

# Chapter 800 Restriction in Applications Filed Under 35 U.S.C. 111; Double Patenting

<b>801</b>	<b>Introduction</b>	806.05(g)	Apparatus and Product Made — Distinctness
<b>802</b>	<b>Basis for Practice in Statute and Rules</b>	806.05(h)	Product and Process of Using
802.01	Meaning of “Independent” and “Distinct”	806.05(i)	Product, Process of Making, and Process of Using — Product Claim Not Allowable
802.02	Definition of Restriction	<b>807</b>	<b>Patentability Report Practice Has No Effect on Restriction Practice</b>
<b>803</b>	<b>Restriction - When Proper</b>	<b>808</b>	<b>Reasons for Insisting Upon Restriction</b>
803.01	Review by Examiner With at Least Partial Signatory Authority	808.01	Independent Inventions
803.02	Restriction — Markush Claims	808.01(a)	Species
803.03	Restriction — Transitional Applications	808.02	Related Inventions
803.03(a)	Transitional Application — Linking Claim Allowable	<b>809</b>	<b>Claims Linking Distinct Inventions</b>
803.03(b)	Transitional Application — Generic Claim Allowable	809.02	Generic Claim Linking Species
803.04	Restriction - Nucleotide Sequences	809.02(a)	Election Required
<b>804</b>	<b>Definition of Double Patenting</b>	809.02(b)	Election Required — Generic Claim Allowable
804.01	Prohibition of Double Patenting Rejections Under 35 U.S.C. 121	809.02(c)	Action Following Election
804.02	Avoiding a Double Patenting Rejection	809.02(d)	No Species Claims
804.03	Treatment of Commonly Owned Cases of Different Inventive Entities	809.02(e)	Generic Claim Allowable in Substance
804.04	Submission to Technology Center Director	809.03	Linking Claims
<b>805</b>	<b>Effect of Improper Joinder in Patent</b>	809.04	Retention of Claims to Nonelected Invention
<b>806</b>	<b>Determination of Distinctness or Independence of Claimed Inventions</b>	<b>810</b>	<b>Action on the Merits</b>
806.01	Compare Claimed Subject Matter	810.01	Not Objectionable When Coupled With Requirement
806.02	Patentability Over the Prior Art Not Considered	810.02	Usually Deferred
806.03	Single Embodiment, Claims Defining Same Essential Features	810.03	Given on Elected Invention When Requirement Is Made Final
806.04	Independent Inventions	<b>811</b>	<b>Time for Making Requirement</b>
806.04(a)	Species — Genus	811.02	Even After Compliance With Preceding Requirement
806.04(b)	Species May Be Related Inventions	811.03	Repeating After Withdrawal Proper
806.04(c)	Subcombination Not Generic to Combination	811.04	Proper Even Though Grouped Together in Parent Application
806.04(d)	Definition of a Generic Claim	<b>812</b>	<b>Who Should Make the Requirement</b>
806.04(e)	Claims Restricted to Species	812.01	Telephone Restriction Practice
806.04(f)	Claims Restricted to Species, by Mutually Exclusive Characteristics	<b>814</b>	<b>Indicate Exactly How Application Is To Be Restricted</b>
806.04(h)	Species Must Be Patentably Distinct From Each Other	<b>815</b>	<b>Make Requirement Complete</b>
806.04(i)	Generic Claims Presented for First Time After Issue of Species	<b>816</b>	<b>Give Reasons for Holding of Independence or Distinctness</b>
806.05	Related Inventions	<b>817</b>	<b>Outline of Letter for Restriction Requirement Between Distinct Inventions</b>
806.05(a)	Combination and Subcombination or Element	<b>818</b>	<b>Election and Reply</b>
806.05(b)	Old Combination — Novel Subcombination	818.01	Election Fixed by Action on Claims
806.05(c)	Criteria of Distinctness for Combination, Subcombination, or Element of a Combination	818.02	Election Other Than Express
806.05(d)	Subcombinations Usable Together	818.02(a)	By Originally Presented Claims
806.05(e)	Process and Apparatus for Its Practice — Distinctness	818.02(b)	Generic Claims Only — No Election of Species
806.05(f)	Process of Making and Product Made — Distinctness	818.02(c)	By Optional Cancellation of Claims
		818.03	Express Election and Traverse
		818.03(a)	Reply Must Be Complete
		818.03(b)	Must Elect, Even When Requirement Is Traversed
		818.03(c)	Must Traverse To Preserve Right of Petition

- 818.03(d) Traverse of Nonallowance of Linking Claims  
 818.03(e) Applicant Must Make Own Election

**819 Office Generally Does Not Permit Shift**

- 819.01 Office May Waive Election and Permit Shift

**820 Not an Election; Permissible Shift**

- 820.01 Old Combination Claimed — Not an Election  
 820.02 Interference Issues — Not an Election

**821 Treatment of Claims Held To Be Drawn to Nonelected Inventions**

- 821.01 After Election With Traverse  
 821.02 After Election Without Traverse  
 821.03 Claims for Different Invention Added After an Office Action  
 821.04 Rejoinder

**822 Claims to Inventions That Are Not Distinct in Plural Applications of Same Inventive Entity**

- 822.01 Copending Before the Examiner

**823 Unity of Invention Under the Patent Cooperation Treaty**

## 801 Introduction

This chapter is limited to a discussion of the subject of restriction and double patenting under Title 35 of the United States Code and Title 37 of the Code of Federal Regulations as it relates to national applications filed under 35 U.S.C. 111(a). 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 U.S. Patent and Trademark Office is covered in Chapter 1800.

## 802 Basis for Practice in Statute and Rules

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 Director 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 refer-

ence 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 Director may dispense with signing and execution by the inventor. The validity of a patent shall not be questioned for failure of the Director to require the application to be restricted to one invention.

*37 CFR 1.141. Different inventions in one national 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 the 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 an Office action will require the applicant in the reply to that action to elect an invention to which the claims will be restricted, this official action being called a requirement for restriction (also known as a requirement for division). Such requirement will normally be made before any action on the merits; however, it may be made at any time before final action.

(b) Claims to the invention or inventions not elected, if not canceled, 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 1850, 1875, and 1893.03(d) should be consulted for discussions on unity of invention:

- (A) before the International Searching Authority;
- (B) before the International Preliminary Examining Authority; and
- (C) in the National Stage under 35 U.S.C. 371.

### **802.01 Meaning of “Independent” and “Distinct”**

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 as, for example, 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., the examples used for purpose of illustration above. Such was clearly 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 the 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.

### **803 Restriction - When Proper**

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 independent

(MPEP § 806.04 - § 806.04(i)) or distinct (MPEP § 806.05 - § 806.05(i)).

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 independent or distinct inventions.

### CRITERIA FOR RESTRICTION BETWEEN PATENTABLY DISTINCT INVENTIONS

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

(A) 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

(B) There must be a serious burden on the examiner if restriction is required (see MPEP § 803.02, § 806.04(a) - § 806.04(i), § 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 restriction 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 (Comm'r Pat. 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 of separate classification, or 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) - § 806.04(i) and § 808.01(a).

### 803.01 Review by Examiner with at Least Partial Signatory Authority

Since requirements for restriction under 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, only an examiner with permanent or temporary full signatory authority may sign final and non-final Office actions containing a final requirement for restriction, except that an examiner with permanent or temporary partial signatory authority may sign non-final Office actions containing a final requirement for restriction.

### 803.02 Restriction — Markush Claims

#### PRACTICE RE MARKUSH-TYPE CLAIMS

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 the members of the Markush group in the claim on the merits, even though they are directed to independent and distinct inventions. In such a case, the examiner will not follow the procedure described below and will not require restriction.

Since the decisions in *In re Weber*, 580 F.2d 455, 198 USPQ 328 (CCPA 1978) and *In re Haas*, 580 F.2d 461, 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); and *Ex parte Hozumi*, 3 USPQ2d 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. A Markush-type claim can 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. If the Markush-type claim is not allowable over the prior art, 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 nonelected 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 *nonelected species*, the Markush-type claim shall be

rejected and claims to the nonelected species held withdrawn from further consideration. The prior art search, however, will not be extended unnecessarily to cover all nonelected 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.

### 803.03 Restriction — Transitional Applications

#### PRACTICE RE TRANSITIONAL APPLICATION

*37 CFR 1.129. Transitional procedures for limited examination after final rejection and restriction practice.*

\*\*\*\*\*

(b)(1) In an application, other than for reissue or a design patent, that has been pending for at least three years as of June 8, 1995, taking into account any reference made in the application to any earlier filed application under 35 U.S.C. 120, 121 and 365(c), no requirement for restriction or for the filing of divisional applications shall be made or maintained in the application after June 8, 1995, except where:

(i) The requirement was first made in the application or any earlier filed application under 35 U.S.C. 120, 121 and 365(c) prior to April 8, 1995;

(ii) The examiner has not made a requirement for restriction in the present or parent application prior to April 8, 1995, due to actions by the applicant; or

(iii) The required fee for examination of each additional invention was not paid.

(2) If the application contains more than one independent and distinct invention and a requirement for restriction or for the filing of divisional applications cannot be made or maintained pursuant to this paragraph, applicant will be so notified and given a time period to:

(i) Elect the invention or inventions to be searched and examined, if no election has been made prior to the notice, and pay the fee set forth in 1.17(s) for each independent and distinct invention claimed in the application in excess of one which applicant elects;

(ii) Confirm an election made prior to the notice and pay the fee set forth in § 1.17(s) for each independent and distinct invention claimed in the application in addition to the one invention which applicant previously elected; or

(iii) File a petition under this section traversing the requirement. If the required petition is filed in a timely manner, the original time period for electing and paying the fee set forth in § 1.17(s) will be deferred and any decision on the petition affirming or modifying the requirement will set a new time period to elect the invention or inventions to be searched and examined and to pay the fee set forth in § 1.17(s) for each independent and distinct invention claimed in the application in excess of one which applicant elects.

(3) The additional inventions for which the required fee has not been paid will be withdrawn from consideration under § 1.142(b). An applicant who desires examination of an invention so withdrawn from consideration can file a divisional application under 35 U.S.C. 121.

(c) The provisions of this section shall not be applicable to any application filed after June 8, 1995.

“Restriction” under 37 CFR 1.129(b) applies to both restriction requirements under 37 CFR 1.142 and election of species requirements under 37 CFR 1.146.

37 CFR 1.129(b)(1) provides for examination of more than one independent and distinct invention in certain applications pending for 3 years or longer as of June 8, 1995, taking into account any reference to any earlier application under 35 U.S.C. 120, 121, or 365(c). Applicant will not be permitted to have such additional invention(s) examined in an application if:

(A) the requirement was made in the application or in an earlier application relied on under 35 U.S.C. 120, 121, or 365(c) prior to April 8, 1995;

(B) no restriction requirement was made with respect to the invention(s) in the application or earlier application prior to April 8, 1995, due to actions by the applicant; or

(C) the required fee for examination of each additional invention was not paid.

Only if one of these exceptions applies is a normal restriction requirement appropriate and telephone restriction practice may be used.

Examples of what constitute “actions by the applicant” in 37 CFR 1.129(b)(1) are:

(A) applicant abandoned the application and continued to refile the application such that no Office action could be issued in the application,

(B) applicant requested suspension of prosecution under 37 CFR 1.103(a) such that no Office action could be issued in the application,

(C) applicant disclosed a plurality of independent and distinct inventions in the present or parent application, but delayed presenting claims to more than one of the disclosed independent and distinct inventions in the present or parent application such that no restriction requirement could be made prior to April 8, 1995, and

(D) applicant combined several applications, each of which claimed a different independent and distinct invention, into one large “continuing” application, but delayed filing the continuing application first claiming more than one independent and distinct invention such that no restriction requirement could be made prior to April 8, 1995.

In examples (A) and (B), the fact that the present or parent application claiming independent and distinct inventions was on an examiner’s docket for at least 3 months prior to abandonment or suspension, or in examples (C) and (D), the fact that the amendment claiming independent and distinct inventions was first filed, or the continuing application first claiming the additional independent and distinct inventions was on an examiner’s docket, at least 3 months prior to April 8, 1995, is *prima facie* evidence that applicant’s actions did not prevent the Office from making a requirement for restriction with respect to those independent and distinct inventions prior to April 8, 1995. Furthermore, an extension of time under 37 CFR 1.136(a) does not constitute such “actions by the applicant” under 37 CFR 1.129(b)(1).

**NOTE:** If an examiner believes an application falls under the exception that no restriction could be made prior to April 8, 1995, due to applicant’s action, the application must be brought to the attention of the Technology Center (TC) Special Program Examiner for review.

Under 37 CFR 1.129(b)(2), if the application contains claims to more than one independent and distinct invention, and no requirement for restriction or for the filing of divisional applications can be made or maintained, applicant will be notified and given a time period to:

(A) elect the invention or inventions to be searched and examined, if no election has been made prior to the notice, and pay the fee set forth in 37 CFR 1.17(s) for each independent and distinct invention claimed in the application in excess of one which applicant elects,

(B) in situations where an election was made in reply to a requirement for restriction that cannot be maintained, confirm the election made prior to the notice and pay the fee set forth in 37 CFR 1.17(s) for each independent and distinct invention claimed in the application in addition to the one invention which applicant previously elected, or

(C) file a petition under 37 CFR 1.129(b)(2) traversing the requirement without regard to whether the requirement has been made final. No petition fee is required.

37 CFR 1.129(b)(2) also provides that if the petition is filed in a timely manner, the original time period for electing and paying the fee set forth in 37 CFR 1.17(s) will be deferred and any decision on the petition affirming or modifying the requirement will set a new time period to elect the invention or inventions to be searched and examined and to pay the fee set forth in 37 CFR 1.17(s) for each independent and distinct invention claimed in the application in excess of one which applicant elects.

Under 37 CFR 1.129(b)(3), each additional invention for which the required fee set forth in 37 CFR 1.17(s) has not been paid will be withdrawn from consideration under 37 CFR 1.142(b). An applicant who desires examination of an invention so withdrawn from consideration can file a divisional application under 35 U.S.C. 121.

37 CFR 1.129(c) clarifies that the provisions of 37 CFR 1.129(a) and (b) are not applicable to any application filed after June 8, 1995. However, any application filed on June 8, 1995, would be subject to a 20-year patent term.

Form paragraph 8.41 may be used to notify applicant that the application is a transitional application and is entitled to consideration of additional inventions upon payment of the required fee.

*¶ 8.41 Transitional Restriction or Election of Species Requirement To Be Mailed After June 8, 1995*

This application is subject to the transitional restriction provisions of Public Law 103-465, which became effective on June 8, 1995, because:

1. the application was filed on or before June 8, 1995, and has an effective U.S. filing date of June 8, 1992, or earlier;
2. a requirement for restriction was not made in the present or a parent application prior to April 8, 1995; and
3. the examiner was not prevented from making a requirement for restriction in the present or a parent application prior to April 8, 1995, due to actions by the applicant.

The transitional restriction provisions permit applicant to have more than one independent and distinct invention examined in the same application by paying a fee for each invention in excess of one.

Final rules concerning the transition restriction provisions were published in the *Federal Register* at 60 FR 20195 (April 25, 1995) and in the *Official Gazette* at 1174 O.G. 15 (May 2, 1995). The final rules at 37 CFR 1.17(s) include the fee amount required to be paid for each additional invention as set forth in the following requirement for restriction. See the current fee schedule for the proper amount of the fee.

Applicant must either: (1) elect the invention or inventions to be searched and examined and pay the fee set forth in 37 CFR 1.17(s) for each independent and distinct invention in excess of one which applicant elects; or (2) file a petition under 37 CFR 1.129(b) traversing the requirement.

**Examiner Note:**

1. This form paragraph should be used in all restriction or election of species requirements made in applications subject to the transition restriction provisions set forth in 37 CFR 1.129(b) where the requirement is being mailed after June 8, 1995. The procedure is NOT applicable to any design or reissue application.

**803.03(a) Transitional Application — Linking Claim Allowable**

Whenever divided inventions in a transitional application are rejoined because a linking claim is allowed (MPEP § 809) and applicant paid the fee set forth in 37 CFR 1.17(s) for the additional invention, applicant should be notified that he or she may request a refund of the fee paid for that additional invention.

**803.03(b) Transitional Application — Generic Claim Allowable**

Whenever claims drawn to an additional species in a transitional application for which applicant paid the fee set forth in 37 CFR 1.17(s) are no longer withdrawn from consideration because they are fully embraced by an allowed generic claim, applicant should be notified that he or she may request a refund of the fee paid for that additional species.

**803.03(b)**

## MANUAL OF PATENT EXAMINING PROCEDURE

The determination of when claims to a nonelected species would no longer be withdrawn from consideration should be made as indicated in MPEP § 809.02(b), § 809.02(c), or § 809.02(d).

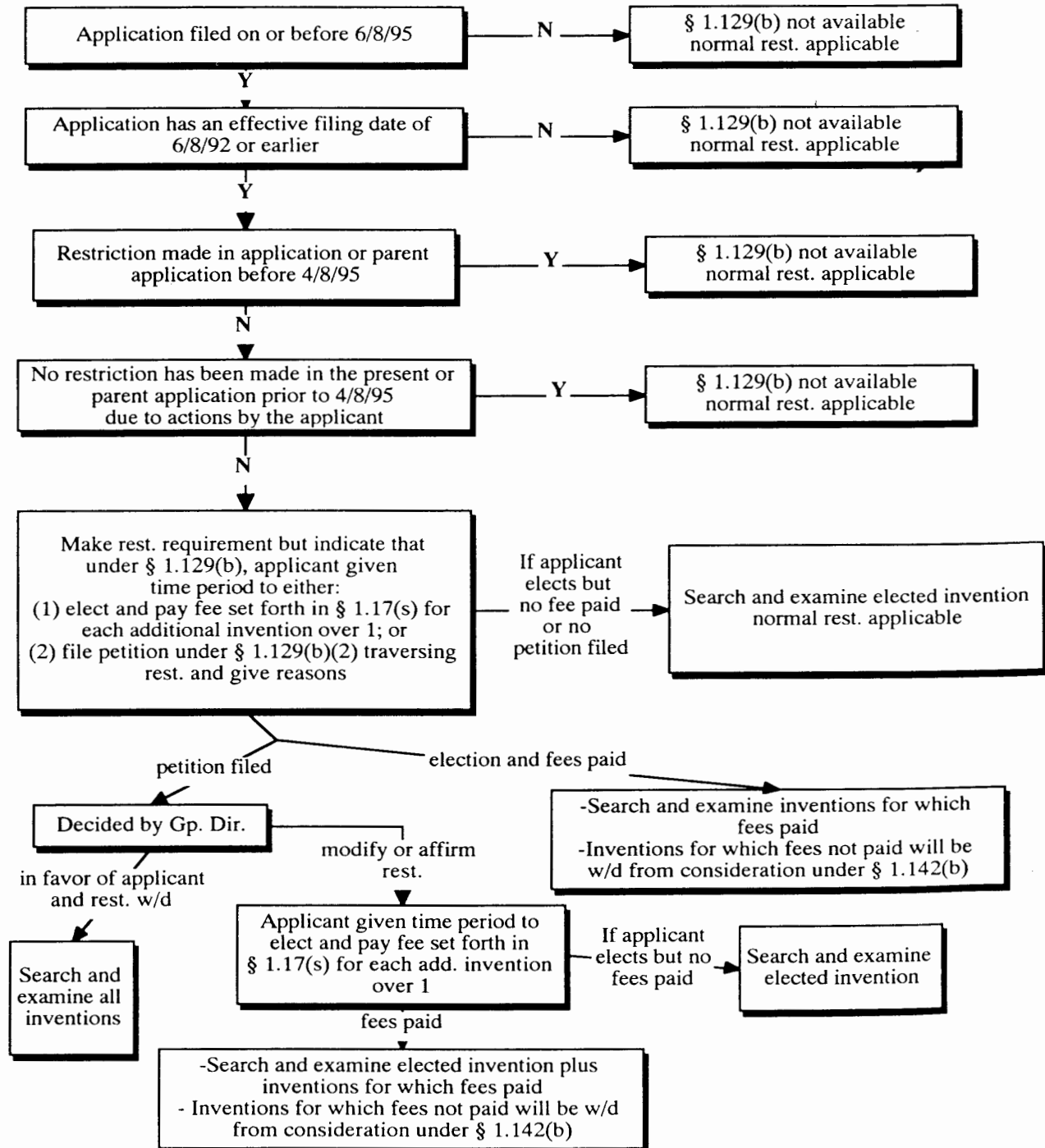


**Transitional Restriction Provision - 37 CFR 1.129(b)**

**Starting June 8, 1995**

**No Telephone restriction**

**Charge time for examination of additional inventions to 112055**



### 803.04 Restriction - Nucleotide Sequences

By statute, “[i]f 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.” 35 U.S.C. 121. Pursuant to this statute, the rules provide that “[i]f two or more independent and distinct inventions are claimed in a single application, the examiner in his action shall require the applicant . . . to elect that invention to which his claim shall be restricted.” 37 CFR 1.142(a). See also 37 CFR 1.141(a).

