

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

<b>801</b>	<b>Introduction</b>	806.05(g)	Apparatus and Product Made *
<b>802</b>	<b>Basis for Practice in Statute and Rules</b>	806.05(h)	Product and Process of Using
802.01	Meaning of “Independent” and “Distinct”	806.05(i)	Product, Process of Making, and Process of Using **
802.02	Definition of Restriction	>806.05(j)	Related Products; Related Processes
<b>803</b>	<b>Restriction — When Proper</b>	806.06	Independent Inventions<
803.01	Review by Examiner With at Least Partial Signatory Authority	<b>807</b>	<b>Patentability Report Practice Has No Effect on Restriction Practice</b>
803.02	* Markush Claims	<b>808</b>	<b>Reasons for Insisting Upon Restriction</b>
803.03	* Transitional Applications	808.01	**>Reasons for Holding of Independence or Distinctness<
803.03(a)	Transitional Application — Linking Claim Allowable	808.01(a)	Species
803.03(b)	Transitional Application — Generic Claim Allowable	808.02	**>Establishing Burden<
803.04	* Nucleotide Sequences	<b>809</b>	<b>* Linking **&gt;Claims&lt;</b>
<b>804</b>	<b>Definition of Double Patenting</b>	**	
804.01	Prohibition of Double Patenting Rejections Under 35 U.S.C. 121	809.02(a)	Election >of Species< Required
804.02	Avoiding a Double Patenting Rejection	**	
804.03	** Commonly Owned *>Inventions< of Different Inventive Entities>; Non-Commonly Owned *>Inventions< Subject to a Joint Research Agreement<	809.03	**>Restriction Between Linked Inventions<
804.04	Submission to Technology Center Director	**	
<b>805</b>	<b>Effect of Improper Joinder in Patent</b>	<b>810</b>	<b>Action on the Merits</b>
<b>806</b>	<b>Determination of Distinctness or Independence of Claimed Inventions</b>	**	
806.01	Compare Claimed Subject Matter	<b>811</b>	<b>Time for Making Requirement</b>
**		811.02	*>New Requirement< After Compliance With Preceding Requirement
806.03	Single Embodiment, Claims Defining Same Essential Features	811.03	Repeating After Withdrawal Proper
806.04	**>Genus and/or Species< Inventions	811.04	Proper Even Though Grouped Together in Parent Application
**		<b>812</b>	<b>Who Should Make the Requirement</b>
806.04(b)	Species May Be >Independent or< Related Inventions	812.01	Telephone Restriction Practice
**		<b>814</b>	<b>Indicate Exactly How Application Is To Be Restricted</b>
806.04(d)	Definition of a Generic Claim	<b>815</b>	<b>Make Requirement Complete</b>
806.04(e)	Claims * >Limited< to Species	**	
806.04(f)	**>Restriction Between< Mutually Exclusive *>Species<	<b>817</b>	<b>Outline of Letter for Restriction Requirement</b>
806.04(h)	Species Must Be Patentably Distinct From Each Other	**	
806.04(i)	Generic Claims Presented ** After Issue of Species	<b>818</b>	<b>Election and Reply</b>
806.05	Related Inventions	818.01	Election Fixed by Action on Claims
806.05(a)	Combination and Subcombination **	818.02	Election Other Than Express
**		818.02(a)	By Originally Presented Claims
806.05(c)	Criteria of Distinctness *>Between< Combination *>and< Subcombination **	818.02(b)	Generic Claims Only — No Election of Species
806.05(d)	Subcombinations Usable Together	818.02(c)	By Optional Cancellation of Claims
806.05(e)	Process and Apparatus for Its Practice *	818.03	Express Election and Traverse
806.05(f)	Process of Making and Product Made *	818.03(a)	Reply Must Be Complete
		818.03(b)	Must Elect, Even When Requirement Is Traversed
		818.03(c)	Must Traverse To Preserve Right of Petition
		818.03(d)	Traverse of **>Restriction Requirement With< Linking Claims
		**	
		<b>819</b>	<b>Office Generally Does Not Permit Shift</b>
		**	

**821 Treatment of Claims Held To Be Drawn to Non-elected Inventions**

- 821.01 After Election With Traverse
- 821.02 After Election Without Traverse
- 821.03 Claims for Different Invention Added After an Office Action
- 821.04 Rejoinder
- >821.04(a) Rejoinder Between Product Inventions; Rejoinder Between Process Inventions
- 821.04(b) Rejoinder of Process Requiring an Allowable Product<

**822 Claims to Inventions That Are Not Distinct in Plural Applications of Same Inventive Entity**

- 822.01 Copending Before the Examiner

**823 Unity of Invention Under the Patent Cooperation Treaty****801 Introduction**

This chapter is limited to a discussion of the subject of restriction and double patenting under Title 35 of the United States Code and Title 37 of the Code of Federal Regulations as it relates to national applications filed under 35 U.S.C. 111(a). 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 U.S. 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 Director 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

Director may dispense with signing and execution by the inventor. The validity of a patent shall not be questioned for failure of the Director to require the application to be restricted to one invention.

*37 CFR 1.141. Different inventions in one national 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 the 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 an Office action will require the applicant in the reply to that action to elect an invention to which the claims will be restricted, this official action being called a requirement for restriction (also known as a requirement for division). Such requirement will normally be made before any action on the merits; however, it may be made at any time before final action.

(b) Claims to the invention or inventions not elected, if not canceled, 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 1850, 1875, and 1893.03(d) should be consulted for discussions on unity of invention:

- (A) before the International Searching Authority;
- (B) before the International Preliminary Examining Authority; and
- (C) in the National Stage under 35 U.S.C. 371.

**802.01 Meaning of “Independent” and “Distinct” [R-3]**

35 U.S.C. 121 quoted in the preceding section states that the \*>Director< 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 \*inventions< as between which the \*Director< 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 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 \*inventions< between which the \*Director< may properly require division.

The term “independent” as already pointed out, means not dependent. A large number of \*inventions< between which, prior to the 1952 Act, division had been proper, are dependent \*inventions<, such as, for example, 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 \*Director< never to approve division between dependent inventions, the word “independent” would clearly have been used alone. If the \*Director< has authority or discretion to restrict independent inventions only, then restriction would be improper as between dependent inventions, e.g., the examples used for purpose of illustration above. Such was clearly 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.

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## I. < INDEPENDENT

The term “independent” (i.e., not dependent) means that there is no disclosed relationship between the two or more \*\*inventions claimed<, that is, they are unconnected in design, operation, \*and< effect\*. For< example \*\*, a< process and >an< apparatus incapable of being used in practicing the process\* >are independent inventions. See also MPEP § 806.06 and § 808.01.

## II. < DISTINCT

\*\*>Two or more inventions are related (i.e., not independent) if they are disclosed as connected in at least one of design (e.g., structure or method of manufacture), operation (e.g., function or method of use), or effect. Examples of related inventions include< combination and part (subcombination) thereof, process and apparatus for its practice, process and product made, etc. \*\*>In< this definition the term related is used as an alternative for dependent in referring to \*inventions< other than independent \*inventions<.

>Related inventions are distinct if the inventions *as claimed* are not connected in at least one of design, operation, or effect (e.g., can be made by, or used in, a materially different process) and wherein at least one invention is PATENTABLE (novel and nonobvious) OVER THE OTHER (though they may each be unpatentable over the prior art). See MPEP § 806.05(c) (combination and subcombination) and § 806.05(j) (related products or related processes) for examples of when a two-way test is required for distinctness.<

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

## 802.02 Definition of Restriction [R-3]

Restriction \*\*>is< the practice of requiring an \*\*>applicant to elect a single claimed invention (e.g., a combination or subcombination invention, a product or process invention, a species within a genus) for examination when two or more independent inventions and/or two or more distinct inventions are claimed in an application.<

### 803 Restriction — When Proper [R-3]

Under the statute, the claims of 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 § 802.01, § 806.06, and § 808.01) or distinct (MPEP § 806.05 - § 806.05(j)).

If the search and examination of all the claims in an application can be made without serious burden, the examiner must examine them on the merits, even though they include claims to independent or distinct inventions.

>

#### I. < CRITERIA FOR RESTRICTION BETWEEN PATENTABLY DISTINCT INVENTIONS

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

(A) The inventions must be independent (see MPEP § 802.01, § 806.06, § 808.01) or distinct as claimed (see MPEP § 806.05 - § 806.05(j)); and

(B) There would be a serious burden on the examiner if restriction is not required (see MPEP § 803.02, § 808, and § 808.02).

>

#### II. < GUIDELINES

Examiners must provide reasons and/or examples to support conclusions, but need not cite documents to support the restriction 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 would have been obvious over each other within the meaning of 35 U.S.C. 103, restriction should not be required. *In re Lee*, 199 USPQ 108 (Comm'r Pat. 1978).

For purposes of the initial requirement, a serious burden on the examiner may be *prima facie* shown by appropriate explanation of separate classification, or 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 - § 806.04(i) and § 808.01(a).

### 803.01 Review by Examiner with at Least Partial Signatory Authority [R-3]

Since requirements for restriction under 35 U.S.C. 121 are discretionary with the Director, 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, only an examiner with permanent full signatory authority or temporary full signatory authority may sign final Office actions containing a final requirement for restriction. An examiner with permanent partial signatory authority or temporary partial signatory authority may sign non-final Office actions containing a final requirement for restriction.

### 803.02 \* Markush Claims [R-3]

A Markush-type claim recites alternatives in a format such as “selected from the group consisting of A, B and C.” See *Ex parte Markush*, 1925 C.D. 126 (Comm'r Pat. 1925). The members of the Markush group (A, B, and C in the example above) ordinarily must belong to a recognized physical or chemical class or to an art-recognized class. However, when the Markush group occurs in a claim reciting a process or a combination (not a single compound), it is sufficient if the members of the group are disclosed in the specification to possess at least one property in common which is mainly responsible for their function in the

claimed relationship, and it is clear from their very nature or from the prior art that all of them possess this property. Inventions in metallurgy, refractories, ceramics, pharmacy, pharmacology and biology are most frequently claimed under the Markush formula but purely mechanical features or process steps may also be claimed by using the Markush style of claiming. See MPEP § 2173.05(h).<

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 the members of the Markush group in the claim on the merits, even though they \*>may be< directed to independent and distinct inventions. In such a case, the examiner will not follow the procedure described below and will not require \*>provisional election of a single species<.

Since the decisions in *In re Weber*, 580 F.2d 455, 198 USPQ 328 (CCPA 1978) and *In re Haas*, 580 F.2d 461, 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 \*>Harnisch<*, 631 F.2d 716, 206 USPQ 300 (CCPA 1980); and *Ex parte Hozumi*, 3 USPQ2d 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 \*\* essential to that utility.

This subsection deals with Markush-type generic claims which \*>recite< 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. A Markush-type claim \*>may< 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 \*\*>a Markush-type claim that encompasses at least two independent or distinct inventions<, the examiner may require a provisional election of a single species prior to examination on the merits. \*\*>An examiner should set forth a requirement for election of a single disclosed species in a Markush-type claim using form paragraph 8.01 when

claims limited to species are present or using form paragraph 8.02 when no species claims are present. See MPEP § 808.01(a) and § 809.02(a).< 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. If the Markush-type claim is not allowable over the prior art, >the provisional election will be given effect and< 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 \*>X-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, \*\*>XA, XB, XC, XD, or XE<. 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 nonelected species would be held withdrawn from further consideration. \*\*>A< second action on the rejected claims \*>can< be made final >unless the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p). See MPEP § 706.07(a)<.

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 nonelected species held withdrawn from further consideration. The prior art search, however, will not be extended unnecessarily to cover all nonelected 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 can be made final unless the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p). See MPEP § 706.07(a). Amendments submitted after the final rejection further restricting the scope of the claim may be denied entry if they do not comply with the requirements of 37 CFR 1.116. See MPEP § 714.13.

If a Markush claim depends from or otherwise requires all the limitations of another generic or linking claim, see MPEP § 809.

### 803.03 \* Transitional Applications [R-3]

#### PRACTICE RE TRANSITIONAL APPLICATION

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

\*\*\*\*\*

(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.

37 CFR 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:

(A) 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;

(B) 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

(C) 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:

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

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

(C) 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

(D) 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 (A) and (B), the fact that the present or parent application claiming independent and distinct inventions was on an examiner’s docket for at least 3 months prior to abandonment or suspension, or in examples (C) and (D), 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 3 months prior to April 8, 1995, is *prima facie* evidence that applicant’s actions did not prevent 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 Technology Center (TC) Special Program Examiner 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:

(A) 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,

(B) in situations where an election was made in reply 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

(C) 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.

37 CFR 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 the 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 a 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 O.G. 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. See the current fee schedule for the proper amount of the fee.

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 form 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.

**803.03(a) Transitional Application — Linking Claim Allowable [R-3]**

Whenever divided inventions in a transitional application are rejoined because a linking claim is *>allowable<* (MPEP § 809, § 821.04, and § 821.04(a)) 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-3]**

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 from consideration because they are fully embraced by an *>allowable<* generic claim, applicant should be notified that he or she may request a refund of the fee paid for that additional species.

