Chapter 800 Restriction >in applications filed under 35 U.S.C. 111<; Double Patenting

801 Introduction [R-8]

>This Chapter is limited to a discussion of the<* subject of restriction ** and double patenting ** under U.S.C. Title 35 ** and the Rules of Practice >as it relates to national applications filed under 35 U.S.C. 111. 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 Patent and Trademark Office is covered in Chapter 1800.<

802 Basis for Practice in Statute ** and Rules [R-8]

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 Commissioner may require the application to be restricted to one of the inventions. If the other invention is made the subject of a divisional application which complies with the requirements of section 120 of this title it shall be entitled to the benefit of the filing date of the original application. A patent issuing on an application with respect to which a requirement for restriction under this section has been made, or on an application filed as a result of such a requirement shall not be used as a reference either in the Patent 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 Commissioner may dispense with signing and execution by the inventor. The validity of a patent shall not be questioned for failure of the Commissioner to require the application to be restricted to one invention. **

37 CFR 1.141. Different inventions in one 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 that 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 his action shall require the applicant in his response to that action to elect that invention to which his claim shall be restricted, this official action being called a requirement for restriction (also known as a requirement for division). If the distinctness and independence of the inventions be clear, such requirement will be made before any action on the merits; however, it may be made at any time before final action in the case, at the discretion of the examiner.

(b) Claims to the invention or inventions not elected, if not cancelled, 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 1868, 1898.02(b) and 1898.07(c) should be consulted for discussions on unity of invention (1) before the International Searching Authority, (2) the International Preliminary Examining Authority and (3) the National Stage under 35 U.S.C. 371.<

802.01 Meaning of "Independent", "Distinct" [R-8]

35 U.S.C. 121 quoted in the preceding section states that the Commissioner may require restriction if two or more "independent and distinct" inventions are claimed in one application. In 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 subjects as between which the Commissioner may require restriction. This in turn depends on the construction of the expression "independent and distinct" inventions.

"Independent," of course, means not dependent. If "distinct" means the same thing, then its use in the statute and in the rule is redundant. If "distinct" means something different, then the question arises as to what the difference in meaning between these two words may be. The hearings before the committees of Congress considering the codification of the patent laws indicate that 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 subjects between which the Commissioner may properly require division.

The term "independent" as already pointed out, means not dependent. A large number of subjects between which, prior to the 1952 Act, division had been proper, are dependent subjects, such, for example, as combination and a subcombination thereof; as process and apparatus used in the practice of the process; as composition and the process in which the composition is used; as process and the product made by such process, etc. If section 121 of the 1952 Act were intended to direct the Commissioner never to approve division between dependent inventions, the word "independent" would clearly have been used alone. If the Commissioner has authority or discretion to restrict independent inventions only, then restriction would be improper as between dependent inventions, e.g., such as the ones used for purpose of illustration above. Such was clearly, however, not the intent of Congress. Nothing in the language of the statute and nothing in the hearings of the committees indicate any intent to change the substantive law on this subject. On the contrary, joinder of the term "distinct" with the term "independent", indicates lack of such intent. The law has long been established that dependent inventions (frequently termed related inventions) such as used for illustration above may be properly divided if they are, in fact "distinct" inventions, even though dependent.

INDEPENDENT

The term "independent" (i.e., not dependent) means that there is no disclosed relationship between the two or more subjects disclosed, that is, they are unconnected in design, operation or effect, for example, (1) species under a genus which species are not usable together as disclosed or (2) process and apparatus incapable of being used in practicing the process.

DISTINCT

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

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

802.02 Definition of Restriction

Restriction, a generic term, includes that practice of requiring an election between distinct inventions, for example, election between combination and subcombination inventions, and the practice relating to an election between independent inventions, for example, and election of species.

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803 Restriction — When Proper [R-8]

Under the statute 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

If the search and examination of an entire application can be made without serious burden, the examiner >must<** examine it on the merits, even though it includes claims to distinct or independent inventions.**

>CRITERIA FOR RESTRICTION BETWEEN PATENTABLY DISTINCT INVENTIONS

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

(1) The inventions must be independent (see MPEP §§ 802.01, 806.04, 808.01) or distinct as claimed (see MPEP §§ 806.05-806.05(i)); and

(2) There must be a serious burden on the examiner if restriction is not required (see MPEP §§ 803.02, 806.04(a) - (j), 808.01(a) and 808.02).<

>GUIDELINES

Examiners must provide reasons and/or examples to support conclusions, but need not cite documents to support the 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 are obvious over each other within the meaning of 35 U.S.C. 103, restriction should not be required, *In re Lee*, 199 USPQ 108 (Deputy Asst. Commr. for Pats 1978).

For purposes of the initial requirement a serious burden on the examiner may be prima facie shown if the examiner shows by appropriate explanation either separate classification, 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(a) - (j) and MPEP § 808.01(a).<

803.01 Review by Primary Examiner

Since requirements for restriction under Title 35 U.S.C. 121 are discretionary with the Commissioner, 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, the primary examiner must personally review and sign all final requirements for restriction.

>803.02 Restriction - Markush Claims [R-8]

PRACTICE RE MARKUSH-TYPE CLAIMS

Since the decisions in *In re Weber et al.*, 198 USPQ 328 (CCPA 1978); and *In re Haas*, 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 Harnish*, 631 F.2d 716, 206 USPQ 300 (CCPA 1980); *Ex Parte Hozumi*, 3 USPQ 2d 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 disclosed as being essential to that utility.

This subsection deals with Markush-type generic claims which include 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. In many cases, the Markush-type claims 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 claims of that nature, the examiner may require a provisional election of a single species prior to examination on the merits. The provisional election will be given effect in the event that the Markush-type claim should be found not allowable. 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. Should the Markush-type claim be found not allowable, 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 C-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, CA, CB, CC, CD, or CE. 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 non-elected species would be held withdrawn from further consideration. As in the prevailing practice, a second action on the rejected claims would be made final.

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 non-elected species held withdrawn from further consideration. The prior art search, however, will not be extended unnecessarily to cover all non-elected 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 made final. Amendments submitted after the final rejection further restricting the scope of the claim **>may be denied entry<.

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 claims on the merits, even though they are directed to independent and distinct inventions. In such a case, the examiner will not follow the above procedure and will not require restriction.<

804 Definition of Double Patenting [R-8]

>Double patenting results when two or more patents are granted containing conflicting claims, that is claims in each patent that recite either the same inventive concept or obvious variations of the same concept.<**

There are 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." This has been interpreted as meaning only one patent. >A good test for double patenting under 35 U.S.C. 101 is whether one of the claims could be literally infringed without literally infringing the other. *In re Vogel*, 164 USPQ 619 (CCPA 1970).<

The other type is the "obviousness" type double patenting rejection which is a judicially created doctrine based on public policy rather than statute and 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. *In re White et al.*, 160 USPQ 417; *In re Thorington et al.*, 163 USPQ 644 >and *In re Vogel*, 164 USPQ 619.

When two or more pending applications of (1) the same inventive entity, (2) the same assignee, or (3) having at least one common inventor, contain conflicting claims which are not patentably distinct, a "provisional" double patenting rejection of either the same or obviousness-type should be made in each application. Such a rejection is "provisional" since the conflicting claims are not, as yet, patented, *In re Wetterau*, 148 USPQ 499 (CCPA 1966).

ONLY PROVISIONAL DOUBLE PATENTING REJECTION IN ONE APPLICATION

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 one of the applications. If the "provisional" double patenting rejection in one application is the only rejection remaining in that application, the examiner should then withdraw that rejection and permit the application to issue as a patent, thereby converting the "provisional" double patenting rejection in the other application(s) into a double patenting rejection at the time the one application issues as a patent.

ONLY PROVISIONAL DOUBLE PATENTING REJECTION IN TWO APPLICATIONS

If the "provisional" double patenting rejections in both application are the only rejections remaining in those applications, the examiner should then withdraw that rejection in one of the applications and permit the application to issue as a patent. 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 the one application issues as a patent.

See MPEP § 304 for conflicting applications, one of which is assigned.<. Note also >MPEP< §§ 804.01 and 804.02.

>Double patenting does not relate to international applications which have not yet entered the national stage in the United States.

The term "double patenting" is properly applicable to cases involving two or more applications and/or patents that have at least one common inventor or that are commonly owned. See 37 CFR 1.78(d) and MPEP § 804.02 for treatment of commonly owned cases with different inventive entities.<

Form paragraphs >7.04, 7.06 and 7.06.1 (see MPEP §§ 706.03(a) and 706.03(k)) may be used for statutory double patenting rejections, and form paragraphs< 7.24 - 7.26.1 may be used for obviousness-type double patenting >rejections<*.

¶ 7.24 Rejection, Obviousness Double Patenting

Claim [1] rejected under the judicially created doctrine of 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 paragraph is used for obviousness-type double patenting rejections based upon a patent.

2. If the obviousness-type double patenting rejection is based on another application, do not use this paragraph. A provisional obviousness-type double patenting rejection should be made using either form paragraph 7.24.1 or 7.25.1.

3. This 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, or

(c) not commonly assigned but has at least one inventor in common.

4. Form Paragraph 7.26 must follow one of paragraphs 7.24 - 7.25.1 and must be used only once in an Office action.

5. In bracket 3, insert the number of the patent.

6. If evidence is also of record to indicate that the conflicting patent is prior art under 35 U.S.C. 102(f) or 102(g), a rejection should additionally be made under 102(f)/103 or 102(g)/ 103 using form paragraph 7.21.

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) or 102(e)/103 may be made using form paragraphs 7.15.1 or 7.21.1.

¶ 7.24.1 Provisional Rejection, Obviousness Double Patenting

Claim [1] provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim [2] of copending application serial 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 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 paragraph 7.24.

3. This 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, or

(c) not commonly assigned but has at least one inventor in common.

4. Form Paragraph 7.26 must follow one of paragraphs 7.24 - 7.25.1 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 place of or 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 double patenting rejection should also be made in the other conflicting application.

8. 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 102(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 under 102(f)/103 or 102(g)/ 103 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 7.21.1 to additionally make a 102(e)/103 rejection.

¶ 7.25 Rejection, Obviousness Double Patenting, Reference

Claim [1] rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim [2] of U.S. patent no. [3] in view of [4].

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 either form paragraph 7.24.1 or 7.25.1.

3. This 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, or

(c) not commonly assigned but has at least one inventor in common.

