Subject: Re: [Efs-web-L] Rejoinder of withdrawn claims canceled by examiner
Date: Friday, September 3, 2021 at 3:31:04 PM Central Daylight Time
From: Efs-web on behalf of David Boundy via Efs-web
To: for users of EFS-Web, Maria Eliseeva
CC: David Boundy
Attachments: ATT00001.txt

Maria --

Item 1. I agree with Bryan and Bob Blaha -- if the method claims and apparatus claims are "twins" (like in most computer cases), getting rejoinder at this point is a near sure thing if you phone.

Item 2. If the examiner cut enough corners in the original restriction, you can petition for rejoinder on the ground that if the examiner didn't serve the ball into the right court, then you don't have to hit it back. Even if you elected without traverse. I had this in a case I took over, the prior attorney had elected without traverse, but the examiner's original paper (years before) was nothing but shortcut. See 14/280,469, petition of June 7, 2021, decision of July 23, 2021.

Item 3. How to deal with it next time and prevent getting yourself into this box. In 2021, with rare exceptions, electing without traverse is utterly unconscionable, because the examiners' papers are usually unconscionable. In the last 2-3 years, restriction/election practice has gone from "often questionable" to "usually brazen lying ass cheating." Many (I'll go as far as "almost all") restriction requirements are milking counts. It's theft. You cannot just roll over for theft. I won't say it's most examiners, but it's the overwhelming majority of examiners that issue restriction requirements.

Example: last week I responded to a restriction --
-- the examiner had assigned one group to a class/subclass that ***doesn't exist*** -- utter fabrication, for no purpose other than to milk counts. This has become the pattern in the last two years or so -- for well over half of all restrictions, 30 seconds in the Manual of Classification https://www.uspto.gov/web/patents/classification , will show that either a class doesn't exist, or the assignment to search classes is complete nonsense, and there's one class that fits all claims like a glove.
-- the examiner wrote "claim A is divisible from claim B because claim A has language 'AAAAA' but B doesn't" and I wrote back and said "Baloney. Exactly the same language is in claim B at lines 17-21" (I knew because I had written claim B by using exactly the language of claim A, precisely to catch this examiner because he'd been pulling this stunt with the previous attorney.).

Here's an update of the long post I send from time to time. It's slightly elaborated since last time I circulated it on Carl's lists -- if you've read the earlier incarnations, this is 90% the same. I'm sure there's something new in there somewhere. This combination of stuff works -- I don't think I've had three successful restriction requirements against me in 25 years (I've been in practice 29).

There are seven grounds on which to traverse a restriction or election of species. You have been told not to traverse. That's wrong. Of the seven grounds, six are useful, and only one ("not patentably distinct") is a ground you **never** use. The other six are just fine. And in addition, for almost all elections of species, you can almost certainly pick one species/figure on which all claims are "readable," and thereby elect all claims.

Foundation. You must **fully** understand the difference between a statutory "restriction requirement" vs. a regulatory "election of species."

The PTO's only statutory authority is 35 U.S.C. § 121. That requires a showing of "independent and distinct," and then guidance adds a further requirement, "serious burden." A regulatory election of species has no direct statutory authority. So it has to fit into the statute somehow. The way it fits is like a financial "call" option on a future restriction -- an election of species has no effect today, it only creates a right for the examiner that ***will*** arise and ***will*** mature into a statutory restriction in the future, if certain contingencies occur.

Restriction requirement	**Election of Species**
Two or more “independent and distinct” inventions are claimed in one application	Two or more patentably distinct species of a generic invention
Statutory—35 U.S.C. § 121, concern that a patent should cover one invention	Nonstatutory concerns for examiner loading—37 C.F. § 1.146
Always asks you to elect from among *claims*	Asks you to elect among *species* in the disclosure
Almost always asks you to elect between independent claims	Typically (though not necessarily) asks you to elect ar dependent claims, or *Markush* species, under a comn parent independent claim
	Requires mutually-exclusive species (MPEP § 806.04(overlap in scope
Nonelected claims are withdrawn from further consideration (subject to petition for rejoinder under § 1.144)	Elected species is examined, and if that species is pat then the genus and other species are also examined
If one claim is generic to another, the broader claim is a “linking claim” under MPEP § 806.05(III) and § 809	If any generic claim is allowed, the election of species requirement dissolves as if it never existed
Further Replies to Office Action use the claim status identifier “(Withdrawn)”	Further Replies to Office Action show nonelected clai “(Original),” “(Currently amended),” or “(Previously presented)”
Once either form is final, you can petition for rejoinder (37 C.F.R. § 1.144) and/or file a divisional	

