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801 Definitions: Division, Double Patenting, "Independent", "Distinct"

A requirement to divide is a ruling that two or more inventions are claimed in a single application, which inventions must be presented, if all are to be claimed, in separate applications. In other words, it is a requirement to limit the claims of the application under consideration to one of the plurality of claimed inventions (Rule 142). Such requirement is, in effect, a rejection on the ground of misjoinder of claimed inventions, and may be variously expressed (809.02 (a), 817, 821.03).

A rejection on the ground of double patenting is a ruling that the invention claimed in an application is the same as, or not patentably distinct from, an invention already claimed by the same applicant, usually in a patent, but at times in a copending application. See 305, 706.03 (k), 822 through 822.03.

Rule 141 draws a distinction between the two terms "independent" and "distinct" by setting forth (1) that independent inventions can not, but (2) that distinct, dependent inventions may, be claimed in one application.

As used in this rule the term "independent" means that there is no disclosed relationship between the two or more subjects disclosed, i. e. they are unconnected in design, operation or effect, e. g. (1) species under a genus which species are not usable together as disclosed or (2) process and apparatus incapable of being used in practicing the process, etc.

The contrasting term "distinct" means that two or more subjects as disclosed are connected in design, operation or effect, i. e. they are related, for example as combination and part (subcombination) thereof, process and apparatus for its practice, process and product made,

etc., but are capable of separate manufacture, use or sale as claimed, and are patentable over each other (though they may each be unpatentable because of the prior art).

802 Basis for Practice in Statutes and Rules

The basis of division and double patenting practice is found in the following statutes and rules:

R. S. 4886; 35 U. S. C. 31: Any person who has invented or discovered any new and useful art, machine, manufacture or composition of matter may ----- obtain a patent therefor.

R. S. 4888; 35 U. S. C. 33: Before any inventor or discoverer shall receive a patent for his invention or discovery ----- he shall particularly point out and distinctly claim the part, improvement or combination which he claims as his invention or discovery.

The above statutes are worded in the *singular*; namely, that an inventor may be granted a patent for his *invention*. This has frequently been held to be the basis for the practice of requiring division, since the statutes authorize the issue of a patent for a single invention and not plural inventions. Conversely, the statutes authorize issue of but one patent, and not two or more patents, to an inventor for one invention, thus establishing the basis for rejections for double patenting.

Rules 141 through 147, which will be quoted under pertinent topics, outline Office practice on questions of division.

Under the statutes and rules, the primary question relative to division and double patenting is, what constitutes a single invention?

803 Arbitrary Rules Compelling Division Are Void

A Patent Office rule once made it mandatory to divide between inventions related as a machine and the process in the performance of which the machine is used. This rule was held to be void by *Steinmetz v. Allen* 1904 C. D. 703; 109 O. G. 549; 192 U. S. 543, since it arbitrarily compelled division between related inventions without consideration as to whether or not the claimed inventions were distinct. The decision points out in great detail wherein a process and apparatus for its practice may be so closely related as to be in effect merely two different ways of stating a single invention.

804 Discretion of Office in Requirements to Divide, and Holding of Double Patenting

Where inventions are so closely related as not to be distinct one from the other, the Office has no discretion, but must permit their joinder in a single application. (Compare 804.03 and 806.05 (a).) Conversely, where inventions that are not distinct are presented by the same inventor in plural applications, all except one must be refused.

Only where the inventions as claimed are distinct or independent may the Office properly require division or properly issue plural patents (Rule 141).

804.01 Related Inventions, Do Not Divide If Result Might Be Double Patenting

The Office policy is not to divide between related inventions if the result might be a holding of double patenting (806.05).

But when inventions are independent, i. e. unrelated, division is proper, even though, as in the case of independent species, double patenting may result (808.01 (a)).

804.02 Double Patenting When Office Requires Division

Where a double patenting situation results from an erroneous requirement to divide between *related* inventions, double patenting must be held and is not excused because of the fault of the Office. Thus the Office must be careful not to be at fault in this respect.

Similarly, where a double patenting situation results from a correct requirement to divide between species (see 806.04 (h) and 808.01 (a)) double patenting must be held.

804.03 Related Inventions May Be Claimed in One Patent or Application

Rule 141 provides that related inventions may be claimed in one application by stating "where several distinct inventions are dependent upon each other and mutually contribute to produce a single result they may be claimed in one application."

805 Effect of Improper Joinder in Patent

No decision is known in which a patent has been found void for improper joinder.

In one decision, *Sessions v. Romadka et al.* 21 F 124, the C. C. E. D. Wisc. on July 26, 1884, held that a claim to a spring catch to hold a

trunk lid shut was valid and infringed. The court held that it was extremely doubtful if the patentee could rightfully claim the several other and different parts of the trunk in a single patent, and ruled that the patentee must disclaim other claims to the other parts of the trunk as a condition for grant of relief. The patentee disclaimed. When the case reached the U. S. Supreme Court, 1892 C. D. 382; 59 O. G. 939, 145 U. S. 29, the question of misjoinder of inventions in a single patent was not before the Court, the Court ruling "Whether these different devices were properly embodied in the same patent or not, we think this was a proper case for a disclaimer under Section 4917."

A comparison of the above case with the two *Hogg et al. v. Emerson* cases, 47 U. S. 437 and 52 U. S. 587 makes it extremely doubtful that the Supreme Court would have held misjoinder under the *Sessions v. Romadka* facts.

806 Determination of Distinctiveness or Independence of Claimed Inventions

The general principles relating to distinctness or independence are elementary, as shown by Rule 141 which states: "Two or more independent inventions can not be claimed in one application; but (a) where several distinct inventions are dependent upon each other and mutually contribute to produce a single result they may be claimed in one application, —", and may be summarized as follows:

(1) Where inventions are independent (i. e. no disclosed relation therebetween), division is compulsory. They can not be claimed in one application. The special considerations relative to this situation are treated in 806.04 through 806.04 (j). Division is mandatory, they "can not" be claimed in one application even though double patenting would be held. (See 806.04 (h).)

(2) Where inventions are related as disclosed but are distinct as claimed, *double patenting will not be held*, and division may be proper.

(3) Where inventions are related as disclosed but are *not distinct* as claimed, division is never proper and *double patenting would invariably be held* if divided.

806.01 Compare Claimed Subject Matter

In passing upon questions of double patenting and division, it is the *claimed* subject matter that is considered and such *claimed* subject matter must be *compared* in order to determine the question of distinctness or independence.

806.02 Patentability Not Considered

For the purpose of a decision on the question of division, and for this purpose only, the claims are ordinarily considered as being in proper form and the question of patentability over the prior art is not considered.

This assumption, of course, is not continued after the question of division is settled and the question of patentability of the several claims in view of prior art is taken up.

806.03 Single Embodiment, Claims Defining Same Essential Features

Where the claims of an application define the same essential characteristics of a *single* disclosed embodiment of an invention, they should never be divided since there would result a holding of double patenting. This is because the claims are but different definitions of the same disclosed subject matter, varying in breadth or scope of definition.

Where such claims appear in different applications of the same inventor, disclosing the same embodiments only one application can be allowed.

806.04 Independent Embodiments

Rule 141 contains the provision "Two or more independent inventions can not be claimed in one application; * * *"

This rule is mandatory. If it can be shown that the two or more inventions are in fact independent applicant must restrict the claims presented to but one only of such independent inventions.