4. Form Paragraph 7.26 must follow one of paragraphs 7.24 - 7.25.1 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. An explanation of the obviousness-type double patenting rejection must follow this paragraph.

8. If evidence is also of record to show that the conflicting patent is prior art under 102(f) or 102(g), a rejection should additionally be made under 102(f)/103 or 102(g)/ 103 using form paragraph 7.21.

9. If the patent issued to a different inventive entity and has an earlier U.S. filing date, a rejection under 35 U.S.C. 102(e) or 102(e)/ 103 may be made using form paragraphs 7.15 or 7.21.

¶ 7.25.1 Provisional Rejection, Obviousness-type Double Patenting Rejection

Claim [1] provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim [2] of copending application serial no. [3] in view of [4].

This is a provisional obviousness-type double patenting rejection.

Examiner Note:

1. This 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 7.25.

3. This 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, or

(c) not commonly assigned but has at least one inventor in common.

4. Form Paragraph 7.26 must follow one of paragraphs 7.24 - 7.25.1 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 place of or in addition to this form paragraph to also resolve any issues of priority of invention under 102(f) and/or (g).

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

7. An explanation of the obviousness-type double patenting rejection must follow this paragraph.

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

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 102(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 under 102(f)/103 or 102(g)/ 103 using form paragraph 7.21.

10. 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 7.21.1 to additionally make a 102(e)/103 rejection.

¶ 7.26 Obviousness-type Double Patenting, Basis

The obviousness-type double patenting rejection is a judicially established doctrine based upon public policy and is primarily intended to prevent prolongation of the patent term by prohibiting claims in a second patent not patentably distinct from claims in a first patent. In re Vogel, 164 USPQ 619 (CCPA 1970). A timely filed terminal disclaimer in compliance with 37 CFR 1.321(b) would overcome an actual or provisional rejection on this ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.78(d).

Examiner Note:

This paragraph must be used only once in an Office action and must follow one of form Paragraphs 7.24 - 7.25.1.

The Court of Customs and Patent Appeals has held that a terminal disclaimer is ineffective **>for the "same invention" type double patenting situation<, where it is attempted to twice claim the same invention. However, the "obviousness" type double patenting rejection may be obviated by a terminal disclaimer.**>Such a disclaimer is required in each application since the Office cannot ensure which application will issue first.<

The inventive entity is the sole inventor or the joint inventors listed on a patent or patent application. A sole inventor in one application and joint inventors in another application cannot constitute a single or the same inventive entity, even if the sole inventor is one of the joint inventors. Likewise, two sets of joint inventors do not constitute a single inventive entity if any individual inventor is included in one set who is not also included in the other set.

804.01 Nullification of Double Patenting Rejection [R-8]

35 U.S.C. 121, third sentence, provides that where the Office requires restriction **, the patent of either the parent or any divisional application thereof conforming to the requirement cannot be used as a reference against the other. This apparent nullification of double patenting as a ground of rejection or invalidity in such cases imposes a heavy burden on the Office to guard against erroneous requirements for restriction where the claims define essentially the same inventions in different language and which, if acquiesced in, might result in the issuance of several patents for the same invention.**

A. SITUATIONS WHERE THE DOUBLE PATENTING PROTECTION UNDER 35 U.S.C. 121 DOES NOT APPLY

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

(b) The claims of the different applications or patents are not consonant with the requirement made by the examiner, due to the fact that the claims have been changed in material respects from the claims at the time the requirement was made.

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

(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<.

B. SITUATIONS WHERE THE DOUBLE PATENTING PROTECTION UNDER 35 U.S.C. 121 APPARENTLY APPLIES

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

804.02 Terminal Disclaimer Avoiding Double Patenting Rejection [R-8]

If two or more cases are filed by a single inventive entity >, a common inventor, and/or are commonly owned<, and ** by reason >for example,< of the filing of one or more terminal disclaimers >and there is a covenant against dual ownership<, two or more patents may properly be granted, provided the claims of the different cases are not drawn to the same invention as defined for double patenting purposes (*In re Knohl*, 155 USPQ 586; *In re Griswold*, 150 USPQ 804; In re *Vogel and Vogel*, 164 USPQ 619).

The Patent and Trademark Office cannot ensure that two or more cases ** will have a 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 problem of dual ownership of patents to patentably indistinct inventions.

Claims that differ from each other (aside from minor differences in language, punctuation, etc.), whether or not the difference is 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 is obvious, terminal disclaimers are effective to overcome rejections on double patenting. However, 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(b).

>See MPEP § 1490 for wording for a terminal disclaimer. In drafting the terminal disclaimer, consideration should be given to the effect on the expiration date of one patent if a maintenance fee is not paid on the other patent.<

Where there is no difference >in the claims<, the inventions are the same and a terminal disclaimer is ineffective.

>It should be emphasized that a terminal disclaimer cannot be used to overcome a rejection under 35 U.S.C. 102(e)/103.<

37 CFR 1.321 Statutory disclaimer

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(b) A terminal disclaimer, when filed in an application to obviate a double patenting rejection, must be accompanied by the fee set forth in § 1.20(d) and include a provision that any patent granted on that application 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.

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

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(d) Where an application claims an invention which is not patentably distinct from an invention claimed in a commonly owned patent with the same or a different inventive entity, a double patenting rejection will be made in the application. An obviousness-type double patenting rejection may be obviated by filing a terminal disclaimer in accordance with § 1.321(b).<**

804.03 >Treatment of Conflicting Claims in< ** Commonly Owned Cases of Different Inventive Entities [R-8]

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

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(c) Where two or more applications, or an application and a patent naming different inventors and owned by the same party 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 assignee may be called upon 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. In addition to making said statement, the assignee may also explain why an interference should >or should not< be declared**.

>(d) Where an application claims an invention which is not patentably distinct from an invention claimed in a commonly owned patent with the same or a different inventive entity, a double patenting rejection will be made in the application. An obviousness-type double patenting rejection may be obviated by filing a terminal disclaimer in accordance with § 1.321(b).<

In view of 35 U.S.C. 135, it is >normally< necessary to determine priority of invention whenever two different inventive entities are claiming a single inventive concept, including variations of the same concept each of which would be obvious in view of the other. **

>PRIORITY DETERMINATION NOT REQUIRED FOR INVENTIONS MEETING THE PROVISIONS OF THE SECOND PARAGRAPH OF 35 U.S.C. 103.

A determination of priority is not required when two inventions come within the provisions of the second paragraph of 35 U.S.C. 103. Two inventions of different inventive entities come within the provisions of the second paragraph of 35 U.S.C. 103 when (1) the later invention is not anticipated by the earlier invention under 35 U.S.C. 102; (2) the earlier invention qualifies as prior art against the later invention only under subsection (f) or (g) of 35 U.S.C. 102 ; and (3) 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. If the two inventions come within the provisions of the second paragraph of 35 U.S.C. 103, it is not necessary to determine priority of invention since the earlier invention is disqualified as prior art against the later invention and since the prohibitions against double patenting can be used to ensure that the patent terms expire together. In situations where the inventions of different inventive entities come within the provisions of the second paragraph of 35 U.S.C. 103 by virtue of meeting the requirements set forth above, any conflicting claims of different inventive entities should be rejected under the judicially created doctrine of "obviousness-type" double patenting. See MPEP § 804. In circumstances where the inventions of different inventive entities come within the provisions of the second paragraph

of 35 U.S.C. 103, no inquiry under 37 CFR 1.78(c) should be made since it is unnecessary to determine the prior inventor.

PRIORITY DETERMINATION REQUIRED FOR INVENTIONS NOT MEETING THE PROVISIONS OF THE SECOND PARAGRAPH OF 35 U.S.C. 103

If the inventions of different inventive entities do not come within the provisions of the second paragraph of 35 U.S.C. 103, or there is no evidence that they do, but are owned by the same party and contain conflicting claims, it is necessary to determine the prior inventor unless the conflicting claims by all but one inventive entity are eliminated.

If the conflicting claims of the different inventive entities are contained in an application and a patent having an earlier effective filing date than the application, the application should be rejected utilizing the patent under 35 U.S.C. 102 and/or 103 and also on the grounds of double patenting.

If the conflicting claims of commonly owned inventions of different inventive entities are contained in two applications or an application and a patent having a later effective filing date than the application, the provisions of 37 CFR 1.78(c) should be relied upon if the inventions do not come within the provisions of the second paragraph of 35 U.S.C. 103. This could occur if the subject matter of one invention would anticipate the subject matter of the other, if earlier. This could also occur if the subject matter of one invention would be obvious in view of the subject matter of the other, if earlier, and there is no statement of record 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. If the earlier invention of a different inventive entity has not been shown to be disqualified as prior art to the later commonly owned invention under the second paragraph of 35 U.S.C. 103 and the inventions are claimed in (1) different applications, or (2) an application and a patent having a later effective filing date than the application, the examiner should call upon the assignee to (a) 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, (b) indicate which inventive entity is the prior inventor. In making the requirement, the examiner must provided a proper foundation for the basic requirement under 37 CFR 1.78(c) that the claims to the inventions are conflicting, i.e., the "two different inventive entities are claiming a single inventive concept, including variations of the same concept each of which would be obvious in view of the other." *In re Rekers*, 203 USPQ 1034 (Commr. Pats. 1979). In responding to the examiner's requirement, the response must comply therewith, but may also explain why an interference should or should not be declared. If the response does not comply with the requirement, the application will be held abandoned. In some situations the application file wrappers may reflect which invention is the prior invention, e.g., by reciting that one invention is an improvement of the other invention. See *Margolis et al v. Banner*, 202 USPQ 365 (CCPA 1979), wherein the 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. If one application has an earlier effective filing date than the other application, a provisional rejection under 35 U.S.C. 102(e) or 102(e)/103 would be appropriate. See MPEP § 706.02. In circumstances where the assignee is called upon to make a statement under the provisions of 37 CFR 1.78(c) and 35 U.S.C. 132, a double patenting rejection should also be made in the application(s) having the conflicting claims. A terminal disclaimer can have no effect on other than the double patenting rejection in circumstances where the rejection is one based upon 35 U.S.C. 102 or 103.

