

# **Biotechnology, Chemical and Pharmaceutical Customer Partnership Meeting**

## **Restriction Practice**

*September 25, 2019*

UNITED STATES  
PATENT AND TRADEMARK OFFICE



# Topics

- When restriction is proper: independent or distinct inventions and serious burden
- Restriction and double patenting
- Breadth vs. patentable distinction
- Determining distinctness between related inventions
- Election of species
- Linking claims
- Election by original presentation
- Rejoinder and withdrawal of restriction requirement.

**When restriction is proper**

# Authority for restriction

- The authority for requiring a restriction between inventions is based in 35 U.S.C. 121 divisional applications, which reads in part:
  - If two or more independent and distinct inventions are claimed in one application, the Director may require the application to be restricted to one of the inventions.
- Restriction is the practice of requiring an applicant to elect a single, claimed invention for examination when two or more independent inventions and/or two or more distinct inventions are claimed in the application.
  - The terms “independent” (i.e., unrelated) and “distinct” (i.e., related but patentably distinct) have mutually exclusive meanings and thus are interpreted as alternative requirements. Only one of these requirements must be met in order to support a restriction.

*MPEP 802, 802.02*



# When restriction is proper

- For a proper requirement for restriction between patentably distinct inventions, there are two criteria:
  - (i) Showing the inventions are independent or distinct as claimed
  - AND
  - (ii) Showing that there would be a serious search and examination burden on the examiner if restriction is not required.
- A restriction requirement is made at the discretion of the examiner.
  - Restriction is NOT a tool for reducing the number of claims for mere convenience.

*MPEP 803(I)*

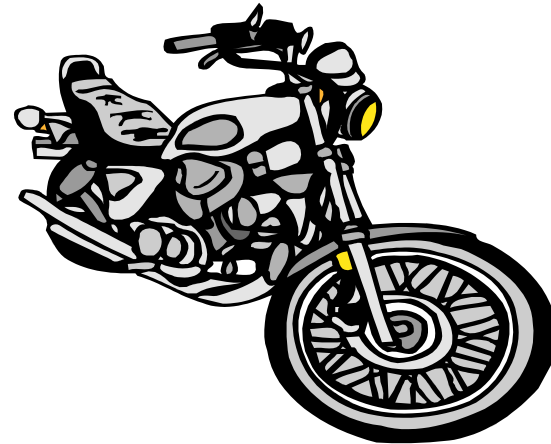


# Independent inventions

- Inventions, as claimed, are independent (i.e., unrelated) if there is no disclosed relationship between the inventions. That is, they are unconnected in design, operation, and effect.
- For example:



versus



*MPEP 802.011, 806.06*



# Independent inventions (*cont.*)

- Restriction to one independent invention can be required when:
  - It can be shown that two or more inventions are independent, and
  - There would be a serious burden on the examiner if restriction is not required.
- Examples include:
  - Two different combinations, not disclosed as capable of use together, having different modes of operation, different functions, and different effects:
    - o An article of apparel and a locomotive; a process of painting a house and a process of boring a well.
  - Where the two inventions are process and product, and the product cannot be used in, or made by, the process:
    - o A specific process of molding is independent from a molding apparatus that cannot be used to practice the specific process.
- Use FP 8.20.02 to restrict between independent, unrelated inventions and FP 8.20.03 to restrict between an unrelated product and process.

# Related but distinct inventions

These cash registers are related, but may be considered distinct if found to be not connected in at least one of design, operation, or effect.



VS.



*MPEP 802.01 II, 803*



# Related but distinct inventions (cont.)

- Two or more inventions are related (i.e., not independent) if they are disclosed as connected in at least one of design (e.g., structure or method of manufacture), operation (e.g., function or method of use), or effect.
  - Related inventions are **distinct** if the inventions **as claimed** are not connected in at least one of design, operation, or effect (e.g., can be made by, or used in, a materially different process) and wherein at least one invention is PATENTABLE (novel and nonobvious) OVER THE OTHER (though they may each be unpatentable over the prior art).
- Restriction can be required when related inventions can be shown to be distinct and there would be a serious burden on the examiner if restriction is not required.

