

Restriction Requirements



Restriction Requirements

- Three different types:
 - Restriction (U.S.)
 - Elections of Species
 - Unity of Invention Requirement (PCT)
- Requirement set forth in Office Action
 - Typically made in first Office Action issued
 - Can be made at any time prior to final action
- Period for reply is short
 - 2-month / 60 day period for reply is normal
 - Examiner can set at 3-month by preference
 - This is usually done by mistake, but allowed (and favorable)



Restriction Requirements

- Restrictions
 - Distinct or Independent inventions claimed
 - Identified by “Groups” (of claims)
- Elections of Species
 - Multiple embodiments disclosed in the specification
 - Identified by “Species”
 - Claims cover one or more species
- Unity of Invention Requirement
 - Claims cover inventions lacking unity
 - Identified by “Inventions”
 - Claims must relate to one invention only or to a group of inventions so linked as to form a single general inventive concept
 - Used in U.S. National Phase applications based on PCT rules



Practice Point

- How a foreign application enters the U.S. matters for Restriction Practice
 - A “bypass continuation, or paris convention” application is examined under *U.S.* restriction practice
 - A “national phase” application is examined under *PCT* restriction practice
- For a given case, this could make a difference as to whether a restriction requirement is received.

Restriction Requirements -US

- Restriction is proper when the inventions are:
 - Independent or Distinct, as claimed, and
 - There exists a serious burden on the Examiner if restriction is not made
 - MPEP 803 defines *prima facie* cases of serious burden as:
 - separate classification,
 - separate status in the art, or
 - different field of search
 - If any of these can be shown, a rebuttal presumption is created that a serious burden exists
 - If none can be shown, restriction is not proper



Example US Restriction

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. **Claims 1-6 and 13**, drawn to a positive active material and a lithium secondary battery, classified in 429/219.
 - II. **Claims 7-12**, drawn to method of preparing a positive active material, classified in 29/623.1.

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

2. Inventions I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make another and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the positive active material can be made by another and materially different process such as the nanoparticles could be grown on the oxide surface by chemical vapor deposition instead of the claimed mixing and forced coating process.

Unity of Invention - PCT

- When a single PCT application or U.S. National Phase application claims a group of inventions
 - The inventions must have a technical relationship among those inventions involving one or more of the same or corresponding special technical features (STF)
 - STF means those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art
 - STF cannot be a feature that is known in the prior art



PCT Restriction

1. REQUIREMENT FOR UNITY OF INVENTION

As provided in 37 CFR 1.475(a), a national stage application shall relate to one invention only or to a group of inventions so linked as to form a single general inventive concept (“requirement of unity of invention”). Where a group of inventions is claimed in a national stage application, the requirement of unity of invention shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features. The expression “special technical features” shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art.

The determination whether a group of inventions is so linked as to form a single general inventive concept shall be made without regard to whether the inventions are claimed in separate claims or as alternatives within a single claim. See 37 CFR 1.475(e).

PCT Restriction

WHEN CLAIMS ARE DIRECTED TO MULTIPLE CATEGORIES OF INVENTIONS

As provided in 37 CFR 1.475(b), a national stage application containing claims to different categories of invention will be considered to have unity of invention if the claims are drawn only to one of the following combinations of categories:

- (1) A product and a process specially adapted for the manufacture of said product; or
- (2) A product and process of use of said product; or
- (3) A product, a process specially adapted for the manufacture of the said product, and a use of the said product; or
- (4) A process and an apparatus or means specifically designed for carrying out the said process; or
- (5) A product, a process specially adapted for the manufacture of the said product, and an apparatus or means specifically designed for carrying out the said process.

Otherwise, unity of invention might not be present. See 37 CFR 1.475(c).

PCT Restriction

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1-11, drawn to a method for inducing stem cell differentiation on a scaffold.

Group II, claim(s) 12-13, drawn to a renal tissue cell.

Group III, claim(s) 14, drawn to a bioartificial organ.

Group IV, claim(s) 15, drawn to a material for medical purposes.

Group V, claim(s) 16-17, drawn to a method for producing an artificial organ.

Group VI, claim(s) 18-19, drawn to a method for inducing differentiation of stem cells into tissue cells with polycystic kidney-like morphology.

Group VII, claim(s) 20, drawn to tissue cells with polycystic kidney-like morphology.

