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MAILED
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OFFICE OF PETITIONS

In re Application of
Gilbert P. Hyatt
Application No. 06/848,017
Filed: April 3, 1986
Attorney Docket No. 307

ON PETITION

BACKGROUND

This is one of nearly 400 applications sharing one of eleven identical specifications, most of which were filed shortly before the June 8, 1995 deadline for "Pre-GATT" treatment of applications. During prosecution of these applications, Petitioner added thousands of claims, multiplying the claims in each application so that approximately 115,000 pending claims are directed to one of the eleven specifications. Petitioner asserts priority for those claims to a large number of different specifications with widely varying priority dates. In order to identify the appropriate priority date for each claim and clarify the scope of the claims, a requirement under 35 USC 131, 37 CFR 1.75, and 37 CFR 1.105 ("Requirement") was mailed in the instant application on September 16, 2013. *See Hyatt v. USPTO*, No. 13-cv-1535, 2014 WL 2446176, at *1-2 & 5-6 (E.D. Va. May 29, 2014).

A petition ("Initial Petition") requesting supervisory review of the Requirement was filed October 28, 2013.

A petition decision by the Technology Center Director ("TC Director's decision") dismissing the October 28, 2013 petition was mailed January 10, 2014.

A petition for supervisory review of the Technology Center Director's petition decision of was submitted February 28, 2014.

A response to the Requirement was filed March 17, 2014.

A replacement petition for supervisory review of the Technology Center Director's petition decision ("Petition" or "Pet.") was submitted on May 12, 2014.

This is a decision on the Petition under 37 CFR 1.181(a)(1) and (3), requesting that the Director exercise his supervisory authority to review the TC Director's decision which refused to withdraw the Requirement under 35 USC 131, 37 CFR 1.75, and 37 CFR 1.105.

The Petition under 37 CFR 1.181(a)(1) and (3) is granted insofar as the decision has been reviewed, but is otherwise **DENIED**.

STATUTE, REGULATION, AND PROCEDURES

35 U.S.C. 2(b)(2) states:

> The Office—
> (2) may establish regulations, not inconsistent with law, which—
> (A) shall govern the conduct of proceedings in the Office[.]

35 U.S.C. 112 (pre-AIA) states in part:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.
>
> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

35 U.S.C. 134 states:

> (a) PATENT APPLICANT.— An applicant for a patent, any of whose claims has been twice rejected, may appeal from the decision of the primary examiner to the Board of Patent Appeals and Interferences, having once paid the fee for such appeal.

37 CFR 1.75(b) states:

> More than one claim may be presented provided they differ substantially from each other and are not unduly multiplied.

37 CFR 1.105 (pre-AIA) states:

> (a) (1) In the course of examining or treating matter in a pending or abandoned application filed under 35 U.S.C. 111 or 371 (including a reissue application), in a patent, or in a reexamination proceeding, the examiner or other Office employee may require the submission, from individuals identified under § 1.56(c), or any

assignee, of such information as may be reasonably necessary to properly examine or treat the matter, for example:

(i) Commercial databases: The existence of any particularly relevant commercial database known to any of the inventors that could be searched for a particular aspect of the invention.

(ii) Search: Whether a search of the prior art was made, and if so, what was searched.

(iii) Related information: A copy of any non-patent literature, published application, or patent (U.S. or foreign), by any of the inventors, that relates to the claimed invention.

(iv) Information used to draft application: A copy of any non-patent literature, published application, or patent (U.S. or foreign) that was used to draft the application.

(v) Information used in invention process: A copy of any non-patent literature, published application, or patent (U.S. or foreign) that was used in the invention process, such as by designing around or providing a solution to accomplish an invention result.

(vi) Improvements: Where the claimed invention is an improvement, identification of what is being improved.

(vii) In Use: Identification of any use of the claimed invention known to any of the inventors at the time the application was filed notwithstanding the date of the use.

(viii) Technical information known to applicant. Technical information known to applicant concerning the related art, the disclosure, the claimed subject matter, other factual information pertinent to patentability or concerning the accuracy of the examiner's stated interpretation of such items.

(2) Where an assignee has asserted its right to prosecute pursuant to § 3.71(a) of this chapter, matters such as paragraphs (a)(1)(i), (iii), and (vii)of this section may also be applied to such assignee.

(3) Requirements for factual information known to applicant may be presented in any appropriate manner, for example:

(i) A requirement for factual information;

(ii) Interrogatories in the form of specific questions seeking applicant's factual knowledge; or

(iii) Stipulations as to facts with which the applicant may agree or disagree.

(4) Any reply to a requirement for information pursuant to this section that states either that the information required to be submitted is unknown to or is not readily available to the party or parties from which it was requested may be accepted as a complete reply.

(b) The requirement for information of paragraph (a)(1) of this section may be included in an Office action, or sent separately.

(c) A reply, or a failure to reply, to a requirement for information under this section will be governed by §§ 1.135 and 1.136.

37 CFR 1.181 states in part:

> (a) Petition may be taken to the Director:
> (1) From any action or requirement of any examiner in the ex parte prosecution of an application, or in ex parte or inter partes prosecution of a reexamination proceeding which is not subject to appeal to the Board of Patent Appeals and Interferences or to the court;
> (2) In cases in which a statute or the rules specify that the matter is to be determined directly by or reviewed by the Director; and
> (3) To invoke the supervisory authority of the Director in appropriate circumstances. For petitions involving action of the Board of Patent Appeals and Interferences, see § 41.3 of this title.