*MPEP 802.01 II and 806.05*



# Showing serious burden

- Reasons must be provided as to why a serious search and examination burden would exist if restriction was not required.
- Serious burden can be shown if the inventions have **one or more of the following**:
  - a) Separate classification.
    - To show that each invention 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).
  - b) Separate status in the art when they are classifiable together.
    - To show a recognition of separate inventive effort by inventors, may be shown by citing patents which are evidence of such separate status, and also of a separate field of search.
  - c) A different field of search.
    - To show it is necessary to search for one of the inventions in a manner that is not likely to result in finding art pertinent to the other invention(s) (e.g., searching different main groups/sub-groups or electronic resources, or employing different search queries), even though the inventions are classified together (patents need not be cited).

*MPEP 803 II, 803.02, 806.05, 808.02; FP 8.21*



# When restriction is not appropriate

Restriction cannot be required when **one or more of the following are true:**

- No serious burden exists in searching and examining the claims, even if the claims are drawn to independent or distinct inventions;
- Inventions are not distinct **as claimed**;
- There is an express admission that the claimed inventions would have been obvious over each other within the meaning of 35 U.S.C. 103; or
- Claims define the same essential characteristics of a single disclosed embodiment.

*MPEP 803, 806.03*



# **Restriction and non-statutory double patenting**

# Restriction and non-statutory double patenting

If the examiner indicates, via restriction, that inventions A and B are independent or patentably distinct, this would prohibit any later assertion that A and B are patentably **indistinct** under non-statutory double patenting, except as noted below (and in *MPEP 804.01*).

- A nonstatutory double patenting rejection between separate applications to A and B could be properly made if the restriction requirement was withdrawn before the rejection.
- A nonstatutory double patenting rejection between separate applications to A and B could be properly made if the examiner later determines that the inventions are patentably indistinct and the later application is **not** a divisional application that has consonance with the restriction requirement.
  - Consonance means maintaining the line of demarcation between the independent and distinct inventions identified in the restriction requirement. *MPEP 804.01B*

*MPEP 804.01A-H*



# Restriction and non-statutory double patenting (*cont.*)

- When restriction is required, the examiner is prohibited from making a non-statutory double patenting rejection against any claim in a subsequent divisional application that is directed only to any of the originally non-elected inventions under 35 U.S.C. 121, unless the restriction requirement was withdrawn.
- Improperly applying restriction to patentably indistinct sets of claims can result in the possibility of multiple patents being awarded for patentably indistinct variations of the same invention, since non-statutory double patenting against the divisional applications is prohibited.
  - Multiple patents for the same invention could lead to multiple lawsuits against an accused infringer by different assignees of patents to the indistinct claims.

*MPEP 804.01*



# Restriction and non-statutory double patenting (*cont.*)

If it is unclear whether restriction should be applied, an examiner should ask whether they would be inclined to apply a nonstatutory double patenting rejection if the claims were presented in different applications:

- If yes, then restriction should not be required.
- If no, then restriction may be appropriate, but remember that requiring restriction is at the examiner's discretion and requires a showing of serious search and examination burden.

**Breadth vs. patentable distinction**



# Breadth vs. patentable distinction

Do not mistake variations in breadth for patentable distinctness. Claims should not be restricted if they define the same essential characteristics of a single disclosed embodiment of an invention.

- Claims define the same essential characteristics when the claims:
  - Provide different definitions of the same invention, or vary only in breadth or scope of the invention.

*MPEP 806.03*



# Breadth vs. patentable distinction (*cont.*)

Claim 1. An ice cube tray for freezing liquids comprising: a frame and multiple compartments within the frame.

Claim 2. The ice cube tray of claim 1, wherein the multiple compartments are star-shaped.

Claim 3. An ice cube tray for freezing liquids comprising: a frame and multiple compartments within the frame, wherein the compartments are polygonal.

Claim 1 is broad, while claims 2 and 3 are more narrow. The claims are not restrictable because claim 1 defines the same invention of a structure for making ice cubes, albeit in a broader way. All limitations of claim 1 are anticipated by the limitations of claims 2 or 3 and could serve as the basis for non-statutory double patenting if presented in separate applications. Accordingly, restriction would not be proper.

**Determining distinctness between  
related inventions**

# Types of related inventions

- Combination-subcombination
- Subcombinations usable together
- Process and apparatus for its practice
- Process of making and product made
- Apparatus and product made
- Product and process of using
- Product, process of making, and process of using
- Related products/processes

*MPEP 806.05(c)-(j)*



# Combination-subcombination

- A combination contains two or more subcombinations or elements claimed together.
- Combination-subcombination can appear in various forms, as seen below. This list is not exhaustive.
  - Where A, B, and C represent claim elements, “sp” indicates an element claimed specifically, and “br” indicates an element claimed broadly:
    - $AB_{sp} - B_{sp}$
    - $AB_{br} - B_{sp}$
    - $ABC_{sp} - B_{sp} - C_{sp}$
    - $AB_{sp}C_{sp} - B_{sp} - C_{sp}$

Illustrative examples of these types will follow.

