Chapter 800 Restriction in Applications Filed Under 35 U.S.C. 111; Double Patenting

801 Introduction

This chapter is limited to a discussion of the subject of restriction and double patenting under U.S.C. Title 35 and the Rules of Practice as it relates to national applications filed under 35 U.S.C. 111. The discussion of unity of invention under the Patent Cooperation Treaty Articles and Rules as it is applied as an International Searching Authority, International Preliminary Examining Authority, and in applications entering the National Stage under 35 U.S.C. 371 as a Designated or Elected Office in the Patent and Trademark Office is covered in Chapter 1800.

802 Basis for Practice in Statute and Rules

The basis for restriction and double patenting practices 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.

37 CFR 1.141. Different inventions in one application.

(a) Two or more independent and distinct inventions may not be claimed in one national application, except that more than one species of an invention, not to exceed a reasonable number, may be specifically claimed in different claims in one national application, provided that application also includes an allowable claim generic to all the claimed species and all the claims to species in excess of one are written in dependent form (§ 1.75) or otherwise include all the limitations of the generic claim.

(b) Where claims to all three categories, product, process of making and process of use, are included in a national application, a three way requirement for restriction can only be made where the process of making is distinct from the product. If the process of making and the product are not distinct, the process of using may be joined with the claims directed to the product and the process of making the product even though a showing of distinctness between the product and process of using the product can be made.

37 CFR 1.142. 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 claim 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.

The pertinent Patent Cooperation Treaty (PCT) articles and rules are cited and discussed in Chapter 1800. Sections 1868, 1898.02(b) and 1898.07(c) should be consulted for discussions on unity of invention: (1) before the International Searching Authority, (2) the International Preliminary Examining Authority, and (3) the National Stage under 35 U.S.C. 371.

802.01 Meaning of "Independent" and "Distinct"

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 37 CFR 1.141, 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 35 U.S.C. 121: "enacts as law existing practice with re-

spect 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 subjects, 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 "independent", 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 (novel and unobvious) 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

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, and election of species.

803 Restriction – When Proper

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 (MPEP § 806.04 – § 806.04(j)) or distinct MPEP § 806.05 – § 806.05(i)).

This is true where two or more of the 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).

In applications containing claims of that nature, the examiner may require a provisional election of a single species prior to examination on the merits. The provisional election will be given effect in the event that the Markush–type claim should be found not allowable. Following election, the Markush–type claim will be examined fully with respect to the elected species and further to the extent necessary to determine patentability. Should the Markush–type claim be found not allowable, examination will be limited to the Markush–type claim and claims to the elected species, with claims drawn to species patentably distinct from the elected species held withdrawn from further consideration.

As an example, in the case of an application with a Markush–type claim drawn to the compound C–R,

wherein R is a radical selected from the group consisting of A, B, C, D, and E, the examiner may require a provisional election of a single species, CA, CB, CC, CD, or CE. The Markush-type claim would then be examined fully with respect to the elected species and any species considered to be clearly unpatentable over the elected species. If on examination the elected species is found to be anticipated or rendered obvious by prior art, the Markush-type claim and claims to the elected species shall be rejected, and claims to the non-elected species would be held withdrawn from further consideration. As in the prevailing practice, a second action on the rejected claims would be made final.

On the other hand, should no prior art be found that anticipates or renders obvious the elected species, the search of the Markush-type claim will be extended. If prior art is then found that anticipates or renders obvious the Markush-type claim with respect to a non-elected species, the Markush-type claim shall be rejected and claims to the non-elected species held withdrawn from further consideration. The prior art search, however, will not be extended unnecessarily to cover all non-elected species. Should applicant, in response to this rejection of the Markush-type claim, overcome the rejection, as by amending the Markush-type claim to exclude the species anticipated or rendered obvious by the prior art, the amended Markush-type claim will be reexamined. The prior art search will be extended to the extent necessary to determine patentability of the Markush-type claim. In the event prior art is found during the reexamination that anticipates or renders obvious the amended Markush-type claim, the claim will be rejected and the action made final. Amendments submitted after the final rejection further restricting the scope of the claim will not be entered.

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 all claims on the merits, even though they are directed to independent and distinct inventions. In such a case, the examiner will not follow the above procedure and will not require restriction.

If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to distinct or independent inventions.

CRITERIA FOR RESTRICTION BETWEEN PATENTABLY DISTINCT INVENTIONS

There are two criteria for a proper requirement for restriction between patentably distinct inventions:

(1) The inventions must be independent (see MPEP § 802.01, § 806.04, § 808.01) or distinct as claimed (see MPEP § 806.05 – § 806.05(i)); and

(2) There must be a serious burden on the examiner if restriction is not required (see MPEP § 803.02 § 806.04(a)–(j), § 808.01(a) and § 808.02).

GUIDELINES

Examiners must provide reasons and/or examples to support conclusions, but need not cite documents to support the requirement in most cases.

Where plural inventions are capable of being viewed as related in two ways, both applicable criteria for distinctness must be demonstrated to support a restriction requirement.

If there is an express admission that the claimed inventions are obvious over each other within the meaning of 35 U.S.C. 103, restriction should not be required, *In re Lee,* 199 USPQ 108 (Deputy Asst. Comm'r. for Pats 1978).

For purposes of the initial requirement, a serious burden on the examiner may be *prima facie* shown if the examiner shows by appropriate explanation either separate classification, separate status in the art, or a different field of search as defined in MPEP § 808.02. That *prima facie* showing may be rebutted by appropriate showings or evidence by the applicant. Insofar as the criteria for restriction practice relating to Markush-type claims is concerned, the criteria is set forth in MPEP § 803.02. Insofar as the criteria for restriction or election practice relating to claims to genus-species, see MPEP § 806.04(a) – (j) and MPEP § 808.01(a).

803.01 Review by Primary Examiner

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.

803.02 Restriction — Markush Claims

PRACTICE RE MARKUSH–TYPE CLAIMS

Since the decisions in *In re Weber et al.*, 198 USPQ 328 (CCPA 1978); and *In re Haas*, 198 USPQ 334 (CCPA 1978), it is improper for the Office to refuse to examine that which applicants regard as their invention, unless the subject matter in a claim lacks unity of invention, *In re Harnish*, 631 F.2d 716, 206 USPQ 300 (CCPA 1980); *Ex Parte Hozumi*, 3 USPQ 2d 1059 (Bd. Pat. App. & Int. 1984). Broadly, unity of invention exists where compounds included within a Markush group (1) share a common utility and (2) share a substantial structural feature disclosed as being essential to that utility.

This subsection deals with Markush–type generic claims which include a plurality of alternatively usable substances or members. In most cases, a recitation by enumeration is used because there is no appropriate or true generic language. In many cases, the Markush–type claims include independent and distinct inventions. This is true where two or more of the 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).

In applications containing claims of that nature, the examiner may require a provisional election of a single species prior to examination on the merits. The provisional election will be given effect in the event that the Markush–type claim should be found not allowable. Following election, the Markush–type claim will be examined fully with respect to the elected species and further to the extent necessary to determine patentability. Should the Markush–type claim be found not allowable, examination will be limited to the Markush–type claim and claims to the elected species, with claims drawn to species patentably distinct from the elected species held withdrawn from further consideration.

As an example, in the case of an application with a Markush–type claim drawn to the compound C–R, wherein R
is a radical selected from the group consisting of A, B, C, D, and E, the examiner may require a provisional election of a single species, CA, CB, CC, CD, or CE. The Markush–type claim would then be examined fully with respect to the elected species and any species considered to be clearly unpatentable over the elected species. If on examination the elected species is found to be anticipated or rendered obvious by prior art, the Markush–type claim and claims to the elected species shall be rejected, and claims to the non–elected species would be held withdrawn from further consideration. As in the prevailing practice, a second action on the rejected claims would be made final.

On the other hand, should no prior art be found that anticipates or renders obvious the elected species, the search of the Markush–type claim will be extended. If prior art is then found that anticipates or renders obvious the Markush–type claim with respect to a *non–elected species,* the Markush–type claim shall be rejected and claims to the non–elected species held withdrawn from further consideration. The prior art search, however, will not be extended unnecessarily to cover all non–elected species. Should applicant, in response to this rejection of the Markush–type claim, overcome the rejection, as by amending the Markush–type claim to exclude the species anticipated or rendered obvious by the prior art, the amended Markush–type claim will be reexamined. The prior art search will be extended to the extent necessary to determine patentability of the Markush–type claim. In the event prior art is found during the reexamination that anticipates or renders obvious the amended Markush–type claim, the claim will be rejected and the action made final. Amendments submitted after the final rejection further restricting the scope of the claim may be denied entry.

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 must examine all claims on the merits, even though they are directed to independent and distinct inventions. In such a case, the examiner will not follow the above procedure and will not require restriction.

>803.03 Restriction — Transitional Applications [R-1]

PRACTICE RE TRANSITIONAL APPLICATION

37 CFR 1.129. Transitional procedures for limited examination after final rejection and restriction practice.

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(b)(1) In an application, other than for reissue or a design patent, that has been pending for at least three years as of June 8, 1995, taking into account any reference made in the application to any earlier filed application under 35 U.S.C. 120, 121 and 365(c), no requirement for restriction or for the filing of divisional applications shall be made or maintained in the application after June 8, 1995, except where:

(i) the requirement was first made in the application or any earlier filed application under 35 U.S.C. 120, 121 and 365(c) prior to April 8, 1995;

(ii) the examiner has not made a requirement for restriction in the present or parent application prior to April 8, 1995, due to actions by the applicant; or

(iii) the required fee for examination of each additional invention was not paid.

(2) If the application contains more than one independent and distinct invention and a requirement for restriction or for the filing of divisional applications cannot be made or maintained pursuant to this paragraph, applicant will be so notified and given a time period to:

(i) elect the invention or inventions to be searched and examined, if no election has been made prior to the notice, and pay the fee set forth in 1.17(s) for each independent and distinct invention claimed in the application in excess of one which applicant elects;

(ii) confirm an election made prior to the notice and pay the fee set forth in § 1.17(s) for each independent and distinct invention claimed in the application in addition to the one invention which applicant previously elected; or

(iii) file a petition under this section traversing the requirement. If the required petition is filed in a timely manner, the original time period for electing and paying the fee set forth in § 1.17(s) will be deferred and any decision on the petition affirming or modifying the requirement will set a new time period to elect the invention or inventions to be searched and examined and to pay the fee set forth in § 1.17(s) for each independent and distinct invention claimed in the application in excess of one which applicant elects.

(3) The additional inventions for which the required fee has not been paid will be withdrawn from consideration under § 1.142(b). An applicant who desires examination of an invention so withdrawn from consideration can file a divisional application under 35 U.S.C. 121.

(c) The provisions of this section shall not be applicable to any application filed after June 8, 1995.

"Restriction" under 37 CFR 1.129(b) applies to both restriction requirements under 37 CFR 1.142 and election of species requirements under 37 CFR 1.146.

Section 1.129(b)(1) provides for examination of more than one independent and distinct invention in certain applications pending for 3 years or longer as of June 8, 1995, taking into account any reference to any earlier application under 35 U.S.C. 120, 121, or 365(c). Applicant will not be permitted to have such additional invention(s) examined in an application if:

(1) The requirement was made in the application or in an earlier application relied on under 35 U.S.C. 120, 121, or 365(c) prior to April 8, 1995;

(2) no restriction requirement was made with respect to the invention(s) in the application or earlier application prior to April 8, 1995, due to actions by the applicant; or

(3) the required fee for examination of each additional invention was not paid.

Only if one of these exceptions applies, is a normal restriction requirement appropriate and telephone restriction practice may be used.

Examples of what constitute "actions by the applicant" in 37 CFR 1.129(b)(1) are:

(1) applicant abandoned the application and continued to refile the application such that no Office action could be issued in the application,

(2) applicant requested suspension of prosecution under 37 CFR 1.103(a) such that no Office action could be issued in the application,

(3) applicant disclosed a plurality of independent and distinct inventions in the present or parent application, but delayed presenting claims to more than one of the disclosed independent and distinct inventions in the present or parent application such that no restriction requirement could be made prior to April 8, 1995, and

(4) applicant combined several applications, each of which claimed a different independent and distinct invention, into one large "continuing" application, but delayed filing the continuing application first claiming more than one independent and distinct invention such that no restriction requirement could be made prior to April 8, 1995.

In examples (1) and (2), the fact that the present or parent application claiming independent and distinct inventions was on an examiner's docket for at least three months prior to abandonment or suspension, or in examples (3) and (4), the fact that the amendment claiming independent and distinct inventions was first filed, or the continuing application first claiming the additional independent and distinct inventions was on an examiner's docket, at least three months prior to April 8, 1995, is *prima facie* evidence that applicant's actions did not pre-

vent the Office from making a requirement for restriction with respect to those independent and distinct inventions prior to April 8, 1995. Furthermore, an extension of time under 37 CFR 1.136(a) does not constitute such "actions by the applicant" under 37 CFR 1.129(b)(1).

NOTE: If an examiner believes an application falls under the exception that no restriction could be made prior to April 8, 1995 due to applicant's action, the application must be brought to the attention of the Group Expert for review.

Under 37 CFR 1.129(b)(2), if the application contains claims to more than one independent and distinct invention, and no requirement for restriction or for the filing of divisional applications can be made or maintained, applicant will be notified and given a time period to:

(i)elect the invention or inventions to be searched and examined, if no election has been made prior to the notice, and pay the fee set forth in 37 CFR 1.17(s) for each independent and distinct invention claimed in the application in excess of one which applicant elects,

(ii) in situations where an election was made in response to a requirement for restriction that cannot be maintained, confirm the election made prior to the notice and pay the fee set forth in 37 CFR 1.17(s) for each independent and distinct invention claimed in the application in addition to the one invention which applicant previously elected, or

(iii) file a petition under 37 CFR 1.129(b)(2) traversing the requirement without regard to whether the requirement has been made final. No petition fee is required. 37 CFR 1.129(b)(2) also provides that if the petition is filed in a timely manner, the original time period for electing and paying the fee set forth in 37 CFR 1.17(s) will be deferred and any decision on the petition affirming or modifying the requirement will set a new time period to elect the invention or inventions to be searched and examined and to pay the fee set forth in 37 CFR 1.17(s) for each independent and distinct invention claimed in the application in excess of one which applicant elects.

Under 37 CFR 1.129(b)(3), each additional invention for which the required fee set forth in 37 CFR 1.17(s) has not been paid will be withdrawn from consideration under 37 CFR 1.142(b). An applicant who desires examination of an invention so withdrawn from consideration can file a divisional application under 35 U.S.C. 121.

Section 1.129(c) clarifies that the provisions of 37 CFR 1.129(a) and (b) are not applicable to any application filed after June 8, 1995. However, any application filed on June 8, 1995, would be subject to a 20−year patent term.

Form paragraph 8.41 may be used to notify applicant that application is a transitional application and is entitled to consideration of additional inventions upon payment of the required fee.

¶ *8.41 Transitional Restriction or Election of Species Requirement to be Mailed After June 8, 1995*

This application is subject to the transitional restriction provisions of Public Law 103−465, which became effective on June 8, 1995, because:

1. the application was filed on or before June 8, 1995, and has an effective U.S. filing date of June 8, 1992, or earlier;

2. a requirement for restriction was not made in the present or a parent application prior to April 8, 1995; and

3. the examiner was not prevented from making a requirement for restriction in the present or parent application prior to April 8, 1995, due to actions by the applicant.

The transitional restriction provisions permit applicant to have more than one independent and distinct invention examined in the same application by paying a fee for each invention in excess of one.

Final rules concerning the transition restriction provisions were published in the *Federal Register* at 60 FR 20195 (April 25, 1995) and in the *Official Gazette* at 1174 OG 15 (May 2, 1995). The final rules at 37 CFR 1.17(s) include the fee amount required to be paid for each additional invention as set forth in the following requirement for restriction.

Applicant must either: (1) elect the invention or inventions to be searched and examined and pay the fee set forth in 37 CFR 1.17(s) for each independent and distinct invention in excess of one which applicant elects; or (2) file a petition under 37 CFR 1.129(b) traversing the requirement.

Examiner Note:

1. This paragraph should be used in all restriction or election of species requirements made in applications subject to the transition restriction provisions set forth in 37 CFR 1.129(b) where the requirement is being mailed after June 8, 1995. The procedure is NOT applicable to any design or reissue application.