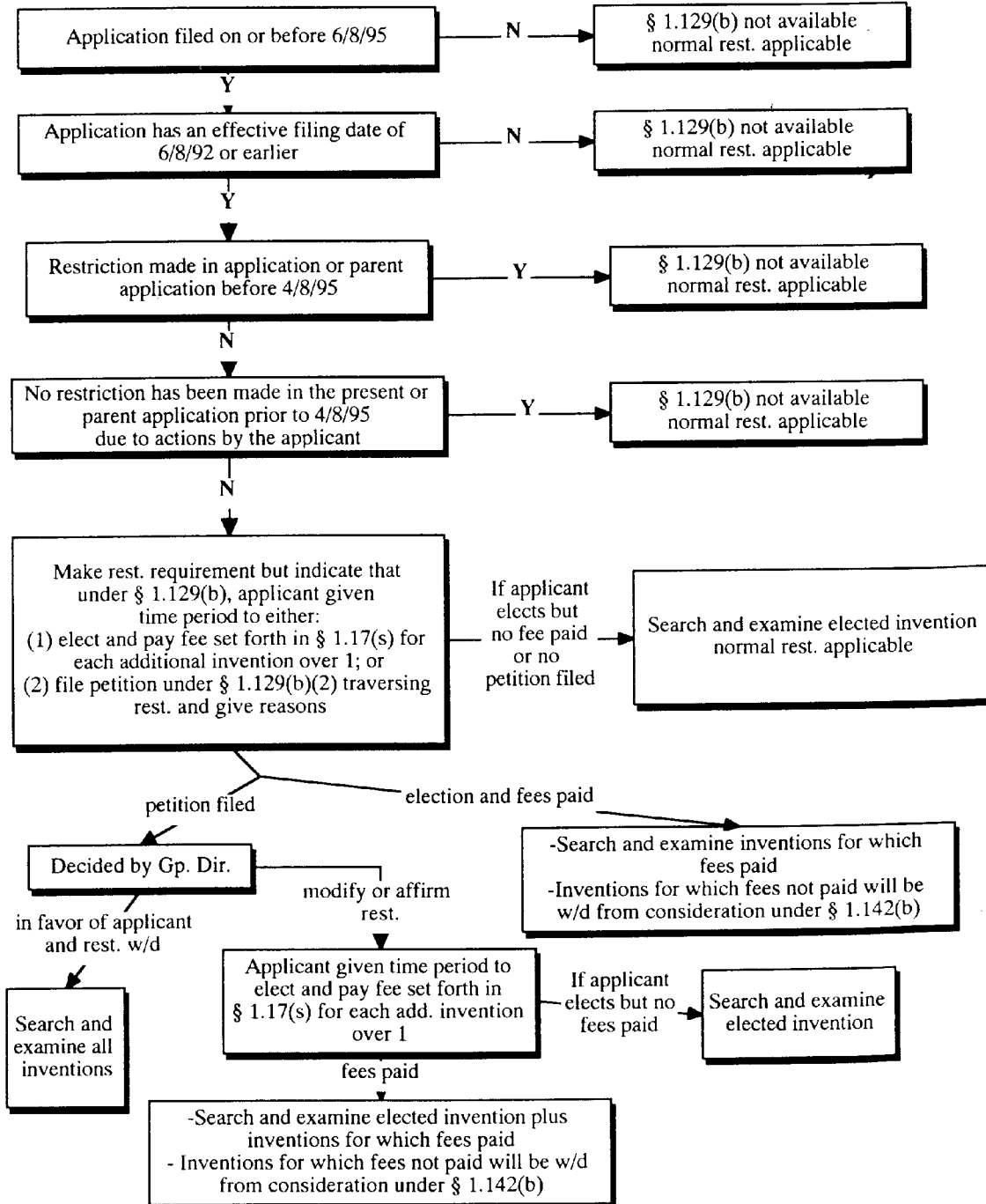
The determination of when claims to a nonelected species would no longer be withdrawn from consideration should be made as indicated in MPEP § 806.04(d), § 821.04, and § 821.04(a).

**Transitional Restriction Provision - 37 CFR 1.129(b)**

**Starting June 8, 1995**

**No Telephone restriction**

**Charge time for examination of additional inventions to 112055**



### 803.04 \* Nucleotide Sequences [R-3]

By statute, “[i]f two or more independent and distinct inventions are claimed in one application, the \*>Director< may require the application to be restricted to one of the inventions.” 35 U.S.C. 121. Pursuant to this statute, the rules provide that “[i]f two or more independent and distinct inventions are claimed in a single application, the examiner in his action shall require the applicant . . . to elect that invention to which his claim shall be restricted.” 37 CFR 1.142(a). See also 37 CFR 1.141(a).

\*>Polynucleotide molecules defined by their nucleic acid sequence (hereinafter “nucleotide sequences”) that encode< different proteins are structurally distinct chemical compounds\*. These sequences are thus deemed to normally constitute independent and distinct inventions within the meaning of 35 U.S.C. 121. Absent evidence to the contrary, each such nucleotide sequence is presumed to represent an independent and distinct invention, subject to a restriction requirement pursuant to 35 U.S.C. 121 and 37 CFR 1.141 *et seq.* Nevertheless, to further aid the biotechnology industry in protecting its intellectual property without creating an undue burden on the Office, the \*>Director< has decided *sua sponte* to partially waive the requirements of 37 CFR 1.141 *et seq.* and permit a reasonable number of such nucleotide sequences to be claimed in a single application. See *Examination of Patent Applications Containing Nucleotide Sequences*, 1192 O.G. 68 (November 19, 1996).

It has been determined that normally ten sequences constitute a reasonable number for examination purposes. Accordingly, in most cases, up to ten independent and distinct nucleotide sequences will be examined in a single application without restriction. In addition to the specifically selected sequences, those sequences which are patentably indistinct from the selected sequences will also be examined. Furthermore, nucleotide sequences encoding the same protein are not considered to be independent and distinct inventions and will continue to be examined together.

In some exceptional cases, the complex nature of the claimed material, for example a protein amino acid sequence reciting three dimensional folds, may necessitate that the reasonable number of sequences to be selected be less than ten. In other cases, applicants may petition pursuant to 37 CFR 1.181 for examina-

tion of additional nucleotide sequences by providing evidence that the different nucleotide sequences do not cover independent and distinct inventions.

See MPEP § 1850 for treatment of claims containing independent and distinct nucleotide sequences in international applications filed under the Patent Cooperation Treaty (PCT) and national stage applications filed under 35 U.S.C. 371.

#### EXAMPLES OF NUCLEOTIDE SEQUENCE CLAIMS

Examples of typical nucleotide sequence claims impacted by the partial waiver of 37 CFR 1.141 *et seq.* (and the partial waiver of 37 CFR 1.475 and 1.499 *et seq.*, see MPEP § 1850) include:

(A) an isolated and purified DNA fragment comprising DNA having at least 95% identity to a DNA sequence selected from SEQ ID Nos. 1-1,000;

(B) a combination of DNA fragments comprising SEQ ID Nos. 1-1,000; and

(C) a combination of DNA fragments, said combination containing at least thirty different DNA fragments selected from SEQ ID Nos. 1-1,000.

Applications claiming more than ten individual independent and distinct nucleotide sequences in alternative form, such as set forth in example (A), will be subject to a restriction requirement. Only the ten nucleotide sequences selected in response to the restriction requirement and any other claimed sequences which are patentably indistinct therefrom will be examined.

Applications claiming only a combination of nucleotide sequences, such as set forth in example (B), will generally not be subject to a restriction requirement. The presence of one novel and nonobvious sequence within the combination will render the entire combination allowable. The combination will be searched until one nucleotide sequence is found to be allowable. The order of searching will be chosen by the examiner to maximize the identification of an allowable sequence. If no individual nucleotide sequence is found to be allowable, the examiner will consider whether the combination of sequences taken as a whole renders the claim allowable.

Applications containing only composition claims reciting different combinations of individual nucleotide sequences, such as set forth in example

(C), will be subject to a restriction requirement. Applicants will be required to select one combination for examination. If the selected combination contains ten or fewer sequences, all of the sequences of the combination will be searched. If the selected combination contains more than ten sequences, the combination will be examined following the procedures set forth above for example (B). More specifically, the combination will be searched until one nucleotide sequence is found to be allowable with the examiner choosing the order of search to maximize the identification of an allowable sequence. The identification of any allowable sequence(s) will cause all combinations containing the allowed sequence(s) to be allowed.

In applications containing all three claims set forth in examples (A)-(C), the Office will require restriction of the application to ten sequences for initial examination purposes. Based upon the finding of allowable sequences, claims limited to the allowable sequences as in example (A), all combinations, such as in examples (B) and (C), containing the allowable sequences and any patentably indistinct sequences will be rejoined and allowed.

\*\*>Nonelected claims< requiring any allowable >nucleotide< sequence(s) >should be considered for rejoinder. See MPEP § 821.04<. \*\*

## 804 Definition of Double Patenting [R-3]

### 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 therefor, 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 Director 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 Director may dispense with signing and execution by the inventor.

The validity of a patent shall not be questioned for failure of the Director 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, \*\* two or more patents or applications >must have at least one common inventor and/or be either commonly assigned/owned or non-commonly assigned/owned but subject to a joint research agreement as set forth in 35 U.S.C. 103(c)(2) and (3) pursuant to the CREATE Act (Pub. L. 108-453, 118 Stat. 3596 (2004)). Congress recognized that the amendment to 35 U.S.C. 103(c) would result in situations in which there would be double patenting rejections between applications not owned by the same party (see H.R. Rep. No. 108-425, at 5-6 (2003)). For purposes of a double patenting analysis, the application or patent and the subject matter disqualified under 35 U.S.C. 103(c) as amended by the CREATE Act will be treated as if commonly owned. See also MPEP § 804.03.< 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 generally 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 rejections based on either a one-way determination of obviousness or a two-way determination of obviousness. Nonstatutory double patenting could include a rejection which is not the usual “obviousness-type” double patenting rejection. This type of double patent-

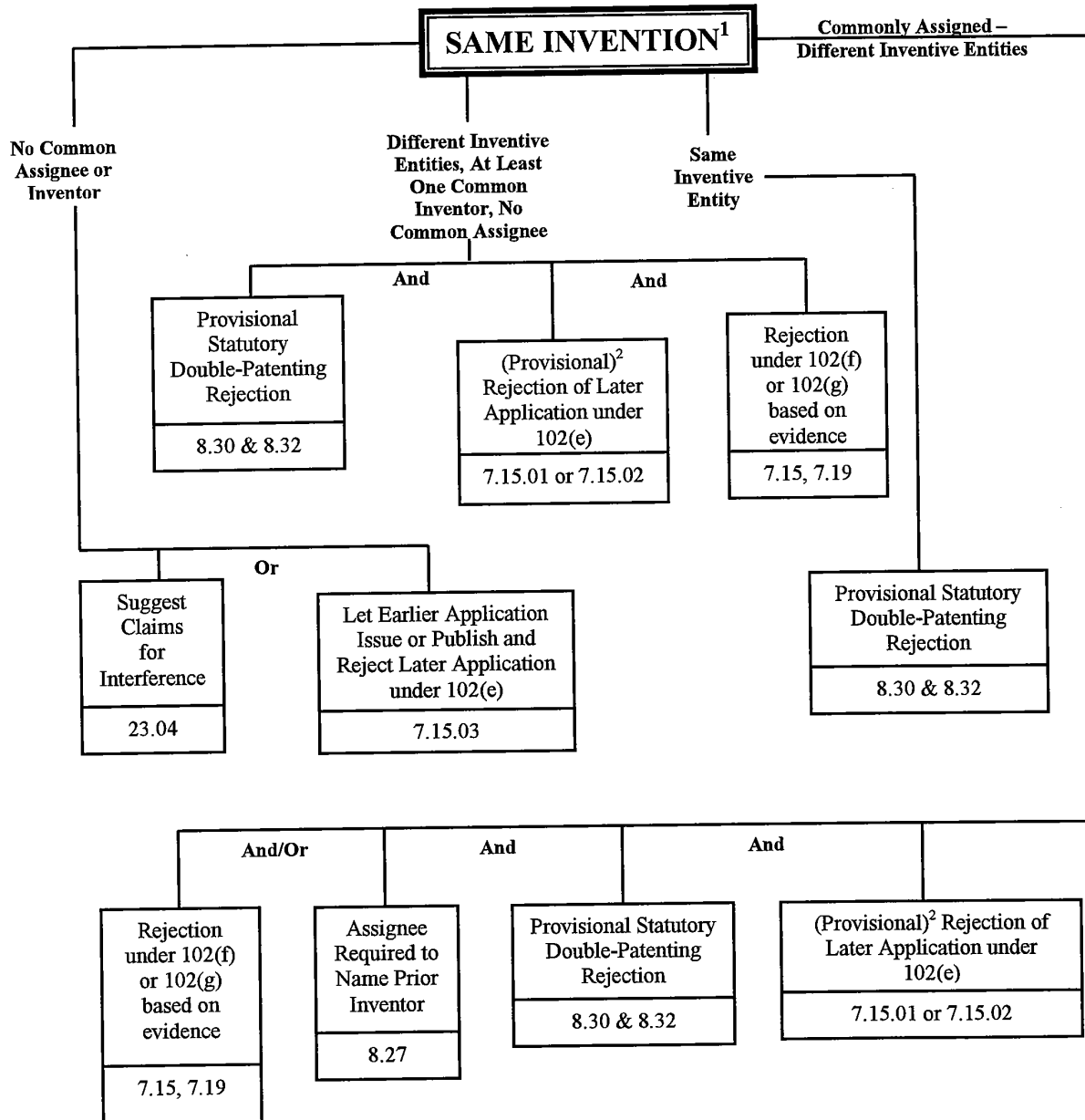
ing rejection is rare and is limited to the particular facts of the case. *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968).

Refer to Charts I-A, I-B, II-A, and II-B for an overview of the treatment of applications having conflicting claims (e.g., where a claim in an application is not patentably distinct from a claim in a patent or another application). See MPEP § 2258 for information pertaining to double patenting rejections in reexamination proceedings.

\*\*>

**CONFLICTING CLAIMS BETWEEN  
TWO APPLICATIONS**

CHART I-A

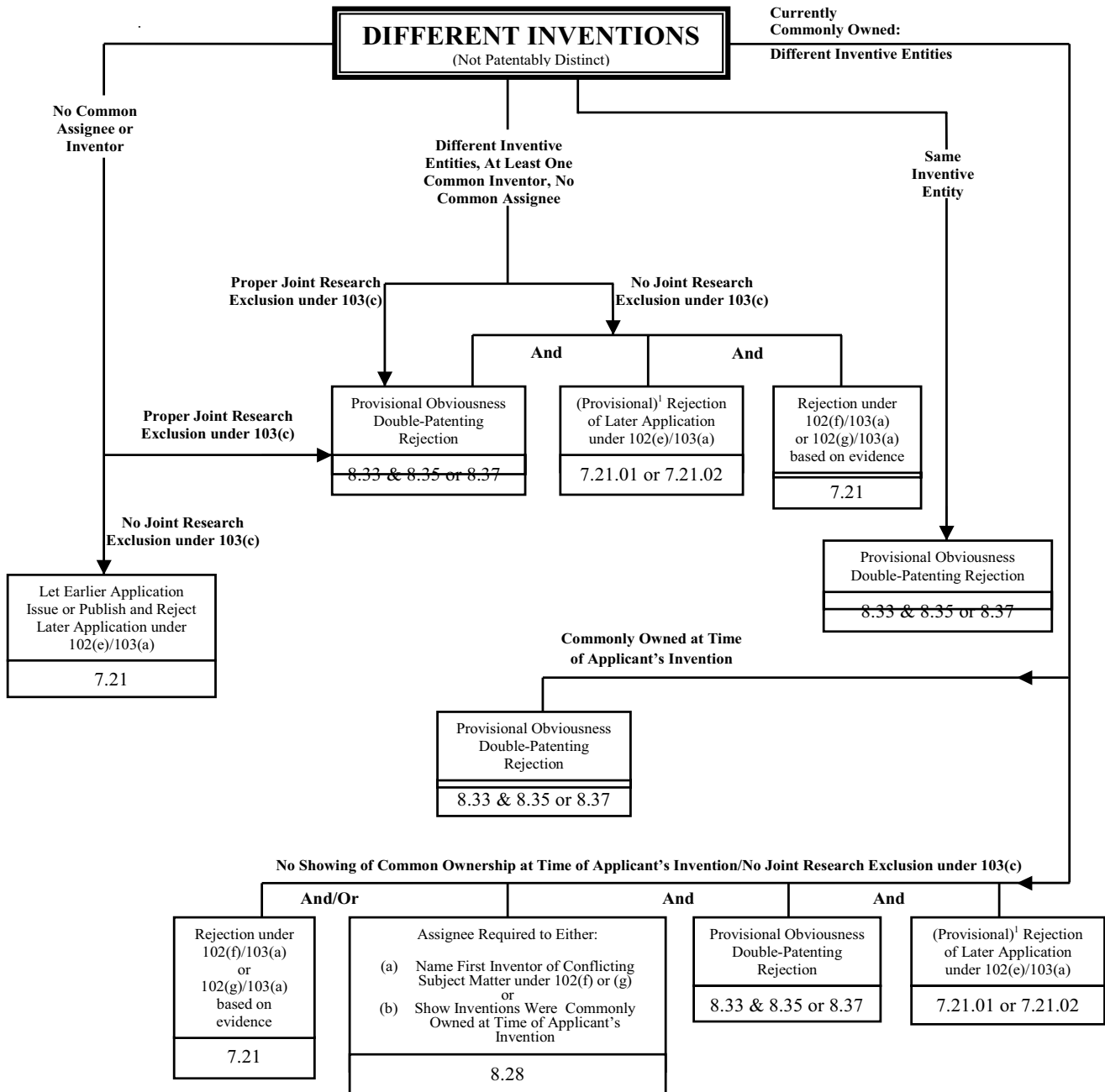


<sup>1</sup> The joint research exclusion of 35 U.S.C. 103(c) is not applicable.