DOUBLE PATENTING IN COMMONLY OWNED CASES OF DIFFERENT INVENTIVE ENTITIES

The Patent and Trademark Office has withdrawn the Commissioner's Notice of January 9, 1967, "Double Patenting", 834 O.G. 1615 (Jan. 31, 1967), to the extent that it does not authorize a double patenting rejection where different inventive entities are present. The examiner may reject claims in commonly owned applications of different inventive entities 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)

> ("--- the correct procedure for double patenting cases is to analyze the claims to determine the inventions defined therein, and then decide whether such inventions, as claimed are patentably distinct and therefore qualified to be claimed in separate patents").

In accordance with established patent law doctrines, double patenting rejections can be overcome in certain circumstances by disclaiming, pursuant to the existing provisions of 37 CFR 1.321, 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.<**

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.

If after taking out a patent, a common assignee presents claims for the first time in a copending application >by different inventive entities< not patentably distinct from the claims in the patent, the claims of the application should be rejected on the

ground that the assignee, by taking out the patent at a time when the application was not claiming the patented invention, is estopped to contend that the patentee is not the prior inventor. > This rejection could be overcome if the requirements of the second paragraph of 35 U.S.C. 103 are met. The claims in the copending application should also be rejected on the ground of double patenting. If the patent has an earlier filing date than the copending application, a rejection under 35 U.S.C. 102(e) or 102(e)/103 would also be appropriate.<**

Before making the requirement >to state the prior inventor under 37 CFR 1.78(c) and 35 U.S.C. 132<, with its threat to hold the case abandoned if the statement is not made by >the< assignee, the examiner must make sure that claims are present in each case >which are conflicting as defined in MPEP § 804<**.

Form paragraph 8.27 or 8.28 may be used to make a requirement under 37 CFR 1.78(c).

¶ 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 Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see M.P.E.P. 2302), 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 the application.

Examiner Note:

1. In bracket 3, insert the U.S. patent number or the copending application serial number.

2. The claims listed in brackets 1 and 2, must be for the same invention. If one invention is obvious in view of the other, do not use this paragraph; see form paragraph 8.28.

3. A provisional or actual statutory double patenting rejection may also be made using paragraphs 7.06 or 7.06.1.

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 7.15.1 or 7.15.

¶ 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 paragraph should be used when the application being examined is commonly assigned with a conflicting application or a patent but there is no indication that they were commonly assigned at the time the invention was actually made.

2. If the conflicting claims are in a patent with an earlier U.S. filing date, make a rejection under 35 U.S.C. 102(e)/103 using paragraph 7.21 in addition to this paragraph.

3. If the conflicting claims are in a commonly-assigned, copending application with an earlier filing date, make a provisional 102(e)/103 rejection of the claims using paragraph 7.20 and 7.21.1 in addition to this paragraph.

4. In bracket 3, insert the number of the conflicting patent or application.

5. An obviousness double patenting rejection may also be included in the action using paragraphs 7.24 - 7.26.

6. In bracket 4, explain why the claims in the conflicting cases are not considered to be distinct.

7. Form paragraph 8.28.1 MUST follow the use of this paragraph.

¶ 8.28.1 Advisory Information Relating to Paragraph 8.28

Commonly assigned [1], discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103 if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(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 is required under 37 CFR 1.78(c) and 35 U.S.C. 132 to either show that the conflicting inventions were commonly owned at the time the invention in this application was made or to name the prior inventor of the conflicting subject matter. Failure to comply with this requirement will result in a holding of abandonment of the application.

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 based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g).

Examiner Note:

This form paragraph should follow paragraph 8.28 and should only be used once in an Office Action.<

804.04 Submission to Group Director [R-8]

In order to promote uniform practice, every action containing a rejection on the ground of double patenting of either a parent or a divisional case (where the divisional case was filed because of a requirement to restrict by the examiner under 35 U.S.C. 121, including a requirement to elect species, made by the Office) must be submitted to the group director for approval prior to mailing. When the rejection on the ground of double patenting is disapproved, it shall not be mailed but other appropriate action shall be taken. Note >MPEP< § 1003, item 4.

805 Effect of Improper Joinder in Patent

35 U.S.C. 121, last sentence provides: "The validity of a patent shall not be questioned for failure of the Commissioner to require the application to be restricted to one invention." In other words under this statute, no patent can be held void for improper joinder of inventions claimed therein.

806 Determination of Distinctness or Independence of Claimed Inventions [R-8]

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

1. Where inventions are independent (i.e., no disclosed relation therebetween), restriction to one thereof is ordinarily

proper, >MPEP< §§ 806.04-806.04(j), though a reasonable number of species may be claimed when there is an allowed (novel and unobvious) claim generic thereto, 37 CFR 1.141, >MPEP< §§ 809.02-809.02(e).

2. Where inventions are related as disclosed but are distinct as claimed, restriction may be proper.

3. Where inventions are related as disclosed but are not distinct as claimed, restriction is never proper. Since, if restriction is required by the Office double patenting cannot be held, it is imperative the requirement should never be made where related inventions as claimed are not distinct. For (2) and (3) see >MPEP< §§ 806.05-806.05(i) and 809.03. >See MPEP § 802.01 for criteria for patentably distinct inventions.<

806.01 Compare Claimed Subject Matter

In passing upon questions of double patenting and restriction, it is the claimed subject matter that is considered and such claimed subject matter must be compared in order to determine the question of distinctness or independence.

806.02 Patentability Over the Prior Art Not Considered

For the purpose of a decision on the question of restriction, and for this purpose only, the claims are ordinarily assumed to be in proper form and patentable (novel and unobvious) over the prior art.

This assumption, of course, is not continued after the question of restriction is settled and the question of patentability of the several claims in view of prior art is taken up.

806.03 Single Embodiment, Claims Defining Same Essential Features [R-8]

Where the claims of an application define the same essential characteristics of a *single* disclosed embodiment of an invention, restriction therebetween should never be required. This is because the claims are but different definitions of the same disclosed subject matter, varying in breadth or scope of definition.

Where such claims appear in different applications optionally filed by the same inventor, disclosing the same embodiments, see >MPEP< §§ 804-804.02.

806.04 Independent Inventions

If it can be shown that the two or more inventions are in fact independent, applicant should be required to restrict the claims presented to but one of such independent inventions. For example:

1. Two different combinations, not disclosed as capable of use together, having different modes of operation, different functions or different effects are independent. An article of apparel such as a shoe, and a locomotive bearing would be an example. A process of painting a house and a process of boring a well would be a second example.

2. 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 which cannot be used to practice the specific process.

3. Where species under a genus are independent, for example, a genus of paper clips having species differing in the manner in which a section of the wire is formed in order to achieve a greater increase in its holding power.

SPECIES ARE TREATED EXTENSIVELY IN THE FOLLOWING SECTIONS

806.04(a) Species — Genus

The statute (35 U.S.C. 121) lays down the general rule that restriction may be required to one of two or more independent inventions. 37 CFR 1.141 makes an exception to this, providing that a reasonable number of species may be claimed in one application if the other conditions of the rule are met.

806.04(b) Species May Be Related Inventions [R-8]

Species, while usually independent may be related under the particular disclosure. 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(i). 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. In *ex parte Healy*, 1898 C.D. 157, 84 O.G. 1281, a clamp for a handle bar stem and a specifically different clamp for a seat post both usable together on a bicycle were claimed. In his decision, the Commissioner considered both the restriction practice under election of species and the practice applicable to restriction between combination and subcombinations.

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 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.

Form Paragraph 8.14 may be used in intermediate — final product restriction requirements.

¶ 8.14 Intermediate — Final Product

Examiner Note:

Following is shown an Intermediate — Final Product situation.

Inventions [1] and [2] are related as mutually exclusive species in 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 (MPEP section 806.04(b), 3rd paragraph), and the species are patentably distinct (MPEP section 806.04(h)).

In this instant case, the intermediate product is deemed to be useful as [3] and the inventions are deemed patentably distinct since there is nothing on this record to show them to be obvious variants. 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 inventions anticipated by the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103 of the other invention.

>The intermediate and final product must have a mutually exclusive species relationship and as with all species restrictions, must be patentably distinct.

Typically, the intermediate loses its identity in the final product.

Additionally, the intermediate must be shown to be useful to make other than the final product. The examiner must give an example of an alternative use but need not provide documentation. Applicant then has the burden to prove or provide a convincing argument that the intermediate does not have the suggested use.<

806.04(c) Subcombination Not Generic to Combination [R-8]

The situation is frequently presented where two different combinations are disclosed, having a subcombination *common to each.* It is frequently puzzling to determine whether a claim readable on two different combinations is generic thereto.

This was early recognized in *Ex parte Smith,* 1888 C.D. 131, 44 O.G.1183, where it was held that a subcombination was not generic to the different combinations in which it was used.

To exemplify, a claim that defines only the subcombination, e.g., the mechanical structure of a joint, is not a generic or genus claim to two forms of a combination, e.g., two different forms of a doughnut cooker each of which utilize the same form of joint.

806.04(d) Definition of a Generic Claim [R-8]

In an application presenting three species illustrated, for example, in Figures 1, 2 and 3 respectively, a generic claim should read on each of these views; but the fact that a claim does so read is not conclusive that it is generic. It may define only an element or subcombination common to the several species.

It is not possible to define a generic claim with that precision existing in the case of a geometrical term. In general, a generic claim should include no material element additional to those recited in the species claims, and must comprehend within its confines the organization covered in each of the species.

For the purpose of obtaining claims to more than one species in the same case, the generic claim cannot include limitations not present in each of the added species claims. Otherwise stated, the claims to the species which can be included in a case in addition to a single species must contain all the limitations of the generic claim.

Once a claim that is determined to be generic is allowed, all of the claims drawn to species in addition to the elected species which include all the limitations of the generic claim will ordinarily be obviously allowable in view of the allowance of the generic claim, since the additional species will depend thereon or otherwise include all of the limitations thereof.

When all or some of the claims directed to one of the species in addition to the elected species do not include all the limitations of the generic claim, then that species cannot be claimed in the same case with the other species, see >MPEP< § 809.02(c)(2).

806.04(e) Claims Restricted to Species [R-8]

Claims are definitions of inventions. *Claims are never species.* Claims may be restricted 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 definition (and thus be designated *a generic or genus claim).*

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

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

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

806.04(h) Species Must Be Patentably Distinct From Each Other and From Genus [R-8]

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, there should be no determination of whether or not the species claimed in the divisional application is patentable over the species retained in the parent case since such a determination was made before the requirement to restrict was made.