For example, two different combinations, not disclosed as capable of use together, having different modes of operation, different functions or different effects are independent. An article of apparel such as a shoe, and a locomotive bearing would be an example. A process of painting a house and a process of boring a well would be a second example.

As a further example, where the two embodiments are process and apparatus, and the apparatus can not be used to practice the process or any part thereof, they are independent. A process of burning oil is independent of an oil burner which cannot be caused to operate in such a manner as to practice the process.

Species are treated extensively in the following sections.

806.04 (a) Species—Genus

The practice of treating species as independent inventions stems from *Ex parte Eagle*, 1870

C. D. 137 which held that an applicant was entitled to illustrate plural different forms of a generic invention but could claim specifically but one with which he could present his generic claims.

806.04 (b) Species-Genus, Species May Be Related Inventions

Species may be related under the particular disclosure.

For example, subcombinations usable with each other may be species of some generic invention, *Ex parte Healy* 1898 C. D. 157; 84 O. G. 1281, where a clamp for a handle bar stem and a specifically different clamp for a seat post both for use on a bicycle were claimed and were held to be properly divisible since no combination claim was presented and the practice at that time permitted the claiming of but a single species.

As a further example, one species of carbon compound may have such chemical characteristics as to spontaneously convert into a second species of carbon compound. These species would obviously be quite closely related.

806.04 (c) Species-Genus, Subcombination Not Generic to Combination

The relation "combination—subcombination" presents the situation where plural claims are all readable upon a single embodiment, where the relation is not specific claim to genus, but combination to subcombination or element.

The situation is frequently presented where two different combinations are disclosed, having a subcombination common to each. It is frequently puzzling to determine whether a claim readable on two different combinations is generic thereto, or is restricted to the common subcombination.

This was early recognized in *Ex parte Smith* 1888 C. D. 131; 44 O. G. 1183, where it was held that a subcombination was not generic to the combination in which it was used.

Note 806-04 (d) for definition of generic claim.

806.04 (d) Species-Genus, Definition of a Generic Claim

In an application presenting three species illustrated, for example, in Figures 1, 2 and 3 respectively, a generic claim should read on each of these views; but the fact that a claim does so read is not conclusive that it is generic.

It may define only an element common to the several species.

It is not possible to define a generic claim with that precision existing in the case of a geometrical term. In general, a generic claim should include no material element additional to those recited in the species claims, and must comprehend within its confines the organization covered in each of the species.

For the purpose of obtaining claims to more than one species in the same case, the generic claim cannot include limitations not present in each of the added species claims. Otherwise stated, the claims to the species which can be included in a case in addition to a single species must contain all the limitations of the generic claim. It should be noted that even under the old rule relating to the three species, the Commissioner and the Board of Appeals had held that when a generic claim is allowed, claims restricted respectively to the second and third species must contain every limitation of the generic claim, although these rulings had not been uniformly followed. The Notice of April 6, 1948, on this matter is no longer in effect.

Once a claim that is determined to be generic is allowed, the claims restricted to species above one but not to exceed five species, provided they comply with the requirements, will ordinarily be obviously allowable in view of the allowance of the generic claim.

When all or some of the claims directed to one of the species over the first do not include all the limitations of the generic claim, then that species cannot be claimed in the same case with the other species.

806.04 (e) Species-Genus, Claims Restricted to Species

Claims are never species. They are definitions of inventions. They may be restricted to a single disclosed embodiment (i. e. a single species, and thus be designated a specific or species claim), or may include two or more of the disclosed embodiments within the breadth of scope of definition (and thus be designated a generic or genus claim).

Species are always the specifically different embodiments

They are *usually* but not always independent as disclosed (See 806.04 (b)) and come under the first provision of Rule 141 since there is usually no disclosure of relationship therebetween. The fact that a genus for two different embodiments is capable of being conceived and defined, does not affect the independence of the embodiments, where the case under consideration contains no disclosure of any community of operation, function or effect.

806.04 (f) Claims Restricted to Species, by Mutually Exclusive Characteristics

Claims to be restricted to different species must be mutually exclusive. The general test as to when claims are restricted respectively to different species is the fact that one claim recites limitations which *under the disclosure* are found in a first species but not in a second, while a second claim recites limitations disclosed only for the second species and not the first. This is frequently expressed by saying that claims to be restricted to different species, must recite the mutually exclusive characteristics of such species.

806.04 (g) Claims Restricted to Species, Plural Species Claims

Prior to June 1, 1930, claims specific to only one species could be obtained in an application. On June 1, 1930, old rule 41 was amended to provide that "more than one species of an invention, not to exceed three, may be claimed in one application if that application also includes an allowable claim generic to all the claimed species." This amendment to the rule constitutes an exception to the first proviso of the rule that independent inventions can not be claimed in one application. This provision was repeated in new rule 141 with clarifying change in language.

In October 1949, the rule was amended to permit the claiming of up to five species; the amended rule is quoted in section 809.02.

806.04 (h) Genus-Species, Species Must Be Patentably Distinct From Each Other and From Genus

It was early held (when the practice was to permit the claiming of but a single species) that an application could claim one species and such generic claims as might be allowable, but that no claims restricted to the other species could be allowed in the same application (Ex parte Cowper, 1879 C. D. 194; 16 O. G. 499). If the additional species were patentably distinct they could be claimed in separate applications.

The above practice is still in force, as modified by the changes in the rule permitting the claiming of first three and now up to five species.

Now, where generic claims are allowed, applicant may claim in the *same application* species not to exceed five, as provided by Rule 141 as amended. As to these, the patentable

distinction between the species or between the species and genus is not rigorously investigated, since they will issue in the same patent.

Other applications presented claiming additional species under the genus claimed in the first are closely investigated to determine if the differences are in fact patentable.

Where the genus has been allowed and patented, species claims in another application (even though copending with the application that resulted in the patent containing generic claims) are properly rejected on the generic claims when not patentably distinct therefrom.

806.04 (i) Genus-Species, Generic Claims Rejected When Presented for First Time After Issue

Where an applicant has separate applications for plural species, but presents no generic claim until after the issue of a patent for one of the species, the generic claims cannot be allowed, even though the applications were copending.

806.04 (j) Genus-Species, Generic Claims in One Patent Only (Generic Claims in Application Rejected)

Generic claims covering two or more species which are separately claimed in two or more patents to the same inventor issued on copending applications must all be present in a single one of the patents. If present in two or more patents, the generic claims in the later patents are void. Thus generic claims in an application should be rejected on the ground of double patenting in view of the generic claims of the patent.

806.05 Related Embodiments

Where two or more related embodiments are being claimed, the principal question to be determined in connection with a requirement to divide or a rejection on the ground of double patenting is whether or not the inventions as claimed are distinct. If they are not distinct, division is never proper, and if claimed in separate applications or patents, double patenting must be held.

The various pairs of related inventions are noted in following sections. The distinction between them shown as a basis for requiring division, or for a holding that there would be no double patenting, must be material.

806.05 (a) Combination or Aggregation and Subcombination

A combination or an aggregation is an organization of which a subcombination (or element) is a part.

The distinction between combination and aggregation is not material to questions of division or to questions of double patenting. Relative to questions of division where a combination is alleged, the claim thereto must be assumed to be allowable as pointed out in 806.02, in the absence of a holding by the Examiner to the contrary. When a claim is found in a patent, it has already been found by the Office to be for a combination and not an aggregation and must be treated on that basis.