MPEP 704.11 states:

> Information which may be required under 37 CFR 1.105 is that information reasonably necessary to properly examine or treat a matter in a pending or abandoned application filed under 35 U.S.C. 111 (including a reissue application), in a pending or abandoned application that has entered the national stage under 35 U.S.C. 371, in a patent, or in a reexamination proceeding.
>
> There must be a reasonable basis for the information required that would aid in the examination of an application or treatment of some matter. A requirement for information under 37 CFR 1.105 places a substantial burden on the applicant that is to be minimized by clearly focusing the reason for the requirement and the scope of the expected response. Thus, the scope of the requirement should be narrowly defined, and a requirement under 37 CFR 1.105 may only be made when the examiner has a reasonable basis for requiring information.
>
> The terms "factual" and "facts" are included in 37 CFR 1.105 to make it clear that it is facts and factual information, that are known to applicant, or readily obtained after reasonable inquiry by applicant, that are sought, and that requirements under 37 CFR 1.105 are not requesting opinions that may be held or would be required to be formulated by applicant. Where the factual information requested related to the subject application, and details thereof, applicant would be expected to make a reasonable inquiry under the circumstances to find the factual information requested (37 CFR 11.18(b)(2)). Applicant need not, however, derive or independently discover a fact, such as by experimentation, in response to a requirement for information. The purpose of 37 CFR 1.105 is to improve patent quality, and render better decisions, and not to put applicants in jeopardy of meeting their duties of candor and good faith in their replies to a requirement for information.

INFORMATION REASONABLY NECESSARY FOR FINDING PRIOR ART

The criteria stated in 37 CFR 1.105 for making a requirement for information is that the information be reasonably necessary to the examination or treatment of a matter in an application. The information required would typically be that necessary for finding prior art or for resolving an issue arising from the results of the search for art or from analysis of the application file. A requirement for information necessary for finding prior art is not a substitute for the examiner performing a search of the relevant prior art; the examiner must make a search of the art according to MPEP §§ 704.01 and 904 – 904.03.

The criteria of reasonable necessity is generally met, e.g., where:

(A) the examiner's search and preliminary analysis demonstrates that the claimed subject matter cannot be adequately searched by class or keyword among patents and typical sources of non-patent literature, or
(B) either the application file or the lack of relevant prior art found in the examiner's search justifies asking the applicant if he or she has information that would be relevant to the patentability determination.

The first instance generally occurs where the invention as a whole is in a new area of technology which has no patent classification or has a class with few pieces of art that diverge substantially from the nature of the claimed subject matter. In this situation, the applicant is likely to be among the most knowledgeable in the art, as evidenced by the scarcity of art, and requiring the applicant's information of areas of search is justified by the need for the applicant's expertise.

The second instance generally occurs where the application file, or other related applications or publications authored by the applicant, suggests the applicant likely has access to information necessary to a more complete understanding of the invention and its context. In this situation, the record suggests that the details of such information may be relevant to the issue of patentability, and thus shows the need for information in addition to that already submitted by the applicant.

MPEP 704.11(a) states, in relevant part:

37 CFR 1.105(a)(1)(i)-(viii) list specific examples of information that may be reasonably required. Other examples, not meant to be exhaustive, of information that may be reasonably required for examination of an application include:
(R) Clarification of the correlation and identification of what structure, material, or acts set forth in the specification would be capable of carrying out a function recited in a means or steps plus function claim limitation. If it is not apparent to the examiner where in the specification and drawings there is support for a particular claim limitation reciting a means to accomplish a function, and if an inquiry by the examiner for such support is met by a stated lack of knowledge thereof by the applicant, the examiner could very well conclude that there is no such support and make appropriate rejections under, for example, .35 U.S.C.

112(a) or pre-AIA 35 U.S.C. 112, first paragraph (written description) and 35 U.S.C. 112(b) or pre-AIA 35 U.S.C. 112 , second paragraph
(S) Interrogatories or Stipulations.

(1) Of the common technical features shared among all claims, or admission that certain groups of claims do not share any common technical features,
(2) About the support found in the disclosure for means or steps plus function claims (35 U.S.C. 112(f) or pre-AIA 35 U.S.C. 112, paragraph 6),
(3) Of precisely which portion(s) of the disclosure provide the written description and enablement support for specific claim element(s),
(8) Of support for added limitations in an amended claim,

MPEP 706.01 states:

> The refusal to grant claims because the subject matter as claimed is considered unpatentable is called a "rejection." The term "rejected" must be applied to such claims in the examiner's action. If the form of the claim (as distinguished from its substance) is improper, an "objection" is made. An example of a matter of form as to which objection is made is dependency of a claim on a rejected claim, if the dependent claim is otherwise allowable. See MPEP § 608.01(n). The practical difference between a rejection and an objection is that a rejection, involving the merits of the claim, is subject to review by the Patent Trial and Appeal Board, while an objection, if persisted, may be reviewed only by way of petition to the Director of the USPTO.
>
> Similarly, the Board will not hear or decide issues pertaining to objections and formal matters which are not properly before the Board. These formal matters should not be combined in appeals to the Board.

