Restriction Practice Webinar
May 11, 2011

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Fish & Richardson P.C.
35 U.S.C. § 121

• 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. ...

• A patent issuing on an application with respect to which a requirement for restriction under this section has been made, or on an application filed as a result of such a requirement, shall not be used as a reference either in the Patent and Trademark Office or in the courts against a divisional application or against the original application or any patent issued on either of them, if the divisional application is filed before the issuance of the patent on the other application. ...

• The validity of a patent shall not be questioned for failure of the Director to require the application to be restricted to one invention.
Restriction Requirement – Example

• Compound / method of using compound, e.g., for treating diabetes.

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

  I. Claims 1 to 32, drawn to compounds and compositions thereof, classified in classes 540, 544, 546, 548, various subclasses. (Election of a single compound is also required).

  II. Claims 33 to 37, drawn to methods of use, classified in class 514, various subclasses. (Election of a single compound and a single disease is also required).

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

• Restriction requirement alleges compound and method of treating diabetes are distinct because claimed method can be performed with a materially different product (e.g. insulin).
Restriction Requirements by Technology Center

Percentage of Applications with Restriction Requirements

USPTO Restriction Requirement Data

Restriction Requirements Mailed

- FY1993
- FY2008
- FY2009

Restriction Requirements
First OA on the Merits
When is a Restriction Requirement Proper?

• 35 U.S.C. § 121:
  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.

• MPEP:
  [A]n 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
Application Filed under 35 U.S.C. 111 (i.e. non PCT)

- MPEP Chapter 800.
  - Explanations are generally rather unclear.

- MPEP 803: Two criteria:
  (A) The inventions must be independent or distinct as claimed; and
  (B) There would be a serious burden on the examiner if restriction is not required.
  - Policy: restriction should not be required if it could result in more than one patent being issued for patentably indistinct inventions (i.e. obviousness-type double patenting)

- Election of species:
  - Applies when inventions distinct from each other are encompassed by a generic claim.
  - Restriction between species must be withdrawn when generic (linking) claim found allowable.
Independence/Distinctness

• Independent (MPEP 802.01).
  • No disclosed relationship between the two or more inventions claimed.
  • Unconnected in design, operation, and effect.
  • e.g. Process and an apparatus incapable of being used in practicing the process.

• Distinct (MPEP 802.01).
  • 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 over the other.
# Distinctness of Related Inventions

<table>
<thead>
<tr>
<th>Inventions</th>
<th>Criteria for Distinctness/Restriction</th>
<th>MPEP</th>
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<tbody>
<tr>
<td>Combination/Subcombination</td>
<td>(A) Combination does not require the particulars of the subcombination as claimed for patentability and (B) subcombination has utility by itself or in another materially different combination</td>
<td>806.05(c)</td>
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<td>Subcombinations usable together</td>
<td>Subcombinations do not overlap in scope and are not obvious variants</td>
<td>806.05(d)</td>
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<td>Process and apparatus</td>
<td>(A) process <em>as claimed</em> can be practiced by a materially different apparatus; or (B) apparatus <em>as claimed</em> can be used to practice another materially different process</td>
<td>806.05(e)</td>
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<td>Process of making and product made</td>
<td>(A) process <em>as claimed</em> is not an obvious process of making the product and can be used to make another materially different product; or (B) product <em>as claimed</em> can be made by another materially different process</td>
<td>806.05(f)</td>
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<td>Apparatus and product made</td>
<td>(A) apparatus <em>as claimed</em> is not an obvious apparatus for making the product and the apparatus as claimed can be used to make another materially different product; or (B) that the product as claimed can be made by another materially different apparatus.</td>
<td>806.05(g)</td>
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<td>Product and process of using</td>
<td>(A) the process of using as claimed can be practiced with another materially different product; or (B) the product as claimed can be used in a materially different process</td>
<td>806.05(h)</td>
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<td>Product, process of making and process of using</td>
<td>If the process of making and the product are not distinct, the process of using may be joined ... even though a showing of distinctness between the product and process of using the product can be made.</td>
<td>806.05(i)</td>
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<td>Related products/Related processes</td>
<td>(A) the inventions <em>as claimed</em> do not overlap in scope; (B) the inventions <em>as claimed</em> are not obvious variants; and (C) the inventions <em>as claimed</em> are either not capable of use together or can have a materially different design, mode of operation, function, or effect.</td>
<td>806.05(j)</td>
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- Restriction practice does not apply.
- PCT Rules apply.
- Unity of invention standard (PCT Rule 13.2):
  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.
- Special technical feature:
  - A technical feature (or combination of features).
  - Novel/inventive over the prior art.
  - Unclear whether prior art includes unpublished art (e.g. § 102(e) art – not “prior art” for the International Search under PCT Rule 33.1).
National Phase Application (35 U.S.C. § 371)