<sup>2</sup> Where the application being applied as a reference has NOT been published, the rejection under 102(e) should be provisional.

**CONFLICTING CLAIMS BETWEEN  
TWO APPLICATIONS**

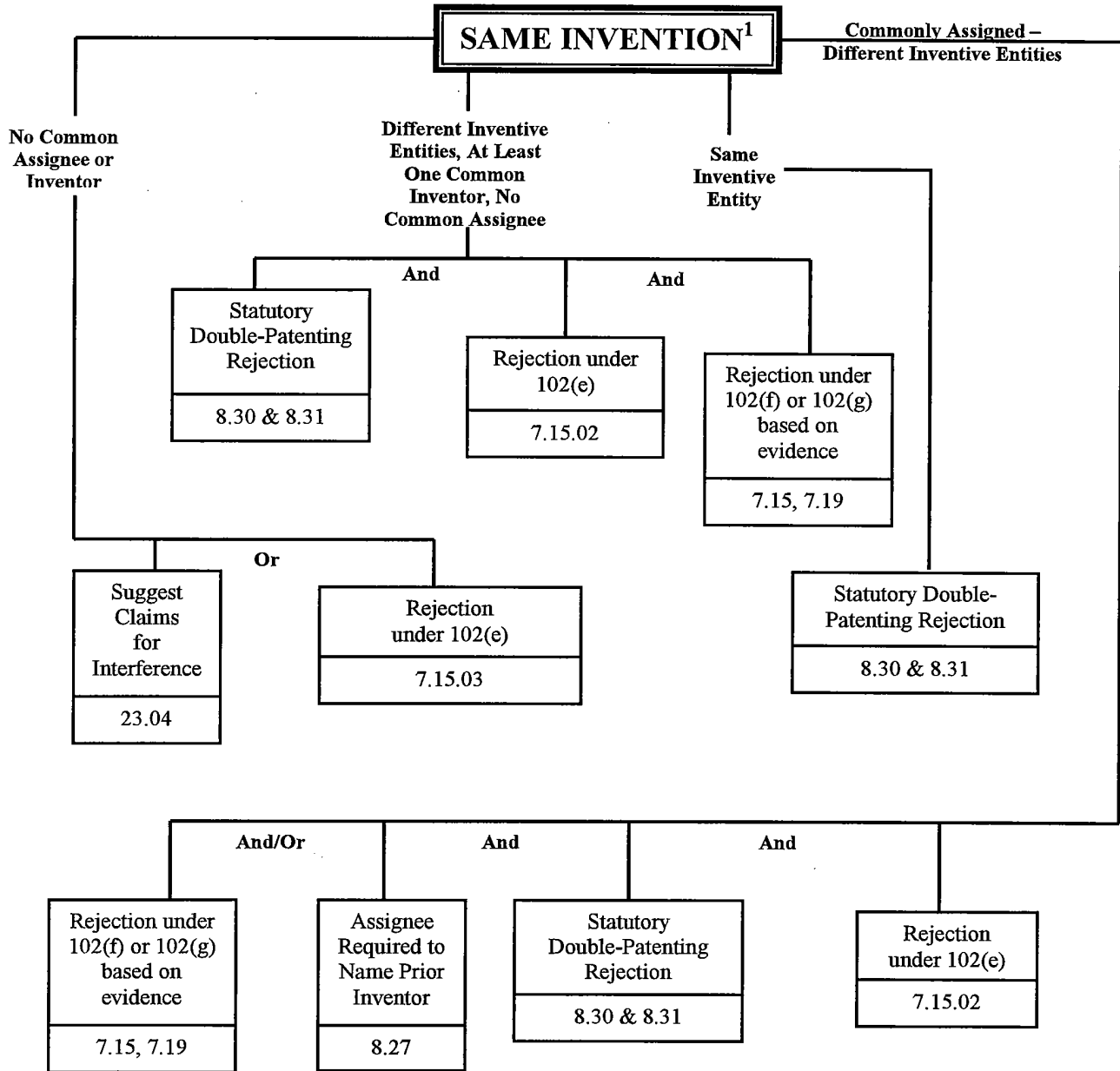
**CHART I-B**



<sup>1</sup> Where the application being applied as a reference has NOT been published, the rejection under 102(e)/103(a) should be provisional.

**CONFLICTING CLAIMS BETWEEN  
AN APPLICATION AND A PATENT**

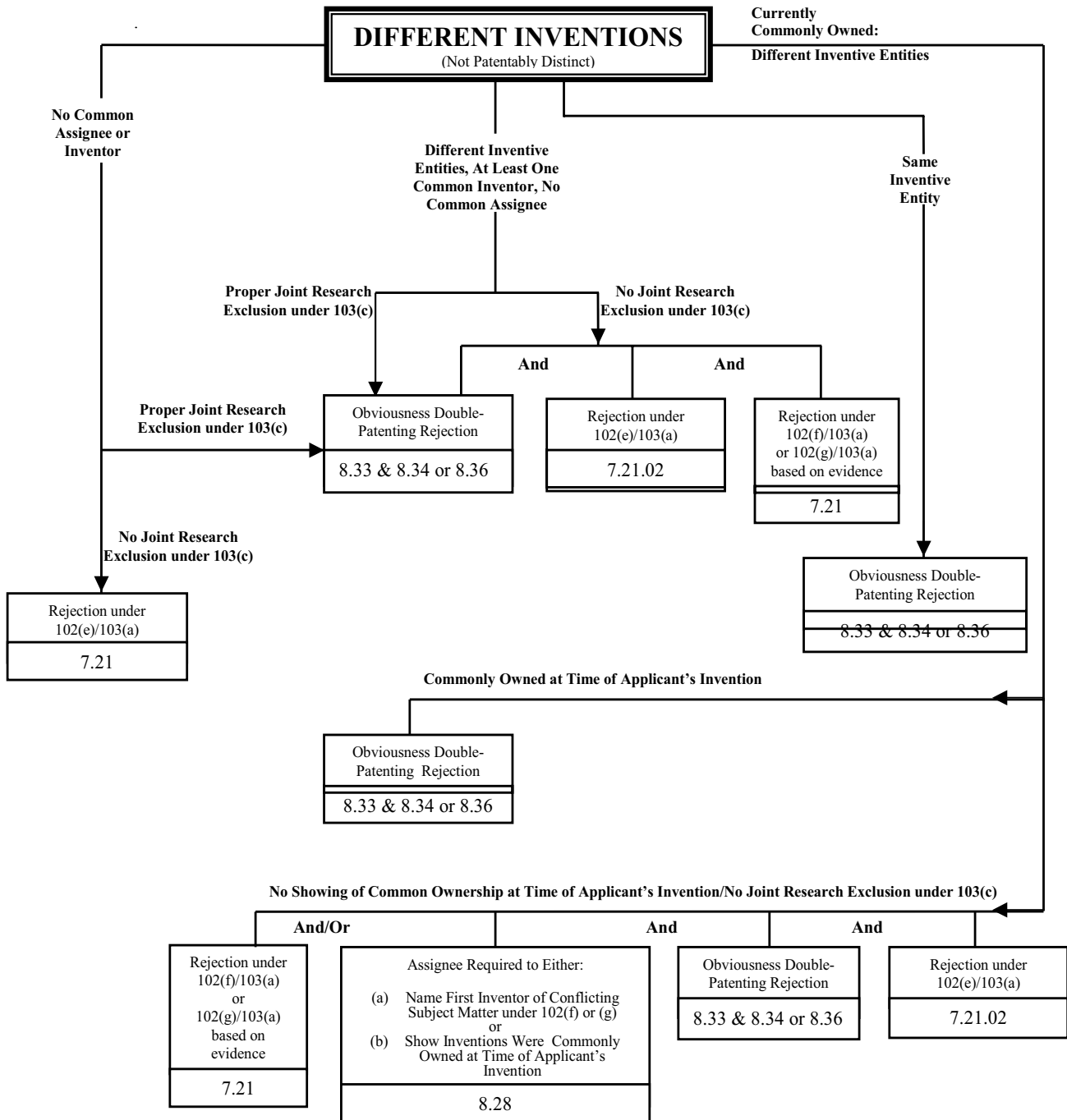
CHART II-A



<sup>1</sup> The joint research exclusion of 35 U.S.C. 103(c) is not applicable.

**CONFLICTING CLAIMS BETWEEN  
AN APPLICATION AND A PATENT**

**CHART II-B**



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## I. INSTANCES WHERE DOUBLE PATENTING ISSUE CAN BE RAISED

A double patenting issue may arise between two or more pending applications, >or< between one or more pending applications and a patent\*\*. A double patenting issue may likewise arise in a reexamination proceeding between the patent claims being reexamined and the claims of one or more applications and/or patents. 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 \*>a different< inventive entity having a common inventor \*\*, and/or by \*\*>a common assignee/owner. Double patenting may also exist where the inventions claimed in a patent and an application were made as a result of activities undertaken within the scope of a joint research agreement as defined in 35 U.S.C. 103(c)(2) and (3).< 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 >that were< filed by the same inventive entity, or by different inventive entities having a common inventor, and/or by a common assignee >, or that claim an invention resulting from activities undertaken within the scope of a joint research agreement as defined in 35 U.S.C. 103(c)(2) and (3),< 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 applications (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*, 356 F.2d 556, 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 >at least< one of the applications. \*\*

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### 1. **Nonstatutory Double Patenting Rejections**

If a “provisional” nonstatutory obviousness-type double patenting (ODP) rejection is the only rejection remaining in the earlier filed of the two pending applications, while the later-filed application is rejectable on other grounds, the examiner should withdraw that rejection and permit the earlier-filed application to issue as a patent without a terminal disclaimer. If the ODP rejection is the only rejection remaining in the later-filed application, while the earlier-filed application is rejectable on other grounds, a terminal disclaimer must be required in the later-filed application before the rejection can be withdrawn.

If “provisional” ODP rejections in two applications are the only rejections remaining in those applications, the examiner should withdraw the ODP rejection in the earlier filed application thereby permitting that application to issue without need of a terminal disclaimer. A terminal disclaimer must be required in the later-filed application before the ODP rejection can be withdrawn and the application permitted to issue. If both applications are filed on the same day, the examiner should determine which application claims the base invention and which application claims the improvement (added limitations). The ODP rejection in the base application can be withdrawn without a terminal disclaimer, while the ODP rejection in the improvement application cannot be withdrawn without a terminal disclaimer.

Where there are three applications containing claims that conflict such that an ODP rejection is made in each application based upon the other two, it is not sufficient to file a terminal disclaimer in only one of the applications addressing the other two applications. Rather, an appropriate terminal disclaimer must be filed in at least two of the applications to link all three together. This is because a terminal disclaimer filed to obviate a double patenting rejection is effective only with respect to the application in which the terminal disclaimer is filed; it is not effective to link the other two applications to each other.

## 2. Statutory Double Patenting Rejections (35 U.S.C. 101)

A terminal disclaimer cannot be filed to obviate a statutory double patenting rejection.

If a “provisional” statutory double patenting rejection is the only rejection remaining in one of the applications (but not both), the examiner should withdraw the rejection in that application and permit that application to issue as a patent, thereby converting the “provisional” double patenting rejection in the other application into a double patenting rejection when the application issues as a patent.

If a “provisional” statutory double patenting rejection is the only rejection remaining in both applications, the examiner should withdraw that rejection in the application with the earlier filing date and permit that application to issue as a patent. If both applications were filed on the same day, the applicant should be given an opportunity to elect which of the two should be allowed. In either situation, 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 one application issues as a patent.<

### C. *Between One or More Applications and a Published Application - Provisional Rejections*

Double patenting may exist \*>where< a published patent application and an application >are< filed by the same inventive entity, or by different inventive entities having a common inventor, and/or by a common assignee. >Double patenting may also exist where a published application and an application claim inventions resulting from activities undertaken

within the scope of a joint research agreement as defined in 35 U.S.C. 103(c)(2) and (3).< Since the published application has not yet issued as a patent, the examiner is permitted to make a “provisional” rejection on the ground of double patenting >when the published application has not been abandoned and claims pending therein conflict with claims of the application being examined<. See the discussion regarding “provisional” double patenting \*>rejections< in subsection B. above.

### D. *Reexamination Proceedings*

A double patenting issue may raise a substantial new question of patentability of a claim of a patent, and thus be addressed in a reexamination proceeding. *In re Lonardo*, 119 F.3d 960, 966, 43 USPQ2d 1262, 1266 (Fed. Cir. 1997) (In giving the \*>Director< authority under 35 U.S.C. 303(a) in determining the presence of a substantial new question of patentability, “Congress intended that the phrases ‘patents’ and ‘other patents or publications’ in section 303(a) not be limited to *prior art* patents or printed publications.” (emphasis added)). Accordingly, if the issue of double patenting was not addressed during original prosecution, it may be considered during reexamination.

>Double patenting may exist where a reference patent or application and the patent under reexamination are filed by inventive entities that have at least one inventor in common and/or are filed by a common owner/assignee. Where the patent under reexamination was granted on or after December 10, 2004, double patenting may also exist where the inventions claimed in the reference and reexamination proceeding resulted from activities undertaken within the scope of a joint research agreement pursuant to 35 U.S.C. 103(c)(2) and (3), and if evidence of the joint research agreement has been made of record in the patent being reexamined or in the reexamination proceeding. A double patenting rejection may NOT be made on this basis if the patent under reexamination issued before December 10, 2004. See MPEP § 804.04. The prior art exclusion under 35 U.S.C. 103(c) cannot be used to overcome an obvious double patenting rejection. See MPEP § 706.02(1) for more information on 35 U.S.C. 103(c). See MPEP § 2258 for more information on making double patenting rejections in reexamination proceedings.<

## 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 ....” 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 Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957). 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 the following:

(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; and

(C) Whether a nonstatutory basis exists.