Nucleotide sequences encoding different proteins are structurally distinct chemical compounds and are unrelated to one another. These sequences are thus deemed to normally constitute independent and distinct inventions within the meaning of 35 U.S.C. 121. Absent evidence to the contrary, each such nucleotide sequence is presumed to represent an independent and distinct invention, subject to a restriction requirement pursuant to 35 U.S.C. 121 and 37 CFR 1.141 *et seq.* Nevertheless, to further aid the biotechnology industry in protecting its intellectual property without creating an undue burden on the Office, the Commissioner has decided *sua sponte* to partially waive the requirements of 37 CFR 1.141 *et seq.* and permit a reasonable number of such nucleotide sequences to be claimed in a single application. See *Examination of Patent Applications Containing Nucleotide Sequences*, 1192 O.G. 68 (November 19, 1996).

It has been determined that normally ten sequences constitute a reasonable number for examination purposes. Accordingly, in most cases, up to ten independent and distinct nucleotide sequences will be examined in a single application without restriction. In addition to the specifically selected sequences, those sequences which are patentably indistinct from the selected sequences will also be examined. Furthermore, nucleotide sequences encoding the same protein are not considered to be independent and distinct inventions and will continue to be examined together.

In some exceptional cases, the complex nature of the claimed material, for example a protein amino acid sequence reciting three dimensional folds, may necessitate that the reasonable number of sequences to be selected be less than ten. In other cases, applicants

may petition pursuant to 37 CFR 1.181 for examination of additional nucleotide sequences by providing evidence that the different nucleotide sequences do not cover independent and distinct inventions.

See MPEP § 1850 for treatment of claims containing independent and distinct nucleotide sequences in international applications filed under the Patent Cooperation Treaty (PCT) and national stage applications filed under 35 U.S.C. 371.

#### EXAMPLES OF NUCLEOTIDE SEQUENCE CLAIMS

Examples of typical nucleotide sequence claims impacted by the partial waiver of 37 CFR 1.141 *et seq.* (and the partial waiver of 37 CFR 1.475 and 1.499 *et seq.*, see MPEP § 1850) include:

(A) an isolated and purified DNA fragment comprising DNA having at least 95% identity to a DNA sequence selected from SEQ ID Nos. 1-1,000;

(B) a combination of DNA fragments comprising SEQ ID Nos. 1-1,000; and

(C) a combination of DNA fragments, said combination containing at least thirty different DNA fragments selected from SEQ ID Nos. 1-1,000.

Applications claiming more than ten individual independent and distinct nucleotide sequences in alternative form, such as set forth in example (A), will be subject to a restriction requirement. Only the ten nucleotide sequences selected in response to the restriction requirement and any other claimed sequences which are patentably indistinct therefrom will be examined.

Applications claiming only a combination of nucleotide sequences, such as set forth in example (B), will generally not be subject to a restriction requirement. The presence of one novel and nonobvious sequence within the combination will render the entire combination allowable. The combination will be searched until one nucleotide sequence is found to be allowable. The order of searching will be chosen by the examiner to maximize the identification of an allowable sequence. If no individual nucleotide sequence is found to be allowable, the examiner will consider whether the combination of sequences taken as a whole renders the claim allowable.

Applications containing only composition claims reciting different combinations of individual

nucleotide sequences, such as set forth in example (C), will be subject to a restriction requirement. Applicants will be required to select one combination for examination. If the selected combination contains ten or fewer sequences, all of the sequences of the combination will be searched. If the selected combination contains more than ten sequences, the combination will be examined following the procedures set forth above for example (B). More specifically, the combination will be searched until one nucleotide sequence is found to be allowable with the examiner choosing the order of search to maximize the identification of an allowable sequence. The identification of any allowable sequence(s) will cause all combinations containing the allowed sequence(s) to be allowed.

In applications containing all three claims set forth in examples (A)-(C), the Office will require restriction of the application to ten sequences for initial examination purposes. Based upon the finding of allowable sequences, claims limited to the allowable sequences as in example (A), all combinations, such as in examples (B) and (C), containing the allowable sequences and any patentably indistinct sequences will be rejoined and allowed.

Rejoinder will be permitted for claims requiring any allowable sequence(s). Any claims which have been restricted and nonselected and which are limited to the allowable sequence(s) will be rejoined and examined.

## 804 Definition of Double Patenting

### *35 U.S.C. 101. Inventions Patentable.*

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

### *35 U.S.C. 121. Divisional Applications.*

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. 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 Director may dispense with signing and execution by the inventor. The validity of a patent shall not be questioned for failure of the Director to require the application to be restricted to one invention.

The doctrine of double patenting seeks to prevent the unjustified extension of patent exclusivity beyond the term of a patent. The public policy behind this doctrine is that:

The public should . . . be able to act on the assumption that upon the expiration of the patent it will be free to use not only the invention claimed in the patent but also modifications or variants which would have been obvious to those of ordinary skill in the art at the time the invention was made, taking into account the skill in the art and prior art other than the invention claimed in the issued patent.

*In re Zickendraht*, 319 F.2d 225, 232, 138 USPQ 22, 27 (CCPA 1963) (Rich, J., concurring). Double patenting results when the right to exclude granted by a first patent is unjustly extended by the grant of a later issued patent or patents. *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982).

Before consideration can be given to the issue of double patenting, there must be some common relationship of inventorship and/or ownership of two or more patents or applications. Since the doctrine of double patenting seeks to avoid unjustly extending patent rights at the expense of the public, the focus of any double patenting analysis necessarily is on the claims in the multiple patents or patent applications involved in the analysis.

There are generally 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". The second is the "nonstatutory-type" double patenting rejection based on a judicially created doctrine grounded in public policy and which 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. Nonstatutory double patenting includes rejections based on one-way determination of obviousness and on two-way determination of obviousness. Nonstatutory double patenting could include a rejection which is not the usual "obviousness-type" double patenting rejection. This type of double patenting rejection is rare and is limited to the particular facts of the case. *In re*

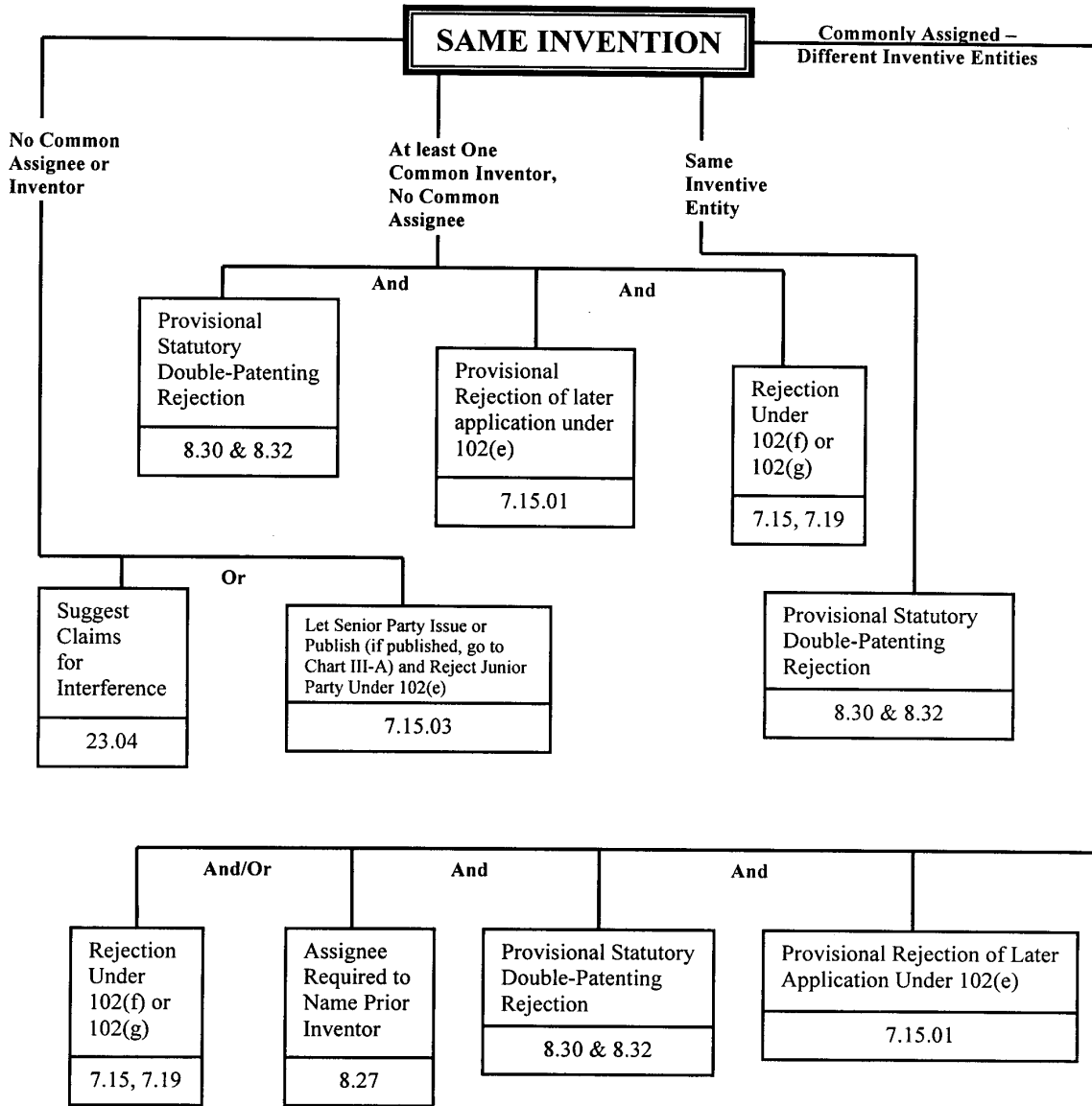
*Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968).

Refer to Charts I-A, I-B, II-A, II-B, III-A, and III-B for an overview of the treatment of applications

having conflicting claims (e.g., where a claim in an application is not patentably distinct from a claim in a patent or another application).

**CONFLICTING CLAIMS BETWEEN:  
TWO APPLICATIONS \***

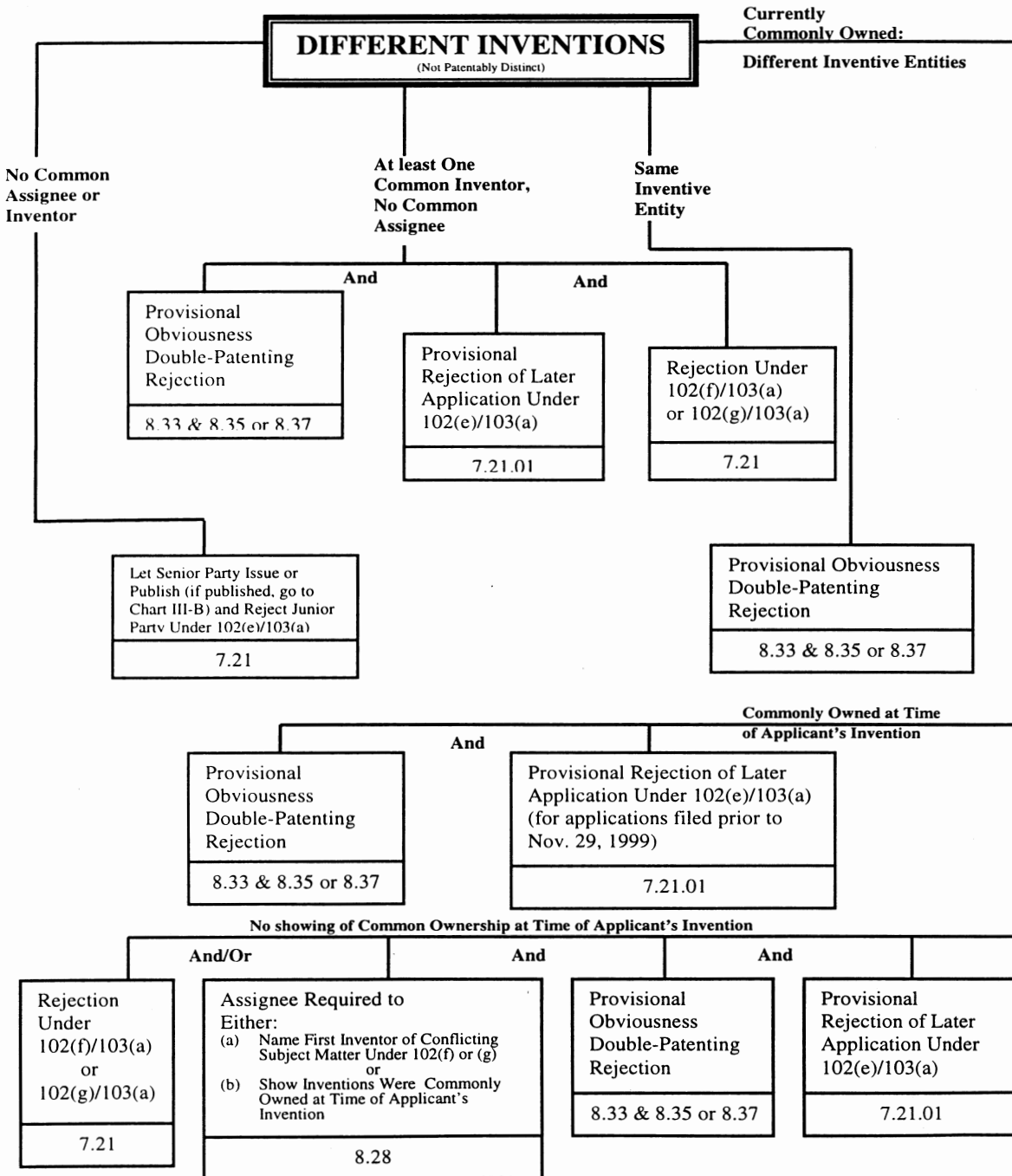
CHART I-A



\* This chart applies where the application being applied as a reference has NOT been published.

**CONFLICTING CLAIMS BETWEEN:  
TWO APPLICATIONS \***

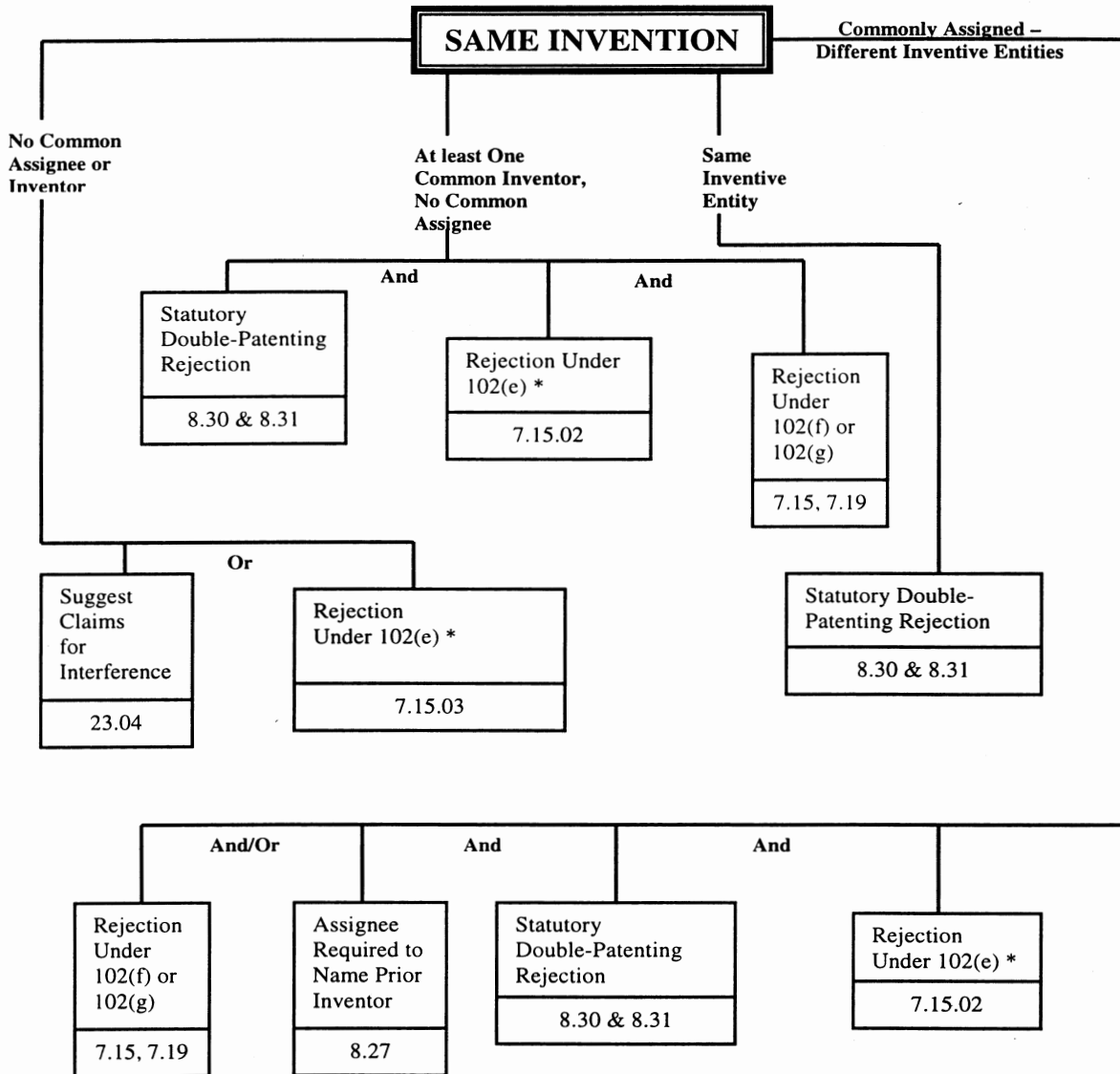
**CHART I-B**



\* This chart applies where the application being applied as a reference has NOT been published.

