

Dear Sir or Madam,

Please find attached a topic submission for the Case Studies pilot program, relating to the species elections in restriction requirements. If you have any issues with the PDF file or questions concerning the submission, please do not hesitate to contact me.

We would appreciate it if you could please acknowledge receipt of this submission via return email.

Respectfully submitted,

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Title: Use of Species Elections in lieu of Restriction Requirement to Limit Examiner's Search

Proposal for Study: Examiners are utilizing species elections to narrow the scope of their search and not expanding to the generic claim after a species is allowable

Explanation: Some Examiners issue a restriction requirement dividing the claims into groups such as, for example, (I) composition of matter, (II) method of manufacturing, and (III) method of use. Then within a particular group, for example group (I), the Examiner will further require multiple species elections. See MPEP 809.02(A). Once the Examiner has examined a single species, the Examiner will force the Applicant to cancel the generic claims that encompass the species and only allow the elected species.

As such, the Applicant will be forced to pursue the generic claims in a later filed application. As this is a species election, the Applicant is no longer able to rely on the 35 U.S.C. § 121 safe harbor to prevent future double patenting rejections between genus and species applications.

The USPTO should study current Restriction and species election practice. For example, the USPTO may review patent applications for the number of species elections required by the Examiner and how many patents are issued from the applications that contain (I) only the elected species, or (II) the elected species and generic claims encompassing such species to determine if there are significant variations which arise between Examiners/Supervisory Patent Examiner Groups at the USPTO. Discovery of such variations could lead to (a) a better understanding of USPTO Restriction and species election practice, (b) identify whether additional training is needed and which groups could benefit from the training, and (c) ensure consistency across patent applications where a Restriction Requirement is issued and species election are required.