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

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

Where generic claims are allowed in a national application, applicant may claim in the *same application* additional species as provided by 37 CFR 1.141. As to these, the patentable distinction between the species or between the species and genus is not rigorously investigated, since they will issue in the same patent. However, the practice stated in >MPEP< § 706.03(k) may be followed if the claims differ from the allowed genus only by subject matter that can be shown by citation of prior art.

Where, however, an applicant optionally files another national application with claims to a different species, or for a species disclosed but not claimed in a parent case as filed and first acted upon by the examiner, there should be close investigation to determine the presence or absence of patentable difference. See >MPEP< §§ 804.01 and 804.02.

806.04(i) Generic Claims ** Presented for First Time After Issue of Species [R-8]

>The Patent and Trademark Office no longer follows the practice of prohibiting the allowance of generic claims that are presented for the first time after the issuance of a copending application claiming plural species. Instead the Office may reject the generic claims on the grounds of obviousness-type double patenting. Applicant may overcome such a rejection by filing a terminal disclaimer. See *In re Braithwaite*, 154 USPQ 38 (CCPA 1967).<**

806.04(j) Generic Claims in One Patent Only [R-8]

Generic claims covering two or more species which are separately claimed in two or more patents to the same *> inventive entity, a common inventor, and/or common assignee< issued on copending applications *must all be present in a single one of the patents.* If present in two or more patents, the generic claims in the later patents are void. Thus generic claims in an application should be rejected on the ground of double patenting **>of either the statutory or obviousness-type in view of the generic claims of the patent. See *In re Braithwaite*, 154 USPQ 38.<

806.05 Related Inventions

Where two or more related inventions are being claimed, the principal question to be determined in connection with a requirement to restrict or a rejection on the ground of double patenting is whether or not the inventions as claimed are distinct. If they are distinct, restriction may be proper. If they are not distinct, restriction is never proper. If non-distinct 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 in a national application.

The various pairs of related inventions are noted in the following sections.

806.05(a) Combination ** and Subcombination or Element [R-8]

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

** Relative to questions of restriction where a combination is alleged, the claim thereto must be assumed to be allowable (novel and unobvious) as pointed out in >MPEP< § 806.02, in the absence of a holding by the examiner to the contrary. When a claim is found in a patent, it has already been found by the Office to be >allowable< ** and must be treated on that basis.

806.05(b) Old Combination — Novel Subcombination [R-8]

Restriction is ordinarily not proper between a combination (AB) that the examiner holds to be old and unpatentable and the subcombination (B) in which the examiner holds the novelty, if any, to reside, *Ex parte Donnell*, 1923 C.D. 54, 315 O.G. 398 (Comm'r Pats.1923). (See >MPEP< § 820.01.)

806.05(c) Criteria of Distinctness for Combination, Subcombination or Element of a Combination [R-8]

In order to establish that combination and subcombination inventions are distinct, two-way distinctness must be demonstrated.

To support a requirement for restriction, both two-way distinctness and reasons for insisting on restriction are necessary >, i.e. separate classification, status, or field of search. See MPEP § 808.02<.

If it can be shown that a combination, as claimed

(1) does not require the particulars of the subcombination as

claimed for patentability (to show novelty and unobviousness), and

(2) the subcombination can be shown to have utility either by itself or in other and different relations, the inventions are distinct. When these factors cannot be shown, such inventions are not distinct.

The following examples are included for general guidance.

1. SUBCOMBINATION NOT ESSENTIAL TO COMBINATION

AB_{br} / B_{sp} 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. separate classification, status, or field of search.

This situation can be diagramed as combination A B_{br} >("br" is an abbreviation for "broad")<, and subcombination B_{sp} >("sp" is an abbreviation for "specific")<. B_{br} indicates that in the combination the subcombination is broadly recited and that the specific characteristics set forth in the subcombination claim B_{sp} are not set forth in the combination claim.

Since claims to both the subcombination and combination are presented and assumed to be patentable, the omission of details of the claimed subcombination B_{sp} in the combination claim A B_{br} is evidence that the patentability of the combination does not rely on the details of the specific subcombination.

2. SUBCOMBINATION ESSENTIAL TO COMBINATION

A B_{sp} / B_{sp} No restriction

If there is no evidence that combination A B_{sp} is patentable without the details of B_{sp}, restriction should not be required. Where the relationship between the claims is such that the separately claimed subcombination B_{sp} constitutes the essential distinguishing feature of the combination A B_{sp} as claimed, the inventions are not distinct and a requirement for restriction must not be made, even though the subcombination has separate utility.

3. SOME COMBINATION CLAIMS RECITE SPECIFIC FEATURES OF THE SUBCOMBINATION BUT OTHER COMBINATION CLAIMS GIVE EVIDENCE THAT THE SUBCOMBINATION IS NOT ESSENTIAL TO THE COMBINATION.

A B_{sp} / A B_{br} (Evidence claim) / B_{sp} Restriction proper

Claim A B_{br} is an evidence claim which indicates that the combination does not rely upon the specific details of the subcombination for its patentability. If claim A B_{br} is subsequently found to be unallowable, the question of rejoinder of the inventions restricted must be *>considered< and the letter to the applicant should so state. Therefore, where the combination evidence claim A B_{br} does not set forth the details of the subcombination B_{sp} and the 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 different statutory categories, 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

Examiner Note:

Following is shown a combination-subcombination situation. (MPEP 806.05(c)).

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:

In situations involving evidence claims, see MPEP 806,05(c), example 3, and explain in bracket 3.

In bracket 4, suggest utility other than used in combination.

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

806.05(d) Subcombinations Usable Together [R-8]

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

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

Form Paragraph 8.16 may be used in restriction requirements between subcombinations.

¶ 8.16 Subcombinations, usable together

Examiner Note:

Following is shown a situation of subcombinations usable together. (MPEP 806.05(d)).

Inventions [1] and [2] are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the

instant case invention [3] has separate utility such as [4]. See (MPEP 806.05(d)).

Examiner Note:

1. In bracket 3, insert the appropriate group number or identify the invention.

2. In bracket 4, suggest utility other than with the other invention.

>Only one way Distinctness is Required.

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)).

The burden is on the examiner to provide an example.

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 — Distinctness [R-8]

** In applications claiming inventions in different statutory categories, only one-way distinctness is generally needed to support a restriction requirement. However, see >MPEP< § 806.05(c).

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

>If the apparatus claims include a claim to "means" for practicing the process, the claim is a linking claim and must be examined with the elected invention. If it is ultimately allowed rejoinder is required.<

Form Paragraph 8.17 may be used to make restriction requirements between process and apparatus.

¶ 8.17 Process and apparatus

Examiner Note:

Following is shown a process and apparatus for its practice situation. MPEP (806.05(e)).

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 and materially different process. (MPEP 806.05(e)). In this case [3].

Examiner Note:

In bracket 3, use one or more of the following reasons:

1) The process as claimed can be practiced by another and materially different apparatus such as ---

2) The process as claimed can be practiced by hand.

3) The apparatus as claimed can be used to practice another and materially different process such as---

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

If the apparatus claims include a claim to "means" for practicing the process, this claim is a linking claim (except for the presence of this claim restriction between apparatus and process claims would be proper). The linking claim must be examined with the elected invention, but only to the extent necessary to determine if the linking claim is unpatentable. If the linking claim is unpatentable, restriction is proper.

It should be noted that a claim such as, "An apparatus for the practice of the process of claim 1, comprising ...." and then the claim continues with purely apparatus limitations, is not a linking claim. This is merely a preamble similar to a statement of intended use and should be treated as any preamble.

If applicant proves or provides convincing argument that there is no material difference or in the case of that process that 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 — Distinctness [R-8]

** 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: (1) that the process *as claimed* is not an obvious process of making the product and the process *as claimed* can be used to make other and different products, or (2) that the product *as claimed* can be made by another and materially different process.

>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*, 149 USPQ 55 (CCPA 1966)) and can be restricted from the process if the examiner can demonstrate 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 Paragraph 8.18 may be used in restriction requirements between product and process of making.

¶ 8.18 Product and Process of Making

Examiner Note:

Following is shown a Product and Process of Making situation (MPEP 806.05(f)).

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 and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP 806.05(f)). In the instant case [3].

Examiner Note:

In bracket 3, use one or more of the following reasons:

1) The process as claimed can be used to make a materially different product such as ---,

2) The product as claimed can be made by a materially different process such as ---

806.05(g) Apparatus and Product Made - Distinctness [R-8]

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: (1) that the apparatus as claimed is not an obvious apparatus for making the product and the apparatus as claimed can be used to make other and different products, or (2) that the product as claimed can be made by another and materially different apparatus.

Form Paragraph 8.19 may be used for restriction requirements between apparatus and product made.

¶ 8.19 Apparatus and Product Made

Examiner Note:

Following is shown an Apparatus and Product Made situation (MPEP 806.05(g)).

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 different product or (2) that the product as claimed can be made by another and materially different apparatus (MPEP 806.05(g)). In this case [3].

Examiner Note:

In bracket 3, Use one or more of the following reasons:

1) 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 ---

2) The product can be made by a materially different apparatus such as ---

>Only One Way Distinctness is Required

The examiner must show by way of example either (1) that the apparatus *as claimed* is not an obvious apparatus for making the product and the apparatus *as claimed* can be used to make other and different products or (2) that the product *as claimed* can be made by another and materially different apparatus.

See form paragraph 8.19 above.

The burden is on the examiner to provide an example which 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-8]

** 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: (1) the process for using as claimed can be practiced with another materially different product, or (2) 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 Paragraph 8.20 may be used in restriction requirements between the product and method of using.

¶ 8.20 Product and Process of Using

Examiner Note:

Following is shown a Product and Process of Using the product situation. (MPEP 806.05(h)).

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 (MPEP 806.05(h)). In the instant case [3].

Examiner Note:

In bracket 3, use one or more of the following reasons:

1) The process as claimed can be practiced with another materially different product such as ---

2) The product as claimed can be used in a materially different process such as ---

806.05(i) Product, Process of Making, and Process of Using -- Product Claim Not Allowable [R-8]

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.

Restriction may be required where the product claimed links the two process-type claims and is not patentable, or where the process of making is not patentably distinct from the claimed product.<

Where an application contains claims to a product, claims to a process specially adapted for the manufacture of the product, and claims to *>a< process of using the product **, and the product claims are not allowable (they are not novel *>and< unobvious), restriction is proper between the process of making and the process of using. **>As defined above, the process of making and product are not patentably distinct (specially adapted). In this instance, applicant may be required to elect either (1) the product and process of making it, or (2) the product and/or the use depending on whether the examiner can make a showing of distinctness (MPEP § 806.05(h)).

