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Representative Patent Claims: Their Use in Appeals to the Board and in Infringement Litigation

Patricia E. Campbell

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Abstract

In general every patent claim is considered a separate invention. However, in certain instances, multiple claims are grouped together and the patentee’s rights are determined with respect to these “representative claims.” This article examines the representative claims procedures utilized in patent prosecution and litigation. The recent changes in the rules governing the appeals of a rejected patent claim before the Board of Patent Appeals and Interferences are highlighted first, followed by an examination of the use of representative claims in patent litigation and proposals for some guidelines for the selection of representative claims.
I. INTRODUCTION

The statutes creating the patent system, expressly sanctioned by the Constitution, represent an affirmative policy choice by Congress to reward inventors. Each patent claim is considered a separate invention and is viewed as a distinct property right. However, in certain instances, the Patent & Trademark Office ("PTO") and the courts are permitted to group claims together and reach a determination concerning an inventor's patent rights on the basis of a few "representative claims." These procedures are justified as promoting efficiency and relieving judicial frustration and jury confusion.

This article will examine the representative claims procedures utilized in patent prosecution and litigation. Section II discusses the use of representative claims when a patent applicant appeals a rejection of its claims to the Board of Patent Appeals and Interferences ("the Board"), and highlights recent changes in the rules governing that procedure. Section III examines the use of representative claims in patent litigation, including the effect of validity and infringement determinations on other, non-representative claims and whether a court-imposed representative claims procedure is a violation of the Constitutional rights of the patentee. Section III concludes with a discussion of potential strategic advantages enjoyed by a patent owner which tries its case on the basis of representative claims and proposes a few guidelines for the selection of representative claims.

II. REPRESENTATIVE CLAIMS IN APPEALS TO THE BOARD

During prosecution of a patent application, the patent examiner is required to evaluate each claim separately. The examiner may not
focus solely on the independent claims or on a general conception of
the invention when determining whether patent claims should be
allowed.\(^7\)

However, when an applicant's claims have been twice or finally
rejected by the examiner, the applicant may file an appeal to the
Board.\(^8\) On appeal, when multiple claims subject to the same ground
of rejection are argued as a group by the appellant, the Board may
select a single claim from the group of claims that are argued together
to decide the appeal, rather than reviewing each claim separately.\(^9\)
That is, for each separate ground of rejection stated by the examiner,
the Board may select one claim that it considers representative of the
group and may decide the appeal of the rejection on the basis of its
evaluation of the selected claim alone.\(^10\) In a departure from prior
practice, the failure of the appellant to argue claims separately is
deemed a waiver of any argument that those claims should be subject
to separate treatment.\(^11\)

\(A.\) A Prior Version Of The Rules Created A Limited
Representative Claims Procedure To Be Utilized In Appeals
To The Board

In late 2004, the PTO enacted significant changes to the rules
governing proceedings before the Board, including the rules
authorizing the Board to decide an appeal on the basis of a
representative claim.\(^12\) Prior to September 2004, when those changes
took effect, if an appellant did not wish to participate in the
"representative" claims process, it was required to state its objections
in an appeal brief.\(^13\) The rules provided that, within two months after
filing a notice of appeal, the applicant was required to file a brief
containing a number of specific items, including a "grouping of

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\(^7\) See 37 C.F.R. § 1.104 (2005), requiring the patent examiner to allow or reject each
claim in a patent application.

\(^8\) 37 C.F.R. § 41.31(a)(1) (2005). See also 4-11 DONALD S. CHISUM, CHISUM ON
PATENTS § 11.06[1][d][i], at 11-547 (2005) [hereinafter CHISUM ON PATENTS].


\(^10\) Id.

\(^11\) Id.


\(^13\) 37 C.F.R. § 1.197(c)(7) (2004), removed by Rules of Practice Before the Board of
claims." Unless the appellant specifically argued that claims subject to the same ground of rejection were separately patentable, the Board was permitted to select a single claim upon which to decide the appeal for each ground of rejection. The former Rules of Practice Before the Board of Patent Appeals and Interferences stated:

For each ground of rejection which appellant contests and which applies to a group of two or more claims, the Board shall select a single claim from the group and shall decide the appeal as to the ground of rejection on the basis of that claim alone unless a statement is included that the claims of the group do not stand or fall together and, in the argument ... appellant explains why the claims of the group are believed to be separately patentable. Merely pointing out differences in what the claims cover is not an argument as to why the claims are separately patentable.

As a result, the appellant was required to perform two affirmative acts in order to obtain separate review of individual claims within each group of claims subject to a common ground of rejection. The appellant’s brief had to “(a) state that the claims did not stand or fall together, and (b) present arguments explaining why those claims subject to a common rejection were separately patentable.” An appellant could organize the claims into as many groups as it desired, and it could even designate a separate group for each claim.

