

Design Patent ProGuide – Restrictions  
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Quick Reference Guide

DO:

Assume restriction is the default whenever more than one potentially distinct design is disclosed.

Analyze restriction solely under patentable distinctness, not examiner burden.

Compare designs as complete visual impressions, not by element-by-element analysis.

Clearly identify and label embodiments in the specification and drawings.

Expect restriction between combination and subcombination designs unless overall appearances are indistinguishable.

Be prepared to elect and cancel figures, not merely elect by argument.

Traverse only with evidence or concrete explanation of why designs are obvious variations.

Remember that if designs are held patentably indistinct, all rejections apply to all embodiments.

Correct § 112(a)/(b) issues first if the design scope is unclear, as restriction may be held in abeyance.

Assume the examiner may redefine or collapse embodiments if applicant definitions are unclear.

Treat examiner-defined restriction groups as controlling unless and until successfully traversed; election does not preserve applicant-defined embodiment framing.

Assume restriction may be made before any prior art rejection and may defer action on the merits entirely.

Use explicit non-admission language when electing without traverse to avoid implied agreement with examiner characterization.

Include a provisional election under 37 C.F.R. § 1.143 even when traversing a restriction requirement.

Anticipate restriction even when embodiments differ only by scope if the scope difference changes the overall visual impression.

Expect restriction to apply even when differences are obvious over the prior art if overall appearances are not basically the same.

Recognize that restriction analysis may require prior art comparison even though it is not a §103 rejection.

Assume that common embodiments included in multiple restriction groups carry downstream double-patenting consequences.

Consider filing divisional applications promptly for valuable nonelected designs withdrawn under 37 C.F.R. § 1.142(b).

Mirror the examiner's own standard in a traversal. When arguing no restriction (or improper grouping), expressly track the governing language: the embodiments "have overall appearances with basically the same design characteristics," and any differences are "minor/patentably indistinct or obvious variations," so they comprise a single inventive concept.

Check for a "common embodiment." If a feature set (or a complete portion) is identical across groups (e.g., "cup" alone vs. "cup and saucer"), evaluate whether the common design is patentably indistinct from one group and included to give the applicant broadest election options; confirm whether the examiner has applied the "common embodiment" concept and consider the downstream double-patenting implications for continuing practice.

Confirm which restriction form paragraph the examiner used (e.g., ¶ 15.27 for appearance-based restriction, ¶ 15.29 for combination/subcombination, ¶ 15.27.08 for mixed appearance-and-scope restriction) and verify that the form paragraph matches the examiner's stated legal theory. Use of the wrong form paragraph, for example, applying a pure appearance-based paragraph to a combination/subcombination situation, may signal an error in the examiner's restriction analysis that is worth identifying and traversing. Mismatched form paragraphs occasionally reveal that the examiner has not clearly articulated the basis for restriction, which can support a substantive traversal.

## DON'T

Don't rely on "serious burden" arguments, which are irrelevant in design restriction practice.

Don't assume an admission of indistinctness will defeat restriction without satisfying both MPEP prongs.

Don't treat different scopes as automatically indistinct; scope differences can create patentable distinctness.

Don't leave embodiments ambiguously described and expect applicant control over grouping.

Don't expect election alone to suffice; mandatory cancellation and renumbering are often required.

Don't argue minor feature differences in isolation instead of overall appearance.

Don't traverse restriction without substantiation; bare traversal is treated as election without traverse.

Don't assume prior art is irrelevant; it may be necessary to assess obviousness of differences.

Don't rely on the ability to later "fix" embodiment distinctions through amendment after restriction has been imposed.

Don't assume that obviousness of differences alone defeats restriction when overall appearances differ.

Don't assume that partial-view embodiments automatically share a single inventive concept with full-article embodiments when the difference in scope alters the overall visual impression of the design.

Don't treat examiner grouping of multiple embodiments into a single elected group as harmless; it may limit later continuation strategy.

Don't assume traversal preserves withdrawn groups for later prosecution without affirmative divisional filing.

Don't assume restriction determinations are insulated from later finality; they can be made final and enforced through cancellation.

Don't assume restriction will automatically be deferred due to § 112 issues; deferral is discretionary and case-specific.

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## 1. Introduction and Theory

Design patent restriction practice is governed by principles that differ fundamentally from utility patent restriction practice. A design patent application is limited to a single claim, and that claim may encompass multiple embodiments only when the embodiments reflect a single inventive concept. As a result, restriction analysis

in design applications is inseparably tied to the requirement that patentable distinct designs cannot be examined under a single claim.

Practitioners frequently confuse (i) a §103 obviousness rejection with (ii) the “obviousness” concept used in design restriction / single-inventive-concept analysis. In a restriction requirement, the examiner is not making a traditional §103 rejection between embodiments. Instead, the question is whether multiple embodiments constitute a single inventive concept because they are patentably indistinct, i.e., merely obvious variations of one another under the standard applied in design practice for retaining multiple embodiments in one application (commonly framed in terms of nonstatutory double patenting / obviousness-type variation concepts).

Although MPEP guidance uses §103-style wording (e.g., “obvious to a designer of ordinary skill”), that language operates here as a patentable-indistinctness screen (are the embodiments just obvious variations of the same design concept?), not as a stand-alone prior-art rejection analysis. An examiner may cite analogous prior art to explain why differences are merely obvious variations, but the restriction inquiry remains two-step: whether overall appearances are basically the same, and (if so) whether differences are minor/patentably indistinct or obvious variations.

Restriction is required whenever a design application discloses more than one patentably distinct design. Patentable distinctness is determined by comparing the overall visual appearances of the designs as complete entities, rather than by evaluating individual features or elements in isolation. Differences that affect the overall appearance of a design may render designs patentably distinct even when the differences appear minor at a component level.

Unlike utility patent practice, examiner search or examination burden plays no role in design restriction analysis. The inquiry does not turn on whether the designs could be examined efficiently together, but instead on whether the designs are sufficiently similar in overall appearance to constitute a single inventive concept under nonstatutory double patenting principles.

When differences between designs are not facially *de minimis*, consideration of the prior art may be necessary to determine whether those differences would have been obvious to a designer of ordinary skill in the art. Even if differences are shown to be obvious, restriction remains proper when the overall appearances of the designs are not basically the same.

Designs that differ in scope, such as a combination design and a subcombination or component design, may also be patentably distinct when the difference in scope alters the overall visual impression. Because a design claim protects only the design as a whole and does not extend to individual parts, patentably distinct scopes cannot be supported by a single claim and must be restricted.

Clear identification and description of embodiments is critical in design restriction practice. When embodiments are ambiguously described or inadequately delineated, the examiner may define, regroup, or collapse embodiments for restriction purposes. Failure

to control embodiment definition at the outset can result in loss of applicant control over the framing and outcome of restriction.

Where the scope or appearance of the claimed design is unclear due to deficiencies under 35 U.S.C. § 112(a) or § 112(b), restriction may be deferred until those issues are resolved. Once the design scope is clarified, restriction analysis proceeds based on the clarified disclosure.

## 2. Recommended Form

[Reserved]

## 3. Rules and Guidance for Restrictions

### 3.1 Single-Claim Requirement in Design Applications

A design patent application may contain only one claim. Unlike utility applications, plural claims directed to plural inventions are not permitted. 37 C.F.R. § 1.153(a); MPEP § 1504.05

### 3.2 Multiple Embodiments Permitted Only If a Single Inventive Concept Is Present

Multiple embodiments may be disclosed in a single design application only if they involve a single inventive concept, determined under nonstatutory double patenting standards. *In re Rubinfeld*, 270 F.2d 391 (CCPA 1959); MPEP § 1504.05

### 3.3 Restriction Is Required for Patentably Distinct Designs

Restriction is required under 35 U.S.C. § 121 when a design application discloses more than one patentably distinct design. 35 U.S.C. § 121; MPEP § 1504.05. As a practical matter, meaningful restriction analysis generally presupposes a definite and enabled disclosure, and examiners will typically require § 112(a) and § 112(b) issues to be resolved before imposing restriction to ensure proper embodiment identification and grouping.

### 3.4 “Serious Burden” Is Not the Basis for Design Restriction

Unlike utility applications, serious search or examination burden does not establish the basis for restriction in design applications under MPEP § 803. Restriction in design applications is mandatory when designs are patentably distinct and cannot be supported by a single design claim. MPEP §§ 803, 1504.05.

Note: Why “serious burden” does not drive design restriction. Unlike utility applications, where restriction is often justified by search/examination burden, design restriction turns primarily on the single-claim constraint: patentably distinct designs cannot be supported by a single formal design claim. Accordingly, when patentably

distinct designs are present, restriction is required regardless of whether the examiner could search the embodiments efficiently.