2. This paragraph should be followed by form paragraph(s) 8.01, 8.02 or 8.08−8.22, as appropriate.<

>803.03(a) Transitional Application — Linking Claim Allowable [R−1]

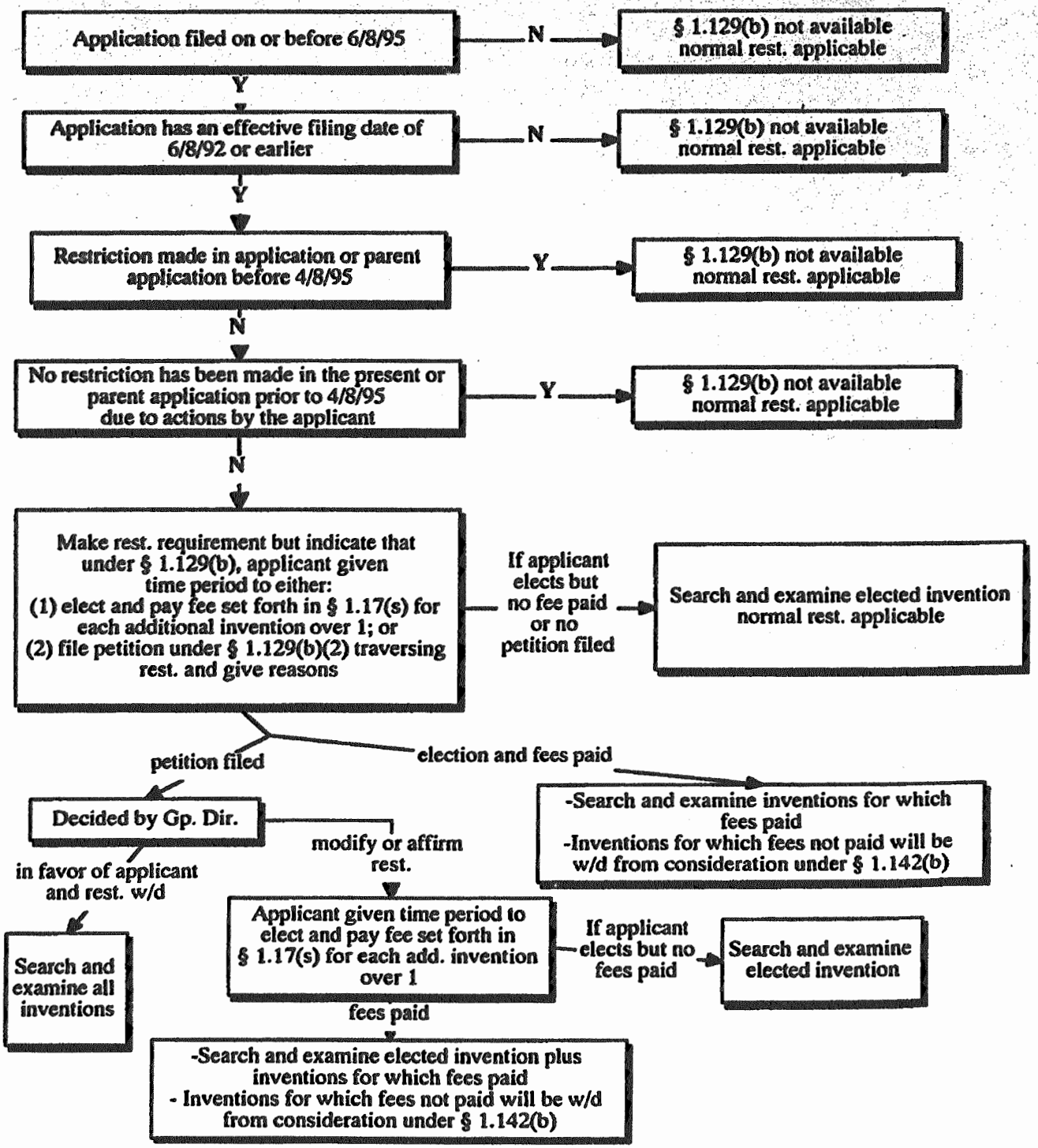
Whenever divided inventions in a transitional application are rejoined because a linking claim is allowed (MPEP § 809) and applicant paid the fee set forth in 37 CFR 1.17(s) for the additional invention, applicant should be notified that he or she may request a refund of the fee paid for that additional invention.<

>803.03(b) Transitional Application — Generic Claim Allowable [R-1]

Whenever claims drawn to an additional species in a transitional application for which applicant paid the fee set forth in 37 CFR 1.17(s) are no longer withdrawn because they are fully embraced by an allowed generic claim, applicant should be notified that he or she may request a refund of the fee paid for that additional species.

The determination of when claims to a non-elected species would no longer be withdrawn should be made as indicated in MPEP § 809.02(b), § 809.02(c), or § 809.02(d).<

Transitional Restriction Provision - 37 CFR 1.129(b)
Starting June 8,1995
No Telephone restriction
Charge time for examination of additional inventions to 112055



804 Definition of Double Patenting [R–1]

35 U.S.C. 101. Inventions Patentable

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title.

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 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.

The doctrine of double patenting seeks to prevent the unjustified extension of patent exclusivity beyond the ** term of a patent. The public policy behind this doctrine is that:

> The public should . . . be able to act on the assumption that upon the expiration of the patent it will be free to use not only the invention claimed in the patent but also modifications or variants which would have been obvious to those of ordinary skill in the art at the time the invention was made, taking into account the skill in the art and prior art other than the invention claimed in the issued patent.

In re Zickendraht, 319 F.2d 225, 232, 138 USPQ 22, 27 (CCPA 1963) (Rich, J., concurring). Double patenting results when the right to exclude granted by a first patent is unjustly extended by the grant of a later issued patent or patents. *In re Van Ornum,* 686 F.2d 937, 214 USPQ 761 (CCPA 1982).

Before consideration can be given to the issue of double patenting, there must be some common relationship of inventorship and/or ownership of two or more patents or applications. Since the doctrine of double patenting seeks to avoid unjustly extending patent rights at the expense of the public, the focus of any double patenting analysis necessarily is on the claims in the multiple patents or patent applications involved in the analysis.

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". The second is the "nonstatutory–type" double patenting rejection based on a judicially created doctrine grounded in public policy and which is primarily intended to prevent prolongation of the patent term by prohibiting claims in a second patent not patentably distinguishing from claims in a first patent. Nonstatutory double patenting includes one–way obviousness, two–way obviousness and nonobviousness rejections.

Refer to Charts I–A, I–B, II–A, and II–B for an overview of the treatment of applications having conflicting claims.

I. INSTANCES WHERE DOUBLE PATENTING ISSUE CAN BE RAISED

A double patenting issue can arise between two or more pending applications, between one or more pending applications and a patent, or in a reexamination proceeding. Double patenting does not relate to international applications which have not yet entered the national stage in the United States.

A. BETWEEN ISSUED PATENT AND ONE OR MORE APPLICATIONS

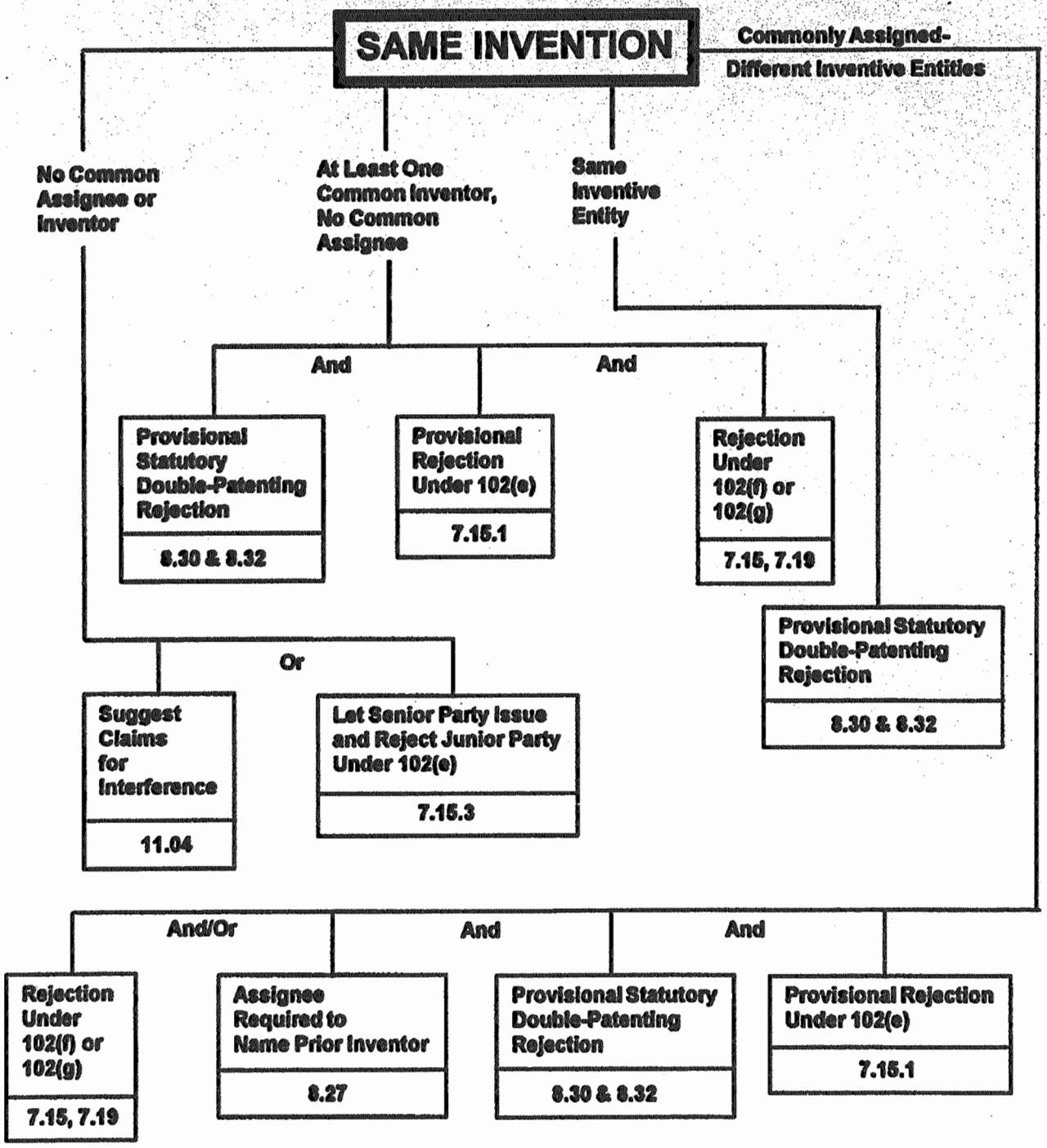
Double patenting may exist between an issued patent and an application filed by the same inventive entity, or by an inventive entity having a common inventor with the patent, and/or by the owner of the patent. Since the inventor/patent owner has already secured the issuance of a first patent, the examiner must determine whether the grant of a second patent would give rise to an unjustified extension of the rights granted in the first patent.

B. BETWEEN COPENDING APPLICATIONS — PROVISIONAL REJECTIONS

Occasionally, the examiner becomes aware of two copending applications filed by the same inventive entity, or by different inventive entities having a common inventor, and/or that are filed by a common assignee that would raise an issue of double patenting if one of the applications became a patent. Where this issue can be addressed without violating the confidential status of ap-

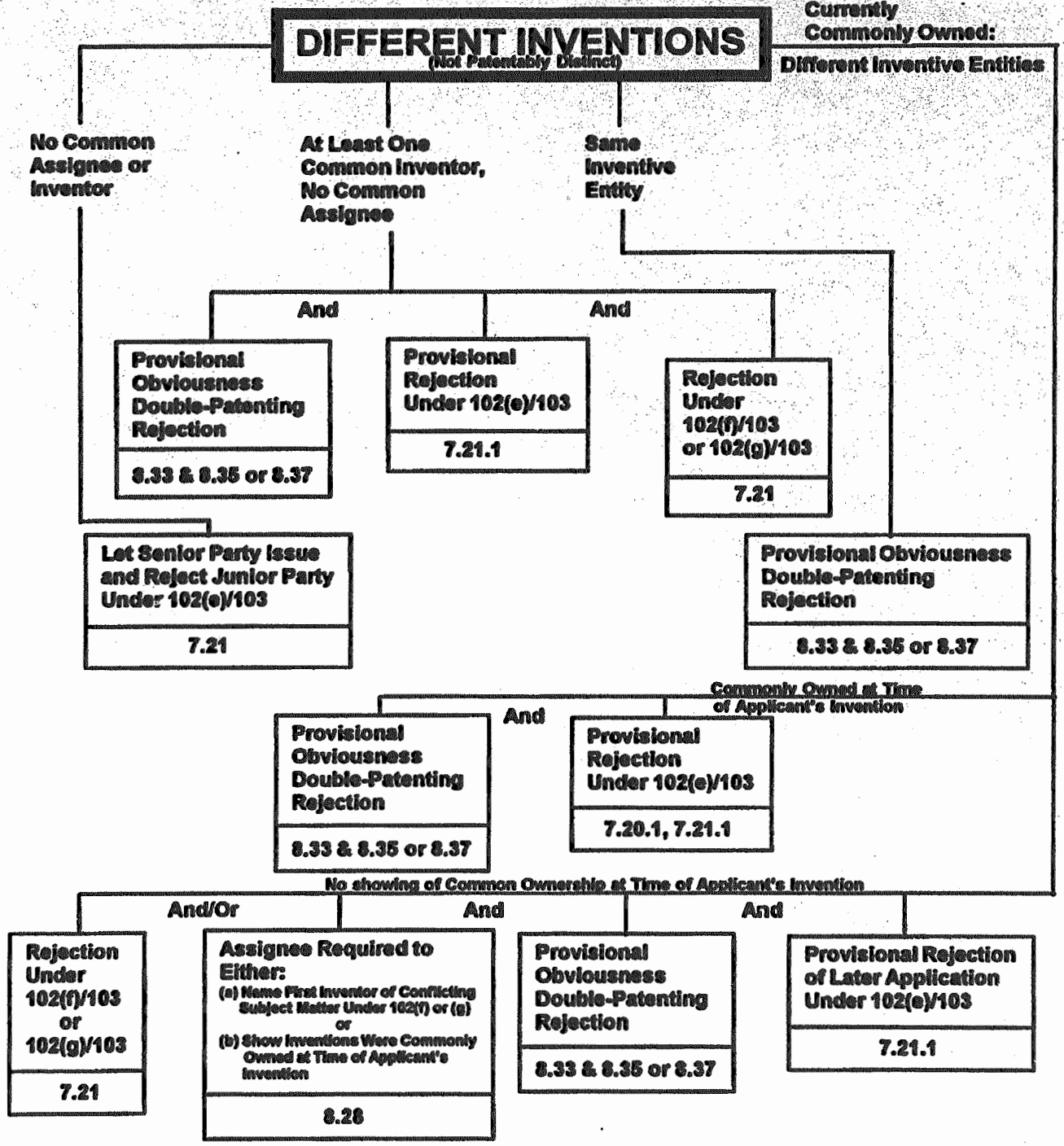
CONFLICTING CLAIMS BETWEEN: TWO APPLICATIONS

CHART I-A



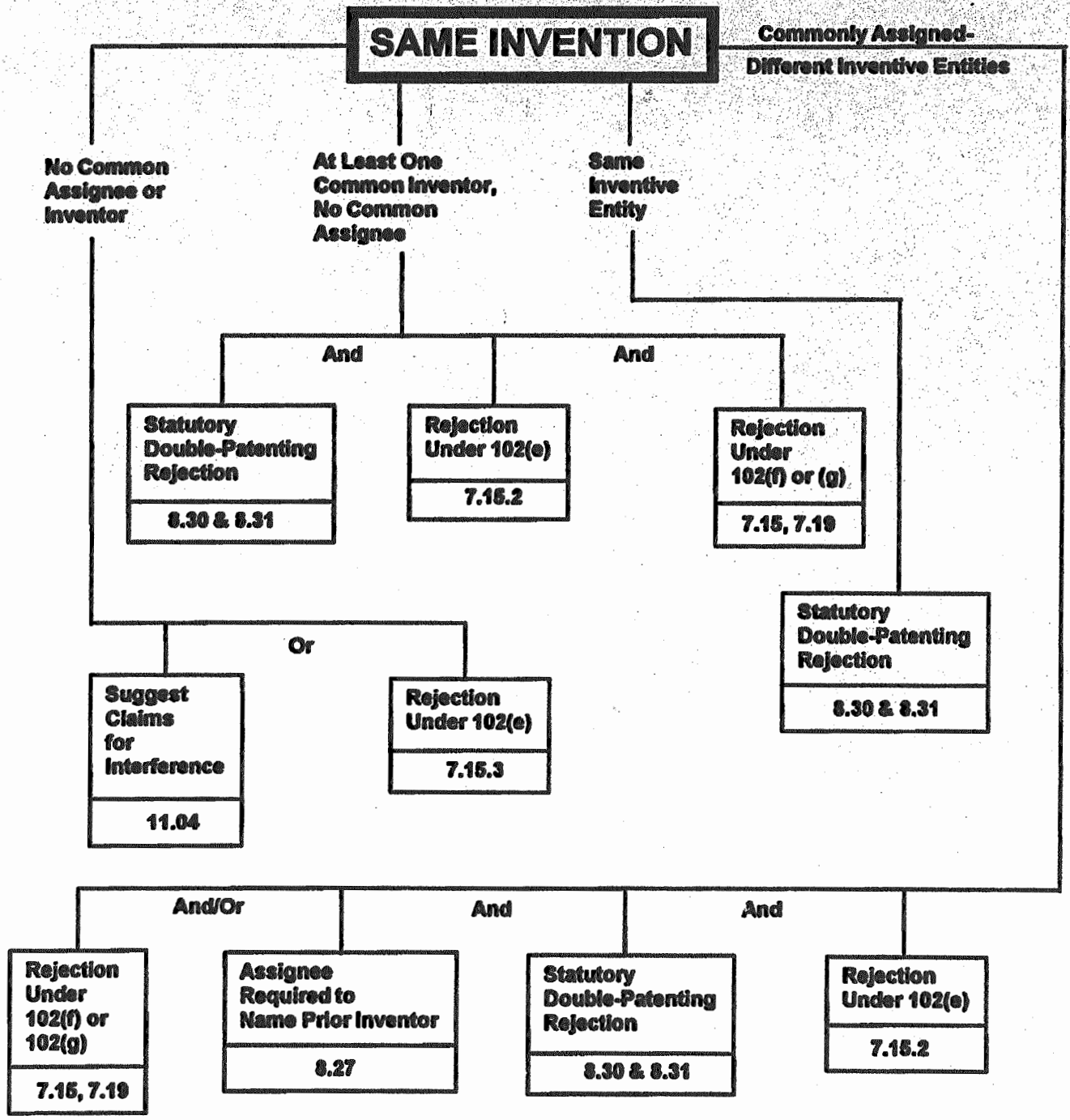
CONFLICTING CLAIMS BETWEEN: TWO APPLICATIONS

