

The Limited Monopoly™

Restriction Requirements - Are You Claiming More Than One Invention In Your Patent Application?

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Once your utility patent application is prepared and filed with the United States Patent and Trademark Office, it is mostly a matter of waiting for your case to be examined by a patent office Examiner. This wait may take quite some time, but eventually you will receive an Office action. You may at first be surprised to find that the first action received is a “requirement for restriction/election,” meaning that the Examiner believes you are claiming more than one invention.

Restriction- A Definition

The Patent Rules basically state that “Two or more independent and distinct inventions may not be claimed in one national application...”¹. So if the Examiner believes that two or more independent and distinct inventions are claimed in a single patent application, the Examiner will issue an Office action that requires the applicant to elect an invention to which the claims will be restricted. This official action is known as a “requirement for restriction.”

To look more closely, the term “independent” means that there is no disclosed relationship between the two or more subjects disclosed, that is, they are unconnected in design, operation, or effect². This criterion rarely forms the basis of a restriction requirement because two or more completely unrelated inventions are not usually disclosed in one patent application.

The term “distinct” is usually the one that defines most restriction requirements. The term distinct means that two or more subjects as disclosed are related, such as a process and an apparatus for its practice, a process and a product made from the process, etc., but are capable of separate manufacture, use, or sale as claimed, and are patentable (novel and unobvious) over each other (though they may be unpatentable due to prior art).

When Is A Restriction Properly Made By The Examiner?

To issue a restriction requirement, an Examiner must first show that the claimed inventions are distinct, and then must also show that a serious burden would be placed on the Examiner if the restriction were not required. The serious burden usually relates to the searches that the Examiner performs. Multiple inventions mean multiple search and examination iterations for the Examiner, all of which are considered serious burden. To prove serious burden, the Examiner must show that the related inventions are separately classified (the patent classification system categorizes inventions by field), have a separate status in the art, or require a different field of search.

Restriction Requirements Based On Different Species

A restriction requirement may be drawn

to specific claims where the claims are for independent and distinct inventions, or the restriction requirement may be drawn to specific embodiments, or species. An invention may often times be implemented in alternative embodiments, each of which may be considered a separate species. If the claims directed to the respective species are patentably distinct from each other, the applicant will be required to elect a single patentably distinct species for the application unless there is an allowable generic claim that encompasses each of the patentably distinct species.

If You Don't Agree With The Examiner (To Traverse or Not To Traverse...)

Often times an applicant does not agree with the findings of the Examiner. In responding to a restriction requirement, a patent practitioner is required to elect claims to a particular invention or species. If the practitioner intends



to argue for the removal or reconsideration of a restriction requirement (known as “traversing the restriction requirement”), the arguments are submitted in writing along with the elected claims. The Examiner can then accept or reject the arguments. It is never recommended to attempt to traverse a restriction requirement by arguing that the subjects are not patentably distinct from each other. Should the subjects end up as claims in different patents, then the practitioner is on record as having stated that one or more of the patents are invalid over the other(s). This could be very damaging in any future patent litigation.

In responding to a restriction requirement with traverse, it is important to look at the costs to do so where the Examiner may have reasonable arguments for restriction. If one does not attempt to traverse the restriction requirement, or if the traversal is unsuccessful, there is no loss of substantive rights. One simply withdraws the non-elected claims and refiles them in one or more divisional patent applications. A divisional patent application is a separate patent application, and may result in a separately

issued patent down the road. Of course there is a cost to file divisional patent applications, each of which may result in a separately issued patent, but the cost may be lower than the cost to pay a practitioner to attempt to traverse the restriction requirement. So while it may not always be worthwhile to attempt to argue (traverse) the restriction requirement of the Examiner, it is still important to understand and verify that the Examiner has issued a proper restriction requirement, as two or more patents for the same invention may also create problems for the patent holder a few years down the road.

Divisional Patent Applications Resulting From Restriction Requirements

A divisional patent application is a type of patent application which contains matter from a previously filed application (known as the “parent application”). Even though the divisional patent application is filed later than the parent patent application, it will retain its parent’s filing date and right to priority. So if your traversal is unsuccessful, or if you have decided not to traverse, you may still file one or more divisional patent applications up until the time that the parent application issues as a patent. Of course as time goes on, you may also find that the non-elected claims have either decreased or increased in expected value for your business, and this may help to make your divisional filing decision.

The Increase In Restriction Requirements

Recently, there has been an increase in restriction requirements made by Examiners. It is widely speculated that this is an attempt to reduce the workload of an already overburdened Examining Corps. These actions may, however, have the unintended consequence of increasing the backlog of patent applications, as more divisionals are filed as a result of more restriction requirements. This can only serve to increase an already high backlog of patent applications at the USPTO. So if you receive a restriction requirement on your patent application, look at it carefully with the help of your patent practitioner to see if it was properly issued by the Examiner.

¹37 C.F.R. §1.141. ; ²M.P.E.P. §802.01.

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