

# Restriction Requirements

## Strategies for Defeating Patent Application Restriction Requirements

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It is only natural when filing a patent application with the U.S. Patent & Trademark Office (“USPTO”) to want to protect as much subject matter as possible. Usually applicants try to cover an array of invention categories such as a method for making a product, a product, a system containing the product, and a method for using the product. The downside may come when the USPTO imposes its authority for a restriction requirement on the patent application, forcing the owner to choose just one of those categories to be examined. Unless the owner argues successfully against the restriction requirement, the result is that the owner will be forced to file additional patent applications, i.e. divisional applications, for the other categories of invention, increasing the costs and slowing the process of protecting all aspects of the invention.

The following are suggestions for preventing restriction requirements from being imposed as well as overcoming restriction requirements when imposed, and lessening the impact on the patent application.

The first strategy for preventing a restriction requirement is to file separate patent applications for each category of invention rather than wait for a restriction requirement. This strategy has the advantage of quickening protection of all aspects of the invention, but will increase the costs from the start.

Another strategy for preventing a restriction requirement involves the manner in which the patent application is prepared. When drafting the patent application, method claims and product claims can be written to share as many similar limitations as possible. This technique will reduce the ability of the examiner to support a restriction requirement between the method claims and the product claims by showing that the method as claimed can be used to make a different product or the product as claimed can be made by a different method. Also, the use of a linking claim between product claims and method claims should be considered.

Linking claims can be used to limit the impact of the restriction requirement by allowing both the product and method claims to be examined together.

Another strategy for preventing a restriction requirement relates to an election of species requirement where the USPTO forces the patent owner to choose between separate species within the same genus. It is actually very difficult, if not impossible, to prevent an election of species requirement from being imposed since the other species in the genus are still examined in the same application, but only after the first species is examined. Costs do not increase with an election of species requirement, but the application can be delayed. To lessen the impact of an election of species requirement, one claim should be drafted as broadly as possible so it can be considered a generic claim to all of the potential species. The examiner must examine the generic claim and, once allowed, any species claim depending from the generic claim should also be allowable.

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If a restriction requirement is imposed, one very effective strategy is to amend the claims so it is possible to defeat the restriction requirement or argue that it should be modified. For example, there is no reason why a generic claim or a linking claim cannot be added. There is also no reason why a generic claim cannot be amended to include all of the species. Nor is there any reason why the product and method claims cannot be amended to contain as many similar limitations as possible.

The most common strategy when a restriction requirement is imposed is to reply and argue that the restriction requirement is improper. If successful, it will be removed and all categories of the invention will be examined. To defeat a restriction requirement, the requirement itself and the underlying reasoning from the examiner should be carefully examined. One mistake made by examiners is applying Patent Cooperation Treaty (“PCT”) rules to U.S. applications. It is a simple matter to prove in a reply that the PCT rules do not apply in U.S. applications. A second mistake made by examiners is not accounting for all generic or linking claims. Other mistakes include imposing a species election where they are not mutually exclusive, and imposing a restriction rather than an election of species. Perhaps the most common mistake is when an examiner does not provide sufficient reasoning to

support the argument that the method as claimed can be used to make a different product or the product as claimed can be made by a different method.

The following is an example of a strategy for overcoming a restriction requirement. While not foolproof, it can often be very effective. In this example, the owner drafted the application (or amended the claims) so it contained a product claim and two method claims.

Product Claim: A table, comprising:

- a top;
- a first leg connected to the top;
- a second leg connected to the top;
- a third leg connected to the top; and
- a fourth leg connected to the top.

Method Claim (A): A method for making a table, comprising:

- making a top by . . . ;
- making a first leg by . . . ;
- making a second leg by . . . ;
- making a third leg by . . . ;
- making a fourth leg by . . . ; and
- connecting the four legs to the top by . . .

Method Claim (B): A method for making a table, comprising:

- providing a top;
- providing a first leg connected to the top;
- providing a second leg connected to the top;
- providing a third leg connected to the top; and
- providing a fourth leg connected to the top.

The examiner initially reviews the application and notices two categories of claims are present: a product claim and the method (A) claim. Without noticing method claim (B), the examiner restricts the claims on the basis that the claimed product can be made using a materially different process or the claimed process can be used to make a materially different product. The examiner groups the method claims as containing both method claim (A) and method claim (B).

In reality, both the product claim and method claim (B) contain almost the exact same limitations. The only difference between these two claims is the “providing” language before each limitation in the method (B) claim. Thus, it can be very difficult for the examiner to show the claimed product can be made by a materially different process, or vice versa.

Examiners will then take one of two actions. First, examiners may put further thought and effort into the restriction requirement and make it final with a better rationale. Or second, examiners may think they were wrong, give up on the restriction requirement, and examine all of the claims. This second action often occurs when the examiner is fairly junior.

Win or lose, there are certain actions that can be taken to lessen the impact of a restriction requirement. For an election of species requirement, the generic claim should be an independent claim containing both the elected species and the non-elected species. When the elected species has been allowed, the examiner must examine the non-elected species. But, if the claim is already an independent claim and the examiner has already determined it is allowable, the examiner will likely do nothing more. When the elected species is in a dependent claim, the examiner will continue the examination process.

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Also, one's ability to take advantage of rejoinder practice must be kept in mind. With rejoinders, the owner can rejoin claims after the product and method claims have been restricted. Where the owner elected and obtained allowance of a product claim, the process claims may be rejoined if the process claims depend from or include all the limitations of the allowable product claim. The best method for keeping rejoinder a viable option is to not cancel the method claims; rather, continue to amend the method claims throughout prosecution even after they have been withdrawn.

Careful forethought and knowledge of the process when preparing a patent application is ultimately the best strategy for defeating restriction requirements.

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