CHART I-B



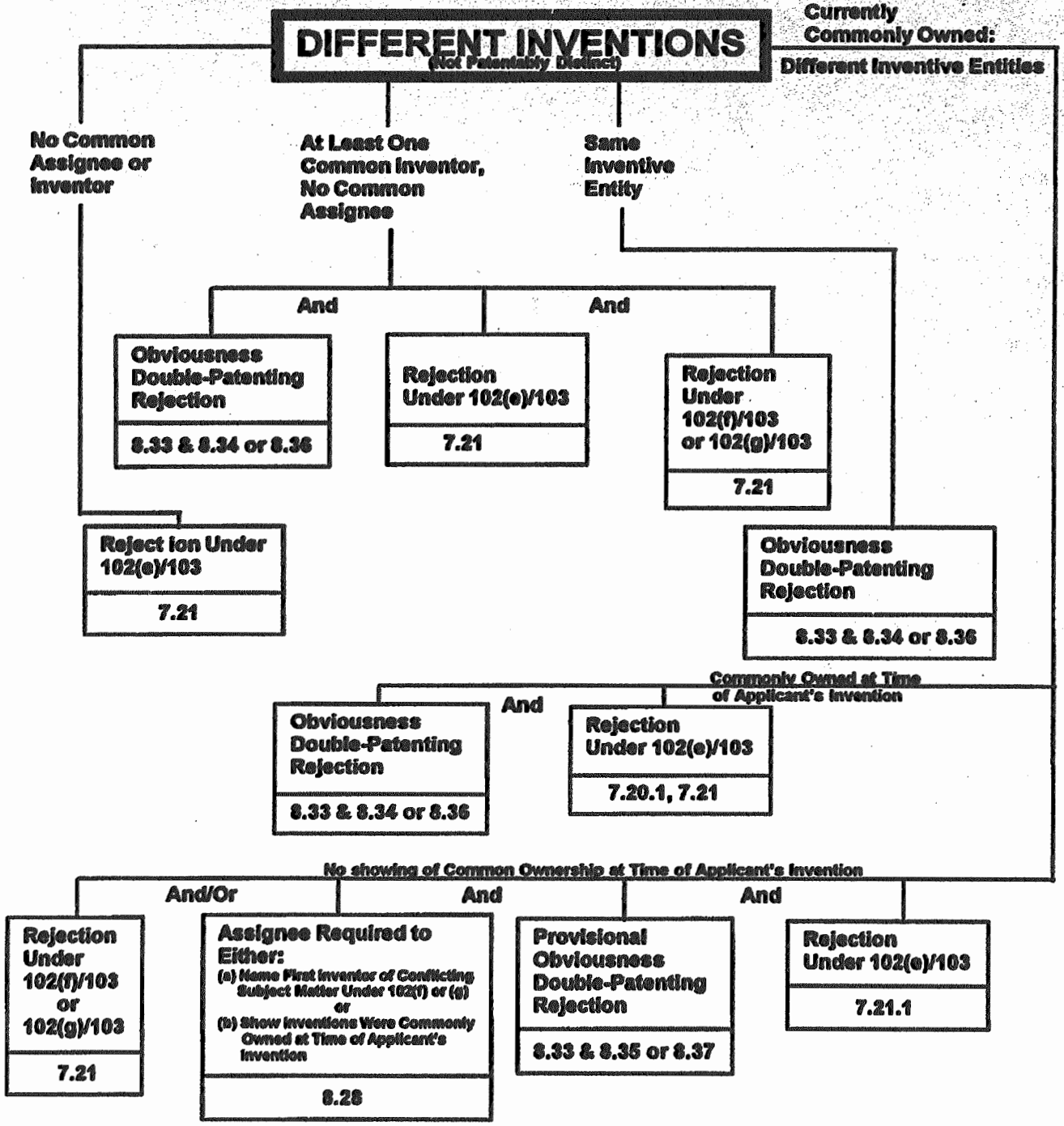
CONFLICTING CLAIMS BETWEEN: APPLICATION AND A PATENT

CHART II-A



CONFLICTING CLAIMS BETWEEN: APPLICATION AND A PATENT

CHART II-B



plications (35 U.S.C. 122), the courts have sanctioned the practice of making applicant aware of the potential double patenting problem if one of the applications became a patent by permitting the examiner to make a "provisional" rejection on the ground of double patenting. *In re Mott,* 539 F.2d 1291, 190 USPQ 536 (CCPA 1976); *In re Wetterau,* 148 USPQ 499 (CCPA 1966). The merits of such a provisional rejection can be addressed by both the applicant and the examiner without waiting for the first patent to issue.

The "provisional" double patenting rejection should continue to be made by the examiner in each application as long as there are conflicting claims in more than one application unless that "provisional" double patenting rejection is the only rejection remaining in one of the applications. If the "provisional" double patenting rejection in one application is the only rejection remaining in that application, the examiner should then withdraw that rejection and permit the application to issue as a patent, thereby converting the "provisional" double patenting rejection in the other application(s) into a double patenting rejection at the time the one application issues as a patent.

If the "provisional" double patenting rejections in both applications are the only rejections remaining in those applications, the examiner should then withdraw that rejection in one of the applications (e.g., the application with the earlier filing date) and permit the application to issue as a patent. The examiner should maintain the double patenting rejection in the other application as a "provisional" double patenting rejection which will be converted into a double patenting rejection when the one application issues as a patent.

C. REEXAMINATION PROCEEDINGS

A double patenting issue may be raised in a reexamination proceeding. *Ex parte Obiaya,* 227 USPQ 58 (Bd. Pat. App. & Inter. 1985) (Double patenting rejections are analogous to rejections under 35 U.S.C. 103 and depend on the presence of a prior patent as the basis for the rejection). Accordingly, a double patenting issue may properly be addressed in a reexamination proceeding. See MPEP 2258.

II. REQUIREMENTS OF A DOUBLE PATENTING REJECTION (INCLUDING PROVISIONAL REJECTIONS)

When a double patenting rejection is appropriate, it must be based either on statutory grounds or nonstatutory grounds. The ground of rejection employed depends upon the relationship of the inventions being claimed. Generally, a double patenting rejection is not permitted where the claimed subject matter is presented in a divisional application as a result of a restriction requirement made in a parent application under 35 U.S.C. 121.

Where the claims of an application are substantively the same as those of a first patent, they are barred under 35 U.S.C. 101 – the statutory basis for a double patenting rejection. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention", in this context, means an invention drawn to identical subject matter. *Miller* v. *Eagle Mfg. Co.,* 151 U.S. 186 (1894); *In re Ockert,* 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel,* 422 F.2d 438, 164 USPQ 619 (CCPA 1970). Where the claims of an application are not the "same" as those of a first patent, but the grant of a patent with the claims in the application would unjustly extend the rights granted by the first patent, a double patenting rejection under nonstatutory grounds is proper.

In determining whether a proper basis exists to enter a double patenting rejection, the examiner must determine —

(a) Whether a double patenting rejection is prohibited by the third sentence of 35 U.S.C. 121? See MPEP 804.01. If such a prohibition applies, a double patenting rejection cannot be made.

(b) Whether a statutory basis exists?

(c) Whether a nonstatutory basis exists?

Each determination must be made on the basis of all the facts in the case before the examiner. Charts I–A, I–B, II–A, and II–B illustrate the methodology of making such a determination.

Domination and double patenting should not be confused. They are two separate issues. One patent or application "dominates" a second patent or application when the first patent or application has a broad or gen-

eric claim which fully encompasses or reads on an invention defined in a narrower or more specific claim in another patent or application. Domination by itself; i.e., in the absence of statutory or nonstatutory double patenting grounds, cannot support a double patenting rejection. *In re Sarett*, 140 USPQ 474, 482 (CCPA 1964); *In re Kaplan*, 229 USPQ 678, 681 (Fed. Cir. 1986). However, the presence of domination does not preclude double patenting. See, e.g., *In re Schneller*, 158 USPQ 210 (CCPA 1968).

A. STATUTORY DOUBLE PATENTING — 35 U.S.C. 101

In determining whether a statutory basis for a double patenting rejection exists, the question to be asked is: Is the same invention being claimed twice? 35 U.S.C. 101 prevents two patents from issuing on the same invention. "Same invention" means identical subject matter. *Miller* v. *Eagle Mfg. Co.*, 151 U.S. 186 (1984); *In re Ockert*, 114 USPQ 330 (CCPA 1957); *In re Vogel*, 164 USPQ 619 (CCPA 1970).

A reliable test for double patenting under 35 U.S.C. 101 is whether a claim in the application could be literally infringed without literally infringing a corresponding claim in the patent. *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970). Is there an embodiment of the invention that falls within the scope of one claim, but not the other? If there is such an embodiment, then identical subject matter is not defined by both claims and statutory double patenting would not exist. For example, the invention defined by a claim reciting a compound having a "halogen" substituent is not identical to or substantively the same as a claim reciting the same compound except having a "chlorine" substituent in place of the halogen because "halogen" is broader than "chlorine." On the other hand, claims may be differently worded and still define the same invention. Thus, a claim reciting a widget having a length of "36 inches" defines the same invention as a claim reciting the same widget having a length of "3 feet."

If it is determined that the same invention is being claimed twice, 35 U.S.C. 101 precludes the grant of the second patent regardless of the presence or absence of a terminal disclaimer. *Vogel, supra.*

Form paragraphs 8.30 and 8.31 (between an issued patent and one or more applications) or 8.32 (provisional rejections) may be used to make statutory double patenting rejections.

¶ 8.30 35 U.S.C. 101, Statutory Basis for Double Patenting "Heading" Only

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. *Miller* v. *Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory-type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Examiner Note:

This form paragraph must be used as a heading for all subsequent double patenting rejections of the statutory (same invention) type using either of form paragraphs 8.31 or 8.32.

¶ 8.31 Rejection, 35 U.S.C. 101, Double Patenting (Old 7.06)

Claim [1] rejected under 35 U.S.C. 101 as claiming the same invention as that of claim [2] of prior U.S. patent no. [3]. This is a double patenting rejection.

Examiner Note

1. This paragraph must be preceded by form paragraph 8.30 and is used only for double patenting rejections of the same invention claimed in an earlier patent; that is, the "scope" of the inventions claimed is identical.

2. If the conflicting claims are in another copending application, do not use this paragraph. A provisional double patenting rejection should be made using paragraph 8.32.

3. Do not use this paragraph for non-statutory-type double patenting rejections. If non-statutory type, use appropriate form paragraphs 8.33 to 8.39.

4. This paragraph may be used where the conflicting patent and the pending application are:

(a) by the same inventive entity, or

(b) by a different inventive entity and are commonly assigned even though there is no common inventor, or

(c) not commonly assigned but have at least one common inventor.

5. In bracket 3, insert the number of the conflicting patent.

6. If the patent is to a different inventive entity and is commonly assigned with the application, paragraph 8.27 should additionally be used to require the assignee to name the first inventor.

7. If evidence is of record to indicate that the patent is prior art under either 35 U.S.C. 102(f) or (g), a rejection should also be made using paragraphs 7.15 and/or 7.19 in addition to this double patenting rejection.

8. If the patent is to a different inventive entity from the application and the effective U.S. filing date of the patent antedates the effective filing date of the application, a rejection under 35 U.S.C. 102(e) should additionally be made using paragraph 7.15.>0<2.

¶ *8.32 Provisional Rejection, 35 U.S.C. 101, Double Patenting (Old 7.06.1)*

Claim[1] provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claim[2] of copending application * no. [3]. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

Examiner Note:

1. This paragraph must be preceded by form paragraph 8.30 and is used only for double patenting rejections of the same invention claimed in another copending application; that is, the scope of the claimed inventions is identical.
2. If the conflicting claims are from an issued patent, do not use this paragraph. See paragraph 8.31.
3. Do not use this paragraph for non-statutory-type double patenting rejections. See paragraphs 8.33 to 8.39.
4. This paragraph may be used where the conflicting claims are in a copending application that is:
   (a) by the same inventive entity, or
   (b) by a different inventive entity and is commonly assigned even though there is no common inventor, or
   (c) not commonly assigned but has at least one common inventor.
5. Paragraph 8.28 may be used in place of or along with this paragraph to resolve any remaining issues relating to priority under 35 U.S.C. 102(f) or (g).
6. In bracket 3, insert the number of the conflicting application.
7. A double patenting rejection should also be made in the conflicting application.
8. If the copending application is by a different inventive entity and is commonly assigned, paragraph 8.27 should additionally be used to require the assignee to name the first inventor.
9. If evidence is also of record to show that either application is prior art unto the other under 35 U.S.C. 102(f) or (g), a rejection should also be made in the other application using paragraphs 7.15 and/or 7.19 in addition to this provisional double patenting rejection.
10. If the applications do not have the same inventive entity and effective U.S. filing date, a provisional 102(e) rejection should additionally be made in the later-filed application using paragraph 7.15.>0<1.

If the "same invention" is not being claimed twice, an analysis must be made to determine whether a nonstatutory basis for double patenting exists.

B. NONSTATUTORY DOUBLE PATENTING

A rejection based on nonstatutory double patenting, whether of the obvious type or nonobvious type, is based on a judicially created doctrine grounded in public policy so as to prevent the unjustified or improper timewise extension of the right to exclude granted by a patent. *In re Sarett*, 327 F.2d 1005, 140 USPQ 474 (CCPA 1964); *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968); *In re White*, 405 F.2d 904, 160 USPQ 417 (CCPA 1969); *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Goodman*, 29 USPQ2d 2010 (Fed. Cir. 1993).

1. Obvious Type

In determining whether a nonstatutory basis exists for a double patenting rejection, the first question to be asked is — Does any claim in the application define an invention that is merely an obvious variation of an invention claimed in the patent? If the answer is yes, then an "obvious type" nonstatutory double patenting rejection may be appropriate.

A double patenting rejection of the obvious type is "analogous to [a failure to meet] the nonobviousness requirement of 35 U.S.C. 103" except that the patent principally underlying the double patenting rejection is not considered prior art. *In re Braithwaite*, 379 F.2d 594, 154 USPQ 29 (CCPA 1967). Therefore, any analysis employed in an obvious-type double patenting rejection parallels the guidelines for analysis of a 35 U.S.C. 103 obviousness determination. *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Braat*, 937 F.2d 589, 19 USPQ2d 1289 (Fed. Cir. 1991).

Since the analysis employed in an obvious-type double patenting determination parallels the guidelines for a 35 U.S.C. 103 rejection, the factual inquiries set forth in *Graham* v. *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103 are employed when making an obvious-type double patenting analysis. These factual inquiries are summarized as follows:

(1) Determine the scope and content of a patent claim and the prior art relative to a claim in the application at issue;

(2) Determine the differences between the scope and content of the patent claim and the prior art as determined in (1) and the claim in the application at issue;

(3) Determine the level of ordinary skill in the pertinent art; and

(4) Evaluate any objective indicia of nonobviousness.

The conclusion of obvious-type double patenting is made in light of these factual determinations.

Any obvious-type double patenting rejection should make clear:

(1) The differences between the inventions defined by the conflicting claims — a claim in the patent compared to a claim in the application; and

(2) The reasons why a person of ordinary skill in the art would conclude that the invention defined in the claim in issue is an obvious variation of the invention defined in a claim in the patent.

