

Restriction Requirement Basics**

What is a Restriction Requirement?

If two or more independent and distinct inventions are claimed in a single application, the examiner may require the applicant to elect one of the inventions for examination. This is called a restriction. The other invention is withdrawn from consideration.

Restriction is between inventions not claims. The claims merely define the inventions.

Basic Restriction Requirements:

Two criteria for a proper requirement for restriction between patentably distinct inventions:

1. Inventions are (A) “independent” or (B) “related,” but “distinct”
 - Inventions are “independent” when they are not capable of use together or are not disclosed as being connected in design, operation, or effect.
 - Inventions are “related” when they disclosed as being connected in at least one of design, operation, or effect.
 - Inventions are “distinct” if, as claimed, they are not connected in at least one of design, operation, or effect and one invention is patentable over the other.

AND

2. There is a serious burden on the Examiner if the restriction is required.
 - Criteria for Burden:
 - Separate classification
 - Separate status in the art
 - Divergent field of search

Types of Restrictions:

1. Combination/Subcombination

- a. To support a requirement for restriction between combination and subcombination inventions, both two-way distinctness and reasons for insisting on restriction are necessary, i.e., there would be a serious search burden if restriction were not required as evidenced by separate classification, status, or field of search.
- b. Two-way Distinction: the inventions are distinct if it can be shown that a combination as claimed:
 - i. does not require the particulars of the subcombination as claimed for patentability (to show novelty and unobviousness), and
 - ii. the subcombination can be shown to have utility either by itself or in another materially different combination.
- c. Example #1: *Subcombination essential to combination*

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- i. *AB^{sp}/B^{sp} No Restriction* - Where a combination *as claimed* requires the details of a subcombination *as separately claimed*, there is usually no evidence that combination AB^{sp} is patentable without the details of B^{sp}. The inventions are not distinct and a requirement for restriction must not be made or maintained, even if the subcombination has separate utility.
 - d. Example #2: *Subcombination not Essential to Combination*
 - i. *AB^{br}/B^{sp} Restriction proper* - Where a combination *as claimed* does not require the details of the subcombination *as separately claimed* and the subcombination has separate utility, the inventions are distinct and restriction is proper if reasons exist for insisting upon the restriction, i.e., there would be a serious search burden if restriction were not required as evidenced by separate classification, status, or field of search.
 - ii. *AB^{sp}/AB^{br}/B^{sp} Restriction Proper* - The presence of a claim to combination AB^{sp} does not alter the propriety of a restriction requirement properly made between combination AB^{br} and subcombination B^{sp}. Claim AB^{br} is an evidence claim which indicates that the combination does not rely upon the specific details of the subcombination for its patentability. If a restriction requirement can be properly made between combination AB^{br} and subcombination B^{sp}, any claim to combination AB^{sp} would be grouped with combination AB^{br}.
 - e. Example #3: *Plural Combinations Requiring a Subcombination Common to Each Combination*
 - i. When an application includes a claim to a single subcombination, and that subcombination is required by plural claimed combinations that are properly restrictable, the subcombination claim is a linking claim and will be examined with the elected combination. The claimed plural combinations are evidence that the subcombination has utility in more than one combination.
- 2. Subcombinations Usable Together**
- a. Two or more claimed subcombinations, disclosed as usable together in a single combination, and which can be shown to be separately usable, are usually restrictable when the subcombinations do not overlap in scope and are not obvious variants.
- 3. Process & Apparatus for its Practice**
- a. Process and apparatus for its practice can be shown to be distinct inventions, if either or both of the following can be shown: (A) that the process as claimed can be practiced by another materially different apparatus or by hand; or (B) that the apparatus as claimed can be used to practice another materially different process.
- 4. Process of Making & Product Made**
- a. A process of making and a product made by the process can be shown to be distinct inventions if either or both of the following can be shown: (A) that the process as claimed is not an obvious process of making the product and the process as claimed can

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be used to make another materially different product; or (B) that the product as claimed can be made by another materially different process.

5. Apparatus & Product Made

- a. An apparatus and a product made by the apparatus can be shown to be distinct inventions if either or both of the following can be shown: (A) that the apparatus as claimed 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.

6. Product & Process of Using

- a. A product and a process of using the product can be shown to be distinct inventions if either or both of the following can be shown: (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.

7. Product, Process of Making, & Process of Using

- a. Where an application contains claims to a product, claims to a process specially adapted for making the product, and claims to a process of using the product, applicant may be required to elect either (A) the product and process of making it; or (B) the process of using. If the examiner can not make a showing of distinctness between the process of using and the product, restriction cannot be required.

8. Related Products; Related Processes

- a. To support a requirement for restriction between two or more related product inventions, or between two or more related process inventions, both two-way distinctness and reasons for insisting on restriction are necessary, i.e., separate classification, status in the art, or field of search.
- b. For other related product inventions, or related process inventions, the inventions are distinct if
 - i. the inventions as claimed do not overlap in scope, i.e., are mutually exclusive;
 - ii. the inventions as claimed are not obvious variants; and
 - iii. the inventions as claimed are either not capable of use together or can have a materially different design, mode of operation, function, or effect.

Response to a Restriction:

Any response an Office action including a restriction requirement must include an election of the single invention to which the claims (and, hence, examination) will be restricted. The election must be filed no later than one month after the mailing date of the requirement for restriction, if the requirement is made without an action by the Examiner on the merits of the claims. The response period may be extended by up to 5 months by payment of extension fees. In no event can the response period exceed 6 months.

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