

Traversing restriction requirements: a quick reference guide

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During patent prosecution, it is somewhat frequent to receive a restriction requirement. Restriction requirements occur when the examiner believes that the claims express more than one distinct invention.¹ Accordingly, a restriction requirement requires an applicant to choose which of the “inventions” should be examined in this application. This presents the applicant, and their representative attorney or agent, with a couple of options.

The applicant must elect one of the sets of claims presented by the examiner and withdraw the remaining claims. This decision is claim and situationally dependent.

However, the more frequently discounted decision is whether to elect a set of claims with or without traverse. Electing without traverse allows the applicant to choose one of the options presented by the examiner without commenting on or arguing the correctness of the examiner’s restriction.

Applicants can show how an examiner’s groups of the claims are wrong.

Electing with traverse allows the applicant to provisionally select an option from the examiner’s choices to satisfy the requirement; however, it also provides the applicant with the ability to present arguments on why the examiner’s restriction requirement is improper. Both of these options have pros and cons that should be carefully weighed.

Electing without traverse allows the applicant to use the application to prosecute the chosen set of claims. The applicant can file a divisional application to prosecute the unelected claims. In some cases, for example, where a client is planning an expansive patent family, a divisional can be beneficial.

Because the examiner issued a restriction requirement, a later divisional application regarding the unelected claims cannot be subject to obviousness-type double patenting rejection.² The divisional can also have a different, potentially longer “shelf-life” than the parent application if the patent office delays the application.³

Electing with traverse allows the applicant to provisionally choose a set of claims to satisfy the restriction requirement, but also present

arguments why the restriction is improper. Under MPEP § 803, “there are two criteria for a proper requirement for a restriction between patentably distinct inventions: (A) The inventions must be independent ... or distinct as claimed; and (B) There would be a serious burden on the examiner if restriction is not required.⁴ Accordingly, applicants can choose to attack either or both of these prongs.

Some take the view that it is more appealing to accept the restriction and give the examiner an early, albeit minor, “win.”

Arguments can take a variety of forms. Applicants can show how an examiner’s groups of the claims are wrong. However, that may just result in the examiner modifying the groupings and issuing another restriction requirement.

One issue that typically arises while making an argument against the first prong is, either purposely or inadvertently, that the applicant essentially admits on the record that the inventions are not patentably distinct. This means that, in the event that the examiner finds prior art that applies to the first group, if the applicant has presented the first prong traversal argument on the record, the examiner can also potentially use the same prior art against the second group. For this reason, arguments that the inventions are not patentably distinct must be made very cautiously.

On the other hand, arguments made against the second, “serious burden,” prong are generally straightforward. Applicants can argue that examining claims would not present a serious burden due to similarity or the nature of the application. However, examiners have significant discretion in determining what constitutes a “serious burden.”

As such, second prong arguments can have limited success. Overall, few examiners are swayed by traversal arguments. Presenting an argument with traverse preserves the applicant’s right to petition for an improper restriction later. However, again, very few of these petitions are resolved in favor of the applicant.

One last attribute of traversal can help an applicant: rejoinder. If an election is made with traverse, under MPEP § 821.01, once the application is in a condition for allowance, the examiner must give the applicant two months to decide how to proceed with withdrawn claims.⁵

Otherwise, if the election was made without traverse, once the application is in a condition for allowance, the examiner can automatically cancel the withdrawn claims.⁶ This can prevent the applicant from having the opportunity to attempt to rejoin the claims.⁷

Rejoinder can provide significant value to the applicant as it can result in the withdrawn claims being placed back into the application for allowance. This can save an applicant significant costs by avoiding additional filing fees, prosecution costs, and future maintenance fees (by only having to maintain one patent versus multiple).

Ultimately, deciding whether to traverse should be determined on a case-by-case basis. Some take the view that it is more appealing to accept the restriction and give the examiner an early, albeit minor, “win.” Others think that preserving the ability to seek rejoinder is more important, given the modest cost a traversal argument usually entails. It comes down to client goals and the nature of the rejection.

Notes

¹ See MPEP § 802.

² See 35 U.S.C.A. § 121.

³ See *AbbVie Inc. v. Mathilda & Terence Kennedy Inst. of Rheumatology Trust*, 764 F.3d 1366, 1373 (Fed. Cir 2014).

⁴ MPEP § 803.

⁵ See *id.* at § 821.01.

⁶ See *id.* at § 821.02.

⁷ See *id.* at § 821.04.

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