There are many reasons to traverse a restriction or election of species requirement, and for keeping as many claims together as possible (there are exceptions, of course, and maybe we'll talk about them some day):

1. Costs (more filing fees, more issue fees, more maintenance fees, more hassle in managing more cases, the n-squared cost of managing IDS's for parallel cases).
2. The CCPA noted at least twice that the whole is more than the sum of its parts because of adverse claim construction inferences, and that sometimes you *can't* recover the full scope of the original claims with any number of divisionals. *In re Marti*, 359 F.2d 900, 149 USPQ 534 (CCPA 1966) and *In re Weber*, 580 F.2d 455, 198 USPQ 328 (CCPA 1978).
3. And almost always in 2021, the examiner's chopping is so fine that it would be cost-prohibitive to try to recover all subject matter through a large number of divisionals.
4. Delays in issuance of some of the claims (if you have to restrict, the restricted claims will issue at least 18 months later than the other claims).
5. Reduction in patent term (you lose 14 months of patent term adjustment for the time until the divisional application comes up for first examination).
6. The longer the application is pending and the more different claims pending, the greater the opportunity to amend the claims to track competitors' products.
7. Likewise, the longer the application is pending and the more different claims pending, the greater the opportunity to retailor the claims to track evolution of your client's own commercial product.
8. Loss of patent term adjustment: Almost always, the first patent in a family has the greatest accumulation of patent term adjustment, but daughter cases will have close to zero. If you keep all claims together, all claims benefit from that longer term.
9. Keeping more claims together usually delays final rejection, which in turn usually increases patent term adjustment.
10. If the restricted claims are very similar (for example, some examiners will restrict between method and apparatus "twins" of each other), and one set of claims issues, and you present the other claims in a divisional, and the examiner rejects the second set of claims, you now have bad dents and tarnish on the claims in the parent issued patent, and no meaningful way to fix it.
11. Some very disingenuous examiners, if they require election of species between A B and C, and you try to add a C limitation to a B claim, will claim you can't do it. The examiner is cheating of course, but it's an additional cost if you acquiesce to a bogus restriction/election.
12. Substantive risks of inconsistent arguments (at the very least, you will have to make arguments in the later cases that you could not have foreseen during prosecution of the earlier cases)
13. Division of claims increases risks of prosecution history estoppel and disclaimer of broader claim scope.
14. Contrary to popular belief, double patenting is a real risk. The § 121 safe harbor for divisionals has many prerequisites, it's far from a given. Basically, if you make an election today, and you amend any of the claims at any time in the future, the result may no longer be "consonant," and the § 121 safe harbor would no longer apply. *Geneva Pharms., Inc. v. GlaxoSmithKline PLC*, 349 F.3d 1373, 1381, 68 USPQ2d 1865, 1871 (Fed. Cir. 2003).
15. It's not clear that an election of species qualifies as a statutory restriction to trigger the § 121 safe harbor. Though I know of no case directly on point in either direction, it's possible that if you ***don't*** pursue the remedies available to you to traverse an election of species (which, after all, is not a *present* restriction, only an option or warning of a *future* restriction), a court could conclude that your continuation is a voluntary divisional, and that the § 121 safe harbor doesn't apply. *See Geneva Pharms., Inc. v. GlaxoSmithKline PLC*, 349 F.3d 1373, 1379–80, 68 USPQ2d 1865, 1870 (Fed. Cir. 2003) ("In the [parent] application, the method of use claims were not entered. Therefore, those claims could not have been subject to a restriction requirement. If the applicants sought the benefit of § 121, the applicants should have requested entry of the claims so that the PTO could issue a formal restriction requirement under [37 C.F.R.] § 1.145.")
16. Blocking an examiner from shortcutting (well, let's call it what it is -- cheating) early in the process seems to

reduce shortcutting later in the process. If you give candy to a playground bully, you'll get pounded again. If you make clear that you are not a pattsy, the bully stops.

