non-elected claims.

Where the respective inventions are located in different groups the requirement for restriction should be made only after consultation with and approval by all groups involved. If an oral election would cause the application to be examined in another group, the initiating group should transfer the application with a signed memorandum of the restriction requirement and a record of the interview. The receiving group will incorporate the substance of this memorandum in its official letter as indicated above. Differences as to restriction should be settled by the existing chain of command, e.g. supervisory primary examiner or group director.

This practice is limited to use by examiners who have at least negotiation authority. Other examiners must have the prior approval of their supervisory primary examiner.

814 Indicate Exactly How Application Is To Be Restricted [R–45]

A. *Species.* The mode of indicating how to require restriction between species is set forth in § 809.02(a).

As pointed out in ex parte Ljungstrom 1905 C.D. 541; 119 O.G. 2335, 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 make the requirement clear.

B. *Inventions other than species.* 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 subject should be noted along with a statement of the subject matter to which they are drawn.

This is the best way to most clearly and precisely indicate to applicant how the application should be restricted. It consists in identifying each separate subject amongst which restriction is required, and grouping each claim with its subject.

The separate inventions should be identified by a grouping of the claims with a short description of the total extent of the invention claimed in each group, specifying the type or relationship of each group as by stating the group is drawn to process, or to subcombination, or to product, etc., and should indicate the classification or separate status of each group, as for example, by class and subclass.

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 propriety of a final requirement where the requirement is otherwise proper and the correct disposition of the omitted or erroneously grouped claim is clear.

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

815 Make Requirement Complete [R–18]

When making a requirement every effort should be made to have the requirement complete. If some of the claimed inventions are classifiable in another art unit and the examiner has any doubt as to the proper line among the same, he should refer the application to the examiner of the other art unit for information on that point and such examiner should render the necessary assistance.

816 Give Reasons for Holding of Independence or Distinctness [R–45]

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, 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* does not rely upon the subcombination as its essential distinguishing part.

Each other relationship of claimed invention should be similarly treated and the *reasons* for the conclusions of distinctness of invention as claimed set forth.

The separate inventions should be identified by a grouping of the claims with a short description of the total extent of the invention claimed in each group, specifying the type or relationship of each group as by stating the group is drawn to a process, or to subcombination, or to product, etc., and should indicate the classification or separate status of each group, as for example, by class and subclass. See § 809.

817 Outline of Letter for Restriction Requirement between Distinct Inventions [R–45]

The statement in §§ 809.02 through 809.02(d) is adequate indication of the form of letter when election of species is required.

No outline of a letter is given for other types of independent inventions since they rarely occur.

The following outline of a letter for a requirement to restrict is intended to cover every type of original restriction requirement between related inventions including those having linking claims.

OUTLINE OF LETTER

A. Statement of the requirement to restrict and that it is being made under 35 U.S.C. 121
- Identify each group by Roman numeral
- List claims in each group
  - Check accuracy of numbering
    - Look for same claims in two groups
    - Look for omitted claims
  - 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

B. Take into account claims not grouped, indicating their disposition.
Linking claims
Indicate—(make no action)
Statement of groups to which linking claims may be assigned for examination
Other ungrouped claims
Indicate disposition
e.g., previously nonelected, nonstatutory, canceled, etc.

C. Allegation of distinctness
Point out *facts* which show distinctness
Treat the inventions as *claimed*, don't 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 examiner's suggestion
(2) Combination—Subcombination
Combination as claimed does *not* require subcombination
AND
Subcombination usable alone or in other combination
Demonstrate by examiner's suggestion
(3) Process—Apparatus
Process can be carried out by hand or by other apparatus
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 examiner's suggestion
OR
Process (or apparatus) can produce other product (rare)

D. Allegation of reasons for insisting upon restriction
Separate status in the art
Different classification
Same classification but recognition of divergent subject matter
Divergent fields of search
search required for one group not required for the other

E. Summary statement
Summarize (1) distinctness and (2) reasons for insisting upon restriction, if applicable.
Include paragraph advising as to response required.
Indicate effect of allowances of linking claims, if any present.
Indicate effect of cancellation or non-allowance of evidence claims (see § 806.05(c)).

818 Election and Response [R–38]

Election is the designation of the particular one of two or more disclosed inventions that will be prosecuted in the application.

A response is the reply to each point raised by the examiner's action, and may include a traverse or compliance.

A traverse of a requirement to restrict is a statement of the reasons upon which the applicant relies for his conclusion that the requirement is in error.

To be complete, a response to a requirement which merely specifies the linking claims need only include a proper election.

