Chapter 800 Restriction; Double Patenting

800 Introduction

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

The applicable law is determined by the date a requirement to restrict was made final.

If made *final* prior to January 1, 1953, the requirement could not have been made under the provisions of 35 U. S. C. 121, and the preceding edition of the M. P. E. P. should be consulted for applicable practice.

The provisions of 35 U. S. C. 121, and the practice stated herein, apply to all requirements initially made on or after January 1, 1953, and also to all requirements initially made prior to January 1, 1953, and either acquiesced in without traverse or made final after traverse on or after that date.

802 Basis for Practice in Statutes and Rules

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

35 U. S. C. 121. Divisional applications. If two or more independent and distinct inventions are claimed in one application, the Commissioner may require the application to be restricted to one of the inventions. If the other invention is made the subject of a divisional application which complies with the requirements of section 120 of this title it shall be entitled to the benefit of the filing date of the original application. A patent issuing on an application with respect to which a requirement for restriction under this section has been made, or on an application filed as a result of such a requirement, shall not be used as a reference either in the Patent 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.

Rules 141 through 146, which will be quoted under pertinent topics, outline Office practice on questions of restriction.

802.01 Meaning of "Independent", "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 Rule 141 the statement is made that two or more "independent and distinct inventions" may not be claimed in one application.

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

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

The term "independent" as already pointed out, means *not dependent.* A large number of subjects between which, in the past, division has 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 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 divide independent inventions only, then division would be improper as between depend-

ent 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.

While in ordinary parlance, two inventions that are "independent" (i. e., not dependent) might also be considered as accurately termed "distinct", the converse is not true. Inventions that may be "distinct" may be dependent, and thus the term "independent" could not accurately be used in referring to the same. For the purpose of this Manual, these terms are used as defined below.

The term "independent" (i. e., not dependent) means that there is no disclosed relationship between the two or more subjects disclosed, i. e., they are unconnected in design, operation or effect, e. g., (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, etc.

The term "distinct" means that two or more subjects as disclosed are connected in design, operation, or effect, i. e., they are related, for example as combination and part (subcombination) thereof, process and apparatus for its practice, process and product made, etc., but are capable of separate manufacture, use or sale as claimed, and are patentable over each other (though they may each be unpatentable because of the prior art). It will be noted that in this definition the term "related" is used as an alternative for "dependent" in referring to subjects other than independent subjects.

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

802.02 Definitions; Restriction, Double Patenting

A requirement to restrict is a requirement to limit the claims of the application under consideration to one of the plurality of claimed inventions (Rule 142) indicated in the requirement.

A rejection on the ground of double patenting is a ruling that the invention claimed in an application is the same as, or not patentably distinct from, an invention already claimed by the same applicant, usually in a patent, but at times in a copending application. See 305, 706.03(k), 822, and 822.01.

803 Restriction—When Proper

Under the statute an application may properly be required to be restriced to one of two or more claimed inventions only if they are independent (806.04—806.04(j)) or distinct (806.05–806.05(g).)

Where inventions are neither independent nor distinct one from the other their joinder in a single application must be permitted.

803.01 Review by Primary Examiner

Requirements for restriction under Title 35 U. S. Code 121 being discretionary with the Commissioner, it becomes very important that the practice under this section be carefully administered. Notwithstanding the fact that this section 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 or the signatory to an Office action must personally review all requirements for restriction. (Notice of April 14, 1953.)

804 Double Patenting Rejection

35 U. S. C. 121, third sentence, provides that where the Office requires restriction, neither the parent nor any divisional application thereof conforming to the requirement can be used as a reference against the other. This apparent nullification of double patenting as a ground of rejection or invalidity in such cases imposes a heavy burden on the Office to guard against erroneous requirements for restriction where the claims define essentially the same inventions in different language and which, if acquiesced in, might result in the issuance of several patents for the same invention.

804.01 Applicability

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

A. SITUATIONS WHERE 35 U. S. C. 121 DOES NOT APPLY

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

(b) The requirement for *restriction* was made *final* prior to January 1, 1953, and so could not have been made under Section 121 of the new law.

(c) The Office made either the initial or final requirement for restriction to a single distinct and independent invention on or after January 1, 1953, but the claims of the different applications or patents are not consonant with the requirement made by the Examiner, due to the fact that the claims have been changed in material respects from the claims at the time the requirement was made.