- Little guidance in the MPEP, particularly re national phase.
  - Administrative Instructions under the PCT Annex B.
  - International Preliminary Examination Guidelines Chapter 10.
- Aspects of restriction practice are applied:
  - Election of species requirement allowed (though inconsistent with unity of invention standard). MPEP 1893.05(d).
  - Undue burden standard may apply. See Burke USPTO BCP Meeting Presentation Dec. 9 2009 (http://www.cabic.com/bcp/120909/)
  - Rejoinder practice applies. MPEP 1893.05(d).
- Restriction between product and at least the first method of making/using usually improper. 37 C.F.R. § 1.475.
  - Novel product should be a special technical feature shared between product and all methods of making/using the product.
- Continuation or divisional of a National Phase Application:
  - Filed under 35 U.S.C. § 111, so restriction practice applies.
Restriction Requirement Considerations

• Consequence of Restriction Requirement:
  • Patent narrowed for reasons unrelated to patentability.
  • Increased cost and time to obtain full protection of claimed invention.
  • May not be practicable to obtain protection for all related, but distinct inventions.

• Potential Advantages:
  • Separate patents for related inventions (e.g. compound / method).
  • May have different term due to patent term adjustment.
  • Safe harbor from double patenting in a divisional application filed as the result of a restriction requirement. *Pfizer, Inc. v. Teva Pharmaceuticals USA, Inc.*, 518 F.3d 1353 (Fed. Cir. 2008).
  • “Consonance” requirement. *Gerber Garment Technology, Inc. v. Lectra Systems, Inc.*, 916 F.2d 683 (Fed. Cir. 1990) (“the line of demarcation between the ‘independent and distinct inventions’ that prompted the restriction requirement [must] be maintained”).
Restriction Requirement Options

• Election may be made either with or without an accompanying traverse of the requirement. MPEP 818.03.

• If the applicant disagrees with the requirement for restriction, he may request reconsideration and withdrawal or modification of the requirement. 37 C.F.R. § 1.143.

• Must make an election.
  • A provisional election must be made even though the requirement is traversed. MPEP 818.03(b).
  • Applicant, not examiner, makes the election. 37 C.F.R. §§ 1.142, 1.143.
    • Examiner must not restrict (or further restrict) an application without giving an opportunity to elect.

• Telephone restriction practice (MPEP 812.01).
  • If the attorney or agent objects to making an oral election, or fails to respond, a restriction letter will be mailed.
Restriction Requirement Problems

• Multi-way restriction requirements (e.g. 10+ “Groups”).
• Unclear restriction requirements.
• Failure to consider inventions as claimed (e.g. restriction based on examples).
• Failure to distinguish restriction practice vs. unity of invention.
• Restriction within a Markush claim.
  • Artificial species (e.g. groups defined with terms not used in the claims).
  • Holes and overlaps between groups.
  • Examples may provide uneven support for different restriction groups despite adequate support for the generic invention.
• Failure to extend examination to non-elected species (MPEP 803.02).
• Objections to claims for “containing non-elected subject matter”.
• Failure to rejoin rejoinable inventions (MPEP 821.04).
Restriction of a Markush Group

• Claim:
  A compound of formula A-[CORE]-B wherein A is aryl or heteroaryl and B is aryl, heteroaryl, C_{1-6} alkyl or C_{3-6} cycloalkyl.