MPEP 2173.05(n) states:

> 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) or pre-AIA 35 U.S.C. 112, second paragraph, 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) or pre-AIA 35 U.S.C. 112, second paragraph, should be applied judiciously and should be rare.

If an undue multiplicity rejection under 35 U.S.C. 112(b) or pre-AIA 35 U.S.C. 112, second paragraph, 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) or pre-AIA 35 U.S.C. 112, second paragraph. 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) or pre-AIA 35 U.S.C. 112, second paragraph, 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) or pre-AIA 35 U.S.C. 112, second paragraph, 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 Trail and Appeal Board.

Also, it is possible to reject one claim over an allowed claim if they differ only by subject matter old in the art. This ground of rejection is set forth in Ex parte Whitelaw, 1915 C.D. 18, 219 O.G. 1237 (Comm'r Pat. 1914). The Ex parte Whitelaw doctrine is restricted to cases where the claims are unduly multiplied or are substantial duplicates. *Ex parte Kochan*, 131 USPQ 204, 206 (Bd. App. 1961).

OPINION

In the instant application, the examiner issued a Requirement that included three substantive provisions: "[5a.] select a reasonable number of claims, [5b.] identify the earliest applicable priority date and any reliance on incorporation by reference for the selected claims, and [5c.] provide a complete copy of the current claims." Applicant filed a reply to the Requirement, including an apparently complete copy of the current claims, and subsequently the Initial Petition under 37 CFR 1.181 for supervisory review of the Requirement. The Initial Petition was dismissed in the TC Director's Decision.

Petitioner then filed the Replacement Petition under 37 CFR 1.181(a)(1) and (3) requesting a review of the TC Director's Decision. (Pet. at 1). Petitioner also requests that instructions be given to the TC Director to cease reframing issues on petition. (Pet. at 5). The *gravamen* of Petitioner's complaint seems to be that the TC Director's Decision refused to direct the examiner to: (1) withdraw with prejudice the Requirement (despite Petitioner's reframing of the issue, Petitioner should note that the requirement has three parts and is not, in its totality, a 37 CFR 1.105 requirement) (Pet. at 41-42, VI. 1, 7, 8, 9, 10, 11, 12, 13, 14); (2) refrain from imposing

penalties for failure to comply with information collection requirements (Pet. at 41-42, VI. 15, 16); and (3) cease and desist from issuing collection requirements Petitioner believes are unlawful or contain unapproved information collection requirements, purportedly for lack of a valid OMB Control Number (Pet. at 41-42, VI. 2, 3, 4, 5, 6) .

In support of why this relief should have been granted, Petitioner lodges a host of arguments under Sections (II), (III), (IV), and (V) of his petition; this Decision is generally organized to correspond to those Sections. Ultimately, none of Petitioner's arguments demonstrates error in the TC Director's decision, or otherwise demonstrates entitlement to the relief sought. [1]

I. The TC Director's Decision did not ignore Petitioner's arguments.

Petitioner initially complains that the TC Director's December 2013 Decision "errs" because it decides issues that Petitioner did not raise. *See* Pet. at 5-6 (Section II(A)). 37 CFR 1.181 provides that a petition may be taken "[f]rom any action or requirement of any examiner in the ex parte prosecution of an application, or in ex parte or inter partes prosecution of a reexamination proceeding which is not subject to appeal to the Board of Patent Appeals" and is not a forum for general complaints about USPTO practices or procedures. Thus, Petitioners' complaint that the TC Director's Decision addresses issues not raised in Petitioner's previous petition is not a grievance to be considered under 37 CFR 1.181. Moreover, if Petitioner believes that the TC Director's Decision addressed arguments he did not make, then that portion of the Decision should be of no concern to Petitioner.

To the extent Petitioner alleges the TC Director's Decision failed to address issues raised by the Petitioner's first petition, that complaint is not well-taken. Review of the TC Director's Decision does not indicate that it failed to address, or misrepresented, any issue that Petitioner properly raised with sufficient clarity such that a response was both warranted and possible. Accordingly, only the issues concerning any action or requirement of the examiner will be treated in this decision.

II. The Paperwork Reduction Act does not prohibit the USPTO from making the Requirement and does not shield Petitioner from consequences of non-compliance.

Petitioner argues that the Requirement lacks a valid OMB Control Number and is therefore an unapproved collection of information. *See* Pet. at 6 -14 (Section III). The Paperwork Reduction Act ("PRA"), 44 U.S.C. § 3501, *et seq.*, is inapplicable to the Office's Requirement under 35 USC § 131 and 37 CFR 1.75(b) and 1.105. ("Requirement"). The PRA was enacted to minimize the paperwork burden on individuals and businesses imposed by the Federal government while ensuring the greatest public benefit of information collected through that paperwork. *See* 44 U.S.C. § 3501. The Requirement is not subject to the PRA because the Requirement itself does not constitute a "collection of information" as that term is defined by the

[1] Despite Petitioners' discussion of reframing issues, he has not requested relief that parallels the relief requested in the initial petition. The present petition lists 16 items in "Relief Requested", the majority of which are requests for policy statements from the USPTO and not supervision of the action of the examiner.

PRA and the facts sought in response to the Requirement do not constitute "information" as defined by the PRA.