### 3.5 Admissions of Indistinctness Do Not Control

An applicant's admission that embodiments are not patentably distinct does not overcome a restriction requirement unless both of the following are satisfied:

1. The embodiments have basically the same overall appearance, and
2. The differences are insufficient to patentably distinguish one design from another. MPEP § 1504.05; Ex parte Appeal No. 315-40, 152 USPQ 71 (Bd. App. 1965)

### 3.6 Patentable Distinctness Requires a Whole-Design Comparison

Patentable distinctness in design restriction is determined by comparing the overall appearances of the designs as a whole, not by analyzing individual elements. MPEP § 1504.05

### 3.7 Two-Part Test for Patentable Indistinctness

Designs are not patentably distinct only if both of the following are true:

1. The overall appearances have basically the same design characteristics, and
2. The differences are either (a) de minimis, or (b) would have been obvious to a designer of ordinary skill in the art. MPEP § 1504.05

Important clarification on “obviousness” in the restriction context. Although this analysis uses §103-type language (e.g., “obvious to a designer of ordinary skill”), the question in a restriction requirement is not whether a particular embodiment is unpatentable under §103 in the ordinary prior-art rejection sense. Rather, the inquiry is whether the embodiments constitute a single inventive concept because they are patentably indistinct / obvious variations of one another—i.e., the same core concept reflected in the nonstatutory double patenting (obviousness-type variation) standard used to determine whether multiple embodiments can be retained in one design application. Accordingly, an examiner may cite analogous prior art to show that differences are merely obvious variations, but the analysis remains anchored in whether the embodiments are patentably indistinct as designs, not in issuing a standalone §103 rejection between embodiments.

### 3.8 Prior Art May Be Required to Assess Distinctness

In determining whether differences between designs are obvious or de minimis, a search of the prior art may be necessary. MPEP § 1504.05

### 3.9 Independent Designs Are Always Restrictable

Designs are independent inventions when there is no apparent relationship between the articles disclosed, and restriction is clearly proper in such cases. MPEP §§ 806.06, 1504.05

### 3.10 Subcombination Designs Are Often Patentably Distinct

When an application discloses both:

- a combination design, and
- a subcombination or component design,

restriction is often required because the subcombination typically has a distinct overall appearance. MPEP § 1504.05; *Ex parte Sanford*; *Blumcraft v. Ladd*

The MPEP describes the combination/subcombination scenario as a “segregable parts” problem: a single design claim cannot cover patentably distinct segregable parts of a design. If the “part-only” design has a distinct overall appearance from the “whole-article” design (or is not merely a minor/obvious scope variation), restriction is proper because the only way to protect patentably distinct segregable parts is via separate claims in separate applications.

Practice Note: Distinguish “partial claiming” from “different embodiments.” A partial-claiming disclosure (e.g., a portion of the article shown/claimed, often via broken lines to define scope) concerns how much of the article is claimed. By contrast, multiple embodiments are different versions/configurations of the article (e.g., different shapes/ornamentation) that may or may not be patentably indistinct. In scope-based restriction issues, focus first on whether the “part-only” versus “whole-article” presentations create patentably distinct overall appearances (segregable parts). In embodiment-based restriction issues, focus on whether the embodiments share basically the same design characteristics and differ only in minor/obvious ways.

### 3.11 Different Scope Alone Can Create Patentable Distinctness

Embodiments claiming different scopes of a design may be patentably distinct if the scope difference affects the overall appearance. MPEP § 1504.05; *In re Rubinfield*

### 3.12 If Designs Are Patentably Indistinct, All Rejections Apply to All Embodiments

If multiple embodiments are retained as patentably indistinct, any rejection of one applies equally to all. *Ex parte Appeal* No. 315-40; MPEP § 1504.05. Once multiple embodiments are determined to comprise a single inventive concept, no argument asserting patentability based on differences between those embodiments will be considered.

### 3.13 Restriction May Be Deferred or Held in Abeyance When §112 Issues Prevent Proper Grouping

When the scope or appearance of the claimed design is indefinite or non-enabled, the examiner may decline to issue a restriction requirement and instead hold restriction in abeyance until the §112(a)/(b) issues are resolved. App. 29/800,498 (restriction expressly deferred due to indefiniteness)

Note: Deferral of restriction is discretionary. When the scope or appearance of the claimed design is indefinite or non-enabled, the examiner has discretion to decline to issue a restriction requirement and instead hold restriction in abeyance until the §112(a) and/or §112(b) issues are resolved. However, examiners are not required to defer restriction and may impose restriction even when §112 issues exist, particularly where the examiner can still determine proper grouping (or where restriction is necessary to establish a clear prosecution posture).

### 3.14 Failure to Clearly Identify Embodiments Allows Examiner to Define Them for Restriction Purposes

If the applicant does not clearly identify and delineate embodiments in the specification and drawings, the examiner may independently reconstruct and define embodiments and impose restriction based on the examiner's characterization. App. 29/800,498 (examiner rejected applicant's embodiment structure and substituted their own)

### 3.15 Examiner May Collapse Applicant-Identified Embodiments Before Applying Restriction

An examiner may treat multiple applicant-identified embodiments as a single embodiment when the examiner determines the differences do not affect overall appearance, and then restrict against another embodiment. App. 29/912,970 (examiner intentionally grouped figures despite applicant's contrary position)

### 3.16 Restriction Is Enforced Through Election and Requested Cancellation of Nonelected Figures

Compliance with a restriction requirement requires election of a single group under 37 C.F.R. § 1.143. Examiners typically request cancellation of nonelected figures and corresponding descriptions, along with renumbering of remaining figures, to conform the application to the elected design. Apps. 29/912,970; 29/942,698.

### 3.17 Examiner May Define Multiple Restriction Groups That Combine Multiple Embodiments Into a Single Group

An examiner may define restriction groups that aggregate multiple embodiments together into a single elected group, rather than requiring election of a single embodiment, when the examiner determines that the grouped embodiments share a sufficiently similar overall appearance. App. 29/936,969 (Examiner grouped Embodiments 1-4 into Group I, distinct from Embodiment 5)

### 3.18 Rejoinder of Nonelected Designs

When a restriction requirement has been imposed and an elected design is found allowable, nonelected designs that are patentably indistinct from the elected design may be rejoined for examination. Rejoinder is discretionary and applies only where the nonelected subject matter requires no separate search or examination. MPEP § 821.04.

Note: While Examiners often initiate rejoinder on their own when a design is found allowable, rejoinder is not guaranteed. Applicants should proactively monitor nonelected embodiments. If an elected design is allowed and the applicant believes nonelected subject matter is patentably indistinct, it is highly recommended to affirmatively request rejoinder in the response. This ensures the Examiner addresses the issue and may avoid the need for a costly divisional application.

### 3.19 Provisional Election Is Required Even When Traversing a Restriction Requirement

A response to a restriction requirement must include a provisional election of a single group for examination on the merits, even when the restriction requirement is traversed. Failure to include a provisional election renders the response nonresponsive. 37 C.F.R. § 1.143; MPEP §§ 818, 821.01.

For example, if applicant responds only, “Applicant traverses the restriction requirement because the embodiments are obvious variations,” but does not make a provisional election of a single group, the reply will be held nonresponsive under 37 CFR 1.143. If not corrected within the applicable period (including any shortened statutory period), the application may go abandoned.

### 3.20 Nonelected Designs Are Withdrawn from Consideration and Must Be Pursued Separately

Upon election of a design group, nonelected designs are withdrawn from further examination under 37 C.F.R. § 1.142(b). Protection for nonelected designs may be obtained only through a divisional application. Failure to timely pursue divisional protection may result in loss of rights.

### 3.21 Inclusion of a Common Embodiment in Multiple Restriction Groups Creates Double-Patenting Risk

When a common embodiment is included in more than one restriction group to preserve applicant election options, that embodiment should not be pursued in multiple continuing applications. Inclusion of a common embodiment in both the elected application and a continuing application may give rise to double-patenting rejections. MPEP § 821.04; Form Paragraph 15.33.

Practice Note: Common Embodiments in Multiple Groups. Examiners may include a common embodiment in more than one restriction group to give the applicant the broadest possible election choices, for example, a “cup” embodiment may appear in

both Group I: Cup and Group II: Cup and Saucer if the “cup” portion is patentably indistinct from subject matter in both groups.

Practice Risk: This flexibility creates downstream hazards. Practitioners must (i) carefully track what was actually elected and examined in the parent; (ii) avoid pursuing the same common embodiment in both the parent and any divisional/continuation; and (iii) plan continuing filings to avoid unnecessary double patenting / ODP complications. As a best practice, if a common embodiment is elected in the parent, do not carry the same common embodiment forward in a continuing application unless you have a deliberate and defensible strategy to address double-patenting risk.

Note: 35 U.S.C. § 121 safe harbor warning (ODP immunity is not automatic). The protection against obviousness-type double patenting provided by 35 U.S.C. § 121 generally applies only where the later application is a true divisional filed as a result of a USPTO restriction requirement. If an applicant voluntarily “splits” subject matter without a formal restriction requirement (or files a continuing application that is not properly tethered to the restriction), the applicant may lose § 121’s safe-harbor protection and face ODP complications. Accordingly, when restriction is issued, preserve the record and structure continuing filings to maintain § 121 alignment where possible.