• Examples:

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<td>B</td>
<td>Me</td>
<td>Et</td>
<td>nPr</td>
<td>nBu</td>
<td>iPr</td>
<td>cPr</td>
<td>Ph</td>
<td>Me</td>
<td>Ph</td>
</tr>
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• Groups:

  Group I: ... wherein A is phenyl, B is C_{1-6} alkyl.
  Group II: ... wherein A is phenyl, B is C_{3-6} cycloalkyl.
  Group III: ... wherein A is phenyl, B is aryl.
  Group IV: ... wherein A is phenyl, B is heteroaryl.
  Group V: ... wherein A is pyridyl, B is C_{1-6} alkyl.
  Group VI: ... wherein A is pyridyl, B is aryl.
  Group VII: Compounds not in Groups I-VI.
Markush Claims

- 35 U.S.C. § 121 did not provide a basis for an Examiner to reject a Markush claim because “a rejection under s 121 violates the basic right of the applicant to claim his invention as he chooses”. *In re Weber*, 580 F.2d 455 (C.C.P.A. 1978).
- Rejection of claims as containing an “improper Markush group” was reversed where “the claimed compounds all belong to a subgenus, as defined by appellant, which is not repugnant to scientific classification. Under these circumstances ... the claimed compounds [were considered] to be part of a single invention so that there is unity of invention.” *In re Harnisch*, 631 F.2d 716 (C.C.P.A. 1980).
- Cases did not expressly preclude rejection of claims for having an “improper Markush Group” or rules permitting intra-claim restriction.
Markush Claims (MPEP 803.02)

- “Since the decisions in *In re Weber*, 580 F.2d 455, 198 USPQ 328 (CCPA 1978) and *In re Haas*, 580 F.2d 461, 198 USPQ 334 (CCPA 1978), it is improper for the Office to refuse to examine that which applicants regard as their invention, unless the subject matter in a claim lacks unity of invention. *In re Harnisch*, 631 F.2d 716, 206 USPQ 300 (CCPA 1980); and *Ex parte Hozumi*, 3 USPQ2d 1059 (Bd. Pat. App. & Int. 1984).”

- “Broadly, unity of invention exists where compounds included within a Markush group (1) share a common utility, and (2) share a substantial structural feature essential to that utility.”

- MPEP does not state what Examiner should do if claims do not have “unity of invention.”

- Unclear how “unity of invention” under *Harnisch* (as interpreted by USPTO) relates to “unity of invention” under PCT Rules.
Markush Claims (MPEP 803.02)

- No express authority for restriction within a Markush claim.
- Examiner may require a provisional election of species.
  - If the elected species is found allowable, search and examination is extended to other species until prior art is found, or claims are found allowable over the prior art.
  - Claims readable on the elected species must be examined to the extent necessary to determine patentability over the prior art.
  - If claims can be rejected and applicant amends to overcome the rejection, subsequent rejection upon extended examination (necessitated by the amendment) can be made final.
  - Switching between elected and non-elected alternatives is possible by cancelling the elected alternative from the claim (though switching between elected and elected inventions is generally not allowed). MPEP 821.03.

LeGuyader, USPTO BCP Meeting Presentation, March 6, 2007 (http://www.cabic.com/bcp/030607/)
Markush Claims – Recent Developments

• Proposed “Markush Rules” 72 Fed. Reg. 44492 (Aug. 10, 2007) would have permitted intra-claim restriction of Markush claims. The proposed rules were not finalized.

