



Commissioner for Patents
Washington, DC 20231
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Memorandum

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To: Technology Center Directors
Patent Examining Corps

From: *Stephen G. Kunin*
Stephen G. Kunin
Deputy Commissioner for Patent Examination Policy

Subject: Rejections Based on Undue Multiplicity

It has been brought to my attention that some examiners are issuing second and subsequent Office actions based solely on unusual technical rejections such as undue multiplicity. This is not in accord with published patent examination policy, which ensures that patent applicants obtain a prompt yet complete examination of their applications. Under the principles of compact prosecution, each claim should be reviewed for compliance with every statutory requirement for patentability in the initial review of the application. Compact prosecution includes a complete first action on the merits, a search of the prior art, a minimum number of actions, and an early indication of allowable subject matter.

The Office does recognize that when applicants present large number of claims to one invention in a single application, that large number of claims may create burden to the examiner, but nevertheless, Office policy is that absent basis for a restriction requirement, applicants are entitled to an examination of the claims presented provided applicants pay the required fees and otherwise comply with the statute. While undue multiplicity rejections based on 35 U.S.C. 112, 2nd paragraph are set forth in MPEP 2173.05(n), such rejections should be applied judiciously and should be rare.

As noted by the court in *In re Flint*, 411 F.2d 1353, 1357, 162 USPQ 228, 231 (CCPA 1969), “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.” Where applicant presents an unreasonable

number of claims in view of the nature and scope of applicant's invention, which are repetitious and multiplied with a net result of which is to confuse rather than to clarify, a rejection on undue multiplicity based on 35 U.S.C. 112, 2nd paragraph may be appropriate. In such case, the examiner should contact applicant by telephone explaining that the claims are unduly multiplied and will be rejected under 35 U.S.C. 112, 2nd paragraph. 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, 2nd 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, 2nd 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 Board of Patent Appeals and Interferences.