*MPEP 806.05(c), 806.05(d)*

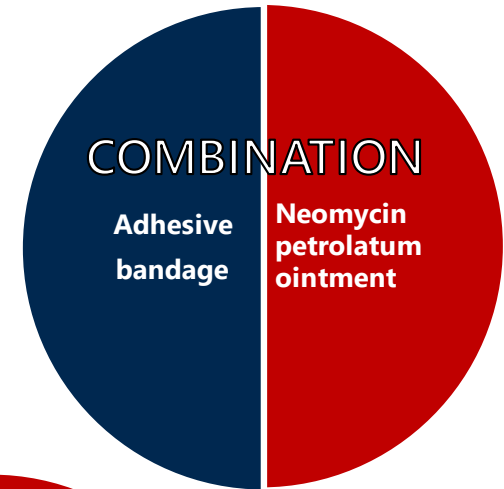


# Combination-subcombination (cont.)

- To support a restriction between a combination and a subcombination a two-way test for distinctness and reasons for insisting on restriction are necessary.
- Distinctness can be shown when:
  - (i) The combination as claimed does not require the particulars of the subcombination as claimed for patentability (i.e., to show novelty and non-obviousness of the combination), AND
  - (ii) The subcombination has utility either by itself or in another materially different combination.
- When these factors cannot be shown, the inventions are not distinct.

# EXAMPLE 1

Claim 1. A wound dressing comprising:  
an adhesive bandage; and  
an antibiotic ointment of neomycin  
and a petrolatum base disposed on a  
surface of the bandage.



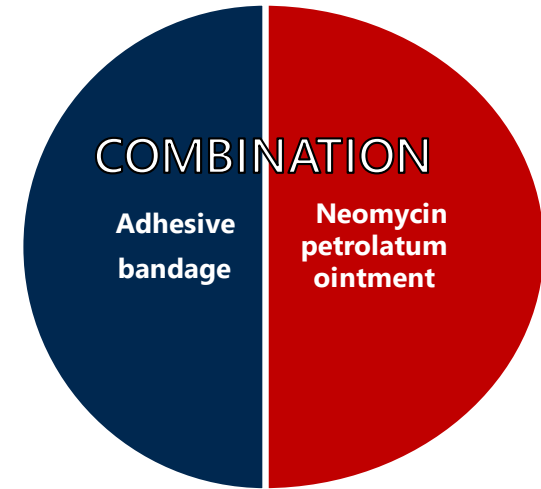
Claim 2. An antibiotic ointment for a  
wound dressing comprising:  
neomycin; and  
a petrolatum base.



# Summary: EXAMPLE 1

## $AB_{sp} - B_{sp}$

- The combination (wound dressing of claim 1) requires the particulars of the subcombination (ointment of claim 2) for patentability, even though the subcombination has utility either by itself or in another materially different combination, so this claim group pair does not meet the first part of the two-way combination-subcombination test.
- While the ointment may have separate utility in another type of dressing, or utility on its own (i.e., it meets part ii of the test), a restriction cannot be made because the two-way test requires meeting **both** requirements (i) and (ii).
- **No distinctness** - restriction would not be proper.

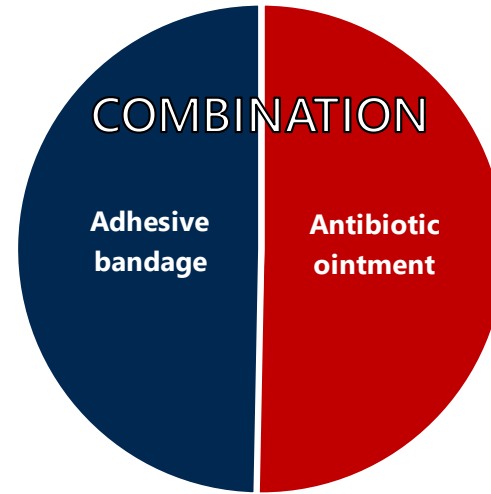




# EXAMPLE 2

Claim 3. A wound dressing comprising:

an adhesive bandage; and  
an antibiotic ointment  
disposed on a surface of the  
bandage.