When considering whether the invention defined in a claim of an application is an obvious variation of the invention defined in the claim of a patent, the disclosure of the patent may not be used as prior art. This does not mean that one is precluded from all use of the patent disclosure.

The specification can always be used as a dictionary to learn the meaning of a term in the patent claim. *In re Boylan*, 392 F.2d 1017, 157 USPQ 370 (CCPA 1968). Further, those portions of the specification which provide support for the patent claims may also be examined and considered when addressing the issue of whether a claim in the application defines an obvious variation of an invention claimed in the patent. *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970). The court in *Vogel* recognized "that it is most difficult, if not meaningless, to try to say what is or is not an obvious variation of a claim," but that one can judge whether or not the invention claimed in an application is an obvious variation of an embodiment disclosed in the patent which provides support for the patent claim. According to the court, one must first "determine how much of the patent disclosure pertains to the invention claimed in the patent" because only "[T]his portion of the specification supports the patent claims and may be considered." The court pointed out that "this use of the disclosure is not in contravention of the cases forbidding its use as prior art, nor is it applying the patent as a reference under 35 U.S.C. 103, since only the disclosure of the invention claimed in the patent may be examined."

a. One-Way Obviousness

If the application is the later filed case or both are filed on the same day, only a one-way determination of obviousness is needed in resolving the issue of double patenting — i.e., whether the invention defined in a claim in the application is an obvious variation of the invention defined in a claim in the patent. If a claimed invention in the application is obvious over a claimed invention in the patent, there would be an unjustified timewise extension of the patent and an obvious-type double patenting rejection is proper. Unless a claimed invention in the application is obvious over a claimed invention in the patent, no double patenting rejection of the obvious-type is made, but this does not necessarily preclude a rejection based on nonstatutory, nonobvious double patenting.

Similarly, even if the application at issue is the earlier filed case, only a one-way determination of obviousness is needed to support a double patenting rejection, in the absence of a finding of administrative delay on the part of the Office causing delay in prosecution of the application at issue, the earlier filed case. However, if administrative delay in prosecution of the application at issue, i.e., the earlier filed case, on the part of the Office results in earlier issuance of a patent on the later filed application containing conflicting claims, a two-way determination of obviousness may be required to support a double patenting rejection.

Form paragraph 8.33 and the appropriate one of form paragraphs 8.34-8.37 may be used to make nonstatutory rejections of the obvious-type.

b. Two-Way Obviousness

If the patent is the later filed case, the question of whether the timewise extension of the right to exclude granted by a patent is justified or unjustified must be addressed. A two-way test need only be applied when there is administrative delay. In the absence of administrative delay, a one-way test is appropriate. *In re Goodman*, 29 USPQ2d 2010 (Fed. Cir. 1993). (Applicant's voluntary decision to obtain early issuance of claims directed to a species and to pursue prosecution of previously rejected genus claims in a continuation is a considered election to postpone by the applicant, and not administrative delay). Unless the record clearly shows administrative delay by the Office, the examiner may use the one-way obviousness determination and shift the burden to applicant to show why a two-way obviousness determination is required.

When making a two-way obviousness determination where appropriate, it is necessary to apply the *Graham* obviousness analysis twice, once with the application claims as the claims in issue, and once with the patent claims as the claims in issue. Where a two-way obviousness determination is required, an obvious-type

double patenting rejection is appropriate only where each analysis compels a conclusion that the invention defined in the claims in issue is an obvious variation of the invention defined in a claim in the other application/patent. If either analysis does not compel a conclusion of obviousness, no double patenting rejection of the obvious–type is made, but this does not necessarily preclude a rejection based on nonstatutory, nonobvious double patenting.

Although a delay in the processing of applications before the Office that would cause patents to issue in an order different from the order in which the applications were filed is a factor to be considered in determining whether a one–way or two–way obviousness determination is necessary to support a double patenting rejection, it may be very difficult to assess whether an applicant or the administrative process is primarily responsible for a delay in the issuance of a patent. On the one hand, it is applicant who presents claims for examination and pays the issue fee. On the other hand, the resolution of legitimate differences of opinion that must be resolved in an appeal process or the time spent in an interference proceeding can significantly delay the issuance of a patent. Nevertheless, the reasons for the delay in issuing a patent have been considered in assessing the propriety of a double patenting rejection. Thus, in *Pierce* v. *Allen B. DuMont Laboratories, Inc.*, 297 F.2d 323, 131 USPQ 340 (3rd. Cir. 1961), the Court found that administrative delay may justify the extension of patent rights beyond 17 years but "a considered election to postpone . . . acquisition of the broader [patent after the issuance of the latter filed application] should not be tolerated." In *Pierce*, the patentee elected to participate in an interference proceeding [after all claims in the application had been determined to be patentable] whereby the issuance of the broader patent was delayed by more than seven years after the issuance of the narrower patent. The court determined that the second issued patent was invalid on the ground of double patenting. On the other hand, in *General Foods Corp.* v. *Studiengesellschaft Kohle mbH*, 972 F.2d 1272, 23 USPQ2d 1839 (Fed. Cir. 1992), the court elected not to hold the patentee accountable for a delay in issuing the first filed application until after the second filed application issued as a patent, even where the patentee had intentionally refiled the first filed application as a continuation–in–part after receiving a Notice of Allowance indicating that all claims presented were patentable. Similarly, where, through no fault of the applicant, the claims in a later filed application issue first, an obvious–type double patenting rejection is improper, in the absence of a two–way obviousness determination, because the applicant does not have complete control over the rate of progress of a patent application through the Office. *In re Braat*, 937 F.2d 589, 19 USPQ2d 1289 (Fed. Cir. 1991). While acknowledging that allowance of the claims in the earlier filed application would result in the timewise extension of an invention claimed in the patent, the court was of the view that the extension was justified under the circumstances in this case, indicating that a double patenting rejection would be proper only if the claimed inventions were obvious over each other — a two–way obviousness determination.

Form Paragraph 8.33 and the appropriate one of Form Paragraphs 8.34–8.37 may be used to make nonstatutory rejections of the obvious type.

¶ *8.33 Basis For Non–statutory Double Patenting (Obviousness and Non–obvious type) "Heading" Only*

The non–statutory double patenting rejection, whether of the obvious–type or non–obvious–type, is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent. *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); *In re Van Omum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); In re Longi, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); and *In re Goodman*, 29 USPQ2d 2010 (Fed. Cir. 1993).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321 (b) and (c) may be used to overcome an actual or provisional rejection based on a non–statutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.78 (d).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b)

Examiner Note:

This form paragraph is to be used as a heading before a non–statutory double patenting rejection using any of form paragraphs 8.34 – 8.39.

¶ *8.34 Rejection, Obviousness Type Double Patenting – No Secondary Reference(s)*

Claim[1] rejected under the judicially created doctrine of obviousness–type double patenting as being unpatentable over claim[2] of U.S. patent no. [3]. Although the conflicting claims are not identical, they are not patentably distinct from each other because [4].

Examiner Note:

1. This paragraph is used for obviousness–type double patenting rejections based upon a patent.

2. If the obviousness–type double patenting rejection is based upon another application, do not use this paragraph. A provisional

double patenting rejection should be made using form paragraphs 8.33 and 8.35 or 8.37.

3. This paragraph may be used where the conflicting invention is claimed in a patent which is:

(a) by the same inventive entity, or

(b) by a different inventive entity and is commonly assigned even though there is no common inventor, or

(c) not commonly assigned but has at least one inventor in common.

4. Form paragraph 8.33 must precede any one of paragraphs 8.34 to 8.39 and must be used only ONCE in an Office action.

5. In bracket 3, insert the number of the patent.

6. If evidence indicates that the conflicting patent is prior art under 35 U.S.C. 102(f) or (g), a rejection should additionally be made under 102(f)/103 or 102(g)/103 using paragraph 7.21.

7. If the patent is to another inventive entity and has an earlier U.S. filing date, a rejection under 35 U.S.C. 102(e) or 102(e)/103 may be made using paragraphs 7.15.>0<2 or 7.21.>0<2.

8. In bracket 4, provide appropriate rationale of obviousness for any claims being rejected over the claims of the cited patent.

¶ *8.35 Provisional Rejection, Obviousness Type Double Patenting – No Secondary Reference(s) (Old 7.24.1)*

Claim[1] provisionally rejected under the judicially created doctrine of obviousness–type double patenting as being unpatentable over claim[2] of copending application * no. [3]. Although the conflicting claims are not identical, they are not patentably distinct from each other because [4].

This is a provisional obviousness–type double patenting rejection because the conflicting claims have not in fact been patented.

Examiner Note:

1. This paragraph should be used when the conflicting claims are in another copending application.

2. If the conflicting claims are in a patent, do not use this paragraph. Use form paragraphs 8.33 and 8.34.

3. This paragraph may be used where the conflicting claims are in a copending application that is:

(a) by the same inventive entity, or

(b) is commonly assigned even though there is no common inventor, or

(c) not commonly assigned but has at least one common inventor.

4. Form paragraph 8.33 must precede any one of paragraphs 8.34 to 8.39 and must be used only ONCE in an office action.

5. If the conflicting application is currently commonly assigned but the file does not establish that the conflicting inventions were commonly owned at the time the later invention was made, form paragraph 8.28 may be used in place of or in addition to this form paragraph to also resolve any issues relating to priority under 102(f) and/or (g).

6. In bracket 3, insert the number of the conflicting application.

7. A provisional double patenting rejection should also be made in the conflicting application.

8. If evidence shows that either application is prior art unto the other under 35 U.S.C. 102(f) or (g) and the copending application has not been disqualified as prior art in a 103 rejection based on common ownership), a rejection should additionally be made in the other application under 35 U.S.C. 102(f)/103 or 102(g)/103 using paragraph 7.21.

9. If the disclosure of one application may be used to support a rejection of the other and the applications have different inventive entities and different U.S. filing dates, use paragraph 7.21.>0<1 to additionally make a 102(e)/103 rejection in the other application.

10. In bracket 4, provide appropriate rationale for obviousness of claims being rejected over the claims of the cited patent.

¶ *8.36 Rejection, Obviousness Type Double Patenting – With Secondary Reference(s)*

Claim[1] rejected under the judicially created doctrine of obviousness–type double patenting as being unpatentable over claim[2] of U.S. patent no. [3] in view of [4]. [5].

Examiner Note:

1. This paragraph is used for obviousness–type double patenting rejections where the primary reference is a conflicting patent.

2. If the obviousness double patenting rejection is based on another application, do not use this paragraph. A provisional obviousness–type double patenting rejection should be made using form paragraphs 8.33 and 8.35 or 8.37.

3. This paragraph may be used where the prior invention is claimed in a patent which is:

(a) by the same inventive entity, or

(b) by a different inventive entity and is commonly assigned even though there is no common inventor, or

(c) not commonly assigned but has at least one common inventor.

4. Form paragraph 8.33 must precede any one of paragraphs 8.34 to 8.39 and must be used only ONCE in an office action.

5. In bracket 3, insert the number of the conflicting patent.

6. In bracket 4, insert the secondary reference.

7. In bracket 5, insert an explanation of the obviousness–type rejection.

8. If evidence shows that the conflicting patent is prior art under 102(f) or (g), a rejection should additionally be made under 102(f)/103 or 102(g)/103 using paragraph 7.21.

9. If the patent issued to a different inventive entity and has an earlier U.S. filing date, a rejection under 35 U.S.C. 102(e) or 102(e)/103 may be made using paragraphs 7.15.>0<2 or 7.21.>0<2.

¶ *8.37 Provisional Rejection, Obviousness Type Double Patenting – With Secondary Reference(s) (Old 7.25.1)*

Claim[1] provisionally rejected under the judicially created doctrine of obviousness–type double patenting as being unpatentable over claim[2] of copending application * no. [3] in view of [4]. [5].

This is a provisional obviousness–type double patenting rejection.

Examiner Note:

1. This paragraph is used for obviousness–type double patenting rejections where the primary reference is a conflicting application.

2. If the conflicting claims are in a patent, do not use this paragraph. Use form paragraph 8.34.

3. This paragraph may be used where the conflicting claims are in a copending application that is:

(a) by the same inventive entity, or

(b) is commonly assigned even though there is no common inventor, or

(c) commonly assigned but has at least one common inventor.

4. Form paragraph 8.33 must precede any one of paragraphs 8.34 to 8.39 and must be used only ONCE in an office action.

5. If the conflicting cases are currently commonly assigned but the file does not establish that the conflicting inventions were commonly owned at the time the later invention was made, form paragraph 8.28 may be used in place of or in addition to this form paragraph to also resolve any issues relating to priority under 102(f) and/or (g).

6. In bracket 3, insert the number of the conflicting application.

7. In bracket 5, insert an explanation of the obviousness–type rejection.

8. A provisional double patenting rejection should also be made in the conflicting application.

9. If evidence shows that either application is prior art unto the other under 35 U.S.C. 102(f) or (g) and the copending application has not been disqualified as prior art in a 103 rejection based on common ownership, a rejection should additionally be made under 35 U.S.C. 102(f)/103 or 102(g)/103 using paragraph 7.21.

10. If the disclosure of one application may be used to support a rejection of the other and the applications have different inventive entities and different U.S. filing dates, use paragraph 7.21.>0<1 to additionally make a 102(e)/103 rejection.

2. Nonobviousness Type

There are some unique circumstances where it has been recognized that another type of nonstatutory double patenting rejection is applicable even where the inventions claimed in two or more applications/patents are considered nonobvious over each other. These circumstances are illustrated by the facts before the court in *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968).

Schneller disclosed an invention relating to a wire clip having three elements known in the prior art (A, B, and C), and two features (X and Y) which he had invented that could be used separately or in combination. Schneller acknowledged the best mode of his invention used the two features (X and Y) in combination. The claims of the patent were directed to a wire clip comprising ABCX. Schneller voluntarily filed a divisional application claiming wire clips comprising ABCY and ABCXY. Without determining that the combinations ABCY and ABCXY were obvious over the combination ABCX claimed in the patent, the court affirmed the double patenting rejection. It was observed that the claims in both the patent and the application cover the preferred embodiment disclosed in both the application and the patent (ABCXY). Since patent protection for the metal clips defined by ABCXY, fully disclosed in and covered by the claims of the patent, would be extended by allowance of the appealed claims, the double patenting rejection was affirmed.

In making an analysis for this type of nonstatutory double patenting, the first question is: Is the subject matter recited in the claims of the application fully disclosed in the patent and covered by a claim in the patent? If the answer is no, double patenting does not exist. If the answer is yes, the second question is: Is there any reason why applicant was prevented from presenting the same claims for examination in the issued patent? If the answer is no, a double patenting rejection is appropriate.

A fact situation similar to that in *Schneller* was presented to a Federal Circuit panel in *In re Kaplan*, 789 F.2d 1574, 229 USPQ 678 (Fed. Cir. 1986). Kaplan had been issued a patent on a process of making chemicals in the presence of an organic solvent. Among the organic solvents disclosed and claimed as being useful were tetraglyme and sulfolane. One unclaimed example in the patent was specifically directed to a mixture of these two solvents. The claims in the application to Kaplan and Walker, the application before the Office, were directed to essentially the same chemical process, but requiring the use of the solvent mixture of tetraglyme and sulfolane. In reversing the double patenting rejection, the court stated that the mere fact that the broad process claim of the patent requiring an organic solvent reads on or "dominates" the narrower claim directed to basically the same process using a specific solvent mixture does not, per se, justify a double patenting rejection. The court also pointed out that the double patenting rejection improperly used the disclosure of the joint invention (solvent mixture) in the Kaplan patent specification as though it were prior art.

A significant factor in the *Kaplan* case was that the broad invention was invented by Kaplan, and the narrow invention (i.e., using a specific combination of solvents) was invented by Kaplan and Walker. Since these applications (as the applications in *Braat*) were filed before the Patent Law Amendments Act of 1984 (Pub. Law 98–622, November 8, 1984) amending 35 U.S.C. 116 to expressly authorize filing a patent application in the names of joint inventors who did not necessarily make a contribution to the invention defined in each claim in the patent, it was necessary to file multiple applications to claim both the broad and narrow inventions. Accordingly, there was a valid reason, driven by statute, why the claims to the specific solvent mixture were not presented for examination in the Kaplan patent application.

Each double patenting situation must be decided on its own facts. To the extent that one would view the *Schneller* and *Kaplan* decisions to be in conflict, it is clear

that *Schneller* is the controlling precedent. Decisions of a three-judge panel of the Federal Circuit cannot overturn prior precedential decisions of the CCPA. See *UMC Elec. Co. v. United States*, 816 F.2d 647, 2 USPQ2d 1465 (Fed. Cir. 1987), *cert. denied*, 484 U.S. 1025 (1988).

Form paragraph 8.33 and the appropriate one of 8.38 (between an issued patent and one or more applications) and 8.39 (provision rejections) may be used to make nonstatutory double patenting rejections of the nonobvious type.