Now -- **HOW** do you traverse? That's the important question. True, you **NEVER EVER EVER** traverse on "not patentably distinct." Which means that all traverses are either procedural (the examiner skipped a necessary showing) or arise under the "no serious burden" prong, or the "not mutually exclusive" prong for election of species. There are at least four ways to traverse a statutory restriction or regulatory election of species --

- no ***showing*** of independent and distinct
- not independent and distinct (which is here only of academic interest -- you'd NEVER actually argue this)
- no ***showing*** of serious burden
- no serious burden

and three more for a regulatory election of species:

- not mutually exclusive (that's almost always a good ground of traverse an election of species in anything except chemistry)
- if the examiner gives you three ways to characterize the group (figures, words to characterize the group, and claims), you can pick any one of the three characterizations of the group, and ignore the other two.
- You can defeat an election of species by the designation of generic claims and designation of "readable on." In many cases, most claims will be "readable on" many of the examiner's groups. It's a mistake to assume that any claim can only be a member of one group.

Challenging a statutory restriction requirement between independent claims.

MPEP § 803 states that the examiner must make two showings for any restriction requirement: "independent and distinct" and "serious burden."

Independent and distinct. The only really safe way to challenge "independent and distinct" is to challenge a procedural aspect in a way that contains no admission that the subject matter of the two inventions is even related. The things I see over and over:

- Almost all of the form paragraphs require examiners to show search class and subclass for each group. Look up the class/subclass in the Manual of Classification. About 10% of the time, one of the classes doesn't exist —the examiner just made it up. Another 50% of the time, one or more of the search classes exists but is completely bogus, selected in clear bad faith. Only 20-30% of the time are the two classes/subclasses plausible. Often there's another class/subclass that's spot on for all groups, and the examiner overlooked it. You can argue whatever is appropriate.
- About 1/3 of the time, the examiner "edited" the relevant form paragraph. Find the relevant form paragraph in MPEP Chapter 800, and test it. if the examiner shortcut, you've got a good ground to traverse that won't hurt you.
- MPEP § 809.02(a)(B) requires that an Action identify the characteristics of the disclosed species among which election is proposed that establish the basis for division and classification. Examiners skip this more often than they show it.

Serious burden. MPEP § 808.02 clarifies that there are only three ways to show “serious burden:” "separate classification," "separate status in the art," and "different field of search." MPEP § 803(I)(B), § 803(II) ¶ 4, and § 806.01 requires “Examiners must provide reasons and/or examples to support conclusions” of “unduly extensive and burdensome search,” for example, by “appropriate explanation of separate classification, or separate status in the art, or a different field of search.” Examiners stopped doing this around 2010. The requirement is still in the MPEP, and you can OFTEN shut down a restriction if you demand such a showing.

Challenging a regulatory election of species requirement (almost always between dependent claims).

Strategic point 1. The PTO's only authority for election of species requirements lies in the restriction statute. MPEP § 809.02(a) clarifies that the requirements that must be shown for a Requirement for Election of Species are a superset of the showings required for a valid Restriction Requirement. Examiners skip this essentially 100% of the time—showings of "independent and distinct" and "serious burden" are a true rarity. Perfectly good basis for traverse.

Strategic point 2. In addition, an election of species requirement requires that the species be "mutually exclusive." MPEP § 806.04(f).

Strategic point 3. It's crucial to remember the key property of an election of species requirement—if any generic claim is allowed, then all groups of which that claim is a member come back in. So in an election of species requirement, your main goals are—

(1) describe as many claims as possible as generic to as many groups as possible.

(2) of the claims that you can't genericize, get as many into your elected group as possible.

In most cases, if you do those two well, any traverse is almost a tertiary concern.

Strategic point 4. "Readable on" is not "reads on." "Readable on" is a term that is only used in this context -- it has no other meaning or use in patent law, and the MPEP doesn't define it. "Readable on" doesn't mean "this isolated feature in this specific claim looks a little bit like that figure." "Reads on" means "every limitation, limitation-by-limitation, exactly." That's obviously not what the MPEP means. "Readable on" has to be DIFFERENT. The only sensible meaning of "readable on" is "has no limitation that rules out all possible correspondence." So if Figs 1-23 show various configurations of the inlet port, and Fig. 24 shows a round outlet port, and Fig. 25 shows a square outlet port, then a claim that says "wherein the outlet port is rectangular" ***reads on*** Fig 25, but is ***readable on*** Figs. 1-23 and Fig 25. Remember that election of species was originally designed for chemistry, where atoms are discrete and it's easy to see when two claims are "mutually exclusive" (this one says "a methyl group" and that one says "chlorine"). With that background, it's easy to see what "readable on" means.