Claim 4. An antibiotic ointment comprising:

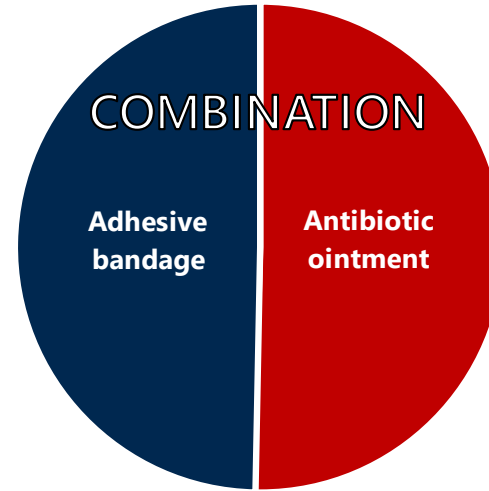
neomycin; and  
a petrolatum base.



# Summary: EXAMPLE 2

## $AB_{br} - B_{sp}$

- The combination (wound dressing of claim 3) does not require the particulars of the subcombination (ointment of claim 4) for patentability AND the subcombination of claim 4 can be used by itself or in another materially different combination.
- **Distinct** – restriction would be proper if a serious burden is shown.



# Subcombinations usable together

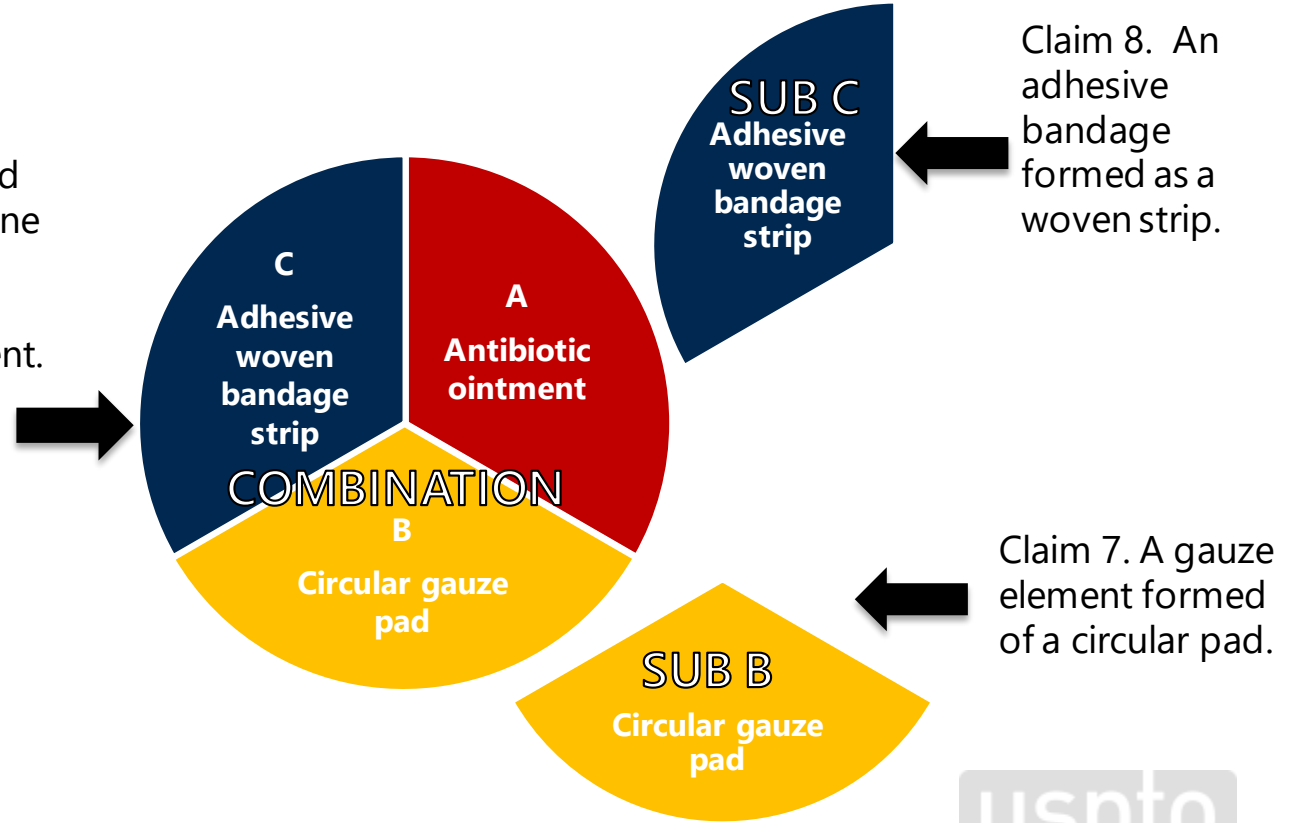
- Two or more claimed subcombinations, disclosed as usable together in a single combination, are usually restrictable when:
  - At least one subcombination as claimed can be shown to be separately usable or has utility other than in the disclosed combination, AND
  - The subcombinations as claimed do not overlap in scope\*, AND
  - The subcombinations as claimed are not obvious variants of one another.
- \*Not overlapping in scope means that the inventions have mutually exclusive limitations or the limitations of one claimed invention would not read on the limitations of the other claimed invention (and vice versa).
  - Example: a robotic eye has limitations that would not be included in a robotic hand and vice versa, so they do not overlap in scope.
- Serious burden must also be shown to support a restriction between subcombinations.