806.05 (b) Combination and Subcombination, Old Combination—Novel Subcombination

Division is never proper between a combination (AB) that the examiner holds to be old and unpatentable and the subcombination (B) in which the examiner holds the novelty, if any, to reside, *ex parte* Donnell 1923 C. D. 54, 315 O. G. 398. (See 818.03.)

806.05 (c) Combination and Subcombination, Criteria of Distinctness

Broadly stated, where a combination as claimed does not require the particulars of the subcombination as claimed for its patentability, and the subcombination can be shown to have utility either by itself or in other and different relations, the inventions are distinct. When these factors cannot be shown, such inventions are not distinct.

806.05 (d) Subcombinations Usable Together

Two or more claimed subcombinations, disclosed as usable together in a single combination, and which can be shown to be separately usable, are usually distinct from each other.

Care should always be exercised in this situation to determine if the several subcombinations are generically claims. (See 806.04 (c).)

806.05 (e) Process and Apparatus for Its Practice

Process and apparatus for its practice can be shown to be distinct inventions, if either or both of the following can be shown: (1) that the process can be practiced by another ma-

terially different apparatus or by hand, or (2) that the apparatus can be used to practice another and materially different process.

806.05 (f) Process and Product Made

A process and a product made by the process can be shown to be distinct inventions if either or both of the following can be shown: (1) that the process claimed is not the necessary or an obvious process of making the product *and* the process can be used to make other and different products, or (2) that the product can be made by another and materially different process.

806.05 (g) Apparatus and Product Made

The criteria are the same as in 806.05 (f) substituting apparatus for process.

807 The Practice of Making Patentability Reports Has No Effect Upon Division Practice

Patentability report practice (705), has no effect upon, and does not modify in any way, the practice of division, being designed merely to facilitate the handling of cases in which division can not properly be required.

808 Reasons for Insisting Upon Division

Every requirement to divide has two aspects, (1) the reasons (as distinguished from the mere statement of conclusion) why the inventions *as claimed* are either independent or distinct, and (2) the reasons for insisting upon division therebetween.

808.01 Independent Inventions

Where the inventions claimed are independent, i. e., where they are not connected in design, operation or effect under the disclosure of the particular application under consideration, *the facts relied upon for this conclusion are in essence the reasons for insisting upon division, since under Rule 141 division is mandatory.* [This situation, except for species (treated in the following section) is but rarely presented, since few persons will file an application containing disclosures of independent things.] Division between independent inventions being mandatory, (806) it is not necessary that a separate status in the art or separate classification be shown.

808.01 (a) Species

Where there is no disclosure of relationship between species, (see 806.04 (b)), they are independent inventions and division therebetween is mandatory (806.04) even though there is no patentable distinction between the species as claimed. Thus the reasons for insisting upon division between species, are the facts relied upon for the conclusion that there are claims restricted respectively to two or more different species that are disclosed in the application, and it is not necessary to show a separate status in the art or separate classification.

An exception was made by the amendment to the rules permitting the claiming of three species when a claim generic thereto is allowed and now the claiming of up to five species (806.04 (g)). The mandatory requirement to divide applies to all claims restricted to species in excess of five included within an allowed genus or to those species over one the claims to which do not include all the limitations of the generic claim or in excess of one when there is no allowed genus, even though these additional species are not allowable over either the other species or the allowed genus.

Even though the examiner rejects the generic claims, and even though the applicant cancels the same and thus admits that the genus is unpatentable, where there is a relationship disclosed between species such disclosed relation must be discussed and reasons advanced leading to the conclusion that the disclosed relation does not prevent division, in order to establish the propriety of division.

808.02 Related Inventions

Where, as disclosed in the application, the several inventions claimed are related, and such related inventions are not patentably distinct as claimed, division is never proper (804, 806.05). If the Office requires division, or if applicant optionally divides, double patenting will be held.

Where the related inventions as claimed are shown to be distinct, it is the Office policy to permit them to be claimed in one application where they are classified together, do not have a separate status in the art, and involve the same field of search. The examiner must show by appropriate citation of art at least one of the following, in order to establish reasons for insisting upon division:

(1) Separate classification thereof:

This shows that each distinct subject has attained a separate status in the art as a separate subject for inventive effort, and also a separate field of search.

(2) A separate status in the art when they are classifiable together;

Even though they are classified together, by citing appropriate art from the single subclass, each subject can be shown to have formed a separate subject for inventive effort when some of the art pertains to the one subject and some to the other subject.

(3) A separate field of search:

Where it is necessary to search for one of the distinct subjects in places where no pertinent art to the other subject exists, a separate field of search is shown, even though the two are classified together. The art cited to show a separate field of search must in fact be pertinent to the type of subject matter covered by the claims.

Where, however, the classification is the same and the field of search is the same and there is no clear indication of separate future classification and field of search, no reasons exist for dividing among related inventions. This is particularly true in the manufacturing arts where manufacturing processes and the resultant product are classified together, e. g. Carbon Compounds Class 260. Under these circumstances, applicant may optionally divide since double patenting will not be held, but it is Office policy not to require division.

809 Divisible Inventions Except for Linking Claims

There are a number of situations which arise in which an application has claims to two or more properly divisible inventions, but presented in the same case are one or more claims (generally called "linking" claims) indivisible therefrom and thus linking together the inventions otherwise divisible.

Where the situation exists, and it is found after a complete examination that the linking claims are not allowable, such claims should be rejected and division required among the several different inventions claimed.

The linking claims *must* be examined with the invention elected, and should any linking claim subsequently be allowed, rejoinder of the divided inventions must be permitted.

Since a rejection of linking claims is a prerequisite to a requirement to divide a complete action must be made on such claims, *but no action on novelty and patentability need be made on the claims to the divisible inventions.*

809.01 Practice First Stated

So far as can be determined, this practice was first stated in *ex parte Mansfield and Hayes* 1902 C. D. 94, 98 O. G. 2363 where a re-

jection of aggregative claims which operated to defeat division between two inventions (which were divisible in the absence of such aggregated claims) was approved. This was a Commissioner's decision, in which he said that to do otherwise would "amount to piecemeal consideration of the merits of the application."

809.02 Species—Generic Claim Rejected

Extract from Rule 141. (b) more than one species of an invention, not to exceed five, may be specifically claimed in different claims in one application, provided the application also includes an allowable claim generic to all the claimed species and all the claims to each species in excess of one are written in dependent form or otherwise include all the limitations of the generic claim.

[Old rule 41].

The practice is stated in greater detail in Rule 146:

Rule 146 Election of species. In the first action on an application containing a generic claim and claims restricted separately to each of more than one species embraced thereby, the examiner, if of the opinion after a complete search on the generic claims that no generic claim presented is allowable, shall require the applicant in his response to that action to elect that species of his invention to which his claims shall be restricted if no generic claim is finally held allowable. However, if such application contains claims directed to more than five species, the examiner may require restriction of the claims to not more than five species before taking any further action in the case.

[Old Rule 41]

The last sentence of rule 146, that the Examiner may require restriction of the claims so that not more than five species are separately claimed, is permissive. It may be used in aggravated cases of a multiplicity of species, without acting on generic claims, to narrow the issues down to five species. When a claim which is generic to more than one of the disclosed species is allowed, and more than five species are separately claimed, restriction to not more than five species should be required.