### 3.22 Divisional Filing Strategy Is an Integral Part of Restriction Compliance

Because restriction withdrawal under 37 C.F.R. § 1.142(b) removes nonelected designs from examination, practitioners must evaluate divisional filing strategy at the time of election. Delay in filing divisional applications may foreclose protection for commercially valuable designs.

## 4. Application of Rules and Guidance to Objections and Rejections

The following examples illustrate common restriction-related objections and procedural pitfalls that arise during U.S. design patent prosecution. These examples show how restriction practice often extends beyond election itself and can require coordinated amendments to the drawings, figure descriptions, and specification to conform the application to the elected design group.

### 4.1 Figure Renumbering Required After Election and Cancellation of Nonelected Figures

In Application 29/942,698, the examiner required restriction compliance not only through election, but also through mandatory cancellation of all nonelected figures and corresponding descriptions. After the applicant canceled the nonelected figures, the examiner further required that the remaining figures be renumbered sequentially starting with FIG. 1, because leaving gaps in figure numbering (e.g., FIGS. 1, 2, 5, and 6) creates an improper and nonconforming drawing set. The applicant corrected the defect by renumbering the remaining figures consecutively and conforming all related figure descriptions and specification references to match the revised figure numbering. This example reflects a common examiner position that figure renumbering is an expected

mechanical requirement after restriction compliance and should be treated as part of the election response rather than deferred to a later amendment. Rule 3.16.

#### 4.2 Restriction Held in Abeyance Where Indefiniteness Prevented Proper Embodiment Grouping

In Application 29/800,498, the examiner initially declined to proceed with restriction grouping because the scope of the claimed design was indefinite and the disclosure was not enabling, making it impossible to determine whether the drawings reflected multiple patentably distinct embodiments or merely unclear variations of a single design. Instead of issuing an enforceable restriction requirement, the examiner held restriction in abeyance and required the applicant to correct the §112(a)/(b) defects first. Only after the design disclosure became clear did restriction become procedurally appropriate. This example illustrates that restriction may be deferred where the examiner cannot reliably identify the design groupings due to ambiguity in the drawings or specification, and that resolving indefiniteness may be a prerequisite to meaningful restriction practice. Rule 3.13.

#### 4.3 Examiner Redefined Embodiments Where Applicant Failed to Clearly Delineate Them

In Application 29/800,498, the applicant's drawings and specification failed to clearly identify what constituted separate embodiments, resulting in ambiguity regarding whether the figures represented a single design concept or multiple distinct embodiments. The examiner rejected the applicant's implied embodiment structure and instead independently defined and reconstructed the embodiments for restriction purposes, imposing restriction based on the examiner's own grouping framework. The applicant regained control of the restriction posture only after amending the drawings and specification to clearly identify the intended embodiments and align the figure descriptions with the embodiment structure. This example illustrates the practical risk that failure to clearly delineate embodiments permits the examiner to define them unilaterally, often in a manner unfavorable to applicant strategy. Rule 3.14.

#### 4.4 Examiner Collapsed Applicant-Identified Embodiments Before Imposing Restriction

In Application 29/912,970, the applicant presented multiple embodiments as distinct and separately identifiable designs. The examiner determined that the differences between those embodiments did not materially affect the overall appearance and therefore treated them as a single embodiment for examination purposes. The examiner then imposed restriction against a second embodiment, effectively collapsing multiple applicant-identified embodiments into a single grouped embodiment before requiring election. In response, the applicant elected a group while traversing and then amended the drawings and descriptions to conform strictly to the elected embodiment as interpreted by the examiner. This example illustrates that even where applicants attempt to preserve multiple embodiments in a single application, examiners may collapse them into a single embodiment if they consider the differences to be patentably indistinct, and then restrict against a second design. Rule 3.15.

#### 4.5 Restriction Compliance Required Coordinated Cancellation and Conforming Amendments

In Application 29/942,698, the examiner enforced restriction compliance through a multi-step process requiring election, cancellation of all nonelected drawing figures, and full conformance of the written specification to the remaining elected embodiment. The examiner specifically required the applicant to cancel nonelected figures and their corresponding descriptions, renumber the remaining figures sequentially, and revise all figure descriptions and specification references to ensure that the written disclosure corresponded exactly to the remaining drawing set. The applicant complied by canceling the nonelected figures, renumbering the retained figures starting at FIG. 1, and amending the figure descriptions to eliminate any reference to withdrawn embodiments. This example illustrates that restriction compliance is not limited to election alone and frequently requires full structural conformance of the drawing set and specification. Rule 3.16.

#### 4.6 Examiner Grouped Multiple Embodiments Into a Single Restriction Group

In Application 29/936,969, the examiner identified five separate embodiments and then grouped them into two restriction groups rather than requiring election of a single embodiment. The examiner structured the restriction as Group I consisting of Embodiments 1–4 (FIGS. 1–28) and Group II consisting of Embodiment 5 (FIGS. 29–35). The applicant elected Group I without traverse but expressly clarified that the lack of traverse should not be interpreted as agreement with the examiner’s characterization of the inventions or grouping structure. This example illustrates a common examiner practice of aggregating multiple related embodiments into a single restriction group, allowing election of a broader set of figures, while still restricting against a visually distinct embodiment requiring separate examination. Rule 3.17.

### 5. Practice and Enforcement Notes

#### 5.1 International (Hague) practice note.

Restriction/unity concepts can surface differently for international design filings (Hague), including how “unity of design” is assessed and how multiple designs are handled procedurally. For U.S. prosecution of U.S.-designated Hague applications, practitioners should confirm whether the Office’s unity/restriction posture tracks standard domestic restriction analysis or whether additional unity-of-design considerations are invoked in the particular procedural posture of the case.

#### 5.2 Petition Practice Under 37 CFR 1.144 (Overview)

A petition under 37 CFR 1.144 is the formal procedural vehicle to seek administrative review of an examiner’s restriction requirement. Because restriction is a "petitionable" matter rather than an "appealable" one, the Patent Trial and Appeal Board (PTAB) lacks jurisdiction to review it. To preserve petition rights, a practitioner must navigate a specific three-step sequence:

1. Provisional Election: Elect an invention with a timely response.
2. Substantive Traversal: Identify specific errors in the examiner's analysis (e.g., failure to show "distinctness").
3. Renewal of Traversal: If the examiner maintains the restriction in a subsequent action, the applicant must affirmatively renew the traversal in the next reply. Failure to renew the traversal in the response to the Office Action that makes the restriction final constitutes a waiver of the right to petition (MPEP § 818.01(c)).

## Appendix 1 Checklist

Before responding to a restriction requirement:

### I. UNDERSTANDING THE RESTRICTION

- Is restriction based on appearance, scope, or both, and are those grounds clearly stated?
- Did the examiner collapse or redefine embodiments?
- Have all embodiments been explicitly identified and described in your application?
- Are any embodiments common to multiple groups?
- Does the restriction include a common embodiment appearing in more than one group?
- Are § 112(a)/(b) issues preventing meaningful grouping?
- Has the examiner expressly deferred action on the merits pending compliance with restriction?

### II. ELECTION REQUIREMENTS & STRATEGY

- Is election required even if traversing?
- Has the examiner required provisional election under 37 C.F.R. § 1.143, even where traversal is asserted?
- Election without traverse (if strategic): If electing without traverse for strategy, have I included a clear statement that the election is made for purposes of prosecution efficiency and is not an admission that the restriction requirement is proper?
- Have you preserved non-admission language when electing without traverse?
- Will election affect continuation or divisional strategy?

### III. TRAVERSAL CONSIDERATIONS

- Traversal substance: Does my traversal include specific reasoning and/or record-based support, not merely a conclusory statement that the groups are "not patentably distinct"?
- Have any groups been withdrawn under 37 C.F.R. § 1.142(b) rather than substantively rejected?
- Rejoinder feasibility: If seeking rejoinder, does the nonelected subject matter require a separate search or separate classification/field of search (i.e., is rejoinder realistically discretionary)?

### IV. COMMON EMBODIMENT & DOUBLE-PATENTING RISKS

Common embodiment check: Does a common embodiment appear in multiple groups, and have I evaluated the downstream continuing-filing / ODP consequences of electing it?

Will election of a group foreclose inclusion of a common embodiment in a continuation due to double-patenting risk?

## V. FORMAL COMPLIANCE & AMENDMENTS

Does the restriction require mandatory figure cancellation?

Does the restriction require renumbering figures starting at FIG. 1 after cancellation?

Conforming amendments: After cancelling nonelected figures, have I conformed the figure numbering, figure descriptions, and any descriptive statements so the specification matches the elected embodiment(s) (and removed/corrected text tied to cancelled embodiments)?