# Subcombinations usable together (*cont.*)

- When the claim set includes plural subcombinations usable together in a single combination **and** claims a combination that requires the particulars of at least one of the subcombinations, two-way distinctness and serious burden must be shown.
- Each subcombination is distinct from the combination as claimed if:
  - (A) The combination does not require the particulars of the subcombination as claimed for patentability, and
  - (B) The subcombination can be shown to have utility either by itself or in another materially different combination.

# EXAMPLE 3

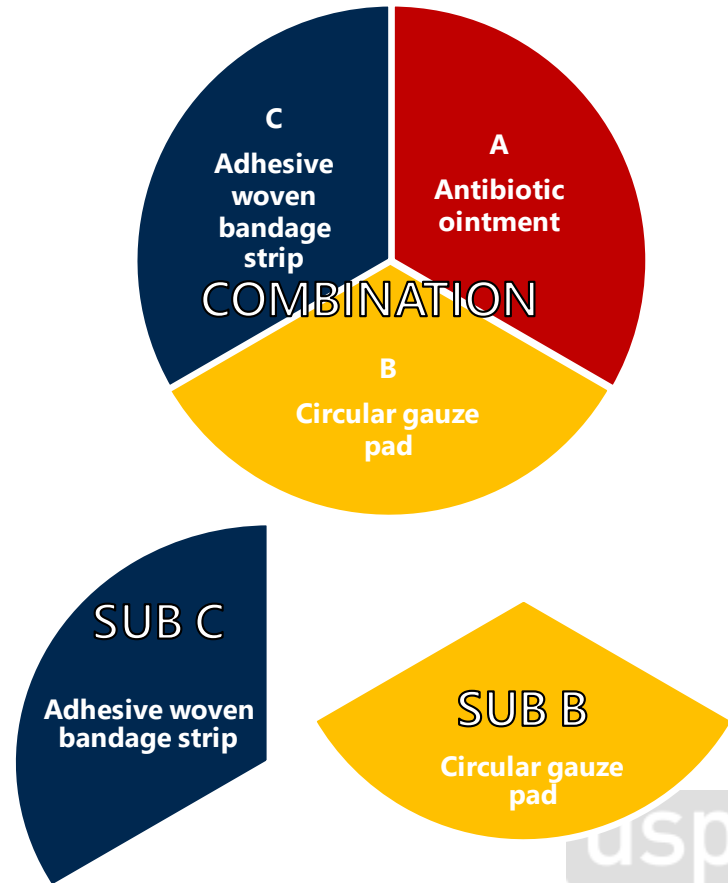
Claim 6. A wound dressing comprising:  
an adhesive bandage formed as a woven strip;  
a gauze element formed as a circular pad secured to one side of the bandage; and  
antibiotic ointment disposed on the gauze element.



# Summary: EXAMPLE 3

$AB_{sp}C_{sp} - B_{sp} - C_{sp}$

- The presence of the first subcombination (the gauze element of claim 7) is evidence that the details of the second subcombination (the adhesive bandage of claim 8) are not required for patentability of the combination (the wound dressing of claim 6) and vice versa.
- **Distinct** - a restriction between the subcombinations would be proper upon a showing of serious search and examination burden.



