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Procedural Changes to Reduce Multiplication of Applications on Same Invention Restriction/Unity of Invention

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June 18, 2010

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1



Restriction Practice in the U.S.

- **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...



Restriction Practice in the U.S. MPEP 803

- **MPEP 803 Restriction - When Proper [R-3]**
- Under the statute, the claims of 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 or distinct.
- If the search and examination of all the claims in an application can be made without serious burden, the examiner must examine them on the merits, even though they include claims to independent or distinct inventions.



Restriction Practice in the U.S. 2004 TC 1600 Action Plan

- (1) publish examples of claim sets,
- (2) emphasize rejoinder practice,
- (3) deliver and publish updated examiner training on restriction practice,
- (4) enhance the quality review of restriction requirements, and
- (5) assess the progress of the action plan.



Restriction Practice in the U.S. Examiner guidelines

- Independent inventions – not disclosed as capable of use together or as connected in design, operation or effect
- Related inventions
 - subcombinations usable together
 - Combination/subcombination



Restriction Practice in the U.S. Examiner guidelines (cont'd)

- Related inventions (cont'd)
 - Process and apparatus for its use
 - Product and process for making
 - Apparatus and product made
 - Product and process for using
 - Intermediate/final product
 - Special case: Product, process of making and process of using



Restriction Practice in the U.S. Examiner guidelines (cont'd)

- Criteria for burden
 - Separate classification
 - Separate status in the art
 - Divergent fields of search



Restriction Practice in the U.S. Examiner guidelines (cont'd)

- Linking claims
 - One or more claims inseparable from claims to two or more otherwise properly divisible inventions
 - When found allowable, linking claims prevent maintaining a restriction requirement between inventions that are otherwise divisible



Restriction Practice in the U.S. Examiner guidelines (cont'd)

- Linking claims (cont'd)
 - Genus claims linking species claims
 - Claim to necessary process of making a product linking proper process and product claims
 - Claim to “means” for practicing a process linking proper apparatus and process claims
 - Claim to the product linking a process of making and a process of using



Restriction Practice in the U.S. Examiner guidelines (cont'd)

- Effect of Linking claims
 - If generic or linking claim is allowed, restriction requirement must be withdrawn
 - When a restriction requirement is withdrawn, 35 USC 121 no longer shields claims from double patenting if they issue in different patents



Restriction Practice in the U.S. Examiner guidelines (cont'd)

- Election of species
 - Must elect a single disclosed species for prosecution on the merits, to which claims will be restricted if no generic claim is allowable
 - In response, Applicant must list all claims readable on the species
 - Upon allowance of generic claim, applicant is entitled to consideration of claims to additional species written in dependent form



Restriction Practice in the U.S. Examiner guidelines (cont'd)

- Markush practice
 - Unity of invention
 - Compounds have a common utility
 - Compounds as a whole have a substantial structural similarity



Restriction Practice in the U.S. Examiner guidelines (cont'd)

- <http://www.uspto.gov/web/patents/tc1600restrictionmaterials.pdf>



“Advantages” of Restriction Practice

- Gives Examiner more time to do a thorough search/examination
- Generates additional fees for the Patent Office
- Makes it easier for third parties to evaluate the scope of the invention claimed in each patent – not true because patent attorneys/agents (who should be consulted for advice) routinely deal with multiple claims (method and apparatus)



Disadvantages of Restriction Practice

- Adds administrative burden on PTO to process a duplicate file
- New EPO rules are particularly burdensome because additional files are created that may never be examined, but nevertheless add to the backlog
- Examiner inefficiency – he/she must reacquaint himself/herself with the file at a later date



Disadvantages of Restriction Practice (cont'd)

- Practice is difficult for inventors to understand because they believe all aspects of the idea are related
- Should elect not only which “invention” is commercially important, but also which is free from prior art
- Additional maintenance fees/annuities add to the cost of patenting an invention



Possible solutions

- Give Examiners incentives to examine more than one “invention” (e.g., additional time per application)
- Patent Office could charge additional fees for each group searched and examined in a single application, which will be less than additional filing, grant and maintenance fees/annuities associated with the divisional application
- Examiner could provide art to assist in electing a group



THANK YOU!