Strategic point 5. Carefully **read** the examiner's paper, and compare it to the MPEP. Cheating is rampant. Most of the form paragraphs require the examiner to designate a search class/subclass -- many examiners leave that out. Simplifying the form paragraphs is just plain cheating. Look at the examiner's class/subclass -- well over half the time, one or more is totally bogus, and and ***nothing*** to do with the invention -- clearly the examiner just threw darts. Also known as cheating. So spend the time to find the right class/subclass the claims ***should*** be searched in, and point out that that removes the examiner''s "serious burden of search." And ask what good faith basis there could possibly be for the examiner to propose to search in classes that are so obviously irrelevant.

These strategic points give you great power, the power by which I defeat every single election of species requirement, and the overwhelming majority of restriction requirements, I've had in 29 years. Those four letters of "readable on" let you designate essentially all claims as generic to multiple groups.

Let’s illustrate, using the following set of example claims and figures:

1. A widget with an inlet port and an outlet port.
2. The widget of claim 1, further comprising a baffle in the outlet port.
3. The widget of claim 1, wherein the inlet port is round.
4. The widget of claim 1, wherein the inlet port is square.
5. The widget of claim 1, wherein the inlet port is long.
6. The widget of claim 1, wherein the outlet port is long.

7. The widget of claim 1, wherein the outlet port is short.

8. The widget of claim 1, wherein the outlet port is round.

Fig. 1 shows a widget in which the inlet port is long and round, and the outlet port is short and square with a baffle. Fig. 2 shows another widget, in which the inlet port is long and square, and the outlet port is short and round. Fig. 3 is a detail view of only an inlet port, in which the inlet port is short and rectangular. Fig. 4 is a detail view of only an outlet port, in which the outlet port is long and round.

You might respond:

Group I relates to a round inlet port. Claims 1–3 and 5–8 are readable on group I.

Group II relates to a square inlet port. Claims 1, 2, and 4–8 are readable on group II.

Group III relates to a rectangular inlet port. Claims 1, 2, and 5–8 are readable on group III.

Group IV relates to a round outlet port. Claims 1–8 are readable on group IV.

Applicant elects group IV. Claims 1–2 and 5–8 are generic to all groups. Claim 3 is generic to groups I and IV. Claim 4 is generic to groups II and IV.

Boom. You still have to raise some traverse, to preserve future rights. But the heart of the technique is a a perfectly good election. By making all claims generic, you've neutered the requirement, and you give up essentially nothing.

Often I amend the dependent claims to reduce restrictability. For example, I add dependent claims that make clear that the species or inventions are useable in combination.

Factors to consider in selecting a species include:

- Select a species that has explicit enabling and written description support (particularly important in biotech/chem/pharma cases)
- Select a species that, to the best information you and the client have, is free of the art
- If the likely commercial embodiment is known, select the species that covers the commercial embodiment
- Select the species that retains the most options for downstream prosecution, which is usually the most generic species

For some examples, see

- https://forum.napp.org/topic/1771-successful-example-of-how-to-deal-with-a-bogus-election-of-species-based-on-figures
- 16/018,626, Aug 7, 2020 to Feb 3, 2021
- 14/280,469 March 30, 2020
- 11/533,300 Feb 12, 2013
- 14/266,013 Aug 31, 2019
- 15/285,209 Dec 5, 2017
- 14/280,469, petition of June 7, 2021, decision of July 23, 2021.

On Fri, Sep 3, 2021 at 3:28 PM Maria Eliseeva via Efs-web <efs-web@oppedahl-lists.com> wrote:

> Dear colleagues,

There is a case where apparatus claims were recently allowed. Process claims were withdrawn after a restriction without traverse. Examiner canceled the withdrawn claims himself and issued allowance of the apparatus claims.

Client wants to request that those withdrawn/canceled claims be rejoined (they are allowable process claims now). I checked the MPEP and it is my understanding that there is a possibility for a request to reinstate and rejoin canceled claims. Have you rejoined such process claims in your practice and are there are issues to watch for in doing so?What is your experience?

TIA!

Maria

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