*MPEP 806.05(d)*

# Process and apparatus for its practice

Restriction between a process and an apparatus for its practice is based on a **one-way** test for distinctness:

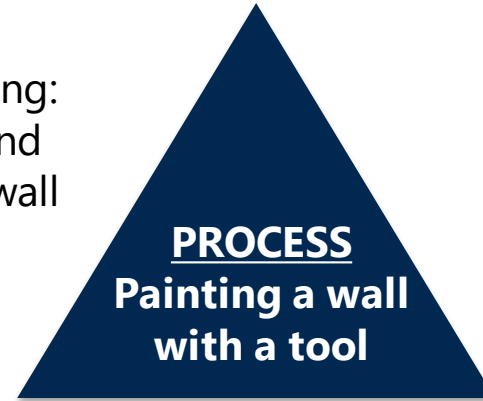
- (i) The process as claimed can be practiced by another materially different apparatus or by hand; OR
- (ii) The apparatus as claimed can be used to practice another materially different process.

*MPEP 806.05(e); FP 8.17*

# EXAMPLE 4

Claim 1. A process of painting a wall comprising:  
depositing primer on the wall with a tool; and  
depositing a pigmented latex paint on the wall  
with the tool.

Claim 2. An brush tool comprising:  
a handle; and  
a plurality of bristles attached to a first  
end of the handle.





# Process of making and product made

Restriction between a process of making and a product made is based on a **one-way** test for distinctness:

- (i) The process as claimed is not an obvious process of making the product, and the process as claimed can be used to make another materially different product, OR
- (ii) The product as claimed can be made by another materially different process.

*MPEP 806.05(f); FP 8.18*



# EXAMPLE 5

Claim 1. A process of making strips of material comprising:  
weaving cotton fibers together to form a fabric sheet; and  
cutting the fabric sheet into a plurality of strips.

Claim 2. A bandage comprising:  
a strip of material having an adhesive layer.



# Apparatus and product made

Restriction between an apparatus and a product made by the apparatus is based on a **one-way** test for distinctness:

- (i) The apparatus as claimed is not an obvious apparatus for making the product and the apparatus as claimed can be used to make another materially different product, OR
- (ii) The product as claimed can be made by another materially different apparatus.

*MPEP 806.05(g); FP 8.19*

# EXAMPLE 6

Claim 1. An apparatus for doping a material comprising:

- a mixing chamber;
- a heater; and
- an ion implanter.



**APPARATUS**  
Doping  
apparatus



**PRODUCT**  
N-type doped  
semiconductor

Claim 2. An N-type doped semiconductor device comprising:

- a silicon base; and
- a phosphorous dopant in the base.

# Product and process of using a product

Restriction between a product and process of using a product is based on a **one-way** test for distinctness:

- (i) The process of using as claimed can be practiced with another, materially different product, OR
- (ii) The product as claimed can be used in a materially different process.

*MPEP 806.05(h); FP 8.20*



# EXAMPLE 7

Claim 1. A process of painting a wall comprising:  
    depositing primer on the wall with a tool; and  
    depositing a pigmented latex paint on the wall with the tool.

Claim 2. A brush tool comprising:  
    a handle; and  
    a plurality of bristles attached to a first end of the handle.



# Establishing distinctness between product, process of making, and process of using

- Where claims to all three categories—product, process of making, and process of using—are present, a **three-way requirement** for restriction can only be made when:
  - (i) The process of making the product **as claimed** is distinct from the product, AND
  - (ii) The process of using the product **as claimed** is distinct from the product, AND
  - (iii) The process of making the product as claimed is distinct from the process of using the product.
- If a showing of distinctness cannot be made between the process of making and the product, the process of using may be joined with process of making and the product.