Where a rejection or objection is included with a restriction requirement, applicant, besides making a proper election must also distinctly and specifically point out the supposed errors in the examiner's rejection or objection. See rule 111.

818.01 Election Fixed by Action on Claims

Election becomes fixed when the claims in an application have received an action on their merits by the Office.

818.02 Election Other Than Express

Election may be made in other ways than expressly in response to a requirement.

818.02(a) By Originally Presented Claims [R–45]

Where claims to another invention are properly added and entered in the case before an action is given, they are treated as original claims for purposes of restriction only.

The claims originally presented *and acted upon* by the Office on their merits determine the invention elected by an applicant, and subsequently presented claims to an invention other than that acted upon should be treated as provided in § 821.03.

818.02(b) Generic Claims Only—No Election of Species [R–38]

Where only generic claims are first presented and prosecuted in an application in which no election of a single invention has been made, and applicant later presents species claims to more than one species of the invention he must at that time indicate an election of a single species. The practice of requiring election of species in cases with only generic claims of the unduly extensive and burdensome search type is set forth in § 808.01(a).

818.02(c) By Optional Cancellation of Claims

Where applicant is claiming two or more inventions (which may be species or various types of related inventions) and as a result of action on the claims he cancels the claims to one or more of such inventions, leaving claims to one invention, and such claims are acted upon by the examiner, the claimed invention thus acted upon is elected.

818.03 Express Election and Traverse

Rule 143. Reconsideration of requirement. If the applicant disagrees with the requirement for restriction, he may request reconsideration and withdrawal or modification of the requirement, giving the reasons therefor (see rule 111). 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 restriction will be reconsidered on such a request. If the requirement is repeated and made final, the examiner will at the same time act on the claims to the invention elected.

Election in response to a requirement may be made either with or without an accompanying traverse of the requirement.

818.03(a) Response Must Be Complete

As shown by the first sentence of rule 143, the traverse to a requirement must be complete as required by rule 111(b) which reads in part: "In order to be entitled to reexamination or reconsideration, the *applicant must make request therefor in writing*, and he *must distinctly and specifically point out the supposed errors* in the examiner's action; the applicant *must respond to every ground* of objection and rejection of the prior office action_____ and the applicant's action *must appear throughout to be a bona fide attempt to advance the case to final action.* The *mere allegation* that the examiner has erred will not be received as a proper reason for such reexamination or reconsideration."

Under this rule, the applicant is required to specifically point out the reasons on which he bases his conclusion that a requirement to restrict is in error. A mere broad allegation that the requirement is in error does not comply with the requirement of rule 111. Thus the required provisional election (See § 818.03(b)) becomes an election without traverse.

818.03(b) Must Elect, Even When Requirement Is Traversed [R–18]

As noted in the second sentence of rule 143, a provisional election must be made even though the requirement is traversed.

All requirements should have as a concluding paragraph a sentence stating in substance:

> "Applicant is advised that his response to be complete must include an election consonant with the requirement, see rule 143."

The suggested concluding statement should be reworded to fit the facts of the particular requirement, e.g., as in § 809.02(a) second form paragraph under (3).

818.03(c) Must Traverse To Preserve Right of Petition

Rule 144. Petition from requirement for restriction. After a final requirement for restriction, the applicant, in addition to making any response due on the remainder of the action, may petition the Commissioner to review the requirement. Petition may be deferred until after final action on or allowance of claims to the invention elected, but must be filed not later than appeal. A petition will not be considered if reconsideration of the requirement was not requested. (See rule 181.)

818.03(d) Traverse of Non-Allowance of Linking Claims [R–18]

A traverse of the non-allowance of the linking claims is not a traverse of the requirement to restrict, it is a traverse of a holding of non-allowance.

Election combined with a traverse of the non-allowance of the linking claims only is an agreement with the position taken by the Office that restriction is proper if the linking type claim is not allowable and improper if they are allowable. 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 rule 144 would not apply*, since the record would be one of agreement as to the propriety of restriction.

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 restriction, *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 product limited by the process of making it. The traverse may set forth particular reasons justifying the conclusion that restriction 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 restriction is made final in spite of such traverse, the right to petition is preserved even though all linking claims are canceled.

818.03(e) Applicant Must Make His Own Election

Applicant must make his own election. The examiner will not make the election for him, rule 142, rule 143, second sentence.

819 Office Generally Does Not Permit Shift

The general policy of the Office is not to permit the applicant to shift to claiming another invention after an election is once made and action given on the elected subject matter. When claims are presented which the examiner holds are drawn to an invention other than elected he should treat the claims as outlined in § 821.03.