Cross-reference audit: After cancelling nonelected figures, have I reviewed the full specification text, including the brief description of the drawings, any descriptive statement, and the claim, to confirm that all references to cancelled embodiment figures, embodiment numbers, and embodiment-specific descriptions have been removed or corrected? Residual cross-references to cancelled figures are a common source of follow-up objections and can delay allowance even after substantive compliance is complete.

Appendix 2  
Questions and Answers

Q1. Can serious examination burden justify restriction in a design application?

A: No. Examiner burden is irrelevant in design restriction practice.

Q2. Can multiple embodiments ever remain in one design application?

A: Yes, but only if they share a single inventive concept and are patentably indistinct.

Q3. Does admitting embodiments are indistinct defeat restriction?

A: Not unless both the “same overall appearance” and “no patentable difference” prongs are satisfied.

Q4. Can the examiner redefine my embodiments?

A: Yes, if applicant definitions are unclear or inconsistent.

Q5. Is election without traverse risky?

A: Election without traverse is not inherently "risky"; it is often strategic. Practitioners frequently elect without traverse to expedite prosecution when they intend to file divisionals or when the restriction outcome is acceptable as a portfolio strategy. However, election without traverse has three practical consequences worth weighing deliberately. First, it generally forfeits the leverage to later challenge the propriety of the restriction through petition practice under 37 C.F.R. § 1.144. Second, it may limit arguments that the restriction was improper in downstream proceedings. Third, and less obviously, if the restriction requirement was actually improper, electing without traverse may forfeit the §121 safe harbor, meaning that a divisional filed as a result of an improper restriction may not receive obviousness-type double patenting immunity, because §121 protection applies only where a restriction was lawfully required. For routine restrictions where the groupings are commercially acceptable, election without traverse is efficient. Where the restriction is substantively questionable or the §121 safe harbor matters to long-term portfolio strategy, traversal should be seriously considered.

Q6. If designs are held indistinct, what happens to rejections?

A: Any rejection of one applies equally to all retained embodiments.

Q7. Can restriction be made final in a design application?

A: Yes. If traversal does not overcome the requirement, restriction may be repeated and made final, and compliance enforced through cancellation.

Q8. Can restriction be imposed before any §102 or §103 rejection?

A: Yes. Action on the merits may be deferred entirely pending compliance with restriction.

Q9. Does obviousness of differences eliminate restriction?

A: No. Even obvious differences require restriction if the overall appearances are not basically the same.

Q10. Can a single embodiment appear in more than one restriction group?

A: Yes. A common embodiment may be included in multiple groups to preserve election options, but it raises double-patenting concerns in continuations.

Q11. Does traversal preserve nonelected groups automatically?

A: No. Nonelected groups are withdrawn from consideration and must be pursued in a divisional application.

Q12. Can examiner-defined embodiment groupings override applicant-defined embodiments?

A: Yes. Where applicant definitions are unclear or unpersuasive, the examiner may redefine or collapse embodiments for restriction purposes.

Q13. What should an applicant do if the examiner incorrectly groups or defines embodiments?

A: The applicant should timely traverse the restriction requirement and explain why the examiner's grouping is incorrect, supported by a clear explanation of overall appearance or scope. Failure to do so may result in acceptance of the examiner's characterization.

Q14. Can I file a divisional application for nonelected subject matter even if I elected without traverse?

A: Yes. Election without traverse does not forfeit the right to file a divisional application directed to withdrawn/nonelected subject matter. However, electing without traverse may limit later efforts to challenge the propriety of the restriction (including petition posture), so the decision should be made deliberately.

Q15. Must I cancel the nonelected figures and descriptions?

A: Examiners commonly request cancellation of nonelected figures and their corresponding descriptions, along with renumbering of remaining figures. While not mechanically automatic in every case, failure to comply typically leads to objections and delay, and in some situations, continued noncompliance after final

restriction posture can prevent the case from reaching allowance. As a best practice, proactively cancel nonelected figures/descriptions and conform the remaining drawings and text.

## Appendix 3 Limitations

Restriction practice in design patent applications is inherently fact-dependent and highly sensitive to the specific drawings and disclosures presented in a given application. Minor changes in contour, proportion, scope, or claimed portion can materially affect whether designs are considered to have basically the same overall appearance. As a result, outcomes in restriction practice cannot be predicted with certainty based solely on categorical rules, and practitioners must evaluate each case on its own visual record.

The principles summarized in this ProGuide reflect governing statutes, regulations, MPEP guidance, and consistent examiner practice, but they do not eliminate examiner discretion in defining embodiments, grouping designs, or determining patentable distinctness. Examiners retain broad authority to characterize the disclosure for restriction purposes, particularly where the applicant's specification or drawings fail to clearly delineate embodiments or differences between them.

Restriction determinations are based on overall appearance rather than individual features, which limits the effectiveness of arguments focused on isolated design elements. Even when differences between designs appear minor at a component level, restriction may still be required if those differences alter the overall visual impression of the design as a whole. Conversely, designs that differ in scope or article may still be retained together only when their overall appearances are basically the same and the scope differences are truly insignificant.

This ProGuide does not supplant the need for careful consideration of prior art in restriction analysis. In some cases, prior art is necessary to determine whether differences between designs would have been obvious to a designer of ordinary skill in the art. However, even a showing of obviousness does not preclude restriction when the overall appearances of the designs are not basically the same.

The guidance provided here does not account for strategic considerations unique to a particular prosecution, such as continuation planning, divisional strategy, terminal disclaimer risks, or future enforcement goals. Decisions regarding whether to traverse, elect without traverse, or pursue divisional protection require judgment beyond the scope of generalized restriction principles.

Finally, this ProGuide reflects prevailing USPTO practice as evidenced by prosecution histories and official guidance, but examiner application of restriction principles may vary across art units and individual examiners. Practitioners should treat these rules and examples as a framework for analysis rather than a guarantee of outcome, and should be prepared to adapt strategy based on examiner behavior and case-specific facts.

Appendix 4  
Selected MPEP, CFR, Statutory, and Case Law References

1504.05 Restriction [R-01.2024]

General principles of utility restriction are set forth in Chapter 800 of the MPEP. These principles are also applicable to design restriction practice with the exception of those differences set forth in this section.

Unlike a utility patent application, which can contain plural claims directed to plural inventions, a design patent application may only have a single claim. *See* 37 CFR 1.153(a). More than one embodiment of a design may be protected by a single claim. However, such embodiments may be presented only if they involve a single inventive concept according to the nonstatutory double patenting practice for designs. *See In re Rubinfeld*, 270 F.2d 391, 123 USPQ 210 (CCPA 1959). Therefore, the examiner will require restriction in each design application which contains more than one patentably distinct design. Additionally, while applicant, as a matter of right, may not shift from claiming one invention to claiming another, the examiner is not precluded from permitting a shift. *See* MPEP § 819. However, an examiner in a design patent application must ensure that the new invention is limited to a single inventive concept.

Restriction will be required under 35 U.S.C. 121 if a design patent application claims multiple designs that are patentably distinct from each other. The issue of whether a search and examination of an entire application can be made without serious burden to an examiner (as noted in MPEP § 803) is not applicable to design applications when determining whether a restriction requirement should be made. Clear admission on the record by the applicant that the embodiments are not patentably distinct will not overcome a requirement for restriction if the embodiments do not meet the following two requirements: (A) the embodiments have overall appearances with basically the same design characteristics; and (B) the differences between the embodiments are insufficient to patentably distinguish one design from the other. Regarding the second requirement, without evidence, such an admission is merely a conclusory statement. If multiple designs are held to be patentably indistinct and can be covered by a single claim, any rejection of one over prior art will apply equally to all. *See Ex parte Appeal No. 315-40*, 152 USPQ 71(Bd. App. 1965).

I. INDEPENDENT INVENTIONS

Design inventions are independent if there is no apparent relationship between two or more disparate articles disclosed in the drawings; for example, a pair of eyeglasses and a door handle; a bicycle and a camera; an automobile and a bathtub. Also note examples in MPEP § 806.06. Restriction in such cases is clearly proper. This situation may be rarely presented since design patent applications are seldom filed containing disclosures of independent articles.

II. DISTINCT INVENTIONS

In determining patentable distinctness, the examiner must compare the overall appearances of the multiple designs. Each design must be considered as a whole, i.e., the elements of the design are not considered individually as they may be when establishing a prima facie case of obviousness under 35 U.S.C. § 103. Designs are not distinct inventions if: (A) the multiple designs have overall appearances with basically the same design characteristics; and (B) the differences between the multiple designs are insufficient to patentably distinguish one design from the other. Differences may be considered insufficient to patentably distinguish when they are *de minimis* or obvious to a designer of ordinary skill in the art. Therefore, in determining the question of patentable distinctness under 35 U.S.C. § 121 in a design application, a search of the prior art may be necessary. Both of the above considerations are important. Differences between the designs may prove to be obvious in view of the prior art, but if the overall appearances are not basically the same, the designs remain patentably distinct.