*MPEP 806.05(i)*

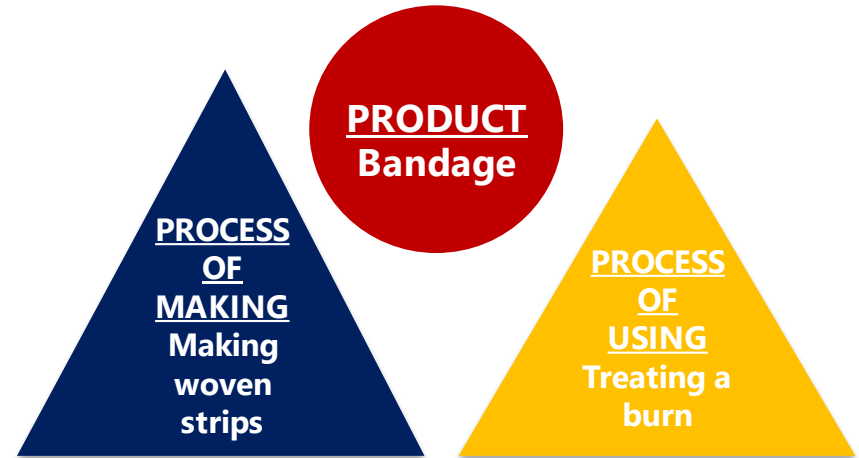


# EXAMPLE 8

Claim 1. A process of making strips of material comprising:  
weaving cotton fibers together to form a fabric sheet; and  
cutting the fabric sheet into a plurality of strips.

Claim 2. A bandage comprising:  
a strip of material having an adhesive layer.

Claim 3. A method of treating a burn, comprising  
applying a strip shaped bandage with burn salve to a patient.





# Related products or related processes

Restriction between related products or related processes is based on a **two-way** test for distinctness, which means both (or all, if more than two) claim groups in question must meet these criteria:

- (i) The inventions as claimed do not overlap in scope, AND
- (ii) The inventions as claimed are not obvious variants, AND
- (iii) The inventions as claimed are not capable of use together or can have a materially different design, mode of operation, function, or effect.

*MPEP 806.05(j)*



**Election of species**

# Election of species

- An election of species is a type of restriction requirement.
- An election of species may be required when there are multiple patentably distinct embodiments of an invention claimed, and where there is a serious burden to the examiner to examine all of them.
- In election of species situations, generic claims may or may not be present.
- Distinct species are identified by figures or distinguishing characteristics.
  - Claims can be used for grouping when figures and description are not convenient.

*MPEP 808.01(a)*



# Election of species (*cont.*)

**Two-prong** test for distinctness:

- (i) Each species, as claimed, requires a mutually exclusive limitation, AND
- (ii) The species, as claimed, are not obvious variants of each other.

*MPEP 806.04(f)*

# Election of species (*cont.*)

Election of species **cannot** be required:

- When the species are obvious variants of each other,  
OR
- Where the examining the species together would not present a serious burden,  
OR
- When the claims are only directed to a single species, with no generic claim.

*MPEP 803, 806.04, 809.02(a), 808.01(a), FP 8.01*



# Election of species – Markush groupings

- A Markush group is a closed list of alternatives recited in a single claim (e.g., “selected from the group consisting of amino, halogen, nitro, chloro, and alkyl”).
  - This specific wording is not required for Markush treatment.
- Election of species may only be required between patentably distinct alternatives in a proper Markush claim.
  - Patentably indistinct alternatives should be grouped together.
- When an elected species in a proper Markush claim is found to be allowable, another species must be examined, until one species is found in the prior art, or until the entire Markush group is found to be allowable over the prior art.

*MPEP 803.02 III (A); 2117*



**Linking claims**

# What is a linking claim?

- A linking claim is a claim which, if allowable, links together claimed inventions that would otherwise be properly divisible (restrictable).
- When a linking claim is found to be allowable, any restriction between linked claims must be withdrawn and the claims rejoined.
  - In this case, the record should be made clear that the restriction has been withdrawn, and identify which claims are being rejoined, as appropriate.

*MPEP 809*





# Linked inventions and common claim types linking them

- Linking claims and linked inventions are usually either product claims linking properly divisible product inventions, or process claims linking properly divisible process inventions.
- The most common types of linking claims are:
  - Genus claims linking species claims.
  - Subcombination claims linking plural combinations.
- Restriction can be required between claims to distinct (but linked) inventions.
  - If a linked invention is elected, the linking claims are examined with the elected invention.



# Election by original presentation

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# Election by original presentation

- Election by original presentation limits the **subsequent prosecution** to the initially-examined (acted upon) invention in a single application.
- Applicants are generally not permitted to switch inventions after an election is made in response to a restriction requirement, and there has been an office action on the merits of the elected invention.
  - Requests for continued examination (RCEs) may not be used as a matter of right to shift inventions.