As Technology Center ("TC") Director Hafiz correctly explained, the Requirement is not a "collection of information" subject to the PRA. *See* TC Director's Decision at 2-3. The PRA applies only to "collection[s] of information," which the Act explicitly defines as "the obtaining, causing to be obtained, soliciting, or requiring the disclosure to third parties or the public of facts or opinions, . . . calling for . . . answers to *identical questions posed to, or identical reporting or recordkeeping requirements imposed on, ten or more persons* . . . ." *See* 44 U.S.C. § 3502(3) (emphasis added); *see also* 5 C.F.R. § 1320(c) (defining "collection of information" as only those collections imposing identical requirements on ten or more persons). The Office of Management and Budget ("OMB") further has explained that "facts or opinions that are . . . addressed to a single person" are *not* collections of information. *See* Mem. from Cass Sunstein, Administrator, OMB, to the Heads of Executive Depts. and Agencies, and Independent Regulatory Agencies (Apr. 7, 2010), at 3 (available at http://www.whitehouse.gov/sites/default/files/omb/assets/inforeg/PRAPrimer_04072010.pdf). Here, the Requirement consists solely of a series of questions posed *only* to "a single person," Mr. Hyatt. And, the questions pertain specifically to issues *only* in *Mr. Hyatt's* applications and the unique issues created by *his* applications.

Petitioner argues that the Requirement must be subject to the PRA because "[e]lsewhere, the USPTO routinely acknowledges that its information requirements are covered by the PRA" and because Rule 105 and amendments to Rule 105 were implemented simultaneous with other rules that contained collections of information subject to the PRA. *See* Pet. at 6, 13-14. Neither argument is availing. The USPTO seeks OMB review of information collections subject to the PRA's requirements. *See, e.g.*, OMB Control Nos. 0651-0031, 0651-0032. The USPTO does not seek OMB review of individualized office actions or requests for facts or opinions that are not covered by the PRA. Rule 105(a) requirements are an example of a request for facts. Examiners routinely contact applicants to clarify particular issues in applications, and because each request for clarification is unique to the specific applicant, none of these requests is subject to the PRA. As such, the Requirement does not constitute a "collection of information" as defined by the PRA, and the PRA is wholly inapplicable to it.

Moreover, as Director Hafiz correctly explained, even if the PRA could be construed to apply to the Requirement, the response it seeks would not constitute "information" as defined by the PRA. *See* TC Director's Decision at 3. As its implementing regulations explain, "'Information' does not generally include . . . [f]acts, or opinions obtained or solicited through nonstandardized follow-up questions designed to clarify responses to approved collections of information." *See* 5 C.F.R. § 1320.3(h)(9). Here, as Petitioner readily admits, the USPTO has an approved collection of information for patent applications and application processing, such that the information petitioner submits regarding his application constitutes a "response" to an approved collection. *See* Initial Petition at 3; *see also* OMB Control Number 0651-0032; OMB Control Number 0651-0031. The Requirement asks Petitioner to clarify the responses he provided in his initial applications, specifically to explain how the information he provided in those approved collections is not duplicative. *See* Requirement at Section 4 (identifying examples of overlapping claims for benefit of priority, similar or identical claims and overlapping portions of

the specification in others of the 11 roughly distinct specifications.). Thus, despite Petitioner's allegation that the USPTO does not "describe [the Requirement] as a 'follow-up' or elaboration of information that was required in the initial patent application," the Requirement explicitly asks Petitioner "follow-up questions designed to clarify [his] responses" in his patent applications. *See* Pet. at 11-12 (emphasis removed); Requirement at 5-27. As such, the Requirement does not seek "information" as defined by the PRA.[2]

III. Requirement 5(a) is consistent with Rule 75, current USPTO policy, and legal precedent; any resulting rejection will ultimately be appealable to the Board.

First, Petitioner mistakenly and repeatedly reframes Requirement 5(a) as a "Rule 105 Directive." However, Requirement 5(a) is an undue multiplicity requirement related to 37 CFR § 1.75(b) rather than a 37 CFR § 105 requirement.

Second, Petitioner argues that selecting a reasonable number of claims consistent with 37 CFR § 1.75(b) per Requirement 5(a) is allegedly unlawful and unenforceable. *See* Pet. at 14-34 (Section IV). That is incorrect. The examiner acted within his authority to make Requirement 5(a), as the USPTO has a defined policy with respect to claim multiplicity. *See* 37 CFR 1.75(b), *supra*. *See also* MPEP 2173.05(n), *supra*. *See* Mem. from Stephen G. Kunin, Deputy Commissioner for Patent Examination Policy, Rejections Based on Undue Multiplicity (March 18, 2002) ("Kunin Memo") (available at **http://www.uspto.gov/web/offices/pac/dapp/opla/documents/multiplicity.pdf**).