If the appellant’s brief did not include the mandatory statement that all claims subject to a common ground of rejection did not stand or fall together on appeal, the claims could be treated collectively. In that instance, the Board panel assigned to the case normally selected

14. Id.
15. Id.
16. Id.
17. In re McDaniel, 293 F.3d 1379, 1383, 63 U.S.P.Q.2d 1462, 1464 (Fed. Cir. 2002) (quoting MPEP, supra note 6, § 1206 (8th ed. Aug. 2001)). Claims are said to “stand or fall together” where, if the ground of rejection were sustained as to any one of the rejected claims, it would be equally applicable to all of them.
18. Id.; see also JOHN GLADSTONE MILLS III ET AL., PATENT LAW FUNDAMENTALS § 16:35, at 16-119 (2d ed. 2004) [hereinafter PATENT LAW FUNDAMENTALS] (“in order to have the Board consider whether the additional limitations contained in dependent claims impart patentability, appellant’s brief must not only state that such dependent claims did not stand or fall with the independent claim, but must also present argument why such dependent claims were separately patentable”).
the broadest claim in the group and considered only that claim. This was true even where the group contained two broad claims, such as "ABCDE" and "ABCDF," or where there were both broad method and apparatus claims on appeal in the same group.

As a result, the burden was placed squarely on the applicant to opt out of the representative claims process on appeal. The absence of a statement that the claims did not stand or fall together and the lack of any supporting argument were regarded as a concession by the applicant that, if the ground of rejection were sustained as to any one of the rejected claims, it would be equally applicable to all of them.

Upon receipt of a copy of the appellant’s brief, the original examiner was required to furnish the appellant with a written answer. The answer was required to include a statement of whether the examiner disagreed with any statement in appellant’s brief that certain claims did not stand or fall together and, if the examiner disagreed, an explanation as to why he believed that those claims were not separately patentable. In the event of a disagreement between the applicant and the examiner, the applicant was given an opportunity to address the examiner’s arguments in his reply brief, and the matter then became an issue for the Board.

1. The Purpose Of The Representative Claims Procedure Was To Lighten The Workload Of The Board

The rationale behind the prior rule was to make the appeals process as efficient as possible for the Board. The PTO commented that, "while the Board will consider each separately argued claim, the work of the Board can be done in a more efficient manner by

21. Id.
22. Id. The MPEP further provided that if the brief of a pro se appellant was accepted, it would be presumed that all the claims of a rejected group of claims stood or fell together, unless the pro se appellant included an argument in his brief stating why he considered one or more of the claims in the rejected group to be separately patentable from the other claims in the group. Id. at 1200-9.
23. See id.
26. Id. § 1208, at 1200-18.
27. Id. § 1208.3, at 1200-26; see also Ex parte Schier, 21 U.S.P.Q.2d 1016, 1017 (B.P.A.I. 1991) ("Initially we note that there is a dispute between the examiner and the appellant as to whether the patentability of the dependent claims stands or falls with the patentability of parent claim 1.").
selecting a single claim from a group of claims when the appellant does not meet the requirements of 37 C.F.R. §192(c)(7).”

The Federal Circuit observed that the rule promoted efficiency by ignoring distinctions among claims that were not relevant to patentability, stating that “[t]he rule operates to relieve the Board from having to review – and an applicant from having to argue – the myriad of distinctions that might exist among claims, where those distinctions are, in and of themselves, of no patentable consequence to a contested rejection.” Thus, the Court viewed the representative claims procedure as easing the workload of both the Board and the applicant. For example, if an applicant believed that two commonly rejected but patentably distinct claims were distinguishable over the cited prior art for reasons that were applicable to both claims, the Court saw no reason why either the Board or the applicant should be concerned with the distinctions between claims in the rejected group. “If the applicant’s commonly applicable reasons for patentability have merit, the rejection of both claims will be overcome, quite apart from any patentable distinctions that exist between the claims.” The Court characterized the rule as a “default” that authorized the Board to designate one claim to serve as representative of others in the same commonly rejected group and “to focus its attention on only those matters that are dispositive of the appeal, unless [the] applicant overcomes the default to assure separate review of individual claims by meeting the two conditions specified in the rule.”

The practical effect of the rule was that the patentability of dependent claims often depended upon the patentability of the independent claims on appeal. Indeed, in nearly all cases decided

29. Id.
31. See id. at 1383, 63 U.S.P.Q.2d at 1464.
32. Id. at 1383, 63 U.S.P.Q.2d at 1464-65.
33. Id. at 1383, 63 U.S.P.Q.2d at 1465.
34. Id. at 1383, 63 U.S.P.Q.2d at 1465. See also, e.g., In re Nielson, 816 F.2d 1567, 1571-72, 2 U.S.P.Q.2d 1525, 1527-28 (Fed. Cir. 1987), where the appellant separately argued before the Board the rejection of three dependent claims, and the examiner discussed in detail the grounds for rejection in his answer. The Board erred in holding that these dependent claims stood or fell with the independent claim and in rejecting it on that basis. Id. at 1572, 2 U.S.P.Q.2d 1528. The Court held that the PTO did not present a prima facie case of obviousness as to the dependent claims, because the cited references offered no suggestion of the claimed combination. Id. However, the court affirmed the Board's rejection of the other dependent claims, which the applicant did not challenge with any reasonable specificity before the Board. Id.
prior to 2002, where the appellant did not argue that the dependent claims were separately patentable, the Board treated them as standing or falling with a representative independent claim and the Federal Circuit did not disagree.\textsuperscript{36}