**CONFLICTING CLAIMS BETWEEN:  
APPLICATION AND A PATENT**

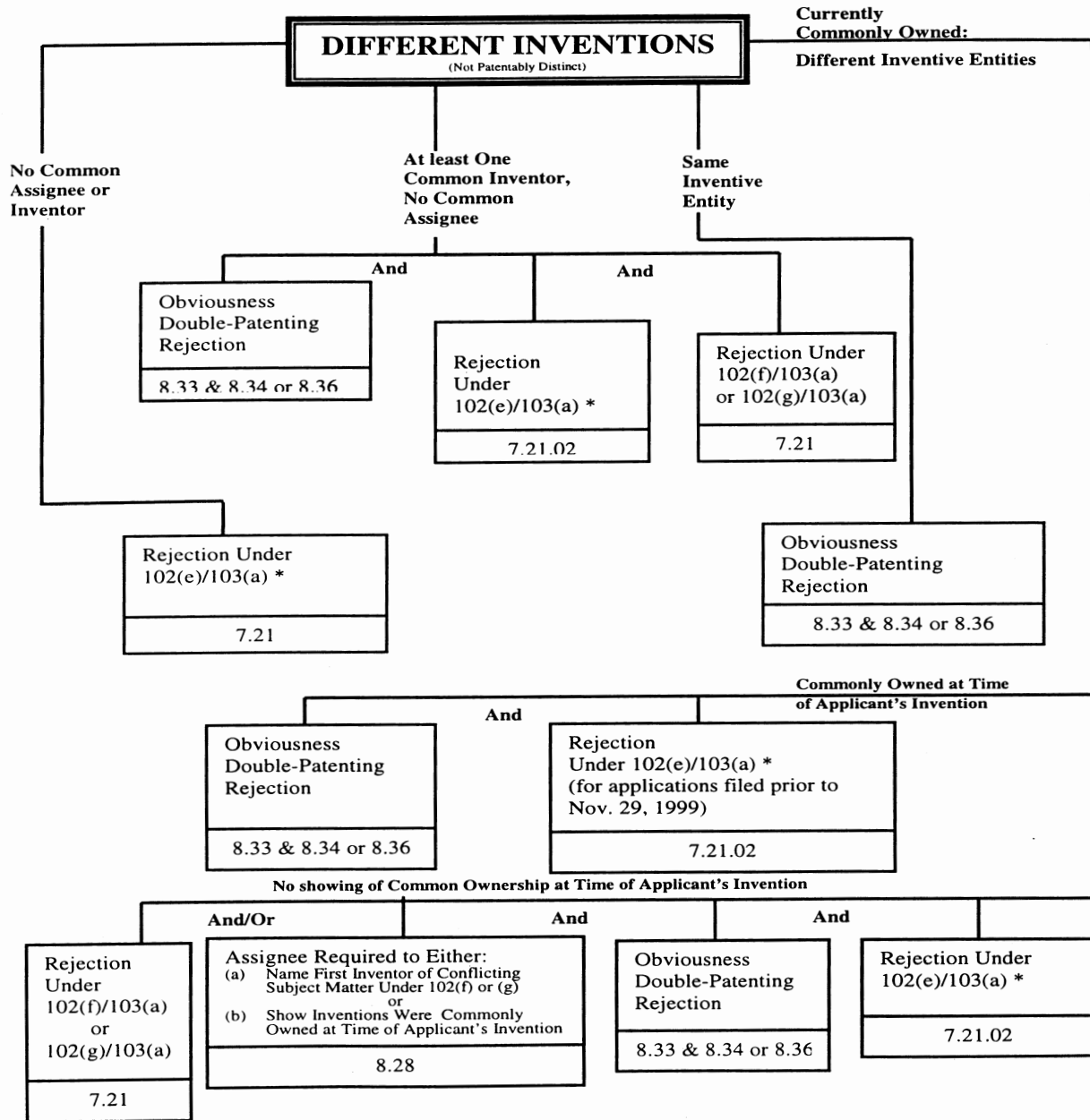
CHART II-A



\* A rejection under 35 U.S.C. 102(e) would NOT be appropriate where the application being examined was filed on or after Nov. 29, 2000 or filed prior to Nov. 29, 2000 and voluntarily published, and the reference patent issued from an international application (reference patent has no 102(e) prior art effect).

**CONFLICTING CLAIMS BETWEEN:  
APPLICATION AND A PATENT**

**CHART II-B**

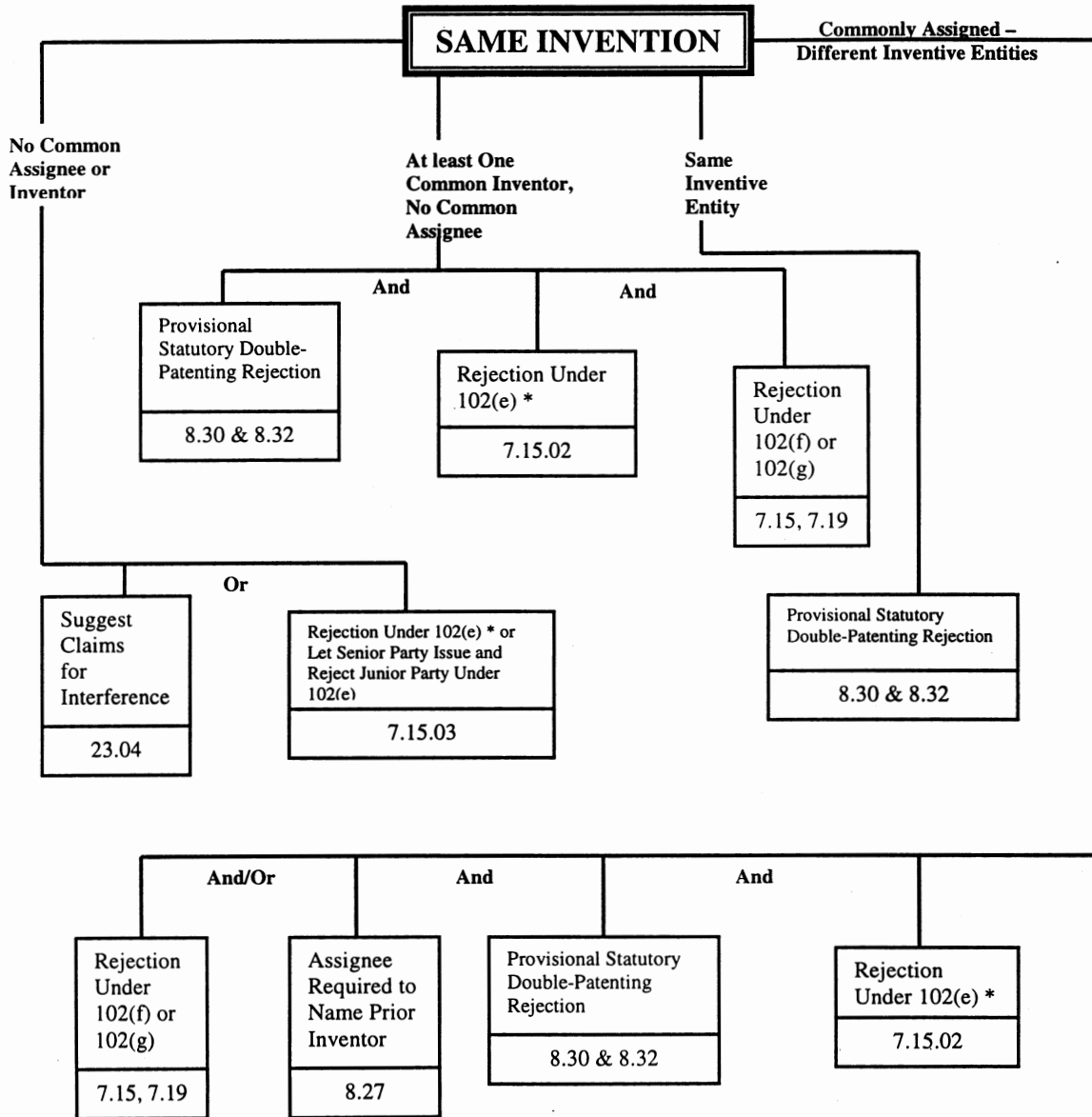


\*The reference patent would NOT be prior art under 35 U.S.C. 102(e) where the patent issued from an international application and the application being examined was filed on or after Nov. 29, 2000 or filed prior to Nov. 29, 2000 and voluntarily published.



**CONFLICTING CLAIMS BETWEEN:  
APPLICATION AND A PUBLISHED  
APPLICATION**

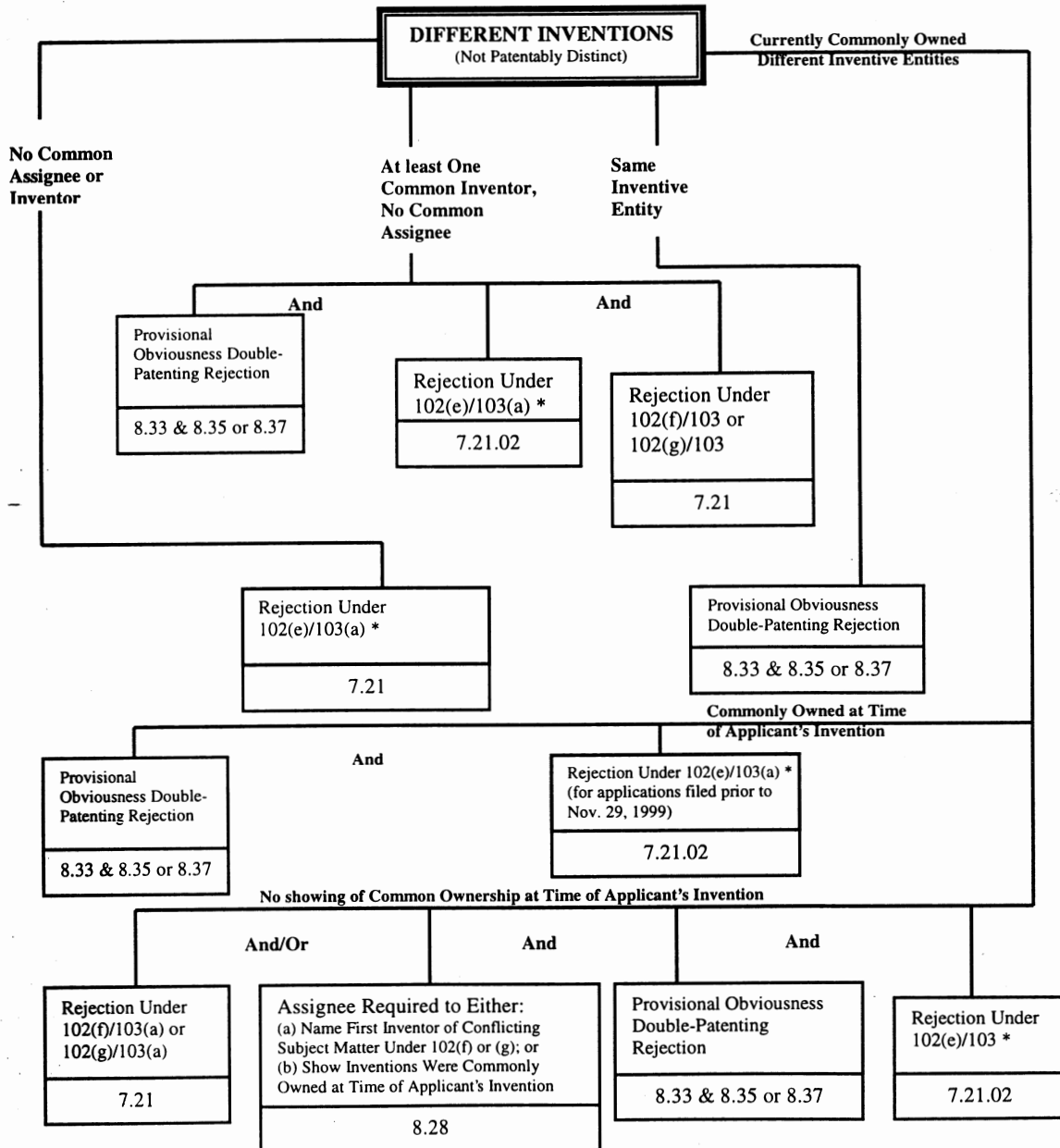
CHART III-A



\* Apply 35 U.S.C. 102(e) rejection if the application being examined was filed on or after Nov. 29, 2000 or filed prior to Nov. 29, 2000 and voluntarily published, otherwise, apply rejection under 35 U.S.C. 102(a) or (b), where appropriate and make a "provisional" rejection of the later application under 35 U.S.C. 102(e) using form paragraph 7.15.01.

**CONFLICTING CLAIMS BETWEEN:  
APPLICATION AND A PUBLISHED  
APPLICATION**

CHART III-B



\* Apply 35 U.S.C. 102(e)/103(a) rejection if the application being examined was filed on or after Nov. 29, 2000 or filed prior to Nov. 29, 2000 and voluntarily published, otherwise, apply rejection under 35 U.S.C. 102(a)/103(a) or 102(b)/103(a), where appropriate and make a "provisional" rejection of the later application under 35 U.S.C. 102(e)/103(a) using form paragraph 7.21.01.

## **I. INSTANCES WHERE DOUBLE PATENTING ISSUE CAN BE RAISED**

A double patenting issue may arise between two or more pending applications, between one or more pending applications and a patent, or between one or more pending applications and a published application. A double patenting issue may likewise arise in a reexamination proceeding between the patent claims being reexamined and the claims of one or more applications and/or patents. Double patenting does not relate to international applications which have not yet entered the national stage in the United States.

### **A. *Between Issued Patent and One or More Applications***

Double patenting may exist between an issued patent and an application filed by the same inventive entity, or by an inventive entity having a common inventor with the patent, and/or by the owner of the patent. Since the inventor/patent owner has already secured the issuance of a first patent, the examiner must determine whether the grant of a second patent would give rise to an unjustified extension of the rights granted in the first patent.

### **B. *Between Copending Applications—Provisional Rejections***

Occasionally, the examiner becomes aware of two copending applications filed by the same inventive entity, or by different inventive entities having a common inventor, and/or by a common assignee that would raise an issue of double patenting if one of the applications became a patent. Where this issue can be addressed without violating the confidential status of applications (35 U.S.C. 122), the courts have sanctioned the practice of making applicant aware of the potential double patenting problem if one of the applications became a patent by permitting the examiner to make a “provisional” rejection on the ground of double patenting. *In re Mott*, 539 F.2d 1291, 190 USPQ 536 (CCPA 1976); *In re Wetterau*, 356 F.2d 556, 148 USPQ 499 (CCPA 1966). The merits of such a provisional rejection can be addressed by both the applicant and the examiner without waiting for the first patent to issue.

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.

If the “provisional” double patenting rejections in both applications are the only rejections remaining in those applications, the examiner should then withdraw that rejection in one of the applications (e.g., the application with the earlier filing date) 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.

### **C. *Between One or More Applications and a Published Application - Provisional Rejections***

Double patenting may exist between a published patent application and an application filed by the same inventive entity, or by different inventive entities having a common inventor, and/or by a common assignee. Since the published application has not yet issued as a patent, the examiner is permitted to make a “provisional” rejection on the ground of double patenting. See the discussion regarding “provisional” double patenting rejection in subsection B. above.

### **D. *Reexamination Proceedings***

A double patenting issue may raise a substantial new question of patentability of a claim of a patent, and thus be addressed in a reexamination proceeding. *In re Lonardo*, 119 F.3d 960, 966, 43 USPQ2d 1262, 1266 (Fed. Cir. 1997) (In giving the Commissioner authority under 35 U.S.C. 303(a) in determining the presence of a substantial new question of patentability, “Congress intended that the phrases ‘patents and publications’ and ‘other patents or publications’ in section 303(a) not be limited to *prior art* patents or printed publications.” (emphasis added)). Accordingly, if the issue of double patenting was not

addressed during original prosecution, it may be considered during reexamination.

## II. REQUIREMENTS OF A DOUBLE PATENTING REJECTION (INCLUDING PROVISIONAL REJECTIONS)

When a double patenting rejection is appropriate, it must be based either on statutory grounds or nonstatutory grounds. The ground of rejection employed depends upon the relationship of the inventions being claimed. Generally, a double patenting rejection is not permitted where the claimed subject matter is presented in a divisional application as a result of a restriction requirement made in a parent application under 35 U.S.C. 121.

Where the claims of an application are substantively the same as those of a first patent, they are barred under 35 U.S.C. 101 - the statutory basis for a double patenting rejection. A rejection based on double patenting of the “same invention” type finds its support in the language of 35 U.S.C. 101 which states that “whoever invents or discovers any new and useful process ... may obtain a patent therefor ....” Thus, the term “same invention,” in this context, means an invention drawn to identical subject matter. *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957). Where the claims of an application are not the “same” as those of a first patent, but the grant of a patent with the claims in the application would unjustly extend the rights granted by the first patent, a double patenting rejection under nonstatutory grounds is proper.

In determining whether a proper basis exists to enter a double patenting rejection, the examiner must determine the following:

(A) Whether a double patenting rejection is prohibited by the third sentence of 35 U.S.C. 121 (see MPEP § 804.01; if such a prohibition applies, a double patenting rejection cannot be made);

(B) Whether a statutory basis exists; and

(C) Whether a nonstatutory basis exists.

Each determination must be made on the basis of all the facts in the application before the examiner. Charts I-A, I-B, II-A, II-B, III-A, and III-B illustrate the methodology of making such a determination.

Domination and double patenting should not be confused. They are two separate issues. One patent or application “dominates” a second patent or application when the first patent or application has a broad or generic claim which fully encompasses or reads on an invention defined in a narrower or more specific claim in another patent or application. Domination by itself, i.e., in the absence of statutory or nonstatutory double patenting grounds, cannot support a double patenting rejection. *In re Kaplan*, 789 F.2d 1574, 1577-78, 229 USPQ 678, 681 (Fed. Cir. 1986); and *In re Sarrett*, 327 F.2d 1005, 1014-15, 140 USPQ 474, 482 (CCPA 1964). However, the presence of domination does not preclude double patenting. See, e.g., *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968).

### A. Statutory Double Patenting — 35 U.S.C. 101

In determining whether a statutory basis for a double patenting rejection exists, the question to be asked is: Is the same invention being claimed twice? 35 U.S.C. 101 prevents two patents from issuing on the same invention. “Same invention” means identical subject matter. *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957).

A reliable test for double patenting under 35 U.S.C. 101 is whether a claim in the application could be literally infringed without literally infringing a corresponding claim in the patent. *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970). Is there an embodiment of the invention that falls within the scope of one claim, but not the other? If there is such an embodiment, then identical subject matter is not defined by both claims and statutory double patenting would not exist. For example, the invention defined by a claim reciting a compound having a “halogen” substituent is not identical to or substantively the same as a claim reciting the same compound except having a “chlorine” substituent in place of the halogen because “halogen” is broader than “chlorine.” On the other hand, claims may be differently worded and still define the same invention. Thus, a claim reciting a widget having a length of “36 inches” defines the same invention as a claim reciting the same widget having a length of “3 feet.”

If it is determined that the same invention is being claimed twice, 35 U.S.C. 101 precludes the grant of the second patent regardless of the presence or absence of a terminal disclaimer. *Id.*

Form paragraphs 8.30 and 8.31 (between an issued patent and one or more applications) or 8.32 (provisional rejections) may be used to make statutory double patenting rejections.

¶ 8.30 35 U.S.C. 101, Statutory Basis for Double Patenting “Heading” Only

A rejection based on double patenting of the “same invention” type finds its support in the language of 35 U.S.C. 101 which states that “whoever invents or discovers any new and useful process... may obtain a patent therefor...” (Emphasis added). Thus, the term “same invention,” in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

**Examiner Note:**

The above form paragraph must be used as a heading for all subsequent double patenting rejections of the statutory (same invention) type using either of form paragraphs 8.31 or 8.32.

¶ 8.31 Rejection, 35 U.S.C. 101, Double Patenting

Claim [1] rejected under 35 U.S.C. 101 as claiming the same invention as that of claim [2] of prior U.S. Patent No. [3]. This is a double patenting rejection.

**Examiner Note:**

1. This paragraph must be preceded by form paragraph 8.30 and is used only for double patenting rejections of the same invention claimed in an earlier patent; that is, the “scope” of the inventions claimed is identical.
2. If the conflicting claims are in another copending application, do not use this paragraph. A provisional double patenting rejection should be made using paragraph 8.32.
3. Do not use this paragraph for non-statutory-type double patenting rejections. If non-statutory type, use appropriate form paragraphs 8.33 to 8.39.
4. This paragraph may be used where the conflicting patent and the pending application are:
  - (a) by the same inventive entity, or
  - (b) by a different inventive entity and are commonly assigned even though there is no common inventor, or
  - (c) not commonly assigned but have at least one common inventor.
5. In bracket 3, insert the number of the conflicting patent.

6. If the patent is to a different inventive entity and is commonly assigned with the application, paragraph 8.27 should additionally be used to require the assignee to name the first inventor.

7. If evidence is of record to indicate that the patent is prior art under either 35 U.S.C. 102(f) or (g), a rejection should also be made using paragraphs 7.15 and/or 7.19 in addition to this double patenting rejection.

8. If the patent is to a different inventive entity from the application and the effective U.S. filing date of the patent antedates the effective filing date of the application, a rejection under 35 U.S.C. 102(e) should additionally be made using form paragraph 7.15.02.