Practical Effects

- The U.S., in general, is much more likely to allow multiple claims in the same category without restriction (although election of species may be required)
- The PCT, in general, is much more likely to allow multiple categories (so long as they are linked by a common technical feature)

Restrictions

- Imposed by Examiner to limit patent application to only one independent or distinct invention
 - “Independent” means completely unrelated
 - No disclosed relationship between the inventions claimed, i.e., the inventions are unconnected in design, operation, and effect
 - “Distinct” means somehow related, but separate
 - Related inventions are distinct if the inventions as claimed are not connected in at least one of design, operation, or effect (e.g., can be made by, or used in, a materially different process) and
 - At least one invention is patentable (novel and nonobvious) over the other
 - although both inventions may each be unpatentable over prior art



Related Invention Examples

- Process and Apparatus for Its Practice



- Distinctness can be shown if:

- The process as claimed can be practiced by another materially different apparatus or by hand, or
- The apparatus as claimed can be used to practice another materially different process

- Process of Making and Product Made



- Distinctness can be shown if:

- 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
- The product as claimed can be made by another and materially different process

Related Invention Examples

- Apparatus and Product Made



- Distinctness can be shown if:

- 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
- The product claimed can be made by another and materially different apparatus

- Product and Process of Using



- Distinctness can be shown if:

- The process of using as claimed can be practiced with another materially different product, or
- The product as claimed can be used in a materially different process

To Traverse or Not?

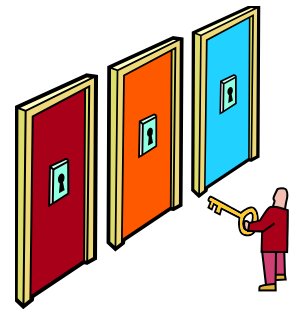
- In general, we advise *not* to traverse restriction requirements.

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.


- The applicant *must* concede that the groups or species are obvious – thus, a prior art rejection against one, may impact patentability of both.

Restrictions

- In reply to a restriction, election of an invention, by identifying a Group of claims, must be made
 - Even if the restriction is being traversed, a provisional election must still be made
 - Traversal should be made carefully
 - Substantive traversal of restriction may result in an admission that the identified inventions are not patentably distinct
 - Traversal on the grounds that no serious burden exists is always safe
 - However, not generally effective, as Examiners have a wide discretion in this area



Restrictions

- Claims reading on the non-elected inventions, if not canceled, are nevertheless withdrawn from further consideration by the election
 - Withdrawn claims are subject to reinstatement in the event the requirement for restriction is withdrawn or overruled
- If no traversal, or non-successful traversal, restriction is made final 
 - After restriction is made final, claims / amendments cannot be presented that are directed to a non-elected invention
 - Pursue non-elected inventions in divisional applications
 - Divisional applications must each contain claims relating to only one invention or further restrictions will be required

When to Traverse

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

- I. Claims 1-13, drawn to a method for recovery olefins from a methanol to olefins reactor effluent, classified in 585
- II. Claims 14-16, drawn to a method for recovery olefin from a hydrocarbon mixture, classified in 585.
- III. Claim 17, drawn to an apparatus system, classified in 210.

U.S. Traversal Example

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

Inventions I and III 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 and 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, the apparatus system can be used in a process for separating sulfur compounds from hydrocarbons.

Inventions I and II are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different designs, modes of operation, and effects (MPEP § 802.01 and § 806.06). In the instant case, the different inventions have different effects because one invention involve with converting methanol to olefins whereas another does not involve such conversion.

Successful Traversal -US

- Applicant traverses the restriction of Groups I and II, and believes claims 1-13 and 14-16 can be examined together. Initially, it is noted that both Group I and Group II are drawn to methods for recovery of olefins, and each are classified in 585. Accordingly, there would not be a serious search burden on the Examiner.

Successful Traversal - US

- Further, Applicant notes that the Examiner relies on MPEP form paragraph 8.20.02, “Unrelated Inventions.” The Examiner’s Note for this form paragraph, note 1, indicates that form paragraph 8.20.02 is “to be used only when claims are presented to unrelated inventions, e.g., a necktie and a locomotive bearing not disclosed as capable of use together.” In the instant case, the method of claims 1-13 and that of claims 14-16 are not as disparate as a necktie and a bearing.
- Rather, Applicant notes that both Group I and Group II are each related to a method of recovery of olefins. This is evident by the Examiner’s own description of the groups. Further, the “effect” of both method groups is the separation and recovery of olefins from a mixture; the source of the mixture is not an “effect” as asserted by the Examiner. For the foregoing reasons, Applicant requests that claims 1-16 be examined together.