Embodiments claiming different scopes of the same design can be patentably distinct using the two-step analysis above. When an application illustrates a component, which is a subcombination of another embodiment, the subcombination often has a distinct overall appearance and a restriction should be required. When an application illustrates only a portion of the design, which is the subject of another embodiment, that portion often has a distinct overall appearance and a restriction should be required.

#### A. Multiple Embodiments – Difference in Appearance

It is permissible to illustrate more than one embodiment of a design invention in a single application. However, such embodiments may be presented only if they involve a single inventive concept. Two designs involve a single inventive concept when the two designs are patentably indistinct according to the standard of nonstatutory double patenting. See *In re Rubinfeld*, 270 F.2d 391, 123 USPQ 210 (CCPA 1959).

Embodiments that are patentably distinct over one another do not constitute a single inventive concept and thus may not be included in the same design application. See *In re Platner*, 155 USPQ 222 (Comm'r Pat. 1967). The disclosure of plural embodiments does not require or justify more than a single claim, which claim must be in the formal terms stated in MPEP § 1503.01, subsection III. The specification should make clear that multiple embodiments are disclosed and should particularize the differences between the embodiments. If the disclosure of any embodiment relies on the disclosure of another embodiment for completeness to satisfy the requirements of 35 U.S.C. § 112(a) (or for applications filed prior to September 16, 2012, 35 U.S.C. § 112, first paragraph), the differences between the embodiments must be identified either in the figure descriptions or by way of a descriptive statement in the specification of the application as filed.

For example, the second embodiment of a cabinet discloses a single view showing only the difference in the front door of the cabinet of the first embodiment; the figure description should state that this view “is a second embodiment of Figure 1, the only difference being the configuration of the door, it being understood that all other surfaces are the same as those of the first embodiment.” This type of statement in the description is understood to incorporate the disclosure of the first embodiment to complete the disclosure of the second embodiment. However, in the absence of such a statement in the

specification of an application as filed, the disclosure of one embodiment will normally not be permitted to provide antecedent basis for any written or visual amendment to the disclosure of other embodiments.

The obviousness standard under 35 U.S.C. § 103 must be applied in determining whether multiple embodiments may be retained in a single application. See MPEP § 1504.03. That is, it must first be determined whether the embodiments have overall appearances that are basically the same as each other. If the appearances of the embodiments are considered to be basically the same, then it must be determined whether the differences are either minor between the embodiments and not a patentable distinction, or obvious to a designer of ordinary skill in view of the analogous prior art. If embodiments meet both of the above criteria, they may be retained in a single application. If embodiments do not meet either one of the above criteria, restriction is required. It should be noted that if the embodiments do not have overall appearances that are basically the same, restriction must be required since their appearances are patentably distinct. In such case, it does not matter for restriction purposes if the differences between the appearances of the embodiments are shown to be obvious in view of analogous prior art.

Form paragraph 15.27.02 or 15.27.03, if appropriate, may be used to notify applicant that restriction is not required because the embodiments are not patentably distinct.

¶ 15.27.02 Restriction Not Required – Change In Appearance (First Action – Non Issue)

This application discloses the following embodiments:

Embodiment 1 – Figs. [1]

Embodiment 2 – Figs. [2]

[3]

Multiple embodiments of a single inventive concept may be included in the same design application only if they are patentably indistinct. See *In re Rubinfeld*, 270 F.2d 391, 123 USPQ 210 (CCPA 1959). Embodiments that are patentably distinct from one another do not constitute a single inventive concept and thus may not be included in the same design application. See *In re Platner*, 155 USPQ 222 (Comm'r Pat. 1967).

The above identified embodiments are considered by the examiner to present overall appearances that are basically the same. Furthermore, the differences between the appearances of the embodiments are considered minor and patentably indistinct, or are shown to be obvious in view of analogous prior art cited. Accordingly, they are deemed to be obvious variations and are being retained and examined in the same application.

Any rejection of one embodiment over prior art will apply equally to all other embodiments. See *Ex parte Appeal No. 315-40*, 152 USPQ 71 (Bd. App. 1965). No argument asserting patentability based on the differences between the embodiments will be considered once the embodiments have been determined to comprise a single inventive concept. Failure of applicant to traverse this determination in reply to this action will be considered an admission of lack of patentable distinction between the above identified embodiments.

Examiner Note:

In bracket 3, add embodiments as necessary.

¶ 15.27.03 Restriction Not Required – Change In Appearance (First Action Issue)

This application discloses the following embodiments:

Embodiment 1 – Figs. [1]

Embodiment 2 – Figs. [2]

[3]

Multiple embodiments of a single inventive concept may be included in the same design application only if they are patentably indistinct. See *In re Rubinfeld*, 270 F.2d 391, 123 USPQ 210 (CCPA 1959). Embodiments that are patentably distinct from one another do not constitute a single inventive concept and thus may not be included in the same design application. See *In re Platner*, 155 USPQ 222 (Comm'r Pat. 1967).

The above identified embodiments are considered by the examiner to present overall appearances that are basically the same. Furthermore, the differences between the appearances of the embodiments are considered minor and patentably indistinct, or are shown to be obvious in view of analogous prior art cited. Accordingly, they are deemed to be obvious variations and are being retained and examined in the same application.

Examiner Note:

In bracket 3, add embodiments as necessary.

The following form paragraphs may be used in a restriction requirement. Examiners must include a brief explanation of the differences between the appearances of the embodiments that render them patentably distinct.

¶ 15.27 Restriction Under 35 U.S.C. § 121

This application discloses the following embodiments:

Embodiment 1 – Figs. [1]

Embodiment 2 – Figs. [2]

[3]

Multiple embodiments of a single inventive concept may be included in the same design application only if they are patentably indistinct. See *In re Rubinfeld*, 270 F.2d 391, 123 USPQ 210 (CCPA 1959). Embodiments that are patentably distinct from one another do not constitute a single inventive concept and thus may not be included in the same design application. See *In re Platner*, 155 USPQ 222 (Comm'r Pat. 1967). The [4] create(s) patentably distinct designs.

Because of the differences identified, the embodiments are considered to either have overall appearances that are not basically the same, or if they are basically the same, the

differences are not minor and patentably indistinct or are not shown to be obvious in view of analogous prior art.

The above embodiments divide into the following patentably distinct groups of designs:

Group I: Embodiment [5]

Group II: Embodiment [6]

[7]

Restriction is required under 35 U.S.C. § 121 to one of the above identified patentably distinct groups of designs.

A reply to this requirement must include an election of a single group for prosecution on the merits, even if this requirement is traversed, 37 CFR 1.143. Any reply that does not include election of a single group will be held nonresponsive. Applicant is also requested to direct cancellation of all drawing figures and the corresponding descriptions which are directed to the nonelected groups.

Should applicant traverse this requirement on the grounds that the groups are not patentably distinct, applicant should present evidence or identify such evidence now of record showing the groups to be obvious variations of one another. If the groups are determined not to be patentably distinct and they remain in this application, any rejection of one group over prior art will apply equally to all other embodiments. See *Ex parte Appeal No. 315-40*, 152 USPQ 71 (Bd. App. 1965). No argument asserting patentability based on the differences between the groups will be considered once the groups have been determined to comprise a single inventive concept.

In view of the above requirement, action on the merits is deferred pending compliance with the requirement in accordance with *Ex parte Heckman*, 135 USPQ 229 (P.O. Super. Exam. 1960).

Examiner Note:

1. In bracket 3, add embodiments as necessary.
2. In bracket 4, insert an explanation of the difference(s) between the embodiments.
3. In bracket 7, add groups as necessary.
- 4.

¶ 15.27.01 Restriction Under 35 U.S.C. § 121 (Obvious Variations Within Group)

This application discloses the following embodiments:

Embodiment 1 – Figs. [1]

Embodiment 2 – Figs. [2]

[3]

Multiple embodiments of a single inventive concept may be included in the same design application only if they are patentably indistinct. See *In re Rubinfeld*, 270 F.2d 391, 123 USPQ 210 (CCPA 1959). Embodiments that are patentably distinct from one another do

not constitute a single inventive concept and thus may not be included in the same design application. See *In re Platner*, 155 USPQ 222 (Comm'r Pat. 1967).

The above embodiments divide into the following patentably distinct groups of designs:

Group I: Embodiment [4]

Group II: Embodiment [5]

[6]

The embodiments disclosed within each group have overall appearances that are basically the same. Furthermore, the differences between them are considered minor and patentably indistinct, or are shown to be obvious in view of analogous prior art cited.

Therefore, they are considered by the examiner to be obvious variations of one another within the group. These embodiments thus comprise a single inventive concept and are grouped together. However, the [7] patentably distinguishes each group from the other(s).

Because of the differences identified, the embodiments of each group are considered to either have overall appearances that are not basically the same, or if they are basically the same, the differences are not minor and patentably indistinct or are not shown to be obvious in view of analogous prior art.

Restriction is required under 35 U.S.C. § 121 to one of the patentably distinct groups of the designs.