¶ 8.32 Provisional Rejection, 35 U.S.C. 101, Double Patenting

Claim [1] provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claim [2] of copending Application No. [3]. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

**Examiner Note:**

1. This paragraph must be preceded by form paragraph 8.30 and is used only for double patenting rejections of the same invention claimed in another copending application; that is, the scope of the claimed inventions is identical.
2. If the conflicting claims are from an issued patent, do not use this paragraph. See paragraph 8.31.
3. Do not use this paragraph for non-statutory-type double patenting rejections. See paragraphs 8.33 to 8.39.
4. 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 even though there is no common inventor, or
  - (c) not commonly assigned but has at least one common inventor.
5. Paragraph 8.28 may be used in place of or along with this paragraph to resolve any remaining issues relating to priority under 35 U.S.C. 102(f) 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 conflicting application.
8. If the copending application is by a different inventive entity and is commonly assigned, paragraph 8.27 should additionally be used to require the assignee to name the first inventor.
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 (g), a rejection should also be made in the other application using paragraphs 7.15 and/or 7.19 in addition to this provisional double patenting rejection.
10. If the applications do not have the same inventive entity and effective U.S. filing date, a provisional 102(e) rejection should additionally be made in the later-filed application using paragraph 7.15.01.

If the “same invention” is not being claimed twice, an analysis must be made to determine whether a non-statutory basis for double patenting exists.

## B. Nonstatutory Double Patenting

A rejection based on nonstatutory double patenting is based on a judicially created doctrine grounded in public policy so as to prevent the unjustified or improper timewise extension of the right to exclude granted by a patent. *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969); *In re White*, 405 F.2d 904, 160 USPQ 417 (CCPA 1969); *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968); *In re Sarett*, 327 F.2d 1005, 140 USPQ 474 (CCPA 1964).

### 1. Obviousness-Type

In determining whether a nonstatutory basis exists for a double patenting rejection, the first question to be asked is — does any claim in the application define an invention that is merely an obvious variation of an invention claimed in the patent? If the answer is yes, then an “obviousness-type” nonstatutory double patenting rejection may be appropriate. Obviousness-type double patenting requires rejection of an application claim when the claimed subject matter is **not patentably distinct** from the subject matter claimed in a commonly owned patent when the issuance of a second patent would provide unjustified extension of the term of the right to exclude granted by a patent. See *Eli Lilly & Co. v. Barr Labs., Inc.*, 251 F.3d 955, 58 USPQ2d 1865 (Fed. Cir. 2001); *Ex parte Davis*, 56 USPQ2d 1434, 1435-36 (Bd. Pat. App. & Inter. 2000).

A double patenting rejection of the obviousness-type is “analogous to [a failure to meet] the nonobviousness requirement of 35 U.S.C. 103” except that the patent principally underlying the double patenting rejection is not considered prior art. *In re Braithwaite*, 379 F.2d 594, 154 USPQ 29 (CCPA 1967). Therefore, any analysis employed in an obviousness-type double patenting rejection parallels the guidelines for analysis of a 35 U.S.C. 103 obviousness determination. *In re Braat*, 937 F.2d 589, 19 USPQ2d 1289 (Fed. Cir. 1991); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985).

Since the analysis employed in an obviousness-type double patenting determination parallels the guide-

lines for a 35 U.S.C. 103(a) rejection, the factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103 are employed when making an obvious-type double patenting analysis. These factual inquiries are summarized as follows:

(A) Determine the scope and content of a patent claim and the prior art relative to a claim in the application at issue;

(B) Determine the differences between the scope and content of the patent claim and the prior art as determined in (A) and the claim in the application at issue;

(C) Determine the level of ordinary skill in the pertinent art; and

(D) Evaluate any objective indicia of nonobviousness.

The conclusion of obviousness-type double patenting is made in light of these factual determinations.

Any obviousness-type double patenting rejection should make clear:

(A) The differences between the inventions defined by the conflicting claims — a claim in the patent compared to a claim in the application; and

(B) The reasons why a person of ordinary skill in the art would conclude that the invention defined in the claim in issue is an obvious variation of the invention defined in a claim in the patent.

When considering whether the invention defined in a claim of an application is an obvious variation of the invention defined in the claim of a patent, the disclosure of the patent may not be used as prior art. This does not mean that one is precluded from all use of the patent disclosure.

The specification can always be used as a dictionary to learn the meaning of a term in the patent claim. *In re Boylan*, 392 F.2d 1017, 157 USPQ 370 (CCPA 1968). Further, those portions of the specification which provide support for the patent claims may also be examined and considered when addressing the issue of whether a claim in the application defines an obvious variation of an invention claimed in the patent. *In re Vogel*, 422 F.2d 438, 441-42, 164 USPQ 619, 622 (CCPA 1970). The court in *Vogel* recognized “that it is most difficult, if not meaning-

less, to try to say what is or is not an obvious variation of a claim,” but that one can judge whether or not the invention claimed in an application is an obvious variation of an embodiment disclosed in the patent which provides support for the patent claim. According to the court, one must first “determine how much of the patent disclosure pertains to the invention claimed in the patent” because only “[t]his portion of the specification supports the patent claims and may be considered.” The court pointed out that “this use of the disclosure is not in contravention of the cases forbidding its use as prior art, nor is it applying the patent as a reference under 35 U.S.C. 103, since only the disclosure of the invention claimed in the patent may be examined.”

#### (a) One-Way Obviousness

If the application at issue is the later filed application or both are filed on the same day, only a one-way determination of obviousness is needed in resolving the issue of double patenting, i.e., whether the invention defined in a claim in the application is an obvious variation of the invention defined in a claim in the patent. See, e.g., *In re Berg*, 46 USPQ2d 1226 (Fed. Cir. 1998) (the court applied a one-way test where both applications were filed the same day). If a claimed invention in the application is obvious over a claimed invention in the patent, there would be an unjustified timewise extension of the patent and an obvious-type double patenting rejection is proper. Unless a claimed invention in the application is obvious over a claimed invention in the patent, no double patenting rejection of the obvious-type should be made, but this does not necessarily preclude a rejection based on another type of nonstatutory double patenting (see MPEP § 804, paragraph II.B.2. below).

Similarly, even if the application at issue is the earlier filed application, only a one-way determination of obviousness is needed to support a double patenting rejection in the absence of a finding of: (A) administrative delay on the part of the Office causing delay in prosecution of the earlier filed application; and (B) applicant could not have filed the conflicting claims in a single (i.e., the earlier filed) application. See MPEP § 804, paragraph II.B.1.(b) below.

Form paragraph 8.33 and the appropriate one of form paragraphs 8.34 - 8.37 may be used to make nonstatutory rejections of the obvious-type.

#### (b) Two-Way Obviousness

If the patent is the later filed application, the question of whether the timewise extension of the right to exclude granted by a patent is justified or unjustified must be addressed. A two-way test is to be applied only when the applicant could not have filed the claims in a single application *and* there is administrative delay. *In re Berg*, 46 USPQ2d 1226 (Fed. Cir. 1998) (“The two-way exception can only apply when the applicant could not avoid separate filings, and even then, only if the PTO controlled the rates of prosecution to cause the later filed species claims to issue before the claims for a genus in an earlier application . . . In *Berg*'s case, the two applications could have been filed as one, so it is irrelevant to our disposition who actually controlled the respective rates of prosecution.”). In the absence of administrative delay, a one-way test is appropriate. *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993) (applicant's voluntary decision to obtain early issuance of claims directed to a species and to pursue prosecution of previously rejected genus claims in a continuation is a considered election to postpone by the applicant and not administrative delay). Unless the record clearly shows administrative delay by the Office and that applicant could not have avoided filing separate applications, the examiner may use the one-way obviousness determination and shift the burden to applicant to show why a two-way obviousness determination is required.

When making a two-way obviousness determination where appropriate, it is necessary to apply the *Graham* obviousness analysis twice, once with the application claims as the claims in issue, and once with the patent claims as the claims in issue. Where a two-way obviousness determination is required, an obvious-type double patenting rejection is appropriate only where each analysis compels a conclusion that the invention defined in the claims in issue is an obvious variation of the invention defined in a claim in the other application/patent. If either analysis does not compel a conclusion of obviousness, no double patenting rejection of the obvious-type is made, but this does not necessarily preclude a nonstatutory double patenting rejection based on the fundamental reason to prevent unjustified timewise extension of the right to exclude granted by a patent. *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968).

Although a delay in the processing of applications before the Office that would cause patents to issue in an order different from the order in which the applications were filed is a factor to be considered in determining whether a one-way or two-way obviousness determination is necessary to support a double patenting rejection, it may be very difficult to assess whether an applicant or the administrative process is primarily responsible for a delay in the issuance of a patent. On the one hand, it is applicant who presents claims for examination and pays the issue fee. On the other hand, the resolution of legitimate differences of opinion that must be resolved in an appeal process or the time spent in an interference proceeding can significantly delay the issuance of a patent. Nevertheless, the reasons for the delay in issuing a patent have been considered in assessing the propriety of a double patenting rejection. Thus, in *Pierce v. Allen B. DuMont Laboratories, Inc.*, 297 F.2d 323, 131 USPQ 340 (3d Cir. 1961), the court found that administrative delay may justify the extension of patent rights beyond 17 years but “a considered election to postpone acquisition of the broader [patent after the issuance of the later filed application] should not be tolerated.” In *Pierce*, the patentee elected to participate in an interference proceeding [after all claims in the application had been determined to be patentable] whereby the issuance of the broader patent was delayed by more than 7 years after the issuance of the narrower patent. The court determined that the second issued patent was invalid on the ground of double patenting. Similarly, in *In re Emert*, 124 F.3d 1458, 44 USPQ2d 1149 (Fed. Cir. 1997), the court found that the one-way test is appropriate where applicants, rather than the Office, had significant control over the rate of prosecution of the application at issue. In support of its finding that the applicants were responsible for delaying prosecution of the application during the critical period, the court noted that the applicants had requested and received numerous time extensions in various filings. More importantly, the court noted, after initially receiving an obviousness rejection of all claims, applicants had waited the maximum period to reply (6 months), then abandoned the application in favor of a substantially identical continuation application, then received another obviousness rejection of all claims, again waited the maximum period to reply, and then again abandoned the application in favor of a second

continuation application substantially identical to the original filing. On the other hand, in *General Foods Corp. v. Studiengesellschaft Kohle mbH*, 972 F.2d 1272, 23 USPQ2d 1839 (Fed. Cir. 1992), the court elected not to hold the patentee accountable for a delay in issuing the first filed application until after the second filed application issued as a patent, even where the patentee had intentionally refiled the first filed application as a continuation-in-part after receiving a Notice of Allowance indicating that all claims presented were patentable. Similarly, where, through no fault of the applicant, the claims in a later filed application issue first, an obvious-type double patenting rejection is improper, in the absence of a two-way obviousness determination, because the applicant does not have complete control over the rate of progress of a patent application through the Office. In *re Braat*, 937 F.2d 589, 19 USPQ2d 1289 (Fed. Cir. 1991). While acknowledging that allowance of the claims in the earlier filed application would result in the timewise extension of an invention claimed in the patent, the court was of the view that the extension was justified under the circumstances in this case, indicating that a double patenting rejection would be proper only if the claimed inventions were obvious over each other — a two-way obviousness determination.

Form paragraph 8.33 and the appropriate one of form paragraphs 8.34-8.37 may be used to make non-statutory rejections of the obvious type.

¶ 8.33 *Basis for Nonstatutory Double Patenting, “Heading” Only*

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).



**Examiner Note:**

This form paragraph is to be used as a heading before a non-statutory double patenting rejection using any of form paragraphs 8.34 - 8.39.

*¶ 8.34 Rejection, Obviousness Type Double Patenting - No Secondary Reference(s)*

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 patentable 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 upon another application, do not use this paragraph. A provisional double patenting rejection should be made using form paragraphs 8.33 and 8.35 or 8.37.
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 even though there is no common inventor, or
  - (c) not commonly assigned but has at least one inventor in common.
4. Form paragraph 8.33 must precede any one of paragraphs 8.34 to 8.39 and must be used only ONCE in an Office action.
5. In bracket 3, insert the number of the patent.
6. If evidence indicates that the conflicting patent is prior art under 35 U.S.C. 102(f) or (g), a rejection should additionally be made under 102(f)/103(a) or 102(g)/103(a) using 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)/103(a) may be made using form paragraph 7.21.02. For applications filed on or after November 29, 1999, rejections under 35 U.S.C. 102(e)/103(a) should not be made or maintained if the applicant provides evidence that the subject matter of the reference and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.
8. In bracket 4, provide appropriate rationale of obviousness for any claims being rejected over the claims of the cited patent.

*¶ 8.35 Provisional Rejection, Obviousness Type Double Patenting - No Secondary Reference(s)*

Claim [1] provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim [2] of copending Application 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 paragraph. Use form paragraphs 8.33 and 8.34.

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) is commonly assigned even though there is no common inventor, or
- (c) not commonly assigned but has at least one common inventor.

4. Form paragraph 8.33 must precede any one of paragraphs 8.34 to 8.39 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 conflicting application.

8. If evidence shows that either application is prior art unto the other under 35 U.S.C. 102(f) or (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 in the other application under 35 U.S.C. 102(f)/103(a) or 102(g)/103(a) using 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 paragraph 7.21.01 to additionally make a rejection under 35 U.S.C. 102(e)/103(a) rejection in the other application. For applications filed on or after November 29, 1999, rejections under 35 U.S.C. 102(e)/103(a) should not be made or maintained if the applicant provides evidence that the subject matter of the reference and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

10. In bracket 4, provide appropriate rationale for obviousness of claims being rejected over the claims of the cited patent.

*¶ 8.36 Rejection, Obviousness Type Double Patenting - With Secondary Reference(s)*

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]. [5]

**Examiner Note:**

1. This 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 paragraph. A provisional obviousness-type double patenting rejection should be made using form paragraphs 8.33 and 8.35 or 8.37.
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 even though there is no common inventor, or

- (c) not commonly assigned but has at least one common inventor.
4. Form paragraph 8.33 must precede any one of paragraphs 8.34 to 8.39 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. In bracket 5, insert an explanation of the obviousness-type rejection.
  8. If evidence shows that the conflicting patent is prior art under 35 U.S.C. 102(f) or (g), a rejection should additionally be made under 35 U.S.C. 102(f)/103(a) or 102(g)/103(a) using 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)/103(a) may be made using paragraphs 7.15.02 or 7.21.02. For applications filed on or after November 29, 1999, rejections under 35 U.S.C. 102(e)/103(a) should not be made or maintained if the applicant provides evidence that the subject matter of the reference and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

¶ 8.37 *Provisional Rejection, Obviousness Type Double Patenting - With Secondary Reference(s)*

Claim [1] provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim [2] of copending Application No. [3] in view of [4]. [5]

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 paragraph, use form paragraph 8.34.
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) is commonly assigned even though there is no common inventor, or
  - (c) not commonly assigned but has at least one common inventor.
4. Form paragraph 8.33 must precede any one of paragraphs 8.34 to 8.39 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 relating to priority under 102(f) and/or (g).
6. In bracket 3, insert the number of the conflicting application.
7. In bracket 4, insert the secondary reference.
8. In bracket 5, insert an explanation of the obviousness-type rejection.
9. A provisional double patenting rejection should also be made in the conflicting application.

10. If evidence shows that either application is prior art unto the other under 35 U.S.C. 102(f) or (g) and the copending application has not been disqualified as prior art in a 35 U.S.C. 103(a) rejection based on common ownership, a rejection should additionally be made under 35 U.S.C. 102(f)/103(a) or 102(g)/103(a) using paragraph 7.21.

11. 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 paragraph 7.21.01 to additionally make a rejection under 35 U.S.C. 102(e)/103(a). For applications filed on or after November 29, 1999, rejections under 35 U.S.C. 102(e)/103(a) should not be made or maintained if the applicant provides evidence that the subject matter of the reference and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

**2. Another Type of Nonstatutory Double Patenting Rejection**

There are some unique circumstances where it has been recognized that another type of nonstatutory double patenting rejection is applicable even where the inventions claimed in two or more applications/patents are considered nonobvious over each other. These circumstances are illustrated by the facts before the court in *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). In affirming the double patenting rejection, the court summed up the situation:

in appellant's own terms: The combination ABC was old. He made two improvements on it, (1) adding X and (2) adding Y, the result still being a unitary clip of enhanced utility. While his invention can be practiced in the forms ABCX or ABCY, the greatest advantage and best mode of practicing the invention as disclosed is obtained by using both inventions in the combination ABCXY. His first application disclosed ABCXY and other matters. He obtained a patent claiming [a clip comprising] BCX and ABCX, . . . so claiming these combinations as to cover them *no matter what other feature is incorporated in them*, thus *covering effectively ABCXY*. He now, many years later, seeks more claims directed to ABCY *and ABCXY*. Thus, protection he already had would be extended, albeit in somewhat different form, for several years beyond the expiration of his patent, were we to reverse.

397 F.2d at 355-56, 158 USPQ at 216 (emphasis in original).

The court recognized that "there is no double patenting in the sense of claiming the same invention because ABCX and ABCY are, in the technical patent law sense, different inventions. The rule against 'double patenting,' however, is not so circumscribed. The

fundamental reason for the rule is *prevent unjustified timewise extension of the right to exclude* granted by a patent no matter how the extension is brought about. To . . . prevail here, appellant has the burden of establishing that the invention claimed in his patent is ‘independent and distinct’ from the invention of the appealed claims...appellant has clearly not established the independent and distinct character of the inventions of the appealed claims.” 397 F.2d at 354-55, 158 USPQ at 214-15 (emphasis in original). The court observed:

The controlling fact is that patent protection for the clips, fully disclosed in and covered by the claims of the patent, would be extended by allowance of the appealed claims. Under the circumstance of the instant case, wherein we find no valid excuse or mitigating circumstances making it either reasonable or equitable to make an exception, and wherein there is no terminal disclaimer, the rule against “double patenting” must be applied.

397 F.2d at 355, 158 USPQ at 215.

The decision in *In re Schneller* did not establish a rule of general application and thus is limited to the particular set of facts set forth in that decision. The court in *Schneller* cautioned “against the tendency to freeze into rules of general application what, at best, are statements applicable to particular fact situations.” *Schneller*, 397 F.2d at 355, 158 USPQ at 215. Non-statutory double patenting rejections based on *Schneller* **will be rare**. The Technology Center (TC) Director must approve any nonstatutory double patenting rejections based on *Schneller*. If an examiner determines that a double patenting rejection based on *Schneller* is appropriate in his or her application, the examiner should first consult with his or her supervisory patent examiner (SPE). If the SPE agrees with the examiner then approval of the TC Director must be obtained before such a nonstatutory double patenting rejection can be made.

A fact situation similar to that in *Schneller* was presented to a Federal Circuit panel in *In re Kaplan*, 789 F.2d 1574, 229 USPQ 678 (Fed. Cir. 1986). Kaplan had been issued a patent on a process of making chemicals in the presence of an organic solvent. Among the organic solvents disclosed and claimed as being useful were tetraglyme and sulfolane. One unclaimed example in the patent was specifically directed to a mixture of these two solvents. The claims in the application to Kaplan and Walker, the

application before the Office, were directed to essentially the same chemical process, but requiring the use of the solvent mixture of tetraglyme and sulfolane. In reversing the double patenting rejection, the court stated that the mere fact that the broad process claim of the patent requiring an organic solvent reads on or “dominates” the narrower claim directed to basically the same process using a specific solvent mixture does not, *per se*, justify a double patenting rejection. The court also pointed out that the double patenting rejection improperly used the disclosure of the joint invention (solvent mixture) in the Kaplan patent specification as though it were prior art.

A significant factor in the *Kaplan* case was that the broad invention was invented by Kaplan, and the narrow invention (i.e., using a specific combination of solvents) was invented by Kaplan and Walker. Since these applications (as the applications in *Braat*) were filed before the Patent Law Amendments Act of 1984 (Pub. Law 98-622, November 8, 1984) amending 35 U.S.C. 116 to expressly authorize filing a patent application in the names of joint inventors who did not necessarily make a contribution to the invention defined in each claim in the patent, it was necessary to file multiple applications to claim both the broad and narrow inventions. Accordingly, there was a valid reason, driven by statute, why the claims to the specific solvent mixture were not presented for examination in the Kaplan patent application.

Each double patenting situation must be decided on its own facts.

Form paragraph 8.33 and the appropriate one of form paragraphs 8.38 (between an issued patent and one or more applications) and 8.39 (provisional rejections) may be used to make this type of nonstatutory double patenting rejection.