U.S. Restriction Tips

- *Only* traverse in situations where the restriction is clearly erroneous
- Consider whether rejoinder is likely
 - *i.e.*, claim is just a method of using the product.
 - *If the product is patentable, the method will be rejoined, so pointless to argue*

PCT Traversal

- Under PCT Rule 13.2, unity of invention exists when there is a technical relationship among the claimed inventions involving one or more special technical features. The term “special technical features” is defined as meaning those technical features that define a contribution which each of the inventions considered as a whole, makes over the prior art.
- The determination is made based on the contents of the claims as interpreted in light of the description and drawings. “If...there is a single general inventive concept that appears novel and involves inventive step, then there is unity of invention and an objection of lack of unity does not arise...the benefit of any doubt being given to the applicant.” MPEP § 1850. (Emphasis added).

PCT Traversal

- “Although lack of unity of invention should certainly be raised in clear cases, it should neither be raised nor maintained on the basis of a narrow, literal or academic approach.”
- Applicant respectfully notes that the International Searching Authority did not reject these claims for lack of unity of invention.

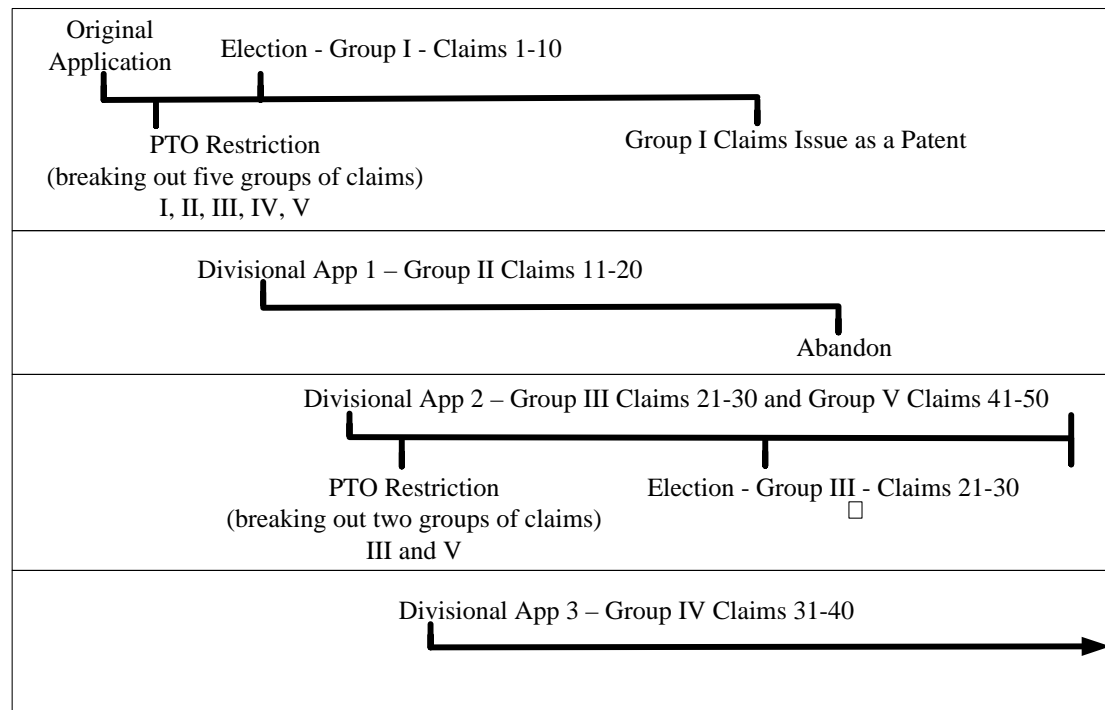
PCT Tips

- *Very* difficult to successfully argue PCT, unless the special technical feature is clearly patentable over the prior art
- Examiner will often cite prior art as negating a STF, which is usually then used in an OA. Amendments made can help with both the RR and anticipated OA
- Consider whether to enter as a bypass continuation if you have multiple claims in the same category