A reply to this requirement must include an election of a single group for prosecution on the merits, even if this requirement is traversed, 37 CFR 1.143. Any reply that does not include election of a single group will be held nonresponsive. Applicant is also requested to direct cancellation of all drawing figures and the corresponding descriptions which are directed to the nonelected groups.

Should applicant traverse this requirement on the grounds that the groups are not patentably distinct, applicant should present evidence or identify such evidence now of record showing the groups to be obvious variations of one another. If the groups are determined not to be patentably distinct and they remain in this application, any rejection of one group over prior art will apply equally to all other groups. See *Ex parte Appeal No. 315-40*, 152 USPQ 71 (Bd. App. 1965). No argument asserting patentability based on the differences between the groups will be considered once the groups have been determined to comprise a single inventive concept.

In view of the above requirement, action on the merits is deferred pending compliance with the requirement in accordance with *Ex parte Heckman*, 135 USPQ 229 (P.O. Super. Exam. 1960).

Examiner Note:

1. In bracket 3, add embodiments as necessary.
2. In bracket 6, add groups as necessary.
3. In bracket 7, insert an explanation of the difference(s) between the groups.

¶ 15.28 Telephone Restriction Under 35 U.S.C. § 121

This application discloses the following embodiments:

Embodiment 1 – Figs. [1]

Embodiment 2 – Figs. [2]

[3]

Multiple embodiments of a single inventive concept may be included in the same design application only if they are patentably indistinct. See *In re Rubinfeld*, 123 USPQ 210 (CCPA 1959). Embodiments that are patentably distinct from one another do not constitute a single inventive concept and thus may not be included in the same design application. See *In re Platner*, 155 USPQ 222 (Comm’r Pat. 1967). The [4] create(s) patentably distinct designs. See *In re Platner*, 155 USPQ 222 (Comm’r Pat. 1967).

Because of the differences identified, the embodiments of each Group are considered to either have overall appearances that are not basically the same, or, if they are basically the same, the differences are not minor and patentably indistinct or are not shown to be obvious in view of analogous prior art.

The above disclosed embodiments divide into the following patentably distinct groups of designs:

Group I: Embodiment [5]

Group II: Embodiment [6]

[7]

Restriction is required under 35 U.S.C. § 121 to one of the patentably distinct groups of designs.

During a telephone discussion with [8] on [9], a provisional election was made [10] traverse to prosecute the design(s) of Group [11]. Affirmation of this election should be made by applicant in replying to this Office action.

Group [12] is withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being for a nonelected design(s).

Examiner Note:

1. In bracket 3, add embodiments as necessary.
2. In bracket 4, insert an explanation of the difference(s) between the embodiments.
3. In bracket 7, add groups as necessary.
4. In bracket 10, insert --with-- or --without--.

¶ 15.28.01 Telephone Restriction Under 35 U.S.C. § 121 (Obvious Variations Within Group)

This application discloses the following embodiments:

Embodiment 1 – Figs. [1]

Embodiment 2 – Figs. [2]

[3]

Multiple embodiments of a single inventive concept may be included in the same design application only if they are patentably indistinct. See *In re Rubinfeld*, 270 F.2d 391, 123 USPQ 210 (CCPA 1959). Embodiments that are patentably distinct from one another do not constitute a single inventive concept and thus may not be included in the same design application. See *In re Platner*, 155 USPQ 222 (Comm’r Pat. 1967).

The above embodiments divide into the following patentably distinct groups of designs:

Group I: Embodiment [4]

Group II: Embodiment [5]

[6]

The embodiments disclosed within each group have overall appearances that are basically the same. Furthermore, the differences between them are considered minor and patentably indistinct, or are shown to be obvious in view of analogous prior art cited. Therefore, they are considered by the examiner to be obvious variations of one another within the group. These embodiments thus comprise a single inventive concept and are grouped together. However, the [7] patentably distinguishes each group from the other(s).

Because of the differences identified, the embodiments of each Group are considered to either have overall appearances that are not basically the same, or if they are basically the same, the differences are not minor and patentably indistinct or are not shown to be obvious in view of analogous prior art.

Restriction is required under 35 U.S.C. § 121 to one of the patentably distinct groups of designs.

During a telephone discussion with [8] on [9], a provisional election was made [10] traverse to prosecute the design(s) of Group [11]. Affirmation of this election should be made by applicant in replying to this Office action.

Group [12] is withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being for a nonelected design(s).

Examiner Note:

1. In bracket 3, add embodiments as necessary.
2. In bracket 6, add groups as necessary.
3. In bracket 7, insert an explanation of the differences between the groups.
4. In bracket 10, insert --with-- or --without--.

¶ 15.31 Provisional Election Required (37 CFR 1.143)

Applicant is advised that the reply to be complete must include a provisional election of one of the enumerated designs, even though the requirement may be traversed (37 CFR 1.143).

#### B. Combination/Subcombination – Difference in Scope

A design claim covers the entire design as a whole. Furthermore, claim protection to the whole design does not extend to any individual part or portion thereof. See *KeyStone Retaining Wall Systems Inc. v. Westrock Inc.*, 997 F.2d 1444, 27 USPQ2d 1297 (Fed. Cir. 1993). Embodiments directed to a design as a whole (combination) as well as individual parts or portions (subcombination) thereof may not be included in a single application if the appearances are patentably distinct. In such instance, restriction would be required since patentably distinct combination/subcombination subject matter must be supported by separate claims. However, a design claim may cover embodiments of different scope directed to the same inventive concept within a single application if the designs are not patentably distinct. See *In re Rubinfeld*, 270 F.2d 391, 123 USPQ 210 (CCPA 1959). The court held that the inventive concept of a design is not limited to its embodiment in a single specific article, and as long as the various embodiments are not patentably distinct, they may be protected by a single claim. See *Blumcraft of Pittsburgh v. Ladd*, 238 F. Supp. 648, 144 USPQ 562 (D.D.C. 1965).

The determination that the design of the subcombination/element is patentably indistinct from the combination means that the designs are not patentable over each other (novel and unobvious) and may remain in the same application. In contrast, if the embodiments are patentably distinct, the designs are considered to be separate inventions which require separate claims, and restriction to one or the other is necessary. See *In re Kelly*, 200 USPQ 560 (Comm'r Pat. 1978); *Ex parte Sanford*, 1914 C.D. 69, 204 O.G. 1346 (Comm'r Pat. 1914); *Ex parte Heckman*, 135 USPQ 229 (P.O. Super. Exam. 1960). In determining whether embodiments of different scope can be retained in a single application, they must have overall appearances that are basically the same, and the difference in scope must be minor and not a patentable distinction. That is, they must, by themselves, be considered obvious over each other under 35 U.S.C. § 103 without the aid of analogous prior art. The reason for this, as stated above, is because claim protection to the whole design does not extend to any individual part or portion thereof.

Therefore, if the difference in scope between embodiments has an impact on the overall appearance that distinguishes one over the other, they must be restricted since the difference in scope creates patentably distinct designs that must be supported by separate claims. Form paragraph 15.27.04 or 15.27.05, if appropriate, may be used to notify applicant that restriction is not required because the embodiments required are not patentably distinct.

#### ¶ 15.27.04 Restriction Not Required – Change In Scope (First Action – Non Issue)

This application discloses the following embodiments:

Embodiment 1 – Figs. [1]

Embodiment 2 – Figs. [2]

[3]

Designs which involve a change in scope may be included in the same design application only if they are patentably indistinct. However, design patent protection does not extend to patentably distinct segregable parts of a design. *Ex parte Sanford*, 1914 C.D. 69, 204 O.G. 1346 (Comm’r Pat. 1914); *Blumcraft of Pittsburgh v. Ladd*, 238 F. Supp. 648, 144 USPQ 562 (D.D.C. 1965).

The above identified embodiments are considered by the examiner to present overall appearances that are basically the same. Furthermore, the difference in scope between embodiments is considered minor and patentably indistinct. Accordingly, they are deemed to be obvious variations and are being retained and examined in the same application. Any rejection of one embodiment over prior art will apply equally to all other embodiments. See *Ex parte Appeal No. 315-40*, 152 USPQ 71 (Bd. App. 1965). No argument asserting patentability based on the differences between the embodiments will be considered once the embodiments have been determined to comprise a single inventive concept. Failure of applicant to traverse this determination in reply to this Office action will be considered an admission of lack of patentable distinction between the embodiments.

Examiner Note:

In bracket 3, add embodiments as necessary.

¶ 15.27.05 Restriction Not Required – Change In Scope (First Action Issue)

This application discloses the following embodiments:

Embodiment 1 – Figs. [1]

Embodiment 2 – Figs. [2]

[3]

Designs which involve a change in scope may be included in the same design application only if they are patentably indistinct. However, design patent protection does not extend to patentably distinct segregable parts of a design. *Ex parte Sanford*, 1914 C.D. 69, 204 O.G. 1346 (Comm’r Pat. 1914); *Blumcraft of Pittsburgh v. Ladd*, 238 F. Supp. 648, 144 USPQ 562 (D.D.C. 1965).