Where the inventions are distinct and of such a nature that the Office compels restriction, an election is not waived even though the examiner gives action upon the patentability of the claims to the non-elected invention, Ex parte Loewenbach 1904 C.D. 170, 110 O.G. 857, and In re Waugh 1943 C.D. 411; 553 O.G. 3 (CCPA).

819.01 Office May Waive Election and Permit Shift [R–38]

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. It may do so where the shift results in no additional work or expense, and particularly where the shift reduces work as by simplifying the issues (Ex parte Heritage Pat. No. 2,375,414 decided January 26, 1944). If the examiner has accepted a shift from claiming one invention to claiming another, the case is not abandoned (Meden v. Curtis, 1905 C.D. 272; 117 O.G. 1795).

820 Not an Election; Permissible Shift

Where the Office rejects on the ground that the process is obvious, the only invention being in the product made, presenting claims to the product is not a shift (Ex parte Trevette, 1901 C.D. 170; 97 O.G. 1173).

Product elected—no shift where examiner holds invention to be in process (Ex parte Grier, 1923 C.D. 27; 309 O.G. 223).

Genus allowed, applicant may elect up to four additional species thereunder, in accordance with Rule 141, this not constituting a shift (Ex parte Sharp et al., Patent No. 2,232,739).

820.01 Old Combination Claimed—Not an Election [R–45]

Where an application originally presents claims to a combination (AB), the examiner holding the novelty if any, to reside in the subcombination (B) per se only (see § 806.05(b)), and these claims are rejected on the ground of "old combination," subsequently presented claims to subcombination (B) of the originally claimed combination should not be rejected on the ground of previous election of the combination, nor should this rejection be applied to such combination claims if they are reasserted. Ex parte Donnell, 1923 C.D. 54. Final rejection of the reasserted "old combination" claims is the action that should be taken. The combination and subcombination as defined by the claims under this special situation are not for distinct inventions. (See § 806.05(c).) See also § 706.03(j).

820.02 Interference Issues—Not an Election

Where an interference is instituted prior to an applicant's election, the subject matter of the interference issues is not elected. An applicant may, after the termination of the in-

terference, elect any one of the inventions that he claimed.

821 Treatment of Claims Held to be Drawn to Non-Elected Inventions [R–45]

Claims held to be drawn to non-elected inventions, including claims to non-elected species, are treated as indicated in §§ 821.01 through 821.03. However, for treatment of claims held to be drawn to species non-elected without traverse in applications not ready for issue (where such holding is not challenged), see §§ 809.02(c) through 809.02(e).

The propriety of a requirement to restrict, if traversed, is reviewable by petition under rule 144. In re Hengehold, 169 USPQ 473.

All claims that the examiner holds are not directed to the elected subject matter should be withdrawn from further consideration by the examiner as set forth in § 809.02(c) and §§ 821.01 through 821.03. As to one or more of such claims the applicant may traverse the examiner's holding that they are not directed to the elected subject matter. The propriety of this holding, if traversed, is *appealable*. Thus, if the examiner adheres to his position after such traverse, he should *reject* the claims to which the traverse applies on the ground that they are not directed to the elected subject matter.

821.01 After Election With Traverse [R–26]

Where the initial requirement is traversed, it should be reconsidered. If, upon reconsideration, the examiner is still of the opinion that restriction is proper he shall repeat and make final the requirement in the next Office action. (See § 803.01). In doing so, the examiner should reply to the reasons or argument advanced by applicant in his traverse. If the examiner, upon reconsideration, is of the opinion that the requirement for restriction is improper he should state in the next Office action that the requirement for restriction is withdrawn and give an action on all the claims.

If the requirement is repeated and made final, in that and in each subsequent action, the claims to the nonelected invention should be treated substantially as follows:

"Claims _____ stand withdrawn from further consideration by the examiner, rule 142(b), as being for a nonelected invention (or species), the requirement having been traversed in paper No. _____."

This will show that applicant has retained the right to petition from the requirement under rule 144. (See § 818.03(c).)

When the case is otherwise ready for issue, and has not received a final action, the examiner should treat the case substantially as follows:

"Claims _____ stand allowed.

"This application is in condition for allowance except for the presence of claims _____ to an invention (or species) nonelected with traverse in paper No. _____. Applicant is given one month from the date of this letter to cancel the noted claims or take other appropriate action (rule 144). Failure to take action during this period will be treated as authorization to cancel the nonelected claims by examiner's amendment and pass the case for issue.