Each determination must be made on the basis of all the facts in the application 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 generic 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 Kaplan*, 789 F.2d 1574, 1577-78, 229 USPQ 678, 681 (Fed. Cir. 1986); and *In re Sarrett*, 327 F.2d 1005, 1014-15, 140 USPQ 474, 482 (CCPA 1964). However, the presence of domination does not preclude double patenting. See, e.g., *In re Schneller*, 397 F.2d 350, 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 (1894); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957).

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. *Id.*

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. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957).

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:**

The above 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

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 form 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 form paragraph. A provisional double patenting rejection should be made using form paragraph 8.32.
3. Do not use this form paragraph for nonstatutory-type double patenting rejections. If nonstatutory type, use appropriate form paragraphs 8.33 to 8.39.
4. This form 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, or

(d) made as a result of activities undertaken within the scope of a joint research agreement.

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, form 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 form 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 form paragraph 7.15.02.

¶ 8.32 Provisional Rejection, 35 U.S.C. 101, Double Patenting

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 form 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 form paragraph 8.31.
3. Do not use this paragraph for nonstatutory-type double patenting rejections. See form paragraphs 8.33 to 8.39.
4. This form 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, or
  - (d) made as a result of activities undertaken within the scope of a joint research agreement.
5. Form paragraph 8.28 may be used along with this form 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 provisional 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, form 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 form 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 form paragraph 7.15.01.

<

If the “same invention” is not being claimed twice, an analysis must be made to determine whether a non-statutory basis for double patenting exists.

### **B. Nonstatutory Double Patenting**

A rejection based on nonstatutory double patenting 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 Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969); *In re White*, 405 F.2d 904, 160 USPQ 417 (CCPA 1969); *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968); *In re Sarett*, 327 F.2d 1005, 140 USPQ 474 (CCPA 1964).

#### **1. Obviousness-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 “obviousness-type” nonstatutory double patenting rejection may be appropriate. Obviousness-type double patenting requires rejection of an application claim when the claimed subject matter is **not patentably distinct** from the subject matter claimed in a commonly owned patent>, or a non-commonly owned patent but subject to a joint research agreement as set forth in 35 U.S.C. 103(c)(2) and (3),< when the issuance of a second patent would provide unjustified extension of the term of the right to exclude granted by a patent. See *Eli Lilly & Co. v. Barr Labs., Inc.*, 251 F.3d 955, 58 USPQ2d 1869 (Fed. Cir. 2001); *Ex parte Davis*, 56 USPQ2d 1434, 1435-36 (Bd. Pat. App. & Inter. 2000).

A double patenting rejection of the obviousness-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 obviousness-type double patenting rejection parallels the guidelines for analysis of a 35 U.S.C. 103 obviousness determination. *In re Braat*, 937 F.2d 589, 19 USPQ2d 1289 (Fed. Cir. 1991); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985).

Since the analysis employed in an obviousness-type double patenting determination parallels the guidelines for a 35 U.S.C. 103(a) 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:

(A) Determine the scope and content of a patent claim \*\* relative to a claim in the application at issue;

(B) Determine the differences between the scope and content of the patent claim \*\* as determined in (A) and the claim in the application at issue;

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

(D) Evaluate any objective indicia of nonobviousness.

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

Any obviousness-type double patenting rejection should make clear:

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

(B) The reasons why a person of ordinary skill in the art would conclude that the invention defined in the claim \*\*>at issue would have been< 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 \*>would have been< 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. >*General Foods Corp. v. Studiengesellschaft Kohle mbH*, 972 F.2d 1272, 1279, 23 USPQ2d 1839, 1846 (Fed. Cir. 1992).< This does not mean that one is precluded from all use of the patent disclosure.

The specification can \* be used as a dictionary to learn the meaning of a term in the patent claim. \*\*>*Toro Co. v. White Consol. Indus., Inc.*, 199 F.3d 1295, 1299, 53 USPQ2d 1065, 1067 (Fed. Cir. 1999) (“[W]ords in patent claims are given their ordinary meaning in the usage of the field of the invention, unless the text of the patent makes clear that a word was used with a special meaning.”); *Renishaw PLC v. Marposs Societa' per Azioni*, 158 F.3d 1243, 1250, 48 USPQ2d 1117, 1122 (Fed. Cir. 1998) (“Where there are several common meanings for a claim term, the patent disclosure serves to point away from the improper meanings and toward the proper meanings.”). See also MPEP § 2111.01.< 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, 441-42, 164 USPQ 619, 622 (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 at issue is the later filed application 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 \*>would have been< an obvious variation of the invention defined in a claim in the patent. See, e.g., *In re Berg*, >140 F.3d 1438,< 46 USPQ2d 1226 (Fed. Cir. 1998) (the court applied a one-way test where both applications were filed the same day). If a claimed invention

in the application \*>would have been< 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 \*>would have been< obvious over a claimed invention in the patent, no double patenting rejection of the obvious-type should be made, but this does not necessarily preclude a rejection based on another type of nonstatutory double patenting (see MPEP § 804, paragraph II.B.2. below).

Similarly, even if the application at issue is the earlier filed application, only a one-way determination of obviousness is needed to support a double patenting rejection in the absence of a finding \*: (A) >of< administrative delay on the part of the Office causing delay in prosecution of the earlier filed application; and (B) >that< applicant could not have filed the conflicting claims in a single (i.e., the earlier filed) application. See MPEP § 804, paragraph II.B.1.(b) below.

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 application, 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 is to be applied only when the applicant could not have filed the claims in a single application *and* there is administrative delay. *In re Berg*, 46 USPQ2d 1226 (Fed. Cir. 1998) (“The two-way exception can only apply when the applicant could not avoid separate filings, and even then, only if the PTO controlled the rates of prosecution to cause the later filed species claims to issue before the claims for a genus in an earlier application . . . In *Berg*’s case, the two applications could have been filed as one, so it is irrelevant to our disposition who actually controlled the respective rates of prosecution.”). In the absence of administrative delay, a one-way test is appropriate. *In re Goodman*, 11 F.3d 1046, 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 and that applicant could not have avoided filing separate applications, 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 nonstatutory double patenting rejection based on the fundamental reason to prevent unjustified timewise extension of the right to exclude granted by a patent. *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968).

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 (3d 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 later 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 7 years after the issuance of the narrower patent. The court determined that the second issued patent was invalid on the ground of double patenting. Similarly, in *In re Emert*, 124 F.3d 1458, 44 USPQ2d 1149 (Fed. Cir. 1997), the court found that the one-way test is appropriate where applicants, rather than the Office, had significant control over the rate of prosecution of the application at issue. In support of its finding that the applicants were responsible for delaying prosecution of the application during the critical period, the court noted that the applicants had requested and received numerous time extensions in various filings. More importantly, the court noted, after initially receiving an obviousness rejection of all claims, applicants had waited the maximum period to reply (6 months), then abandoned the application in favor of a substantially identical continuation application, then received another obviousness rejection of all claims, again waited the maximum period to reply, and then again abandoned the application in favor of a second continuation application substantially identical to the original filing. 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 non-statutory rejections of the obvious type.

\*\*>

¶ 8.33 *Basis for Nonstatutory Double Patenting, “Heading” Only*

The nonstatutory double patenting rejection 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 and to prevent possible harassment by multiple assignees. A non-statutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). *See, e.g., In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

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 on the ground of nonstatutory 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 form 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 form paragraph. A provi-

sional double patenting rejection should be made using form paragraph 8.33 and either form paragraph 8.35 or 8.37.

3. This form 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, or
- (d) made as a result of activities undertaken within the scope of a joint research agreement.

4. Form paragraph 8.33 must precede any one of form 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(a) or 102(g)/103(a) using form paragraph 7.21, unless the patent is disqualified under 35 U.S.C. 103(c) as prior art in a 35 U.S.C. 103(a) rejection.

7. If the patent is to a different inventive entity and has an earlier effective U.S. filing date, a rejection under 35 U.S.C. 102(e)/103(a) may be made using form paragraph 7.21.02. For applications pending on or after December 10, 2004, rejections under 35 U.S.C. 102(e)/103(a) should not be made or maintained if the patent is disqualified under 35 U.S.C. 103(c) as prior art in a 35 U.S.C. 103(a) rejection.

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

Claim [1] provisionally rejected on the ground of nonstatutory 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 form 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 form paragraph. Use form paragraphs 8.33 and 8.34.
3. This form paragraph may be used where the conflicting claims are in a copending application that is:
  - (a) by the same inventive entity, or
  - (b) commonly assigned even though there is no common inventor, or
  - (c) not commonly assigned but has at least one common inventor, or
  - (d) made as a result of activities undertaken within the scope of a joint research agreement.
4. Form paragraph 8.33 must precede any one of form 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 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 obviousness-type 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 under 35 U.S.C. 103(c) as prior art in a 103(a) rejection, a rejection should additionally be made in the other application under 35 U.S.C. 102(f)/103(a) or 102(g)/103(a) using form 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 form paragraph 7.21.01 to additionally make a rejection under 35 U.S.C. 102(e)/103(a) in the later filed application. For applications pending on or after December 10, 2004, rejections under 35 U.S.C. 102(e)/103(a) should not be made or maintained if the patent is disqualified under 35 U.S.C. 103(c) as prior art in a 35 U.S.C. 103(a) rejection.

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

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

Claim [1] rejected on the ground of nonstatutory 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 form 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 form paragraph. A provisional obviousness-type double patenting rejection should be made using form paragraphs 8.33 and either 8.35 or 8.37.

3. This form 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, or
- (d) made as a result of activities undertaken within the scope of a joint research agreement.

4. Form paragraph 8.33 must precede any one of form 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 35 U.S.C. 102(f) or (g), a rejection should additionally be made under 35 U.S.C. 102(f)/103(a) or 102(g)/103(a) using form paragraph 7.21, unless the patent is disqualified under 35 U.S.C. 103(c) as prior art in a 35 U.S.C. 103(a) rejection.

9. If the patent issued to a different inventive entity and has an earlier effective U.S. filing date, a rejection under 35 U.S.C. 102(e)/103(a) may be made using form paragraph 7.21.02. For applications pending on or after December 10, 2004, rejections under 35 U.S.C. 102(e)/103(a) should not be made or maintained if the patent is disqualified under 35 U.S.C. 103(c) as prior art in a 35 U.S.C. 103(a) rejection.

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

Claim [1] provisionally rejected on the ground of nonstatutory 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 form 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 form paragraph, use form paragraph 8.36.

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

- (a) by the same inventive entity, or
- (b) commonly assigned even though there is no common inventor, or
- (c) not commonly assigned but has at least one common inventor, or
- (d) made as a result of activities undertaken within the scope of a joint research agreement.

4. Form paragraph 8.33 must precede any one of form 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 addition to this form paragraph to also resolve any issues relating to priority under 35 U.S.C. 102(f) and/or (g).

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

7. In bracket 4, insert the secondary reference.

8. In bracket 5, insert an explanation of the obviousness-type rejection.

9. A provisional obviousness-type double patenting rejection should also be made in the conflicting application.

10. 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 under 35 U.S.C. 103(c) as prior art in a 35 U.S.C. 103(a) rejection, a rejection should additionally be made under 35 U.S.C. 102(f)/103(a) or 102(g)/103(a) using form paragraph 7.21.

11. 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 form paragraph 7.21.01 to additionally make a rejection under 35 U.S.C. 102(e)/103(a) in the application with the later effective U.S. filing date. For applications pending on or after December 10, 2004, rejections under

35 U.S.C. 102(e)/103(a) should not be made or maintained if the patent is disqualified under 35 U.S.C. 103(c) as prior art in a 35 U.S.C. 103(a) rejection.

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## 2. Another Type of Nonstatutory Double Patenting Rejection

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). In affirming the double patenting rejection, the court summed up the situation:

in appellant's own terms: The combination ABC was old. He made two improvements on it, (1) adding X and (2) adding Y, the result still being a unitary clip of enhanced utility. While his invention can be practiced in the forms ABCX or ABCY, the greatest advantage and best mode of practicing the invention as disclosed is obtained by using both inventions in the combination ABCXY. His first application disclosed ABCXY and other matters. He obtained a patent claiming [a clip comprising] BCX and ABCX, . . . so claiming these combinations as to cover them *no matter what other feature is incorporated in them*, thus *covering effectively ABCXY*. He now, many years later, seeks more claims directed to ABCY and ABCXY. Thus, protection he already had would be extended, albeit in somewhat different form, for several years beyond the expiration of his patent, were we to reverse.

397 F.2d at 355-56, 158 USPQ at 216 (emphasis in original).

The court recognized that “there is no double patenting in the sense of claiming the same invention because ABCX and ABCY are, in the technical patent law sense, different inventions. The rule against ‘double patenting,’ however, is not so circumscribed. The fundamental reason for the rule is to *prevent unjustified timewise extension of the right to exclude* granted by a patent no matter how the extension is brought about. To . . . prevail here, appellant has the burden of establishing that the invention claimed in his patent is ‘independent and distinct’ from the invention of the appealed claims...appellant has clearly not established the independent and distinct character of the inventions of the appealed claims.” 397 F.2d at 354-

55, 158 USPQ at 214-15 (emphasis in original). The court observed:

The controlling fact is that patent protection for the clips, fully disclosed in and covered by the claims of the patent, would be extended by allowance of the appealed claims. Under the circumstance of the instant case, wherein we find no valid excuse or mitigating circumstances making it either reasonable or equitable to make an exception, and wherein there is no terminal disclaimer, the rule against “double patenting” must be applied.

397 F.2d at 355, 158 USPQ at 215.

The decision in *In re Schneller* did not establish a rule of general application and thus is limited to the particular set of facts set forth in that decision. The court in *Schneller* cautioned “against the tendency to freeze into rules of general application what, at best, are statements applicable to particular fact situations.” *Schneller*, 397 F.2d at 355, 158 USPQ at 215. Nonstatutory double patenting rejections based on *Schneller* **will be rare**. The Technology Center (TC) Director must approve any nonstatutory double patenting rejections based on *Schneller*. If an examiner determines that a double patenting rejection based on *Schneller* is appropriate in his or her application, the examiner should first consult with his or her supervisory patent examiner (SPE). If the SPE agrees with the examiner then approval of the TC Director must be obtained before such a nonstatutory double patenting rejection can be made.

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.