The above identified embodiments are considered by the examiner to present overall appearances that are basically the same. Furthermore, the difference in scope between embodiments is considered minor and patentably indistinct. Accordingly, they are deemed to be obvious variations and are being retained and examined in the same application.

Examiner Note:

In bracket 3, add embodiments as necessary.

Form paragraph 15.29 or 15.30, if appropriate, may be used to make a restriction requirement.

¶ 15.29 Restriction Under 35 U.S.C. § 121 (Segregable Parts or Combination/Subcombination)

This application discloses the following embodiments:

Embodiment 1 – Figs. [1] drawn to a [2].

Embodiment 2 – Figs. [3] drawn to a [4].

[5]

Restriction to one of the following inventions is required under 35 U.S.C. § 121:

Group I – Embodiment [6]

Group II – Embodiment [7]

[8]

The designs as grouped are distinct from each other since under the law a design patent covers only the invention disclosed as an entirety, and does not extend to patentably distinct segregable parts; the only way to protect such segregable parts is to apply for separate patents. See *Ex parte Sanford*, 1914 C.D. 69, 204 O.G. 1346 (Comm’r Pat. 1914); and *Blumcraft of Pittsburgh v. Ladd*, 238 F. Supp. 648, 144 USPQ 562 (D.D.C. 1965). It is further noted that patentably distinct combination/subcombination subject matter must be supported by separate claims, whereas only a single claim is permissible in a design patent application. See *In re Rubinfeld*, 270 F.2d 391, 123 USPQ 210 (CCPA 1959).

[9]

Because the designs are distinct for the reason(s) given above, and have acquired separate status in the art, restriction for examination purposes as indicated is proper (35 U.S.C. § 121).

A reply to this requirement must include an election of a single group for prosecution on the merits, even if this requirement is traversed. 37 CFR 1.143. Any reply that does not include an election of a single group will be held nonresponsive. Applicant is also requested to direct cancellation of all drawing figures and the corresponding descriptions which are directed to the nonelected groups.

Should applicant traverse this requirement on the grounds that the groups are not patentably distinct, applicant should present evidence or identify such evidence now of record showing the groups to be obvious variations of one another. If the groups are determined not to be patentably distinct and they remain in this application, any rejection of one group over the prior art will apply equally to all other groups. See *Ex parte Appeal No. 315-40*, 152 USPQ 71 (Bd. App. 1965). No argument asserting patentability based on

the differences between the groups will be considered once the groups have been determined to comprise a single inventive concept.

In view of the above requirement, action on the merits is deferred pending compliance with the requirement in accordance with *Ex parte Heckman*, 135 USPQ 229 (P.O. Super. Exam. 1960).

Examiner Note:

1. In bracket 5, add embodiments as necessary.
2. In bracket 8, add groups as necessary.
3. In bracket 9, add comments, if necessary.

¶ 15.30 Telephone Restriction Under 35 U.S.C. § 121 (Segregable Parts or Combination/Subcombination)

This application discloses the following embodiments:

Embodiment 1 – Figs. [1] drawn to a [2].

Embodiment 2 – Figs. [3] drawn to a [4].

[5]

Restriction to one of the following inventions is required under 35 U.S.C. § 121:

Group I – Embodiment [6]

Group II – Embodiment [7]

[8]

The designs as grouped are distinct from each other since under the law a design patent covers only the invention disclosed as an entirety, and does not extend to patentably distinct segregable parts; the only way to protect such segregable parts is to apply for separate patents. See *Ex parte Sanford*, 1914 C.D. 69, 204 O.G. 1346 (Comm'r Pat. 1914); and *Blumcraft of Pittsburgh v. Ladd*, 238 F. Supp. 648, 144 USPQ 562 (D.D.C. 1965). It is further noted that patentably distinct combination/subcombination subject matter must be supported by separate claims, whereas only a single claim is permissible in a design patent application. See *In re Rubinfield*, 270 F.2d 391, 123 USPQ 210 (CCPA 1959).

[9]

During a telephone discussion with [10] on [11], a provisional election was made [12] traverse to prosecute the invention of Group [13]. Affirmation of this election should be made by applicant in replying to this Office action.

Group [14] is withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being for a nonelected invention.

Examiner Note:

1. In bracket 5, add embodiments as necessary.
2. In bracket 8, add groups as necessary.
3. In bracket 9, insert additional comments, if necessary.

Form paragraph 15.27.06 or 15.27.07, if appropriate, may be used to notify applicant that restriction is not required because the designs are not patentably distinct.

¶ 15.27.06 Restriction Not Required (Change in Appearance and Scope – First Action Non Issue)

This application discloses the following embodiments:

Embodiment 1 – Figs. [1] drawn to a [2].

Embodiment 2 – Figs. [3] drawn to a [4].

[5]

Embodiment(s) [6] involve a difference in appearance. Multiple embodiments of a single inventive concept may be included in the same design application only if they are patentably indistinct. See *In re Rubinfeld*, 270 F.2d 391, 123 USPQ 210 (CCPA 1959). Embodiments that are patentably distinct from one another do not constitute a single inventive concept and thus may not be included in the same design application. See *In re Platner*, 155 USPQ 222 (Comm’r Pat. 1967).

Embodiment(s) [7] directed to the combination(s) in relation to Embodiment(s) [8] directed to the subcombination(s)/element(s). Designs which involve a change in scope may be included in the same design application only if they are patentably indistinct. However, design protection does not extend to patentably distinct segregable parts of a design. *Ex parte Sanford*, 1914 C.D. 69, 204 O.G. 1346 (Comm’r Pat. 1914); *Blumcraft of Pittsburgh v. Ladd*, 238 F. Supp. 648, 144 USPQ 562 (D.D.C. 1965).

The above identified embodiments are considered by the examiner to present overall appearances that are basically the same. Furthermore, the differences between embodiments are considered minor and patentably indistinct, or are shown to be obvious in view of analogous prior art cited. Accordingly, they are deemed to be obvious variations and are being retained and examined in the same application. Any rejection of one embodiment over prior art will apply equally to all other embodiments. See *Ex parte Appeal No. 315-40*, 152 USPQ 71 (Bd. App. 1965). No argument asserting patentability based on the differences between the embodiments will be considered once the embodiments have been determined to comprise a single inventive concept. Failure of applicant to traverse this determination in reply to this action will be considered an admission of lack of patentable distinction between the embodiments.

Examiner Note:

1. In bracket 5, add embodiments as necessary.
2. Insert an explanation of the differences between the designs in the explanations of the embodiments; for example, Figs. 1–5 directed to a cup and saucer; Figs. 6–9 directed to a saucer.

3. It is possible and proper that embodiments may be listed in both explanatory paragraphs.

¶ 15.27.07 Restriction Not Required (Change in Appearance and Scope – First Action Issue)

This application discloses the following embodiments:

Embodiment 1 – Figs. [1] drawn to a [2].

Embodiment 2 – Figs. [3] drawn to a [4].  
[5]

Embodiment(s) [6] involve a difference in appearance. Multiple embodiments of a single inventive concept may be included in the same design application only if they are patentably indistinct. See *In re Rubinfeld*, 270 F.2d 391, 123 USPQ 210 (CCPA 1959). Embodiments that are patentably distinct from one another do not constitute a single inventive concept and thus may not be included in the same design application. See *In re Platner*, 155 USPQ 222 (Comm’r Pat. 1967).

Embodiment(s) [7] directed to the combination(s) in relation to Embodiment(s) [8] directed to the subcombination(s)/element(s). Designs which involve a change in scope may be included in the same design application only if they are patentably indistinct. However, design protection does not extend to patentably distinct segregable parts of a design. *Ex parte Sanford*, 1914 C.D. 69, 204 O.G. 1346 (Comm’r Pat. 1914); *Blumcraft of Pittsburgh v. Ladd*, 238 F. Supp. 648, 144 USPQ 562 (D.D.C. 1965).

The above identified embodiments are considered by the examiner to present overall appearances that are basically the same. Furthermore, the differences between embodiments are considered minor and patentably indistinct, or are shown to be obvious in view of analogous prior art cited. Accordingly, they were deemed to be obvious variations and are being retained and examined in the same application. Accordingly, they were deemed to comprise a single inventive concept and have been examined together.

Examiner Note:

1. In bracket 5, add embodiments as necessary.
2. Insert an explanation of the differences between the designs in the explanations of the embodiments; for example, Figs. 1–5 directed to a cup and saucer; Figs. 6–9 directed to a saucer.
3. It is possible and proper that embodiments may be listed in both explanatory paragraphs.

The following form paragraphs may be used in a restriction requirement.

Examiners must include a brief explanation of the differences between embodiments that render them patentably distinct.

#### ¶ 15.27.08 Restriction with Differences in Appearance and Scope

This application discloses the following embodiments:

Embodiment 1: Figs. [1] drawn to a [2].