>Except as set forth in the previous paragraph,< restriction may be required only where the process of making and the product made are distinct (MPEP § 806.05(f)), otherwise, the process of using must be joined with other types of claims even if a showing of distinctness (MPEP § 806.05(h)) can be made.

Determination of patentability of the product need not be made prior to making a requirement for restriction unless the requirement is based on a determination that the product claims are not allowable.

Form paragraph 8.20.1 may be used in product, process of making and process of using situations where the product is not allowable.

¶ 8.20.1 Product, Process of Making and Process of Using - Product is not Allowable

Examiner Note:

Following is shown a Product, Process of Making and Process of Using - Product is not Allowable. MPEP 806.05(i).

Inventions [1] and [2] are related as a process of making and process of using the product. The use as claimed cannot be practiced with a materially different product. Since the product is not allowable, restriction is proper between said method of making and method of using. The product claim will be examined along with the elected invention (MPEP 806.05(i)).<

807 Patentability Report Practice Has No Effect on Restriction Practice [R-8]

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-8]

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

808.01 Independent Inventions [R-8]

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

808.01(a) Species [R-8]

Where there is no disclosure of relationship between species (see >MPEP< § 806.04(b)), they are independent inventions and election of one >invention< following a requirement for restriction is mandatory even though applicant disagrees with the examiner. There must be a patentable difference between the species as claimed, see >MPEP< § 806.04(h). Thus the reasons for insisting upon election of one species, are the facts relied upon for the conclusion that there are claims restricted respectively to two or more patentably different species that are disclosed in the application, and it is not necessary to show a separate status in the art or separate classification.

A single disclosed species must be elected as a prerequisite to applying the provisions of 37 CFR 1.141 to additional species if a generic claim is allowed.

Even though the examiner rejects the generic claims, and even though the applicant cancels the same and thus admits that the genus is unpatentable, where there is a relationship disclosed between species, such disclosed relation must be discussed and reasons advanced leading to the conclusion that the disclosed relation does not prevent restriction, in order to establish the propriety of restriction.

Election of species should not be required if the species claimed are considered clearly unpatentable (obvious) over each other. In making a requirement for restriction in an application claiming plural species, the examiner should group together species considered clearly unpatentable over each other, with the statement that restriction as between those species is not required.

Election of species should be required prior to a search on the merits (1) in all applications containing claims to a plurality of species with no generic claims, and (2) in all applications containing both species claims and generic or Markush claims.

In all applications in which no species claims are present and a generic claim recites such a multiplicity of species that an unduly extensive and burdensome search is required, a requirement for an election of species should be made prior to a search of the generic claim.

In all * applications where a generic claim is found allowable, the application should be treated as indicated in >MPEP< §§ 809.02 (b), (c), or (e). If an election is made pursuant to a telephone requirement, the next action should include a full and complete action on the elected species as well as on any generic claim that may be present.

808.02 Related Inventions [R-8]

Where, as disclosed in the application, the several inventions claimed are related, and such related inventions are not patentably distinct as claimed, restriction under 35 U.S.C. 121

is never proper (>MPEP< § 806.05). If applicant optionally restricts, double patenting may be held.

Where the related inventions as claimed are shown to be distinct under the criteria of >MPEP< §§ 806.05(c-i), the examiner, in order to establish reasons for insisting upon restriction, must show by appropriate explanation one of the following:

(1) Separate classification thereof:

This shows that each distinct subject has attained recognition in the art as a separate subject for inventive effort, and also a separate field of search. Patents need not be cited to show separate classification.

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

Even though they are classified together,** each subject can be shown to have formed a separate subject for inventive effort when an explanation indicates a recognition of separate inventive effort by inventors. Separate status in the art may be shown by citing patents which are evidence of such separate status>, and also of a separate field of search<.

(3) A different field of search:

Where it is necessary to search for one of the distinct subjects in places where no pertinent art to the other subject exists, a different field of search is shown, even though the two are classified together. The indicated different field of search must in fact be pertinent to the type of subject matter covered by the claims. Patents need not be cited to show different fields of search.

Where, however, the classification is the same and the field of search is the same and there is no clear indication of separate future classification and field of search, no reasons exist for dividing among related inventions.

809 Claims Linking Distinct Inventions [R-8]

Where, upon examination of an application containing claims to distinct inventions, linking claims are found, restriction can nevertheless be required. See >MPEP< § 809.03 for definition of linking claims.

A letter including only a restriction requirement or a telephoned requirement to restrict (the latter being encouraged) will be effected, specifying which claims are considered linking. See >MPEP< § 812.01 for telephone practice in restriction requirements.

No art will be indicated for this type of linking claim and no rejection of these claims made.

A **>one month< shortened statutory period will be set for response to a written requirement. Such action will not be an "action on the merits" for the purpose of the second action final program.

To be complete, a response to a requirement made according to this section need only include a proper election.

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

809.02 Generic Claim Linking Species [R-8]

Under 37 CFR 1.141, an allowed generic claim may link a reasonable number >of< species embraced thereby.

The practice is stated in 37 CFR 1.146.

37 CFR 1.146. Election of species.

In the first action on an application containing a generic claim and claims restricted separately to each of more than one species embraced thereby, the examiner may require the applicant in his response to that action to elect that species of his or her invention to which his or her claim shall be restricted if no generic claim is held 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 case.

809.02(a) Election Required [R-8]

Where generic claims are present, the examiner should send a letter including only a restriction requirement or place a telephone requirement to restrict (the latter being encouraged). See >MPEP< § 812.01 for telephone practice in restriction requirements.

Action as follows should be taken:

(1) Identify generic claims or indicate that no generic claims are present. See >MPEP< § 806.04(d) for definition of a generic claim.

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

(3) Applicant should then be required to elect a single disclosed species under 35 U.S.C. 121, and advised as to the requisites of a complete response and his rights under 37 CFR 1.141.

For generic claims, a search should not be made and art should not be cited.

**>A one month< shortened statutory period will be set for response when a written requirement is made without an action on the merits. This period may be extended under the provisions of 37 CFR 1.136(a). Such action will not be an "action on the merits" for purposes of the second action final program.

To be complete, a response to a requirement made according to this section >should include a proper election along with a listing of all claims readable thereon>, including any claims subsequently added.<**

In those applications wherein a requirement for restriction is accompanied by an action on all claims, such action will be considered to be an action on the merits and the next action should be made final.

Examiners should use Form Paragraphs 8.01 or 8.02 >to make election of species requirements<.

¶ 8.01 Election of Species

This application contains claims directed to the following patentably distinct species of the claimed invention: [1].

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.

Applicant is advised that a response to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a generic claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP 809.02(a).

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 inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103 of the other invention.

Examiner Note:

In bracket 2, insert the appropriate generic claim information.

¶ 8.02 Election when claims are not restricted to species

Claim [1] generic to a plurality of disclosed patentably distinct species comprising [2]. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species, even though this requirement is traversed.

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 inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103 of the other invention.

Examiner Note:

1. This paragraph should be used for the election of species requirement described in MPEP 803 .02 (Markush group) and 809.02(d) (burdensome search necessary).

2. In bracket [2] clearly identify the species from which election is to be made.

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

It is necessary to (1) identify generic claims or state that none are present, and (2) to clearly identify each species involved.

809.02(b) Election Required — Generic Claim Allowable

When a claim generic to two or more claimed species is found to be allowable on the first or any subsequent action on the merits and *election of a single species has not been made*, applicant should be informed that the claim is allowable and generic, and a requirement should be made that applicant elect a single species embraced by the allowed genus unless the species claims are all in the form required by 37 CFR 1.141 and no more than a reasonable number of species are claimed. Substantially the following should be stated:

> "Applicant is advised that his or her response to be complete must include an identification of the single, disclosed species within the allowed genus that he or she elects and a listing of all claims readable thereupon. Applicant is entitled to consideration of claims to a reasonable number of disclosed species in addition to the elected species, which species he or she must identify and list all claims restricted to each, provided all the claims to each additional species are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141"

809.02(c) Action Following Election [R-8]

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

(1) When the generic claims are rejected >, or there is no generic claim<, all claims not readable on the elected species should be treated substantially as follows:

> "Claim _____ are held to be withdrawn from further consideration under 37 CFR 1.142(b) as not readable on the elected species >,there being no (allowable) generic claim<."

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

>(i) When all claims to each of the additional species are embraced by an allowable generic claim as provided by 37 CFR 1.141, applicant should be advised of the allowable generic claim and that claims drawn to the non-elected species are no longer withdrawn since they are fully embraced by the allowed generic claim.

(ii)< When any claim directed to one of said additional species embraced by an allowed generic claim is not in the required form, all claims to that species should be held to be withdrawn from further consideration by the examiner. The holding should be worded somewhat as follows:

> "Claims _____ directed to species _____ are withdrawn from further consideration in this case, since all of the claims to this species do not depend upon or otherwise include all of the limitations of an allowed generic claim as required by 37 CFR 1.141."

>Note that each additional species is handled separately. When all of the claims to one non-elected species are embraced by an allowable generic claim *but* each of the claims to another non-elected species are not embraced by an allowable generic claim, applicant should be advised that the claims to the one non-elected species are no longer withdrawn from further consideration but that the claims to the other non-elected species remain withdrawn from further consideration since all of the claims to this other species do not depend upon or fully include all of the limitations of an allowed generic claim as required by 37 CFR 1.141. This holding should be worded as follows:

> "Allowed claims _____ are generic. Claims _____ directed to species _____ are no longer withdrawn from further consideration in this case since all of the claims to this species depend from or otherwise include all of the limitations of an allowed generic claim. Claims _____directed to species_____ are withdrawn from further consideration in this case since all of the claims to this species do not depend upon or otherwise include all of the limitations of an allowed generic claim as required by 37 CFR 1.141."<

When the case is otherwise ready for issue >and there is an allowed generic claim, and applicant has not been previously notified as to the allowance of a generic claim, applicant should be advised of the allowance of a generic claim and given a time limit of 1 month to conform all of the claims to the non-elected species to fully embrace an allowed generic claim or the examiner will cancel the claims to each non-conforming species by examiner's amendment and pass the case to issue. If the election is traversed,<, an additional paragraph worded as Form Paragraph 8.03 should be added to the holding.