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

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¶ 8.38 *Double Patenting - Nonstatutory (Based Solely on Improper Timewise Extension of Patent Rights) With a Patent*

Claim [1] rejected on the ground of nonstatutory 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. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

**Examiner Note:**

1. This form paragraph should only be used where approval from the TC Director to make a nonstatutory double patenting rejection based on *In re Schneller* has been obtained.
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. In bracket 4, insert a description of the subject matter being claimed which is covered in the patent.
5. Form paragraph 8.33 must precede any one of form paragraphs 8.34 to 8.39 and must be used only ONCE in an Office action.
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 35 U.S.C. 102(f)/103(a) or 102(g)/103(a) using form paragraph 7.21, unless the patent is disqualified under 35 U.S.C. 103(c) as prior art in a 35 U.S.C. 103(a) rejection.
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)/103(a) may be made using form paragraph 7.21.02. For applications pending on or after December 10, 2004, rejections under 35 U.S.C. 102(e)/103(a) should not be made or maintained if the patent is disqualified under 35 U.S.C. 103(c) as prior art in a 35 U.S.C. 103(a) rejection.

¶ 8.39 *Double Patenting - Nonstatutory (Based Solely on Improper Timewise Extension of Patent Rights) With Another Application*

Claim [1] provisionally rejected on the ground of nonstatutory double patenting over claim [2] of copending Application No. [3]. This is a provisional double patenting rejection because the conflicting claims have not in fact been patented.

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. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

**Examiner Note:**

1. This form paragraph should only be used where approval from the TC Director to make a nonstatutory double patenting rejection based on *In re Schneller* has been obtained.
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. Form paragraph 8.33 must precede any one of form 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 addition to this form paragraph to also resolve any issues relating to priority under 35 U.S.C. 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(a) or 102(g)/103(a) using form paragraph 7.21, unless the patent is disqualified under 35 U.S.C. 103(c) as prior art in a 35 U.S.C. 103(a) rejection.

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 form paragraph 7.21.01 to additionally make a rejection under 35 U.S.C. 102(e)/103(a) in the application with the later effective U.S. filing date. For applications pending on or after December 10, 2004, rejections under 35 U.S.C. 102(e)/103(a) should not be made or maintained if the patent is disqualified under 35 U.S.C. 103(c) as prior art in a 35 U.S.C. 103(a) rejection.

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### 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 Indus. 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 Indus.*, 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. 724 F.2d at 940-41, 220 USPQ at 487-88. But see *Carman Indus.* (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(a) 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(a). *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(a) 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(a) 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(a) 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.

\*\*>For applications filed on or after November 29, 1999 and for applications pending on or after December 10, 2004, a commonly assigned/owned patent or application may be disqualified as 35 U.S.C. 102(e) prior art in a 35 U.S.C. 103(a) rejection. See 35 U.S.C. 103(c)(1). As an alternative to invoking the prior art exclusion under 35 U.S.C. 103(c)(1),< the assignee can take some preemptive measures to avoid having a >commonly assigned/owned< 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(a) rejection was made. *In re Katz*, 687 F.2d 450, 215 USPQ 14 (CCPA 1982). See also MPEP § 716.10. It may also be possible for applicant to respond to a 35 U.S.C. 102(e)/103(a) 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. See MPEP § 715. See also 37 CFR 1.130 and MPEP § 718 for affidavits or declarations to disqualify a commonly owned patent as prior art under 35 U.S.C. 103.

\*\*>For applications pending on or after December 10, 2004, and for reexamination proceedings in which the patent under reexamination was granted on or after December 10, 2004, a patent or application may be disqualified as 35 U.S.C. 102(e) prior art in a

35 U.S.C. 103(a) rejection if evidence of a joint research agreement pursuant to 35 U.S.C. 103(c)(2) and (3) is made of record in the application (or patent) being examined (or reexamined), and the conflicting claims resulted from a joint research agreement that was in effect on or before the date the later claimed invention was made.

An examiner should make both a 35 U.S.C. 102(e)/103 rejection and a double patenting rejection over the same reference< when the facts support both rejections. >If the examiner makes only one of these rejections when both are applicable, if the next office action includes the previously omitted rejection, it cannot be made final.< A prior art reference that renders claimed subject matter obvious under 35 U.S.C. 102(e)/103(a) does not create a double patenting situation where that subject matter is not claimed in the reference patent. \*\*>For applications pending on or after December 10, 2004, rejections under 35 U.S.C. 102(e)/103(a) should not be made or maintained if the reference is disqualified under 35 U.S.C. 103(c) as prior art in a 35 U.S.C. 103(a) rejection. See MPEP § 706.02(l)(1) for information regarding when prior art is disqualified under 35 U.S.C. 103(c) based on common ownership or claimed inventions made as a result of activities undertaken within the scope of a joint research agreement.

Until applicant establishes the existence of a joint research agreement, the examiner cannot apply a double patenting rejection based on the possible existence of such an agreement. If in reply to an Office action applying a rejection under 35 U.S.C. 102(e)/103, applicant disqualifies the relied upon reference under the joint research agreement provision of 35 U.S.C. 103(c) and a subsequent double patenting rejection based upon the disqualified reference is applied, the next Office action may be made final even if applicant did not amend the claims (provided the examiner introduces no other new ground of rejection that was not necessitated by either amendment or an information disclosure statement filed during the time period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p)). The Office action is properly made final because the new double patenting rejection was necessitated by the applicant's amendment of the application.<

### 804.01 Prohibition of Double Patenting Rejections Under 35 U.S.C. 121 [R-3]

35 U.S.C. 121 authorizes the \*>Director< 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(j)<, 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 application are filed as a result of such requirement.

The following are situations where the prohibition \*>against< double patenting rejections under 35 U.S.C. 121 does not apply:

(A) The applicant voluntarily files two or more applications without a restriction requirement by the examiner. >35 U.S.C. 121 requires claims of a divisional application to have been formally entered, restricted, and removed from an earlier application in order to obtain the benefit of 35 U.S.C. 121. *Geneva Pharms. Inc. v. GlaxoSmithKline PLC*, 349 F.3d 1373,

1379, 68 USPQ2d 1865, 1870 (Fed. Cir. 2003) (For claims in a divisional application that were not in the original application, 35 U.S.C. 121 “does not suggest that the original application merely needs to provide some support for claims that are first entered formally in the later divisional application.” *Id.*); < *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) and *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. 916 F.2d at 688, 16 USPQ2d at 1440.

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

(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). >Note that a restriction requirement in an earlier-filed application does not carry over to claims of a continuation application in which the examiner does not reinstate or refer to the restriction requirement in the parent application. Reliance on a patent issued from such a continuation application to reject claims in a later-filed divisional application is not prohibited under 35 U.S.C. 121. *Bristol-Myers Squibb Co. v.*

*Pharmachemie BV*, 361 F.3d 1343, 1348, 70 USPQ2d 1097, 1100 (Fed. Cir. 2004).<

(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).

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(G) Where a requirement for restriction between a product, a process of making the product, and a process of using the product was made subject to the non-allowance of the product and the product is subsequently allowed. In this situation the restriction requirement must be withdrawn.<

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*, 784 F.2d at 361, 228 USPQ at 844, (J. Newman, concurring), “35 U.S.C. 121 of course does not provide that multiple patents may be granted on the identical invention.”

## 804.02 Avoiding a Double Patenting Rejection [R-3]

### I. STATUTORY

A rejection based on the statutory type of double patenting can be avoided by amending the conflicting claims so that they are not coextensive in scope. Where the conflicting claims are in one or more pending applications and a patent, a rejection based on statutory type double patenting can also be avoided by canceling the conflicting claims in all the pending applications. Where the conflicting claims are in two or more pending applications, a provisional rejection based on statutory type double patenting can also be avoided by canceling the conflicting claims in all but one of the pending applications. 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 (Comm’r. 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 650 (CCPA 1962).

### II. NONSTATUTORY

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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 Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); *In re Knohl*, 386 F.2d 476, 155 USPQ 586 (CCPA 1967); and *In re Griswold*, 365 F.2d 834, 150 USPQ 804 (CCPA 1966). 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*, 392 F.2d 633, 157 USPQ 363 (CCPA 1968); *In re Eckel*, 393 F.2d 848, 157 USPQ 415 (CCPA 1968); and *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 F.2d 433, 146 USPQ 479 (CCPA 1965). 37 CFR 1.131 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 (Comm’r. Pat. 1971), citing the court 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).

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 USPQ2d 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 “provisional” nonstatutory double patenting rejection \*\* is made in each of two or more pending applications, \*\* the examiner should follow the practice set forth in MPEP § 804, subsection I.B.1. in determining in which of the applications an appropriate terminal disclaimer must be filed.

Claims that differ from each other (aside from minor differences in language, punctuation, etc.), whether or not the difference would have been 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 would have been obvious, terminal disclaimers are effective to overcome double patenting rejections. Where the subject matter of the reference and the claimed invention were commonly owned at the time the invention was made, 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). 37 CFR 1.321(d) sets forth the requirements for a terminal disclaimer where the claimed invention resulted from activities undertaken within the scope of a joint research agreement as defined in 35 U.S.C. 103(c)(3). It should be emphasized that a terminal disclaimer cannot be used to overcome a rejection under 35 U.S.C. 102(e)/103(a).

### III. TERMINAL DISCLAIMER REQUIRED DESPITE REQUEST TO ISSUE ON 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 problems of dual ownership by a common assignee, or by parties to a joint research agreement, of patents to patentably indistinct inventions. In any event, the Office cannot ensure that two or more applications will have a common issue date.

### IV. DISCLAIMING MULTIPLE DOUBLE PATENTING REFERENCES

If multiple conflicting patents and/or pending applications are applied in double patenting rejections made in a single application, then prior to issuance of that application, it is necessary to disclaim the terminal part of any patent granted on the application which would extend beyond the application date of each one of the conflicting patents and/or applications. A terminal disclaimer fee is required for each terminal disclaimer filed. To avoid paying multiple terminal disclaimer fees, a single terminal disclaimer based on common ownership may be filed, for example, in which the term disclaimed is based on all the conflicting, commonly owned double patenting references. Similarly, a single terminal disclaimer based on a joint research agreement may be filed, in which the term disclaimed is based on all the conflicting double patenting references.

Each one of the commonly owned conflicting double patenting references must be included in the terminal disclaimer to avoid the problem of dual ownership of patents to patentably indistinct inventions in the event that the patent issuing from the application being examined ceases to be commonly owned with any one of the double patenting references that have issued or may issue as a patent. Note that 37 CFR 1.321(c)(3) requires that a terminal disclaimer for commonly owned conflicting claims “[i]nclude a provision that any patent granted on that application or any patent subject to the reexamination proceeding shall be enforceable only for and during such period that said patent is commonly owned with

the application or patent which formed the basis for the rejection.”

>Filing a terminal disclaimer including each one of the conflicting double patenting references is also necessary to avoid the problem of ownership of patents to patentably indistinct inventions by parties to a joint research agreement. 37 CFR 1.321(d) sets forth the requirements for a terminal disclaimer where the claimed invention resulted from activities undertaken within the scope of a joint research agreement.<

## V. 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, and guidance as to the filing and treatment of a terminal disclaimer, are provided in MPEP § 1490.

## VI. TERMINAL DISCLAIMERS REQUIRED TO OVERCOME **\*\*>NONSTATUTORY<** DOUBLE PATENTING REJECTIONS IN APPLICATIONS FILED ON OR AFTER JUNE 8, 1995

Public Law 103-465 (1994) amended 35 U.S.C. 154(a)(2) to provide that any patent issuing on a utility or plant application filed on or after June 8, 1995 will expire 20 years from its filing date, or, if the application claims the benefit of an earlier filed application under 35 U.S.C. 120, 121, or 365(c), 20 years from the earliest filing date for which a benefit under 35 U.S.C. 120, 121, or 365(c) is claimed. Therefore, any patent issuing on a continuing utility or plant application filed on or after June 8, 1995 will expire 20 years from the earliest filing date for which a benefit is claimed under 35 U.S.C. 120, 121, or 365(c), subject to the provisions of 35 U.S.C. 154(b).

There are at least two reasons for insisting upon a terminal disclaimer to overcome a **\*\*>nonstatutory<** double patenting rejection in a continuing application subject to a 20-year term under 35 U.S.C. 154(a)(2).

First, 35 U.S.C. 154(b) includes provisions for patent term extension based upon prosecution delays during the application process. Thus, 35 U.S.C. 154 does not ensure that any patent issuing on a continuing utility or plant application filed on or after June 8, 1995 will necessarily expire 20 years from the earliest filing date for which a benefit is claimed under 35 U.S.C. 120, 121, or 365(c). Second, 37 CFR 1.321(c)(3) requires that a terminal disclaimer filed to obviate a **\*\*>nonstatutory<** double patenting rejection >based on commonly owned conflicting claims< include a provision that any patent granted on that application be enforceable only for and during the period that the patent is commonly owned with the application or patent which formed the basis for the rejection. **\*\*>**37 CFR 1.321(d) sets forth the requirements for a terminal disclaimer where the claimed invention resulted from activities undertaken within the scope of a joint research agreement. These requirements serve< to avoid the potential for harassment of an accused infringer by multiple parties with patents covering the same patentable invention**\*\*>**. See, e.g., *In re Van Ornum*, 686 F.2d 937, 944-48, 214 USPQ 761, 767-70 (CCPA 1982). Not insisting upon a terminal disclaimer to overcome a **\*\*>nonstatutory<** double patenting rejection in an application subject to a 20-year term under 35 U.S.C. 154(a)(2) would result in the potential for the problem that 37 CFR 1.321(c)(3) was promulgated to avoid.

Accordingly, a terminal disclaimer under 37 CFR 1.321 is required in an application to overcome a **\*\*>nonstatutory<** double patenting rejection, even if the application was filed on or after June 8, 1995 and claims the benefit under 35 U.S.C. 120, 121, or 365(c) of the filing date of the patent or application which forms the basis for the rejection. Examiners should respond to arguments that a terminal disclaimer under 37 CFR 1.321 should not be required in a continuing application filed on or after June 8, 1995 to overcome a **\*\*>nonstatutory<** double patenting rejection due to the change to 35 U.S.C. 154 by citing to this section of the MPEP or to the *Official Gazette* notice at 1202 O.G. 112 (Sept. 30, 1997).

### 804.03 **\*\* Commonly Owned \*>Inventions< of Different Inventive Entities>; Non-Commonly Owned \*>Inventions< Subject to a Joint Research Agreement< [R-3]**

35 U.S.C. 103. *Conditions for patentability; non-obvious subject matter.*

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(c)(1) Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person.

(2) For purposes of this subsection, subject matter developed by another person and a claimed invention shall be deemed to have been owned by the same person or subject to an obligation of assignment to the same person if —

(A) the claimed invention was made by or on behalf of parties to a joint research agreement that was in effect on or before the date the claimed invention was made;

(B) the claimed invention was made as a result of activities undertaken within the scope of the joint research agreement; and

(C) the application for patent for the claimed invention discloses or is amended to disclose the names of the parties to the joint research agreement.

(3) For purposes of paragraph (2), the term “joint research agreement” means a written contract, grant, or cooperative agreement entered into by two or more persons or entities for the performance of experimental, developmental, or research work in the field of the claimed invention.<

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

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(c) If an application or a patent under reexamination and at least one other application naming different inventors are owned by the same person and 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 Office may require the assignee 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. Even if 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 conflicting claims may be rejected under

the doctrine of double patenting in view of such commonly owned or assigned applications or patents under reexamination.