(d) The requirement was made subject to the nonallowance of generic or other linking claims and such linking claims are subsequently allowed. (Extract from Notice of December 10, 1952.)

B. SITUATIONS WHERE 35 U. S. C. 121 APPARENTLY APPLIES

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

D. EFFECT OF DISCLAIMER

Where a rejection on applicant's patent on the ground of double patenting is proper, such rejection cannot be avoided by filing under Rule 321 a disclaimer of the invention claimed in the patent. Ex parte Williams 1917 C. D. 73, 245 O. G. 277.

The mere filing of a terminal disclaimer does not *ipso facto* overcome a rejection on the ground of double patenting. In re Siu 1955 C. D. 176, 696 O. G. 421.

804.02 Submission to Supervisory Classification Examiner

In order to promote uniform practice, every action containing a rejection on the ground of double patenting of either a parent or a divisional case (where the divisional case was filed because of a requirement to restrict, including a requirement to elect species, made by the Office) must be submitted to the Supervisory Examiner of Classification for approval prior to mailing. When the rejection on the ground of double patenting is disapproved, it shall not be mailed but other appropriate action shall be taken. (Notice of November 1, 1950, Revised.)

805 Effect of Improper Joinder in Patent

35 U. S. C. (1952) 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 are elementary, and may be summarized as follows:

1. Where inventions are independent (i. e., no disclosed relation therebetween), restriction to one thereof is ordinarily proper, 806.04–806.04 (j), though up to 5 species may be claimed when there is an allowed claim generic thereto, Rule 141, 809.02–809.02 (e).

2. Where inventions are related as dis-

closed but are distinct as claimed, restriction may be proper.

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

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 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.

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, only one application can be allowed.

806.04 Independent Embodiments

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

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 only of such independent inventions.

For example, 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.

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

Species are treated extensively in the following sections.

806.04 (a) Species—Genus

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

806.04 (b) Species - Genus, Species May Be Related Inventions

Species, while usually independent may be related under the particular disclosure. Where subjects, as disclosed and claimed, are simultaneously (a) species under a claimed genus and (b) dependent or related inventions, then the question of joinder must be determined by *both* the practice applicable to species *and* the practice applicable to the particular types of dependent or related inventions, and if restriction is improper under either practice, restriction should not be required.

For example, subcombinations usable with each other may be species of some generic invention, Ex parte Healy 1898 C. D. 157; 84 O. G. 1281, where a clamp for a handle bar stem and a specifically different clamp for a seat post both for use on a bicycle were claimed and were held to be properly divisible since no combination claim was presented and the practice at

that time permitted the claiming of but a single species.

As a further example, one species of carbon compound may have such chemical characteristics as to spontaneously convert into a second species of carbon compound. These species would obviously be quite closely related.

806.04 (c) Species - Genus, Subcombination Not Generic to Combination

The relation "combination—subcombination" presents the situation where plural claims are all readable upon a single embodiment, where the relation is not specific claim to genus, but combination to subcombination or element.

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, or is restricted to the common subcombination.

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 combination 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 forms of a doughnut cooker each of which utilize the same form of joint, because the joint is not a doughnut cooker.

806.04 (d) Species-Genus, 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, the claims restricted to species in addition to one but not to exceed four additional species, provided they comply with the requirements, 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 first do not include all the limitations of the generic claim, then that species cannot be claimed in the same case with the other species, see 809.02 (c) (2).

806.04 (e) Species-Genus, Claims Restricted to Species

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

Species are always the specifically different embodiments.

They are *usually* but not always independent as disclosed (See 806.04 (b)) since there is usually no disclosure of relationship therebetween. The fact that a genus for two different embodiments is capable of being conceived and defined, does not affect the independence of the embodiments, where the case under consideration contains no disclosure of any community of operation, function or effect.

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

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

806.04 (g) Claims Restricted to Species, Plural Species Claimed

Pending applications are to be permitted to take advantage of Rule 141 at the stage in the prosecution in which it is convenient to do so. Amendments after allowance of an application proposing to add species claims as permitted by the rule, should be admitted by the examiner unless other reasons compel their refusal. (Extract from Notice of Nov. 4, 1949, Revised.)

