

# FIRST TO FILE PATENT DRAFTING: A Practitioner's Guide

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Excerpt

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Case Law Last Updated May 29, 2016

This version: June 16, 2016

[FirstToFilePatentDraftingJune16.pdf](#)

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§ 2[e][2] Presenting Numerous Claims should not be a Goal

A central theme of this monograph is that the patent application should present a simple, easy to examine set of claims which is best facilitated by having as many claims as *necessary* to represent the business interests of the applicant. A simple approach gives the Examiner sufficient time to do a complete examination.

Professor Crouch provides the most extreme examples of presentation of a large number of claims in his tabulation:

<b>Top Ten Patents: Most Claims Per Patent (2013)*</b>			
Rank	Patent No.	Claims	Assignee
1	8,401,902	404	Function Media LLC
2	8,404,693	372	Adolor Corporation
3	8,437,669	322	Canon
4	8,562,424	319	IGT
5	8,585,593	243	University of Virginia
6	8,389,958	223	Immunolight
7	8,599,764	222	Qualcomm
8	8,598,516	220	Individuals (Kazakhstan)
9	8,355,982	220	VeriFone
10	8,538,123	213	Cummins-Allison

\* Dennis Crouch, *Jumbo Patents of 2013*, PATENTLY-O (Jan. 20, 2014)

In the first instance, it is difficult to comprehend precisely how the inventor’s interests are best served by presentation of literally hundreds of claims. This is completely contrary to the philosophy of a holistic presentation. *See* § 1[b], *A Holistic Approach to the New Patent Law*.

But, if a significant minority of applicants file too many claims for a reasonable, complete examination, the question must be asked: Is it time to dust off the “undue multiplicity” ground of rejection that the PTO seems reluctant to utilize to control presentation of too many claims?

## § 2[e][2][A] Practical, Minimalist Claim Approach

It is obvious that one should file as many claims as *necessary* to meet the *business needs* of the applicant, which is a dominant theme of this monograph, but otherwise the number of claims should be kept to the minimum. These points are dealt with elsewhere. The greater the number of claims the greater the likelihood of difficulties one has in drafting claims that particularly point out and distinction claim the invention. See § 11[a][3], *A Simple, Easy to Examine Patent Application*; § 11[a][7], *Minimum Number of Claims*; § 13[e][3] *A Reasonable Number of Subclaims*.

## § 2[e][2][B] “Undue Multiplicity” as Basis for Rejection

Filing too many claims should be avoided.

There are many applicants who routinely file twenty claims in a patent application, simply because there is no fee penalty for filing as many claims as an applicant wants, up to twenty, without an additional filing fee. Recently the most popular patent blog trumpeted a “top ten” list of the best patent firms judged by how many independent claims were obtained in their patents versus the number of originally filed claims. See the IPWatchdog Claims Study”, James Cosgrove, *The Top 10 Patent Law Firms that Lose the Fewest Independent Claims*, IPWatchdog (October 20, 2015). Responsive to this study, IPWatchdog posted various comments echoing the *ex parte* practitioner viewpoint that focused upon the number of claims presented in an application : “Some clients have large budgets that support paying a whole lot of independent-claim fees. If they choose to start with many claims and then whittle them down during examination, that’s a valid client strategy. \*\*\* *Law firms* have nothing to do with the strategies, budgets, and priorities of different applicants. \*\*\* Chemical patents tend to involve a lot of independent claims for distinct species.” *Id.* (quoting comment of David Stein (October 20, 2015)). Earlier, a lead instructor of the Practising Law Institute’s patent drafting course explained that “investors love patents. Sophisticated investors know that if you have one patent you can get more from the disclosure by filing continuations and continuing to milk the disclosure for as many claims as you can eventually get the Patent Office to issue.” Gene Quinn, *Preparing for Future*

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*Litigation Before Your Patent Issues*, IPWatchdog.com (October 26, 2010). One commentator said that an “application should be “replete with as many claims as we think we might be able to get away with.” Stan E. Delo, *Comment on IPWatchdog* (January 8, 2011).

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”.

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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

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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

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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.”

### § 2[e][2][C] *Manual* Support for “Undue Multiplicity” as Basis for Rejection

Despite the apparent reluctance of the Patent Office to reject claims on the basis of “undue multiplicity”, the *Manual* sets forth the apparent viability of a such a rejection:

“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 (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 (CCPA 1969). Undue multiplicity rejections based on 35 U.S.C. 112(b) ... should be applied judiciously and should be rare.

“\* \* \*. If applicant [does not comply with a] 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.”

MPEP § 2173.05(n), *Multiplicity* (R-11)(2013).