¶ 8.03 In Condition for allowance, Non-elected Claims

This application is in condition for allowance except for the presence of claim [1] to an invention non-elected with traverse in Paper no. [2]. APPLICANT IS GIVEN ONE MONTH FROM THE DATE OF THIS LETTER TO CANCEL THE NOTED CLAIMS OR TAKE OTHER APPROPRIATE ACTION (37 CFR 1.144). Failure to take action during this period will be treated as authorization to cancel the noted claims by Examiner's Amendment and pass the case to issue. Extensions of time under 37 CFR 1.136(a) will not be permitted since this application will be passed to issue.

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

Claims directed to species not embraced by an allowed generic claim should be treated as follows:

> "Claims _____ are for species not embraced by an allowed generic claim as required by 37 CFR 1.141 and are withdrawn from further consideration in this case, 37 CFR 1.142(b)."

809.02(d) No Species Claims [R-8]

Where only generic claims are presented no restriction can be required except in those cases where the generic claims recite such a multiplicity of species that an unduly extensive and burdensome search is necessary. See >MPEP< § 808.01(a). If after an action on only generic claims with no restriction requirement, applicant presents species claims to more than one species of the invention he or she must at that time indicate an election of a single species.

809.02(e) Generic Claim Allowable in Substance [R-8]

Whenever a generic claim is found to be allowable in substance, even though it is objected to or rejected on merely formal grounds, action on the species claims shall thereupon be given as if the generic claim were allowed.

The treatment of the case should be as indicated in >MPEP< §§ 809.02 (b), (c), or (d).

809.03 Linking Claims [R-8]

There are a number of situations which arise in which an application has claims to two or more properly divisible inventions, so that a requirement to restrict the application to one would be proper, but presented in the same case are one or more claims (generally called "linking" claims) inseparable therefrom and thus linking together the inventions otherwise divisible.

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

Genus claims linking species claims.

A claim to the necessary process of making a product linking proper process and product claims.

A claim to "means" for practicing a process linking proper apparatus and process claims.

A claim to the product linking a process of making and a use (process of using).

Where linking claims exist, a letter including a restriction requirement only or a telephoned requirement to restrict (the latter being encouraged) will be effected, specifying which claims are considered to be linking. Note Form Paragraph 8.12.

¶ 8.12 Restriction, Linking Claims

Claim [1] link(s) inventions [2] and [3].

For traverse of rejection of linking claim in * applications see >MPEP< § 818.03(d).

809.04 Retention of Claims to Non-Elected Invention [R-8]

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

If a linking claim is allowed, the examiner must thereafter examine species if the linking claim is generic thereto, or he or she must examine the claims to the non-elected inventions that

are linked to the elected invention by such allowed linking claim.

When a final requirement is contingent on the non-allowability of the linking claims, applicant may petition from the requirement under 37 CFR 1.144 without waiting for a final action on the merits of the linking claims; or applicant may defer his >or her< petition until the linking claims have been finally rejected, but not later than appeal. 37 CFR 1.144, >MPEP< § 818.03(c).

810 Action on the Merits [R-8]

In general, in an * application when a requirement to restrict is made, no action on the merits is given.

810.01 Not Objectionable When Coupled With Requirement [R-8]

A basic policy of the present examining program is that the second action on the merits should be made final whenever proper, >MPEP< § 706.07(a). In those applications wherein a requirement for restriction or election is accompanied by a complete action on the merits of all the claims, such action will be considered to be an action on the merits and the next action by the examiner should be made final. When preparing a final action in an application where applicant has traversed the restriction requirement, see >MPEP< § 821.01.

Although an action on the merits is not necessary to a requirement, it is not objectionable, *Ex parte Lantzke*, 1910 C.D. 100, 156 O.G. 257.>However, note that a question may arise as to whether there is a serious burden on the examiner.<

However, except as noted in >MPEP< § 809 and >MPEP< § 812.01, if an action is given on the merits, *it must be given on all claims.*

810.02 Usually Deferred [R-8]

The Office policy is to >usually< defer action on the merits until after the requirement for restriction is complied with, >or< withdrawn **.

Ex parte Pickles, 1904 C.D. 126, 109 O.G. 1888.
Ex parte Snyder, 1904 C.D. 242, 110 O.G. 2636.
Ex parte Weston, 1911 C.D. 218, 173 O.G. 285.

810.03 Given on Elected Invention When Requirement Is Made Final [R-8]

37 CFR 1.143 last sentence states: "If the requirement is repeated and made final, the examiner will at the same time act on the claims to the invention elected." Thus, action is ordinarily given on the elected invention in the action making the requirement final.

¶ 8.25.1 Election Without Traverse

Applicant's election without traverse of [1] in Paper No [2] is acknowledged.

811 Time for Making Requirement [R-8]

37 CFR 1.142(a), 2nd sentence: "If the distinctness and independence of the invention be clear, such requirement ** will be made before any action upon the merits; however, it may be made at any time before final action in the case at the discretion of the examiner."

This means, >the examiner should,< make a proper requirement as early as possible in the prosecution, in the first action if possible, otherwise as soon as a proper requirement develops.

>Before making a restriction requirement after the first action on the merits, the examiner will consider whether there will be a serious burden if restriction is not required.<

811.02 Even After Compliance With Preceding Requirement

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

811.03 Repeating After Withdrawal — Proper [R-8]

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

811.04 Proper Even Though Grouped Together in Parent Case

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

812 Who Should Make the Requirement [R-8]

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

An examiner should not require restriction in an application >if< none of the claimed subject matter ** is classifiable in his or her group. Such an application should be transferred to a group to which at least some of the subject matter belongs.

812.01 Telephone Restriction Practice [R-8]

If an examiner determines that a requirement for restriction should be made in an application, the examiner should formulate a draft of such restriction requirement including an indication of those claims considered to be linking or generic. No search or rejection of the linking claims should be made.

Thereupon, the examiner should telephone the attorney of record and request an oral election, with or without traverse if desired, after the attorney has had time to consider the restriction requirement. The examiner should arrange for a second telephone call within a reasonable time, generally within three working days. If the attorney objects to making an oral election, or fails to respond, the usual restriction letter will be mailed, and this letter should * contain * reference to the unsuccessful telephone call. See >MPEP< §§ 809 and 809.02(a).

When an oral election is made, the examiner will then proceed to incorporate into the Office action a formal restriction requirement including the date of the election, the attorney's name, and a complete record of the telephone interview, followed by a complete action on the elected claims including linking or generic claims if present.

Form* >Paragraphs 8.23 or 8.23.1< should be used to make a telephone election of record.

¶ 8.23 Requirement, When Elected by Telephone

During a telephone conversation with [1] or [2] a provisional election was made [3] traverse to prosecute the invention of [4], claim [5]. Affirmation of this election must be made by applicant in responding to this Office action. Claim [6] withdrawn from further consideration by the Examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Examiner Note:

1) In bracket 3, insert "with" or "without", whichever is applicable.
2) In bracket 4, insert either the elected group or species.
3) An action on the merits of the claims should follow.

>¶ 8.23.1 Requirement, On Election by Telephone

A telephone call was made to [1] on [2] to request an oral election to the above restriction requirement, but did not result in an election being made.

Examiner Note:

1. In bracket 1, insert the name of the attorney called.
2. In bracket 2, insert the date.
3. This paragraph should be used in all instances where a telephone election was attempted and applicant did not or would not make an election.<

If on examination the examiner finds the elected claims to be allowable and no traverse was made, the letter should be written on PTOL-37 (Examiner's Amendment) and should include cancellation of the non-elected claims, a statement that the prosecution is closed and that a notice of allowance will be sent in due course. Correction of formal matters in the above-noted situation which cannot be handled by a telephone call and thus requires action by the applicant should be handled under the Ex parte Quayle practice, using PTOL-326.

Should the elected claims be found allowable in the first action, and an oral traverse was noted, the examiner should include in his or her action a statement under >MPEP< § 821.01, making the restriction final and giving applicant one month to either cancel the non-elected claims or take other appropriate action (37 CFR 1.144). Failure to take action will be treated as an authorization to cancel the non-elected claims by an examiner's amendment and pass the case to issue. Prosecution of the application is otherwise closed.

In either situation (traverse or no traverse), caution should be exercised to determine if any of the allowed claims are linking or generic >claims< before cancelling the non-elected claims.

Where the respective inventions are located in different groups the requirement for restriction should be made only after consultation with and approval by all groups involved. If an oral election would cause the application to be examined in another group, the initiating group should transfer the application with a signed memorandum of the restriction requirement and a record of the interview. The receiving group will incorporate the substance of this memorandum in its official letter as indicated above. Differences as to restriction should be settled by the existing chain of command, e.g. supervisory primary examiner or group director.

This practice is limited to use by examiners who have at least negotiation authority. Other examiners must have the prior approval of their supervisory primary examiner.

814 Indicate Exactly How Application Is To Be Restricted [R-8]

A. Species. The mode of indicating how to require restriction between species is set forth in >MPEP< § 809.02(a).

As pointed out in *Ex parte Ljungstrom*, 1905 C.D. 541, 119 O.G. 2335, the particular limitations in the claims and the reasons why such limitations are considered to restrict the claims to a particular disclosed species should be mentioned if necessary to make the requirement clear.

B. Inventions other than species. It is necessary to read all of the claims in order to determine what the claims cover. When doing this, the claims directed to each separate subject should be noted along with a statement of the subject matter to which they are drawn.

This is the best way to most clearly and precisely indicate to applicant how the application should be restricted. It consists in identifying each separate subject amongst which restriction is required, and grouping each claim with its subject.

The separate inventions should be identified by a grouping of the claims with a short description of the total extent of the invention claimed in each group, specifying the type or relationship of each group as by stating the group is drawn to a process, or to a subcombination, or to a product, etc., and should indicate the classification or separate status of each group, as for example, by class and subclass.

While every claim should be accounted for, the omission to group a claim, or placing a claim in the wrong group will not affect the propriety of a final requirement where the requirement is otherwise proper and the correct disposition of the omitted or erroneously grouped claim is clear.

C. Linking claims. The generic or other linking claims should not be associated with any one of the linked inventions since such claims must be examined with any one of the linked inventions that may be elected. This fact should be clearly stated.

