

“UNDUE MULTIPLICITY”: RESTORATION OF A NEEDED TOOL FOR EXAMINERS

Harold C. Wegner

The following examination procedure is proposed:

- (1) Where an Examiner determines that the application contains a large number of claims which are unnecessarily proliferated, particularly where the Examiner can point to inconsistent language and definitions within the claims, the applicant shall be required to elect a certain number of claims fixed by the examiner for further prosecution.
- (2) The applicant shall then elect claims not to exceed the number set by the examiner for further prosecution and, if he traverses the undue multiplicity requirement/rejection, shall point out *why* each of the claims is necessary for applicant's business interests and explain *how* the several claims are each patentably distinct, each from the other, including pointing out the support for each claim in the specification.
- (3) The elected claims will then be acted upon both on the merits *and* if the examiner maintains his position on undue multiplicity, all claims shall also be rejected on this basis.

Discussion

A small minority of patent applicants abuse the patent system by filing appreciably more claims than are necessary to define their inventions. A useful tool to control this abuse is the rejection based upon “undue multiplicity”. This rejection was commonly used up through the 1960's and until *In re Wakefield*, 422 F.2d 897 (CCPA 1970).

With limited examination resources it is unfair to the 99 % of patent applicants who present a reasonable number of claims to be deprived of examination time based upon the actions of less than one percent of the applicant pool who create a burden on examination resources.

The “undue multiplicity” rejection should be restored where there are both a large number of claims and where there is inconsistent usage within the set of claims that obscure the definition of the invention.

Background: The *Kunin Memorandum*

Rejections based on undue multiplicity have been silenced by the leadership of the Patent and Trademark Office through the so-called “Kunin Memorandum”, more formally styled as *Rejections Based on Undue Multiplicity*, Memorandum from Stephen G. Kunin, Deputy Commissioner for Patent Examination Policy to Technology Center Directors and the Patent Examining Corps (March 18, 2002). Undue multiplicity is also considered in the *Manual of Patent Examining Procedure*. See Appendix: *MPEP § 2173.05(n) Multiplicity* [R-11.2013].

The *Kunin Memorandum* purports to quote from *In re Flint*, 411 F.2d 1353, 1357 (CCPA 1969), as basis to limit the use of undue multiplicity as a basis for rejection. But, the quotation in the *Kunin Memorandum* is actually a quotation from *In re Chandler*, 319 F.2d 211 (CCPA 1963), which *affirmed* a rejection on undue multiplicity. Thus, the quotation from *Chandler* was mere *dicta* as the *holding* in that case was an *affirmance* of an undue multiplicity rejection.

One of the last cases on undue multiplicity where the Office was reversed occurred nearly fifty years ago in *Wakefield*. In that case the rejection was reversed because, as the court pointed out, “[e]ach appealed claim is relatively brief and clear in its meaning. Examination of forty claims in a single application may be tedious work, but this is no reason for saying that the invention is obscured by the large number of claims. We note that *the claims were clear enough for the examiner to apply references against all of them in his first action.*” *Wakefield*, 422 F.2d at 900-91.

In passing, the court discussed *Wakefield* in dicta in *Tafas v. Doll*, 559 F.3d 1345, 1363 (Fed. Cir. 2009) (“Subject to the arguable requirement that an applicant cannot ‘obscure’ his invention by ‘undue multiplicity,’ our precedent does not suggest that there is a limit on the number of claims. *In re Clark*, 97 F.2d 628, 631 (1938); *see also In re Wakefield*, 422 F.2d 897, 900 (CCPA 1970) (‘[A]n applicant should be allowed to determine the necessary number and scope of his claims....’); *In re Chandler*, 319 F.2d 211, 225 (CCPA 1963) (‘[A]pplicants should be allowed reasonable latitude in stating their claims in regard to number and phraseology employed. The right of applicants to freedom of choice in selecting phraseology which truly points out and defines their inventions should not be abridged.’).”)

Appendix: MPEP § 2173.05(n) Multiplicity [R-11.2013]

Where, in view of the nature and scope of applicant’s invention, applicant presents an unreasonable number of claims which are repetitious and multiplied, the net result of which is to confuse rather than to clarify, a rejection on undue multiplicity based on 35 U.S.C. 112(b) ... may be appropriate. As noted by the court in *In re Chandler*, 319 F.2d 211, 225, 138 USPQ 138, 148 (CCPA 1963), “applicants should be allowed reasonable latitude in stating their claims in regard to number and phraseology employed. The right of applicants to freedom of choice in selecting phraseology which truly points out and defines their inventions should not be abridged. Such latitude, however, should not be extended to sanction that degree of repetition and multiplicity which beclouds definition in a maze of confusion. The rule of reason should be practiced and applied on the basis of the relevant facts and circumstances in each individual case.” See also *In re Flint*, 411 F.2d 1353, 1357, 162 USPQ 228, 231 (CCPA 1969). Undue multiplicity rejections based on 35 U.S.C. 112(b) ... should be applied judiciously and should be rare.

If an undue multiplicity rejection under 35 U.S.C. 112(b) ... is appropriate, the examiner should contact applicant by telephone explaining that the claims are unduly multiplied and will be rejected under 35 U.S.C. 112(b) ... Note MPEP § 408. The examiner should also request that applicant select a specified number of claims for purpose of examination. If applicant is willing to select, by telephone, the claims for examination, an undue multiplicity rejection on all the claims based on 35 U.S.C. 112(b) ... should be made in the next Office action along with an action on the merits on the selected claims. If applicant refuses to comply with the telephone request, an undue multiplicity rejection of all the claims based on 35 U.S.C. 112(b) ... should be made in the next Office action. Applicant’s reply must include a selection of claims for purpose of examination, the number of which may not be greater than the number specified by the examiner. In response to applicant’s reply, if the examiner adheres to the undue multiplicity rejection, it should be repeated and the selected claims will be examined on the merits. This procedure preserves applicant’s right to have the rejection on undue multiplicity reviewed by the Patent Trial and Appeal Board. **