Embodiment 2: Figs. [3] drawn to a [4].

[5]

The above embodiments divide into the following patentably distinct groups of designs:

Group I: Embodiment [6]

Group II: Embodiment [7]

[8]

Group(s) [9] involve a difference in appearance. Multiple embodiments of a single inventive concept may be included in the same design application only if they are patentably indistinct. See *In re Rubinfeld*, 270 F.2d 391, 123 USPQ 210 (CCPA 1959). Embodiments that are patentably distinct from one another do not constitute a single inventive concept and thus may not be included in the same design application. See *In re Platner*, 155 USPQ 222 (Comm'r Pat. 1967). The [10] creates patentably distinct designs.

Because of the differences identified, the embodiments are considered to either have overall appearances that are not basically the same, or if they are basically the same, the differences are not minor and patentably indistinct or are not shown to be obvious in view of analogous prior art.

Group(s) [11] directed to the combination(s) in relation to Group(s) [12] directed to the subcombination(s)/element(s). The designs as grouped are distinct from each other since under the law a design patent covers only the design disclosed as an entirety, and does not extend to patentably distinct segregable parts; the only way to protect such segregable parts is to apply for separate patents. See *Ex parte Sanford*, 1914 C.D. 69, 204 O.G. 1346 (Comm'r Pat. 1914); *Blumcraft of Pittsburgh v. Ladd*, 238 F. Supp. 648, 144 USPQ 562 (D.D.C. 1965). It is further noted that combination/subcombination subject matter, if patentably distinct, must be supported by separate claims, whereas only a single claim is permissible in a design patent application. See *In re Rubinfeld*, 270 F.2d 391, 123 USPQ 210 (CCPA 1959).

In any groups that include multiple embodiments, the embodiments are considered by the examiner to be obvious variations of one another within the group and, therefore, patentably indistinct. These embodiments thus comprise a single inventive concept and are grouped together.

Restriction is required under 35 U.S.C. § 121 to one of the patentably distinct groups of designs.

A reply to this requirement must include an election of a single group for prosecution on the merits even if this requirement is traversed. 37 CFR 1.143. Any reply that does not include an election of a single group will be held nonresponsive. Applicant is also

requested to direct cancellation of all drawing figures and the corresponding descriptions which are directed to the nonelected groups.

Should applicant traverse this requirement on the grounds that the groups are not patentably distinct, applicant should present evidence or identify such evidence now of record showing the groups to be obvious variations of one another. If the groups are determined not to be patentably distinct and they remain in this application, any rejection of one group over prior art will apply equally to all other groups. See *Ex parte Appeal No. 315-40*, 152 USPQ 71 (Bd. App. 1965). No argument asserting patentability based on the differences between the groups will be considered once the groups have been determined to comprise a single inventive concept.

In view of the above requirement, action on the merits is deferred pending compliance with the requirement in accordance with *Ex parte Heckman*, 135 USPQ 229 (P.O. Super. Exam. 1960).

Examiner Note:

1. In bracket 5, add embodiments as necessary.
2. In bracket 8, add embodiments as necessary.
3. Insert an explanation of the differences between the designs in the explanations of the embodiments; for example, Figs. 1–5 directed to a cup and saucer; Figs. 6–9 directed to a saucer.
4. It is possible and proper that embodiments may be listed in both explanatory paragraphs.
5. In bracket 10, insert an explanation of the differences between the designs.

#### ¶ 15.28.02 Telephone Restriction with Differences in Appearance and Scope

This application discloses the following embodiments:

Embodiment 1: Figs. [1] drawn to a [2].

Embodiment 2: Figs. [3] drawn to a [4].

[5]

The above embodiments divide into the following patentably distinct groups of designs:

Group I: Embodiment [6]

Group II: Embodiment [7]

[8]

Group(s) [9] involve a difference in appearance. Multiple embodiments of a single inventive concept may be included in the same design application only if they are patentably indistinct. See *In re Rubinfeld*, 270 F.2d 391, 123 USPQ 210 (CCPA 1959). Embodiments that are patentably distinct from one another do not constitute a single inventive concept and thus may not be included in the same design application. See *In re Platner*, 155 USPQ 222 (Comm'r Pat. 1967). The [10] creates patentably distinct designs.

Because of the differences identified, the embodiments are considered to either have overall appearances that are not basically the same, or if they are basically the same, the differences are not minor and patentably indistinct or are not shown to be obvious in view of analogous prior art.

Group(s) [11] directed to the combination(s) in relation to Group(s) [12] directed to the subcombination(s)/element(s). The designs as grouped are distinct from each other since under the law a design patent covers only the design disclosed as an entirety, and does not extend to patentably distinct segregable parts; the only way to protect such segregable parts is to apply for separate patents. See *Ex parte Sanford*, 1914 C.D. 69, 204 O.G. 1346 (Comm'r Pat. 1914); *Blumcraft of Pittsburgh v. Ladd*, 238 F. Supp. 648, 144 USPQ 562 (D.D.C. 1965). It is further noted that combination/subcombination subject matter, if patentably distinct, must be supported by separate claims, whereas only a single claim is permissible in a design patent application. See *In re Rubinfeld*, 270 F.2d 391, 123 USPQ 210 (CCPA 1959).

In any groups that include multiple embodiments, the embodiments are considered by the examiner to be obvious variations of one another within the group and, therefore, patentably indistinct. These embodiments thus comprise a single inventive concept and are grouped together.

Restriction is required under 35 U.S.C. § 121 to one of the patentably distinct groups of designs.

During a telephone discussion with [13] on [14], a provisional election was made [15] traverse to prosecute the invention of Group [16]. Affirmation of this election should be made by applicant in replying to this Office action.

Group [17] is withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being for a nonelected invention.

Examiner Note:

1. In bracket 5, add embodiments as necessary.
2. In bracket 8, add groups as necessary.
3. Insert an explanation of the differences between the designs in the explanations of the embodiments; for example, Figs. 1–5 directed to a cup and saucer; Figs. 6–9 directed to a saucer.
4. It is possible and proper that embodiments may be listed in both explanatory paragraphs.
5. In bracket 10, insert an explanation of the differences between the designs.
6. In bracket 15, insert --with-- or --without--.

#### ¶ 15.33 Qualifying Statement To Be Used In Restriction When A Common Embodiment Is Included In More Than One Group

The common embodiment is included in more than a single group as it is patentably indistinct from the other embodiment(s) in those groups and to give applicant the

broadest possible choices in the election. If the common embodiment is elected in this application, then applicant is advised that the common embodiment should not be included in any continuing application to avoid a rejection on the ground of double patenting under 35 U.S.C. § 171 in the new application.

The following form paragraphs may be used to notify applicant that the nonelected invention(s) are withdrawn from consideration.

#### ¶ 15.34 Groups Withdrawn From Consideration After Traverse

Group [1] withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being for a nonelected design, the requirement having been traversed in the reply filed on [2].

#### ¶ 15.35 Cancel Nonelected Design (Traverse)

The restriction requirement maintained in this application is or has been made final. Applicant must cancel Group [1] directed to the design(s) nonelected with traverse in the reply filed on [2], or take other timely appropriate action (37 CFR 1.144).

#### ¶ 15.36 Groups Withdrawn From Consideration Without Traverse

Group [1] withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being for the nonelected design. Election was made without traverse in the reply filed on [2].

#### ¶ 15.37 Cancellation of Nonelected Groups, No Traverse

In view of the fact that this application is in condition for allowance except for the presence of Group [1] directed to a design or designs nonelected without traverse in the reply filed on [2], and without the right to petition, such Group(s) have been canceled.

### III. TRAVERSAL OF RESTRICTION REQUIREMENT

If a response to a restriction requirement includes an election with traverse on the grounds that the groups are not patentably distinct, applicant must present evidence or identify such evidence of record showing the groups to be obvious variations of one another. Traversal of a restriction requirement alone without an explanation in support thereof will be treated as an election without traverse. See MPEP § 818.01(c) and form paragraph 8.25.02.

A traversal of a restriction requirement based on there being no serious burden to an examiner to search and examine an entire application (as noted in MPEP § 803) is not applicable to design patent applications. The fact that the embodiments may be searched together cannot preclude a requirement for restriction if their appearances are considered patentably distinct, since patentably distinct embodiments cannot be supported by a single formal design claim. Also, clear admission on the record by the applicant, on its own, that the embodiments are not patentably distinct (as noted in MPEP § 809.02(a))

will not overcome a requirement for restriction if the embodiments do not have overall appearances that are basically the same as each other.

When a traversal specifically points out alleged errors in a restriction, examiners must reevaluate the requirement in view of these remarks. If the restriction requirement is to be maintained, it must be repeated and made final in the next Office action and the arguments answered. If the application is otherwise in condition for allowance, except for the presence of a non-elected invention, the examiner should contact applicant and advise the applicant of the options with regard to any pending claims withdrawn from consideration. Alternatively, applicant may be notified using form paragraph 8.03. See MPEP § 821.01.