806.04 (h) Genus - Species, Species Must Be Patentably Distinct From Each Other and From Genus

Where an applicant files a divisional application claiming a species previously claimed 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.

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

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

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

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

806.04 (i) Genus - Species, Generic Claims Rejected When Presented for First Time After Issue

Where an applicant has separate applications for plural species, but presents no generic claim until after the issue of a patent for one of the species, the generic claims cannot be allowed, even though the applications were copending.

806.04 (j) Genus - Species, Generic Claims in One Patent Only (Generic Claims in Application Rejected)

Generic claims covering two or more species which are separately claimed in two or more patents to the same inventor issued on copending applications *must all be present in a single one of the patents.* If present in two or more patents, the generic claims in the later patents are void. Thus generic claims in an application should be rejected on the ground of double patenting in view of the generic claims of the patent.

806.05 Related Embodiments

Where two or more related embodiments 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 not distinct, restriction is never proper. If claimed in separate applications or patents, double patenting must be held, except where the additional applications were filed consonant with a requirement to restrict.

The various pairs of related inventions are noted in following sections. The distinction between them shown as a basis for requiring restriction, or for a holding that there would be no double patenting, must be material.

806.05 (a) Combination or Aggregation and Subcombination

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

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

806.05 (b) Combination and Subcombination, Old Combination—Novel Subcombination

Restriction is never proper between a combination (AB) that the examiner holds to be old and unpatentable and the subcombination (B) in which the examiner holds the novelty, if any, to reside, ex parte Donnell 1923 C. D. 54, 315 O. G. 398. (See 820.01.)

806.05 (c) Combination and Subcombination, Criteria of Distinctness

Broadly stated, where a combination *as claimed* does not require the particulars of the subcombination *as claimed* for its patentability, *and* 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.

806.05 (d) Subcombinations Usable Together

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

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

806.05 (e) Process and Apparatus for Its Practice

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

806.05 (f) Process and Product Made

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

806.05 (g) Apparatus and Product Made

The criteria are the same as in 806.05 (f) substituting apparatus for process.

807 The Practice of Making Patentability Reports Has No Effect Upon Restriction Practice

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

808 Reasons for Insisting Upon Restriction

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

808.01 Independent Inventions

Where the inventions claimed are independent, i. e., where they are not connected in design, operation or effect under the disclosure of the particular application under consideration (806.04), *the facts relied upon for this conclusion are in essence the reasons for insisting upon restriction.* [This situation, except for species (treated in the following section) is but rarely presented, since few persons will file an application containing disclosures of independent things.]

808.01 (a) Species

Where there is no disclosure of relationship between species (see 806.04 (b)), they are independent inventions and election of one is mandatory even though there is no patentable distinction between the species as claimed. Thus the reasons for insisting upon election of one species, are the facts relied upon for the conclusion that there are claims restricted respectively to two or more 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 Rule 141 to not more than four additional species if a generic claim is allowed. Under Office policy as set forth in Rule 141, only one species may be claimed if no generic claim is allowed and no more than five species may be claimed if a generic claim is allowed, *even though the species are not patentably different.*

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.

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 is never proper (806.05). If applicant optionally restricts, double patenting will be held.

Where the related inventions as claimed are shown to be distinct, it is the Office policy to permit them to be claimed in one application where they are classified together, do not have a separate status in the art, and involve the same field of search. The examiner must show by appropriate citation of art at least one of the following, in order to establish reasons for insisting upon division:

(1) Separate classification thereof:

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

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

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

(3) A separate 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 separate field of

search is shown, even though the two are classified together. *The art cited to show a separate field of search must in fact be pertinent to the type of subject matter covered by the claims.*

Where, however, the classification is the same and the field of search is the same and there is no clear indication of separate future classification and field of search, no reasons exist for dividing among related inventions. This is particularly true in the manufacturing arts where manufacturing processes and the resultant product are classified together, e. g. Carbon Compounds Class 260. Under these circumstances, applicant may optionally restrict to one of plural distinct inventions since double patenting will not be held, but it is Office policy not to require restriction.

809 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.

Where the situation exists, and it is found after a complete examination that the linking claims are not allowable, such claims should be rejected and restriction required.