815 Make Requirement Complete

When making a requirement every effort should be made to have the requirement complete. If some of the claimed inventions are classifiable in another art unit and the examiner has any doubt as to the proper line among the same, the application should be referred to the examiner of the other art unit for information on that point and such examiner should render the necessary assistance.

816 Give Reasons for Holding of Independence or Distinctness [R-8]

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

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

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

The separate inventions should be identified by a grouping of the claims with a short description of the total extent of the invention claimed in each group, specifying the type or relationship of each group as by stating the group is drawn to a process, or to subcombination, or to product, etc., and should indicate the classification or separate status of each group, as for example, by class and subclass. See >MPEP< § 809.

Note Form Paragraph 8.13.

¶ 8.13 Distinctness (Heading)

The inventions are distinct, each from the other because of the following reasons:

Instructions:

Use various relationships of inventions to show distinctness.

Form paragraphs 8.14 to 8.20 in MPEP §§ 806.04(b) - (h) to indicate distinctness.

817 Outline of Letter for Restriction Requirement between Distinct Inventions [R-8]

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

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

The following outline of a letter for a requirement to restrict is intended to cover every type of original restriction requirement between related inventions including those having linking claims.

OUTLINE OF LETTER

A. Statement of the requirement to restrict and that it is being made under 35 U.S.C. 121
- -Identify each group by Roman numeral
- -List claims in each group
- -Check accuracy of numbering
  - Look for same claims in two groups
  - Look for omitted claims
- -Give short description of total extent of the subject matter claimed in each group.
- -Point out critical claims of different scope
- -Identify whether combination, subcombination, process, apparatus or product
- -Classify each group
- -Form Paragraphs 8.08-8.11 should be used to group inventions.

¶ 8.08 Restriction, 2 Groupings

Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claim [1], drawn to [2], classified in Class [3], subclass [4].
II. Claim [5], drawn to [6], classified in Class [7], subclass [8].

¶ 8.09 Restriction, 3rd Grouping

III. Claim [1], drawn to [2], classified in Class [3], subclass [4].

¶ 8.10 Restriction, 4th Grouping

IV. Claim [1], drawn to [2], classified in Class [3], subclass [4].

¶ 8.11 Restriction, Additional Groupings

[1] Claim [2], drawn to [3], classified in Class [4], subclass [5].

B. Take into account claims not grouped, indicating their disposition.
- -Linking claims
- -Indicate — (make no action)
- -Statement of groups to which linking claims may be assigned for examination
- -Other ungrouped claims.
- -Indicate disposition e.g., previously nonelected, non-statutory, canceled, etc.

C. Allegation of distinctness
- -Point out facts which show distinctness
- -Treat the inventions as claimed, don't merely state your conclusion that inventions in fact are distinct
- -(1) Subcombination— (Subcombination (disclosed) as usable together)
  - Each usable alone or in other identified combination
  - Demonstrate by examiner's suggestion
- -(2) Combination — Subcombination
  - Combination as claimed does not require subcombination
  - AND
  - Subcombination usable alone or in other combination
  - Demonstrate by examiner's suggestion
- -(3) Process — Apparatus
  - Process can be carried out by hand or by other apparatus

Demonstrate by examiner's suggestion
OR
Demonstrate apparatus can be used in other process (rare).
-(4) Process of making and/or Apparatus — Product
Demonstrate claimed product can be made by other process (or apparatus)
By examiner's suggestion
OR
Process of making (or apparatus) can produce other product (rare)

D. Allegation of reasons for insisting upon restriction
-Separate status in the art
-Different classification
-Same classification but recognition of divergent subject matter
-Divergent fields of search
-Search required for one group not required for the other

E. Summary statement
-Summarize (1) distinctness and (2) reasons for insisting upon restriction, if applicable.
-Include paragraph advising as to response required.
-Indicate effect of allowances of linking claims, if any present.
-Indicate effect of cancellation or non-allowance of evidence claims (see >MPEP< § 806.05(c)).

Form Paragraph 8.21 must be used at the conclusion of each restriction requirement.

¶ 8.21 Conclusion of All Restriction Requirements

Examiner Note:
THIS PARAGRAPH MUST BE ADDED AS A CONCLUSION TO ALL RESTRICTION REQUIREMENTS employing any of form paragraphs 8.14 to 8.20.

Because these inventions are distinct for the reasons given above and [1] restriction for examination purposes as indicated is proper.

Examiner Note:
In the bracket insert by writing one or more of the following reasons:
1) have acquired a separate status in the art as shown by the different classification.
2) have acquired a separate status in the art because of their recognized divergent subject matter.
3) the search required for group [ ] is not required for Group [ ].

>Form Paragrah 8.23.2 must be included in all restriction requirements for applications having joint inventors.

¶ 8.23.2 Joint Inventors, Correction of Inventorship
Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(h).

Examiner Note:
This paragraph must be included in all restriction requirements for applications having joint inventors.<

818 Election and Response

Election is the designation of the particular one of two or more disclosed inventions that will be prosecuted in the application.

A response is the reply to each point raised by the examiner's action, and may include a traverse or compliance.

A traverse of a requirement to restrict is a statement of the reasons upon which the applicant relies for his conclusion that the requirement is in error.

To be complete, a response to a requirement which merely specifies the linking claims need only include a proper election.

Where a rejection or objection is included with a restriction requirement, applicant, besides making a proper election must also distinctly and specifically point out the supposed errors in the examiner's rejection or objection. See 37 CFR 1.111.

818.01 Election Fixed by Action on Claims

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

818.02 Election Other Than Express [R-8]

Election may be made in other ways than expressly in response to a requirement >as set forth in MPEP §§ 818.02(a) - (c)<.

818.02(a) By Originally Presented Claims [R-8]

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

The claims originally presented and acted upon by the Office on their merits determine the invention elected by an applicant, and subsequently presented claims to an invention other than that acted upon should be treated as provided in >MPEP< § 821.03.

818.02(b) Generic Claims Only — No Election of Species [R-8]

Where only generic claims are first presented and prosecuted in an application in which no election of a single invention has been made, and applicant later presents species claims to more than one species of the invention, he or she must at that time indicate an election of a single species. The practice of requiring election of species in cases with only generic claims of the unduly extensive and burdensome search type is set forth in >MPEP< § 808.01(a).

818.02(c) By Optional Cancellation of Claims

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

818.03 Express Election and Traverse

37 CFR 1.143. Reconsideration of requirement.

If the applicant disagrees with the requirement for restriction, he may request reconsideration and withdrawal or modification of the requirement, giving the reasons therefor (see § 1.111.) In requesting reconsideration the applicant must indicate a provisional election of one invention for prosecution, which invention shall be the one elected in the event the requirement becomes final. The requirement for restriction will be reconsidered on such a request. If the requirement is repeated and made final, the examiner will at the same time act on the claims to the invention elected.

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

818.03(a) Response Must Be Complete [R-8]

As shown by the first sentence of 37 CFR 1.143 the traverse to a requirement must be complete as required by 37 CFR 1.111(b) which reads in part: "In order to be entitled to reconsideration or further examination, the applicant or patent owner must make request therefor in writing. The reply by the applicant or patent owner must distinctly and specifically point out the supposed errors in the examiner's action and must respond to every ground of objection and rejection in the prior Office action. . . . The applicant's or patent owner's reply must appear throughout to be a *bona fide* attempt to advance the case to final action. . . ."

Under this rule, the applicant is required to specifically point out the reasons on which he or she bases his or her conclusions that a requirement to restrict is in error. A mere broad allegation that the requirement is in error does not comply with the requirement of >37 CFR< § 1.111. Thus the required provisional election (See >MPEP< § 818.03(b)) becomes an election without traverse.

818.03(b) Must Elect, Even When Requirement Is Traversed [R-8]

As noted in the second sentence of 37 CFR 1.143, a provisional election must be made even though the requirement is traversed.

All requirements >for restriction< should include Form Paragraph 8.22.

¶ 8.22 Requirement, Election, Mailed

Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Examiner Note:

This paragraph can be used in Office actions with or without an action on the merits.

818.03(c) Must Traverse To Preserve Right of Petition [R-8]

37 CFR 1.144. Petition from requirement for restriction.

After a final requirement for restriction, the applicant, in addition to making any response due on the remainder of the action, may petition the Commissioner to review the requirement. Petition may be deferred until after final action on or allowance of claims to the invention elected, but must be filed not later than appeal. A petition will not be considered if reconsideration of the requirement was not requested. (See § 1.181.)

>If applicant does not distinctly and specifically point out supposed errors in the restriction requirement, the election should be treated as an election without traverse and be so indicated to the applicant by use of form paragraph 8.25.2.

¶ 8.25.2 Election Without Traverse Based on Incomplete Response

Applicant's election of [1] in Paper No. [2] is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP 818.03(a)).<

818.03(d) Traverse of Non-Allowance of Linking Claims

A traverse of the non-allowance of the linking claims is not a traverse of the requirement to restrict; it is a traverse of a holding of non-allowance.

Election combined with a traverse of the non-allowance of the linking claims only is an agreement with the position taken by the Office that restriction is proper if the linking type claim is not allowable and improper if they are allowable. If the Office allows such a claim it is bound to withdraw the requirement and to act on all linked inventions. But once all linking claims are canceled 37 CFR 1.144 would not apply, since the record would be one of agreement as to the propriety of restriction.

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

818.03(e) Applicant Must Make Own Election

Applicant must make his or her own election. The examiner will not make the election for the applicant, 37 CFR 1.142, 37 CFR 1.143, second sentence.

819 Office Generally Does Not Permit Shift [R-8]

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

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

819.01 Office May Waive Election and Permit Shift

While applicant, as a matter of right, may not shift from claiming one invention to claiming another, the Office is not precluded from permitting a shift. It may do so where the shift results in no additional work or expense, and particularly where the shift reduces work as by simplifying the issues: *Ex parte Heritage* Pat. No. 2,375,414 decided January 26, 1944. If the examiner has accepted a shift from claiming one invention to claiming another, the case is not abandoned: *Meden v. Curtis*, 1905 C.D.272, 117 O.G. 1795 (Comm'r Pats 1905).

820 Not an Election; Permissible Shift

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

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

Genus allowed, applicant may prosecute a reasonable number of additional species thereunder, in accordance with 37 CFR 1.141, this not constituting a shift: *Ex parte Sharp et al.*, Patent No. 2,232,739.