¶ *8.38 Double Patenting – Non-statutory, Non-obvious With a Patent*

Claim[1] rejected under the judicially created doctrine of double patenting over claim[2] of U.S. patent no. [3] since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: [4].

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Examiner Note:

1. This form paragraph must be preceded by form paragraph 8.33.
2. Use this form paragraph only when the subject matter of the claim(s) is fully disclosed in, and covered by, at least one claim of an issued U.S. Patent which is commonly owned or where there is common inventorship (one or more inventors in common).
3. In bracket 3, insert the number of the patent.
4. Form paragraph 8.33 must precede any one of paragraphs 8.34 to 8.39 and must be used only ONCE in an Office action.
5. If evidence indicates that the conflicting patent is prior art under 35 U.S.C. 102(f) or (g), a rejection should additionally be made under 102(f)/103 or 102(g)/103 using paragraph 7.21.
6. If the patent is to another inventive entity and has an earlier U.S. filing date, a rejection under 35 U.S.C. 102(e) or 102(e)/103 may be made using paragraphs 7.15.>0<2 or 7.21.>0<2.

¶ *8.39 Double Patenting – Non-statutory, Non-obvious With Another Application*

Claim[1] rejected under the judicially created doctrine of double patenting over claim[2] of copending application * >no.< [3].

The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter, as follows: [4].

Furthermore, there is no apparent reason why applicant would be prevented from presenting claims corresponding to those of the instant application in the other copending application. *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Examiner Note:

1. This form paragraph must be preceded by form paragraph 8.33.
2. Use this form paragraph only when the subject matter of the claim(s) is fully disclosed in, and covered by, at least one claim of another copending application which is commonly owned or where there is common inventorship (one or more inventors in common).
3. In bracket 3, insert the number of the conflicting application.
4. In bracket 4, insert a description of the subject matter being claimed which is covered in the copending application.
5. Paragraph 8.33 must precede any one of paragraphs 8.34 to 8.39 and must be used only ONCE in an office action.
6. If the conflicting application is currently commonly assigned but the file does not establish that the conflicting inventions were commonly owned at the time the later invention was made, form paragraph 8.28 may be used in place of or in addition to this form paragraph to also resolve any issues relating to priority under 102(f) and/or (g).
7. A provisional double patenting rejection should also be made in the conflicting application.
8. If evidence shows that either application is prior art unto the other under 35 U.S.C. 102(f) or (g) and the copending application has not been disqualified (as prior art in a 103 rejection based on common ownership), a rejection should additionally be made in the other application under 35 U.S.C. 102(f)/103 or 102(g)/103 using paragraph 7.21.
9. If the disclosure of one application may be used to support a rejection of the other and the applications have different inventive entities and different U.S. filing dates, use paragraph 7.21.>0<1 to additionally make a 102(e)/103 rejection.

3. Design/Plant — Utility situations

Double patenting issues may be raised where an applicant has filed both a utility patent application (35 U.S.C. 111) and either an application for a plant patent (35 U.S.C. 161) or an application for a design patent (35 U.S.C. 171). In general, the same double patenting principles and criteria that are applied in utility-utility situations are applied to utility-plant or utility-design situations. Double patenting rejections in utility-plant situations may be made in appropriate circumstances.

Although double patenting is rare in the context of utility versus design patents, a double patenting rejection of a pending design or utility application can be made on the basis of a previously issued utility or design patent, respectively. *Carman Industries Inc. v. Wahl*, 724 F.2d 932, 220 USPQ 481 (Fed. Cir. 1983). The rejection is based on the public policy preventing the extension of the term of a patent. Double patenting may be found in a design-utility situation irrespective of whether the claims in the patent relied on in the rejection and the claims in issue involve the same invention, or whether they involve inventions which are obvious variations of one another. *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

In *Carman*, the court held that no double patenting existed between a design and utility patent since the claims in the utility patent, drawn to the interior construction of a flow promoter, were not directed to the same invention or an obvious variation of the invention claimed in a design patent directed to the visible external surface configuration of a storage bin flow promoter. The majority opinion in this decision appears to indicate that a two–way obviousness determination is necessary in design–utility cases. But see *Carman* (J. Nies, concurring).

In *Thorington*, the court affirmed a double patenting rejection of claims for a fluorescent light bulb in a utility patent application in view of a previously issued design patent for the same bulb. In another case, a double patenting rejection of utility claims for a finger ring was affirmed in view of an earlier issued design patent, where the drawing in both the design patent and the utility application illustrated the same article. *In re Phelan*, 205 F.2d 183, 98 USPQ 156 (CCPA 1953). A double patenting rejection of a design claim for a flashlight cap and hanger ring was affirmed over an earlier issued utility patent. *In re Barber*, 81 F.2d 231, 28 USPQ 187 (CCPA 1936). A double patenting rejection of claims in a utility patent application directed to a balloon tire construction was affirmed over an earlier issued design patent. *In re Hargraves*, 53 F.2d 900, 11 USPQ 240 (CCPA 1931).

III. CONTRAST BETWEEN DOUBLE PATENTING REJECTION AND REJECTIONS BASED ON PRIOR ART

Rejections over a patent or another copending application based on double patenting or 35 U.S.C. 103 are similar in the sense that both require comparison of the claimed subject matter with at least part of the content of another patent or application, and both may require that an obviousness analysis be made. However, there are significant differences between a rejection based on double patenting and one based on 35 U.S.C. 102(e) prior art under 35 U.S.C. 103. *In re Bartfeld*, 925 F.2d 1450, 17 USPQ2d 1885 (Fed. Cir. 1991).

One significant difference is that a double patenting rejection must rely on a comparison with the claims in an issued or to be issued patent, whereas an obviousness rejection based on the same patent under 35 U.S.C. 102(e)/103 relies on a comparison with what is disclosed (whether or not claimed) in the same issued or to be issued patent. In a 35 U.S.C. 102(e)/103 rejection over a prior art patent, the reference patent is available for all that it fairly discloses to one of ordinary skill in the art, regardless of what is claimed. *In re Bowers*, 359 F.2d 886, 149 USPQ 570 (CCPA 1966).

A second significant difference is that a terminal disclaimer cannot be used to obviate a rejection based on 35 U.S.C. 102(e)/103 prior art. *In re Fong*, 378 F.2d 977, 154 USPQ 25 (CCPA 1967). The purpose of a terminal disclaimer is to obviate a double patenting rejection by removing the potential harm to the public by issuing a second patent, and not to remove a patent as prior art.

Where the inventions are made by inventors that have assigned their rights to a common assignee, the assignee can take some preemptive measures to avoid having a copending application become prior art under 35 U.S.C. 102(e). The applications can be filed on the same day, or copending applications can be merged into a single continuation–in–part application and the parent applications abandoned. If these steps are undesirable or the first patent has issued, the prior art effect of the first patent may be avoided by a showing under 37 CFR 1.132 that any unclaimed invention disclosed in the first patent was derived from the inventor of the application before the examiner in which the 35 U.S.C. 102(e)/103 rejection was made. *In re Katz*, 687 F.2d 450, 215 USPQ 14 (CCPA 1982). Finally, it may be possible for applicant to respond to a 35 U.S.C. 102(e)/103 rejection by showing, under 37 CFR 1.131, that the date of invention of the claimed subject matter was prior to the effective filing date of the reference patent which has been relied upon for its unclaimed disclosure.

Because there are significant differences between a rejection based on double patenting and one based on prior art under 35 U.S.C. 102(e)/103 over the same issued patent, it is both appropriate and necessary that an examiner make both rejections when the facts support both rejections. A prior art reference that renders claimed subject matter obvious under 35 U.S.C. 102(e)/103 does not create a double patenting situation where that subject matter is not claimed in the reference patent. Where the subject matter that renders a claim obvious is both claimed and disclosed in a U.S. patent which satisfies the criteria of 35 U.S.C. 102(e), the examiner should make rejections based both on double patenting and 35 U.S.C. 103.

804.01 Prohibition of Double Patenting Rejections Under 35 U.S.C. 121

35 U.S.C. 121 authorizes the Commissioner to restrict the claims in a patent application to a single invention when independent and distinct inventions are presented for examination. The third sentence of 35 U.S.C. 121 prohibits the use of a patent issuing on an application with respect to which a requirement for restriction has been made, or on an application filed as a result of such a requirement, as a reference against any divisional application, if the divisional application is filed before the issuance of the patent. The 35 U.S.C. 121 prohibition applies only where the Office has made a requirement for restriction. The prohibition does not apply where the divisional application was voluntarily filed by the applicant and not in response to an Office requirement for restriction. 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 restrictions where the claims define essentially the same invention in different language and which, if acquiesced in, might result in the issuance of several patents for the same invention.

The prohibition against holdings of double patenting applies to requirements for restriction between the related subjects treated in MPEP 806.04 through 806.05(i), 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 are filed as a result of such requirement.

The following are situations where the prohibition of double patenting rejections under 35 U.S.C. 121 does not apply:

(a) The applicant voluntarily files two or more cases without a restriction requirement by the examiner. *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968)

(b) The claims of the different applications or patents are not consonant with the restriction requirement made by the examiner, since the claims have been changed in material respects from the claims at the time the requirement was made. For example, the divisional application filed includes additional claims not consonant in scope to the original claims subject to restriction in the parent. *Symbol Technologies, Inc.* v. *Opticon, Inc.*, 935 F.2d 1569, 19 USPQ2d 1241 (Fed. Cir. 1991). *Gerber Garment Technology, Inc.* v. *Lectra Systems Inc.*, 916 F.2d 683, 16 USPQ2d 1436 (Fed. Cir. 1990). In order for consonance to exist, the line of demarcation between the independent and distinct inventions identified by the examiner in the requirement for restriction must be maintained. *Gerber, supra.*

(c) The restriction requirement was written in a manner which made it clear to applicant that the requirement was made subject to the non allowance of generic or other linking claims and such linking claims are subsequently allowed. Therefore, if a generic or linking claim is subsequently allowed, the restriction requirement should be removed.

(d) The requirement for restriction (holding of lack of unity of invention) was only made in an international application by the International Searching Authority or the International Preliminary Examining Authority.

(e) The requirement for restriction was withdrawn by the examiner before the patent issues. *In re Ziegler*, 443 F.2d 1211, 170 USPQ 129 (CCPA 1971).

(f) The claims of the second application are drawn to the "same invention" as the first application or patent. *Studiengesellschaft Kohle mbH* v. *Northern Petrochemical Co.*, 784 F.2d 351, 228 USPQ 837 (Fed. Cir. 1986).

While the situation should not arise where appropriate care is exercised in defining the independent and distinct inventions in a restriction requirement, the issue might arise as to whether 35 U.S.C. 121 prevents the use of a double patenting rejection when the identical invention is claimed in both the patent and the pending application. Under these circumstances, the Office will make the double patenting rejection because the patentee is entitled only to a single patent for an invention. As expressed in *Studiengesellschaft Kohle, supra*, (J. Newman, concurring), "35 U.S.C. 121 of course does not pro vide that multiple patents may be granted on the identical invention."

804.02 Avoiding a Double Patenting Rejection

I. STATUTORY

A rejection based on the statutory type of double patenting can be avoided by canceling the conflicting claims in all but one of the pending application(s) or patent, or by amending the conflicting claims so that they are not

coextensive in scope. A terminal disclaimer is not effective in overcoming a statutory double patenting rejection.

The use of a 37 CFR 1.131 affidavit in overcoming a statutory double patenting rejection is inappropriate. *In re Dunn*, 349 F.2d 433, 146 USPQ 479 (CCPA 1965). *Knell v. Muller*, 174 USPQ 460 (Com. Pat. 1971), citing the CCPA decisions in *In re Ward*, 236 F.2d 428, 111 USPQ 101 (CCPA 1956); *In re Teague*, 254 F.2d 145, 117 USPQ 284 (CCPA 1958); and *In re Hidy*, 303 F.2d 954, 133 USPQ 65 (CCPA 1962).

II. NONSTATUTORY

37 CFR 1.78. Claiming benefit of earlier filing date and cross references to other applications.

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(d) Where an application claims an invention which is not patentably distinct from an invention claimed in a commonly owned patent with the same or a different inventive entity, a double patenting rejection will be made in the application. An obviousness–type double patenting rejection may be obviated by filing a terminal disclaimer in accordance with § 1.321(b).

A rejection based on a nonstatutory type of double patenting can be avoided by filing a terminal disclaimer in the application or proceeding in which the rejection is made. *In re Knohl*, 155 USPQ 586 (CCPA 1967); *In re Griswold*, 150 USPQ 804 (CCPA 1966); *In re Vogel*, 164 USPQ 619 (CCPA 1970). The use of a terminal disclaimer in overcoming a nonstatutory double patenting rejection is in the public interest because it encourages the disclosure of additional developments, the earlier filing of applications, and the earlier expiration of patents whereby the inventions covered become freely available to the public. *In re Jentoft*, 157 USPQ 363 (CCPA 1968); *In re Eckel*, 393 F.2d 848, 157 USPQ 415 (CCPA 1968); *In re Braithwaite*, 379 F.2d 594, 154 USPQ 29 (CCPA 1967).

The use of a 37 CFR 1.131 affidavit in overcoming a double patenting rejection is inappropriate because the claim or claims in the application are being rejected over a patent which claims the rejected invention. *In re Dunn*, 349 F2.d 433, 146 USPQ 479 (CCPA 1965). Rule 131 is inapplicable if the claims of the application and the patent are "directed to substantially the same invention". It is also inapplicable if there is a lack of "patentable distinctness" between the claimed subject matter. *Knell* v. *Muller*, 174 USPQ 460 (Com. Pat. 1971), citing the CCPA decisions in *In re Ward*, 236 F.2d 428, 111 USPQ 101 (CCPA 1956); In re Teague, 254 F.2d 145, 117 USPQ 284 (1958); and *In re Hidy*, 303 F.2d 954, 133 USPQ 65 (CCPA 1962).

The Patent and Trademark Office cannot ensure that two or more cases will have a common issue date. Applicants are cautioned that reliance upon a common issue date cannot effectively substitute for the filing of one or more terminal disclaimers in order to overcome a proper double patenting rejection, particularly since a common issue date alone does not avoid the potential problem of dual ownership of patents to patentably indistinct inventions.

A patentee or applicant may disclaim or dedicate to the public the entire term, or any terminal part of the term of a patent. 35 U.S.C. 253. The statute does not provide for a terminal disclaimer of only a specified claim or claims. The terminal disclaimer must operate with respect to all claims in the patent.

The filing of a terminal disclaimer to obviate a rejection based on nonstatutory double patenting is not an admission of the propriety of the rejection. *Quad Environmental Technologies Corp.* v. *Union Sanitary District*, 946 F.2d 870, 20 USPQ 2d 1392 (Fed. Cir. 1991). The court indicated that the "filing of a terminal disclaimer simply serves the statutory function of removing the rejection of double patenting, and raises neither a presumption nor estoppel on the merits of the rejection."

A terminal disclaimer filed to obviate a double patenting rejection is effective only with respect to the application identified in the disclaimer, unless by its terms it extends to continuing applications. If an appropriate double patenting rejection of the nonstatutory type is made in two or more pending applications, an appropriate terminal disclaimer must be filed in each application.

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 under 35 U.S.C. 101. In cases where the difference in claims is obvious, terminal disclaimers are effective to overcome double patenting rejections. 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(c). It should be emphasized that a terminal disclaimer cannot be used to overcome a rejection under 35 U.S.C. 102(e)/103.

REQUIREMENTS OF A TERMINAL DISCLAIMER

A terminal disclaimer is a statement filed by an owner (in whole or in part) of a patent or a patent to be granted that is used to disclaim or dedicate a portion of the entire term of all the claims of a patent. The requirements for a terminal disclaimer are set forth in 37 CFR 1.321. Sample forms of a terminal disclaimer are provided in MPEP 1490.

804.03 Treatment of Commonly Owned Cases of Different Inventive Entities [R-1]

37 CFR 1.78 Claiming benefit of earlier filing date and cross references to other applications.

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(c) Where two or more applications, or an application and a patent naming different inventors and owned by the same party contain conflicting claims, and there is no statement of record indicating that the claimed inventions were commonly owned or subject to an obligation of assignment to the same person at the time the later invention was made, the assignee may be called upon to state whether the claimed inventions were commonly owned or subject to an obligation of assignment to the same person at the time the later invention was made, and if not, indicate which named inventor is the prior inventor. In addition to making said statement, the assignee may also explain why an interference should or should not be declared.

(d) Where an application claims an invention which is not patentably distinct from an invention claimed in a commonly owned patent with the same or a different inventive entity, a double patenting rejection will be made in the application. An obviousness-type double patenting rejection may be obviated by filing a terminal disclaimer in accordance with § 1.321(b).