Both the Requirement itself (*see, e.g.*, Section 6) and the TC Director's Decision (*see, e.g.*, Dec. at 4-5) explained that Requirement 5(a) reflects Rule 1.75(b), and the USPTO policy underlying it; that regulation and policy, in turn, reflect valid exercise of the Office's inherent authority under 35 U.S.C. §§ 2 and 131 to govern the prosecution of patent applications through reasonable requirements. *See also* MPEP § 2173.05(n); *In re Bogese*, 303 F.3d 1362 (Fed. Cir. 2002); *Hyatt v. USPTO*, No. 1:13-cv-1535, 2014 WL (E.D.Va. May 29, 2014).
Similarly, as both the Requirement and the TC Director's Decision explain, governing legal precedent supports the USPTO's ability to police abusive claim practices through the so-called "undue multiplicity" doctrine. *See, e.g.*, *Carlton v. Bokee*, 84 U.S. 463, 472 (1873) (patent is "void" where "by ambiguity and a needless multiplication of nebulous claims [it] is calculated to deceive and mislead the public"); *Victor Talking Machine Co. v. Thomas A. Edison, Inc.*, 229 F. 999 (2nd Cir. 1915) (Hand, L .) (opining that courts should discourage the practice that permitted 48 claims on the "simple and perfectly obvious" invention at issue, and lamenting that "[i]t takes the scholastic ingenuity of a Saint Thomas with the patience of a yogi to decipher their meaning

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[2] Petitioner also argues, without reference to any authority, that 5 C.F.R. § 1320.3(h)(9) applies only to "clerical" clarifications. Neither the language of the regulation, the history of its implementation, nor any plausible understanding of its purpose, supports Petitioner's interpretation. *See* 5 C.F.R. § 1320.3(h)(9); Controlling Paperwork Burdens on the Public: Regulatory Changes Reflecting Recodification of the Paperwork Reduction Act, 60 Fed. Reg. 44978-01 (Aug. 29, 1995); Controlling Paperwork Burdens on the Public, 48 Fed. Reg. 13666-01, 13677 (Mar. 31, 1983) (originally including the exclusion in 5 C.F.R. § 1320.3(h)(9) as 5 C.F.R. § 1320.7(k)(9) and noting that its inclusion was "self-explanatory").

as they stand."); *In re Chandler*, 319 F.2d 211, 225 (CCPA 1963); *In re Flint*, 411 F.2d 1353, 1357 (CCPA 1969) (stating that "principles applicable to [question of undue multiplication] are well established and were stated by this court in *In re Chandler*, 319 F.2d 211, 50 CCPA 1422"); *In re Chandler*, 254 F.2d 396, 398-400 (CCPA 1958). Thus, the examiner will not be instructed to withdraw or otherwise modify Requirement 5(a).

To the extent that Petitioner seeks review of the application of the undue multiplicity doctrine to facts of his particular patent application, such review is not available by petition but is reserved for review by the Patent Trial and Appeal Board. *See* TC Director Dec. at 5. As stated in MPEP 2173.05(n), the selection of claims for multiplicity purposes as required by Requirement 5(a) is a precursor to examination of the selected claims on their individual merits and a rejection of all claims under 35 USC 112, second paragraph.[3] Thus, while Petitioner creatively drafts his challenge as a petitionable matter (seeking to withdraw the requirement of an Office action) under 37 CFR 1.181, Petitioner is actually seeking review of the examiner's application of the undue multiplicity doctrine to the facts of his case, and, more specifically, any actual or prospective rejection under § 112 resulting from Requirement 5(a). Petitioner's artful pleading will not be permitted to convert subject matter that is subject to appeal to the Board (and further federal judicial review) into subject matter that is reviewable on petition. 37 CFR 1.181 makes clear that matters subject to appeal to the Board are not petitionable. Issues relating to the merits of a patentability rejection are appealable to the Board, rather than petitionable to the Director. *See* 35 U.S.C. § 134; MPEP §§ 706.01 and 1201. The Board has jurisdiction over the examiners' rejections and rationale in support of these rejections, and the examiners are bound by the decisions of the Board. *See In re Loehr*, 500 F.2d 1390 (CCPA 1974). The issue of whether a rejection made by the examiner sets forth a *prima facie* rejection and the issue of whether the examiner sets forth sufficient reasoning to support a rejection are directed to the merits of the examiner's rejection, which have been held to be appealable matters rather than petitionable matters. *See e.g., Boundy v. U.S. Patent & Trademark Office*, 73 USPQ2d, 1471 (E.D. Va. June 2004); *Stagner v. U.S. Patent and Trademark Office,* 8 USPQ2d 1173, 1174 (D. Kan 1988) (court lacked jurisdiction since "applicant must first present his claims to the Board of Patent Appeals prior to resort to the courts"), further opinion, 11 USPQ2d 1553, 1556 (D. Kan. 1989), aff'd, 14 USPQ2d 1671 (Fed. Cir. 1990). It is well settled that the Director will not, on petition, usurp the functions or impinge upon the jurisdiction of the Board. *See In re Dickinson*, 299 F.2d 954, 958 (CCPA 1962); *Bayley's Restaurant v. Bailey's of Boston, Inc.*, 170 USPQ 43, 44 (Comm'r Pat. 1971); *In re Oku*, 25 USPQ2d 1155, 1157 (Comm'r Pat. 1992). Furthermore, if such a review is permitted pursuant to a petition under 37 CFR 1.181, Petitioner would be permitted to seek review of a non-final Office action from the Director and courts as a petitionable matter, which would be contrary to the legal precedents. *See Boundy v. US. Patent & Trademark Office*, 73 USPQ2d at 1471 (Individual examiners' actions are not final actions subject to review as a final agency action under Administrative Procedure Act, 5 U.S.C. 701-06). Accordingly, any question about whether the examiner has set forth sufficient reasoning to support application of the undue multiplicity doctrine as reflected in any related rejection under 35 U.S.C. § 112, ¶ 2 is an appealable matter to the Board, and is not reviewable on petition. *See*

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[3] Petitioner's complaint that the TC Director Decision erred in discussing 35 U.S.C. § 112(b) because no rejection under that provision was included in the Requirement (Pet. at 6 (Section IIB)) ignores that Requirement 5(a) is the precursor to a rejection under § 112(b).

