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From appearance, the Requirement for Restriction (RR for short) in the U.S. and the Requirement for Unity (UR for short) in China are similar in that they require the applicant to make an election among a plurality of claims to be examined in a pending patent application. However, the two practices are not the same.

Practical Considerations in Restriction and Unity Practice

From appearance, the Requirement for Restriction (RR for short) in the U.S. and the Requirement for Unity (UR for short) in China are similar in that they require the applicant to make an election among a plurality of claims to be examined in a pending patent application. However, the two practices are not the same.

Restriction occurs when, in the opinion of the USPTO, there are at least two inventions in a single patent application and (i) the inventions are independent or distinct and (ii) there would be a serious burden on the examiner if restriction is not required. Unity before CNIPA (from August 28, 2018, SIPO has been renamed as CNIPA), rooted in PCT Implementing Rules, requires a patent application relating to (i) one invention or (ii) a group of inventions so linked as to form a single general inventive concept, while the latter usually results from a prior art search and an initial assessment of novelty or inventiveness of the subject-matter of an independent claim.

Apparently, the rationales behind the two requirements are different. The USPTO considers whether there exists a serious search burden as a core factor in deciding whether a requirement for restriction should be issued. See MPEP ("Manual of Patent Examining Procedure"). On the other hand, CNIPA does not treat the search burden as the core, rather considers facilitating in search and examination as the main factor. Taking these rationales into account, we can observe that the USPTO focuses on search burden on the examiner, while CNIPA focuses on examination efficiency, which may explain a fact that many patent applications would encounter RRs from USPTO, and not URs from CNIPA.

I. Taken a scenario of claiming genus and species for example

The applicant generally hopes to pursue a broad genus claim, and reserve narrow species claims. In such a scenario, the USPTO is very likely to issue a RR which identifies two or more groups/genus, two or more species, and/or two or more sub-species that an applicant must choose between for substantive examination.

E.g. claim 1 is a genus claim to a toilet seat having a retractable cover and claims 2-3 are respectively directed to a species of the retractable cover being a foldable curtain and a species about the retractable cover being roller curtain. Assuming an RR is issued and claim 2 is selected, the examiner's search would be very specific. Had the search result for genus claim 1 been positive meaning that species claims 2 and 3 are patentable, claim 3, withdrawn during the selection, would be able to rejoin. Had the search result for genus claim 1 been negative, regardless of the search result for species claim 2, the applicant has to file another application to pursue claim 3.

While in CNIPA, it is unlikely that an examiner requires a selection between species claims when they are respectively dependent upon a genus claim. Generally, the examiner would continue her/his searches on the species once s/he identifies claim 1 unpatentable, e.g., the examiner may fail to identify any prior art reference against claim 2 or 3. In such a case, the applicant may amend claims by incorporating claim 2 into claim 1, and/or alternatively, may file a new application pursuing an independent claim 1 comprising old claims 1 and 3.

II. Taken a scenario of claiming product and process for example

The following claims illustrate this common scenario.

1. A piezoelectric element, comprising: a piezoelectric part; a first substrate and a second substrate, provided at both sides of the piezoelectric part, respectively; a first electrode layer, located between the first substrate and the piezoelectric part; and a second electrode layer, located between the electrode substrate and the piezoelectric part, wherein a surface of at least one of the first substrate and the second substrate close to the piezoelectric part is provided with a convex portion.

2. A method for manufacturing a piezoelectric element, comprising: providing a piezoelectric part; forming a first substrate and a second substrate, a first surface of at least one of the first substrate and the second substrate having a convex portion; forming a first electrode layer and a second electrode layer on the first surfaces of the first substrate and the second substrate, respectively; and arranging the first substrate and the second substrate at both sides of the piezoelectric part, such that the first electrode layer is located between the first substrate and the piezoelectric part, and the second electrode layer is located between the piezoelectric part and the electrode substrate.

A. Possibility of issuing a RR or UR

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Generally, such claims will not subject to a Unity Requirement in CNIPA, as the criteria is whether there exists the same or a corresponding feature in claims. The above product and process claims do recite common features, e.g., a piezoelectric part, a first substrate and a second substrate, convex portion in one of the substrate, and location relationship between these members. Accordingly, the examiner will search for prior art on the patentability of the two claims.

Failure to identify any prior art rendering the product claim unpatentable would result in the unity of the process claim. However, once the examiner has assessed the product claim unpatentable based on the prior art, s/he would continue to search for the claimed process. By such a claiming strategy, the applicant would have the two kinds of claims searched and examined at the same time, and can even get issued on the process claim.

However, regarding the above scenario, the possibility of issuing a restriction requirement by the USPTO is high.