I. DOUBLE PATENTING

The Patent and Trademark Office has withdrawn the Commissioners Notice of January 9, 1967, Double Patenting, 834 O.G. 1615 (Jan. 31, 1967), to the extent that it does not authorize a double patenting rejection where different inventive entities are present. The examiner may reject claims in commonly owned applications of different inventive entities on the ground of double patenting. This is in accordance with existing case law and prevents an organization from obtaining two or more patents with different expiration dates covering nearly identical subject matter. See *In re Zickendraht*, 319 F.2d 225, 138 USPQ 22 (CCPA 1963); (the doctrine is well established that claims in different applications need be more than merely different in form or content; and that patentable distinction must exist to entitle applicants to a second patent); *In re Christensen*, 330 F.2d 652, 141 USPQ 295 (CCPA 1964).

Double patenting rejections can be overcome in certain circumstances by disclaiming, pursuant to the provisions of 37 CFR 1.321, the terminal portion of the term of the later patent and including in the disclaimer a provision that the patent shall be enforceable only for and during the period the patent is commonly owned with the application or patent which formed the basis for the rejection, thereby eliminating the problem of extending patent life. 37 CFR 1.78(d).

II. DETERMINING PRIORITY; REJECTIONS UNDER 35 U.S.C. 102 AND 103

A determination of priority is not required when two inventions come within the provisions of the second paragraph of 35 U.S.C. 103. Two inventions of different inventive entities come within the provisions of the second paragraph of 35 U.S.C. 103 when (1) the later invention is not anticipated by the earlier invention under 35 U.S.C. 102; (2) the earlier invention qualifies as prior art against the later invention only under subsection (f) or (g) of 35 U.S.C. 102; and (3) the inventions were, at the time the later invention was made, owned by the same person or subject to an obligation of assignment to the same person. If the two inventions come within the provisions of the second paragraph of 35 U.S.C. 103, it is not necessary to determine priority of invention since the earlier invention is disqualified as prior art against the later invention and since double patenting rejections can be used to ensure that the patent terms expire together. In circumstances where the inventions of different inventive entities come within the provisions of the second paragraph of 35 U.S.C. 103, no inquiry under 37 CFR 1.78(c) should be made since it is unnecessary to determine the prior inventor. However, if there is no evidence that claims of applications of different inventive entities come within the provisions of the second paragraph of 35 U.S.C. 103 and if the applications are owned by the same party and contain conflicting claims, it is necessary to determine the prior inventor unless the conflicting claims by all but one inventive entity are eliminated.

Form paragraphs 8.27 and 8.28 may be used to require the applicant to name the prior inventor under 37 CFR 1.78(c).

Before making the requirement to state the prior inventor under 37 CFR 1.78(c), with its threat to hold the case abandoned if the statement is not made by the assignee, the examiner must make sure that claims are present in each case which are conflicting as defined in MPEP 804. See *In re Rekers*, 203 USPQ 1034 (Comm'r. Pats. 1979).

In some situations the application file wrappers may reflect which invention is the prior invention, e.g., by reciting that one invention is an improvement of the other invention. See *Margolis et al.* v. *Banner*, 202 USPQ 365 (CCPA 1979) (Court refused to uphold a holding of abandonment for failure to name the prior inventor since the record showed what was invented by the different inventive entities and who was the prior inventor).

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 and will not be filed as a continuing application. 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 by different inventive entities 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. This rejection could be overcome if the requirements of the second paragraph of 35 U.S.C. 103 are met.

¶ *8.27 Different Inventors, Common Assignee, Same Invention*

Claim [1] directed to the same invention as that of claim [2] of commonly assigned [3]. The issue of priority under 35 U.S.C. 102 (g) and possibly 35 U.S.C. 102(f) of this single invention must be resolved.

Since the Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP >§< 2302), the assignee is required to state which entity is the prior inventor of the conflicting subject matter. A terminal disclaimer has no effect in this situation since the basis for refusing more than one patent is priority of invention under 35 U.S.C. 102(f) or (g) and not an extension of monopoly.

Failure to comply with this requirement will result in a holding of abandonment of the application.

Examiner Note:

1. In bracket 3, insert the U.S. patent number or the copending application serial number.

2. The claims listed in brackets 1 and 2 must be for the same invention. If one invention is obvious in view of the other, do not use this paragraph; see form paragraph 8.28.

3. A provisional or actual statutory double patenting rejection may also be made using paragraphs 8.31 or 8.32.

4. If the commonly assigned application or patent has an earlier U.S. filing date, a rejection under 35 U.S.C. 102(e) may also be made using form paragraph ** 7.15.>0<1 or >or 7.15.02<.

¶ *8.28 Different Inventors, Common Assignee, Obvious Inventions, No Evidence of Common Ownership at time of invention*

Claim [1] directed to an invention not patentably distinct from claim [2] of commonly assigned [3]. Specifically, [4]

Examiner Note:

1. This paragraph should be used when the application being examined is commonly assigned with a conflicting application or patent but there is no indication that they were commonly assigned at the time the invention was actually made.

2. If the conflicting claims are in a patent with an earlier U.S. filing date, make a rejection under 35 U.S.C. 102(e)/103 using paragraph 7.21 in addition to this paragraph.

3. If the conflicting claims are in a commonly–assigned, copending application with an earlier filing date, make a provisional 102(e)/103 rejection of the claims using paragraph 7.20 and 7.21.>0<1 in addition to this paragraph.

4. In bracket 3, insert the number of the conflicting patent or application.

5. An obviousness double patenting rejection may also be included in the action using paragraphs 8.34 *>to< 8.36.

6. In bracket 4, explain why the claims in the conflicting cases are not considered to be distinct.

7. Form paragraph 8.28.>0<1 MUST follow ** this paragraph.

¶ *8.28.>0<1 Advisory Information Relating to Paragraph 8.28*

Commonly assigned [1], discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103 if the commonly owned case qualifies as prior art under 35 U.S.C. 102(f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee is required under 37 CFR 1.78(c) and 35 U.S.C. 132 to either show that the conflicting inventions were commonly owned at the time the invention in this application was made or to name the prior inventor of the conflicting subject matter. Failure to comply with this requirement will result in a holding of abandonment of the application.

A showing the the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103 based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g).

Examiner Note:

This form paragraph should follow paragraph 8.28 and should only be used ONCE in an Office action.

If evidence is of record to indicate that one patent or application is prior art under 35 U.S.C. 102(f) or (g) or 102(f)/103 or 102(g)/103 to another application, and the inventions do not fall within the second paragraph of

35 U.S.C. 103, the examiner should also reject the claims of the other application under 35 U.S.C. 102(f), 102(g), 102(f)/103 or 102(g)/103 using the appropriate one(s) o form paragraphs 7.19, 7.15, 7.21 and 7.21.>0<1. Rejections under 35 U.S.C. 102 or 103 cannot be obviated by filing a terminal disclaimer.

¶ *7.15 Rejection, 35 U.S.C. 102(a), (b) Patent or Publication, and (g)*

Claim[1] rejected under 35 U.S.C. 102([2]) as being [3] by [4].

Examiner Note

1. In bracket 2, insert the appropriate paragraph letter or letters of 35 U.S.C 102 in parentheses. If paragraph (e) of 35 U.S.C. 102 is applicable, use form paragraph 7.15.>0<2.

2. In bracket 3, insert either "anticipated" or "clearly anticipated" with an explanation at the end of the paragraph.

3. In bracket 4, insert the prior art relied upon.

4. This rejection must be preceded either by paragraph 7.07 and paragraphs 7.08, 7.09, and 7.14 as appropriate, or by paragraph 7.102.

5. If 35 U.S.C. 102(e) is also being applied, this paragraph must be followed by either form paragraph 7.15.>0<2 or 7.15.>0<3.

¶ *7.19 Rejection, 35 U.S.C. 102(f), Applicant not the Inventor*

Claim [1] rejected under 35 U.S.C. 102(f) because the applicant did not invent the claimed subject matter. [2].

Examiner Note:

1. This paragraph must be preceded either by paragraphs 7.07 and 7.13 or by paragraph 7.102.

2. In bracket 2, insert an explanation of the supporting evidence establishing that applicant was not the inventor.

¶ *7.21 Rejection, 35 U.S.C. 103*

Claim[1] rejected under 35 U.S.C. 103 as being unpatentable over [2]. [3].

Examiner Note:

1. This paragraph must be preceded either by paragraph 7.20 or paragraph 7.102.

2. In bracket 3, an explanation of the rejection applying the Graham vs. Deere test must be provided.

3. If this rejection relies upon art that is disqualified under 35 U.S.C. 102(f) or(g) based upon the common ownership of the inventions, * paragraph ** 7.20.>0<1 >must follow this paragraph<.

4. If this rejection is a provisional 103 rejection based upon a copending application that would comprise prior art under 102(e) if patented, use paragraph 7.21.>0<1 instead of this paragraph.

¶ *7.21.>0<1 Provisional Rejection, 35 U.S.C. 103, Common Assignee or At Least One Common Inventor Only*

Claim[1] provisionally rejected under 35 U.S.C. 103 as being obvious over copending application * no. [2] which has a common [*>3<] with the instant application. Based upon the earlier effective U.S. filing date of the copending application, it would constitute prior art under 35 U.S.C. 102(e) if patented. This provisional rejection under 35 U.S.C. 103 is based upon a presumption of future patenting of the conflicting application. [*>4<].

This provisional rejection might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the copending application was derived from the inventor of this application and is thus not the invention "by another", or by a showing of a date of invention for the instant application prior to the effective U.S. filing date of the copending application under 37 CFR 1.131.

Examiner Note:

1. This paragraph is used to provisionally reject claims not patentably distinct from the disclosure in a copending application having an earlier U.S. filing date and also having either a common assignee or at least one common inventor.

2. If the claimed invention is fully disclosed in the copending application, use paragraph 7.15.>0<1.

>3. In bracket 3, insert either "assignee" or "inventor".<

*>4<. In bracket *>4<, insert explanation of obviousness.

*>5<. If the claimed invention is also claimed in the copending application, a provisional obviousness double patenting rejection should additionally be made using paragraph 8.33 and 8.37.

*>6< If evidence indicates that the copending application is also prior art under 35 U.S.C. 102(f) or (g) and the copending application has not been disqualified as prior art in a >35 U.S.C.< 103 rejection based upon common ownership, a rejection should additionally be made under 35 U.S.C. 103 using paragraph 7.21 (e.g., applicant has named the prior inventor in response to a requirement made using paragraph 8.28).

**

Further, if the conflicting applications have different effective U.S. filing dates, the examiner should consider making a provisional rejection in the later filed application, based on the earlier filed application, under 35 U.S.C. 102(e) or 102(e)/103, using form paragraph 7.15.>0<1 or 7.21.>0<1. Similarly, if an application has a later effective U.S. filing date than a conflicting issued patent, the examiner should consider making a rejection in the application, based on the patent, under 35 U.S.C. 102(e) or 102(e)/103, using form paragraph 7.15.>0<2 or 7.21.>0<2. Rejections under 35 U.S.C. 102 or 103 cannot be obviated by the filing of a terminal disclaimer.

¶ *7.15.>0<1 Provisional Rejection, 35 U.S.C. 102(e) – Common Assignee or At Least One Common Inventor*

Claim[1] provisionally rejected under 35 U.S.C. 102(e) as being anticipated by copending application * no. [2] which has a common [3] with the instant application.

Based upon the earlier effective U.S. filing date of the copending application, it would constitute prior art under 35 U.S.C. 102(e) if patented. This provisional rejection under 35 U.S.C. 102(e) is based upon a presumption of future patenting of the copending application. [4].

This provisional rejection under *>35 U.S.C.< 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the copending application was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

>This rejection may not be overcome by the filing of a terminal disclaimer. See *In re Bartfeld*, 17 USPQ 2d 1685 (Fed. Cir. 1991).<

Examiner Note:

1. This paragraph is used to provisionally reject over a copending application with an earlier filing date that discloses the claimed invention. The copending application must have either a common assignee or at least one common inventor.

2. If the claims are obvious over the invention disclosed in the other copending application, use paragraph 7.21.>0<1.

3. In bracket 3, insert either "assignee" or "inventor."

4. In bracket 4, an appropriate explanation may be provided in support of the Examiner's position on anticipation, if necessary.

5. If the claims of the copending application conflict with the claims of the instant application, a provisional double patenting rejection should also be given using paragraphs 8.30 and 8.32.

6. If evidence is additionally of record to show that either invention is prior art unto the other under 35 U.S.C. 102(f) or (g), a rejection using paragraphs 7.13 and/or 7.14 should also be made.

¶ *7.15.>0<2 Rejection, 35 U.S.C. 102(e), Common Assignee or Inventor(s)*

Claim[1] rejected under 35 U.S.C. 102(e) as being anticipated by [2].

The applied reference has a common [3] with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another", or by an appropriate showing under 37 CFR 1.131.

Examiner Note:

1. This paragraph is used to reject over a patent with an earlier filing date that discloses, but does not claim the same invention. The patent must have either a common assignee or a common inventor.

2. In bracket 3, insert either "assignee" or "inventor."

¶ *7.21.>0<2 Rejection, 35 U.S.C. 103, Common Assignee or At Least One Common Inventor*

Claim[1] rejected under 35 U.S.C. 103 as being obvious over [2].

The applied reference has a common [3] with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103 might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another", or by a showing of a date of invention for the instant application of any unclaimed subject matter prior to the effective U.S. filing date of the reference under 37 CFR 1.131. [4].

Examiner Note:

1. This paragraph is used to reject over a patent with an earlier filing date that discloses the claimed invention. The patent must have either a common assignee or at least one common inventor.

2. In bracket 3, insert either "assignee" or "inventor."

3. In bracket 4, insert explanation of obviousness.

804.04 Submission to Group Director

In order to promote uniform practice, every action containing a rejection on the ground of double patenting of a divisional (or parent) application (where the divisional application 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. If the rejection on the ground of double patenting is disapproved, it shall not be mailed but other appropriate action shall be taken. Note MPEP 1003, item 4.

805 Effect of Improper Joinder in Patent

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

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

1. Where inventions are independent (i.e., no disclosed relation therebetween), restriction to one thereof is ordinarily proper, MPEP § 806.04 – § 806.04(j), though a reasonable number of species may be claimed when there is an allowed (novel and unobvious) claim generic thereto, 37 CFR 1.141, MPEP § 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, 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 MPEP § 806.05 – § 806.05(i) and 809.03. See MPEP § 802.01 for criteria for patentably distinct inventions.

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

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 (novel and unobvious) 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

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 MPEP § 804 – § 804.02.

806.04 Independent Inventions

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

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. 37 CFR 1.141 makes an exception to this, providing that a reasonable number of 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–1]

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 MPEP § 806.05 – § 806.05(i). 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.

Form Paragraph 8.14 may be used in intermediate – final product restriction requirements.

¶ *8.14 Intermediate – Final Product*

**

Inventions [1] and [2] are related as mutually exclusive species in intermediate–final product relationship. Distinctness is proven for claims in this relationship if the intermediate product is useful to make other than the final product (MPEP *>§< 806.04(b), 3rd paragraph), and the species are patentably distinct (MPEP *>§< 806.04(h)).

In this instant case, the intermediate product is deemed to be useful as [3] and the inventions are deemed patentably distinct since there is nothing on this record to show them to be obvious variants. Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions anticipated by the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103 of the other invention.

>Examiner Note:

1. This form paragraph is to be used when claims are presented to both an intermediate and final product (MPEP § 806.04(b)).
2. Conclude restriction requirement with form paragraph 8.21.<

The intermediate and final product must have a mutually exclusive species relationship and as with all species restrictions, must be patentably distinct.

Typically, the intermediate loses its identity in the final product.

Additionally, the intermediate must be shown to be useful to make other than the final product. The examiner must give an example of an alternative use but need not provide documentation. Applicant then has the burden to prove or provide a convincing argument that the intermediate does not have the suggested use.

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 utilizes the same form of joint.

806.04(d) 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 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 MPEP § 809.02(c)(2).

806.04(e) Claims Restricted to Species

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 and 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 MPEP § 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 commonality 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

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 a national application containing claims directed to more than a reasonable number of species, the examiner should not require restriction to a reasonable number of species unless he or she is satisfied that he or she 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 in a national application, applicant may claim in the *same application* additional species as provided by 37 CFR 1.141. 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 MPEP § 706.03(k) may be followed if the claims differ from the allowed genus only by subject matter that can be shown by citation of prior art.

Where, however, an applicant optionally files another national 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 MPEP § 804.01 and § 804.02.

806.04(i) Generic Claims Presented for First Time After Issue of Species

The Patent and Trademark Office no longer follows the practice of prohibiting the allowance of generic claims that are presented for the first time after the issuance of a copending application claiming plural species. Instead, the Office may reject the generic claims on the grounds of obviousness–type double patenting. Applicant may overcome such a rejection by filing a terminal disclaimer. See *In re Braithwaite*, 154 USPQ 38 (CCPA 1967).