#### ¶ 8.38 Double Patenting - Non-Statutory (Based Solely on Improper Timewise Extension of Patent Rights) With a Patent

Claim [1] rejected under the judicially created doctrine of double patenting over claim [2] of U. S. Patent No. [3] since the claims, if allowed, would improperly extend the “right to exclude” already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: [4]

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which

matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

#### Examiner Note:

1. This form paragraph should only be used where approval from the TC Director to make a nonstatutory double patenting rejection based on *In re Schneller* has been obtained.
2. Use this form paragraph only when the subject matter of the claim(s) is fully disclosed in, and covered by at least one claim of, an issued U.S. Patent which is commonly owned or where there is common inventorship (one or more inventors in common).
3. In bracket 3, insert the number of the patent.
4. In bracket 4, insert a description of the subject matter being claimed which is covered in the patent.
5. Form paragraph 8.33 must precede any one of form paragraphs 8.34 to 8.39 and must be used only ONCE in an Office action.
6. If evidence indicates that the conflicting patent is prior art under 35 U.S.C. 102(f) or (g), a rejection should additionally be made under 35 U.S.C. 102(f)/103(a) or 102(g)/103(a) 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)/103(a) may be made using paragraph 7.21.02. For applications filed on or after November 29, 1999, rejections under 35 U.S.C. 102(e)/103(a) should not be made or maintained if the applicant provides evidence that the subject matter of the reference and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

#### ¶ 8.39 Double Patenting - Non-Statutory (Based Solely on Improper Timewise Extension of Patent Rights) With Another Application

Claim [1] provisionally rejected under the judicially created doctrine of double patenting over claim [2] of copending Application No. [3]. This is a provisional double patenting rejection because the conflicting claims have not in fact been patented.

The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter, as follows: [4]

Furthermore, there is no apparent reason why applicant would be prevented from presenting claims corresponding to those of the instant application in the other copending application. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

#### Examiner Note:

1. This form paragraph should only be used where approval from the TC Director to make a nonstatutory double patenting rejection based on *In re Schneller* has been obtained.
2. Use this form paragraph only when the subject matter of the claim(s) is fully disclosed in, and covered by at least one claim of, another copending application which is commonly owned or where there is common inventorship (one or more inventors in common).

3. In bracket 3, insert the number of the conflicting application.
4. In bracket 4, insert a description of the subject matter being claimed which is covered in the copending application.
5. Form paragraph 8.33 must precede any one of form paragraphs 8.34 to 8.39 and must be used only ONCE in an office action.
6. 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 35 U.S.C. 102(f) and/or (g).
7. A provisional double patenting rejection should also be made in the conflicting application.
8. If evidence shows that either application is prior art unto the other under 35 U.S.C. 102(f) or (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 in the other application under 35 U.S.C. 102(f)/103(a) or 102(g)/103(a) 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 paragraph 7.21.01 to additionally make a rejection under 35 U.S.C. 102(e)/103(a). For applications filed on or after November 29, 1999, rejections under 35 U.S.C. 102(e)/103(a) should not be made or maintained if the applicant provides evidence that the subject matter of the reference and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

### 3. Design/Plant — Utility Situations

Double patenting issues may be raised where an applicant has filed both a utility patent application (35 U.S.C. 111) and either an application for a plant patent (35 U.S.C. 161) or an application for a design patent (35 U.S.C. 171). In general, the same double patenting principles and criteria that are applied in utility-utility situations are applied to utility-plant or utility-design situations. Double patenting rejections in utility-plant situations may be made in appropriate circumstances.

Although double patenting is rare in the context of utility versus design patents, a double patenting rejection of a pending design or utility application can be made on the basis of a previously issued utility or design patent, respectively. *Carman Indus. Inc. v. Wahl*, 724 F.2d 932, 220 USPQ 481 (Fed. Cir. 1983). The rejection is based on the public policy preventing the extension of the term of a patent. Double patenting may be found in a design-utility situation irrespective of whether the claims in the patent relied on in the rejection and the claims in issue involve the same

invention, or whether they involve inventions which are obvious variations of one another. *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

In *Carman Indus.*, the court held that no double patenting existed between a design and utility patent since the claims in the utility patent, drawn to the interior construction of a flow promoter, were not directed to the same invention or an obvious variation of the invention claimed in a design patent directed to the visible external surface configuration of a storage bin flow promoter. The majority opinion in this decision appears to indicate that a two-way obviousness determination is necessary in design-utility cases. 724 F.2d at 940-41, 220 USPQ at 487-88. But see *Carman Indus.* (J. Nies, concurring).

In *Thorington*, the court affirmed a double patenting rejection of claims for a fluorescent light bulb in a utility patent application in view of a previously issued design patent for the same bulb. In another case, a double patenting rejection of utility claims for a finger ring was affirmed in view of an earlier issued design patent, where the drawing in both the design patent and the utility application illustrated the same article. *In re Phelan*, 205 F.2d 183, 98 USPQ 156 (CCPA 1953). A double patenting rejection of a design claim for a flashlight cap and hanger ring was affirmed over an earlier issued utility patent. *In re Barber*, 81 F.2d 231, 28 USPQ 187 (CCPA 1936). A double patenting rejection of claims in a utility patent application directed to a balloon tire construction was affirmed over an earlier issued design patent. *In re Hargraves*, 53 F.2d 900, 11 USPQ 240 (CCPA 1931).

### III. CONTRAST BETWEEN DOUBLE PATENTING REJECTION AND REJECTIONS BASED ON PRIOR ART

Rejections over a patent or another copending application based on double patenting or 35 U.S.C. 103(a) are similar in the sense that both require comparison of the claimed subject matter with at least part of the content of another patent or application, and both may require that an obviousness analysis be made. However, there are significant differences between a rejection based on double patenting and one based on 35 U.S.C. 102(e) prior art under

35 U.S.C. 103(a). *In re Bartfeld*, 925 F.2d 1450, 17 USPQ2d 1885 (Fed. Cir. 1991).

One significant difference is that a double patenting rejection must rely on a comparison with the claims in an issued or to be issued patent, whereas an obviousness rejection based on the same patent under 35 U.S.C. 102(e)/103(a) relies on a comparison with what is disclosed (whether or not claimed) in the same issued or to be issued patent. In a 35 U.S.C. 102(e)/103(a) rejection over a prior art patent, the reference patent is available for all that it fairly discloses to one of ordinary skill in the art, regardless of what is claimed. *In re Bowers*, 359 F.2d 886, 149 USPQ 570 (CCPA 1966).

A second significant difference is that a terminal disclaimer cannot be used to obviate a rejection based on 35 U.S.C. 102(e)/103(a) prior art. *In re Fong*, 378 F.2d 977, 154 USPQ 25 (CCPA 1967). The purpose of a terminal disclaimer is to obviate a double patenting rejection by removing the potential harm to the public by issuing a second patent, and not to remove a patent as prior art.

Where the inventions are made by inventors that have assigned their rights to a common assignee, the assignee can take some preemptive measures to avoid having a copending application become prior art under 35 U.S.C. 102(e). The applications can be filed on the same day, or copending applications can be merged into a single continuation-in-part application and the parent applications abandoned. If these steps are undesirable or the first patent has issued, the prior art effect of the first patent may be avoided by a showing under 37 CFR 1.132 that any unclaimed invention disclosed in the first patent was derived from the inventor of the application before the examiner in which the 35 U.S.C. 102(e)/103(a) rejection was made. *In re Katz*, 687 F.2d 450, 215 USPQ 14 (CCPA 1982). See also MPEP § 716.10. It may also be possible for applicant to respond to a 35 U.S.C. 102(e)/103(a) rejection by showing, under 37 CFR 1.131, that the date of invention of the claimed subject matter was prior to the effective filing date of the reference patent which has been relied upon for its unclaimed disclosure. See MPEP § 715. See also 37 CFR 1.130 and MPEP § 718 for affidavits or declarations to disqualify a commonly owned patent as prior art under 35 U.S.C. 103.

Because there are significant differences between a rejection based on double patenting and one based on prior art under 35 U.S.C. 102(e)/103 over the same issued patent, it is both appropriate and necessary that an examiner make both rejections when the facts support both rejections. A prior art reference that renders claimed subject matter obvious under 35 U.S.C. 102(e)/103(a) does not create a double patenting situation where that subject matter is not claimed in the reference patent. Where the subject matter that renders a claim obvious is both claimed and disclosed in a U.S. patent which satisfies the criteria of 35 U.S.C. 102(e), the examiner should make rejections based both on double patenting and 35 U.S.C. 103(a). For applications filed on or after November 29, 1999, rejections under 35 U.S.C. 102(e)/103(a) should not be made or maintained if the applicant provides evidence that the subject matter of the reference and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

### **804.01 Prohibition of Double Patenting Rejections Under 35 U.S.C. 121**

35 U.S.C. 121 authorizes the Commissioner to restrict the claims in a patent application to a single invention when independent and distinct inventions are presented for examination. The third sentence of 35 U.S.C. 121 prohibits the use of a patent issuing on an application with respect to which a requirement for restriction has been made, or on an application filed as a result of such a requirement, as a reference against any divisional application, if the divisional application is filed before the issuance of the patent. The 35 U.S.C. 121 prohibition applies only where the Office has made a requirement for restriction. The prohibition does not apply where the divisional application was voluntarily filed by the applicant and not in response to an Office requirement for restriction. 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 restrictions where the claims define essentially the same invention in differ-

ent language and which, if acquiesced in, might result in the issuance of several patents for the same invention.

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 application are filed as a result of such requirement.

The following are situations where the prohibition of double patenting rejections under 35 U.S.C. 121 does not apply:

(A) The applicant voluntarily files two or more applications without a restriction requirement by the examiner. *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968).

(B) The claims of the different applications or patents are not consonant with the restriction requirement made by the examiner, since the claims have been changed in material respects from the claims at the time the requirement was made. For example, the divisional application filed includes additional claims not consonant in scope to the original claims subject to restriction in the parent. *Symbol Technologies, Inc. v. Opticon, Inc.*, 935 F.2d 1569, 19 USPQ2d 1241 (Fed. Cir. 1991) and *Gerber Garment Technology, Inc. v. Lectra Systems, Inc.*, 916 F.2d 683, 16 USPQ2d 1436 (Fed. Cir. 1990). In order for consonance to exist, the line of demarcation between the independent and distinct inventions identified by the examiner in the requirement for restriction must be maintained. 916 F.2d at 688, 16 USPQ2d at 1440.

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

(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.

(E) The requirement for restriction was withdrawn by the examiner before the patent issues. *In re Ziegler*, 443 F.2d 1211, 170 USPQ 129 (CCPA 1971).

(F) The claims of the second application are drawn to the “same invention” as the first application or patent. *Studiengesellschaft Kohle mbH v. Northern Petrochemical Co.*, 784 F.2d 351, 228 USPQ 837 (Fed. Cir. 1986).

While the situation should not arise where appropriate care is exercised in defining the independent and distinct inventions in a restriction requirement, the issue might arise as to whether 35 U.S.C. 121 prevents the use of a double patenting rejection when the identical invention is claimed in both the patent and the pending application. Under these circumstances, the Office will make the double patenting rejection because the patentee is entitled only to a single patent for an invention. As expressed in *Studiengesellschaft Kohle*, 784 F.2d at 361, 228 USPQ at 844, (J. Newman, concurring), “35 U.S.C. 121 of course does not provide that multiple patents may be granted on the identical invention.”

## 804.02 Avoiding a Double Patenting Rejection

### I. STATUTORY

A rejection based on the statutory type of double patenting can be avoided by amending the conflicting claims so that they are not coextensive in scope. Where the conflicting claims are in one or more pending applications and a patent, a rejection based on statutory type double patenting can also be avoided by canceling the conflicting claims in all the pending applications. Where the conflicting claims are in two or more pending applications, a provisional rejection based on statutory type double patenting can also be avoided by canceling the conflicting claims in all but one of the pending applications. A terminal disclaimer is not effective in overcoming a statutory double patenting rejection.

The use of a 37 CFR 1.131 affidavit in overcoming a statutory double patenting rejection is inappropriate.

*In re Dunn*, 349 F.2d 433, 146 USPQ 479 (CCPA 1965). *Knell v. Muller*, 174 USPQ 460 (Comm’r. Pat. 1971), citing the CCPA decisions in *In re Ward*, 236 F.2d 428, 111 USPQ 101 (CCPA 1956); *In re Teague*, 254 F.2d 145, 117 USPQ 284 (CCPA 1958); and *In re Hidy*, 303 F.2d 954, 133 USPQ 650 (CCPA 1962).

### II. NONSTATUTORY

37 CFR 1.130. Affidavit or declaration to disqualify commonly owned patent or published application as prior art.

\*\*\*\*\*

(b) When an application or a patent under reexamination 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 or a patent under reexamination. A judicially created double patenting rejection may be obviated by filing a terminal disclaimer in accordance with § 1.321(c).

A rejection based on a nonstatutory type of double patenting can be avoided by filing a terminal disclaimer in the application or proceeding in which the rejection is made. *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); *In re Knohl*, 386 F.2d 476, 155 USPQ 586 (CCPA 1967); and *In re Griswold*, 365 F.2d 834, 150 USPQ 804 (CCPA 1966). The use of a terminal disclaimer in overcoming a nonstatutory double patenting rejection is in the public interest because it encourages the disclosure of additional developments, the earlier filing of applications, and the earlier expiration of patents whereby the inventions covered become freely available to the public. *In re Jentoft*, 392 F.2d 633, 157 USPQ 363 (CCPA 1968); *In re Eckel*, 393 F.2d 848, 157 USPQ 415 (CCPA 1968); and *In re Braithwaite*, 379 F.2d 594, 154 USPQ 29 (CCPA 1967).

The use of a 37 CFR 1.131 affidavit in overcoming a double patenting rejection is inappropriate because the claim or claims in the application are being rejected over a patent which claims the rejected invention. *In re Dunn*, 349 F.2d 433, 146 USPQ 479 (CCPA 1965). 37 CFR 1.131 is inapplicable if the claims of the application and the patent are “directed to substantially the same invention”. It is also inapplicable if there is a lack of “patentable distinctness” between the claimed subject matter. *Knell v. Muller*, 174 USPQ 460 (Comm’r. Pat. 1971), citing the court decisions in *In re Ward*, 236 F.2d 428, 111 USPQ 101

(CCPA 1956); *In re Teague*, 254 F.2d 145, 117 USPQ 284 (CCPA 1958); and *In re Hidy*, 303 F.2d 954, 133 USPQ 65 (CCPA 1962).

A patentee or applicant may disclaim or dedicate to the public the entire term, or any terminal part of the term of a patent. 35 U.S.C. 253. The statute does not provide for a terminal disclaimer of only a specified claim or claims. The terminal disclaimer must operate with respect to all claims in the patent.

The filing of a terminal disclaimer to obviate a rejection based on nonstatutory double patenting is not an admission of the propriety of the rejection. *Quad Environmental Technologies Corp. v. Union Sanitary District*, 946 F.2d 870, 20 USPQ2d 1392 (Fed. Cir. 1991). The court indicated that the “filing of a terminal disclaimer simply serves the statutory function of removing the rejection of double patenting, and raises neither a presumption nor estoppel on the merits of the rejection.”

A terminal disclaimer filed to obviate a double patenting rejection is effective only with respect to the application identified in the disclaimer, unless by its terms it extends to continuing applications. If an appropriate double patenting rejection of the nonstatutory type is made in two or more pending applications, an appropriate terminal disclaimer must be filed in each application.

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

### **III. TERMINAL DISCLAIMER REQUIRED DESPITE REQUEST TO ISSUE ON 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. In any event, the Office cannot ensure that two or more applications will have a common issue date.

### **IV. DISCLAIMING MULTIPLE DOUBLE PATENTING REFERENCES**

If multiple conflicting patents and/or pending applications are applied in double patenting rejections made in a single application, then prior to issuance of that application, it is necessary to disclaim each one of the conflicting double patenting references applied, rather than disclaiming only the conflicting double patenting reference with the earliest issue date (assuming at least one of the references is a patent). A terminal disclaimer fee is required for each terminal disclaimer filed. To avoid paying multiple terminal disclaimer fees, a single terminal disclaimer may be filed, wherein all the conflicting double patenting references are disclaimed therein.

Disclaiming each one of the conflicting double patenting references is necessary to avoid the problem of dual ownership of patents to patentably indistinct inventions in the event that the patent issuing from the application being examined ceases to be commonly owned with any one of the double patenting references that have issued or may issue as a patent. Note that 37 CFR 1.321(c)(3) requires that a terminal disclaimer “[i]nclude a provision that any patent granted on that application or any patent subject to the reexamination proceeding 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.”

### **V. REQUIREMENTS OF A TERMINAL DISCLAIMER**

A terminal disclaimer is a statement filed by an owner (in whole or in part) of a patent or a patent to be granted that is used to disclaim or dedicate a portion of the entire term of all the claims of a patent. The requirements for a terminal disclaimer are set forth in 37 CFR 1.321. Sample forms of a terminal disclaimer, and guidance as to the filing and treatment of a terminal disclaimer, are provided in MPEP § 1490.



## VI. TERMINAL DISCLAIMERS REQUIRED TO OVERCOME JUDICIALLY CREATED DOUBLE PATENTING REJECTIONS IN APPLICATIONS FILED ON OR AFTER JUNE 8, 1995

Public Law 103-465 (1994) amended 35 U.S.C. 154(a)(2) to provide that any patent issuing on a utility or plant application filed on or after June 8, 1995 will expire 20 years from its filing date, or, if the application claims the benefit of an earlier filed application under 35 U.S.C. 120, 121, or 365(c), 20 years from the earliest filing date for which a benefit under 35 U.S.C. 120, 121, or 365(c) is claimed. Therefore, any patent issuing on a continuing utility or plant application filed on or after June 8, 1995 will expire 20 years from the earliest filing date for which a benefit is claimed under 35 U.S.C. 120, 121, or 365(c), subject to the provisions of 35 U.S.C. 154(b).

There are at least two reasons for insisting upon a terminal disclaimer to overcome a judicially created double patenting rejection in a continuing application subject to a 20-year term under 35 U.S.C. 154(a)(2). First, 35 U.S.C. 154(b) includes provisions for patent term extension based upon prosecution delays during the application process. Thus, 35 U.S.C. 154 does not ensure that any patent issuing on a continuing utility or plant application filed on or after June 8, 1995 will necessarily expire 20 years from the earliest filing date for which a benefit is claimed under 35 U.S.C. 120, 121, or 365(c). Second, 37 CFR 1.321(c)(3) requires that a terminal disclaimer filed to obviate a judicially created double patenting rejection include a provision that any patent granted on that application be enforceable only for and during the period that the patent is commonly owned with the application or patent which formed the basis for the rejection. This requirement serves to avoid the potential for harassment of an accused infringer by multiple parties with patents covering the same patentable invention (37 CFR 1.601(n)). See, e.g., *In re Van Ornum*, 686 F.2d 937, 944-48, 214 USPQ 761, 767-70 (CCPA 1982). Not insisting upon a terminal disclaimer to overcome a judicially created double patenting rejection in an application subject to a 20-year term under 35 U.S.C. 154(a)(2) would result in the potential for the problem that 37 CFR 1.321(c)(3) was promulgated to avoid.

Accordingly, a terminal disclaimer under 37 CFR 1.321 is required in an application to overcome a judicially created double patenting rejection, even if the application was filed on or after June 8, 1995 and claims the benefit under 35 U.S.C. 120, 121, or 365(c) of the filing date of the patent or application which forms the basis for the rejection. Examiners should respond to arguments that a terminal disclaimer under 37 CFR 1.321 should not be required in a continuing application filed on or after June 8, 1995 to overcome a judicially created double patenting rejection due to the change to 35 U.S.C. 154 by citing to this section of the MPEP or to the *Official Gazette* notice at 1202 O.G. 112 (Sept. 30, 1997).

### 804.03 Treatment of Commonly Owned Cases of Different Inventive Entities

*35 U.S.C. 103. Conditions for patentability; non-obvious subject matter.*

\*\*\*\*\*

(c) Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

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

\*\*\*\*\*

(c) If an application or a patent under reexamination and at least one other application naming different inventors are owned by the same party and 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 Office may require the assignee 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.