*MPEP 706.06(h)VI(B), 818.02(a), 819, 821.03*



# Election by original presentation (*cont.*)

- If applicant later presents claims directed to an invention that is independent or distinct from claims previously examined on the merits, such claims may be withdrawn from consideration as being directed to a non-elected invention.
  - Use FP 8.04 to notify the applicant that those claims will not be examined due to election by original presentation.
- An amendment cancelling 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 using FP 8.26.

*MPEP 821.03*



# Election by original presentation (*cont.*)

- Originally presented claims may be considered constructively elected regardless of whether a restriction requirement was previously issued by the examiner (e.g., where original claims were directed to only one invention, but after an action on the merits, applicant introduced claims to a second, patentably distinct invention).
- When applying election by original presentation, the next office action should include a full explanation of why the new invention(s) is/are independent or distinct from the originally presented invention, using the same reasoning and relationships discussed for restriction.
  - The office action should also include the election by original presentation form paragraph (FP 8.04).

*MPEP 821.03*



# Limits on election by original presentation

Election by original presentation is NOT applicable when:

- A provisional election of a single species was made in accordance with MPEP 803.02 in a Markush claim and applicant amends the claims such that the elected species is cancelled.
- Applicant presents claims that could not have been restricted from the claims drawn to the elected invention had they been presented earlier.

**Rejoinder/withdrawal of restriction  
requirement**

# Rejoinder

- Rejoinder involves withdrawal of a restriction requirement between an allowable elected invention and a non-elected invention and examination of the formerly non-elected invention on the merits.
- In order to be eligible for rejoinder, a claim to a non-elected invention must depend from or otherwise require all the limitations of an allowable claim.
- Rejoined claims must be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103, and 112.
- Any rejoinder must be clearly explained on the record.

*MPEP 821.04*



# Rejoinder (*cont.*)

- As a best practice, examiners should check whether rejoinder is appropriate after each amendment, and each time an office action is sent.
- If all claims elected with traverse are ready for allowance and rejoinder is NOT appropriate, examiner must request permission from applicant to cancel non-elected claims.
- If an election was made without traverse, claims directed to non-elected species and non-elected inventions that are eligible should be rejoined; if not rejoined, such claims may only be cancelled by examiner's amendment when expressly authorized by applicant.

*MPEP 821.01, 821.02, and 821.04*



# Rejoinder of allowable linking claims

When a linking claim is allowable, any restriction requirement between the inventions it links **cannot** be maintained.

- The record **must clearly state** that the restriction requirement has been **withdrawn**, even if claims to non-elected linked inventions have been canceled.
- Any pending claim(s) depending from or otherwise requiring all the limitations of the allowable linking claim(s) will be **rejoined** and fully examined for patentability.
- When a restriction requirement is withdrawn, the examiner should notify the applicant that any canceled subject matter directed to the non-elected groups may be re-introduced via amendment.
  - The applicant need not request rejoinder.

*MPEP 809, FP 8.01, FP 8.02, FP 8.12*



# Rejoinder relating to combinations

Upon determining that all claims directed to an elected combination invention are allowable, the examiner must reconsider the propriety of any restriction requirement between the combination and any subcombination(s).

- If allowable in view of patentability of at least one subcombination, withdraw restriction between elected combination and patentable subcombination.
- Rejoin any subcombinations that were searched and found allowable.
- Rejoin any non-elected claims that require all the limitations of the allowable claim.

*MPEP 806.05(d)*



# Rejoinder of process requiring an allowable product

- If elected product claim(s) are subsequently found allowable, consider withdrawn process claims which depend from or otherwise require all the limitations of an allowable product claim for rejoinder.
  - All claims directed to a non-elected process invention must depend from or otherwise require all the limitations of an allowable product claim to be rejoined.
  - Upon rejoinder of claims directed to a previously non-elected process invention, the restriction requirement is withdrawn.
- If applicant cancels all the claims directed to a non-elected process invention **before** rejoinder occurs, the examiner should not withdraw the restriction requirement.
  - This will preserve applicant's rights under 35 U.S.C. 121.

*MPEP 821.04(b)*



# Summary

- Restriction is the requirement to elect one of two or more patentably distinct inventions for examination.
- Restriction is only proper when there would be a serious search and examination burden on the examiner if not required, and the inventions are independent or distinct.
- Restriction can prohibit a nonstatutory double patenting rejection when later divisional applications are filed, assuming the restriction requirement is maintained.
- Examiners are required to provide a proper basis of restriction and a clear record of withdrawal when appropriate.