• “Indefiniteness Guidelines” 76 Fed. Reg. 7162 (Feb. 9, 2011): rejection of a Markush claim may be appropriate:
  • under § 112, ¶2 “if one skilled in the art cannot determine the metes and bounds of the Markush claim due to an inability to envision all of the members of the Markush”, or
  • “under the ‘improper Markush grouping’ doctrine”...“if the species of a Markush group do not share a single structural similarity or a common use.”
Markush Claims – Recent Developments

• *Ex Parte Delgado* (Bd. Pat. App. & Int., May 9, 2011), in an appeal from an obviousness-type double patenting rejection of a Markush claim
  \[ R^1-[-x-A_1-x-y-A_2-y-]m-R^2 \]

• Order issued requiring additional briefing of:
  • “the apparent conflict between the plain language of § 121 and the *Weber* and *Haas* opinions [and] whether the language of the second paragraph of § 112 ... precludes the Director from exercising his statutory discretion ‘to require the application to be restricted to one of the inventions’ when more than one independent and distinct inventions are encompassed within a single claim.”
  • on whether the claims of the application “were proper Markush Claims” (“A Markush claim is improper if the inventions (1) do not share a common use; or (2) do not share a ‘single structural similarity,’ that is, a substantial structural feature disclosed as being essential to the common utility. *Harnisch*, 631 F.2d at 722.”)
  • Panel: Robert Stoll (Comm’r for Patents), James Moore (Vice Chief Administrative Patent Judge) and Richard Schafer (APJ).
Linking Claims (MPEP 809)

• Application contains claims that are distinct from each other, but not distinct from the linking claim, e.g.
  • Genus claims linking patentably distinct species (e.g. fruit, pear, orange).
  • Claims to subcombination linking patentably distinct combinations (e.g., A, A+B, A+C).
• Restriction can be required between the distinct inventions.
• Linking claim must be examined with the elected invention.
• If linking claim is allowable, non-elected invention must be rejoined.
Election by Original Presentation

- After FAOM, Applicant adds claims which are patentably distinct (or lack unity with) the elected claims.
- Examiner can restrict the out the newly added claims if requirements for restriction (distinctness and burden) met. 37 C.F.R. §1.145.
  - New dependent claims (which could not have been restricted out from the originally presented claims) cannot be restricted out under this provision.
  - New species claims depending from claims which were previously examined only generically: election among the newly presented species can be required. MPEP 808.01.
- Amendment which cancels all elected claims is considered not responsive MPEP 821.03.
  - Not applicable where provisional election of species was made in accordance with MPEP 803.02 and applicant amends the claims to cancel the originally elected species. MPEP 821.03.
  - Applicant can switch between elected and non-elected Markush alternatives by cancelling the elected alternative from the Markush-type claim (even though switching between elected and elected inventions is generally not allowed).

Burke USPTO BCP Meeting Presentation Dec. 9, 2009 (http://www.cabic.com/bcp/120909).
Challenging/Mitigating a Restriction Requirement

• Must **traverse** to reserve the right to petition (37 C.F.R. 1.144; MPEP 818.03(c)).
  • Distinctly and specifically point out supposed errors in the restriction requirement.
• Consider adding linking claims (e.g. generic or Markush claims) (see MPEP 809).
  • Restriction requirement can be maintained but must be withdrawn if linking claim is allowable.
• Remind examiner of proper procedure for examination of Markush claims or application with linking claims (see MPEP 802.03; MPEP 809).
• Request **rejoinder** where applicable (MPEP 821.04).
• **Petition** from restriction requirement (37 C.F.R. 1.144; 37 C.F.R. 1.181).
• Not recommended:
  • Should applicant traverse on the ground that the inventions or species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions or species to be obvious variants or clearly admit on the record that this is the case. MPEP 818.03(b).
Traversing a Restriction Requirement

• Must make an election.
  • A provisional election must be made even though the requirement is traversed. MPEP 818.03(b).
• Must distinctly and specifically point out supposed errors in the restriction requirement MPEP 818.03(c).
• Restriction requirement should be reconsidered and, if appropriate made final. Examiner should respond to arguments made in traversal. MPEP 821.01.
• Examiner should reconsider the propriety of the restriction requirement as to the claims as amended.
• In response to traversal, the examiner may withdraw, modify or issue new restriction requirement.
  • Some kind of modification common.
  • Consider suggesting an alternative restriction for the examiner to consider.
Grounds for Traversing - Examples