This rule requires that species be elected, one when no generic claim is allowed, and up to five if a generic claim is allowed, in accordance with whether the allowed genus embraces within its scope up to five of the disclosed species. Where the genus embraces within its scope more than five of the disclosed species, rule 141 restricts the number that may be specifically claimed to no more than five.

Rules 141 and 146 require that election must be one of or not to exceed five of the *disclosed species*, not of claims, and the elected species must be clearly identified.

809.02 (a) Form of Requirement

In requiring election of species the Examiner will note that the application contains claims restricted to more than one, or more than five disclosed species, which he must clearly identify, as for example, the species of Figs. 1, 2 and 3 or the species of examples I, II and III respectively. Or, in the absence of distinct Figures or examples to identify the several species, the mechanical means, or the particular substance, or other distinguishing characteristic of the species should be stated for each species noted. Grouping of claims for the respective species should not be made unless the species cannot be otherwise identified. The requirement in each case should be for applicant to elect a particular disclosed species.

Applicant should be advised that his response to be complete (under Rules 143 and 111) must include, in addition to a response to the rejection, an identification of the *disclosed* species that he elects consonant with the requirement, and a listing of all claims restricted or generic thereto. An argument that the generic claims are allowable, or that all claims are generic or amended to be generic, unless accompanied by an election, is non-responsive.

An Examiner's action subsequent to an election of species should include a complete action on the merits of all claims that are readable on the elected species. All other claims should be rejected as not readable on the elected species. (Notice of Oct. 29, 1940, Revised.)

Where generic claims are rejected and election of species required, the Examiner's viewpoint as to the generic nature of the rejected claims should be clearly stated.

At the time of making a requirement for an election of species, if it appears that the species claims are not all in the form prescribed by rule 141, the examiner should state in his action that upon the allowance of a generic claim applicant will be entitled to consideration of claims to additional species up to five, provided all the claims to each additional species are written in dependent form or otherwise include all the limitations of the generic claim as provided by rule 141.

When a claim determined to be generic is allowable, whether on the first or any subsequent action, and the number of species claimed does not exceed five, action will be given thereon.

When claims to a single species, either all of the claims to the species or only some of the claims to the species, are not in the appropriate form, the action by the examiner, except in cases where that species stands nonelected, would be

a rejection of all the claims to that species. The rejection could be worded somewhat as follows: Claims _____, directed to the species _____, are rejected as not being properly claimable in the same case with other species since all the claims in this group do not include the limitation of the generic claim as required by rule 141.

809.02 (b) Allowance or Rejection of Generic Claims

Whenever a generic claim is found to be allowable in substance, even though it is objected to or rejected on merely formal grounds, action on the species claims shall thereupon be given as if the generic claim were allowed. (Extract from Notice of Apr. 6, 1948.)

The preceding paragraph of this section is an instruction that whenever a generic claim is allowable in substance, and the species claimed within such genus do not exceed five, action is given on the species as though the genus were allowed in fact. If more than five species within such genus are claimed, applicant must be required to elect the five on which action will be given.

Since rejection of the generic claims is a prerequisite to the requirement to elect (except where generic claims are allowed and more than five species are separately claimed) the rejection should be on the best art to anticipate the generic claims that a complete search makes available, and for the best reasons that the examiner can present.

809.03 Related Inventions, Linking Claims Rejected

There are other situations where claims serve to link related inventions in the manner that species are linked by a generic claim. Whenever two related inventions are distinct from each other as claimed, but there is a claim to invention from which neither is distinct, the claimed "linking" invention must be rejected as a prerequisite to dividing. When this is done, the art used in rejecting the linking claims must be the result of a complete search, and the reasons for rejecting the linking claims must be the best available, but *no action on novelty of the claims to distinct inventions should be given.*

The practice parallels the practice for species when generic claims are rejected.

The best general statement of this practice as applied to situations other than species with a generic claim, is found in *ex parte Robinson*, Pat. No. 2,329,086. This decision (which was rendered in 1943) discusses a number of prior decisions. In that particular case there was a

petition from the examiner's action of requiring division between two inventions coupled with a rejection of claims which were found to link those two inventions. The particular holding is quoted: "The practice of rejecting claims of the linking type at the time of making a requirement of division is considered to be not only proper but necessary in order to avoid compelling the examiner to consider the merits of independent inventions and thus unduly burden the Office."

The main difference is, that in addition to showing distinctness (which parallels showing claim restriction to particular disclosed species), reasons for insisting upon division between related inventions that are distinct as claimed must be shown (as in 808.02) whereas the mere showing of claim restriction to separate disclosed species and lack of disclosed relation therebetween is adequate (808.01(a)).

809.03 (a) Types of Linking Claims

The most common types of linking claims that may prevent division between two related inventions that can otherwise be shown to be distinct and divisible, are:

Aggregation or combination linking two sub-combinations.

Claim to a product defined by process of making the same linking proper product claims and process claims.

A claim to the necessary process of making a product linking proper process and product claims.

A claim to "means" for practicing a process linking proper apparatus and process claims.

809.04 Retention of Claims to Non-Elected Invention

Where division is required predicated upon the non-allowability of generic or other type of linking claims, applicant is entitled to retain in the case claims to the non-elected invention or inventions.

If a linking claim is allowed, the Examiner must thereafter examine species not to exceed three if the linking claim is generic thereto, or he must examine the claims to the non-elected inventions that are linked to the elected invention by such allowed linking claim.

When a final requirement to divide is contingent on the non-allowability of the linking claims, applicant may appeal immediately to the Board of Appeals as to the division requirement under Rule 144 without waiting for a final action on the merits of the linking claims; or he may defer his appeal until the linking claims have been finally rejected. If the latter pro-

cedure is adopted, and the Board allows the rejected linking claims, the requirement of division falls, and the Examiner must act on the claims to the non-elected linked inventions.

810 Action on Novelty

In general, except for linking claims (809) when a requirement to divide is made, no action on novelty and patentability is given.

810.01 Not Objectionable When Coupled With Requirement

Even where action on novelty and patentability is not necessary to a requirement to divide, it is not objectionable, *ex parte* Lantzke 1910 C. D. 100; 156 O. G. 257.

However, except as noted in 809, if an action is given on novelty, *it must be given on all claims.*

810.02 Usually Deferred

The Office policy is to defer action on novelty and patentability until after the requirement to divide is complied with, withdrawn or made final.

Ex parte Pickles, 1904 C. D. 126; 109 O. G. 1888

Ex parte Snyder, 1904 C. D. 242; 110 O. G. 2636

Ex parte Weston, 1911 C. D. 218; 173 O. G. 285

810.03 Given on Elected Invention After Final Requirement Prior to Appeal

Rule 143 last sentence states: "If the requirement is repeated and made final, the Examiner will at the same time act on the claims to the elected invention." Thus, action is ordinarily given on the elected invention after a final requirement and prior to appeal. Rule 144 provides for either immediate appeal on the requirement to divide, or for deferring appeal until final rejection or allowance of the claims to the elected invention.

811 Time for Making Division Requirement

Rule 142, 2nd sentence: "If the divisibility of the inventions be clear, such requirement (i. e. election of the invention to be claimed as required by 1st sentence) will be made before any other action upon the merits; otherwise it may be made at any time before final action in the case, at the discretion of the examiner."

This means, make a requirement to divide as early as possible in the prosecution, in the first

action if possible, otherwise as soon as a proper requirement develops.

811.01 Proper Even Though Late in Prosecution

The rule makes it clear that division may be required at any stage, however late, in the prosecution up to the time of final action.