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

Since a rejection of linking claims is a prerequisite to a requirement to restrict, a complete action must be made on such claims, *but no action on novelty and patentability need be made on the claims to the divisible inventions.*

809.01 Practice First Stated

So far as can be determined, this practice was first stated in ex parte Mansfield and Hayes 1902 C. D. 94, 98 O. G. 2363 where a rejection of aggregative claims which linked two inventions (which were divisible in the absence of such aggregative claims) was approved. This was a Commissioner's decision, in which he said that to do otherwise would "amount to piecemeal consideration of the merits of the application."

809.02 Generic Claim Linking Species

Under Rule 141, an allowed generic claim may link up to five disclosed species embraced thereby.

The practice is stated in Rule 146:

Rule 146. Election of species. In the first action on an application containing a generic claim and claims restricted separately to each of more than one species embraced thereby, the examiner, if of the opinion after a complete search on the generic claims that no generic claim presented is allowable, shall require the applicant in his response to that action to elect that species of his invention to which his claims shall be restricted if no generic claim is finally held allowable. However, if such application contains claims directed to more than five species, the examiner may require restriction of the claims to not more than five species before taking any further action in the case.

The last sentence of Rule 146, that the Examiner may require restriction of the claims so that not more than five species are separately claimed is permissive. It may be used in aggravated cases of a multiplicity of species, without acting on generic claims, to narrow the issues down to five species.

809.02 (a) Election Required—Generic Claim Rejected

The most usual situation is where there are claims restricted to more than one disclosed species, and none of the generic claims are allowable. Action as follows should be taken:

(1) Reject the generic claims, making a complete examination thereof.

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

(3) Applicant should then be required to elect a single disclosed species, and advised as to the requisites of a complete response and his rights under Rule 141. The following form paragraphs are suggested:

"None of the generic claims . . . (identify) having been allowed, applicant is required to elect a single disclosed species to which his claims shall be restricted if no generic claim is finally held allowable."

"Applicant is advised that his response must include, in addition to a response to the rejection an identification of the *disclosed* species

that he elects consonant with the requirement, and a listing of all claims readable thereon. An argument that a generic claim is allowable, or that all claims are generic or amended to be generic, unless accompanied by an election, is nonresponsive."

"Upon the allowance of a generic claim applicant will be entitled to consideration of claims to not more than four species in addition to the single elected species, provided all the claims to each additional species are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by Rule 141."

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

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

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

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

It is still necessary to (1) reject the generic claims, if any, or state that none are present, and (2) to clearly identify each species involved. (Notice of January 24, 1956.)

Where the search develops prior art which meets *all the claims*, action on merits of all claims should be given. Election may also be required.

809.02 (b) Election Required—Generic Claim Allowed

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

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

809.02 (c) Action Following Election

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

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

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

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

When any claim directed to one of said additional species *embraced* by an allowed generic claim is not in the required form, *all* claims to that species should be held to be withdrawn from further consideration by the examiner. The holding should be worded somewhat as follows: "Claims _____ directed to species _____ are withdrawn from further consideration in this case, since *all* of the claims to this species do not depend upon or otherwise include all of the limitations of an allowed generic claim as required by Rule 141." When the case is *otherwise ready for issue*, an addition worded somewhat as follows should be added to the holding: "This application is in condition for allowance except for the presence of such claims. Applicant is given thirty days from the date of this letter to amend the claims in conformance to Rule 141 or take other action (Rule 144). Failure to take action during this period will be treated as authorization to cancel claims to the nonelected species by Examiner's Amendment and pass the case to issue. The prosecution of this case is closed except for consideration of the above matter."

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

809.02 (d) No Species Claims

Where only generic claims are first presented and prosecuted in an application and claims to

more than one species are later presented, applicant must indicate an election of a single species at the time of presentation of the species claims.

809.02 (e) Generic Claims Allowable in Substance

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. (Extract from Notice of Apr. 6, 1948.)

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

809.03 Related Inventions, Linking Claims Rejected

There are other situations where claims serve to link related inventions in the manner that species are linked by a generic claim. Whenever two related inventions are distinct from each other as claimed, but there is a claim to invention from which neither is distinct, the claimed "linking" invention must be rejected as a prerequisite to restriction. When this is done, the art used in rejecting the linking claims must be the result of a complete search, and the reasons for rejecting the linking claims must be the best available, but *no action on novelty of the claims to distinct inventions need be given.*

The practice parallels the practice for species when generic claims are rejected.