"The prosecution of this case is closed except for consideration of the above matter."

When preparing a final action in an application where there has been a traversal of a requirement for restriction, the examiner should indicate in his action that a complete response must include cancellation of the claims drawn to the non-elected invention, or other appropriate action (rule 144). Where a response to a final action has otherwise placed the application in condition for allowance, the failure to cancel claims drawn to the non-elected invention or to take appropriate action will be construed as authorization to cancel these claims by examiner's amendment and pass the case to issue after the expiration of the period for response.

Note that the petition under rule 144 must be filed "not later than appeal". This is construed to mean appeal to the Board of Appeals. If the case is ready for allowance *after* appeal and no petition has been filed, the examiner should simply cancel the non-elected claims by examiner's amendment, calling attention to the provisions of rule 144.

821.02 After Election Without Traverse

Where the initial requirement is not traversed, if adhered to, appropriate action should be given on the elected claims and the claims to the nonelected invention should be treated substantially as follows:

"Claims _____ stand withdrawn from further consideration by the examiner, rule 142(b), as being for a nonelected invention (or species). Election was made *without* traverse in paper No. _____."

This will show that applicant has *not* retained the right to petition from the requirement under rule 144.

Under these circumstances, when the case is otherwise ready for issue, the claims to the nonelected invention, including nonelected species, may be canceled by an examiner's amendment, and the case passed for issue. The examiner's amendment should state in substance:

"In view of the fact that this application is in condition for allowance except for the presence of claims _____ to an invention (or species) nonelected without traverse in paper No. _____, these claims have been canceled."

821.03 Claims for Different Invention Added After an Office Action [R–26]

Claims added by amendment following action by the examiner, §§ 818.01, 818.02(a), to an invention other than previously claimed, should be treated as indicated by rule 145.

Rule 145. Subsequent presentation of claims for different invention. If, after an office action on an application, the applicant presents claims directed to an invention distinct from and independent of the invention previously claimed, the applicant will be required to restrict the claims to the invention previously claimed if the amendment is entered, subject to reconsideration and review as provided in rules 143 and 144.

The action should take substantially the following form:

"I. Claims _____ are directed to _____ (identify the invention) elected by _____ (indicate how the invention was elected, as by original presentation of claims, election with (or without) traverse in paper No. _____, etc.) and applicant has received an action on such claims.

II. Claims _____ are for _____ (identify invention, give factual showing of reasons why, as claimed, it is distinct from elected invention, show separate classification or status, etc., i.e., make complete showing of propriety of requirement in manner similar to an original requirement).

Applicant is required to restrict the claims to the invention previously elected, and thus the claims of group II are held withdrawn from further consideration by the examiner by the prior election, rule 142(b)."

Of course, a complete action on all claims to the elected invention should be given.

Note that the above practice is intended to have no effect on the practice stated in § 1101.01.

An amendment canceling all claims drawn to the elected invention and presenting only claims drawn to the non-elected invention should not be entered. Such an amendment is non-responsive. Applicant should be notified as directed in §§ 714.03 and 714.05.

822 Claims to Inventions That Are Not Distinct in Plural Applications of Same Incentive Entity [R–29]

The treatment of plural applications of the *same inventive entity*, none of which has become a patent, is treated in rule 78 as follows:

(b) Where two or more applications filed by the same applicant contain conflicting claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in more than one application.

See § 304 for conflicting subject matter in two applications, same inventive entity, one assigned.

See §§ 305 and 804.03 for conflicting subject matter, different inventors, common ownership.

See § 706.03(k) for rejection of one claim on another in the same application.

See §§ 706.03(w) and 706.07(b) for res judicata.

See § 709.01 for one application in interference.

See §§ 806.04(h) to 806.04(j) for species and genus in separate applications.

Wherever appropriate, such conflicting applications should be joined. This is particularly true, where the two or more applications are due to, and consonant with, a requirement to restrict which the examiner now considers to be improper.

822.01 Co-pending Before the Examiner [R–26]

Under rule 78(b) the practice relative to overlapping claims in applications copending before the examiner (and not the result of and consonant with a requirement to restrict, for which see § 804.01), is as follows:

Where claims in one application are unpatentable over claims of another application of the same inventive entity because they recite the same invention, a complete examination should be made of the claims of one application. The claims of the other application may be rejected on the claims of the one examined, *whether the claims of the one examined are allowed or not.*

In aggravated situations no other rejection need be entered on the claims held unpatentable over the claims of the other application. However, any additional claims in the one application that are not rejected on the claims of the other should be fully treated.