820.01 Old Combination Claimed — Not an Election [R-8]

Where an application originally presents claims to a combination (AB), the examiner holding the novelty if any, to reside in the subcombination (B) per se only (see >MPEP< § 806.05(b)), and these claims are rejected**, subsequently presented claims to subcombination (B) of the originally claimed combination should not be rejected on the ground of previous election of the combination, nor should this rejection be applied to such combination claims if they are reasserted. *Ex parte Donnell*, 1923 C.D. 54. Final rejection of the reasserted "old combination" claims is the action that should be taken. The combination and subcombination as defined by the claims under this special situation are not for distinct inventions. (See >MPEP< § 806.05(c).) See also >MPEP< § 706.03(j).

820.02 Interference Issues — Not an Election [R-8]

Where an interference is instituted prior to an applicant's election, the subject matter of the interference issues is not elected. An applicant may, after the termination of the interference, elect any one of the inventions ** claimed.

821 Treatment of Claims Held to be Drawn to Non-Elected Inventions [R-8]

Claims held to be drawn to non-elected inventions, including claims to non-elected species, are treated as indicated in >MPEP< §§ 821.01 through 821.03. **

The propriety of a requirement to restrict, if traversed, is reviewable by petition under 37 CFR 1.144, *In re Hengehold*, 169 USPQ 473 (CCPA 1971).

All claims that the examiner holds >as<* not >being< directed to the elected subject matter should be withdrawn from further consideration by the examiner as set forth in >MPEP< § 809.02(c) and >MPEP< §§ 821.01 through 821.03. As to one or more of such claims the applicant may traverse the examiner's holding that they are not directed to the elected subject matter. The propriety of this holding, if traversed, is appealable. Thus, if the examiner adheres to his or her position after such traverse, he or she should *reject* the claims to which the traverse applies on the ground that they are not directed to the elected subject matter. >Because applicant believes the claims are readable on the elected invention and the examiner disagrees, the metes and bounds of the claim(s) cannot be readily ascertained, rendering the claim(s) vague and indefinite within the meaning of 35 U.S.C. 112, second paragraph.<

821.01 After Election With Traverse [R-8]

Where the initial requirement is traversed, it should be reconsidered. If, upon reconsideration, the examiner is still of the opinion that restriction is proper, it should be repeated and >made< final ** in the next Office action. (See >MPEP< § 803.01.) In doing so, the examiner should reply to the reasons or arguments advanced by applicant in the traverse. Form Paragraph 8.25 should be used to make a restriction requirement final.

¶ 8.25 Answer to Arguments With Traverse

Applicant's election with traverse of [1] in Paper No. [2] is acknowledged. The traversal is on the ground(s) that [3]. This is not found persuasive because [3].

The requirement is still deemed to be proper and is therefore made FINAL.

Examiner Note:

1. In bracket 1, insert the invention elected.
2. In bracket 3, insert in summary form, the ground on which traversal is based.
3. In bracket 4, insert the reasons why the traversal was not found to be persuasive.

If the examiner, upon reconsideration, is of the opinion that the requirement for restriction is improper he or she should state in the next Office action that the requirement for restriction is withdrawn and give an action on all the claims.

If the requirement is repeated and made final, in that and in each subsequent action, the claims to the nonelected invention should be treated by using Form Paragraph 8.05.

¶ 8.05 Claims Stand Withdrawn With Traverse

Claim [1] withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected [2], the requirement having been traversed in Paper No. [3].

Examiner Note:

In bracket 2, insert invention or species.

This will show that applicant has retained the right to petition from the requirement under 37 CFR 1.144. (See >MPEP< § 818.03(c).)

When the case is otherwise ready for issue, and has not received a final action, the examiner should treat the case by using Form Paragraph 8.03. See >MPEP< § 809.02(c).

When preparing a final action in an application where there has been a traversal of a requirement for restriction, the examiner should indicate in the Office action that a complete response must include cancellation of the claims drawn to the non-elected invention, or other appropriate action (37 CFR 1.144). See Form Paragraph 8.24.

¶ 8.24 Response to a Final Must Include Cancellation

This application contains claim [1] drawn to an invention non-elected with traverse in Paper No. [2]. A complete response to the final rejection must include cancellation of non-elected claims or other appropriate action (37 CFR 1.144) MPEP 821.01.

Examiner Note:

For use in FINAL rejections of applications containing claim(s) non-elected with traverse.

Where a response to a final action has otherwise placed the application in condition for allowance, the failure to cancel claims drawn to the non-elected invention or to take appropriate action will be construed as authorization to cancel these claims by examiner's amendment and pass the case to issue after the expiration of the period for response.

Note that the petition under 37 CFR 1.144 must be filed "not later than appeal". This is construed to mean appeal to the Board of >Patent< Appeals >and Interferences<. If the case is ready for allowance after appeal and no petition has been filed, the examiner should simply cancel the non-elected claims by examiner's amendment, calling attention to the provisions of 37 CFR 1.144.

821.02 After Election Without Traverse

Where the initial requirement is not traversed, if adhered to, appropriate action should be given on the elected claims and the claims to the nonelected invention should be treated by using Form Paragraph 8.06.

¶ 8.06 Claims Stand Withdrawn Without Traverse

Claim [1] withdrawn from further consideration by the examiner, 37 CFR 1.142(b) as being drawn to a nonelected [2]. Election was made without traverse in Paper No. [3].

Examiner Note:

In bracket 2, insert invention or species.

This will show that applicant has not retained the right to petition from the requirement under 37 CFR 1.144.

Under these circumstances, when the case is otherwise ready for issue, the claims to the nonelected invention, including nonelected species, may be canceled by an examiner's amendment, and the case passed for issue. The examiner's amendment should include Form Paragraph 8.07.

¶ 8.07 Ready for Allowance Without Traverse

This application is in condition for allowance except for the presence of claim [1] to [2] nonelected without traverse. Accordingly, claim [3] been cancelled.

Examiner Note:

In bracket 2, insert either an invention or species.

821.03 Claims for Different Invention Added After an Office Action [R-8]

Claims added by amendment following action by the examiner, >MPEP< §§ 818.01, 818.02(a), to an invention other than previously claimed, should be treated as indicated by 37 CFR 1.145.

37 CFR 1.145. Subsequent presentation of claims for different invention.

If, after an office action on an application, the applicant presents claims directed to an invention distinct from and independent of the invention previously claimed, the applicant will be required to restrict the claims to the invention previously claimed if the amendment is entered, subject to reconsideration and review as provided in §§ 1.143 and 1.144.

The action should include Form Paragraph 8.04.

¶ 8.04 Election by Original Presentation

Newly submitted claim [1] directed to an invention that is inde-

pendent or distinct from the invention originally claimed for the following reasons: [2].

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim [3] withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP 821.03.

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

Note that the above practice is intended to have no effect on the practice stated in >MPEP< § *>2303<.

An amendment canceling all claims drawn to the elected invention and presenting only claims drawn to the non-elected invention should not be entered. Such an amendment is non-responsive. Applicant should be notified by using Form Paragraph 8.26.

¶ 8.26 Cancelled Elected Claims, Non-Responsive

The amendment filed on [1] cancelling all claims drawn to the elected invention and presenting only claims drawn to a non-elected invention is non-responsive, (MPEP 821.03). The remaining claims are not readable on the elected invention because [2]. Applicant is given a one month time limit or until the expiration of the response period set in the last Office action, whichever is longer, to complete the response. No extension of this time limit will be granted under either 37 CFR 1.136 (a) or (b) but the period for response set in the last Office action may be extended up to a maximum of 6 months.

822 Claims to Inventions That Are Not Distinct in Plural Applications of Same Inventive Entity [R-8]

The treatment of plural applications of the same inventive entity, none of which has become a patent, is treated in 37 CFR 1.78(b) as follows:

(b) Where two or more applications filed by the same applicant contain conflicting claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in more than one application.

See >MPEP< § 304 for conflicting subject matter in two applications, same inventive entity, one assigned.

See >MPEP< §§ 305 and 804.03 for conflicting subject matter, different inventors, common ownership.

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

See >MPEP< §§ 706.03(w) and 706.07(b) for res judicata.

See >MPEP< § 709.01 for one application in interference.

See >MPEP< §§ 806.04(h) to 806.04(j) for species and genus in separate applications.

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

Form Paragraph 8.29 should be used when the conflicting claims are identical or conceded by applicant to be not patentably distinct.

¶ 8.29 Conflicting Claims, Copending Applications

Claim [1] of this application conflict with claim [2] of application Serial Number [3]. 37 CFR 1.78(b) provides that where two or more applications filed by the same applicant contain conflicting claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in more than one application. Applicant is required to either cancel the conflicting claims from all but one application or maintain a clear line of demarcation between the applications. See MPEP 822.

Examiner Note:

This paragraph is appropriate when the conflicting claims are identical or conceded by applicant to be not patentably distinct.

822.01 Co-pending Before the Examiner [R-8]

Under 37 CFR 1.78(b) the practice relative to overlapping claims in applications copending before the examiner (and not the result of and consonant with a requirement to restrict, for which see >MPEP< § 804.01), is as follows:

Where claims in one application are unpatentable over claims of another application of the same inventive entity because they recite the same invention, a complete examination should be made of the claims of >each<* application >and all appropriate rejections should be entered in each application, including rejections based upon prior art<. The claims of *>each< application may >also< be rejected >on the grounds of provisional double patenting< on the claims of the **>other application whether or not any claims avoid the prior art. Where appropriate, the same prior art may be relied upon in each of the applications<.**

>ONLY PROVISIONAL DOUBLE PATENTING REJECTION IN ONE APPLICATION

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 one of the applications. If the "provisional" double patenting rejection in one application is the only rejection remaining in that application, the examiner should then withdraw that rejection and permit the application to issue as a patent, thereby converting the "provisional" double patenting rejection in the other application(s) into a double patenting rejection at the time the one application issues as a patent.

ONLY PROVISIONAL DOUBLE PATENTING REJECTION IN TWO APPLICATIONS

If the "provisional" double patenting rejections in both application are the only rejections remaining in those applications, the examiner should then withdraw that rejection in one of the

applications and permit the application to issue as a patent. 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 the one application issues as a patent.<

823 Unity of Invention Under the Patent Cooperation Treaty [R-8]

See >Chapter 1800 for a detailed discussion of unity of invention under the Patent Cooperation Treaty (PCT).<**