811.02 Even After Compliance With Preceding Requirement

Since the rule provides that division is proper at any stage of prosecution up to final action, a second requirement may be made when it becomes proper, even though there was a prior requirement with which applicant complied (Ex parte Benke, 1904 C. D. 63; 108 O. G. 1588).

811.03 Repeating After Withdrawal—Proper

Where a requirement to divide is made and withdrawn or disapproved by an Examiner of Classification because improper, when it becomes proper at a later stage in the prosecution, division may again be required.

811.04 Proper Even Though Grouped Together in Parent Case

Even though inventions are grouped together in a requirement to divide in a parent case, division thereamong may be required in the divisional case if proper.

812 Who Should Make the Requirement

The requirement should be made by an examiner who would examine at least one of the divisible inventions.

An examiner should not require division in an application *none* of the claimed subject matter of which is classifiable in his division. Such an application should be transferred to a division to which at least some of the subject matter belongs.

813 Citation of Art

A. Linking claims rejected. Where generic or other type linking claims are rejected the best art and the best reasons should be given for the rejection.

B. Independent inventions — no linking claims. Art resulting from a cursory search pertinent to the several inventions is cited. It is not necessary to cite art to show separate classification, a separate status in the art or a

separate field of search, where it is shown that the inventions as disclosed in that particular case are in fact independent.

C. Related but distinct inventions. A cursory search should be made and the most pertinent art found should be cited that shows separate classification, a separate status in the art or a separate field of search. It is the claimed subject matter of U. S. patents that shows the first two. Any disclosure pertinent to the claimed subject matter of the application shows the third.

It is noted that the art referred to in the above cases constitutes a general guide to the applicant to aid him in his election. *Where the citation of art to establish distinctness of inventions is necessary*, the art must be pertinent to the particular point being made, for example, art may be cited to show that a product can be made by processes other than that claimed.

814 Indicate Exactly How Application Is To Be Divided

A. Species. The mode of indicating how to divide between species is set forth in Section 809.02 (a).

As pointed out in ex parte Ljungstrom 1905 C. D. 541; 119 O. G. 2335, the particular limitations in the claims and the reasons why such limitations are considered to restrict the claims to a particular disclosed species should be mentioned if necessary to indicate clearly the line of division.

B. Inventions other than species. It is necessary to read all of the claims in order to determine what the claims cover. When doing this, the claims directed to each separate subject should be noted along with a statement of the subject matter to which they are drawn.

This is the best way to most clearly and precisely indicate to applicant how the application should be divided. It consists in identifying each separate subject amongst which division is required, and grouping the claims restricted thereto with its subject.

While every claim should be accounted for, the omission to group a claim, or placing a claim in the wrong group will not affect the propriety of a final requirement where the requirement is otherwise proper and the correct disposition of the omitted or erroneously grouped claim is clear.

C. Linking claims. The generic or other linking claims should not be associated with any one of the linked inventions since such claims must be examined with any one of the linked inventions that may be elected. This fact should be clearly stated.

815 Make Requirement Complete

When making a requirement to divide, every effort should be made to have the requirement to divide complete. If some of the claimed inventions are classifiable in another division and the examiner has any doubt as to the proper line for division among the same, he should refer the application to the examiner of the other division for information on that point and such examiner should render the necessary assistance.

816 Give Reasons for Holding of Independence or Distinctness

The particular reasons relied upon by the Examiner for his holding that the inventions as claimed are either independent or distinct, should be concisely stated. A mere statement of conclusion is inadequate. The reasons upon which the conclusion is based should be given.

For example, in holding that plural species are claimed, the particular limitations recited which are readable upon one disclosed species should be referred to and the reason why under the disclosure, the other species are excluded.

Relative to combination and a subcombination thereof, the examiner should point out the reasons why he considers the subcombination to have utility by itself or in other combinations, and why he considers that the combination as *claimed* does not rely upon the subcombination as its essential distinguishing part.

Each other relationship of claimed invention should be similarly treated and the reasons for the conclusion of distinctness of invention as claimed set forth.

817 Outline of Division Requirement and Sample Letter

The statement in 809.02 (a) is adequate indication of the form of letter when election of species is required.

No sample letter is given for other types of independent inventions since they rarely occur.

The following outline for a requirement to divide and sample letter is intended to cover every type of original division requirement between related inventions including those having linking claims, but not rejections on the ground of prior election of claims reinserted after election, without traverse (821.02); or retained in the case after traverse (821.01), or added for a different invention after election (821.03 and 821.03 (a)).

OUTLINE AND SAMPLE LETTER

- A Citation of art
 - Preferably two patents for each type of invention
 - Group by spacing
 - Identify groups by Roman numerals
 - Give original classification (not X or UX)
- B Statement of the requirement
 - Identify each group by Roman numeral
 - Same as corresponding patent groups
 - List claims in each group
 - Check accuracy of numbering
 - Look for same claims in two groups
 - Look for omitted claims
 - Take into account claims not grouped, indicating their disposition
- C Statement of facts
 - Give short description of total extent of the subject matter claimed in each group
 - Point out critical claims of different scope
 - Identify whether combination, subcombination, process, apparatus or product
 - Classify each group and refer to corresponding patent for evidence.

(Note B and C are usually worked in together, see form letter)
- D Special treatment of ungrouped claims
 - Linking claims
 - Reject
 - Make complete rejection, giving reasons therefor
 - Statement on groups to which linking claims may be assigned for examination
 - Other ungrouped claims
 - Indicate disposition
 - eg: previously non-elected, non statutory, canceled, etc.
- E Allegation of distinctness
 - Point out *facts* which show distinctness
 - Treat the inventions as *claimed*, don't merely state your conclusion that inventions in fact are distinct
 - (1) Subcombination—Subcombination (disclosed as useable together)
 - Each usable alone or in other *identified* combination
 - Demonstrate by cited patent
 - Demonstrate by Examiner's suggestion
 - (2) Combination—Subcombination
 - Combination as claimed does *not* require subcombination

AND

 - Subcombination usable alone or in other *identified* combination
 - Demonstrate by cited patent
 - Demonstrate by Examiner's suggestion

- E Allegation of distinctness—Continued
- (3) Process—Apparatus
 Process can be carried out by hand or by other apparatus
 Demonstrate by cited patent
 Demonstrate by Examiner's suggestion
 OR
 Demonstrate apparatus can be used in other process (rare)
- (4) Process and/or apparatus—Product
 Demonstrate claimed product can be made by other process (or apparatus)
 By cited patent
 By Examiner's suggestion
 OR
 Process (or apparatus) can produce other product (rare)
- F Allegation of reasons for insisting upon division
Must be demonstrated by citation of art
 Separate status in the art
 Different classification
 Refer to exemplary patents
 Same classification
 Refer to exemplary patents
 Divergent fields of search
 Search required for one group not required for the other
- G Sample Letter
- | | | | | | |
|---------|-------|-----------|------|----------|--------|
| I Smith | --- | 3,986,547 | Dec | 25, 2000 | 123-31 |
| Jones | --- | 3,698,521 | Nov | 27, 1966 | 123-31 |
| II Doe | ----- | 3,210,456 | July | 4, 1976 | 261-39 |
| Roe | ----- | 3,836,660 | Oct | 12, 1992 | 261-39 |
| III X | ----- | 3,456,789 | Feb | 29, 1999 | 123-69 |
| Y | ----- | 3,000,001 | May | 30, 1966 | 123-69 |
- Division is required as follows:
- I Claims 1-6 which recite an internal combustion engine combination and would be classified with the Smith and Jones patents.
- II Claims 7-12 which recite a carburetor subcombination and would be classified with the Doe and Roe patents.
- III Claims 13-18 which recite a spark plug subcombination and would be classified with the X and Y patents.
- Claim 19, which recites the specific details of both the carburetor and the spark plug and is thus not divisible from either, is rejected on the ground of aggregation (give statement of reasons). For purposes of examination it may be retained with either Group II or Group III, and if a combination of this type is subsequently found allowable the question of rejoinder of Groups II and III will be considered.
- Claim 20 is rejected as indefinite and not in compliance with Revised Statutes 4888; 35 U. S. C. 33, and accordingly is not assigned to any group.
- Claim 21 drawn to a bearing structure, is rejected as being for a previously non-elected invention.
- The several inventions are distinct, each from the