- Lack of distinctness between inventions as claimed.
  - Failure to meet requirements for distinctness of related applications (MPEP 806.05(a)-(j)).
  - Overlapping subject matter.
- Lack of serious undue burden if restriction not required. MPEP 808.02.
  - Groups encompass similar subject matter which could readily be searched and examined together. Particularly if classification the same. See MPEP 808.02.
  - Subject matter already examined or searched, e.g. in previous office action, prior application, or by another examiner.
  - Examiner’s search already included the non-elected subject matter (PAIR).
  - If the members of the Markush group are sufficiently few in number or so closely related that a search and examination of the entire claim can be made without serious burden. MPEP 808.02.
  - Search for product would necessarily include search for method of making or use same product.
- Note: Election of species allowed for newly added species claims. MPEP 808.01.
Grounds for Traversing – Examples (2)

• Restriction within a Markush group not made provisionally (MPEP 803.02).
• Restriction when linking claims present not made provisionally (MPEP 809).
• Clarity of restriction requirement and demarcation between groups (MPEP 814).
• Failure to consider subject matter as claimed.
  • Restriction requirement defines groups using terms different from the claims.
  • Restriction based on examples rather than the claimed subject matter.
• Incomplete restriction requirements (MPEP 815).
  • Restriction groups do not encompass all of claimed subject matter.
  • Catch-all groups.
Restriction Not Based on Claimed Subject Matter

I. Claims 1-34, drawn to examples 2, 5, 7a, 8, 41-42, 62, 64, 73, 132-137, 139-142, 144-147 and composition thereof, classified in several heterocyclic classes (544, 544, 548, 546) and non-heterocyclic classes (558, 562, etc.), numerous subclasses.

II. Claims 1-34, drawn to examples 6-7 and composition thereof, classified in several heterocyclic classes (544, 544, 548, 546) and non-heterocyclic classes (558, 562, etc.), numerous subclasses.

III. Claims 1-34, drawn to examples 9-12, 18, 23, 33 and composition thereof, classified in several heterocyclic classes (544, 544, 548, 546) and non-heterocyclic classes (558, 562, etc.), numerous subclasses.

IV. Claims 1-34, drawn to example 13 and composition thereof, classified in several heterocyclic classes (544, 544, 548, 546) and non-heterocyclic classes (558, 562, etc.), numerous subclasses.

V. Claims 1-34, drawn to examples 15-16, 70-72, 85 and composition thereof, classified in several heterocyclic classes (544, 544, 548, 546) and non-heterocyclic classes (558, 562, etc.), numerous subclasses.
Unclear / Not Based on Claimed Subject Matter

**Election/Restrictions**

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

   I. Claims In part 1-97, drawn to Compounds represented by common core of
      exemplified compounds of examples 1-8 ( see specification ),
      pharmaceutical compositions containing these compounds and methods
      of treatment using these compounds, classified in class 548, subclass
      409.

   II. Claims In part 1-97, drawn to Compounds represented by common core of
       exemplified compound of example 9 ( see specification ), pharmaceutical
       compositions containing these compounds and methods of treatment
       using these compounds, classified in class 548, subclass 24.

   III. Claims In part 1-97, drawn to Compounds represented by common core of
        exemplified compounds of examples 10-13 ( see specification ),
        pharmaceutical compositions containing these compounds and methods
        of treatment using these compounds, classified in class 546, subclass 16.
Product/Process Distinctness

• Example:

  Claim 1. Compound X.

  Claim 2. A process to reduce swelling by administering compound X.

• Examiner reasons product and process are distinct because the process can be accomplished by using another materially different product, e.g. applying ice.

• Incorrect because the process as claimed does not encompass applying ice.

• Distinctness could be shown if product as claimed can be used in a materially different process of using the product. MPEP 806.05(h).