MPEP's 806. 05(f) provides:

"A process of making and a product made by the process can be shown to be distinct inventions if either or both of the following can be shown: (A) that the process as claimed is not an obvious process of making the product and the process as claimed can be used to make another materially different product; or (B) that the product as claimed can be made by another materially different process."

Following the above rule, it means a restriction requirement generally will be issued if the examiner needs to make a search for both product claim and process claims. In other words, for example, only if the process as claimed is an obvious process of making the product and cannot be used to make another materially different product, there would not be a RR. That means, after the examiner makes a search for a product claim, the examiner doesn't need to make a search for the process claim and apply the search result against the product claim to the process claim.

Assuming an RR is issued with respect to the afore-described claims 1-2 and claim 1 is elected. If the examiner in USPTO doesn't find any prior art reference against the novelty and inventiveness of the product claim, to rejoin the process claim, the applicant will have to amend the process claim incorporating all the limitations of the allowed product claim, which, in fact, is similar to, but stricter than, that in CNIPA. As discussed above, given the common or corresponding special technical features contributing to the patentability, CNIPA doesn't require the process claim reciting all the limitations of the allowed product claim. This means, in case the search result for the product claim is good, CHIPA permits a process claim which might have a broader scope than that allowed in the USPTO.

If the examiner does find some prior art reference against the novelty and inventiveness of the product claim, he/she, of course, would not continue to make a search for the process claim. The process claim can be examined only through filing an RCE, a divisional application, a continuation application, or a continuation-in-part application (CIP).

From this aspect, the applicant has more claims examined in a pending application in CNIPA than in the USPTO.

B. Success chance of arguing RR or UR and the Risk

If an applicant is reluctant to pursue the process claim through an RCE, a divisional application, a continuation application, or a CIP, which may render more cost, the applicant may choose to traverse the restriction requirement while making an election between the product claim and the process claim. But the applicant needs to prove the process is an obvious process of making the product and cannot be used to make another materially different product. As seen, the attempts to overcome a restriction would produce certain prosecution history estoppel here.

On the other hand, prosecution history estoppel is not a concern if an applicant traverses a unity requirement from CNIPA, because the applicant only needs to find one common or corresponding special technical features for the product claim and process claim. Based on this argumentation adopted by CNIPA, the patentablity of the process claim is independent of the product claim, because the process claim is not considered an obvious process of making the product. On the contrary, the process claim has its own features which may make contribution over prior art. The examiner will naturally make a search for the process claims' own features.

C. Limitation of amending to overcome a RR or UR

For a restriction requirement from the USPTO, an amendment will usually only succeed if the process claims completely "mirrors" product elements, i.e. recite "nominal" process elements. E.g., if the product claim comprises x and y, the process claim recites "providing X," "forming Y," etc. That is, when the examiner does find some prior art reference against the product claim, the process claims as amended would not require the examiner to perform another search for process elements that are not included in the product claims. But if the process claim recites "significant" process elements, meaning another

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search necessary, the examiner will likely still insist on restriction.

In contrast, had the applicant failed to identify any common or corresponding special technical feature between the pending product claim and process claim before CNIPA, amendments are necessary. The examiner will likely withdraw the requirement of unity.

D. Limitation of filing new application based on a RR or UR

If the applicant decides to file a divisional application having claims to non-elected inventions in response to an RR issued by the USPTO, consonance is required, i.e., the claimed inventions between the parent and the divisional patent application have not crossed the examiner's lines of demarcation of the inventions identified in the RR. Otherwise, so as in a divisional application, a nonstatutory double patenting would be encountered.

On the other hand, in CNIPA, there is only a divisional application type, and there is no laws or rules corresponding to USPTO's nonstatutory double patenting rejection, only a "same invention" type double patenting rejection, similar to USPTO statutory double patenting rejection. E.g. even the new product claim 1 in a divisional application is just an obvious variation of the old product claim 1 in the parent application for example by adding one substantial feature to make the two claim 1 have materially different scopes, the applicant can easily get issued for the new product claim 1.

In conclusion, compared with USPTO's RR, CNIPA's UR in fact requires the examiner to search and examine more claims and notify the search result to the applicant more quickly. No matter the applicant chooses to argue without any amendments and/or make amendment in reply to the unity requirement, the chance of success in CNIPA is higher and risk is lower. Finally, even if the applicant makes an election, and files a new application for the withdrawn claims according to the RR or UR requirement, different from USPTO, CNIPA doesn't issue a nonstatutory double patenting rejection to the applicant, allowing the applicant to easily possess multiple patents claiming obvious variations of one invention.

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