others, because (1) the engine combination, as defined in the claims of Group I, does not recite nor does the engine require either the specific carburetor subcombination as defined in the claims of Group II, or the specific spark plug subcombinations as defined in the claims of Group III, and (2) the carburetor and spark plug subcombinations have separate utility in other and different combinations. For example, the carburetor of Doe and the spark plug of X could be used in the combination defined by the claims of Group I. The carburetor and spark plug as defined in Groups II and III could equally well be used in a furnace combination.

Since these distinct inventions have acquired a separate status in the art as shown by the different classifications of the above cited exemplary art, and since the fields of search for the respective inventions are not coextensive, division is proper, and all claims are rejected on the ground of misjoinder.

Applicant is advised that his response to be complete must include an election of one of the above inventions identified as I, II and III. An argument that a linking claim such as claim 19 is allowable, unless accompanied by an election, will be considered non-responsive, see Rule 143.

818 Election and Response

Extract from Rule 142. (a) If two or more inventions are claimed in a single application, and they are of such a nature that a single patent may not be issued to cover them the applicant will be required to limit the claims to whichever invention he may elect, this official action being called a requirement for division.

[Old Rule 42]

This portion of the rule authorizes the examiner to make any requirement to divide that he concludes is appropriate and informs the applicant that where he has been compelled to divide he must claim the so divided inventions, if at all, in separate applications.

The expression "limit the claims" does not mean that all reference to the non-elected inventions must be eliminated from the application but means that applicant must elect, thus limiting the application.

Election is the designation of the particular one of divisible inventions that will be prosecuted in the application. Election may be made in other ways than expressly in response to the requirement. (See 818.05 and 818.06.)

A response is the reply to each point raised by the examiner's action, and may include a traverse or compliance.

A traverse of a requirement to divide is a statement of the reasons upon which the applicant relies for his conclusion that the requirement is in error.

818.01 Response Must Be Complete

Rule 143 provides "If the applicant disagrees with the requirement for division, he may request reconsideration, giving his reasons therefor (see Rule 111)."

The response to a requirement to divide must be complete as required by Rule 111 which reads in part: "In order to be entitled to re-examination or reconsideration, the *applicant must make request therefor in writing*, and he *must distinctly and specifically point out the supposed errors* in the examiner's action; the applicant *must respond to every ground of objection* and rejection of the prior office action (except -----) and the applicant's action *must appear throughout to be a bona fide attempt to advance the case to final action*. The *mere allegation* that the examiner has erred will not be received as a proper reason for such reexamination or reconsideration."

Under this rule, the applicant is required to specifically point out the reasons on which he bases his conclusion that a requirement to divide is in error. A mere broad allegation that the requirement is an error is not responsive, and if the period for response has expired, the application is abandoned.

818.02 Election Fixed by Action on Claims

Election becomes fixed when the claims in an application have received an action on their merits by the Office.

818.03 Old Combination Claimed—Not an Election

Where an application originally presents claims to a combination (AB), the examiner holding the novelty if any, to reside in the subcombination (B) per se (see 806.05 (b)) only, and these claims are rejected on the ground of "old combination," subsequently presented claims to subcombination (B) of the originally claimed combination should not be rejected on the ground of previous election of the combination, nor should this rejection be applied to such combination claims if they are reasserted. Final rejection of the reasserted "old combination" claims is the action that should be taken. The combination and subcombination as defined by the claims under this special situation are not for distinct inventions. (See 806.05 (c).)

818.04 Applicant Must Make His Own Election

Applicant must make his own election when division is required. The examiner will not make the election for him, Rule 142.

818.05 Election by Originally Presented Claims

Where claims to another invention are properly added and entered in the case before an action is given, they are treated as original claims.

The claims originally presented *and acted upon* by the Office on their merits determine the invention elected by an applicant and subsequently presented claims to a divisible invention should be rejected as being for an invention other than that elected. See 821.03 and 821.03 (a).

818.05 (a) Generic Claims Only—No Election of Species

Where the originally presented claims are all generic to the several disclosed species, no election of a single species has been made.

818.06 Election by Optional Cancellation of Claims

Where applicant is claiming two or more inventions (which may be species or various types of related inventions) and as a result of action on the claims he cancels the claims to one or more of such inventions, leaving claims to one invention, and such claims are acted upon by the examiner, the claimed invention thus acted upon is elected.

818.07 Election and Traverse in Response to Requirement

Election in response to a requirement to divide may be made either with or without an accompanying traverse of the requirement.

818.07 (a) Must Elect, Even When Requirement Is Traversed

Rule 143 provides "If the applicant disagrees with the requirement for division, he may request reconsideration, giving the reasons therefor (see Rule 111). In requesting reconsideration the applicant must indicate a provisional election of one invention for prosecution, which invention shall be the one elected in the event the requirement becomes final."

Under former practice, some requirements to divide required an election even though accompanied with a traverse, others did not. This rule makes the practice uniform. A provisional election must be made in accordance with the requirement even though accompanied by a traverse of the requirement.

All requirements to divide should have as a

concluding paragraph a sentence stating in substance:

"Applicant is advised that his response to be complete must include an election consonant with the requirement, see Rule 143."

The suggested concluding statement should be reworded to fit the facts of the particular requirement, e. g. as in 809.02 (a) second paragraph and 817 at the end of the sample letter.

818.07 (b) Must Traverse To Preserve Right of Appeal

Rule 143 provides "The requirement for division will be reconsidered on such request, but will not be repeated and made final without the written approval of an Examiner of Classification."

Rule 144 provides "After a final requirement for division the applicant — may appeal from the requirement. — Appeal may not be taken if reconsideration of the requirement was not requested."

Under these rules, in order to appeal the requirement to divide, the applicant must traverse the requirement, an Examiner of Classification must approve the requirement and the Primary Examiner must repeat it and make it final.

As first stated in *ex parte Higinbotham* 1922 C. D. 29; 304 O. G. 231, an election following a requirement to divide, which election is made without traverse of the requirement results in loss of right to appeal from the requirement. This results from the fact that applicant has acquiesced in the accuracy of the holding so that the question is not twice acted upon and appealable questions must be twice acted upon to give the Board its jurisdiction.

818.07 (c) Must Traverse To Preserve Right of Appeal, Traverse of Rejection of Linking Claims

A traverse of the rejection of the linking claims is not a traverse of the requirement to divide, it is a traverse of a holding of non-patentability.