37 CFR 1.130. *Affidavit or declaration to disqualify commonly owned patent or published application as prior art.*

(a) When any claim of an application or a patent under reexamination is rejected under 35 U.S.C. 103 on a U.S. patent or U.S. patent application publication which is not prior art under 35 U.S.C. 102(b), and the inventions defined by the claims in the application or patent under reexamination and by the claims in the patent or published application are not identical but are not patentably distinct, and the inventions are owned by the same party, the applicant or owner of the patent under reexamination may disqualify the patent or patent application publication as prior art. The patent or patent application publication can be disqualified as prior art by submission of:

(1) A terminal disclaimer in accordance with § 1.321(c); and

(2) An oath or declaration stating that the application or patent under reexamination and patent or published application are currently owned by the same party, and that the inventor named in the application or patent under reexamination is the prior inventor under 35 U.S.C. 104.

(b) \*\*>[Reserved]<

## I. DOUBLE PATENTING

\*\*>Claims< in commonly owned applications of different inventive entities >may be rejected< 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) and *In re Christensen*, 330 F.2d 652, 141 USPQ 295 (CCPA 1964).

>Claims may also be rejected on the grounds of nonstatutory double patenting in certain non-commonly owned applications that claim inventions resulting from activities undertaken with the scope of a joint research agreement as defined in 35 U.S.C. 103(c)(3). This prevents the parties to the joint research agreement from obtaining two or more patents with different expiration dates covering nearly identical subject matter. See the amendment to 35 U.S.C. 103(c) by the CREATE Act (Public Law 108-453; 118 Stat. 3596 (2004)).<

Double patenting rejections can be overcome in certain circumstances by disclaiming, pursuant to the provisions of 37 CFR 1.321(c), 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. Double patenting rejections can also be overcome in cases subject to a joint research agreement, under certain circumstances, by disclaiming the terminal portion of the term of the later patent and including in the disclaimer the provisions of 37 CFR 1.321(d).

See MPEP § 706.02(1) - § 706.02(1)(3) for information pertaining to establishment of common ownership and the existence of a joint research agreement pursuant to 35 U.S.C. 103(c), as well as examination practice relating to 35 U.S.C. 103(c).

## II. IDENTIFYING COMMONLY OWNED AND NON-COMMONLY OWNED INVENTIONS SUBJECT TO A JOINT RESEARCH AGREEMENT

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### A. *Common Ownership by the Same Person(s) or Organization(s)*

Applications or patents are “commonly owned” pursuant to 35 U.S.C. 103(c)(1) if they were wholly or entirely owned by the same person(s), or organization(s)/business entity(ies), at the time the claimed invention was made. See MPEP § 706.02(1)(2) for a detailed definition of common ownership. Two inventions of different inventive entities come within the common ownership provisions of 35 U.S.C. 103(c)(1) when:

(A) the later invention is not anticipated by the earlier invention under 35 U.S.C. 102;

(B) the earlier invention qualifies as prior art for purposes of obviousness under 35 U.S.C. 103 against the later invention only under subsections (f) or (g) of 35 U.S.C. 102, or under 35 U.S.C. 102(e) for applications pending on or after December 10, 2004, for reexamination proceedings in which the patent under reexamination was granted on or after December 10, 2004, and for reexamination proceed-

ings in which the patent under reexamination was filed on or after November 29, 1999; and

(C) 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.

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### B. *Non-Commonly Owned Inventions Subject to a Joint Research Agreement*

The Cooperative Research and Technology Enhancement Act of 2004 (CREATE Act) (Public Law 108-453; 118 Stat. 3596 (2004)), which amended 35 U.S.C. 103(c), was enacted on December 10, 2004. The CREATE Act permits an applicant or patentee, who is a party to a joint research agreement, to disqualify prior art that is applied in a rejection under 35 U.S.C. 103(a) and that is otherwise available as prior art only under 35 U.S.C. 102(e), (f) or (g). Congress recognized that this amendment to 35 U.S.C. 103(c) would result in situations in which there would be double patenting between patents or applications not owned by the same party. See H.R. Rep. No. 108-425, at 5-6 (2003).

Pursuant to the CREATE Act, non-commonly owned applications or patents that are subject to a joint research agreement may be treated as if they are “commonly owned,” i.e., owned or subject to assignment by the same person, for the purposes of determining obviousness if certain conditions are met. See 35 U.S.C. 103(c)(2). The term “joint research agreement” means a written contract, grant, or cooperative agreement entered into by two or more persons or entities for the performance of experimental, developmental, or research work in the field of the claimed invention. See 35 U.S.C. 103(c)(3). See also MPEP § 706.02(1)(2).

Two inventions come within the provisions of 35 U.S.C. 103(c)(2), for applications pending on or after December 10, 2004, and for reexamination proceedings in which the patent under reexamination issued after December 10, 2004, when:

(A) the later invention is not anticipated by the earlier invention under 35 U.S.C. 102;

(B) the claimed invention was made by or on behalf of parties to a joint research agreement that

was in effect on or before the date the claimed invention was made;

(C) the claimed invention was made as a result of activities undertaken within the scope of the joint research agreement; and

(D) the application for patent for the claimed invention discloses or is amended to disclose the names of the parties to the joint research agreement.

### **C. Timing of Double Patenting Rejections**

The examiner should make both a double patenting rejection based on common ownership and a rejection based on 35 U.S.C. 102(e)/103 prior art when the facts support both rejections. Until applicant has established that a reference is disqualified as prior art under the joint research agreement exclusion of 35 U.S.C. 103(c), the examiner should NOT apply a double patenting rejection based on a joint research agreement. See MPEP § 706.07(a) and § 804 for information regarding when an Office action that includes a new subsequent double patenting rejection based upon a reference disqualified under 35 U.S.C. 103(c) may be made final.

## **III. DETERMINING INVENTION PRIORITY**

A determination of priority is not required when two inventions are commonly owned as set forth in 35 U.S.C. 103(c)(1).<

Pursuant to 37 CFR 1.78(c), where an application or a patent under reexamination and at least one other application of different inventive entities are owned by the same party and contain conflicting claims, the examiner may require the assignee to state whether the claimed inventions come within the provisions of 35 U.S.C. 103(c) (i.e., indicate whether common ownership or an obligation of assignment to the same person existed at the time the later invention was made). If the assignee states that the provisions of 35 U.S.C. 103(c) do not apply to the conflicting claimed inventions, the assignee is required to indicate which named inventor is the prior inventor. Form paragraphs 8.27, 8.28 and 8.28.01 may be used to require the applicant to identify the prior inventor under 37 CFR 1.78(c). In order to avoid abandonment, the assignee must comply with the requirement under 37 CFR 1.78(c) by naming the prior inventor unless the conflicting claims are eliminated in all but

one application. If, however, the two inventions come within the provisions of 35 U.S.C. 103(c), 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. Accordingly, a response to a requirement under 37 CFR 1.78(c) which states that the inventions of different inventive entities come within the provisions of 35 U.S.C. 103(c)\* is complete without any further inquiry under 37 CFR 1.78(c) as to the prior inventor.

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

In some situations the application file \*>histories< may reflect which invention is the prior invention, e.g., by reciting that one invention is an improvement of the other invention. See *Margolis v. Banner*, 599 F.2d 435, 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. Also note that the conflict between two or more pending applications can be avoided by abandoning the applications and filing a continuation-in-part application merging the conflicting inventions into a single application.

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## **IV. < REJECTIONS UNDER 35 U.S.C. 102 AND 103 AND DOUBLE PATENTING**

Form paragraphs 8.27, 8.28 and 8.28.01 may be used to require the applicant to name the prior inventor under 37 CFR 1.78(c).

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¶ 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 U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP Chapter 2300), 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 this application.

**Examiner Note:**

1. In bracket 3, insert the U.S. patent number or the copending application number.
2. The claims listed in brackets 1 and 2 must be for the same invention. If one invention would have been obvious in view of the other, do not use this form paragraph; see form paragraph 8.28.
3. A provisional or actual statutory double patenting rejection should also be made using form 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 7.15.01 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 form 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. A rejection under 35 U.S.C. 102(e)/103(a) using form paragraph 7.21, 7.21.01 or 7.21.02 also should be made, as appropriate. For applications pending on or after December 10, 2004, rejections under 35 U.S.C. 102(e)/103(a) should not be made or maintained if the patent is disqualified under 35 U.S.C. 103(c) as prior art in a 35 U.S.C. 103(a) rejection.
3. In bracket 3, insert the number of the conflicting patent or application.
4. An obviousness-type double patenting rejection should also be included in the action using one of form paragraphs 8.34 to 8.37.
5. In bracket 4, explain why the claims in the conflicting cases are not considered to be distinct.
6. Form paragraph 8.28.01 MUST follow this paragraph.

¶ 8.28.01 *Advisory Information Relating to Form Paragraph 8.28*

The U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP Chapter 2300). Commonly assigned [1], discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(e), (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 can, under 35 U.S.C. 103(c) and 37 CFR 1.78(c), either show that the conflicting inventions were commonly owned at the time the invention in this application was made, or name the prior inventor of the conflicting subject matter.

A showing that 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(a) based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g), or 35 U.S.C. 102(e) for applications pending on or after December 10, 2004.

**Examiner Note:**

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

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If \*\* the provisions of 35 U.S.C. 103(c)>(1)< apply to the commonly owned conflicting inventions of different inventive entities >or if the provisions of 35 U.S.C. 103(c)(2) apply to non-commonly owned inventions subject to a joint research agreement< and thereby \*>obviate< the obviousness rejection(s), double patenting rejection(s) should be made >(or maintained)< as appropriate. If, however, it is determined that the provisions of 35 U.S.C. 103(c) do NOT apply because the inventions were not commonly owned or subject to an obligation of assignment to the same person at the time the later invention was made, >or because the claimed invention did NOT result from activities undertaken within the scope of a joint research agreement as required by 35 U.S.C. 103(c)(2) and (3),< and there is evidence of record to indicate that a patent or application is prior art against the application being examined, the examiner should make (A) \*>any< appropriate double patenting rejection(s), and (B) the appropriate prior art rejection(s) under 35 U.S.C. 102 and/or 35 U.S.C. 103 in the application being examined. See Charts I-A, I-B, II-A, >and< II-B\*\* in MPEP § 804. Rejections under 35 U.S.C. 102 or 35 U.S.C. 103 cannot be obviated solely by filing a terminal disclaimer.

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¶ 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 7.15.02 or 7.15.03.
2. In bracket 3, insert either --clearly anticipated-- or --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 form paragraph 7.07 and form paragraphs 7.08, 7.09, and 7.14 as appropriate, or by form paragraph 7.103.
5. If 35 U.S.C. 102(e) is also being applied, this form paragraph must be followed by either form paragraph 7.15.02 or 7.15.03.

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¶ 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 7.103.
2. In bracket 2, insert an explanation of the supporting evidence establishing that applicant was not the inventor. See MPEP § 2137.

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¶ 7.21 *Rejection, 35 U.S.C. 103(a)*

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

**Examiner Note:**

1. This paragraph must be preceded by either form paragraph 7.20 or form paragraph 7.103.
2. An explanation of the rejection applying the Graham v. Deere test must follow this form paragraph.
3. If the rejection relies upon prior art under 35 U.S.C. 102(e), use 35 U.S.C. 102(e) as amended by the American Inventors Protection Act to determine the reference's prior art date, unless the reference is a U.S. patent issued directly, or indirectly, from an international application which has an international filing date prior to November 29, 2000. In other words, use pre-AIPA 35 U.S.C. 102(e) only if the reference is a U.S. patent issued directly or indirectly from either a national stage of an international application (application under 35 U.S.C. 371) which has an international filing date prior to November 29, 2000 or a continuing application claiming benefit under 35 U.S.C. 120, 121 or 365(c) to an international application having an international filing date prior to November 29, 2000. See the Examiner Notes for form paragraphs 7.12 and 7.12.01 to assist in the determination of the reference's 35 U.S.C. 102(e) date.

4. If the applicability of this rejection (e.g., the availability of the prior art as a reference under 35 U.S.C. 102(a) or 35 U.S.C. 102(b)) prevents the reference from being disqualified under 35 U.S.C. 103(c), form paragraph 7.20.01 must follow this form paragraph.

5. If this rejection is a provisional 35 U.S.C. 103(a) rejection based upon a copending application that would comprise prior art under 35 U.S.C. 102(e) if patented or published, use form paragraph 7.21.01 instead of this paragraph.

¶ 7.21.01 *Provisional Rejection, 35 U.S.C. 103(a), Common Assignee or at Least One Common Inventor*

Claim [1] provisionally rejected under 35 U.S.C. 103(a) 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 published or patented. This provisional rejection under 35 U.S.C. 103(a) is based upon a presumption of future publication or 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. This rejection might also be overcome by showing that the copending application is disqualified under 35 U.S.C. 103(c) as prior art in a rejection under 35 U.S.C. 103(a). See MPEP § 706.02(1)(1) and § 706.02(1)(2).

**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. This form paragraph should **not** be used in applications pending on or after December 10, 2004 when the copending application is disqualified under 35 U.S.C. 103(c) as prior art in a 35 U.S.C. 103(a) rejection. See MPEP § 706.02(1)(3).
2. Use 35 U.S.C. 102(e) as amended by the American Inventors Protection Act (AIPA) to determine the copending application reference's prior art date, unless the copending application reference is based directly, or indirectly, from an international application which has an international filing date prior to November 29, 2000. If the copending application reference is either a national stage of an international application (application under 35 U.S.C. 371) which has an international filing date prior to November 29, 2000, or a continuing application claiming benefit under 35 U.S.C. 120, 121, or 365(c) to an international application having an international filing date prior to November 29, 2000, use pre-AIPA 35 U.S.C. 102(e) to determine the copending application reference's prior art date. See the Examiner Notes for form paragraphs 7.12 and 7.12.01 to assist in the determination of the 35 U.S.C. 102(e) date.
3. If the claimed invention is fully disclosed in the copending application, use paragraph 7.15.01.
4. In bracket 3, insert either --assignee-- or --inventor--.

5. In bracket 4, insert explanation of obviousness.
6. 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.
7. 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(a) rejection pursuant to 35 U.S.C. 103(c), a rejection should additionally be made under 35 U.S.C. 103(a) using paragraph 7.21 (e.g., applicant has named the prior inventor in response to a requirement made using paragraph 8.28).

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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(a), using form paragraph 7.15.01 or 7.21.01. 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(a), using form paragraph 7.15.02 or 7.21.02. Rejections under 35 U.S.C. 102 or 103 cannot be obviated solely by the filing of a terminal disclaimer. However, \*\*>for applications pending on or after December 10, 2004, rejections under 35 U.S.C. 102(e)/103(a) should not be made or maintained if the patent is disqualified under 35 U.S.C. 103(c) as prior art in a 35 U.S.C. 103(a) rejection.<

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¶ 7.15.01 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 published under 35 U.S.C. 122(b) or patented. This provisional rejection under 35 U.S.C. 102(e) is based upon a presumption of future publication or 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*, 925 F.2d 1450, 17 USPQ2d 1885 (Fed. Cir. 1991).