*37 CFR 1.130. Affidavit or declaration to disqualify commonly owned patent or published application as prior art.*

(a) When any claim of an application or a patent under reexamination is rejected under 35 U.S.C. 103 on a U.S. patent or U.S. patent application publication which is not prior art under 35 U.S.C. 102(b), and the inventions defined by the claims in the application or patent under reexamination and by the claims in the

patent or published application are not identical but are not patentably distinct, and the inventions are owned by the same party, the applicant or owner of the patent under reexamination may disqualify the patent or patent application publication as prior art. The patent or patent application publication can be disqualified as prior art by submission of:

(1) A terminal disclaimer in accordance with § 1.321(c); and

(2) An oath or declaration stating that the application or patent under reexamination and patent or published application are currently owned by the same party, and that the inventor named in the application or patent under reexamination is the prior inventor under 35 U.S.C. 104.

(b) When an application or a patent under reexamination 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 or a patent under reexamination. A judicially created double patenting rejection may be obviated by filing a terminal disclaimer in accordance with § 1.321(c).

## I. DOUBLE PATENTING

The 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).

Double patenting rejections can be overcome in certain circumstances by disclaiming, pursuant to the 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. 37 CFR 1.130(b).

## II. IDENTIFYING COMMONLY OWNED CASES OR DETERMINING INVENTION PRIORITY

A determination of priority is not required when two inventions come within the provisions of 35 U.S.C. 103(c). Two inventions of different inventive entities come within the provisions of 35 U.S.C. 103(c) when:

(A) the later invention is not anticipated by the earlier invention under 35 U.S.C. 102;

(B) the earlier invention qualifies as prior art for purposes of obviousness under 35 U.S.C. 103 against the later invention only under subsection (f) or (g) of 35 U.S.C. 102, or 35 U.S.C. 102(e) for applications filed on or after November 29, 1999; and

(C) 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.

Pursuant to 37 CFR 1.78(c), where an application or a patent under reexamination and at least one other application of different inventive entities are owned by the same party and contain conflicting claims, the examiner may require the assignee to state whether the claimed inventions come within the provisions of 35 U.S.C. 103(c) (i.e., indicate whether common ownership or an obligation of assignment to the same person existed at the time the later invention was made). If the assignee states that the provisions of 35 U.S.C. 103(c) do not apply to the conflicting claimed inventions, the assignee is required to indicate which named inventor is the prior inventor. Form paragraphs 8.27, 8.28 and 8.28.01 may be used to require the applicant to identify the prior inventor under 37 CFR 1.78(c). In order to avoid abandonment, the assignee must comply with the requirement under 37 CFR 1.78(c) by naming the prior inventor unless the conflicting claims are eliminated in all but one application. If, however, the two inventions come within the provisions of 35 U.S.C. 103(c), it is not necessary to determine priority of invention since the earlier invention is disqualified as prior art against the later invention and since double patenting rejections can be used to ensure that the patent terms expire together. Accordingly, a response to a requirement under 37 CFR 1.78(c) which states that the inventions of different inventive entities come within the provi-

sions of 35 U.S.C. 103(c), is complete without any further inquiry under 37 CFR 1.78(c) as to the prior inventor.

Before making the requirement to identify the prior inventor under 37 CFR 1.78(c), with its threat to hold the application abandoned if the statement is not made by the assignee, the examiner must make sure that claims are present in each application which are conflicting as defined in MPEP § 804. See *In re Rekors*, 203 USPQ 1034 (Comm'r Pat. 1979).

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 v. Banner*, 599 F.2d 435, 202 USPQ 365 (CCPA 1979) (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.).

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. Also note that the conflict between two or more pending applications can be avoided by abandoning the applications and filing a continuation-in-part application merging the conflicting inventions into a single application.

#### **A. Excluding A Prior Art Reference Where Common Ownership Or Assignment Obligation Exists**

In order to be disqualified as prior art under 35 U.S.C. 103(c), the subject matter that would otherwise be prior art to the claimed invention and the claimed invention must be commonly owned at the time the claimed invention was made. For applications filed prior to November 29, 1999, the subject matter that is disqualified as prior art under 35 U.S.C. 103 is strictly limited to subject matter that qualifies as prior art only under 35 U.S.C. 102(f) or 35 U.S.C. 102(g) and was commonly owned with the claimed invention at the time the claimed invention was made. For applications filed on or after November 29, 1999,

the subject matter which was prior art under 35 U.S.C. 103 via 35 U.S.C. 102(e) is also disqualified as prior art against the claimed invention if that subject matter and the claimed invention were commonly owned at the time the claimed invention was made. 35 U.S.C. 103(c) applies only to prior art usable in an obviousness rejection under 35 U.S.C. 103.

To rely upon 35 U.S.C. 103(c), a statement of common ownership must be provided in the record of the application being examined. See MPEP § 706.02(1)(2) regarding evidence required to establish common ownership.

For applications filed prior to November 29, 1999, the subject matter which was prior art under 35 U.S.C. 103 via 35 U.S.C. 102(e) will not be disqualified as prior art under 35 U.S.C. 103(c). However, the prior art under 35 U.S.C. 102(e)/103(a) may be disqualified under 37 CFR 1.130 if: (A) the prior art and the application being examined are commonly owned; (B) the prior art does not anticipate the claimed invention of the application; (C) a terminal disclaimer pursuant to 37 CFR 1.321 is filed; and (D) an oath or declaration is filed stating that the application being examined and the prior art are currently owned by the same party, and that the inventor named in the application is the prior inventor under 35 U.S.C. 104. See MPEP § 718.

### **III. REJECTIONS UNDER 35 U.S.C. 102 AND 103 AND DOUBLE PATENTING**

Form paragraphs 8.27, 8.28 and 8.28.01 may be used to require the applicant to name the prior inventor 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 U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP § 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 this application.

**Examiner Note:**

1. In bracket 3, insert the U.S. patent number or the copending application 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 form paragraph; see form paragraph 8.28.
3. A provisional or actual statutory double patenting rejection may also be made using form paragraphs 8.31 or 8.32.
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 7.15.01 or 7.15.02.

*¶ 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 form paragraph should be used when the application being examined is commonly assigned with a conflicting application or 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 or a published application with an earlier U.S. filing date, make a rejection under 35 U.S.C. 102(e)/103(a) using form paragraph 7.21.02 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(a) rejection using form paragraph 7.21.01 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 form paragraphs 8.34 to 8.36.
6. In bracket 4, explain why the claims in the conflicting cases are not considered to be distinct.
7. Form paragraph 8.28.01 MUST follow this paragraph.

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(a) based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g), or 35 U.S.C. 102(e) for applications filed on or after November 29, 1999.

*¶ 8.28.01 Advisory Information Relating to Paragraph 8.28*

The U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP § 2302). Commonly assigned [1], discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) 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 35 U.S.C. 103(c) and 37 CFR 1.78(c) 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 con-

flicting 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(a) based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g), or 35 U.S.C. 102(e) for applications filed on or after November 29, 1999.

**Examiner Note:**

This form paragraph should follow paragraph 8.28 and should only be used ONCE in an Office action.

If it is determined that the provisions of 35 U.S.C. 103(c) apply to the commonly owned conflicting inventions of different inventive entities and thereby overcoming the obviousness rejection(s), double patenting rejection(s) should be made as appropriate. If, however, it is determined that the provisions of 35 U.S.C. 103(c) do NOT apply because the inventions were not commonly owned or subject to an obligation of assignment to the same person at the time the later invention was made, and there is evidence of record to indicate that a patent or application is prior art against the application being examined, the examiner should make (A) the appropriate double patenting rejection(s), and (B) the appropriate prior art rejection(s) under 35 U.S.C. 102 and/or 35 U.S.C. 103 in the application being examined. See Charts I-A, I-B, II-A, II-B, III-A and III-B in MPEP § 804. Rejections under 35 U.S.C. 102 or 35 U.S.C. 103 cannot be obviated solely by filing a terminal disclaimer.

*¶ 7.15 Rejection, 35 U.S.C. 102(a), (b) Patent or Publication, and (g)*

Claim [1] rejected under 35 U.S.C. 102[2] as being [3] by [4].

**Examiner Note:**

1. In bracket 2, insert the appropriate paragraph letter or letters of 35 U.S.C. 102 in parentheses. If paragraph (e) of 35 U.S.C. 102 is applicable, use form paragraph 7.15.02.
2. In bracket 3, insert either --clearly anticipated-- or --anticipated-- with an explanation at the end of the paragraph.
3. In bracket 4, insert the prior art relied upon.
4. This rejection must be preceded either by form paragraph 7.07 and form paragraphs 7.08, 7.09, and 7.14 as appropriate, or by form paragraph 7.103.
5. If 35 U.S.C. 102(e) is also being applied, this paragraph must be followed by either form paragraph 7.15.02 or 7.15.03.

*¶ 7.19 Rejection, 35 U.S.C. 102(f), Applicant Not the Inventor*

Claim [1] rejected under 35 U.S.C. 102(f) because the applicant did not invent the claimed subject matter. [2]

**Examiner Note:**

1. This form paragraph must be preceded either by form paragraphs 7.07 and 7.13 or by form paragraph 7.103.
2. In bracket 2, insert an explanation of the supporting evidence establishing that applicant was not the inventor. See MPEP § 2137.

*¶ 7.21 Rejection, 35 U.S.C. 103(a)*

Claim [1] rejected under 35 U.S.C. 103(a) as being unpatentable over [2].

**Examiner Note:**

1. This form paragraph must be preceded by either form paragraph 7.20 or form paragraph 7.103.
2. An explanation of the rejection applying the *Graham v. Deere* test must follow this form paragraph.
3. If this rejection relies upon art that is disqualified under 35 U.S.C. 102(f) or (g) based upon the common ownership of the invention, form paragraph 7.20.01 must follow this form paragraph.
4. If this rejection is a provisional 35 U.S.C. 103(a) rejection based upon a copending application that would comprise prior art under 35 U.S.C. 102(e) if patented, use paragraph 7.21.01 instead of this paragraph.

*¶ 7.21.01 Provisional Rejection, 35 U.S.C. 103(a), Common Assignee or at Least One Common Inventor*

Claim [1] provisionally rejected under 35 U.S.C. 103(a) as being obvious over copending Application No. [2] which has a common [3] with the instant application. Based upon the earlier effective U.S. filing date of the copending application, it would constitute prior art under 35 U.S.C. 102(e) if patented. This provisional rejection under 35 U.S.C. 103(a) is based upon a presumption of future patenting of the conflicting application. [4]

This provisional rejection might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the copending application was derived from the inventor of this application and is thus not the invention “by another,” or by a showing of a date of invention for the instant application prior to the effective U.S. filing date of the copending application under 37 CFR 1.131. For applications filed on or after November 29, 1999, this rejection might also be overcome by showing that the subject matter of the reference and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person. See MPEP § 706.02(1)(1) and § 706.02(1)(2).

**Examiner Note:**

1. This form paragraph is used to provisionally reject claims not patentably distinct from the disclosure in a copending application having an earlier U.S. filing date and also having either a common assignee or at least one common inventor. This form paragraph should **not** be used in applications filed on or after November 29, 1999 when the application being examined establishes that it and any reference application were owned by, or subject to an obligation of assignment to, the same person, at the time the invention was made. See MPEP § 706.02(1)(3).

2. If the claimed invention is fully disclosed in the copending application, use form paragraph 7.15.01.
3. In bracket 3, insert either --assignee-- or --inventor--.
4. In bracket 4, insert explanation of obviousness.
5. If the claimed invention is also claimed in the copending application, a provisional obviousness double patenting rejection should additionally be made using form paragraphs 8.33 and 8.37.
6. If evidence indicates that the copending application is also prior art under 35 U.S.C. 102(f) or (g) and the copending application has not been disqualified as prior art in a 35 U.S.C. 103(a) rejection based upon common ownership, a rejection should additionally be made under 35 U.S.C. 103(a) using form paragraph 7.21 (e.g., applicant has named the prior inventor in response to a requirement made using form paragraph 8.28).

Further, if the conflicting applications have different effective U.S. filing dates, the examiner should consider making a provisional rejection in the later filed application, based on the earlier filed application, under 35 U.S.C. 102(e) or 102(e)/103(a), using form paragraph 7.15.01 or 7.21.01. Similarly, if an application has a later effective U.S. filing date than a conflicting issued patent, the examiner should consider making a rejection in the application, based on the patent, under 35 U.S.C. 102(e) or 102(e)/103(a), using form paragraph 7.15.02 or 7.21.02. Rejections under 35 U.S.C. 102 or 103 cannot be obviated solely by the filing of a terminal disclaimer. However, for applications filed on or after November 29, 1999, a rejection under 35 U.S.C. 102(e) can be overcome by submitting evidence of common ownership, or an obligation to assign to the same person, at the time the invention was made.

*¶ 7.15.01 Provisional Rejection, 35 U.S.C. 102(e) - Common Assignee or At Least One Common Inventor*

Claim [1] provisionally rejected under 35 U.S.C. 102(e) as being anticipated by copending Application No. [2] which has a common [3] with the instant application.

Based upon the earlier effective U.S. filing date of the copending application, it would constitute prior art under 35 U.S.C. 102(e), if patented. This provisional rejection under 35 U.S.C. 102(e) is based upon a presumption of future patenting of the copending application. [4].

This provisional rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the copending application was derived from the inventor of this application and is thus not the invention “by another,” or by an appropriate showing under 37 CFR 1.131.

This rejection may not be overcome by the filing of a terminal disclaimer. See *In re Bartfeld*, 925 F.2d 1450, 17 USPQ2d 1885 (Fed. Cir. 1991).

**Examiner Note:**

1. This form paragraph is used to provisionally reject over a copending application with an earlier filing date that discloses the claimed invention. The copending application must have either a common assignee or at least one common inventor.
2. If the claims are obvious over the invention disclosed in the other copending application, use form paragraph 7.21.01.
3. In bracket 3, insert either --assignee-- or --inventor--.
4. In bracket 4, an appropriate explanation may be provided in support of the examiner's position on anticipation, if necessary.
5. If the claims of the copending application conflict with the claims of the instant application, a provisional double patenting rejection should also be given using form paragraphs 8.30 and 8.32.
6. If evidence is additionally of record to show that either invention is prior art unto the other under 35 U.S.C. 102(f) or (g), a rejection using form paragraphs 7.13 and/or 7.14 should also be made.

*¶ 7.15.02 Rejection, 35 U.S.C. 102(e), Common Assignee or Inventor(s)*

Claim [1] rejected under 35 U.S.C. 102(e) as being anticipated by [2].

The applied reference has a common [3] with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

**Examiner Note:**

1. This form paragraph is used to reject over a patent with an earlier filing date that discloses but does not claim the same invention. The patent must have either a common assignee or a common inventor.
2. In bracket 3, insert either --assignee-- or --inventor--.

*¶ 7.21.02 Rejection, 35 U.S.C. 103(a), Common Assignee or At Least One Common Inventor*

Claim [1] rejected under 35 U.S.C. 103(a) as being obvious over [2].

The applied reference has a common [3] with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in

the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). For applications filed on or after November 29, 1999, this rejection might also be overcome by showing that the subject matter of the reference and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person. See MPEP § 706.02(1)(1) and § 706.02(1)(2). [4]

**Examiner Note:**

1. This form paragraph is used to reject over a patent with an earlier filing date that discloses the claimed invention, and that only qualifies as prior art under 35 U.S.C. 102(e). If the patent qualifies as prior art under 35 U.S.C. 102(a) or (b), then this form paragraph should not be used (form paragraphs 7.07 and either 7.08 or 7.09 should be used instead). The patent must have either a common assignee or at least one common inventor. This form paragraph should not be used in applications filed on or after November 29, 1999 when the application being examined establishes that it and any reference patent were owned by, or subject to an obligation of assignment to, the same person, at the time the invention was made. See MPEP § 706.03(1)(3).
2. In bracket 3, insert either --assignee-- or --inventor--.
3. In bracket 4, insert explanation of obviousness.

## 804.04 Submission to Technology Center Director

In order to promote uniform practice, every Office action containing a rejection on the ground of double patenting which relies on the parent application rejecting the claims in a divisional or continuing application where the divisional or continuing application was filed because of a requirement to restrict made by the examiner under 35 U.S.C. 121, including a requirement to elect species, must be submitted to the Technology Center Director for approval prior to mailing. If 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.

## 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**

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

(A) Where inventions are independent (i.e., no disclosed relation therebetween), restriction to one thereof is ordinarily proper, MPEP § 806.04 - § 806.04(i), 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).

(B) Where inventions are related as disclosed but are distinct as claimed, restriction may be proper.

(C) Where inventions are related as disclosed but are not distinct as claimed, restriction is never proper.

Where restriction is required by the Office double patenting cannot be held, and thus, it is imperative the requirement should never be made where related inventions as claimed are not distinct. For (B) and (C) 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**

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:

(A) 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.

(B) 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.

(C) 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**

35 U.S.C. 121 provides that restriction may be required to one of two or more independent and distinct inventions. However, 37 CFR 1.141 provides that a reasonable number of species may still be

claimed in one application if the other conditions of the rule are met.

### 806.04(b) Species May Be Related Inventions

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 (Comm'r Pat. 1898), 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

Inventions [1] and [2] are related as mutually exclusive species in an 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 § 806.04(b), 3rd paragraph), and the species are patentably distinct (MPEP § 806.04(h)). In the 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(a) of the other invention.

#### Examiner Note:

1. This form paragraph is to be used when claims are presented to both an **intermediate** and **final product** (MPEP § 806.04(b)).
2. Conclude restriction requirement with one of form paragraphs 8.21.01 through 8.21.03.

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

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 recognized in *Ex parte Smith*, 1888 C.D. 131, 44 O.G.1183 (Comm'r Pat. 1888), 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 different combinations, e.g., a doughnut cooker and an automobile transmission, each of which utilizes the same form of joint.

#### **806.04(d) Definition of a Generic Claim**

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).

#### **806.04(e) Claims Restricted to Species**

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 embodi-

ments 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**

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.

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**

The 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*, 379 F.2d 594, 154 USPQ 29 (CCPA 1967).

## **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 nondistinct 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**

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**

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 Pat.1923). See MPEP § 820.01.

### **806.05(c) Criteria of Distinctness for Combination, Subcombination, or Element of a Combination**

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.

The inventions are distinct if it can be shown that a combination as claimed:

(A) does not require the particulars of the subcombination as claimed for patentability (to show novelty and unobviousness), and

(B) the subcombination can be shown to have utility either by itself or in other and different relations.

When these factors cannot be shown, such inventions are not distinct.

The following examples are included for general guidance.

## I. SUBCOMBINATION NOT ESSENTIAL TO COMBINATION

### *AB<sub>br</sub>/B<sub>sp</sub> 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 diagrammed as combination AB<sub>br</sub> (“br” is an abbreviation for “broad”), and subcombination B<sub>sp</sub> (“sp” is an abbreviation for “specific”). B<sub>br</sub> indicates that in the combination the subcombination is broadly recited and that the specific characteristics set forth in the subcombination claim B<sub>sp</sub> 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<sub>sp</sub> in the combination claim AB<sub>br</sub> is evidence that the patentability of the combination does not rely on the details of the specific subcombination.

## II. SUBCOMBINATION ESSENTIAL TO COMBINATION

### *AB<sub>sp</sub>/B<sub>sp</sub> No Restriction*

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

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

### *AB<sub>sp</sub>/AB<sub>br</sub> (Evidence Claim)/B<sub>sp</sub> Restriction Proper*

Claim AB<sub>br</sub> is an evidence claim which indicates that the combination does not rely upon the specific details of the subcombination for its patentability. If claim AB<sub>br</sub> 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 AB<sub>br</sub> does not set forth the details of the subcombination B<sub>sp</sub> and the subcombination B<sub>sp</sub> 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*

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:**

1. This form paragraph is to be used when claims are presented to both **combination(s)** and **subcombination(s)** (MPEP § 806.05(c)).
2. In situations involving evidence claims, see MPEP § 806.05(c), example 3, and explain in bracket 3.
3. In bracket 4, suggest utility other than used in the combination.
4. Conclude restriction requirement with one of form paragraphs 8.21.01 through 8.21.03.

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

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

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. This form paragraph is to be used when claims are presented to subcombinations usable together (MPEP § 806.05(d)).
2. In bracket 3, insert the appropriate group number or identify the invention.
3. In bracket 4, suggest utility other than with the other invention.
4. Conclude restriction requirement with one of form paragraphs 8.21.01 through 8.21.03.

