



MEMORANDUM

Date: April 25, 2007

To: Technology Center Directors
Patent Examining Corps

From: John Love *John Love*
Deputy Commissioner for Patent Examination Policy

Subject: Changes to Restriction form paragraphs

The purpose of this memorandum is to clarify Office policy with respect to communicating election of species requirements to applicants and with respect to establishing burden in the context of election of species requirements and restriction requirements.

Current form paragraphs 8.01 and 8.02 concerning election of species have caused confusion for some patent examiners and applicants. The current form paragraphs require an examiner to provide an explanation as to why the species are independent or distinct; the revised form paragraphs provide such explanation (i.e., "the mutually exclusive characteristics"). Using the revised form paragraphs, the examiner need only identify the species and identify the generic claim(s) (if present). However, as the Examiner Notes state, it is useful to describe the mutually exclusive characteristics of each species, if these characteristics are not readily apparent by the designation of the species by the figures or examples in the specification.

As noted in MPEP §§ 803 and 808.02, if the examination and search of all the claims in an application can be made without serious burden, the examiner must examine them on the merits, even though they are drawn to independent or distinct inventions, including species. To help ensure that an election of species requirement sets forth the requisite burden, the statement of search and examination burden is now incorporated directly into form paragraphs 8.01 and 8.02. These form paragraphs have been amended to include the three most common reasons for this burden in an election of species. In most cases at least two, if not all three, of these reasons will apply for patentably distinct species. If the applicant argues that the restriction is improper because there is no burden, the examiner should specify which one(s) of the reasons apply. The examiner should be able to readily identify with specificity which reason(s) apply when responding to applicant's arguments, since the search and FAOM will have been done.

New form paragraph 8.21 consolidates and replaces previous form paragraphs 8.21.01- 8.21.03 and 8.22. This new form paragraph will be for use at the end of all restriction requirements which require restrictions between inventions other than election of species, and lists the most common reasons for the search and examination burden.

The next revision of the MPEP will be amended to incorporate these changes. Examiners should seek assistance from knowledgeable TC personnel if questions arise.

Members of the MPEP Chapter 800 Review workgroup include:

TC 1600- Julie Burke, Christopher Low TC 1700- Gladys Corcoran
TC 2100- Pat Salce TC 2800- Hien Phan, Bill Baumeister
TC 2600- Ken Vanderpuye TC 3600- Terry Melius, Vinnie Millin
TC 3700- Tom Hughes OPLA- Kathleen Fonda, Karen Hastings

The following form paragraphs will be available as "custom form paragraphs" until the release of next OACS update in July 2007.

Amended form paragraphs 8.01, 8.02 and new form paragraph 8.21

¶ 8.01 Requiring an Election of Species; Species Claim(s) Present

This application contains claims directed to the following patentably distinct species [1]. The species are independent or distinct because claims to the different species recite the mutually exclusive characteristics of such species. In addition, these species are not obvious variants of each other based on the current record.

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

There is an examination and search burden for these patentably distinct species due to their mutually exclusive characteristics. The species require a different field of search (e.g., searching different classes/subclasses or electronic resources, or employing different search queries); and/or the prior art applicable to one species would not likely be applicable to another species; and/or the species are likely to raise different non-prior art issues under 35 U.S.C. 101 and/or 35 U.S.C. 112, first paragraph.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species to be examined even though the requirement may be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected species, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

The election of the species may be made with or without traverse. To preserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the election of species requirement, the election shall be treated as an election without traverse. Traversal must be presented at the time of election in order to be considered timely. Failure to timely traverse the requirement will result in the loss of right to petition under 37 CFR 1.144. If claims are added after the election, applicant must indicate which of these claims are readable on the elected species.

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

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141.

Examiner Note:

1. In bracket 1, identify the species from which an election is to be made. The species are preferably identified as the species of figures 1, 2, and 3, for example, or the species of examples I, II, and III, respectively. It would be useful to describe the mutually exclusive characteristics of each species if these characteristics are not readily apparent. Or, it may be useful to explain in more detail why the species are

independent or distinct using, for example only, the definition of independent or distinct inventions at MPEP § 802.01 or form paragraphs 8.14.01 or 8.20.02. However, it is not necessary to use form paragraphs 8.14.01 or 8.20.02 here.