Kunin Memo (explaining the Office procedure for policing undue claim multiplicity "preserves applicant's right to have the rejection on undue multiplicity reviewed by the [Patent Trial and Appeal Board]").

Despite Petitioner's statements otherwise, the 37 CFR 1.75(b) Requirement does not result in a refusal to examine or place an arbitrary limit on the number of claims. *See* Pet at 15-17, 25, 30, 34. All of the claims have or will be treated. As such an examination of the application has or will be made. 35 U.S.C. 131 only requires that "The Director shall cause an examination to be made"; it does not specify how that examination shall be made. As such, the TC Director and the examiner are utilizing the rules and the procedures set forth in the MPEP and as reflected in valid case law to ensure effective examination of the application. Additionally, there has been no change of the rules on the fly, or *ad hoc* rulemaking. *See* Pet at 25-26. 37 CFR 1.75(b) has been a validly promulgated regulation since March 1, 1949 (13 FR 9575, 9580, Dec. 31, 1948). *See* MPEP 706.03(l) (Edition 1.0, November 1949). Contrary to Petitioner's argument, the *Tafas* litigation does not preclude Requirement 5(a). Pet. at 19-20. As the TC Director correctly explained in his Decision (*see* TC Dir. Dec. at 5), the *Tafas* litigation is inapposite to this procedural requirement, which is based upon undue multiplicity and § 112 as applied to the particular facts of Petitioner's application. Indeed, for all the emphasis that Petitioner places on the district court decision in *Tafas*, the court acknowledged that its holding regarding the proposed rulemaking at issue there did not infringe upon the USPTO's ability to "reject claims on a case-by-case basis for undue multiplicity" under § 112. *Tafas v. Dudas*, 541 F. Supp. 2d 805, 816 (E.D. Va. 2008).

Nor has the examiner relied on ad hoc standards in issuing Requirement 5(a). *See* Pet. at 22-24, 32-33. The examiner has not acted in an arbitrary and capricious manner, but has comprehensively assessed the landscape of Petitioner's application scheme, and set forth reasons for the 37 CFR 1.75(b) Requirement that go well beyond simply citing the number of claims presented. Petitioner thus ignores the multiple factors analyzed by the examiner when he inaccurately states that Requirement 5(b) is based on "administrative convenience." Pet. at 23, 30. To the contrary, the factors considered by the examiner in making Requirement 5(a) reflect legal precedent. *See, e.g.*, *Chandler*, 254 F.2d at 399; *Chandler*, 319 F.3d at 225 (indicating that "rule of reason should be practiced and applied on the basis of the relevant facts and circumstacnes of each individual case"). Petitioner does not attempt to explain how any of the numerous factors considered by the examiner were contrary to law or policy, or otherwise inappropriate.

While Petitioner complains that the numerical limit of 600 claims that Requirement 5(a) requests the Petitioner to select within each family of applications is arbitrary, there is no hard-and-fast threshold for when the number of claims violates Rule 1.75(b) and the undue multiplicity doctrine. The Requirement lays out a reasonable basis for the number selected. As a practical matter, the notion that 600 claims might be an insufficient number to adequately capture the inventions described in one specification is difficult to fathom. Nonetheless, Requirement 5(a) permits Petitioner to explain why he needs more than 600 claims, thus providing Petitioner with more-than-adequate means to justify a larger number of claims.

Petitioner states that patent applications cannot be examined as a group (*See* Pet at 15). However, it is commonplace for the USPTO to consider more than one application at a time. Examples where this situation occurs is in a double patenting rejection under 35 U.S.C. 101 or an obviousness-type double patenting rejection. And given the unique overlapping nature of Petitioner's application scheme—where he has asserted thousands of claims across multiple applications, all allegedly supported by one common disclosure—it is difficult to see how the examiner can be faulted for considering each family of applications collectively. Ultimately, it is the Director, and not Petitioner, whom Congress has charged with determining whether a patent should issue from an application and how USPTO resources shall be allocated during examination. *See* 35 U.S.C. §§ 2, 131. Moreover, the Requirement is designed to result in an efficient and effective examination of the application; Petitioner's assistance in resolving the issues identified by the Requirement, and in succinctly responding to the merits of any subsequent rejections, will greatly assist the USPTO in finally resolving the ultimate question of whether Petitioner is entitled to receive a patent for any of the claimed inventions.

In short, the examiner will not be directed to withdraw Requirement 5(a), as it is consistent with current USPTO policy, regulations, and legal precedent. Review of any rejection under 35 U.S.C. § 112 resulting from further examination in light of Petitioner's response to the Requirement is by way of appeal to the Patent Trial and Appeal Board, as specified in MPEP 2173.05(n) and the Kunin Memo.