• Lack of unity (371) possible if examiner can provide prior art that anticipates or renders obvious the product as claimed (otherwise product is a “special technical feature”)

• Process claims depending from product claim should be subject to rejoinder even if restriction is not traversed.

• Sun Pharm. Indus., Ltd. v. Eli Lilly & Co., 611 F.3d 1381 (Fed. Cir. 2010): “the holding ... that a ‘claim to a method of using a composition is not patentably distinct from an earlier claim to the identical composition in a patent disclosing the identical use,’ extends to any and all such uses disclosed in the specification of the earlier patent.”

MPEP 806.05(h); Burke USPTO BCP Meeting Presentation Sept. 2 2009, http://www.cabic.com/bcp/090209
Suggesting an Alternative Restriction Requirement

1. Applicant’s election with traverse of Group I in the reply filed on 11/2/07 is acknowledged. The traversal is on the ground(s) that the restriction requirement is not proper, and have suggested an alternative restriction requirement, see section III of applicants’ response on page 10. This is found persuasive because applicants have suggested such restriction requirement and the examiner agrees.
Deciding Whether to Challenge Restriction

- Breadth of claims under restriction requirement versus desired coverage.
- Rapid allowance of narrow claims covering product vs potential delay.
- Chances of success:
  - Decent chance of persuading examiner to modify a restriction requirement if suggest a searchable alternative.
  - Good chance of success on petition if examiner maintains an improper requirement.
- Cost of prosecuting/maintaining divisional application and patent versus cost of traversing/petitioning.
- Written description/enablement support for divisional application.
- Patent term adjustment: potential withdrawal of finality.
  - Final action with improper restriction requirement may be incomplete.
  - Granted petition to withdraw restriction requirement may withdraw finality and remand to examiner for action on improperly withdrawn claims.
Rejoinder

• Restriction requirement between claims to allowable invention and claims to non-elected invention which depend from (or requires all the limitations) of an allowable claim should be withdrawn. MPEP 821.04.
  • All claims to elected invention must be allowable.
  • All claims to non-elected invention must require features of elected invention.

• Same statutory category of invention MPEP 821.04(a).
  • Allowable subcombination linking otherwise restrictable combination claims
  • Allowable generic claim linking otherwise restrictable species.

• Different statutory category of invention (MPEP 821.04(b)).
  • Rejoinder of process claims that require all the limitations of an allowable product claim.

• Applies to 35 U.S.C. §§ 111 and 371 applications (MPEP 821.04; 1893.03(d)).

• Claims to rejoined invention must be fully examined for patentability.
• Prevent rejoinder (to pursue the claims in a divisional application) by cancelling claims to non-elected invention before rejoinder.
Petitions From Restriction Requirement

• **37 C.F.R. §1.144 Petition from Requirement for Restriction.**
  After a final requirement for restriction, the applicant, in addition to making any reply due on the remainder of the action, may petition the Director to review the requirement. Petition may be deferred until after final action on or allowance of claims to the invention elected, but must be filed not later than appeal. A petition will not be considered if reconsideration of the requirement was not requested (see § 1.181).

• **37 C.F.R. § 1.181 Petition to the Director**
  (a) Petition may be taken to the Director:
   (1) From any action or requirement of any examiner in the ex parte prosecution of an application, or in ex parte or inter partes prosecution of a reexamination proceeding which is not subject to appeal to the Board of Patent Appeals and Interferences or to the court;
   (2) In cases in which a statute or the rules specify that the matter is to be determined directly by or reviewed by the Director; and
   (3) To invoke the supervisory authority of the Director in appropriate circumstances. For petitions involving action of the Board of Patent Appeals and Interferences, see § 41.3 of this title.
  (b) Any such petition must contain a statement of the facts involved and the point or points to be reviewed and the action requested. ...
  (f) The mere filing of a petition will not stay any period for reply that may be running against the application, nor act as a stay of other proceedings. Any petition under this part not filed within two months of the mailing date of the action or notice from which relief is requested may be dismissed as untimely, except as otherwise provided. This two-month period is not extendable.
Petition from Restriction Requirement

- **Must traverse to reserve the right to petition (37 C.F.R. 1.144; MPEP 818.03(c)).**
  - Failure to extend examination to non-elected species or rejoin rejoicable claims may be petitionable even if initial restriction requirement was not traversed. MPEP 818.03(d).

