

Examiners use restriction practice to focus their search and examination when the patent includes claims directed to multiple patentably distinct inventions or species. The three main ways claims can be restricted are (1) restriction between different inventions, typically claims in different statutory classes, but also patentably distinct combinations and subcombinations, (2) restriction between different species in the same statutory class, and (3) lack of unity for 371 applications based on a PCT Application.

Making a proper election is essential to future prosecution and must be carefully thought out. Understanding the different ways that claims can be restricted out, what the Examiner is trying to accomplish, and what aspects of the invention are most important to the applicant can help a practitioner make the best election. Failure to respond properly can have negative consequences, such as upsetting the Examiner and painting yourself into a corner.

Restriction can be beneficial where the applicant desires to pursue different aspects of the invention and avoid nonstatutory double patenting rejections and having to file Terminal Disclaimers. Where it is desired to minimize cost and keep as many aspects of the invention together in a single application, it is important to recognize and carefully navigate through various traps that Examiners sometimes set. One is where the Examiner restricts claims directed to a combination (ABC) and subcombination (BC). In such case, it is usually preferable to elect the combination because it permits applicant to pursue claims to both the combination (ABC) and subcombination (BC) by arguing that claims to the subcombination are “generic” to the elected combination. The danger lies in electing the subcombination (BC), which can result in the Examiner forbidding applicant to pursue claims to the non-elected combination (ABC).

A similar situation involves purported “election of species” requirements in which one of the “species” is actually generic to the other species. While this type of requirement should be improper and may be petitionable, an approach that seems to work is to elect the actual species that best matches applicant’s preferred embodiment. That permits applicant to pursue both generic claims and claims that read on the elected species. However, the opposite does not appear to work – electing the more generic “species” on the logic that it

also includes the non-elected species. In such case, the Examiner might forbid applicant from amending the claims to recite *any* elements pertaining to the non-elected species. Therefore, there is more freedom to amend and pursue both broad and narrow claims if desired by electing the narrowest desirable species.