Restrictions

- Divisional Applications

- Can be filed at any time during pendency of parent
- Example:



Restrictions

- Rejoinder
 - Rejoinder involves withdrawal of a restriction requirement between an allowable elected invention and a non-elected invention, and examination of the formerly non-elected invention on the merits
 - The propriety of a restriction requirement should be reconsidered when all the claims directed to the elected invention are in condition for allowance
 - In order to be eligible for rejoinder, a claim to a non-elected invention must depend from or otherwise require all the limitations of an allowable claim
 - Amendments may be made to make rejoinder more likely



Restrictions

- Rejoinder example
 - Restriction is made between a product and a process of making and/or using the product
 - Where the product invention is elected and subsequently found to be allowable:
 - All claims to a non-elected process invention that depend from, or otherwise require all the limitations of, an allowable claim are eligible for rejoinder
 - If applicant cancels all the claims directed to a non-elected process invention before rejoinder cannot occur
 - Rejoined claims are not allowed, merely examined
 - All criteria for patentability must be separately met
 - That is, the requirements of 35 U.S.C. 101, 102, 103 and 112



Election of Species

- Imposed by the Examiner when multiple different embodiments of same invention are disclosed in the specification
- Applicant must elect a single embodiment as the focus of the initial patent search
 - Must include a statement identifying the claims that correspond to the elected embodiment
 - Include a statement of which, if any, of the claims are generic to one or more embodiments
 - Claim correspondence can be complex!
 - Each claim may generically cover multiple different embodiments



Species Requirement

2. This application contains claims directed to the following patentably distinct species:

An additive comprising:

A) a terphenyl derivative represented by Formula (1) [please define R1 to R14 and choose a compound from claim 4] and

B) an xylene derivative represented by Formula (2) [please define R15-R18 and choose a compound from claim 5].

The species are independent or distinct because the compounds are each different. In addition, these species are not obvious variants of each other based on the current record.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species, or a single grouping of patentably indistinct species, for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claim 1 is generic.

There is a search and/or examination burden for the patentably distinct species as set forth above.

Election of Species

- Examiner identifies species and (usually) attempts to indicate claim coverage and generic claims
- Upon making an election in reply
 - First, identify all claims that read on elected species
 - Next, identify all other species any of those claims read on
 - This defines any “generic” claims
 - If any claims are generic, identify any claims that read on any non-elected species covered by a generic claim
 - Leave those claims pending, but withdrawn
 - Claims to non-elected species covered by a generic claim will be rejoined and considered, upon allowance of that generic claim



Election of Species

- General Test for Claim Sorting:
 - When a claim recites limitations which are found only in a single species, then the claim reads only specifically on that species
 - When a claim recites only limitations that are common to two or more species, then the claim reads generically on those two or more species
 - Claims do not have to cover all identified species to be generic
 - If no allowable generic claims exist:
 - Non-elected claims can never be considered
 - Election of species is then similar to restriction
 - Divisionals must be filed to pursue non-elected species



Election of Species Tips

- Always try to include a generic claim (allows for rejoinder of non-elected species)
- Be careful about how the specification describes different embodiments
 - Specifically listing out embodiments as first, second, third, fourth, fifth, will often lead to an election of species requirement

Election of Species

- Can independently traverse species requirements, as Examiners often get these wrong

6. This application contains claims directed to the following patentably distinct species propylene, n-butene, butadiene. The species are independent or distinct because they are prepared from different starting materials, for example, propylene is prepared from propane, whereas n-butene is prepared from n-butane. In addition, these species are not obvious variants of each other based on the current record.

Successful Traversal

- The Examiner has also required an election of species, asserting that propylene, butene, and butadiene are patentably distinct species. Applicant notes that claim 1, among others, includes two reaction zones processing different feeds, such as a first n-alkane and a first isoalkane. Claim 1 also encompasses mixed feeds to the second reaction zone, such as a mixture of isobutane and n-butane (the first isoalkane and second n-alkane, respectively).
- Applicant further notes that dehydrogenation of butane may result in both butene and butadiene. Applicant thus questions the need, as well as the ability, to select a single species or a single grouping of patentably indistinct species, the Examiner indicating propylene, butene, and butadiene as being distinct. For this reason, the species election is respectfully traversed.

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