**Examiner Note:**

1. This form paragraph is used to provisionally reject over a copending application with an earlier filing date that discloses the claimed invention which has not been published under 35 U.S.C. 122. The copending application must have either a common assignee or at least one common inventor.

2. Use 35 U.S.C. 102(e) as amended by the American Inventors Protection Act and the Intellectual Property and High Technology Technical Amendments Act of 2002 (form paragraph 7.12) to determine the copending application reference's prior art date, unless the copending application reference is based directly, or indirectly, from an international application which has an international filing date prior to November 29, 2000. If the copending application reference is either a national stage of an international application (application under 35 U.S.C. 371) which has an international filing date prior to November 29, 2000, or a continuing application claiming benefit under 35 U.S.C. 120, 121, or 365(c) to an international application having an international filing date prior to November 29, 2000, use pre-AIPA 35 U.S.C. 102(e) (form paragraph 7.12.01). See the Examiner Notes for form paragraphs 7.12 and 7.12.01 to assist in the determination of the 35 U.S.C. 102(e) date.

3. If the claims would have been obvious over the invention disclosed in the other copending application, use form paragraph 7.21.01.

4. In bracket 3, insert either --assignee-- or --inventor--.

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

6. 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 form paragraphs 8.30 and 8.32.

7. 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 form paragraphs 7.13 and/or 7.14 should also be made.

¶ 7.15.02 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 form paragraph is used to reject over a patent or patent application publication with an earlier filing date that discloses but does not claim the same invention. The patent or patent application publication must have either a common assignee or a common inventor.

2. 35 U.S.C. 102(e) as amended by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 (form para-

graph 7.12) must be applied if the reference is one of the following:

- a. a U.S. patent or a publication of a U.S. application for patent filed under 35 U.S.C. 111(a);
- b. a U.S. patent issued directly or indirectly from, or a U.S. or WIPO publication of, an international application if the international application has an **international filing date on or after November 29, 2000**.

See the Examiner Notes for form paragraph 7.12 to assist in the determination of the 35 U.S.C. 102(e) date of the reference.

3. Pre-AIPA 35 U.S.C. 102(e) (form paragraph 7.12.01) must be applied if the reference is a U.S. patent issued directly, or indirectly, from an international application filed prior to November 29, 2000. See the Examiner Notes for form paragraph 7.12.01 to assist in the determination of the 35 U.S.C. 102(e) date of the reference.

4. In determining the 35 U.S.C. 102(e) date, consider priority/benefit claims to earlier-filed U.S. provisional applications under 35 U.S.C. 119(e), U.S. nonprovisional applications under 35 U.S.C. 120 or 121, and international applications under 35 U.S.C. 120, 121 or 365(c) if the subject matter used to make the rejection is appropriately supported in the relied upon earlier-filed application's disclosure (and any intermediate application(s)). A benefit claim to a U.S. patent of an earlier-filed international application, which has an international filing date prior to November 29, 2000, may only result in an effective U.S. filing date as of the date the requirements of 35 U.S.C. 371(c)(1), (2) and (4) were fulfilled. Do NOT consider any priority/benefit claims to U.S. applications which are filed before an international application that has an international filing date prior to November 29, 2000. Do NOT consider foreign priority claims under 35 U.S.C. 119(a)-(d) and 365(a).

5. If the reference is a publication of an international application (including voluntary U.S. publication under 35 U.S.C. 122 of the national stage or a WIPO publication) that has an international filing date prior to November 29, 2000, did not designate the United States or was not published in English by WIPO, do not use this form paragraph. Such a reference is not a prior art reference under 35 U.S.C. 102(e). The reference may be applied under 35 U.S.C. 102(a) or (b) as of its publication date. See form paragraphs 7.08 and 7.09.

6. In bracket 3, insert either --assignee-- or --inventor--.

7. This form paragraph must be preceded by either of form paragraphs 7.12 or 7.12.01.

8. Patent application publications may only be used if this form paragraph was preceded by form paragraph 7.12.

¶ *7.21.01 Provisional Rejection, 35 U.S.C. 103(a), Common Assignee or at Least One Common Inventor*

Claim [1] provisionally rejected under 35 U.S.C. 103(a) 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 published or patented. This provisional rejection under 35 U.S.C. 103(a) is based upon a presumption of future publication or 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. This rejection might also be overcome by showing that the copending application is disqualified under 35 U.S.C. 103(c) as prior art in a rejection under 35 U.S.C. 103(a). See MPEP § 706.02(l)(1) and § 706.02(l)(2).

**Examiner Note:**

1. This paragraph is used to provisionally reject claims not patently 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. This form paragraph should **not** be used in applications pending on or after December 10, 2004 when the copending application is disqualified under 35 U.S.C. 103(c) as prior art in a 35 U.S.C. 103(a) rejection. See MPEP § 706.02(l)(3).

2. Use 35 U.S.C. 102(e) as amended by the American Inventors Protection Act (AIPA) to determine the copending application reference's prior art date, unless the copending application reference is based directly, or indirectly, from an international application which has an international filing date prior to November 29, 2000. If the copending application reference is either a national stage of an international application (application under 35 U.S.C. 371) which has an international filing date prior to November 29, 2000, or a continuing application claiming benefit under 35 U.S.C. 120, 121, or 365(c) to an international application having an international filing date prior to November 29, 2000, use pre-AIPA 35 U.S.C. 102(e) to determine the copending application reference's prior art date. See the Examiner Notes for form paragraphs 7.12 and 7.12.01 to assist in the determination of the 35 U.S.C. 102(e) date.

3. If the claimed invention is fully disclosed in the copending application, use paragraph 7.15.01.

4. In bracket 3, insert either --assignee-- or --inventor--.

5. In bracket 4, insert explanation of obviousness.

6. 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.

7. 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(a) rejection pursuant to 35 U.S.C. 103(c), a rejection should additionally be made under 35 U.S.C. 103(a) using paragraph 7.21 (e.g., applicant has named the prior inventor in response to a requirement made using paragraph 8.28).

¶ *7.21.02 Rejection, 35 U.S.C. 103(a), Common Assignee or at Least One Common Inventor*

Claim [1] rejected under 35 U.S.C. 103(a) 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(a) might be overcome by: (1) 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 an invention “by another”; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). This rejection might also be overcome by showing that the reference is disqualified under 35 U.S.C. 103(c) as prior art in a rejection under 35 U.S.C. 103(a). See MPEP § 706.02(1)(1) and § 706.02(1)(2). [4]

#### Examiner Note:

1. This paragraph is used to reject over a reference (patent or published application) with an earlier filing date that discloses the claimed invention, and that only qualifies as prior art under 35 U.S.C. 102(e). If the reference qualifies as prior art under 35 U.S.C. 102(a) or (b), then this form paragraph should not be used (form paragraph 7.21 should be used instead). The reference must have either a common assignee or at least one common inventor. This form paragraph should **not** be used in applications when the reference is disqualified under 35 U.S.C. 103(c) as prior art in a 35 U.S.C. 103(a) rejection. See MPEP § 706.02(1)(3).

2. 35 U.S.C. 102(e) as amended by the American Inventors Protection Act of 1999 (AIPA) must be applied if the reference is one of the following:

- a. a U.S. patent or a publication of a U.S. application for patent filed under 35 U.S.C. 111(a);
- b. a U.S. patent issued directly or indirectly from, or a U.S. or WIPO publication of, an international application if the international application has **an international filing date on or after November 29, 2000**.

See the Examiner Notes for form paragraph 7.12 to assist in the determination of the 35 U.S.C. 102(e) date of the reference.

3. Pre-AIPA 35 U.S.C. 102(e) must be applied if the reference is a U.S. patent issued directly, or indirectly, from an international application filed prior to November 29, 2000. See the Examiner Notes for form paragraph 7.12.01 to assist in the determination of the 35 U.S.C. 102(e) date of the reference.

4. In bracket 3, insert either --assignee-- or --inventor--.

5. In bracket 4, insert explanation of obviousness.

<

### 804.04 Submission to Technology Center Director

In order to promote uniform practice, every Office action containing a rejection on the ground of double patenting which relies on the parent application rejecting the claims in a divisional or continuing application where the divisional or continuing application

was filed because of a requirement to restrict made by the examiner under 35 U.S.C. 121, including a requirement to elect species, must be submitted to the Technology Center 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.

### 805 Effect of Improper Joinder in Patent [R-3]

35 U.S.C. 121, last sentence, provides “the validity of a patent shall not be questioned for failure of the \*>Director< to require the application to be restricted to one invention.” In other words, under this statute, no patent can be held void for improper joinder of inventions claimed therein.

### 806 Determination of Distinctness or Independence of Claimed Inventions [R-3]

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

(A) Where inventions are independent (i.e., no disclosed relation therebetween), restriction to one thereof is ordinarily proper, MPEP § \*\*>806.06<.

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

(C) Where inventions are related as disclosed but are not distinct as claimed, restriction is never proper.

>

(D) A reasonable number of species may be claimed when there is an allowable claim generic thereto. 37 CFR 1.141, MPEP § 806.04.<

Where restriction is required by the Office double patenting cannot be held, and thus, it is imperative the requirement should never be made where related inventions as claimed are not distinct. For (B) and (C) see MPEP § 806.05 - § \*>806.05(j)< and § 809.03. See MPEP § 802.01 for criteria for patentably distinct inventions.

### 806.01 Compare Claimed Subject Matter [R-3]

In passing upon questions of double patenting and restriction, it is the claimed subject matter that is con-

sidered and such claimed subject matter must be compared in order to determine the question of distinctness or independence. >However, a provisional election of a single species may be required where only generic claims are presented and the generic claims recite such a multiplicity of species that an unduly extensive and burdensome search is necessary. See MPEP § 803.02 and § 808.01(a).<

\*\*

### **806.03 Single Embodiment, Claims Defining Same Essential Features [R-3]**

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 \*>not directed to distinct inventions; rather they are< different definitions of the same disclosed subject matter, varying in breadth or scope of definition.

Where such claims \*>are voluntarily presented< in different applications \*\*>having at least one common inventor or a common assignee (i.e., no restriction requirement was made by the Office)<, disclosing the same embodiments, see MPEP § 804 - § 804.02.

### **806.04 \*\*>Genus and/or Species< Inventions [R-3]**

\*\*>Where an application includes claims directed to different embodiments or species that could fall within the scope of a generic claim, restriction between the species may be proper if the species are independent or distinct. However, 37 CFR 1.141 provides that an allowable generic claim may link a reasonable number of species embraced thereby. The practice is set forth in 37 CFR 1.146.

*37 CFR 1.146. Election of species.*

In the first action on an application containing a generic claim to a generic invention (genus) and claims to more than one patentably distinct species embraced thereby, the examiner may require the applicant in the reply to that action to elect a species of his or her invention to which his or her claim will be restricted if no claim to the genus is found to be 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 application.

See MPEP § 806.04(d) for the definition of a generic claim, and MPEP § 806.04(e) for a discussion of claims that include one or more species.<

\*\*

### **806.04(b) Species May Be >Independent or< Related Inventions [R-3]**

Species \*\*>may be either< independent \*\*>or< related under the particular disclosure. >Where species under a claimed genus are not connected in any of design, operation, or effect under the disclosure, the species are independent inventions. See MPEP § 802.01 and § 806.06.< 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(j)<. 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. \*\*>If so,< restriction practice under election of species and the practice applicable to restriction between combination and subcombinations >must be addressed<.

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 >the intermediate and final products do not overlap in scope and are not obvious variants and< 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. >See MPEP § 806.05(j) for restriction practice pertaining to related products, including intermediate-final product relationships.<

\*\*

### **806.04(d) Definition of a Generic Claim [R-3]**

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.

\*\*In general, a generic claim should \*require< no material element additional to those \*\*>required by< the species claims, and \*\* each of the species >claims must require all the limitations of the generic claim<. \*\*

Once a \*\*>generic claim is allowable<, all of the claims drawn to species in addition to the elected species which \*require< all the limitations of the generic claim will ordinarily be \* allowable >over the prior art< in view of the \*allowability< of the generic claim, since the additional species will depend thereon or otherwise \*require< 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 \*require< all the limitations of the generic claim, \*\* see MPEP § \*821.04(a)<.

#### **806.04(e) Claims \*Limited< to Species [R-3]**

Claims are definitions of inventions. *Claims are never species.* \*The scope of a claim< may be \*limited< 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 \*the claim< (and thus be designated a *generic or genus claim*).

*Species are always the specifically different embodiments.*

Species \*\*>may be either< independent >or related< as disclosed (see MPEP § 806.04 and § 806.04(b)) \*\*.

#### **806.04(f) \*\*>Restriction Between< Mutually Exclusive \*Species< [R-3]**

>Where two or more species are claimed, a requirement for restriction to a single species may be proper if the species are mutually exclusive.< Claims \*\* to different species \*\*>are mutually exclusive if< one claim recites limitations \*\*>disclosed for< a first species but not \* a second, while a second claim recites limitations disclosed only for the second species and not the first. This \*\*>may also be< expressed by say-

ing that >to require restriction between claims limited to species, the< claims \*\* must not overlap in scope<.

#### **806.04(h) Species Must Be Patentably Distinct From Each Other [R-3]**

\*\*

In making a requirement for restriction in an application claiming plural species, the examiner should group together species considered clearly unpatentable over each other \*\*.

Where generic claims are \*\*>allowable<, applicant may claim in the *same application* additional species as provided by 37 CFR 1.141. >See MPEP § 806.04. 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 a double patenting rejection of the species claim(s) would be prohibited under 35 U.S.C. 121. See MPEP § 821.04(a) for rejoinder of species claims when a generic claim is allowable.<

Where, however, \*\* claims to a different species, or \* a species disclosed but not claimed in a parent case as filed and first acted upon by the examiner, >are voluntarily presented in a different application having at least one common inventor or a common assignee (i.e., no requirement for election pertaining to said species was made by the Office)< there should be close investigation to determine \*\*>whether a double patenting rejection would be appropriate<. See MPEP § 804.01 and § 804.02.

#### **806.04(i) Generic Claims Presented \*\* After Issue of Species [R-3]**

\*\*>If a generic claim is< presented \*\* after the issuance of a \*\*>patent claiming one or more species within the scope of the generic claim<, the Office may reject the generic \*claim< on the grounds of obviousness-type double patenting >when the patent and application have at least once common inventor and/or are either (1) commonly assigned/owned or (2) non-commonly assigned/owned but subject to a joint research agreement as set forth in 35 U.S.C. 103(c)(2) and (3). See MPEP § 804.< Applicant may overcome such a rejection by filing a terminal disclaimer. See >*In re Goodman*, 11 F.3d 1046, 1053, 29 USPQ2d

2010, 2016 (Fed. Cir. 1993); < *In re Braithwaite*, 379 F.2d 594, 154 USPQ 29 (CCPA 1967).