IV. Requirement 5(b) is an appropriate use of the authority described in 37 CFR § 1.105.

37 CFR § 1.105 provides that "[i]n the course of examining or treating matter in a pending or abandoned application filed under 35 U.S.C. 111 or 371 (including a reissue application), in a patent, or in a reexamination proceeding, the examiner or other Office employee may require the submission, from individuals identified under § 1.56(c), or any assignee, of such information as may be reasonably necessary to properly examine or treat the matter", and further states "[a] reply, or a failure to reply, to a requirement for information under this section will be governed by §§ 1.135 and 1.136."

Petitioner argues that Requirement 5(b) exceeds the examiner's authority under Rule 105. Requirement 5(b) asks Petitioner to identify the earliest described embodiment that provides written description support for the claims elected in response to Requirement 5(a); the Requirement explains that this information is necessary to examination in order to determine the correct priority date for the claims, which, in turn, permits proper identification of relevant prior art under 35 U.S.C. § 102. The requirement under 5(b) is thus relevant to patentability and thus the Office is authorized at least under 37 CFR 1.105 to require applicant to provide the information. *See Star Fruits S.N.C .v. United States*, 393 F.3d 1277, 1282 (Fed. Cir. 2005).

As set forth in *Star Fruits, supra,*

> 37 C.F.R. §1.105(a)(1), very expressly states that the Office, not the applicant, controls the scope of the requirement. Because the scope of information "reasonably necessary to properly examine or treat the matter" is broader than that information the applicant is duty-bound to provide under section 1.56, we are convinced that the Office can require

> the applicant to submit such information when it is known or readily available. The Office is clearly entitled to use section 1.105 to seek information that may support a rejection. Just as the applicant produces information it deems pertinent to patentability under section 1.56, the examiner is free to request information under section 1.105 that the examiner deems pertinent to the issue of patentability. In this case, the dispute over whether Star Fruits should be compelled to answer the examiner's Requirement For Information under section 1.105 boils down to a disagreement between Star Fruits and the examiner as to the significance of the information sought to the ultimate question of whether Star Fruits's application discloses patentable subject matter. The Director is charged with the duty of deciding whether a patent should issue from an application. To perform that duty, the law must be applied to the facts at hand in any application. That the person charged with enforcement of the law, here an examiner, may sometimes disagree with the applicant on the theory or scope of the law to be applied is hardly surprising. So long as the request from the examiner for information is not arbitrary or capricious, the applicant cannot impede the examiner's performance of his duty by refusing to comply with an information requirement which proceeds from the examiner's view of the scope of the law to be applied to the application at hand. To allow such interference would have the effect of forcing the Office to make patentability determinations on insufficient facts and information. **Such conduct inefficiently shifts the burden of obtaining information that the applicant is in the best position to most cheaply provide onto the shoulders of the Office and risks the systemic inefficiencies that attend the issue of invalid patents.** Examination under such circumstances is neither fair and equitable to the public nor efficient. Whether information sought by an examiner under section 1.105 could or would lead to a rejection of the application on its merits does not, for the reasons we have expressed, define the limits of the information that lawfully may be sought by an examiner. So long as there is some legitimate reason for seeking the information under section 1.105, the applicant has a duty to respond. If the examiner deems the information sought pertinent to the legal inquiry the examiner must conduct, the fact that the examiner's theory is incorrect is no ground on which the applicant may refuse to comply with a request for information. The Office is authorized under section 1.105 to require any information that is either relevant to patentability under any nonfrivilous legal theory, or is reasonably calculated to lead to such relevant information. (Emphasis added.)

As the TC Director correctly noted: (1) in order to determine the correct priority date for the claims and thus properly identify relevant prior art under 35 U.S.C. 102, requirement 5(b) requires Petitioner to identify the earliest described embodiment that provides written description support, 35 U.S.C. §112, first paragraph, for Petitioner's claims; (2) Petitioner is the applicant with intimate knowledge of the specification he prepared, claims he drafted and priority chain he advanced, making Petitioner uniquely positioned to efficiently supply the information; and (3) the requirement lists multiple and significant factors in support of Requirement 5(b). TC Dir. Dec. at 7-8. Accordingly, the Office has not been arbitrary and capricious in its 37 CFR § 1.105 requirement for this information.

Neither Rule 105 nor the MPEP forecloses Requirement 5(b). The plain language of Rule 105 does not limit the types of information that "may be reasonably necessary to properly examine or

treat the matter." MPEP § 704.11, despite Petitioner's arguments otherwise, does not limit the scope of information which is "reasonably necessary to properly examine or treat the matter." Therefore, as the TC Director correctly explained, under the totality of the circumstances (including the (1) complexity and overlapping nature of 399 pending applications, (2) the extraordinarily high number of claims totaling 115,000, (3) the number of priority documents, (4) the number of documents incorporated by reference, and (5) the number of specification pages), and the guidance given in MPEP 704.11 and 704.11(a), *supra*, the Examiner has followed appropriate procedures and has not been arbitrary and capricious. *See* TC Dir. Dec. at 7-8.

Nor does Petitioner identify how Requirement 5(b) violates Rule 105 or MPEP 704.11. As an initial matter, contrary to Petitioner's position, nothing in the Rule or MPEP limits when a Rule 105 request for information can be issued. (Pet. at 36). Nothing would be gained by artificially limiting when an examiner can ask for an applicant's assistance in evaluating patentability based solely upon when the examiner requests information. And as the TC Director correctly reasoned, the examiner adequately justified making his request. *See* TC Dir. Dec. at 8.

