Suggested topic is the practice of some examiners in requiring restriction between allegedly patentably distinct species without presenting an explanation of their reasoning, and with the apparent position that every disclosed variation of an invention constitutes a patentably distinct species.

Some examiners appear to view every different embodiment disclosed in the application as a “patentably distinct” species, with no explanation other than to point out some differences between the embodiments (or differences in the claim limitations). In some cases, even different figures illustrating the same embodiment have been asserted to be patentably distinct species.

The examiner in such cases fails to provide an explanation other than stating that the species have different features, and quotes the boilerplate:

> 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.

This not only fails to explain the basis for the position that a serious burden would be created, but does not even definitively state what basis is being applied, due to the recitation of “and/or” in the paragraph.

It might also be noted that the latter two reasons for restriction do not appear to match the bases for establishing a serious burden set forth in MPEP §808.02.

It also appears that the standard for what is “patentably distinct” for purposes of requiring a restriction is vastly different than the standard for what is “patentably distinct”when applying prior art against the claims.

-Jeff

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