

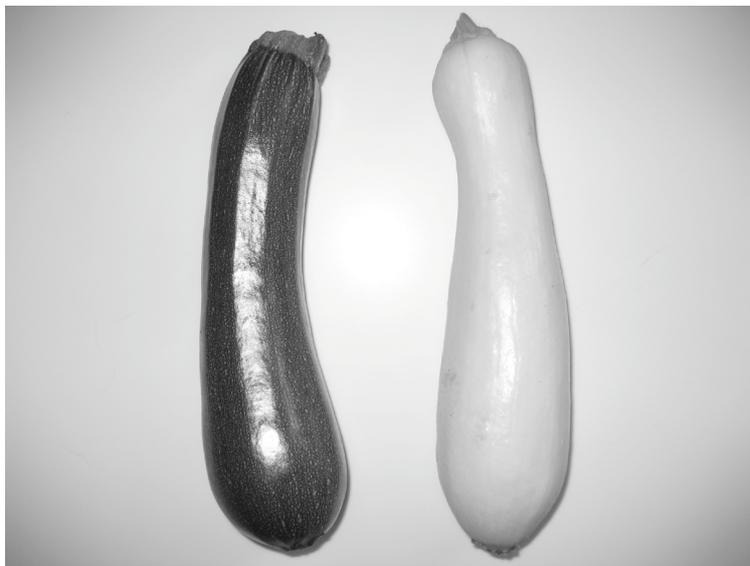
The Limited Monopoly™

Election of Species and Restriction Requirements

by Robert Gunderman, PE and John Hammond, PE

Restriction Requirements - a Brief Refresher¹

The patent rules essentially state that “Two or more independent and distinct inventions may not be claimed in one national application...”.² So one of the first things an Examiner will look for during prosecution is whether two or more independent and distinct inventions are claimed in a single patent application. If the Examiner believes this to be the case, an Office Action containing a “requirement for restriction” will be forthcoming. Sometimes a requirement for restriction is surprising, because the claims all appear directed at a single invention, despite what the Examiner has stated. Frequently an application with product and process claims will receive a restriction requirement. For a restriction requirement to be properly made, two criteria must be met. First, the Examiner must show that the claims are distinct and second, that there would be a serious burden on the Examiner if the restriction were not made. The serious burden part essentially means that multiple search and examination iterations would need to be made by the Examiner. If the Examiner cannot show that both criteria are present, the restriction requirement is not proper. An Applicant may (usually by way of a patent practitioner) attempt to traverse (argue) that the restriction requirement is not proper, and if successful (usually not), the Examiner will withdraw the restriction requirement. Regardless of whether a traversal is attempted, the Applicant must elect one group of claims to be Examined for the reply to the Office Action to be proper.



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When a Restriction is Not Proper

A Restriction Requirement is not proper if the search and examination of all claims in an application can be made without serious burden on the Examiner. If there is no serious burden, the Examiner must examine all claims in the application, even if the claims are drawn to independent or distinct inventions.

A Restriction Requirement must also be retracted if there is an express admission by the Applicant that the claimed inventions are obvious over each other within the meaning of 35 U.S.C. 103. Such an admission will surely get the restriction requirement removed,

but has serious legal ramifications, and should only be done with the advice of an experienced patent practitioner. Among other things, such an admission may get your entire set of claims rejected instead of perhaps only a subset of the claims.

Rejoinder- What is it?

Any review of Restrictions and Elections would not be complete with a brief explanation of what Rejoinder is. After a Restriction Requirement is responded to and the Examiner finds the set of claims that you have elected

allowable, the restriction requirement may be withdrawn by way of a process called Rejoinder only if all claims to the non-elected invention depend from or otherwise require all of the limitations of an allowable claim. This does not mean that the rejoined claims are not examined; they still must be fully examined, but they are rejoined to the same application.

Election of Species

A Restriction Requirement contends that there are multiple inventions claimed in a patent application. Say a computer and a two seat sports car are claimed in a single application. (The only similarity we can see is their potential to crash being directly related to the manufacturer.) An Election of Species, on the other hand, does not contend that there are multiple inventions claimed, but that there are different species of the same invention. A species being different embodiments (versions) of the same invention. Say a laptop computer, a tablet computer, and a PDA. Species are often disclosed as examples or figures in the application. Claims are never species.³

An Election of Species is really quite different than a Restriction Requirement; unfortunately for the Applicant the two are oftentimes confused. In a Restriction Requirement, if you attempt to traverse and your argument is found to be persuasive, the Examiner will withdraw the Requirement. This is unlikely, but can happen. In an election of species, a traversal may be considered an admission by the applicant that the species are identical, and a rejection of one species will lead to a rejection of the other species.

Unless you are able to traverse a Restriction Requirement, you will need to file separate patent applications for each non-elected invention in order to keep those claims alive. In an Election of Species, however, the Examiner is limiting the scope of work to be done during examination, and once some allowable subject matter is found, the Examiner will examine the non-elected claims.

In a Restriction Requirement, you must elect the claims to be examined. With an Election of Species, you elect an invention that is usually indicated by drawing numbers, and then you must indicate which claims relate to that species.

Genus or Generic Claims

A Genus or Generic claim is a claim that encompasses two or more species within its scope.⁴ The claim is thus generic, or common to the two or more versions (species) that are contained in the patent application. These Genus or Generic claims may be separated out during the Election of Species process, and may also be examined later once the Examiner has found allowable subject matter.

Election of Species and Restriction Requirements

Like every facet of patent practice, there is much more to this topic than can be discussed in a short article. While the differences between an Election of Species and a Restriction Requirement may appear subtle, in practice the differences are very important to your overall approach to patent prosecution and your strategy with regard to the development of a patent position for your product or company. While it is advisable to consult with an experienced patent practitioner before taking actions related to Election of Species and Restriction Requirements, knowing a few of the basics and some of the potential pitfalls will help you to better create a fortified and valuable patent position for your business.

1. See also "[The Limited Monopoly™](#)" June 2008
2. 37 C.F.R. §1.141.
3. MPEP 806.04(e)
4. MPEP 806.04(d)

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"Zucchini and Summer Squash- Similar Yet Different"*