### 806.05 Related Inventions [R-3]

Where two or more related inventions are \* 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\*\*.

\*\*>Various< pairs of related inventions are noted in the following sections. >In applications claiming inventions in different statutory categories, only one-way distinctness is generally needed to support a restriction requirement. See MPEP § 806.05(c) (combination and subcombination) and § 806.05(j) (related products or related processes) for examples of when a two-way test is required for distinctness.<

#### 806.05(a) Combination and Subcombination\*\* [R-3]

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

\*\*

#### 806.05(c) Criteria of Distinctness \*> Between< Combination \*>and< Subcombination \*\* [R-3]

\*\*

To support a requirement for restriction >between combination and subcombination inventions<, both two-way distinctness and reasons for insisting on restriction are necessary, i.e., >there would be a serious search burden as evidenced by< separate classification, status, or field of search. See MPEP § 808.02.

The inventions are distinct if it can be shown that a combination as claimed:

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

(B) the subcombination can be shown to have utility either by itself or in \*\*>another materially< different \*>combination<.

When these factors cannot be shown, such inventions are not distinct.

The following examples are included for general guidance.

\*\*>

#### I. SUBCOMBINATION ESSENTIAL TO COMBINATION

##### *AB<sub>sp</sub>/B<sub>sp</sub> No Restriction*

Where a combination *as claimed* sets forth the details of the subcombination *as separately claimed*, there is no evidence that combination AB<sub>sp</sub> is patentable without the details of B<sub>sp</sub>. The inventions are not distinct and a requirement for restriction must not be made or maintained, even if the subcombination has separate utility. This situation can be diagrammed as combination AB<sub>sp</sub> (“sp” is an abbreviation for “specific”), and subcombination B<sub>sp</sub>. Thus the specific characteristics required by the subcombination claim B<sub>sp</sub> are also required by the combination claim.

#### II. SUBCOMBINATION NOT ESSENTIAL TO COMBINATION

##### *A. AB<sub>br</sub>/B<sub>sp</sub> 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., there would be a serious search burden as evidenced by separate classification, status, or field of search.

This situation can be diagrammed as combination AB<sub>br</sub> (“br” is an abbreviation for “broad”), and subcombination B<sub>sp</sub> (“sp” is an abbreviation for “specific”). B<sub>br</sub> indicates that in the combination the subcombination is broadly recited and that the specific characteristics required by the subcombination claim B<sub>sp</sub> are not required by the combination claim.

Since claims to both the subcombination and combination are presented, the omission of details of the

claimed subcombination  $B_{sp}$  in the combination claim  $AB_{br}$  is evidence that the combination does not rely upon the specific limitations of the subcombination for its patentability. If 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 species under a claimed genus, 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 bracket 3, specify the limitations of the claimed subcombination that are not required by the claimed combination. In situations involving evidence claims, see MPEP § 806.05(c), subsection II.
3. In bracket 4, suggest utility other than used in the combination.
4. Conclude restriction requirement with one of form paragraphs 8.21.01 through 8.21.03.

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 utility suggested by the examiner cannot be accomplished, the burden shifts to the examiner to document a viable separate utility or withdraw the requirement.

#### ***B. $AB_{sp}/AB_{br}/B_{sp}$ Restriction Proper***

The presence of a claim to combination  $AB_{sp}$  does not alter the propriety of a restriction requirement properly made between combination  $AB_{br}$  and sub-

combination  $B_{sp}$ . Claim  $AB_{br}$  is an evidence claim which indicates that the combination does not rely upon the specific details of the subcombination for its patentability. If a restriction requirement can be properly made between combination  $AB_{br}$  and subcombination  $B_{sp}$ , any claim to combination  $AB_{sp}$  would be grouped with combination  $AB_{br}$ .

If the combination claims are amended after a restriction requirement such that each combination, as claimed, requires all the limitations of the subcombination as claimed, i.e., if the evidence claim  $AB_{br}$  is deleted or amended to require  $B_{sp}$ , the restriction requirement between the combination and subcombination should not be maintained.

If a claim to  $B_{sp}$  is determined to be allowable, any claims requiring  $B_{sp}$ , including any combination claims of the format  $AB_{sp}$ , must be considered for rejoinder. See MPEP § 821.04.

### III. PLURAL COMBINATIONS REQUIRING A SUBCOMBINATION COMMON TO EACH COMBINATION

When an application includes a claim to a single subcombination, and that subcombination is required by plural claimed combinations that are properly restrictable, the subcombination claim is a linking claim and will be examined with the elected combination (see MPEP § 809.03). The subcombination claim links the otherwise restrictable combination inventions and should be listed in form paragraph 8.12. The claimed plural combinations are evidence that the subcombination has utility in more than one combination. Restriction between plural combinations may be made using form paragraph 8.14.01. See MPEP § 806.05(j).<

#### **806.05(d) Subcombinations Usable Together [R-3]**

Two or more claimed subcombinations, disclosed as usable together in a single combination, and which can be shown to be separately usable, are usually **\*\*>restrictable when the subcombinations do not overlap in scope and are not obvious variants<**.

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 if they do not overlap in scope and are not obvious variants, and if it is shown that at least one subcombination is separately usable. In the instant case subcombination [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 subcombination.
3. In bracket 4, suggest utility other than with the other subcombination.
4. Conclude restriction requirement with one of form paragraphs 8.21.01 through 8.21.03.

<

\*\*

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)).

\*\*

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 \* [R-3]**

\*\*

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

\*\*

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 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 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 materially different process such as.....--.
3. Conclude restriction requirement with one of form paragraphs 8.21.01 through 8.21.03.

<

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

\*\*

If applicant proves or provides convincing argument that there is no material difference or \*\*>that< a process \* 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 \* [R-3]**

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: (A) that the process *as claimed* is not an obvious process of making the product and the process *as claimed* can be used to make \*\*>another materially different product<; or (B) that the product *as claimed* can be made by another \* 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*, 357 F.2d 679, 149 USPQ 55 (CCPA 1966)) and can be restricted from the process if the examiner can dem-

onstrate 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 **8.18** and **8.21.04** should 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 materially different product or (2) that the product as claimed can be made by another 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 the basis for the restriction requirement with one of form paragraphs 8.21.01 through 8.21.03.
4. All restriction requirements between a product and a process of making the product should be followed by form paragraph 8.21.04 to notify the applicant that if a product claim is found allowable, process claims that depend from or otherwise require all the limitations of the patentable product may be rejoined.

#### **¶ 8.21.04 Notice of Potential Rejoinder of Process Claims in Ochiai/Brouwer Situation**

The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and the product claims are subsequently found allowable, withdrawn process claims that depend from or otherwise require all the limitations of the allowable product claim will be considered for rejoinder. All claims directed a nonelected process invention must require all the limitations of an allowable product claim for that process invention to be rejoined.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patent-

ability including the requirements of 35 U.S.C. 101, 102, 103 and 112. Until all claims to the elected product are found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowable product claim will not be rejoined. See MPEP § 821.04(b). Additionally, in order to retain the right to rejoinder in accordance with the above policy, applicant is advised that the process claims should be amended during prosecution to require the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.** Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

#### **Examiner Note:**

This form paragraph should appear at the end of any requirement for restriction between a product and a process of making the product (see form paragraph 8.18) or between a product and a process of using the product (see form paragraph 8.20).

<

### **806.05(g) Apparatus and Product Made \* [R-3]**

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: (A) that the apparatus as claimed is not an obvious apparatus for making the product and the apparatus as claimed can be used to make **another materially different product**; or (B) that the product as claimed can be made by another **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 materially different product or (2) that the product as claimed can be made by another 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 one of form paragraphs 8.21.01 through 8.21.03.

<

The examiner must show by way of example either (A) that the apparatus as *claimed* is not an obvious apparatus for making the product and the apparatus *as claimed* can be used to make **\*\*>**another materially different product< or (B) that the product *as claimed* can be made by another **\*** materially different apparatus.

The burden is on the examiner to provide an example, but the example 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 [R-3]

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: (A) the process of using as claimed can be practiced with another materially different product; or (B) 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 **\*>**paragraphs< 8.20 **\*>**and 8.21.04 should< 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. See 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)). If claims to a process specially adapted for (i.e., not patentably distinct from) making the product are also presented such process of making claims should be grouped with the product invention. See MPEP § 806.05(i).

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 the basis for the restriction requirement with one of form paragraphs 8.21.01 through 8.21.03.

4. All restriction requirements between a product and a process of using the product should be followed by form paragraph 8.21.04 to notify the applicant that if a product claim is found allowable, process claims that depend from or otherwise require all the limitations of the patentable product may be rejoined.

#### ¶ 8.21.04 Notice of Potential Rejoinder of Process Claims in Ochiai/Brouwer Situation

The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and the product claims are subsequently found allowable, withdrawn process claims that depend from or otherwise require all the limitations of the allowable product claim will be considered for rejoinder. All claims directed to a nonelected process invention must require all the limitations of an allowable product claim for that process invention to be rejoined.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103 and 112. Until all claims to the elected product are found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowable product claim will not be rejoined. See MPEP § 821.04(b). Additionally, in order to retain the right to rejoinder in accordance with the above policy, applicant is advised that the process claims should be amended during prosecution to require the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.** Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

#### Examiner Note:

This form paragraph should appear at the end of any requirement for restriction between a product and a process of making the product (see form paragraph 8.18) or between a product and a process of using the product (see form paragraph 8.20).

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**806.05(i) Product, Process of Making, and Process of Using \*\* [R-3]**

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)) making the product, and claims to a process of using the product\*\*, applicant may be required to elect either (A) the product and process of making it; or (B) the process of using. \*If< the examiner can>not< make a showing of distinctness between the process of using and the product (MPEP § 806.05(h)), \*\*>restriction cannot be required<.

\*\*

Form paragraph \*8.20 (See MPEP § 806.05(h))< may be used in product, process of making and process of using situations where the product \*\*>cannot be restricted from the process of making the product.

See MPEP § 821.04(b) for rejoinder practice pertaining to product and process inventions.<

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**806.05(j) Related Products; Related Processes [R-3]**

To support a requirement for restriction between two or more related product inventions, or between two or more related process inventions, both two-way distinctness and reasons for insisting on restriction are necessary, i.e., separate classification, status in the art, or field of search. See MPEP § 808.02. See MPEP § 806.05(c) for an explanation of the requirements to establish two-way distinctness as it applies to inventions in a combination/subcombination relationship. For other related product inventions, or related process inventions, the inventions are distinct if

(A) the inventions *as claimed* do not overlap in scope, i.e., are mutually exclusive;

(B) the inventions *as claimed* are not obvious variants; and

(C) the inventions *as claimed* are either not capable of use together or can have a materially different design, mode of operation, function, or effect. See MPEP § 802.01.

The burden is on the examiner to provide an example to support the determination that the inventions are distinct, but the example need not be documented. If applicant either proves or provides convincing evidence that the example suggested by the examiner is not workable, the burden is on the examiner to suggest another viable example or withdraw the restriction requirement.

As an example, an intermediate product and a final product can be shown to be distinct inventions if the intermediate and final products are mutually exclusive inventions (not overlapping in scope) that are not obvious variants, and the intermediate product as claimed is useful to make other than the final product as claimed. Typically, the intermediate loses its identity in the final product. See also MPEP § 806.05(d) for restricting between combinations disclosed as usable together. See MPEP § 809 - § 809.03 if a generic claim or claim linking multiple products or multiple processes is present.

Form paragraph 8.14.01 may be used to restrict between related products or related processes; form paragraph 8.14 may be used in intermediate-final product restriction requirements; form paragraph 8.16 may be used to restrict between subcombinations.

**¶ 8.14.01 Distinct Products or Distinct Processes**

Inventions [1] and [2] are directed to related [3]. The related inventions are distinct if the inventions as claimed do not overlap in scope, i.e., are mutually exclusive; the inventions as claimed are not obvious variants; and the inventions as claimed are either not capable of use together or can have a materially different design, mode of operation, function, or effect. See MPEP § 806.05(j). In the instant case, [4].

**Examiner Note:**

1. This form paragraph may be used when claims are presented to two or more related product inventions, or two or more related process inventions, wherein the inventions as claimed are mutually exclusive, i.e., there is no product (or process) that would infringe both of the identified inventions. Use form paragraph 8.15 to restrict between combination(s) and subcombination(s).

2. If a generic claim or claim linking multiple product inventions or multiple process inventions is present, see MPEP § 809 - § 809.03.
3. In bracket 3, insert --products -- or --processes--.
4. Conclude restriction requirement with one of form paragraphs 8.21.01 through 8.21.03.

#### ¶ 8.14 Intermediate-Final Product

Inventions [1] and [2] are related as mutually exclusive species in an 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 and the species are patentably distinct (MPEP § 806.05(j)). In the instant case, the intermediate product is deemed to be useful as [3] and the inventions are deemed patentably distinct because there is nothing on this record to show them to be obvious variants.

#### Examiner Note:

1. This form paragraph is to be used when claims are presented to both **an intermediate** and **final product** (MPEP § 806.05(j)).
2. Conclude restriction requirement with one of form paragraphs 8.21.01 through 8.21.03.

#### ¶ 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 if they do not overlap in scope and are not obvious variants, and if it is shown that at least one subcombination is separately usable. In the instant case subcombination [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 subcombination.
3. In bracket 4, suggest utility other than with the other subcombination.
4. Conclude restriction requirement with one of form paragraphs 8.21.01 through 8.21.03.

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## 806.06 Independent Inventions [R-3]

Inventions as claimed are independent if there is no disclosed relationship between the inventions, that is, they are unconnected in design, operation, and effect. If it can be shown that two or more inventions are independent, and if there would be a serious burden on the examiner if restriction is not required, applicant should be required to restrict the claims presented to one of such independent inventions. For example:

(A) Two different combinations, not disclosed as capable of use together, having different modes of operation, different functions and different effects are

independent. An article of apparel 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.

(B) 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 that cannot be used to practice the specific process.

Form paragraph 8.20.02 may be used to restrict between independent, unrelated inventions.

#### ¶ 8.20.02 Unrelated Inventions

Inventions [1] and [2] are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together, and they have different designs, modes of operation, and effects. (MPEP § 802.01 and § 806.06). In the instant case, the different inventions [3].

#### Examiner Note:

1. This form paragraph is to be used only when claims are presented to unrelated inventions, e. g., a necktie and a locomotive bearing not disclosed as capable of use together.
2. In bracket 3, insert reasons for concluding that the inventions are unrelated.
3. This form paragraph must be followed by one of form paragraphs 8.21.01, 8.21.02 or 8.21.03.

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## 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 [R-3]

Every requirement to restrict has two aspects: (A) the reasons (as distinguished from the mere statement of conclusion) why *each invention as claimed* is either independent or distinct from the other(s); and (B) the reasons why there would be a serious burden on the examiner if restriction is not required, i.e., the reasons for insisting upon restriction therebetween as set forth in the following sections.











































