

UNDUE MULTIPLICITY AS BASIS TO LIMIT THE NUMBER OF ACTIVE CLAIMS

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The Federal Circuit in *Shaw Indus. Grp., Inc. v. Automated Creel Sys., Inc.*, ___ F.3d ___ (Fed. Cir. Mar. 23, 2016)(Moore, J.), following *Hyatt v. U.S. Patent & Trademark Office*, 797 F.3d 1374, 1376 (Fed. Cir. 2015), has implicitly reiterated its support for the right of the Patent Office to limit the number of claims under consideration.

There clearly should be no hard and fast numerical limit on the number of claims that the applicant may present to an invention. But, to the extent that there are, say, hundreds of claims, the Office has a right *and a duty* to police any evident abuse of the system with the tools at hand, particularly a rejection based upon “undue multiplicity”.

Historically, the Office has had the power to deny merits consideration to huge numbers of claims by rejection of *all* claims on the basis of indefiniteness under 35 USC § 112, ¶ 2, keyed to “undue multiplicity” where the “degree of repetition and multiplicity [] beclouds definition [of the invention] in a maze of confusion.” *In re Flint*, 411 F.2d 1353, 1357 (CCPA 1969)(Almond, J.)(*dictum*) (quoting *In re Chandler*, 319 F.2d 211, 225 (CCPA 1963)). See also *In re Clark*, 97 F.2d 628, 631 (CCPA 1938)(citing Robinson on Patents, Vol. 2, § 529; *In re*

McCullough, 1927 C.D. 12)(describing the benefits of multiple claims with the proviso that “[i]f by [presenting multiple claims the inventor] more clearly defines his invention and *does not by undue multiplicity obscure the same*, he is acting within the rights granted and the duties required by the patent laws.”)(emphasis added).

Where the number of claims presented is *unreasonable*, the Office should issue an order demanding that the patentee provide a claim chart and explanation as to *why* each and every claim is necessary to protect its invention. Additionally, the Office should provisionally select the number of claims that it considers reasonable and require the patentee to nominate no more than that number of claims for further prosecution (if an undue multiplicity rejection is made).

If the applicant maintains more than the stated number of claims and if his answer as to the number of claims is unsatisfactory, then the Office should, without more, reject *all claims* beyond the elected claims on the basis of “undue multiplicity”.

The “undue multiplicity” rejection has a long history at the Office, but by the late 1960’s this ground of rejection was being abused by some Examiners. Thus, more than forty year ago, the Patent Office denied merits examination to applications with a quite limited number of claims which led to a fact-based reversal of an undue multiplicity rejection in *In re Wakefield*, 422 F.2d 897 (CCPA 1970), where the few claims presented left a picture where the subject matter was

understandable. Since *Wakefield*, it has been a general policy of the Office to refrain from making undue multiplicity rejections.

The Office should reconsider *Wakefield* and the possibility in cases of too many claims of making a *requirement* for a claims chart that points out precisely the patentable differences between the claims and why so many claims are necessary. Failure to comply with the requirement leads to a holding of abandonment of the application. The judicial standard of review at the District Court and thence on appeal to the Federal Circuit is “[u]nder the APA, [where] courts ‘hold unlawful and set aside agency action ... found to be ... arbitrary, capricious, an abuse of discretion, or otherwise not in accordance with law.’” *Star Fruits S.N.C. v. United States*, 393 F.3d 1277, 1282 (Fed. Cir. 2005).

Unlike the situation at the time of *Wakefield* where there was an essentially *de novo* review by the CCPA of all Patent Office rejections, today there is a substantial evidence test that would govern any appeal from an undue multiplicity rejection: The applicant would have to demonstrate that there was an absence of substantial evidence for the undue multiplicity rejection in order to prevail. Unlike a *rejection* of claims where the patent applicant can go back and forth with the examiner through a request for reconsideration to the examiner and then an appeal, in the case of a *requirement* of this nature, the only avenue for redress is through a petition to the Director.

Whether an “undue multiplicity” rejection is open to the Office is unclear as seen from *Tafas v. Doll*, 559 F.3d 1345 (Fed. Cir. 2009)(Prost, J.), *appeal dismissed*, *Tafas v. Kappos*, 586 F.3d 1369 (Fed. Cir. 2009). There, the Court said:

“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 (CCPA 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.’). However, we need not decide whether the USPTO may impose a limit on the number of claims an applicant can pursue[.]”).

Tafas v. Doll, 559 F.3d at 1363.

Case law going beyond *Shaw Indus. Grp., Inc. v. Automated Creel Sys., Inc.*, ___ F.3d ___ (Fed. Cir. Mar. 23, 2016)(Moore, J.), and *Hyatt v. U.S. Patent & Trademark Office*, 797 F.3d 1374, 1376 (Fed. Cir. 2015), also supports the right of the Office to limit consideration of claims to a reasonable number.

While the predecessor Court of Customs and Patent Appeals at the time of *Wakefield* had a decidedly pro-applicant approach there is today a far more balanced judiciary which has itself tackled the problem of patents with too many claims. The “representative claims” approach in *In re Katz Interactive Call Processing Patent Litig.*, 639 F.3d 1303, 1312 (Fed. Cir. 2011), perhaps best manifests this attitudinal evolution at the Federal Circuit:

In the *Katz* case, the Federal Circuit approved a “Representative Claims” approach that puts the burden on the patentee to designate a limited number of claims for a litigation. The Patent Office certainly has the rulemaking power to use the *Katz* solution in Inter Partes Review, as long as it provides flexibility to consider additional claims that “present[] unique issues.” *Katz*, 639 F.3d at 1312.

As the Court noted in *Katz*:

“We reject [the patentee]’s due process argument. [The patentee] has not shown that the claim selection procedure the district court employed was inadequate to protect [the patentee]’s rights with respect to the unasserted claims. [We assume without deciding that [the patentee] has a separate property right in each claim of each asserted patent.] To make out a due process claim, [the patentee] must demonstrate that the district court’s claim selection procedure risked erroneously depriving it of its rights and that the risk outweighed the added costs associated with a substitute procedure. *See Mathews v. Eldridge*, 424 U.S. 319, 335 (1976).

“[The patentee] argues that it was improper for the district court to impose any burden on it to make a showing that any of the unselected claims raised issues of infringement or invalidity that were not duplicative of the issues raised by the selected claims. According to [the patentee], the court should have required the appellees to bear the burden to show that issues were duplicative; absent such a showing, [the patentee] contends, the unasserted claims should have been expressly excluded from the judgments entered in this case.

“* * * Burden allocation... is a tool ‘intended progressively to sharpen the inquiry into the elusive factual question[s]’ in a case. *See Tex. Dep’t of Cmty. Affairs v. Burdine*, 450 U.S. 248, 255 n. 8 (1981). When the claimant is in the best position to narrow the dispute, allocating the production burden to the claimant will benefit the decision-making process and therefore will not offend due process unless the burden allocation unfairly prejudices the claimant’s opportunity to present its claim.