- Restriction requirement has been repeated or made final.
- Is in addition to any other reply required.
- Petition may be deferred until after allowance or final rejection.
- Petition must be filed before appeal (37 C.F.R. § 1.144).
- Petition contains (37 C.F.R. § 1.181):
  - Statement of the facts; points to be reviewed; action requested.
  - Arguments in support of petition.
- **Tips:**
  - Request withdrawal of prior office action if incomplete for failure to examine improperly withdrawn claims (particularly final OA).
  - If filed with response to non-final OA, any delay in response by USPTO does not count against the applicant.
  - File electronically as “Petition for review by the Technology Center SPRE”.
Petition from Restriction Requirement

• Decision drafted by SPE or QPAS for signature by TC Director.
• Decision time: typically about 3 months (TC 1600).
• Next Office Action should not be mailed before petition is decided.
• Does not stop the clock to respond to final office action
  • Petition may request withdrawal of finality on grounds. examination was incomplete as restriction was improper
  • USPTO may expedite decision if 6 month deadline is imminent.
  • File Notice of Appeal if Petition is undecided by the deadline.
  • Contact examiner, SPE, person drafting the petition decision (if known) and/or TC Ombudsman.
Restriction Petitions are Rare But Often Granted (in Full or in Part)

TC 1600 Petition Data

Restriction Petition Outcomes

- Burden: restriction generally improper after FAOM.
  - Newly presented claims to a distinct invention may be held withdrawn but only if requirements for restriction (distinctness + burden met) but not if could not originally have been restricted.
  - Newly presented species claims after OA on only generic claims: election of species may be required (MPEP 808.01).
  - Can add claims to elected inventions.
- Elected species can be cancelled from Markush claim which should then be examined further to the extent necessary to determine patentability (MPEP 821.03).
- Withdrawal of improper requirements to remove non-elected alternatives from Markush Claims.
- Withdrawal of improper requirements to cancel linked claims.
- Restriction requirement converted to provisional election of species.
- Withdrawal of previous Office Action as incomplete where improperly withdrawn claims were not examined.

Guidance on Restriction Practice

• MPEP:
  • Chapter 800 Restriction in Applications Filed Under 35 U.S.C. 111; Double Patenting

• Rules:
  • § 1.141 Different inventions in one national application.
  • § 1.142 Requirement for restriction.
  • § 1.143 Reconsideration of requirement.
  • § 1.144 Petition from requirement for restriction.
  • § 1.145 Subsequent presentation of claims for different invention.
  • § 1.146 Election of species.

• USPTO TC 1600 Restriction Training Materials
  • TC1600 Restriction Action Plan
  • TC1600 Restriction Training Materials
  • Biotechnology/Chemical/Pharmaceutical Customer Practice Meeting Presentations (http://www.cabic.com/bcp/).
Guidance on Unity of Invention Practice

• MPEP:
  • **MPEP 1850**: *Unity of Invention Before the International Searching Authority*
  • **MPEP 1875**: *Unity of Invention before the International Preliminary Examining Authority*
  • **MPEP 1893.03(d)**: *Unity of Invention*

• Rules:
  • **37 C.F.R. 1.475**
  • **37 C.F.R. 1.499**
  • **PCT Rule 13.1**
  • **PCT Rule 13.2** Circumstances in Which the Requirement of Unity of Invention Is to Be Considered Fulfilled
  • **PCT Rule 13.3** Determination of Unity of Invention Not Affected by Manner of Claiming
  • **§ 13.4 Dependent Claims**

• Administrative Instructions under the PCT
  • **Section 206** Unity of Invention
  • **ANNEX B** Unity of Invention

• WIPO
  • [International Search and Preliminary Examination Guidelines](#) Part III Chapter 10
Questions?

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