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

In applications claiming inventions in different statutory categories, only one-way distinctness is generally needed to support a restriction requirement. 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: (A) that the process *as claimed* can be practiced by another materially different apparatus or by hand; or (B) 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. See MPEP § 809.04.

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

#### ¶ 8.17 Process and Apparatus

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:

1. This form paragraph is to be used when claims are presented to both a **process** and **apparatus for its practice** (MPEP § 806.05(e)).
2. In bracket 3, use one or more of the following reasons:
  - (a) --the process as claimed can be practiced by another and materially different apparatus such as .....--,
  - (b) --the process as claimed can be practiced by hand--,
  - (c) --the apparatus as claimed can be used to practice another and materially different process such as .....--.
3. Conclude restriction requirement with one of form paragraphs 8.21.01 through 8.21.03.

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 a 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**

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: (A) 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 (B) 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*, 357 F.2d 679, 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*

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 other 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:**

1. This form paragraph is to be used when claims are presented to both a **product** and the **process of making** the product (MPEP § 806.05(f)).
2. In bracket 3, use one or more of the following reasons:
  - (a) --the process as claimed can be used to make a materially different product such as .....--,
  - (b) --the product as claimed can be made by a materially different process such as .....--.
3. Conclude restriction requirement with one of form paragraphs 8.21.01 through 8.21.03.

### **806.05(g) Apparatus and Product Made — Distinctness**

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: (A) 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 (B) 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*

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:**

1. This form paragraph is to be used when claims are presented to both the **apparatus** and **product made** (MPEP § 806.05(g)).
2. In bracket 3, use one or more of the following reasons:
  - (a) --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 .....--,
  - (b) --the product can be made by a materially different apparatus such as .....--.

3. Conclude restriction requirement with one of form paragraphs 8.21.01 through 8.21.03.

### **ONLY ONE-WAY DISTINCTNESS IS REQUIRED**

The examiner must show by way of example either (A) 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 (B) that the product *as claimed* can be made by another and materially different apparatus.

The burden is on the examiner to provide an example, but the example 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**

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: (A) the process of using as claimed can be practiced with another materially different product; or (B) 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*

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:**

1. This form paragraph is to be used when claims are presented to both the **product** and **process of using the product** (MPEP § 806.05(h)).
2. In bracket 3, use one or more of the following reasons:

(a) --the process as claimed can be practiced with another materially different product such as .....--,

(b) --the product as claimed can be used in a materially different process such as .....--.

3. Conclude restriction requirement with one of form paragraphs 8.21.01 through 8.21.03.

### **806.05(i) Product, Process of Making, and Process of Using — Product Claim Not Allowable**

*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.

Where an application contains claims to a product, claims to a process specially adapted for (i.e., not patentably distinct from, as defined in MPEP § 806.05(f)) making the product, and claims to a process of using the product, and the product claims are not allowable (i.e., not novel and nonobvious), restriction is proper between the process of making and the process of using. In this instance, applicant may be required to elect either (A) the product and process of making it; or (B) the process of using. Unless the examiner can make a showing of distinctness between the process of using and the product (MPEP § 806.05(h)), the product must also be joined with the process of using in grouping (B).

Where the product claims are allowable (i.e., novel and nonobvious), 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 the process of making and product made, even if a showing of distinctness can be made between the product and process of using (MPEP § 806.05(h)).

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

¶ 8.20.01 *Product, Process of Making and Process of Using-Product Not Allowable*

Inventions [1] and [2] are related as 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)).

**Examiner Note:**

This form paragraph is to be used when claims are presented to the **product, process of making** and **process of using** where the product claim(s) are not allowable (MPEP § 806.05(i)).

## **807 Patentability Report Practice Has No Effect on Restriction Practice**

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**

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

### **808.01 Independent Inventions**

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 on 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.

Form paragraph 8.20.02 may be used when claims are directed to independent, unrelated inventions.

¶ 8.20.02 *Unrelated Inventions*

Inventions [1] and [2] are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects. (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions [3].

**Examiner Note:**

1. This form paragraph is to be used only when claims are presented to unrelated inventions, e. g., a necktie and a locomotive bearing.
2. In bracket 3, insert reasons for concluding that the inventions are unrelated.

## **808.01(a) Species**

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). Since the claims are directed to independent inventions, restriction is proper pursuant to 35 U.S.C. 121, 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 if the examiner rejects the generic claims, and even if the applicant cancels the same and admits that the genus is unpatentable, where there is a relationship disclosed between species, such disclosed relationship 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 (A) in all applications containing claims to a plurality of species with no generic claims,

and (B) 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), § 809.02 (c), or § 809.02 (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

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) - § 806.05(i), the examiner, in order to establish reasons for insisting upon restriction, must show by appropriate explanation one of the following:

(A) **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.

(B) **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.

(C) **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

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 1-month (not less than 30 days) shortened statutory period will be set for reply 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 reply 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, the restriction requirement must be withdrawn. Any claim(s) directed to the nonelected invention(s), previously withdrawn from consideration, which depends from or includes all the limitations of the allowable linking claim must be rejoined and will be fully examined for patentability. Where such withdrawn claims have been canceled by applicant pursuant to the restriction requirement, upon the allowance of the linking claim(s), the examiner must notify applicant that any canceled, nonelected claim(s) which depends from or includes all the limitations of the allowable linking claim may be reinstated by submitting the claim(s) in an amendment. Upon entry of the amendment, the amended claim(s) will be fully examined for patentability.



**809.02 Generic Claim Linking Species**

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 as follows:

*37 CFR 1.146. Election of species.*

In the first action on an application containing a generic claim to a generic invention (genus) and claims to more than one patentably distinct species embraced thereby, the examiner may require the applicant in the reply to that action to elect a species of his or her invention to which his or her claim will be restricted if no claim to the genus is found to be 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 application.

**809.02(a) Election Required**

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:

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

(B) 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.

(C) 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 reply and his or her rights under 37 CFR 1.141.

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

A 1-month (not less than 30 days) shortened statutory period will be set for reply 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 reply 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.

*¶ 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 reply 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 claim is allowable or that all claims are generic is considered non-responsive 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(a) 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(a) of the other invention.

**Examiner Note:**

1. This paragraph should be used for the election of 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 an 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 (A) identify generic claims or state that none are present, and (B) 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. Form paragraph 8.48 may be used.

*¶ 8.48 Generic Claim(s) Allowable, No Election of Single Species*

Allowed 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 embraced by the allowed genus.

Applicant is advised that a complete reply to this requirement must include an identification of the species that is elected and a listing of all claims readable thereon. Applicant is entitled to consideration of claims to a reasonable number of disclosed species in addition to the elected species 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. Applicant's reply must include an identification of such additional species along with a listing of the claims readable on each additional species.

**Examiner Note:**

1. This form paragraph is to be used whenever a claim generic to two or more species is found to be allowable and election of a

single disclosed species embraced thereby has not been made of record.

2. In bracket 1, identify the claim(s) found to be generic and allowable.
3. In bracket 2, identify the plurality of species embraced by the allowed generic claim(s).

### 809.02(c) Action Following Election

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.

(A) When the generic claims are rejected, or there is no generic claim, all claims not readable on the elected species should be treated using Form Paragraphs 8.05 and 8.06, as appropriate.

*¶ 8.05 Claims Stand Withdrawn With Traverse*

Claim [1] withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected [2], there being no (allowable) generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. [3].

**Examiner Note:**

In bracket 2, insert --invention-- or --species--.

*¶ 8.06 Claims Stand Withdrawn Without Traverse*

Claim [1] withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected [2], there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. [3].

**Examiner Note:**

In bracket 2, insert --invention--, or --species--.

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

(1) When *all* claims to each of the additional species are embraced by an allowable generic claim as provided by 37 CFR 1.141, applicant must be advised of the allowable generic claim and that claims drawn to the nonelected species are no longer withdrawn since they are fully embraced by the allowed generic claim.

(2) 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 as set forth in form paragraph 8.49.

**¶ 8.49 Allowance of Generic Claim(s), Claims Stand Withdrawn as Not In Required Form**

Claim [1], directed to the species of [2] withdrawn from further consideration since [3] depend upon or otherwise include each of the limitations of an allowed generic claim as required by 37 CFR 1.141.

**Examiner Note:**

1. In bracket 2, insert identification of species followed by --, is-- or --, are--.
2. In bracket 3, insert --it does not-- or --they do not all--.

Note that each additional species is handled separately. When all of the claims to one nonelected species are embraced by an allowable generic claim but each of the claims to another nonelected species is not embraced by an allowable generic claim, applicant must be advised that the claims to the one nonelected species are no longer withdrawn from further consideration but that the claims to the other nonelected 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 set forth in form paragraph 8.50.

**¶ 8.50 Allowance of Generic Claim(s), Some Claims No Longer Considered Withdrawn**

Claim [1] generic and allowable. Accordingly, the restriction requirement as to the encompassed species is hereby withdrawn and claim [2], directed to the species of [3] no longer withdrawn from consideration since all of the claims to this species depend from or otherwise include each of the limitations of an allowed generic claim. However, claim [4], directed to the species of [5] remain withdrawn from consideration since [6] depend upon or otherwise include all the limitations of an allowed generic claim as required by 37 CFR 1.141.

In view of the above noted withdrawal of the restriction requirement as to the linked species, applicant(s) are advised that if any claim(s) depending from or including all the limitations of the allowable generic linking claim(s) be presented in a continuation or divisional application, such claims may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application. Once a restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. See *In re Ziegler*, 44 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP § 804.01.

**Examiner Note:**

1. In bracket 3, insert an identification of species followed by --, is-- or --, are--.
2. In bracket 5, insert an identification of species.
3. In bracket 6, insert --it does not-- or --they do not all--.

4. If all of the pending claims are in proper form, i.e., they include all the limitations of an allowed generic or linking claim, one of form paragraphs 8.45, 8.46 or 8.47 must be used.

When the application 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 must be advised of the allowance of a generic claim and given a time limit of 1 month (not less than 30 days) to conform all of the claims to the nonelected species to fully embrace an allowed generic claim or the examiner will cancel the claims to each nonconforming species by examiner's amendment and pass the application 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 or THIRTY DAYS from the date of this letter, whichever is longer, 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.

**809.02(d) No Species Claims**

Where only generic claims are presented, no restriction can be required except in those applications 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**

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 application should be as indicated in MPEP § 809.02(b), § 809.02(c), or § 809.02(d).

### 809.03 Linking Claims

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

(A) genus claims linking species claims;

(B) a claim to the necessary process of making a product linking proper process and product claims;

(C) a claim to “means” for practicing a process linking proper apparatus and process claims; and

(D) 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. Examiners should use Form Paragraph 8.12 to make restrictions involving linking claims.

#### ¶ 8.12 Restriction, Linking Claims

Claim [1] link(s) inventions [2] and [3]. The restriction requirement [4] the linked inventions is **subject to** the nonallowance of the linking claim(s), claim [5]. Upon the allowance of the linking claim(s), the restriction requirement as to the linked inventions **shall** be withdrawn and any claim(s) depending from or otherwise including all the limitations of the allowable linking claim(s) will be entitled to examination in the instant application. Applicant(s) are advised that if any such claim(s) depending from or including all the limitations of the allowable linking claim(s) is/are presented in a continuation or divisional application, the claims of the continuation or divisional application may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application. Where a restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. *In re Ziegler*, 44 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP § 804.01.

#### Examiner Note:

1. This form paragraph must be included in any restriction requirement with at least one linking claim present.

2. In bracket 4, insert either --between-- or --among--.
3. In bracket 5, insert the claim number(s) of the linking claims.
4. See related form paragraphs 8.45, 8.46 and 8.47.

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

### 809.04 Retention of Claims to Non-elected Invention

Where the requirement for restriction in an application is predicated upon the nonallowability of generic or other type of linking claims, applicant is entitled to retain in the case claims to the nonelected 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 nonelected inventions that are linked to the elected invention by such allowed linking claim.

Form paragraph 8.45 should be used to notify applicant of the allowance of a linking claim and that the nonelected claim(s) depending from or including all the limitations of the allowable linking claim, previously withdrawn from consideration, is/are rejoined and fully examined for patentability under 37 CFR 1.104.

#### ¶ 8.45 Allowance of Linking Claim(s), Nonelected Claims Not Canceled

Linking claim [1] allowed. Since the restriction requirement [2] inventions [3], as set forth in Paper No. [4] mailed on [5], was conditioned on the nonallowance of the linking claim(s), **the restriction requirement as to the linked inventions is hereby withdrawn**. Claim [6], previously withdrawn from consideration as a result of the restriction requirement, [7] hereby rejoined and fully examined for patentability under 37 CFR 1.104. In view of the withdrawal of the restriction requirement as to the linked inventions, applicant(s) are advised that if any claim(s) depending from or including all the limitations of the allowable linking claim(s) be presented in a continuation or divisional application, such claims may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application. Once the restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. See *In re Ziegler*, 44 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP § 804.01.

#### Examiner Note:

1. This form paragraph **must** be used upon the allowance of a linking claim following a restriction requirement with at least one linking claim present and wherein the nonelected claims have NOT been canceled. Use form paragraph 8.46 where the nonelected claims HAVE BEEN canceled.

2. In bracket 2, insert either --between-- or --among--.
3. In bracket 7, insert either --is-- or --are--.

Form paragraph 8.46 (or form paragraph 8.47 if appropriate) must be used to notify applicant of the allowance of a linking claim and that the nonelected claim(s) which depended from or included all the limitations of the allowable linking claim canceled by applicant may be reinstated by submitting the claim(s) in an amendment.

*¶ 8.46 Allowance of Linking Claim(s), Nonelected Claims Canceled, Other Issues Remain Outstanding*

Linking claim [1] allowed. Since the restriction requirement [2] inventions [3], as set forth in Paper No. [4] mailed on [5], was conditioned on the nonallowance of the linking claim(s), **the restriction requirement as to the linked inventions is hereby withdrawn.** Claim [6], which depended from or included all the limitations of the allowable linking claim(s), previously withdrawn from consideration as a result of the restriction requirement, [7] canceled by applicant in Paper No. [8]. The canceled, nonelected claim(s) may be reinstated by applicant if submitted in a timely filed amendment in reply to this action. Upon entry of the amendment, such amended claim(s) will be examined for patentability under 37 CFR 1.104.

In view of the withdrawal of the restriction requirement as to the linked inventions, applicant(s) are advised that if any claim(s) depending from or including all the limitations of the allowable linking claim(s) be presented in a continuation or divisional application, such claims may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application. Once the restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. See *In re Ziegler*, 44 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP § 804.01.

**Examiner Note:**

1. This form paragraph (or form paragraph 8.47) **must** be used upon the allowance of a linking claim following a restriction requirement with at least one linking claim present and wherein the nonelected claims HAVE BEEN canceled. Use form paragraph 8.45 where the nonelected claims have NOT been canceled.
2. If no issues remain outstanding and application is otherwise ready for allowance, use form paragraph 8.47 instead of this form paragraph.
3. In bracket 2, insert either --between-- or --among--.
4. In bracket 7, insert either --was-- or --were--.

*¶ 8.47 Allowance of Linking Claim(s), Nonelected Claims Canceled, No Outstanding Issues Remaining*

Linking claim [1] allowed. Since the restriction requirement [2] inventions [3], as set forth in Paper No. [4] mailed on [5], was conditioned on the nonallowance of the linking claim(s), **the restriction requirement as to the linked inventions is hereby withdrawn.** Claim [6], which depended from or included all the limitations of the allowable linking claim(s), previously withdrawn from consideration as a result of the restriction require-

ment, [7] canceled by applicant in Paper No. [8]. The canceled, nonelected claim(s) may be reinstated by applicant if submitted in an amendment, limited to the addition of such claim(s), filed within a time period of ONE MONTH, or THIRTY DAYS, whichever is longer, from the mailing date of this letter. Upon entry of the amendment, such amended claim(s) will be examined for patentability under 37 CFR 1.104. If NO such amendment is submitted within the set time period, the application will be passed to issue. PROSECUTION ON THE MERITS IS OTHERWISE CLOSED.

In view of the withdrawal of the restriction requirement as to the linked inventions, applicant(s) are advised that if any claim(s) depending from or including all the limitations of the allowable linking claim(s) be presented in a continuation or divisional application, such claims may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application. Once the restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. See *In re Ziegler*, 44 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP § 804.01.

**Examiner Note:**

1. This form paragraph (or form paragraph 8.46) **must** be used upon the allowance of a linking claim following a restriction requirement with at least one linking claim present and wherein the nonelected claims HAVE BEEN canceled. Use form paragraph 8.45 where the nonelected claims have NOT been canceled.
2. This form paragraph should be used only when there are no outstanding issues remaining and is to be used with only a PTO-90C cover sheet.
3. In bracket 2, insert either --between-- or --among--.
4. In bracket 7, insert either --was-- or --were--.

When a final requirement is contingent on the nonallowability 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. See 37 CFR 1.144 and MPEP § 818.03(c).

## 810 Action on the Merits

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

### 810.01 Not Objectionable When Coupled With Requirement

A basic policy of the present examining program is that the second action on the merits should be made final whenever proper. See 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 (Comm'r Pat. 1910). 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 § 812.01, if an action is given on the merits, *it must be given on all claims*.

### **810.02 Usually Deferred**

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 (Comm'r Pat. 1904); *Ex parte Snyder*, 1904 C.D. 242, 110 O.G. 2636 (Comm'r Pat. 1904); and *Ex parte Weston*, 1911 C.D. 218, 173 O.G. 285 (Comm'r Pat. 1911).

### **810.03 Given on Elected Invention When Requirement Is Made Final**

37 CFR 1.143 last sentence states: “[i]f 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.

### **811 Time for Making Requirement**

37 CFR 1.142(a), second sentence states: “[i]f 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 the need for 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 37 CFR 1.142(a) 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 Pat. 1904).

### **811.03 Repeating After Withdrawal Proper**

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 Application**

Even though inventions are grouped together in a requirement in a parent application, restriction or election among the inventions may be required in the divisional applications, if proper.

### **812 Who Should Make the Requirement**

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 Technology Center. Such an application should be transferred to a Technology Center to which at least some of the subject matter belongs.

### **812.01 Telephone Restriction Practice**

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 or agent of record and request an oral election, with or without traverse if desired, after the attorney or agent has had time to consider the restriction requirement. However, no telephone communication need be made where the requirement for restriction is complex, the application is being prosecuted by the applicant *pro se*, or the examiner knows from past experience that an election will not be made by telephone. The examiner should arrange for a second telephone call within a reasonable time, generally within 3 working days. If the attorney or agent 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 or agent'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 8.23.01 should be used to make a telephone election of record.

#### ¶ 8.23 Requirement, When Elected by Telephone

During a telephone conversation with [1] on [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 replying 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.

#### ¶ 8.23.01 Requirement, No 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 applicant or attorney or agent contacted.
2. In bracket 2, insert the date(s) of the telephone contact(s).
3. This form paragraph should be used in all instances where a telephone election was attempted and the applicant's representative did not or would not make an election.

4. This form paragraph should **not** be used if no contact was made with applicant or applicant's representative.

If, on examination, the examiner finds the elected claims to be allowable and no traverse was made, the letter should be attached to the Notice of Allowability form PTOL-37 and should include cancellation of the nonelected 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 Office Action Summary form 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 1 month to either cancel the nonelected claims or take other appropriate action. (37 CFR 1.144). Failure to take action will be treated as an authorization to cancel the nonelected claims by an examiner's amendment and pass the application 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 canceling the nonelected claims.

Where the respective inventions are located in different Technology Centers (TCs), the requirement for restriction should be made only after consultation with and approval by all TCs involved. If an oral election would cause the application to be examined in another TC, the initiating TC should transfer the application with a signed memorandum of the restriction requirement and a record of the interview. The receiving TC 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 patent examiner or TC 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 patent examiner.

## 814 Indicate Exactly How Application Is To Be Restricted

### 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 (Comm'r Pat. 1905), 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.

### 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.

### 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

The particular reasons relied on 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 on 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:

#### Examiner Note:

This form paragraph should be followed by one of form paragraphs 8.14-8.20.02 to show distinctness.



## 817 Outline of Letter for Restriction Requirement Between Distinct Inventions

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

(1) Identify each group by Roman numeral.