2. In bracket 2 insert the appropriate generic claim information.
3. This form paragraph does not need to be followed by form paragraph 8.21.
4. If applicant traverses the requirement on the basis that there is no search burden, the examiner will explain specifically which reason(s) apply.

¶ 8.02 Requiring an Election of Species; No Species Claim Present

Claim [1] generic to the following disclosed patentably distinct species: [2]. The species are independent or distinct because as disclosed the different species have mutually exclusive characteristics for each identified species. In addition, these species are not obvious variants of each other based on the current record.

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

There is an examination and search burden for these patentably distinct species due to their mutually exclusive characteristics. The species require a different field of search (e.g., searching different classes/subclasses or electronic resources, or employing different search queries); and/or the prior art applicable to one species would not likely be applicable to another species; and/or the species are likely to raise different non-prior art issues under 35 U.S.C. 101 and/or 35 U.S.C. 112, first paragraph.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species to be examined even though the requirement may be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected species, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

The election of the species may be made with or without traverse. To preserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the election of species requirement, the election shall be treated as an election without traverse. Traversal must be presented at the time of election in order to be considered timely. Failure to timely traverse the requirement will result in the loss of right to petition under 37 CFR 1.144. If claims are added after the election, applicant must indicate which of these claims are readable on the elected species.

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

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141.

Examiner Note:

1. This form paragraph should be used for the election of requirement described in MPEP § 803.02 (Markush group) and MPEP § 808.01(a) where only generic claims are presented.

2. In bracket 2, clearly identify the species from which an election is to be made. The species may be identified as the species of figures 1, 2, and 3, for example, or the species of examples I, II, and III, respectively. It would be useful to describe the mutually exclusive characteristics of each species if these characteristics are not readily apparent. Or, it may be useful to explain in more detail why the species are

independent or distinct using, for example only, the definition of independent or distinct inventions at MPEP § 802.01 or form paragraphs 8.14.01 or 8.20.02. However, it is not necessary to use form paragraphs 8.14.01 or 8.20.02 here.

3. This form paragraph does not need to be followed by form paragraph 8.21.

4. If applicant traverses the requirement on the basis that there is no search burden, the examiner will explain specifically which reason(s) apply.

New form paragraph 8.21 replaces previous form paragraphs 8.21.01 - 8.21.03 and 8.22:

¶ 8.21 To Establish Burden AND Requirement for Election and Means for Traversal for all Restrictions, other than an Election of Species

Restriction for examination purposes as indicated is proper because all these inventions listed in this action are independent or distinct for the reasons given above and there would be a serious search and examination burden if restriction were not required because one or more of the following reasons apply:

- (a) the inventions have acquired a separate status in the art in view of their different classification;
- (b) the inventions have acquired a separate status in the art due to their recognized divergent subject matter;
- (c) the inventions require a different field of search (for example, searching different classes/subclasses or electronic resources, or employing different search queries);
- (d) the prior art applicable to one invention would not likely be applicable to another invention;
- (e) the inventions are likely to raise different non-prior art issues under 35 U.S.C. 101 and/or 35 U.S.C. 112, first paragraph.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a invention to be examined even though the requirement may be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse. Traversal must be presented at the time of election in order to be considered timely. Failure to timely traverse the requirement will result in the loss of right to petition under 37 CFR 1.144. If claims are added after the election, applicant must indicate which of these claims are readable on the elected invention.

If claims are added after the election, applicant must indicate which of these claims are readable upon the elected invention.

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

Examiner Note:

1. THIS FORM PARAGRAPH MUST BE ADDED TO ALL RESTRICTION REQUIREMENTS **other than** those containing **only election of species**, with or without an action on the merits. This form paragraph only needs to be used once, after all restriction requirements are set out.

2. If applicant traverses the requirement on the basis that there is no search burden, the examiner will explain specifically which reason(s) apply.