Election combined with a traverse of the rejection of the linking claims only is an agreement with the position taken by the Office that division is proper if the linking type claim is not allowed and improper if they are allowed. If the Office allows such a claim it is bound to withdraw the requirement and to act on all linked inventions. *But once all linking claims are canceled the Higinbotham doctrine would apply*, since the record would be one of agreement as to the propriety of division.

Where, however, there is a traverse on the ground that there is some relationship (other than and in addition to the linking type claim) that also prevents division, *the merits of the requirement are contested and not admitted*. Assume a particular situation of process and product made where the claim held linking is a claim to product limited by the process of making it. The traverse may set forth particular reasons for the conclusion that division is improper since the process necessarily makes the product and that there is no other present known process by which the product can be made. If division is approved and made final in spite of such traverse, the right to appeal is preserved even though all linking claims are canceled.

818.07 (d) Interference Issues—Not an Election

Where an interference is instituted prior to an applicant's election, the subject matter of the interference issues is not elected. An applicant may, after the termination of the interference, elect any one of the inventions that he claimed.

818.07 (e) Office May Waive Election and Permit Shift

Note 818.03 for "old combination" and novel subcombinations.

The general policy of the Office is not to permit the applicant to shift to claiming another invention after an election is once made. While applicant, as a *matter of right*, may not shift from claiming one invention to claiming another, the Office is not precluded from permitting a shift. It may do so where the shift results in no additional work or expense, and particularly where the shift reduces work as by simplifying the issues (*Ex parte Heritage Pat. No. 2,375,414* decided January 26, 1944).

Where the Office rejects on the ground that the process is obvious, the only invention being in the product made, presenting claims to the product is not a shift (*Ex parte Trevette*, 1901 C. D. 170; 97 O. G. 1173).

Having accepted a shift, case is not abandoned (*Meden v. Curtis*, 1905 C. D. 272; 117 O. G. 1795).

Division required, product elected—no shift where examiner holds invention to be in process (*Ex parte Grier*, 1923 C. D. 27; 309 O. G. 223).

Genus allowed, applicant may elect any two additional species thereunder, this not constituting a shift (*Ex parte Sharp et al.*, Patent No. 2,232,739).

Where added claims to an optionally divisible invention (see 808.02, last paragraph) are acted upon they should not be rejected as drawn to a non-elected invention (*Ex parte Schmidt*, Pat. No. 2,396,609).

818.07 (f) Office May Waive Election, Generally Does Not Permit Shift

While in a few instances it is Office policy to permit shift, the general policy is not to permit shift. When claims are presented which the Examiner holds are drawn to an invention other than elected he should reject the claims on that ground, as outlined in 821.03 and 821.03 (a).

Where the inventions are distinct and of such a nature that the Office compels division, an election is not waived even though the examiner gives action upon the patentability of the claims to the non-elected invention, *Ex parte Loewenbach* 1904 C. D. 170, 110 O. G. 857, and *In re Waugh* 1943 C. D. 411; 553 O. G. 3 (CCPA).

819 Authority of Primary Examiner in Requirement To Divide

The requirement to divide is an act by the Primary Examiner. He cannot make the requirement final when it is traversed without the approval of an Examiner of Classification. However, after he has made it final, or before, he may withdraw it, if he is persuaded that the withdrawal is proper. After it has been made final he need not re-submit the same question to an Examiner of Classification even though the applicant requests such second consideration of the same question of division. After a requirement to divide is made final, the applicant has the right to appeal to the Board of Appeals if he thinks that further consideration should be given to the question; *ex parte Atkins*, 1940 C. D. 2, 513 O. G. 497.

820 Review by an Examiner of Classification

Rule 143 after treating a traverse of a requirement to divide, provides "The requirement for division will be reconsidered on such request, but will not be repeated and made final without the written approval of an Examiner of Classification, a copy of which approval shall be supplied to the applicant."

The traverse may persuade the Primary Examiner that the requirement should be withdrawn (819). If it does not, he must submit the requirement to an Examiner of Classification.

820.01 Species, Genus

WHEN NOT SUBMITTED FOR REVIEW

Where generic claims are rejected and election of species required, a traverse of the rejection is not a traverse of the requirement for election of species and presents no question for review by an Examiner of Classification. The rejection of generic claims is reviewable only by way of appeal to the Board of Appeals. See 1205 and *Ex parte Doane*, 1931 C. D. 5; 410 O. G. 275.

Where there is no difference of opinion between the Examiner and applicant as to the mutually exclusive character of the species identified by the Examiner in requiring election, there is nothing to be reviewed by an Examiner of Classification. Thus, where the sole issue is the question of readability of claims on the disclosed species (i. e., whether or not claims are restricted to particular species or are generic to more than one), there is no review by an Examiner of Classification, the only review of this question being by way of appeal (*Ex parte Wilcox*, 1933 C. D. 1; 427 O. G. 3).

WHEN SUBMITTED FOR REVIEW

Even though the claimed subjects are species, and even though the generic claim is rejected, when the traverse is on the ground that there is some relation other than or in addition to the fact that plural species are claimed, the case is submitted for review.

For example:

Where the Examiner holds claims to be generic and rejects same, and applicant traverses on the ground that the claims are not generic but are for a subcombination common to the inventions claimed, the case should be submitted for review.

Where the traverse is on the ground that the species are disclosed as used in a single combination and are indivisible for that reason even though the generic claims are rejected (806.04 (b)) the case should be submitted.

820.02 Linking Claims Other Than Genus

A traverse of the rejection of linking claims only is not a traverse of the requirement, and is not reviewed by an Examiner of Classification.

When there is an additional traverse (other than the traverse of such rejection) that sets forth reasons why division among the inventions is improper, it must be submitted to an Examiner of Classification before being made final.

820.03 Mode of Submission

Where an examiner makes a complete requirement to divide, fully stating his reasons as to why the inventions as claimed are considered to be either independent or distinct and fully giving his reasons for compelling division, there is ordinarily no reason for the examiner in submitting the case for review to write a memorandum. His reasons are already on record, to accompany the traverse of the applicant.

However, where claims are added, a memorandum should be submitted to point out how the added claims should be disposed of in the light of the requirement to divide.

Also, where the claims are amended in substance the examiner may submit a memorandum. If such changes affect the requirement to divide, the examiner should submit a memorandum pointing out how the requirement is affected. If such amendments do not affect the requirement to divide, no memorandum is necessary.

Finally, where some of the arguments in the traverse have not been anticipated, the examiner may submit a memorandum answering the same.

820.04 Decision Rendered

Where an Examiner of Classification renders a decision which approves, either in whole or in part, a requirement to divide, he will supply the Primary Examiner with both an original copy and carbon of his decision. These copies will be attached to the original and carbon copies respectively, of the Office action making the requirement final so as to become parts thereof. The necessity of quoting the decision in the Office action is thereby removed. In the body of the Examiner's action should appear the statement that the requirement to divide, as approved in the attached decision, is made final. The decision and action will thus have the same paper number and will be entered together in the "Contents" section of the file wrapper.

Where the requirement to divide is entirely disapproved, the decision should not be entered in the file. The next Office action, however, should either withdraw the requirement, hold it in abeyance, or modify it, as the facts warrant. (Notice of Apr. 6, 1948.)

821 Treatment of Claims to Non-Elected Inventions

For rejection of claims to non-elected species, see 809.02 (a). Sections 821.01 to 821.03 (a) deal with the treatment of claims to non-elected inventions under various election situations.

