

# What To Do If The APJ Limits The Number Of Claims To Be Added To A Patent Or An Application In Interference<sup>1</sup>

By Charles L. Gholz<sup>2</sup>

## INTRODUCTION

The APJs, being human, like to limit the amount of work that they do per “disposal.”<sup>3</sup> Counsel for interferences, also being human, like either to obtain the maximum amount of intellectual property for their clients or to destroy the maximum amount of intellectual property for their adversaries’ clients (or both), which frequently causes them to want the APJs to do more work for a given disposal than the APJs want to do. One of the many situations in which this conflict arises is when counsel for an interferent (whether an applicant-interferent or a patentee-interferent) wants to add a large number of claims to the application or patent in interference, either via a motion to be filed in the initial round of motions or via a motion to be filed in the second (responsive) round of motions.<sup>4</sup> In either case, permission to file such a motion must be obtained from the responsible APJ via a scheduling conference call.

SO ¶ 208.5, “Responsive motions,” sub-paragraph 208.5.1, “Adding a claim,” specifically states that “No more than one claim may be added in response to a motion unless the Board expressly authorized the addition of more claims.” That paragraph also clearly contemplates the addition of a claim to either an application or a patent, for it states that “The claim may only be added to an involved application or patent. \*\*\* Adding a patent claim generally requires the filing of a reissue application.”

SO ¶ 208.3.1, “Designating a claim as corresponding,” clearly contemplates a motion to add a claim at least to an application in interference, for it states that, “If no clean or annotated copy of the claim has been filed, then a clean copy, and[,], where applicable[,], an annotated copy,

of the claim must be filed as an appendix to the motion.” However, it does not clearly apply to a motion to add a claim to a patent in interference via an application to reissue the patent in interference, and, more importantly, it does not expressly state that “No more than one claim may be added unless the Board expressly authorized the addition of more claims.” Nevertheless, I believe that the APJs treat SO ¶ 208.3.1 as if it contained that limitation.

### **What Wnek v. Dobbs Held**

Wnek v. Dobbs, 85 USPQ2d 1159 (PTO BPAI 2006)(non-precedential)(opinion by APJ Tierney for a panel that also consisted of APJs Lane and Medley), discussed in Gholz, A Critique of Recent Opinions in Patent Interferences, 91 JPTOS 1 (2009), §X.D., “There is a Severe Limitation on the Number of Claims that One Can Ask to Add in a Responsive Motion,” held that Dobbs had “failed to demonstrate that, based on the facts of this interference, it requires twelve additional claims to properly respond to Wnek’s §135(b) unpatentability motion”<sup>5</sup> I represented Dobbs, and I had relied on In re Wakefield, 422 F.2d 897, 164 USPQ 636 (CCPA 1970), which reversed an ex parte multiplicity rejection on the ground that, if an applicant pays the required fees and otherwise complies with the statute, it is entitled to examination of as many claims as it cares to present—even if that requires “tedious work” by the examiner. However, according to the panel, “Dobbs’ citation to *Wakefield* and its holding regarding an ex parte multiplicity rejection fails to provide a sufficient explanation as to why the particular facts of this interference demonstrate that Dobbs’ [sic; Dobbs] is entitled to the relief it requests.”<sup>6</sup>

Unpersuaded, I concluded my write-up of Wnek v. Dobbs by saying that “No one likes to do ‘tedious work,’ and the APJs are in a position to avoid having to do so until such time as an interferent, like the applicant Wakefield, make[s] an issue of their having done so on appeal.”<sup>7</sup>

## **What In re Katz Interactive Call Processing Patent Litigation Held**

In re Katz Interactive Call Processing Patent Litigation. \_\_\_ F.3d \_\_\_, 97 USPQ2d 1737 (Fed. Cir. February 18, 2011)(opinion by Circuit Judge Bryson for a panel that also consisted of Circuit Judges Newman and Lourie) (hereinafter referred to as “Katz”), did not involve an interference. Nevertheless, I believe that it is highly relevant to the situation under discussion.