The best general statement of this practice as applied to situations other than species with a generic claim, is found in ex parte Robinson, Pat. No. 2,329,086. This decision (which was rendered in 1943) discusses a number of prior decisions. In that particular case there was a petition from the examiner's action of requiring restriction between two inventions coupled with a rejection of claims which were found to link those two inventions. The particular holding is quoted: "The practice of rejecting claims of the linking type at the time of making a requirement of division is considered to be not only proper but necessary in order to avoid compelling the examiner to consider the merits of independent inventions and thus unduly burden the Office."

The main difference is, that in addition to showing distinctness (which parallels showing claim restriction to particular disclosed species), reasons for insisting upon division between related inventions that are distinct as claimed must be shown (as in 808.02) whereas the mere showing of claim restriction to separate disclosed species and lack of disclosed relation therebetween is adequate (808.01(a)).

809.03 (a) Types of Linking Claims

The most common types of linking claims which, if allowed, may prevent restriction between two related inventions that can otherwise be shown to be distinct and divisible, are:

Aggregation or combination linking two subcombinations.

Claims to a product defined by process of making the same linking proper product claims and process 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.

809.04 Retention of Claims to Non-Elected Invention

Where the requirement is predicated upon the non-allowability of generic or other type of linking claims, applicant is entitled to retain in the case claims to the non-elected invention or inventions.

If a linking claim is allowed, the Examiner must thereafter examine species not to exceed five if the linking claim is generic thereto, or he must examine the claims to the nonelected inventions that are linked to the elected invention by such allowed linking claim.

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

810 Action on Novelty

In general, except for linking claims (809) when a requirement to restrict is made, no action on novelty and patentability is given.

810.01 Not Objectionable When Coupled With Requirement

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

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

810.02 Usually Deferred

The office policy is to defer action on novelty

and patentability until after the requirement is complied with, withdrawn or made final.

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

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

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

810.03 Given on Elected Invention When Requirement Is Made Final

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

811 Time for Making Requirement

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

This means, make a proper requirement as early as possible in the prosecution, in the first

action if possible, otherwise as soon as a proper requirement develops.

811.01 Proper Even Though Late in Prosecution

Rule 142 (a) makes it clear that restriction may be required at any stage, however late, in the prosecution up to the time of final action.

811.02 Even After Compliance With Preceding Requirement

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

811.03 Repeating After Withdrawal—Proper

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

811.04 Proper Even Though Grouped Together in Parent Case

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

812 Who Should Make the Requirement

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

An examiner ordinarily should not require restriction in an application *none* of the claimed subject matter of which is classifiable in his division. Such an application should be transferred to a division to which at least some of the subject matter belongs. Exceptions may arise in which immediate transfer is not expedient, e. g., when transfer would be contrary to 903.08 (a).

813 Citation of Art

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

B. *Independent inventions — no linking claims.* Art resulting from a cursory search pertinent to the several inventions is cited. It is not necessary to cite art to show separate classification, a separate status in the art or a separate field of search, where it is shown that the inventions as disclosed in that particular case are in fact independent.

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

It is noted that the art referred to in the above cases constitutes a general guide to the applicant to aid him in his election. *Where the citation of art to establish distinctness of inventions is necessary*, the art must be pertinent to the particular point being made, for example, art may be cited to show that a product can be made by processes other than that claimed.

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 Section 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.

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 re-

quirement 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 division and the examiner has any doubt as to the proper line among the same, he should refer the application to the examiner of the other division for information on that point and such examiner should render the necessary assistance.

816 Give Reasons for Holding of Independence or Distinctness

The particular reasons relied upon by the Examiner for his holding that the inventions as claimed are either independent or distinct, should be concisely stated. A mere statement of conclusion is inadequate. The reasons upon which the conclusion is based should be given.

For example, relative to combination and a subcombination thereof, the examiner should point out the reasons why he considers the subcombination to have utility by itself or in other combinations, and why he considers that the combination as *claimed* does not rely upon the subcombination as its essential distinguishing part.