(2) List claims in each group. Check accuracy of numbering of the claims; look for same claims in two groups; and look for omitted claims.

(3) Give short description of total extent of the subject matter claimed in each group, pointing out critical claims of different scope and identifying whether the claims are directed to a combination, subcombination, process, apparatus, or product.

(4) Classify each group.

Form paragraphs 8.08-8.11 should be used to group inventions.

#### ¶ 8.08 Restriction, Two 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].

#### Examiner Note:

In bracket 1, insert the appropriate roman numeral, e.g., --V--, -VI--, etc.

(B) Take into account claims not grouped, indicating their disposition.

(1) Linking claims

(i) Indicate (make no action)

(ii) Statement of groups to which linking claims may be assigned for examination

(2) Other ungrouped claims

(3) Indicate disposition, e.g., previously non-elected, nonstatutory, canceled, etc.

(C) Allegation of distinctness

(1) Point out facts which show distinctness

(2) Treat the inventions as claimed, don't merely state the conclusion that inventions in fact are distinct

(i) Subcombination - Subcombination disclosed as usable together

Each usable alone or in other identified combination

Demonstrate by examiner's suggestion

(ii) Combination - Subcombination

Combination as claimed does not require subcombination

AND

Subcombination usable alone or in other combination

Demonstrate by examiner's suggestion

(iii) 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).

(iv) Process of making and/or Apparatus for making — Product made

Claimed product can be made by other process (or apparatus)

Demonstrate by examiner's suggestion

OR

Demonstrate process of making (or apparatus for making) can produce other product (rare)

(D) Provide reasons for insisting upon restriction

(1) Separate status in the art

(2) Different classification

(3) Same classification but recognition of divergent subject matter

- (4) Divergent fields of search, or
  - (5) Search required for one group not required for the other
- (E) Summary statement
- (1) Summarize (i) distinctness and (ii) reasons for insisting upon restriction, if applicable
  - (2) Include paragraph advising as to reply required.
  - (3) Indicate effect of allowances of linking claims, if any present
  - (4) Indicate effect of cancellation or nonallowance of evidence claims (see MPEP § 806.05(c))

One of form paragraphs 8.21.01 through 8.21.03 must be used at the conclusion of each restriction requirement.

*¶ 8.21.01 Conclusion to All Restriction Requirements: Different Classification*

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

**Examiner Note:**

THIS FORM PARAGRAPH (OR ONE OF FORM PARAGRAPHS 8.21.02 OR 8.21.03) MUST BE ADDED AS A CONCLUSION TO ALL RESTRICTION REQUIREMENTS employing any of form paragraphs 8.14 to 8.20.02.

*¶ 8.21.02 Conclusion to All Restriction Requirements: Recognized Divergent Subject Matter*

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

**Examiner Note:**

THIS FORM PARAGRAPH (OR ONE OF FORM PARAGRAPHS 8.21.01 OR 8.21.03) MUST BE ADDED AS A CONCLUSION TO ALL RESTRICTION REQUIREMENTS employing any of form paragraphs 8.14 to 8.20.02.

*¶ 8.21.03 Conclusion to All Restriction Requirements: Different Search*

Because these inventions are distinct for the reasons given above and the search required for Group [1] is not required for Group [2], restriction for examination purposes as indicated is proper.

**Examiner Note:**

THIS FORM PARAGRAPH (OR ONE OF FORM PARAGRAPHS 8.21.01 OR 8.21.02) MUST BE ADDED AS A CON-

CLUSION TO ALL RESTRICTION REQUIREMENTS employing any of form paragraphs 8.14 to 8.20.02.

Form paragraph 8.23.02 must be included in all restriction requirements for applications having joint inventors.

*¶ 8.23.02 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 request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

**Examiner Note:**

This form paragraph must be included in all restriction requirements for applications having joint inventors.

## 818 Election and Reply

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

A reply should be made 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 or her conclusion that the requirement is in error.

To be complete, a reply 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

Election may be made in other ways than expressly in reply to a requirement as set forth in MPEP § 818.02(a) and § 818.02(c).

**818.02(a) By Originally Presented Claims**

Where claims to another invention are properly added and entered in the application 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 in the application, and in any request for continued examination (RCE) which has been filed for the application. 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**

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 exam-

iner will at the same time act on the claims to the invention elected.

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

**818.03(a) Reply Must Be Complete**

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 reply to the Office action. The reply by the applicant or patent owner must be reduced to a writing which distinctly and specifically points out the supposed errors in the examiner's action and must reply 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 application or the reexamination proceeding 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**

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 reply 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**

*37 CFR 1.144. Petition from requirement for restriction.*

After a final requirement for restriction, the applicant, in addition to making any reply 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 8.25.02.

¶ 8.25.02 *Election Without Traverse Based on Incomplete Reply*

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 Nonallowance of Linking Claims**

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

Election combined with a traverse of the nonallowance 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 of making 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 where the process necessarily makes the product and 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**

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. Note that the applicant cannot, as a matter of right, file a request for continued examination (RCE) to obtain continued examination on the basis of claims that are independent and distinct from the claims previously claimed and examined (i.e., applicant cannot switch inventions by way of an RCE as a matter of right). 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 nonelected invention. *Ex parte Loewenbach*, 1904 C.D. 170, 110 O.G. 857 (Comm'r Pat. 1904) and *In re Waugh*, 135 F.2d 627, 57 USPQ 371 (CCPA 1943).

Where a continued prosecution application (CPA) filed under 37 CFR 1.53(d), is a continuation of its parent application and not a divisional, or where a File Wrapper Continuation (FWC) filed under former 37 CFR 1.62, is a continuation of its parent application and not a divisional or C-I-P, an express election made in the prior (parent) application in reply to a restriction requirement carries over to the CPA or FWC application unless otherwise indicated by applicant. In no other type of continuing application may an election carry over from the prior application.

Where there is no indication in the CPA or FWC application that a change in election is desired, the examiner's first action should include a repetition of

the restriction requirement made in the prior application to the extent it is still applicable in the CPA or FWC application and a statement that prosecution is being continued on the invention elected and prosecuted by applicant in the prior application. Examples of what is meant by the phrase “otherwise indicated by applicant” would be where the CPA or FWC is filed as (A) a divisional or (B) a continuation and includes an amendment filed prior to first action in the CPA or FWC adding claims to an invention not previously elected. In each of these examples the examiner should make a new restriction requirement in the first action.

### **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 Pat. 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 (Comm’r Pat. 1901).

Where a product is elected, there is no shift where examiner holds invention to be in the process. *Ex parte Grier*, 1923 C.D. 27, 309 O.G. 223 (Comm’r Pat. 1923).

Where a genus is allowed, applicant may prosecute a reasonable number of additional species thereunder, in accordance with 37 CFR 1.141. This does not constitute a shift. *Ex parte Sharp*, Patent No. 2,232,739.

### **820.01 Old Combination Claimed — Not an Election**

Where an application originally presents claims to a combination (AB) and the examiner holds the novelty, if any, to reside only in the subcombination (B) *per se* (see MPEP § 806.05(b)), and the claims directed to the combination are rejected, subsequently presented claims to subcombination (B) of the originally claimed combination should not be held constructively nonelected on the ground of previous election of the combination. See MPEP § 821.03. *Ex parte Donnell*, 1923 C.D. 54, 315 O.G. 398 (Comm’r Pat. 1923). The combination and subcombination as defined by the claims under this special situation are not for distinct inventions. See MPEP § 806.05(c).

### **820.02 Interference Issues — Not an Election**

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 Nonelected Inventions**

Claims held to be drawn to nonelected inventions, including claims to nonelected 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*, 440 F.2d 1395, 169 USPQ 473 (CCPA 1971).

All claims that the examiner holds as not being directed to the elected subject matter are withdrawn from further consideration by the examiner in accordance with 37 CFR 1.142(b). See MPEP § 809.02(c) and § 821.01 through § 821.03. The examiner should clearly set forth in the Office action the reasons why the claims withdrawn from consideration are not readable on the elected invention. Applicant may traverse the requirement pursuant to 37 CFR 1.143. If a final requirement for restriction is made by the examiner, applicant may file a petition under 37 CFR 1.144 for review of the restriction requirement.

## 821.01 After Election With Traverse

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 [4].

The requirement is still deemed 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(s) 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 pursuant to 37 CFR 1.142(b), as being drawn to a nonelected [2], there being no (allowable) generic or linking claim. Applicant timely traversed the restriction (election) requirement 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 reply must include cancellation of the claims drawn to the nonelected invention, or other appropriate action (37 CFR 1.144). See form paragraph 8.24.

### ¶ 8.24 Reply to Final Must Include Cancellation

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

#### Examiner Note:

For use in FINAL rejections of applications containing claims nonelected with traverse.

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

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 application is ready for allowance after appeal and no petition has been filed, the examiner should simply cancel the nonelected 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. Form paragraphs 8.25.01 or 8.25.02 should be used by the examiner to acknowledge the election without traverse.

### ¶ 8.25.01 Election Without Traverse

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

### ¶ 8.25.02 Election Without Traverse Based on Incomplete Reply

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)).

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 pursuant to 37 CFR 1.142(b) as being drawn to a nonelected [2], there being no allowable generic or linking claim. 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 application is otherwise ready for issue, the claims to the nonelected invention, including nonelected species, may be canceled by an examiner's amendment, and the application passed to issue. However, where the application contains an allowed generic claim, and applicant has not been previously notified as to the allowance of a generic claim, the examiner must, prior to canceling the nonelected claims, notify applicant of the allowance of a generic claim and give applicant a time limit of 1-month (not less than 30 days) to conform all of the claims to the nonelected species to fully embrace an allowed generic claim. See MPEP § 809.02(c). 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 canceled.

**Examiner Note:**

In bracket 2, insert --an invention--, --inventions--, --a species--, or --species--.

### 821.03 Claims for Different Invention Added After an Office Action

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 independent 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 nonelected invention should not be entered. Such an amendment is nonresponsive. Applicant should be notified by using form paragraph 8.26.

¶ 8.26 *Canceled Elected Claims, Non-Responsive*

The amendment filed on [1] canceling 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].

Since the above-mentioned amendment appears to be a *bona fide* attempt to reply, applicant is given a TIME PERIOD of ONE (1) MONTH or THIRTY (30) DAYS, whichever is longer, from the mailing date of this notice within which to supply the omission or correction in order to avoid abandonment. EXTENSIONS OF THIS TIME PERIOD UNDER 37 CFR 1.136(a) ARE AVAILABLE.

### 821.04 Rejoinder

Where product and process claims drawn to independent and distinct inventions are presented in the same application, applicant may be called upon under 35 U.S.C. 121 to elect claims to either the product or process. See MPEP § 806.05(f) and § 806.05(h). The claims to the nonelected invention will be withdrawn from further consideration under 37 CFR 1.142. See MPEP § 809.02(c) and § 821 through § 821.03. However, if applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn process claims which depend from or otherwise include all the limitations of the allowable product claim will be rejoined.

Where the application as originally filed discloses the product and the process for making and/or using the product, and only claims directed to the product are presented for examination, when a product claim is found allowable, applicant may present claims directed to the process of making and/or using the patentable product by way of amendment pursuant to 37 CFR 1.121. In view of the rejoinder procedure, and in order to expedite prosecution, applicants are encouraged to present such process claims, preferably as dependent claims, in the application at an early stage of prosecution. Process claims which depend from or otherwise include all the limitations of the patentable product will be entered as a matter of right if the amendment is presented prior to final rejection or allowance. Amendments submitted after final rejection are governed by 37 CFR 1.116. Process claims which do not depend from or otherwise include the limitations of the patentable product will be withdrawn from consideration, via an election by original presentation (see MPEP § 821.03). Amendments submitted after allowance are governed by 37 CFR 1.312. Process claims which depend from or otherwise include all the limitations of an allowed product claim and which meet the requirements of 35 U.S.C. 101, 102, 103, and 112 may be entered.

Where applicant voluntarily presents claims to the product and process in separate applications (i.e., no restriction requirement was made by the Office), and one of the applications issues as a patent, the remaining application may be rejected under the doctrine of obviousness-type double patenting, where appropriate (see MPEP § 804 - § 804.03), and applicant may overcome the rejection by the filing of a terminal disclaimer under 37 CFR 1.321(c) where appropriate. Similarly, if copending applications separately present product and process claims, provisional obviousness-type double patenting rejections should be made where appropriate. However, once a determination as to the patentability of the product has been reached any process claim which contains limitations identical to the allowed/allowable product should not be rejected over prior art without consultation with a Technology Center Director.

Where product and process claims are presented in a single application and that application qualifies under the transitional restriction practice pursuant to 37 CFR 1.129(b), applicant may either: (A) elect the

invention to be searched and examined and pay the fee set forth in 37 CFR 1.17(s) and have the additional inventions searched and examined under 37 CFR 1.129(b)(2); or (B) elect the invention to be searched and examined and not pay the additional fee (37 CFR 1.129(b)(3)). Where no additional fee is paid, if the elected invention is directed to the product and the claims directed to the product are subsequently found patentable, process claims which either depend from or include all the limitations of the allowable product will be rejoined. If applicant chooses to pay the fees to have the additional inventions searched and examined pursuant to 37 CFR 1.129(b)(2) even if the product is found allowable, applicant would not be entitled to a refund of the fees paid under 37 CFR 1.129(b) by arguing that the process claims could have been rejoined. 37 CFR 1.26(a) states that “[T]he Commissioner may refund any fee paid by mistake or in excess of that required. A change of purpose after the payment of a fee...will not entitle a party to a refund of such fee...” In this case, the fees paid under 37 CFR 1.129(b) were not paid by mistake nor paid in excess, therefore, applicant would not be entitled to a refund.

In the event of rejoinder, the rejoined process claims will 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. If the application containing the rejoined claims is not in condition for allowance, the subsequent Office action may be made final, or, if the application was already under final rejection, the next Office action may be an advisory action.

Form paragraphs 8.42 through 8.44 should be used to notify applicant of the rejoinder of process claims which depend from or otherwise include all the limitations of an allowable product claim.

#### *¶ 8.42 Rejoinder of Less Than All Process Claims*

Claim [1] directed to an allowable product. Pursuant to the procedures set forth in the *Official Gazette* notice dated March 26, 1996 (1184 O.G. 86), claim [2], directed to the process of making or using the patentable product, previously withdrawn from consideration as a result of a restriction requirement, [3] now subject to being rejoined. Process claim [4] hereby rejoined and fully examined for patentability under 37 CFR 1.104. In accordance with the *Official Gazette* notice, *supra*, process claim [5], which [6] not depend from or otherwise include all the limitations of the allowable product, [7] NOT been rejoined.



**Examiner Note:**

1. If ALL previously withdrawn claims are being rejoined, then form paragraph 8.43 should be used instead of this form paragraph.
2. If other non-process claims are present and are NOT being rejoined, use form paragraph 8.44 instead of this form paragraph.
3. In bracket 1, insert the claim number(s) of the allowable product claims followed by either -- is-- or -- are--.
4. In bracket 2, insert the claim number(s) of ALL process claims previously withdrawn from consideration.
5. In bracket 3, insert either --is-- or --are--.
6. In bracket 4, insert the number(s) of the rejoined process claims.
7. In bracket 5, insert the number(s) of the process claims NOT being rejoined followed by either -- is-- or -- are--.
8. In bracket 6, insert --do-- or --does--.
9. In bracket 7, insert --has-- or --have--.
10. If rejoinder occurs after the first Office action on the merits and if any of the rejoined claims are unpatentable, e.g., if a rejection under 35 U.S.C. 112, first paragraph is made, then the next Office action may be made final since the new ground of rejection was necessitated by applicant's reply.

*¶ 8.43 Rejoinder of All Previously Withdrawn Claims*

Claim [1] directed to an allowable product. Pursuant to the procedures set forth in the *Official Gazette* notice dated March 26, 1996 (1184 O.G. 86), claim [2], directed to the process of making or using the patentable product, previously withdrawn from consideration as a result of a restriction requirement, [3] now subject to being rejoined. Claim [4] hereby rejoined and fully examined for patentability under 37 CFR 1.104.

Since all claims previously withdrawn from consideration under 37 CFR 1.142 have been rejoined, the restriction requirement made in the Paper No. [5] is hereby withdrawn.

**Examiner Note:**

1. If LESS THAN ALL previously withdrawn process claims are being rejoined, then form paragraph 8.42 should be used instead of this form paragraph. If LESS THAN ALL previously withdrawn claims are being rejoined, then form paragraph 8.44 should be used instead of this form paragraph.
2. In bracket 1, insert the claim number(s) of the allowable product claim(s) followed by either -- is-- or -- are--.
3. In bracket 2, insert the claim number(s) of the process claim(s) previously withdrawn from consideration.
4. In bracket 3, insert either --is-- or --are--.
5. In bracket 4, insert the number(s) of the process claims being rejoined (should correspond to bracket 2 insert).
6. If rejoinder occurs after the first Office action on the merits and if any of the rejoined claims are unpatentable, e.g., if a rejection under 35 U.S.C. 112, first paragraph is made, then the next Office action may be made final since the new ground of rejection was necessitated by applicant's reply.

*¶ 8.44 Rejoinder of Process Claims, Other Claims Present and Not Rejoined*

Claim [1] directed to an allowable product. Pursuant to the procedures set forth in the *Official Gazette* notice dated March 26,

1996 (1184 O.G. 86), claim [2], directed to the process of making or using the patentable product, previously withdrawn from consideration as a result of a restriction requirement, [3] now subject to being rejoined. Process claim [4] hereby rejoined and fully examined for patentability under 37 CFR 1.104. Claim [5], not directed to the process of making or using the patentable product, will not be rejoined.

**Examiner Note:**

1. If LESS THAN ALL previously withdrawn process claims are being rejoined, then form paragraph 8.42 should be used instead of this form paragraph. If ALL previously withdrawn claims are being rejoined then form paragraph 8.43 should be used instead of this form paragraph.
2. In bracket 1, insert the claim number(s) of the allowable product claim(s) followed by either -- is-- or -- are--.
3. In bracket 2, insert the claim number(s) of the process claim(s) previously withdrawn from consideration.
4. In bracket 3, insert either --is-- or --are--.
5. In bracket 4, insert the number(s) of the process claims being rejoined (should correspond to bracket 2 insert).
6. In bracket 5, insert the number(s) of all previously withdrawn claims which are not being rejoined.
7. If rejoinder occurs after the first Office action on the merits and if any of the rejoined claims are unpatentable, e.g., if a rejection under 35 U.S.C. 112, first paragraph is made, then the next Office action may be made final since the new ground of rejection was necessitated by applicant's reply.

See MPEP § 706.02(n) for the applicability of 35 U.S.C. 103(b) to biotechnological processes and compositions of matter.

See MPEP § 2116.01 for guidance on the treatment of process claims which make or use a novel, nonobvious product.

See MPEP § 806.05(c) for rejoinder of restricted combination/subcombination inventions when an evidence claim is found to be unallowable, and see MPEP § 809 and § 809.04 for rejoinder of restricted inventions when a linking claim is found allowable.

## 822 Claims to Inventions That Are Not Distinct in Plural Applications of Same Inventive Entity

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 § 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(i) 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 No. [3]. 37 CFR 1.78(b) provides that when 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 only when the conflicting claims are patentably distinct.

## 822.01 Copending Before the Examiner

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

\*\*\*\*\*

(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.

\*\*\*\*\*

37 CFR 1.130. *Affidavit or declaration to disqualify commonly owned patent or published application as prior art.*

\*\*\*\*\*

(b) When an application or a patent under reexamination 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 or a patent under reexamination. A judicially created double patenting rejection may be obviated by filing a terminal disclaimer in accordance with § 1.321(c).

\*\*\*\*\*

Where claims in one application are unpatentable over claims of another application of the same inventive entity (or different inventive entity with common ownership) 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. See also MPEP § 804.01 and § 822.

### ONLY PROVISIONAL DOUBLE PATENTING REJECTION REMAINING 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. See also MPEP § 804.01 and § 822.

### ONLY PROVISIONAL DOUBLE PATENTING REJECTIONS REMAINING IN BOTH APPLICATIONS

If the “provisional” double patenting rejections in both applications 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**

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



MANUAL OF PATENT EXAMINING PROCEDURE