Katz was an appeal from the decision of a district court in what was, in many respects, a run-of-the-mill patent infringement decision. However, it was not run-of-the-mill in that it was an appeal from a decision in which 25 patent infringement actions involving numerous defendants had been consolidated into one district court. It was even more not run-of-the-mill in that the plaintiff had asserted numerous claims from numerous different patents against the defendants. Specifically, “Across all 25 actions, Katz asserted a total of 1,975 claims from 31 patents against 165 defendants in 50 groups of related corporate entities (“defendant groups”)”<sup>8</sup>

On motion, “the district court ordered Katz initially to select no more than 40 claims per defendant group, and after discovery to narrow the number of selected claims to 16 per defendant group...[and] that the total number of claims to be asserted against all defendants could not exceed 64 (eight claims for each unique specification including four specifications not at issue in this appeal.”<sup>9</sup> However, of critical importance here, “the court added a proviso that the limitations on the numbers of claims were not immutable. The proviso permitted Katz to add new claims if they ‘raise[d] issues of infringement/validity that [were] not duplicative’ of previously selected claims.”<sup>10</sup>

Instead of moving to implement the proviso, Katz moved the district court to sever and stay proceedings on the non-selected claims. In that motion, “Katz contended that the court’s requirement that it select particular claims violated its due process rights because the court’s

order could result in decisions having a preclusive effect on non-selected claims regardless of whether those claims presented distinct issues of invalidity or infringement.”<sup>11</sup> The district court didn’t buy that argument and, on appeal, neither did the Federal Circuit.

On appeal, Katz argued “that[,] by entering final judgments in these cases without severing and staying the unselected claims, the district court divested Katz of its rights in the unselected claims without due process...[and that] the district court assumed its claims were duplicative in violation of the claim-differentiation doctrine and the independent presumption of claim validity from 35 U.S.C. § 282.”<sup>12</sup> Neither argument persuaded the Federal Circuit.

As to the first argument, according to the Federal Circuit:

Katz has failed to demonstrate that the allocation of burdens in the claim selection procedure adopted by the district court unfairly prejudiced it by creating a significant risk that Katz would be erroneously deprived of property rights in unselected claims. The district court noted that[,] by providing examples of duplicative claims and pointing out the common genealogy of Katz’s patent and the terminal disclaimers in almost all of them, the defendants had made “a convincing showing that many of the claims are duplicative.” Because neither side had provided an analysis of all of the claims, the [district] court recognized the possibility that the limitations on the number of claims to be asserted might be unduly restrictive. The [district] court therefore provided that more claims could be added if Katz could show that the additional claims presented unique issues. Under the circumstances of this case, we conclude that the district court acted reasonably in concluding that it would be more efficient to require Katz to point out those unselected claims that raised separate issues of infringement and invalidity rather than requiring the defendants to prove that all of the unselected claims were duplicative.<sup>13</sup>

As to Katz’s second argument, the Federal Circuit held:

that the [district] court did not violate the statutory presumption that each claim is independently presumed valid, *see* 35 U.S.C. § 282, or the “rebuttable presumption that different claims are of different scope,” *Amgen Inc. v. Hoechst Marion Roussel, Inc.*, 314 F.3d 1313, 1326 (Fed. Cir. 2003). While different claims are presumed to be of different scope, that does not mean that they necessarily present different questions of validity or infringement.

And the [district] court only required Katz to demonstrate that a new claim presented unique questions of validity or infringement. \*\*\* Although the [district] court required Katz to show that additional claims presented unique questions for the case, the [district] court did not place a burden on Katz to demonstrate that its claims covered distinct subject matter.<sup>14</sup>

## Comment

I believe that the logic of Katz could be easily adapted to the situation presented in Wnek v. Dobbs. That is, I believe that it makes sense for an APJ to place the burden on a party desiring to present more than one additional claim, either to a patent in interference or to an application in interference, to persuade him or her that the additional claim or claims would present an issue (either of patentability or of claim correspondence) not presented by the first additional claim. However, I do not believe that a one-size-fits-all rule that an interferent can present only one additional claim would survive judicial scrutiny.

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<sup>3</sup> For an APJ, a “disposal” is the entry of judgment in an interference.

<sup>4</sup> Another, conceptually similar, situation is discussed in Gholz, A Critique of Recent Opinions in Patent Interferences, 88 JPTOS 305 (2006), § X.E.7, “The Trial Section Asserts That It Can Limit the Number of References Relied Upon.”

<sup>5</sup> 85 USPQ2d at 1160.

<sup>6</sup> 85 USPQ2d at 1160.

<sup>7</sup> 91 JPTOS at 6.

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<sup>8</sup> \_\_\_ F.3d at \_\_\_. 97 USPQ2d at 1742.

<sup>9</sup> \_\_\_ F.3d at \_\_\_, 97 USPQ2d at 1742.

<sup>10</sup> \_\_\_ F.3d at \_\_\_, 97 USPQ2d at 1742.

<sup>11</sup> \_\_\_ F.3d at \_\_\_, 97 USPQ2d at 1743.

<sup>12</sup> \_\_\_ F.3d at \_\_\_, 97 USPQ2d at 1743.

<sup>13</sup> \_\_\_ F.3d at \_\_\_, 97 USPQ2d at 1744; footnote omitted.

<sup>14</sup> \_\_\_ F.3d at \_\_\_, 97 USPQ2d at 1745.