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

817 Outline of Restriction Requirement and Sample Letter

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

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

The following outline for a requirement to restrict and sample letter is intended to cover every type of original restriction requirement between related inventions including those having linking claims, but not treatment on the grounds set forth in 821–821.03.

Outline and Sample Letter

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

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

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

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

D. Special treatment of ungrouped claims
- Linking claims
  - Reject
    - Make complete rejection, giving reasons therefor
  - Statement on groups to which linking claims may be assigned for examination
- Other ungrouped claims
  - Indicate disposition
    - e. g.: previously nonelected, nonstatutory, canceled, etc.

E. 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 cited patent
      - Demonstrate by Examiner's suggestion
  - (2) Combination—Subcombination
    - Combination as claimed does *not* require subcombination

AND

- Subcombination usable alone or in other identified combination
  - Demonstrate by cited patent
  - Demonstrate by Examiner's suggestion

Sample Letter

POL-90
Rev.
ADDRESS ONLY
THE COMMISSIONER OF PATENTS
WASHINGTON 25, D. C.

U. S. DEPARTMENT OF COMMERCE
PATENT OFFICE
WASHINGTON

All communications respecting this application should give the serial number, date of filing, and name of the applicant.

PAPER NO. 3

John A. Smith
16,753 Main Street
Detroit 2, Michigan

Applicant:	James A. Black et al.
Ser. No.	733,946
Filed	January 3, 1954
For	INTERNAL COMBUSTION ENGINE

MAILED
JULY 16, 1954
PAT. DIV. 28

16—6845T-4 GPO

Please find below a communication from the EXAMINER in charge of this application.

Robert C. Watson
Commissioner of Patents.

This application has been examined.

Patents cited to show classification:

I.	Smith	2,145,789	Dec. 25, 1950	123-31
	Jones et al.	2,467,899	Jan. 11, 1951	123-31
II.	Doe	2,567,890	Mar. 23, 1951	261-34
	Roe	2,699,999	June 13, 1952	261-34
III.	Brown	2,724,234	Sept. 23, 1953	123-12
	White	2,825,780	Apr. 21, 1950	123-12

Restriction to one of the following inventions is required:

I. Claims 1 to 6 drawn to an internal combustion combination, classified with the Smith and Jones et al patents.

II. Claims 7 to 12, drawn to a carburetor subcombination, classified with the Doe and Roe patents.

III. Claims 13 to 18 drawn to a spark plug subcombination, classified with the Brown and White patents.

Restriction as between groups II and III is contingent upon the non-allowance of claim 19 (including details of both group II and group III and hence not distinct from either group). For the purpose of examination, claim 19 will be retained with group II or III, if either is elected.

Claim 19, which is drawn to an igniter and fuel supply unit and recites the specific details of both a carburetor and a spark plug is rejected on the ground of aggregation (give statement of reasons).

Claim 20 is rejected as indefinite and not in compliance with 35 U.S.C. 112, and accordingly is not assigned to any group.

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

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

Applicants are advised that their response to be complete must include a provisional election of one of the above inventions identified as I, II, and III (see Rule 143), even though they traverse the requirement. An argument that a linking claim such as claim 19 is allowable, unless accompanied by reasons why the subcombinations of II and III are considered indivisible in the absence of such claims, will not be considered a traverse.

Should a claim of the character of claim 19 subsequently be found allowable the question of restriction as between group II and group III will again be considered.

ABClark/nes

Examiner

(3) Process—Apparatus
Process can be carried out by hand or by other apparatus
Demonstrate by cited patent
Demonstrate by Examiner's suggestion
OR
Demonstrate apparatus can be used in other process (rare).
(4) Process and/or apparatus—Product
Demonstrate claimed product can be made by other process (or apparatus)
By cited patent
By Examiner's suggestion
OR
Process (or apparatus) can produce other product (rare)
F. Allegation of reasons for insisting upon restriction
Must be demonstrated by citation of art
Separate status in the art
Different classification
Refer to exemplary patents
Same classification
Refer to exemplary patents
Divergent fields of search
Search required for one group not required for the other

818 Election and Response

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

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.

818.01 Election Fixed by Action on Claims

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

818.02 Election Other Than Express

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

818.02 (a) By Originally Presented Claims

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

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 section 821.03.