821.01 After Election With Traverse of Requirement for Division

If applicant traverses the requirement for division and the requirement is approved by an Examiner of Classification (820 through 820.04), the claims to the non-elected inventions should, in the subsequent Office action, be finally rejected on the ground of *misjoinder* of invention. The requirement for division is, in effect, a rejection on the ground of misjoinder of inventions, and thus lays the ground for the subsequent final rejection for misjoinder. The final rejection on the ground of "misjoinder" indicates that the applicant has retained the right of appeal on the question of division, and should be used *only* when such right of appeal has been preserved. See 818.07 (b).

In subsequent office actions the claims to the non-elected inventions, if retained, should be noted as "standing finally rejected on the ground of misjoinder."

821.02 After Election Without Traverse of Requirement for Division

If the applicant elects without traversing the requirement for division, the claims to the non-elected inventions, if retained in the case, are rejected on the ground that applicant, having elected without traversing the requirement for division, *has waived the right to further prosecute these claims in this application; Ex parte Higinbotham, 304 O. G. 231; 1922 C. D. 29.* This rejection should be repeated in each action so long as any of these claims is retained and should be made final when action on the remaining claims in the case is made final. The rejection in this form indicates that the applicant does not have the right to appeal on the question of division. See 818.07 (b).

The use of the term "estoppel" in this type of rejection should be avoided.

821.02 (a) Case Otherwise Ready for Issue

If during the prosecution of the application the Examiner believes the case to be in condition for issue except for the presence of the non-elected claims retained under the Higinbotham doctrine, such claims may be cancelled by an Examiner's Amendment and the case passed for issue. The Examiner's Amendment should embody a statement such as follows:

In view of the fact that this application is in condition for allowance except for the presence of non-elected claims —, these claims have been cancelled.

Under Rule 144 applicant's election of the subject matter of the allowed claims without a traverse of the requirement for division constitutes a waiver of the right of appeal from such requirement and is accordingly treated as a withdrawal of the non-elected claims.

821.03 Added Claims to Non-Elected Inventions

Rule 145 Subsequent presentation of claims for different invention. If, after an Office action on an application, the applicant presents claims directed to an invention divisible from the invention previously claimed, such claims, if the amendment is entered, will be rejected and the applicant will be required to limit the claims to the invention previously claimed. Such rejection and requirement will not be repeated and made final without the written approval of an examiner of classification.

Claims to an invention other than that elected, added after an election has been made, and including retained claims to a non-elected invention that are amended, should be rejected on the ground that the added claims are *drawn to an invention other than that elected*, except where there is a permissible shift. See 818.07 (e). This should be the form of the rejection regardless of how the election was made, whether deliberately made with or without traverse in response to a requirement for division, 818.07 through 818.07 (c) or whether made constructively, as by original presentation (818.05) or by optional cancellation (818.06). The Examiner should explain, in making the rejection, in what manner the election was made.

The rejection above noted is, in effect, a requirement to divide without a right to elect, since an election already has been made (*Ex parte Pearson*, 1918 C. D. 36; 253 O. G. 259). Accordingly the Examiner should state the reasons why the subject matter of the rejected claims is considered divisible from the elected invention. If there has been a previous requirement for division and it is believed that the added claims should be divided for the same reasons as were given in the previous requirement, a mere statement to that effect may be sufficient. If the original reasons require modification with respect to the new claims, the modification of these reasons should be stated. If the reasons stated in the original requirement for division (either as such or in slightly modified form) are not applicable to the newly added claims (e. g. because they are for subject matter not before claimed), or if there has been no previous requirement for division, the reasons for division as to the added claims

should be stated in a manner similar to an original requirement (808.01, 808.02, 809.02 (a) and 817).

821.03 (a) Subsequent Rejections of Added Claims

A. APPLICANT TRAVERSES

If applicant responds to the rejection of the subsequently presented or amended claims as drawn to an invention other than that elected with a proper traverse (818.07 (b)), he retains a right of appeal from this rejection of the new claims. This is true even where the rejected claims are held by the Examiner to be for the same subject matter as claims non-elected without traverse in response to a previous division requirement. (*Ex parte McKillop*, 1919 C. D. 125; 269 O. G. 703), and the right to appeal as to the original non-traversed requirement is lost (818.07 (b)).

Accordingly, upon traverse of the rejection, and if the Examiner still believes the rejection to be proper (819), the question is submitted to an Examiner of Classification (Rule 145), in the manner described in 820.03, and if written approval is obtained (see 820.04), the rejection of the added claims may be repeated and made final. *The wording of this rejection is "finally rejected on the ground of misjoinder"*, thus indicating the preservation of the right of appeal. The rejection is repeated in subsequent actions as "stand finally rejected on the ground of misjoinder".

It may be noted here that a traverse may, without denying the divisibility of previously considered groups of claims, challenge the assignment of the new claims to a non-elected group; but a traverse may not properly be based upon a mere change of purpose.

B. APPLICANT DOES NOT TRAVERSE

If the applicant admits the propriety of the rejection of the added claims as drawn to an invention other than that elected, subsequent rejections of these claims, if retained, are on the ground that applicant, having failed to traverse such rejection, has *waived the right to further prosecute these claims in this application*; *Ex parte Higinbotham*, 1922 C. D. 29; 304 O. G. 23. Such rejection indicates the loss of the right of appeal on the question of division as to these claims. If the application should be placed in condition for issue except for the presence of claims rejected in the manner above described, these may be cancelled by Examiner's Amendment. (See 821.02 (a) for form of amendment).

822 Claims to Inventions That Are Not Distinct in Plural Applications of Same Inventor

It has been pointed out that where the subject matter claimed in an application is for an invention not distinct from the subject matter claimed in a patent issued to the same inventor, the application claims should be rejected on the claimed subject matter of the patent, on the ground of double patenting.

The treatment of plural applications of the same inventor, none of which has become a patent, is treated in Rule 78 as follows:

(b) Where two or more applications filed by the same applicant, or owned by the same party, contain conflicting claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention in more than one application.

[Old Rule 94]

The following three sections consider only applications of a single inventor, but not conflicting subject matter in two applications, same inventor, one assigned (see 304); conflicting subject matter, different inventors, common ownership (see 305); rejecting one claim on another in same application (see 706.03 (k)), or species and genus in separate applications (see 806.04 (h) through 806.04 (j).)

822.01 Co-pending Before the Examiner

Under Rule 78 (b) the practice relative to overlapping claims in applications co-pending before the examiner, is as follows:

Where claims in one application are unpatentable over claims of another application of the same inventor, (either because they recite the same subject matter, or because the prior art shows that the differences do not impart a patentable distinction) the claims of the one application may be rejected on the claims of the other, *whether the claims of the other are allowed or not*. Such rejection may be made in only one of the applications.

In aggravated situations no other rejection need be entered on the claims held unpatentable over the claims of the other application. However, any additional claims in the one application that are not rejected on the claims of the other should be fully treated.

822.02 Rejection of One Affirmed on Appeal

Where two applications claim inventions that are not patentably distinct and the examiner's rejection of one has been affirmed on appeal, the other may be rejected on the one appealed, on the ground of *res judicata*; In re Edison, 1908 C. D. 327; 133 O. G. 1190; 30 App. D. C. 321. See 706.03 (w).

822.03 One in Issue or in Interference

Where one application is allowed and in issue, or is in interference, the claims in a second application by the same inventor that are for either the same invention or an invention not patentably distinct from the invention allowed or forming the interference issues should be rejected. See 709.01.