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Patently Enabled November 2025 – A Procedural Trap for Patents: The Constructive Election Rule

Key Takeaways

- Prospective patent applicants should evaluate the greatest long-term benefits of their potential patent and direct their initial claim set to the most valuable claims to avoid constructive election by original presentation.
- Failure to do so may trigger constructive election if an applicant adds claims to a different and distinct invention **after** receiving an office action on the merits of the original claims.
- If constructive election is triggered, the claims for the newly added invention are **not** examined and are withdrawn from consideration.

A patent is a business asset—one that can protect a company's most valuable innovations and create long-term competitive advantage. However, during the patent process, a procedural pitfall called **constructive election by original presentation** can limit which parts of an invention are examined by the U.S. Patent and Trademark Office (USPTO). Constructive election occurs when the pending claims change direction after the USPTO has already reviewed the originally presented claims—for example, by deleting them and adding claims directed to a different invention.

Consider an aerospace company whose business needs change over time, resulting in a corresponding change in the assets it may wish to protect. For example, suppose a company files an application disclosing a spaceship, including a novel engine and a novel navigation system, but claiming only the engine. After the first office action on the merits, the company then decides to delete all the original claims and present for the first time new claims directed to the navigation system.

Unfortunately, this strategy will not work because the company has added claims to a "distinct and independent" invention after the examiner has already acted on the initial claims. Here, the examiner will deem the originally presented invention to have been **constructively elected** for prosecution. This is **not** a choice the applicant makes; rather, it is a procedural consequence of the applicant's actions. The examiner will then issue a restriction requirement to withdraw and ignore the newly added claims. From the perspective of the USPTO, enforcing constructive election ensures examination remains focused and efficient. Since a search and examination have already been completed for the initially presented claims, constructive election avoids starting the examination process over with a completely different claim set.

However, all is not lost. The company can still pursue the nonelected claims (i.e., those relating to the navigation system), but they must do so in a **separate application, such as a divisional application**. Additionally, the company can decide whether their original claims (i.e., claims to the engine) are still worth pursuing; if not, the company can simply abandon the original application and invest downstream efforts in examination of, for example, their divisional application with claims to the navigation system.

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