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

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

818.02 (c) By Optional Cancellation of Claims

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

818.03 Express Election and Traverse

Rule 143. Reconsideration of requirement. If the applicant disagrees with the requirement for restriction, he may request reconsideration and withdrawal or modification of the requirement, giving the reasons therefor (see rule 111). In requesting reconsideration the applicant must indicate a provisional election of one invention for prosecution, which invention shall be the one elected in the event the requirement becomes final. The requirement for restriction will be reconsidered on such a request. If the requirement is repeated and made final, the examiner will at the same time act on the claims to the invention elected.

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

818.03 (a) Response Must Be Complete

As shown by the first sentence of Rule 143, the traverse to a requirement must be complete

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

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

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

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

All requirements should have as a concluding paragraph a sentence stating in substance: "Applicant is advised that his response to be complete must include an election consonant with the requirement, see Rule 143."

The suggested concluding statement should be reworded to fit the facts of the particular requirement, e. g., as in 809.02 (a) second form paragraph under (3) and 817 at the end of the sample letter.

818.03 (c) Must Traverse To Preserve Right of Petition

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

818.03 (d) Traverse of Rejection of Linking Claims

A traverse of the rejection of the linking claims is not a traverse of the requirement to restrict, it is a traverse of a holding of nonpatentability.

Election combined with a traverse of the rejection 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 allowed and improper if they are allowed. If the Office allows such a claim it is bound to withdraw the requirement and to act on all linked inventions. *But once all linking claims are canceled Rule 144 would apply*, since the record would be one of agreement as to the propriety of restriction.

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

818.03 (e) Applicant Must Make His Own Election

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

819 Office Generally Does Not Permit Shift

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

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

819.01 Office May Waive Election and Permit Shift

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). Having accepted a shift, case is not abandoned (Meden v. Curtis, 1905 C. D. 272; 117 O. G. 1795).

820 Not an Election; Permissible Shift

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

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

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

820.01 Old Combination Claimed—Not an Election

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 (see 806.05 (b)) only, and these claims are rejected on the ground of "old combination," subsequently presented claims to subcombination (B) of the originally claimed combination should not be rejected on the ground of previous election of the combination, nor should this rejection be applied to such combination claims if they are reasserted. Final rejection of the reasserted "old combination" claims is the action that should be taken. The combination and subcombination as defined by the claims under this special situation are not for distinct inventions. (See 806.05 (c).)

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 that he claimed.

821 Treatment of Claims Held to be Drawn to Non-Elected Inventions

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

The propriety of a requirement to restrict, if traversed, is reviewable by petition under Rule 144.

All claims that the Examiner holds are not directed to the elected subject matter should be withdrawn from further consideration by the Examiner as set forth in section 809.02 (c) and 821.01 through 821.03. As to one or more of such claims the applicant may traverse the Examiner's holding that they are not directed to the elected subject matter. The propriety of this holding, if traversed, is *appealable*. Thus, if the Examiner adheres to his position after such traverse, he should *reject* the claims to which the traverse applies on the ground that they are not directed to the elected subject matter. Claims for which no traverse is presented should be withdrawn under Rule 142 (b) as indicated in the other, above noted, section.

821.01 After Election With Traverse

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

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

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

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

When the case is otherwise ready for issue, the examiner should treat the case substantially as follows:

Claims _____ stand allowed.

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

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

821.02 After Election Without Traverse

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

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

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

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

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

821.03 Claims for Different Invention Added After an Office Action

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

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

The action should take substantially the following form:

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

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

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

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

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

822 Claims to Inventions That Are Not Distinct in Plural Applications of Same Inventor

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

(b) Where two or more applications filed by the same applicant, or owned by the same party, 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 in more than one application.

See 304 for conflicting subject matter in two applications, same inventor, one assigned.

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

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

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

See 709.01 for one application in interference.

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

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

to restrict which the examiner now considers to be improper.

822.01 Co-pending Before the Examiner

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

Where claims in one application are unpatentable over claims of another application of the same inventor (either because they recite the same subject matter, or because the prior art shows that the differences do not impart a patentable distinction), a complete examination should be made of the claims of one application. The claims of the other application may be rejected on the claims of the one examined, *whether the claims of the one examined are allowed or not.*

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