

Training Module for Chapter 8 of the MPEP

(Revised August 16, 2018)

Summary

Chapter 8: Restriction in Applications Filed Under 35 USC 111: Double Patenting

NOTE: The provisions of Chapter 8 have not been changed by the AIA.

Section 803 – Restriction - When Proper

- If two or more independent and distinct inventions are claimed in a single application, the examiner may issue a requirement for restriction (also know as a requirement for division).

NOTE: Each application requires a fee, and if multiple inventions could be claimed in a single application, this could circumvent paying the required fee.

- Such a requirement will normally be made before any action is taken by the USPTO on the merits of the application. However, a restriction may be issued at any time before a final action on the application.
- The applicant may elect which invention he chooses to have examined.
- If the other invention(s) is made the subject of a divisional application, it shall be entitled to the benefit of the filing date of the original application.

- NOTE: A patent issuing on an application which originally received a restriction requirement or on any other application that followed from a restriction requirement shall not be used as a reference by the USPTO or the courts against a divisional application if the divisional application is filed before the issuance of the patent on the other application.

In effect, the USPTO has ruled by their restriction requirements that the inventions are distinct – so it would be inappropriate to use one against the other as prior art.

- Generally, a restriction requirement is proper when the following 2 conditions are present:

(1) the claims are directed to independent inventions, and

(2) there would be a serious burden on the examiner if restriction is not required.

NOTE: The examiner gets paid based on the number of applications he resolves (either by abandonment or by issuing a patent). So, there is a motivation to use a restriction requirement when practical.

- The term “independent invention” means that there is no disclosed relationship between the two or more inventions claimed.

FOR EXAMPLE: A process and an apparatus incapable of being used in practicing the process are independent inventions.

Section 804 – Definition of Doubling Patenting

- An applicant’s attempt to receive multiple patents claiming the same invention is called “double patenting”.

In most cases, the applicant is attempting to extend the term of the rights by double patenting.

- Double patenting may occur between an issued patent and one or more applications or between co-pending applications.
- Where possible, an examiner will attempt to address the issue of double patenting by issuing a “provisional” objection on the grounds of double patenting.
- This provisional objection may be turned in to a statutory double patenting rejection if the examiner allows one of the patents.
- The examiner may also issue a non-statutory double patent rejection in the case where conflicting claims are not identical, but obvious in light of each other. Such a rejection is sometimes referred to a “obviousness-type double patenting”.

NOTE: Claims of applications that are owned by the same entity (even though different inventors) may be rejected if double patenting is determined.

NOTE 2: Applications or patents are considered to be commonly owned if they were wholly or entirely owned by the same person or organization at the time the claimed invention was made.

Section 804.02 – Avoiding a Double Patenting Rejection

- Statutory double patenting can be overcome by the applicant amending or canceling the conflicting claims. There are several ways to deal with a statutory double patenting rejection:
 - (1) amend the conflicting claims so that they are not co-extensive
 - (2) canceling all claims in a patent application that are co-extensive with those in an issued patent.
 - (3) where co-extensive claims are in two or more co-pending applications, cancel these claims in all but one of the applications.
- A rejection based on a non-statutory type of double patenting can be avoided by filing a terminal disclaimer. A terminal disclaimer is a

statement filed by an owner of a patent or patent application used to disclaim a portion of the entire term of all claims of a patent.

In effect, the term of patent rights will not be extended due to a latter filing date if a terminal disclaimer is used.

NOTE: A terminal disclaimer is not effective in overcoming a statutory double patenting rejection.

- NOTE: The “swearing back” procedure of Section 131 cannot be used to overcome any type of double patenting rejection because the rejection involves a patent reference where the same invention is involved.

Section 818 Election and Reply

- If an applicant disagrees with a requirement for restriction, he may request reconsideration and withdrawal or modification of the requirement, giving his reasons therefore (pointing out the supposed error in the restriction requirement). However, he must also make a provisional election of one invention for continued examination in his response.

If the examiner makes the restriction requirement final, he will proceed to act on the claims in the elected invention.

NOTE: A REQUEST FOR RECONSIDERATION IS NOT PROPER WITHOUT INCLUSION OF THE PROVISIONAL ELECTION

Selected Questions and Answers for Chapter 8

Question 8-1 (Oct03pm-41a)

A non-final Office action contains, among other things, a restriction requirement between two groups of claims (Group 1 and Group 2). Determine which of the following, if included in a timely reply under 37 CFR 1.111, preserves applicant’s right to petition the Commissioner to review the restriction requirement in accordance with the patent laws, rules and procedures as related in the MPEP.

- (A) Applicant's entire reply to the restriction requirement is: "The examiner erred in distinguishing between Group 1 and Group 2, and therefore the restriction requirement is respectfully traversed and no election is being made, in order that applicant's right to petition the Commissioner to review the restriction requirement is preserved."
- (B) Applicant's entire reply to the restriction requirement is: "Applicant elects Group 1 and respectfully traverses the restriction requirement, because the examiner erred in requiring a restriction between Group 1 and Group 2."
- (C) Applicant's reply distinctly points out detailed reasons why applicant believes the examiner erred in requiring a restriction between Group 1 and Group 2, and additionally sets forth, "Applicant therefore respectfully traverses the restriction requirement and no election is being made, in order that applicant's right to petition the Commissioner to review the restriction requirement is preserved."
- (D) Applicant's reply distinctly points out detailed reasons why applicant believes the examiner erred in requiring a restriction between Group 1 and Group 2, and additionally sets forth, "Applicant therefore respectfully traverses the restriction requirement and elects Group 2."
- (E) None of the above.

ANSWER: (D) is the most correct answer. MPEP 818.01 states "Election in reply to a requirement for restriction may be made either with or without an accompanying traverse of the requirement. A complete reply to a restriction requirement must include an election even if applicant traverses the requirement." And MPEP 818.01 (c) goes on to say "Traverse is required to preserve right to petition."

In-Depth Review of Chapter 8

Chapter 8 from the MPEP, in its entirety, is on the selection bar at the top of this page. You are encouraged to familiarize yourself with the general format and structure of the MPEP. However, it is recommended that you quickly scan through most of the chapter - while reading only those sections that are **highlighted in yellow**.

[Chapter 8 MPEP](#)