**

806.05 Related Inventions

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 nondistinct 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 in a national application

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

806.05(a) Combination and Subcombination or Element

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

Relative to questions of restriction where a combination is alleged, the claim thereto must be assumed to be allowable (novel and unobvious) as pointed out in MPEP § 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 allowable and must be treated on that basis.

806.05(b) Old Combination — Novel Subcombination

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 (Comm'r Pats.1923). (See MPEP § 820.01.)

806.05(c) Criteria of Distinctness for Combination, Subcombination, or Element of a Combination [R–1]

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, i.e. separate classification, status, or field of search. See MPEP § 808.02.

If it can be shown that a combination, as claimed

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

AB_{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} ("br" is an abbreviation for "broad"), and subcombination B_{sp} ("sp" is an abbreviation for "specific"). 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

A B_{sp} / B_{sp} 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.

A B_{sp} / A B_{br} (Evidence claim) / B_{sp} 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 considered and the letter to the applicant should so state. Therefore, where the combination evidence 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 demonstrated to support a restriction requirement. See also MPEP § 806.04(b).

Form Paragraph 8.15 may be used in combination–subcombination restriction requirements.

¶ *8.15 Combination–Subcombination*

**

Inventions [1] and [2] are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability and (2) that the subcombination has utility by itself or in other combinations. (MPEP >§< 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because [3]. The subcombination has separate utility such as [4].

Examiner Note:

>1. This form paragraph is to be used when claims are presented to both combination(s) and subcombination(s) (MPEP § 806.05(c)).

2.< In situations involving evidence claims, see MPEP *>§ 806.05(c),< example 3, and explain in bracket 3.

>3.< In bracket 4, suggest utility other than used in combination.

>4. Conclude restriction requirement with form paragraph 8.21.<

The burden is on the examiner to suggest an example of separate utility.

If applicant proves or provides an argument supported by facts, that the other utility, suggested by the examiner, cannot be accomplished, the burden shifts to the examiner to document a viable separate utility or withdraw the requirement.

806.05(d) Subcombinations Usable Together [R–1]

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 MPEP § 806.04(b).)

Form Paragraph 8.16 may be used in restriction requirements between subcombinations.

¶ *8.16 Subcombinations, Usable Together*

**

Inventions [1] and [2] are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case invention [3] has separate utility such as [4]. See *MPEP >§< 806.05(d)*.

Examiner Note:

>1. This form paragraph is to be used when claims are presented to subcombinations usable together (MPEP § 806.05(d)).<

*>2<. In bracket 3, insert the appropriate group number or identify the invention.

*>3<. In bracket 4, suggest utility other than with the other invention.

>4. Conclude restriction requirement with form paragraph 8.21.<

Only one way Distinctness is Required.

The examiner must show, by way of example, that one of the subcombinations has utility other than in the disclosed combination.

Care must be taken to determine if the subcombinations are generically claimed.

Where subcombinations 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 related inventions. If restriction is improper under either practice, it should not be required (MPEP § 806.04(b)).

The burden is on the examiner to provide an example.

If applicant proves or provides an argument, supported by facts, that the other use, suggested by the examiner, cannot be accomplished or is not reasonable, the burden is on the examiner to document a viable alternative use or withdraw the requirement.

806.05(e) Process and Apparatus for Its Practice — Distinctness [R–1]

In applications claiming inventions in different statutory categories, only one–way distinctness is generally needed to support a restriction requirement. However, see MPEP § 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.

If the apparatus claims include a claim to "means" for practicing the process, the claim is a linking claim and must be examined with the elected invention. If it is ultimately allowed rejoinder is required.

Form Paragraph 8.17 may be used to make restriction requirements between process and apparatus.

¶ *8.17 Process and Apparatus*

**

Inventions [1] and [2] are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. *MPEP >§< 806.05(e)*. In this case [3].

Examiner Note:

>1. This form paragraph is to be used when claims are presented to both a process and apparatus for its practice (MPEP § 806.05(e)).

2.<In bracket 3, use one or more of the following reasons:

*>a. the< process as claimed can be practiced by another and materially different apparatus such as *>... ,<

*>b. the< process as claimed can be practiced by hand,

*>c. the< apparatus as claimed can be used to practice another and materially different process such as *>....<

>3. Conclude restriction requirement with form paragraph 8.21.<

The burden is on the examiner to provide reasonable examples that recite material differences.

If the apparatus claims include a claim to "means" for practicing the process, this claim is a linking claim (except for the presence of this claim restriction between apparatus and process claims would be proper). The linking claim must be examined with the elected invention, but only to the extent necessary to determine if the linking claim is unpatentable. If the linking claim is unpatentable, restriction is proper.

It should be noted that a claim such as, "An apparatus for the practice of the process of claim 1, comprising ...." and then the claim continues with purely apparatus limitations, is not a linking claim. This is merely a preamble similar to a statement of intended use and should be treated as any preamble.

If applicant proves or provides convincing argument that there is no material difference or in the case of that process that cannot be performed by hand (if examiner so argued), the burden is on the examiner to document another materially different process or apparatus or withdraw the requirement.

806.05(f) Process of Making and Product Made — Distinctness [R–1]

A process of making 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.

Allegations of different processes or products need not be documented.

A product defined by the process by which it can be made is still a product claim (*In re Bridgeford*, 149 USPQ 55 (CCPA 1966)) and can be restricted from the process if the examiner can demonstrate that the product as claimed can be made by another materially different process; defining the product in terms of a process by which it is made is nothing more than a permissible technique that applicant may use to define the invention.

If applicant convincingly traverses the requirement, the burden shifts to the examiner to document a viable alternative process or product, or withdraw the requirement.

Form Paragraph 8.18 may be used in restriction requirements between product and process of making.

¶ *8.18 Product and Process of Making*

**

Inventions [1] and [2] are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make another and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP >§< 806.05(f)). In the instant case [3].

Examiner Note:

>1.This form paragraph is to be used when claims are presented to both a product and the process of making the product (MPEP § 806.05(f)).

2.<In bracket 3, use one or more of the following reasons:

>a. the< process as claimed can be used to make a materially different product such as *>...,<

>b. the< product as claimed can be made by a materially different process such as *>....<

>3. Conclude restriction requirement with form paragraph 8.21.<

806.05(g) Apparatus and Product Made — Distinctness [R−1]

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.

Form Paragraph 8.19 may be used for restriction requirements between apparatus and product made.

¶ *8.19 Apparatus and Product Made*

**

Inventions [1] and [2] are related as apparatus and product made. The inventions in this relationship are distinct 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 can be used for making a different product or (2) that the product as claimed can be made by another and materially different apparatus (MPEP >§< 806.05(g)). In this case [3].

Examiner Note:

>1. This form paragraph is to be used when claims are presented to both the apparatus and product made (MPEP § 806.05(g)).

2.< In bracket 3, use one or more of the following reasons:

*>a. the< apparatus as claimed is not an obvious apparatus for making the product and the apparatus as claimed can be used to make a different product such as *> ...,<

*>b. the< product can be made by a materially different apparatus such as * ....<

>3. Conclude restriction requirement with form paragraph 8.21.<

Only One Way Distinctness is Required

The examiner must show by way of example either (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.

See Form Paragraph 8.19 above.

The burden is on the examiner to provide an example which need not be documented.

If applicant either proves or provides convincing argument that the alternative example suggested by the examiner is not workable, the burden is on the examiner to suggest another viable example or withdraw the restriction requirement.

806.05(h) Product and Process of Using

A product and a process of using the product can be shown to be distinct inventions if either or both of the following can be shown: (1) the process for using as claimed can be practiced with another materially different product, or (2) the product as claimed can be used in a materially different process.

The burden is on the examiner to provide an example, but the example need not be documented.

If the applicant either proves or provides a convincing argument that the alternative use suggested by the examiner cannot be accomplished, the burden is on the examiner to support a viable alternative use or withdraw the requirement.

Form Paragraph 8.20 may be used in restriction requirements between the product and method of using.

¶ *8.20 Product and Process of Using*

**

Inventions [1] and [2] are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP >§< 806.05(h)). In the instant case [3].

Examiner Note:

>1. This form paragraph is to be used when claims are presented to both the product and process of using the product (MPEP § 806.05(h)).

2.< In bracket 3, use one or more of the following reasons:

*>a. the< process as claimed can be practiced with another materially different product such as *> ...,<

*>b. the< product as claimed can be used in a materially different process such as *> ....<

>3. Conclude restriction requirement with form paragraph 8.21.<

806.05(i) Product, Process of Making, and Process of Using — Product Claim Not Allowable [R−1]

37 CFR 1.141. Different inventions in one national application.

*****

(b) Where claims to all three categories, product, process of making, and process of use, are included in a national application, a three way requirement for restriction can only be made where the process of making is distinct from the product. If the process of making and the product are not distinct, the process of using may be joined with the claims directed to the product and the process of making the product even though a showing of distinctness between the product and process of using the product can be made.

Where an application contains claims to a product, claims to a process specially adapted for (i.e., not patentably distinct from, as defined in MPEP § 806.05(f)) the product, and claims to a process of using the product, and the product claims are not allowable (i.e., not novel and nonobvious), restriction is proper between the process of making and the process of using. In this instance, applicant may be required to elect either (1) the product and process of making it, or (2) the process of using. Unless the examiner can make a showing of distinctness between the process of using and the product (MPEP § 806.05(h)), the product must also be joined with the process of using in grouping (2).

Where the product claims are allowable (i.e., novel and nonobvious), restriction may be required only where the process of making and the product made are distinct (MPEP § 806.05(f)); otherwise, the process of using must be joined with the process of making and product made, even if a showing of distinctness can be made between the product and process of using (MPEP § 806.05(h)).

Determination of patentability of the product need not be made prior to making a requirement for restriction unless the requirement is based on a determination that the product claims are not allowable.

Form paragraph 8.20.>0<1 may be used in product, process of making and process of using situations where the product is not allowable.

¶ *8.20.>0<1 Product, Process of Making and Process of Using – Product Is Not Allowable*

**

Inventions [1] and [2] are related as a process of making and process of using the product. The use as claimed cannot be practiced with a materially different product. Since the product is not allowable, restriction is proper between said method of making and method of using. The product claim will be examined along with the elected invention (MPEP >§< 806.05(i)).

>Examiner Note:

1. This paragraph is to be used when claims are presented to the product, process of making, and process of using where the product claims are not allowable (MPEP § 806.05(i)).<

807 Patentability Report Practice Has No Effect on Restriction Practice

Patentability report practice (MPEP § 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 cannot 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 as set forth in the following sections.

808.01 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 (MPEP § 806.04), *the facts relied on 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

Where there is no disclosure of relationship between species (see MPEP § 806.04(b)), they are independent inventions and election of one invention following a requirement for restriction is mandatory even though applicant disagrees with the examiner. There must be a patentable difference between the species as claimed, see MPEP § 806.04(h). Thus the reasons for insisting upon election of one species, are the facts relied on 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 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 (obvious) 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 applications where a generic claim is found allowable, the application should be treated as indicated in MPEP §§ 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.

808.02 Related Inventions

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 (MPEP § 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 MPEP §§ 806.05(c–i), 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, 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, and also of a separate field of search.

(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

Where, upon examination of an application containing claims to distinct inventions, linking claims are found, restriction can nevertheless be required. See MPEP § 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 MPEP § 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 1–month 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

Under 37 CFR 1.141, an allowed generic claim may link a reasonable number of 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 may require the applicant in his response to that action to elect that species of his or her invention to which his or her claim shall be restricted if no generic claim is held allowable. However, if such application contains claims directed to more than a reasonable number of species, the examiner may require restriction of the claims to not more than a reasonable number of species before taking further action in the case.

809.02(a) Election Required [R-1]

Where generic claims are present, the examiner should send a letter including only a restriction requirement or place a telephone requirement to restrict (the latter being encouraged). See MPEP § 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 MPEP § 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 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 1-month >(not less than 30 days)< shortened statutory period will be set for response when a written requirement is made without an action on the merits. This period may be extended under the provisions of 37 CFR 1.136(a). Such action will not be an "action on the merits" for purposes of the second action final program.

To be complete, a response to a requirement made according to this section should include a proper election along with a listing of all claims readable thereon, including any claims subsequently added.

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.

Examiners should use Form Paragraphs 8.01 or 8.02 to make election of species requirements.

¶ *8.01 Election of Species*

This application contains claims directed to the following patentably distinct species of the claimed invention: [1].

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, [2] generic.

Applicant is advised that a response to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a generic claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which 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 upon the elected species. MPEP 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103 of the other invention.

Examiner Note:

In bracket 2, insert the appropriate generic claim information.

¶ *8.02 Election When Claims Are Not Restricted to Species*

Claim [1] generic to a plurality of disclosed patentably distinct species comprising [2]. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species, even though this requirement is traversed.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103 of the other invention.

Examiner Note:

1. This paragraph should be used for the election of species requirement described in MPEP >§§< 803.02 (Markush group) and 809.02(d) (burdensome search necessary).

2. In bracket *>2,< clearly identify the species from which election is to be made.

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

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

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 37 CFR 1.141 and no more than a reasonable number of species are claimed. Substantially the following should be stated:

> "Applicant is advised that his or her response to complete must include an identification of the single, disclosed species within the allowed genus that he or she elects and a listing of all claims readable thereupon. Applicant is entitled to consideration of claims to a reasonable number of disclosed species in addition to the elected species, which species he or she 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 37 CFR 1.141."

809.02(c) Action Following Election [R-1]

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, or there is no generic claim, all claims not readable on the elected species should be treated substantially as follows:

> "Claims_____ are held to be withdrawn from further consideration under 37 CFR 1.142(b) as not readable on the elected species ,there being no (allowable) generic claim."

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

(i) When all claims to each of the additional species are embraced by an allowable generic claim as provided by 37 CFR 1.141, applicant should be advised of the allowable generic claim and that claims drawn to the nonelected species are no longer withdrawn since they are fully embraced by the allowed generic claim.

(ii) 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 37 CFR 1.141."

Note that each additional species is handled separately. When all of the claims to one nonelected species are embraced by an allowable generic claim but each of the claims to another nonelected species are not embraced by an allowable generic claim, applicant should be advised that the claims to the one nonelected species are no longer withdrawn from further consideration but that the claims to the other nonelected species remain withdrawn from further consideration since all of the claims to this other species do not depend upon or fully include all of the limitations of an allowed generic claim as required by 37 CFR 1.141. This holding should be worded as follows:

> "Allowed claims _____ are generic. Claims _____ directed to species _____ are no longer withdrawn from further consideration in this case since all of the claims to this species depend from or otherwise include all of the limitations of an allowed generic claim. 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 37 CFR 1.141."

When the case is otherwise ready for issue and there is an allowed generic claim, and applicant has not been previously notified as to the allowance of a generic claim, applicant should be advised of the allowance of a generic claim and given a time limit of 1 month to conform all of the claims to the nonelected species to fully embrace an allowed generic claim or the examiner will cancel the claims to each nonconforming species by examiner's amendment and pass the case to issue. If the election is traversed,, an additional paragraph worded as Form Paragraph 8.03 should be added to the holding.

¶ *8.03 In Condition for Allowance, Nonelected Claims*

This application is in condition for allowance except for the presence of claim [1] to an invention non-elected with traverse in Paper no. [2]. Applicant is given **>THIRTY DAYS< from the date of this letter to cancel the noted claims or take other appropriate action (37 CFR 1.144). Failure to take action during this period will be treated as authorization to cancel the noted claims by Examiner s Amendment and pass the case to issue. Extensions of time under 37 CFR 1.136(a) will not be permitted since this application will be passed 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 an allowed generic claim as required by 37 CFR 1.141 and are withdrawn from further consideration in this case, 37 CFR 1.142(b)."

809.02(d) No Species Claims

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 MPEP § 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 or she must at that time indicate an election of a single species.

809.02(e) Generic Claim Allowable in Substance [R-1]

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 * >application< should be as indicated in MPEP §§ 809.02 (b), (c), or (d).

809.03 Linking Claims

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 between 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.

A claim to the product linking a process of making and a use (process of using).

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. Note Form Paragraph 8.12.

¶ *8.12 Restriction, Linking Claims*

Claim [1] link(s) inventions [2] and [3].

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

809.04 Retention of Claims to Nonelected Invention

Where the requirement for restriction in an application is predicated upon the nonallowability of generic or other type of linking claims, applicant is entitled to retain in the case claims to the nonelected invention or inventions.

If a linking claim is allowed, the examiner must thereafter examine species if the linking claim is generic thereto, or he or she 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 nonallowability of the linking claims, applicant may petition from the requirement under 37 CFR 1.144 without waiting for a final action on the merits of the linking claims; or applicant may defer his or her petition until the linking claims have been finally rejected, but not later than appeal, 37 CFR 1.144, MPEP § 818.03(c).

810 Action on the Merits

In general, in an application when a requirement to restrict is made, no action on the merits is given.

810.01 Not Objectionable When Coupled With Requirement

A basic policy of the present examining program is that the second action on the merits should be made final whenever proper, MPEP § 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 MPEP § 821.01.

