How Many Patents Do You Want? (Part 1)

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This article is the first of two articles dealing with Unity of Invention issues. This first article is directed to the topic of why the U.S. Patent Office sometimes requires filing of so-called "divisional" patent applications.

The Patent Office has a deceptively simple sounding rule: "One invention, one patent." No more, no less. Don't ask the Patent Office to cram three inventions into a single patent. Don't ask for three patents on a single invention. Sounds simple, right? The subtle trick, though, is how the Patent Office defines the word "invention."

Some concepts that would appear to be a single invention according to a common sense analysis end up being multiple inventions according to the Patent Office. This situation commonly arises when an inventor very industriously develops plural ways to physically manifest his or her invention. These plural physical manifestations may all have a unifying concept that underlies them. However, each of the separate physical manifestations might be viewed as being a separate invention in its own right.

Consider the example of a surgeon who invents an improved clamp for use in arthroscopic surgery. The novel part of the new clamp is in its jaws. In addition to inventing the novel jaw structure, the inventor goes to the trouble to develop three different, alternative mechanisms for actuating the jaws through the elongated shaft of the instrument. One uses rigid links hinged together, another uses a cable and spring, and the third is hydraulic. Despite the fact that all three versions include the novel clamp structure, and the surgeon/inventor regards the three actuator mechanisms as being mere details of the design, the Patent Office may well regard these as being three different "species" that are patentably distinct from one another.

This is an example of "election of species" practice. It gets this name because the Patent Office is forcing the patent applicant to elect one of plural patentably distinct species of a common (or "generic") invention.

The practical effect of such a holding is that the Patent Office may only examine claims directed to a single one of the three species. To obtain examination of the other two species, the inventor may need to file two divisional patent applications that divide out the subject matter (thus the term "divisional") of the original disclosure so that it is claimed in separate applications. The three applications (the original and its two divisionals) would be identical except for the details of how their claims are phrased.

Election of species practice does permit one useful loophole: If the Patent Examiner can be persuaded to allow a claim that is so broad that it encompasses all the species (this is called a "generic" claim), then all the claims to all the species will be allowed. If such a feat can be accomplished, it is an excellent way to avoid the need to file divisional applications.

Another situation where a unity of invention issue arises is when the invention encompasses more than one statutory class of invention. An

example would be when the invention is a metal hand tool (an article of manufacture), a method of manufacturing the new tool (a method), and a machine for mass producing the new tool (a machine). The Patent Office will almost certainly treat this as three distinct inventions despite the fact that the inventor conceived of all three aspects (article, method, and machine) in a single flash of inspiration.

This second example illustrates "restriction" practice. It gets this name because the Patent Office restricts a single application to claims that are directed to only one invention. Unlike election of species practice discussed above, there is no loophole in restriction practice. Receiving a restriction requirement from the Patent Office almost always creates a dilemma of either filing divisional applications or giving up on coverage for some aspects of the invention.

Such a treatment by the Patent Office (either election of species or restriction) can be perceived as either good news or bad news, depending upon one's perspective. For a company aiming to build a patent portfolio with all deliberate haste, being told that they have three inventions (each deserving of its own separate patent), not one invention (entitled to only a single patent, at most), is good news. The added fees to file for, issue, and maintain two additional patents might seem like a small price to pay for the added negotiation leverage and bragging rights they bring.

But what about the budget conscious patent applicant? Such a turn of events might mean that a cash-strapped individual inventor would have to spend his entire annual legal budget on extra, divisional patent applications just so that he can obtain coverage of all aspects of a single (in his eyes) invention.

Careful planning and preparation can increase or decrease (depending on which outcome one desires!) the chances of the Patent Office raising the issue of too many inventions in one application. If there are business reasons to minimize the number of patent applications a company is filing, then the patent applications can be drafted in such a way as to emphasize the aspects of the invention that tend to make it look like a unified concept. On the other hand, a company that emphasizes aggressive acquisition of patents would welcome a patent application that gives the Patent Office reason to require division of application claims between multiple patent applications. One way to promote this outcome is to characterize an invention as being a family of related inventions having some similar aspects.

Keep in mind, though, that restriction requirements and election of species requirements are optional procedures from the point of view of the Patent Examiner. Even if the Examiner is entirely within his or her rights to require divisional applications, there is no rule compelling the Examiner to do so. Therefore, if the desired outcome is to obtain the maximum number of patents, then the most direct way to accomplish that is to simply file plural patent applications to start with.

However, this option is a trade-off because it raises a few complex potential issues. I will address those in a second article in a future issue of this newsletter.

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