Petitioner's argument that Requirement 5(b) impermissibly seeks Petitioner's opinions rather than factual information is incorrect. (Pet. at 36). Petitioner still fails to explain how asking him—the alleged inventor of the asserted claims—to identify where **his** written description supports **his** claims such that he is entitled to a particular priority date, asks Petitioner for his "opinion." *See* TC Dir. Dec. at 7. Simply saying that the examiner seeks "opinion" information does not make it so.

Nor does Petitioner explain how the requested information "is not (and could not be) readily available." (Pet. at 36). Petitioner must have a basis for asserting that a particular claim is entitled to a particular priority date; that Requirement 5(b) asks Petitioner to provide that basis should not require any additional analysis by Petitioner (assuming he has a basis for asserting entitlement to the priority date in the first instance).

Thus, Petitoner's suggestion that he has no better knowledge of the specification, or of the relationship between the specification and the claims, than does the examiner defies common sense. Petitioner asserts "that information is no more "readily available" to Petitioner than to the USPTO – both have access to the same documents and both must work from the same documents". (Pet. at 36). Petitioner, as the inventor of the alleged inventions and drafter of the underlying specification, is the most knowledgeable individual about his claims and his specification. *See Hyatt v. Dudas*, 492 F3d 1365, 1370 (Fed. Cir. 2007) ("Since the applicant is 'in the best position to cheaply provide' information about the purported invention, the PTO's authority to shift the burden to obtain this information is crucial to ensure that the PTO is not 'mak[ing] patentability determinations on insufficient facts and information.'") (internal citations omitted).

Petitioner's position suggests that he has presented claims with no knowledge of the factual support for those claims in his specification. 37 CFR 11.18(b)(2)[5] mandates that any party

[5] Prior to September 2008 the same language was part of 37 CFR 10.18.

signing a paper submitted to the USPTO make an inquiry reasonable under all of the circumstances that the information in the paper is supported by an appropriate legal and factual basis.

> 37 CFR 11.18 (b) By presenting to the Office or hearing officer in a disciplinary proceeding (whether by signing, filing, submitting, or later advocating) any paper, the party presenting such paper, whether a practitioner or non-practitioner, is certifying that—
>
> > (2) To the best of the party's knowledge, information and belief, formed after an inquiry reasonable under the circumstances,
> >
> > > The paper is not being presented for any improper purpose, such as to harass someone or to cause unnecessary delay or needless increase in the cost of any proceeding before the Office;
> > > The other legal contentions therein are warranted by existing law or by a nonfrivolous argument for the extension, modification, or reversal of existing law or the establishment of new law;
> > > The allegations and other factual contentions have evidentiary support or, if specifically so identified, are likely to have evidentiary support after a reasonable opportunity for further investigation or discovery; and
> > > The denials of factual contentions are warranted on the evidence, or if specifically so identified, are reasonably based on a lack of information or belief.

Petitioner has presented thousands of claims, which should have been of differing scope, directed to a single specification that has been copied into multiple applications. It appears that an inquiry reasonable under the circumstances would have included a record of the factual basis for the support and filing date for each claim if this information exceeded Petitioner's immediate recall. It is unreasonable, and an apparent violation of 37 CFR 11.18 or its predecessors, for any party to file thousands of claims directed to a specification with no knowledge of the factual support in the specification as originally filed for those claims. Notably, although Requirement 5(b) invited Petitioner to provide "a particular explanation of why [the priority support under 35 USC 112] is unknown or not available"—the information that Petitioner must have possessed when he filed the claims – he chose not to provide it.

Lastly, Petitioner asserts that the USPTO must accept a reply that the information sought by a Rule 105 request such as Requirement 5(b) is "not reasonably available." Pet. at 38-41. That issue is premature unless and until Petitioner files such a response to Requirement 5(b) that the examiner refuses to accept, which has not occurred to date in this application. Further, as the TC Director explained, neither Rule 105 nor MPEP § 704.12(b) compels the USPTO to accept such a reply. TC Dir. Dec. at 9. To wit, the TC Director correctly reasoned that such a reply would seem dubious here given the nature of the information requested, and that the examiner was reasonable in putting Petitioner on notice of that fact in the Requirement itself:

> Here, it does appear that, absent compelling circumstances, an applicant for a patent should understand how all of his claims are supported in his specification and when the earliest presentation of his invention in a patent application occurred. Accordingly, the

> Examiner was justified in putting Petitioner on notice that absent justification from Petitioner, a response that the requested information is "not known or readily available" will not be accepted. Petitioner is advised to make a good faith attempt, including a reasonable inquiry, to obtain the requested information.

TC Dir. Dec. at 9.

CONCLUSION

A review of the record indicates that the Technology Center Director did not abuse his discretion or act in an arbitrary and capricious manner in his petition decision. The record establishes that the Technology Center Director had a reasonable basis to support his findings and conclusion.

The petition is granted to the extent that the decision of the TC Director has been reviewed; however, the petition is **denied** with respect to making any change to or otherwise disturbing the TC Director's Decision. The Examiner will not be directed to alter his Requirement. This is a final agency action within the meaning of 5 U.S.C. § 704 for purposes of seeking judicial review. See MPEP 1002.02.

Andrew Hirshfeld
Deputy Commissioner for
Patent Examination Policy/
Petitions Officer