Although an action on the merits is not necessary to a requirement, it is not objectionable, *Ex parte Lantzke*, 1910 C.D. 100, 156 O.G. 257. However, note that a question may arise as to whether there is a serious burden on the examiner.

However, except as noted in MPEP § 809 and § 812.01, if an action is given on the merits, *it must be given on all claims*.

810.02 Usually Deferred

The Office policy is to usually defer action on the merits until after the requirement for restriction is complied with, or withdrawn.

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 [R–1]

37 CFR 1.143 last sentence states: "If the requirement is repeated and made final, the examiner will at the same time act on the claims to the invention elected." Thus, action is ordinarily given on the elected invention in the action making the requirement final.

¶ *8.25.>0<1 Election Without Traverse*

Applicant's election without traverse of [1] in Paper No [2] is acknowledged.

811 Time for Making Requirement

37 CFR 1.142(a), 2nd sentence: "If the distinctness and independence of the invention be clear, such requirement 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, the examiner should, 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.

Before making a restriction requirement after the first action on the merits, the examiner will consider whether there will be a serious burden if restriction is not required.

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 (Comm'r Pats. 1904).

811.03 Repeating After Withdrawal Proper

Where a requirement to restrict is made and withdrawn, because it was 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 there among may be required in the divisional case if proper.

812 Who Should Make the Requirement

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 if none of the claimed subject matter is classifiable in his or her 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–1]

If an examiner determines that a requirement for restriction should be made in an application, the examiner 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, the examiner should telephone the attorney of record and request 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 3 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 contain reference to the unsuccessful telephone call. See MPEP § 809 and § 809.02(a). When an oral election is made, the examiner will then proceed to incorporate into the Office action 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.

Form Paragraphs 8.23 or 8.23.1 should be used to make a telephone election of record.

¶ *8.23 Requirement, When Elected by Telephone*

During a telephone conversation with [1] *>on< [2] a provisional election was made [3] traverse to prosecute the invention of [4], claim [5]. Affirmation of this election must be made by applicant in responding to this Office action. Claim [6] withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Examiner Note:

1. In bracket 3, insert "with" or "without", whichever is applicable.
2. In bracket 4, insert either the elected group or species.
3. An action on the merits of the claims should follow.

¶ *8.23.>0<1 Requirement, No Election by Telephone*

A telephone call was made to [1] on [2] to request an oral election to the above restriction requirement, but did not result in an election being made.

Examiner Note:

1. In bracket 1, insert the name of the >applicant or< attorney *>or agent contacted<.

2. In bracket 2, insert the *>date(s) of the telephone contact(s)<.

3. This paragraph should be used in all instances where a telephone election was attempted and *>applicant's representative< did not or would not make an election.

>4. This paragraph should <u>not</u> be used if no contact was made with applicant's representative or applicant.<

If on examination the examiner finds the elected claims to be allowable and no traverse was made, the letter should be written on PTOL-37 (Examiner's Amendment) and should include cancelation of the nonelected 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 PTOL-326.

Should the elected claims be found allowable in the first action, and an oral traverse was noted, the examiner should include in his or her action a statement under MPEP § 821.01, making the restriction final and giving applicant 1-month to either cancel the nonelected claims or take other appropriate action (37 CFR 1.144). Failure to take action will be treated as an authorization to cancel the nonelected claims by an examiner's amendment and pass the case to issue. Prosecution of the 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 claims before canceling the nonelected 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

A. Species. The mode of indicating how to require restriction between species is set forth in MPEP § 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 a process, or to a subcombination, or to a 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

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, the application should be referred 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-1]

The particular reasons relied on by the examiner for 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 or she considers the subcombination to have utility by itself or in other combinations, and why he or she considers that the combination as claimed does not rely on 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 MPEP § 809.

Note Form Paragraph 8.13.

¶ *8.13 Distinctness (Heading)*

The inventions are distinct, each from the other because**:

*>Examiner Note<:

**>This paragraph should be followed by one of< paragraphs 8.14 to **>8.20.02< to *>show< distinctness.

817 Outline of Letter for Restriction Requirement Between Distinct Inventions [R-1]

The statement in MPEP § 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
–Form Paragraphs 8.08–8.11 should be used to group inventions.

¶ *8.08 Restriction, 2 Groupings*
Restriction to one of the following inventions is required under 35 U.S.C. 121:
I. Claim [1], drawn to [2], classified in class [3], subclass [4].
II. Claim [5], drawn to [6], classified in class [7], subclass [8].

¶ *8.09 Restriction, 3rd Grouping*
III. Claim [1], drawn to [2], classified in class [3], subclass [4].

¶ *8.10 Restriction, 4th Grouping*
IV. Claim [1], drawn to [2], classified in class [3], subclass [4].

¶ *8.11 Restriction, Additional Groupings*
[1]. Claim [2], drawn to [3], classified in class [4], subclass [5].

>Examiner Note:
In bracket 1, insert the appropriate roman numeral, e.g., --V--, --VI--, etc.<

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 as signed 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 of making and/or Apparatus — Product
Demonstrate claimed product can be made by other process (or apparatus)
By examiner's suggestion
OR
Process of making (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 nonallowance of evidence claims (see MPEP § 806.05(c)).
Form Paragraph 8.21 must be used at the conclusion of each restriction requirement.

¶ *8.21 Conclusion of All Restriction Requirements*

**

Because these inventions are distinct for the reasons given above and [1] restriction for examination purposes as indicated is proper.

Examiner Note:
>1.This paragraph must be added as a conclusion to all restriction requirements employing any of form paragraphs 8.14 to 8.20.02.<
>2.<In the bracket insert by writing one or more of the following reasons:
*>a.< have acquired a separate status in the art as shown by the different classification,

*>b.< have acquired a separate status in the art because of their recognized divergent subject matter,

*>c.< the search required for *>invention< [ ] is not required for *>invention< [ ].

Form Paragraph 8.23.>0<2 must be included in all restriction requirements for applications having joint inventors.

¶ *8.23.>0<2 Joint Inventors, Correction of Inventorship*

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(h).

Examiner Note:

This paragraph must be included in all restriction requirements for applications having joint inventors.

818 Election and Response

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 37 CFR 1.111.

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 as set forth in MPEP § 818.02(a) and § 818.02(c).

818.02(a) By Originally Presented Claims

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 MPEP § 821.03.

818.02(b) Generic Claims Only — No Election of Species

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 or she 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 MPEP § 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 or she 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

37 CFR 1.143. 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 § 1.111.) 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 37 CFR 1.143 the traverse to a requirement must be complete as required by 37 CFR 1.111(b) which reads in part: "In order to be entitled to reconsideration or further examination, the applicant or patent owner must make request therefor in writing. The reply by the applicant or patent owner must distinctly and specifically point out the supposed errors in the examiner's action and must respond to every ground of objection and rejection in the prior Office action. . . . The applicant's or patent owner's reply must appear throughout to be a *bona fide* attempt to advance the case to final action. . . ."

Under this rule, the applicant is required to specifically point out the reasons on which he or she bases his or her conclusions 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 37 CFR § 1.111. Thus the required provisional election (see MPEP § 818.03(b)) becomes an election without traverse.

818.03(b) Must Elect, Even When Requirement Is Traversed

As noted in the second sentence of 37 CFR 1.143, a provisional election must be made even though the requirement is traversed.

All requirements for restriction should include Form Paragraph 8.22.

¶ *8.22 Requirement, Election, Mailed*

Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Examiner Note:

This paragraph can be used in Office actions with or without an action on the merits.

818.03(c) Must Traverse To Preserve Right of Petition [R-1]

37 CFR 1.144. 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 § 1.181.)

If applicant does not distinctly and specifically point out supposed errors in the restriction requirement, the election should be treated as an election without traverse and be so indicated to the applicant by use of form paragraph 8.25.2.

¶ *8.25.>0<2 Election Without Traverse Based on Incomplete Response*

Applicant's election of [1] in paper no. [2] is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP >§< 818.03(a)).

818.03(d) Traverse of Nonallowance of Linking Claims

A traverse of the nonallowance of the linking claims is not a traverse of the requirement to restrict; it is a traverse of a holding of nonallowance.

Election combined with a traverse of the nonallowance 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 37 CFR 1.144 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 Own Election

Applicant must make his or her own election. The examiner will not make the election for the applicant, 37 CFR 1.142, 37 CFR 1.143, 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 the one elected, he or she should treat the claims as outlined in MPEP § 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 nonelected invention, *Ex parte Loewenbach,* 1904 C.D. 170, 110 O.G. 857 (Comm'r Pats 1904); and *In re Waugh,* 1943 C.D. 411, 553 O.G. 3 (CCPA 1943)

819.01 Office May Waive Election and Permit Shift

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 (Comm'r Pats 1905).

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 prosecute a reasonable number of additional species thereunder, in accordance with 37 CFR 1.141, this not constituting a shift: *Ex parte Sharp et al.,* Patent No. 2,232,739.

820.01 Old Combination Claimed — Not an Election

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 MPEP § 806.05(b)), and these claims are rejected, 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 MPEP § 806.05(c).) See also MPEP § 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 interference, elect any one of the inventions claimed.

821 Treatment of Claims Held to be Drawn to Nonelected Inventions

Claims held to be drawn to nonelected inventions, including claims to nonelected species, are treated as indicated in MPEP § 821.01 through § 821.03.

The propriety of a requirement to restrict, if traversed, is reviewable by petition under 37 CFR 1.144, *In re Hengehold,* 169 USPQ 473 (CCPA 1971).

All claims that the examiner holds as not being directed to the elected subject matter should be withdrawn from further consideration by the examiner as set forth in MPEP § 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 or her position after such traverse, he or she should reject the claims to which the traverse applies on the ground that they are not directed to the elected subject

matter. Because applicant believes the claims are readable on the elected invention and the examiner disagrees, the metes and bounds of the claim(s) cannot be readily ascertained, rendering the claim(s) vague and indefinite within the meaning of 35 U.S.C. 112, second paragraph.

821.01 After Election With Traverse [R-1]

Where the initial requirement is traversed, it should be reconsidered. If, upon reconsideration, the examiner is still of the opinion that restriction is proper, it should be repeated and made final in the next Office action. (See MPEP § 803.01.) In doing so, the examiner should reply to the reasons or arguments advanced by applicant in the traverse. Form Paragraph 8.25 should be used to make a restriction requirement final.

¶ *8.25 Answer to Arguments With Traverse*

Applicant's election with traverse of [1] in paper no. [2] is acknowledged. The traversal is on the ground(s) that [3]. This is not found persuasive because [3].

The requirement is still deemed to be proper and is therefore made FINAL.

Examiner Note:

1. In bracket 1, insert the invention elected.
2. In bracket 3, insert in summary form, the ground>(s)< on which traversal is based.
3. In bracket 4, insert the reasons why the traversal was not found to be persuasive.

If the examiner, upon reconsideration, is of the opinion that the requirement for restriction is improper, he or she 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 by using Form Paragraph 8.05.

¶ *8.05 Claims Stand Withdrawn With Traverse*

Claim [1] withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected [2], the requirement having been traversed in paper no. [3].

Examiner Note:

In bracket 2, insert "invention" or "species".

This will show that applicant has retained the right to petition from the requirement under 37 CFR 1.144 (see MPEP § 818.03(c).)

When the case is otherwise ready for issue, and has not received a final action, the examiner should treat the case by using Form Paragraph 8.03. See MPEP § 809.02(c).

When preparing a final action in an application where there has been a traversal of a requirement for restriction, the examiner should indicate in the Office action that a complete response must include cancellation of the claims drawn to the nonelected invention, or other appropriate action (37 CFR 1.144). See Form Paragraph 8.24.

¶ *8.24 Response to a Final Must Include Cancellation*

This application contains claim [1] drawn to an invention non-elected with traverse in paper no. [2]. A complete response to the final rejection must include cancellation of non-elected claims or other appropriate action (37 CFR 1.144) MPEP >§< 821.01.

Examiner Note:

For use in FINAL rejections of applications containing claim(s) non-elected with traverse.

Where a response to a final action has otherwise placed the application in condition for allowance, the failure to cancel claims drawn to the nonelected 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 37 CFR 1.144 must be filed not later than appeal. This is construed to mean appeal to the Board of Patent Appeals and Interferences. If the case is ready for allowance after appeal and no petition has been filed, the examiner should simply cancel the nonelected claims by examiner's amendment, calling attention to the provisions of 37 CFR 1.144.

821.02 After Election Without Traverse [R-1]

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 by using Form Paragraph 8.06.

¶ *8.06 Claims Stand Withdrawn Without Traverse*

Claim [1] withdrawn from further consideration by the examiner, 37 CFR 1.142(b) as being drawn to a nonelected [2]. Election was made without traverse in paper no. [3].

Examiner Note:

In bracket 2, insert "invention" or "species".

This will show that applicant has not retained the right to petition from the requirement under 37 CFR 1.144.

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 include Form Paragraph 8.07.

¶ *8.07 Ready for Allowance Without Traverse*

This application is in condition for allowance except for the presence of claim [1] to [2] nonelected without traverse. Accordingly, claim [3] been cancelled.

Examiner Note:

In bracket 2, insert either "an invention" or ">a< species".

821.03 Claims for Different Invention Added After an Office Action [R-1]

Claims added by amendment following action by the examiner, MPEP § 818.01, § 818.02(a), to an invention other than previously claimed, should be treated as indicated by 37 CFR 1.145.

37 CFR 1.145. 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 §§ 1.143 and 1.144.

The action should include Form Paragraph 8.04.

¶ *8.04 Election by Original Presentation*

Newly submitted claim [1] directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: [2].

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim [3] withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP >§< 821.03.

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 MPEP § 2303.

An amendment canceling all claims drawn to the elected invention and presenting only claims drawn to the nonelected invention should not be entered. Such an amendment is nonresponsive. Applicant should be notified by using Form Paragraph 8.26.

¶ *8.26 Cancelled Elected Claims, Non-Responsive*

The amendment filed on [1] cancelling all claims drawn to the elected invention and presenting only claims drawn to a non-elected invention is non-responsive, (MPEP >§< 821.03). The remaining claims are not readable on the elected invention because [2]. Applicant is given a ONE MONTH TIME LIMIT or until the expiration of the response period set in the the last Office action, whichever is longer, to complete the response. NO EXTENSION OF THIS TIME LIMIT WILL BE GRANTED UNDER EITHER 37 CFR 1.136 (a) or (b), but the period for response set in the last Office action may be extended up to a maximum of *>SIX< MONTHS.

822 Claims to Inventions That Are Not Distinct in Plural Applications of Same Inventive Entity [R-1]

The treatment of plural applications of the same inventive entity, none of which has become a patent, is treated in 37 CFR 1.78(b) 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 MPEP § 304 for conflicting subject matter in two applications, same inventive entity, one assigned.

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

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

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

See MPEP § 709.01 for one application in interference.

See MPEP § 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.

Form Paragraph 8.29 should be used when the conflicting claims are identical or conceded by applicant to be not patentably distinct.

¶ *8.29 Conflicting Claims, Copending Applications*

Claim [1] of this application conflict with claim [2] of application *>no.< [3]. 37 CFR 1.78(b) provides that *>when< 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. Applicant is required to either cancel the conflicting claims from all but one application or maintain a clear line of demarcation between the applications. See MPEP > §<822.

Examiner Note:

This paragraph is appropriate when the conflicting claims are identical or conceded by applicant to be not patentably distinct.

822.01 Copending Before the Examiner

Under 37 CFR 1.78(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 MPEP § 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 each application and all appropriate rejections should be entered in each application, including rejections based upon prior art. The claims of each application may also be rejected on the grounds of provisional double patenting on the claims of the other application whether or not any claims avoid the prior art. Where appropriate, the same prior art may be relied upon in each of the applications.

ONLY PROVISIONAL DOUBLE PATENTING REJECTION IN ONE APPLICATION

The "provisional" double patenting rejection should continue to be made by the examiner in each application as long as there are conflicting claims in more than one application unless that "provisional" double patenting rejection is the only rejection remaining in one of the applications. If the "provisional" double patenting rejection in one application is the only rejection remaining in that application, the examiner should then withdraw that rejection and permit the application to issue as a patent, thereby converting the "provisional" double patenting rejection in the other application(s) into a double patenting rejection at the time the one application issues as a patent.

ONLY PROVISIONAL DOUBLE PATENTING REJECTION IN TWO APPLICATIONS

If the "provisional" double patenting rejections in both application are the only rejections remaining in those applications, the examiner should then withdraw that rejection in one of the applications and permit the application to issue as a patent. The examiner should maintain the double patenting rejection in the other application as a "provisional" double patenting rejection which will be converted into a double patenting rejection when the one application issues as a patent.

823 Unity of Invention Under the Patent Cooperation Treaty

See Chapter 1800 for a detailed discussion of unity of invention under the Patent Cooperation Treaty (PCT).