2. Under Previous Rules, Appellants Could Easily Opt Out Of Representative Treatment of Claims

Under the prior rules, the burden placed on an appellant who did not wish to participate in the representative claims system was not an onerous one. While the appellant was required to do more than merely point out differences in what the claims cover, the courts did not require detailed arguments supporting the separate patentability of each individual claim.\textsuperscript{37} One commentator observed that, although the patentability of dependent claims would stand or fall with the patentability of an independent claim rejected on common grounds unless expressly and separately argued in the appeal brief, "such express and separate argument, in order to raise an issue sufficient to be decided on appeal, need not be extensive."\textsuperscript{38}

In one instance, the Federal Circuit vacated a Board decision and remanded the case because the Board refused to consider issues relating to dependent claims that it said were raised only in a "routine manner."\textsuperscript{39} The Court noted that during prosecution before the

\textsuperscript{36} See, e.g., \textit{In re Dance}, 160 F.3d 1339, 1340 n.2, 48 U.S.P.Q.2d 1635, 1636 n.2 (Fed. Cir. 1998); \textit{In re Young}, 927 F.2d 588, 590, 18 U.S.P.Q.2d 1091 (Fed. Cir. 1991); \textit{In re King}, 801 F.2d 1324, 1325, 231 U.S.P.Q. 136, 137 (Fed. Cir. 1986); \textit{In re Margolis}, 785 F.2d 1029, 1030, 228 U.S.P.Q. 940, 941 (Fed. Cir. 1986); \textit{In re Kaslow}, 707 F.2d 1366, 1376, 217 U.S.P.Q. 1089, 1096-97 (Fed. Cir. 1983); \textit{In re Semaker}, 702 F.2d 989, 991, 217 U.S.P.Q. 1, 3 (Fed. Cir. 1983). See also \textit{In re Dillon}, 919 F.2d 688, 692, 16 U.S.P.Q.2d 1897, 1900 (Fed. Cir. 1990) ("It is not the practice of this court to review claims that an applicant has not separately argued at the Board level, because, \textit{inter alia}, we lack the benefit of the Board's reasoned decision on the separate patentability of those claims."). Similarly, if a district court holds that an independent claim and a dependent claim in a patent are invalid and, on appeal, the patentee does not argue that the claims are separately patentable, the claims will stand or fall together. Sibia Neurosciences Inc. v. Cadus Pharm. Corp., 225 F.3d 1349, 1359, 55 U.S.P.Q.2d 1927, 1933 (Fed. Cir. 2000); Amgen, Inc. v. Chugai Pharm. Co., 927 F.2d 1200, 1212, 18 U.S.P.Q.2d 1016, 1026 (Fed. Cir. 1991).


\textsuperscript{38} \textit{PATENT LAW FUNDAMENTALS}, supra note 18, § 16:35 at 16-120.

examiner, each claim was examined, and each was appealed. As a result, the dependent claims by their very nature required fewer words of explanation on appeal, and the argument on the dependent claims was not deemed inadequate by the examiner. "That [applicant] did not repeat, in his argument for subordinate claims, everything he had already said in arguing his principal claims did not convert 'dependent' claims into nonentities."42

The appellant was only required to provide something more than a "conclusory" argument in support of his contention that the claims were entitled to separate treatment. In one case, although the applicants urged that the examiner erred in rejecting the dependent claims, it failed to identify the specific errors in the Board's decision or even the features of the dependent claims that would allow them to overcome an obviousness rejection. "Such a conclusory argument by appellants is not sufficient to raise separate issues on appeal with respect to independent claims."45 As a result, the Court held that all of the dependent claims would stand or fall with their respective independent claims.46

B. In re McDaniel Precluded The Board From Relying On An Appellant's Assertion That Claims Stand Or Fall Together

In 2002, the Federal Circuit imposed a significant limitation on the Board's use of representative claims when hearing appeals from a final rejection by the examiner and held that the Board could not blindly rely on an appellant's assertion that claims stand or fall together. In McDaniel, the applicant filed an application relating to an organophosphorus detoxifying gene and a recombinant organophosphorus acid anhydrase enzyme derived from that gene.48

40. Id. at 330, 13 U.S.P.Q.2d at 1410.
41. Id. at 330, 13 U.S.P.Q.2d at 1410-11.
42. Id. at 330, 13 U.S.P.Q.2d at 1410. See also In re Napier, 55 F.3d 610, 614, 34 U.S.P.Q.2d 1782, 1785 (Fed. Cir. 1995) ("[Applicant] has separately argued the merits of some of the other rejected claims, and therefore we must review the Board's decision with respect to each separately argued claim.").
44. See Thrift, 298 F.3d at 1360, 63 U.S.P.Q.2d at 2003.
45. Id. at 1360, 63 U.S.P.Q.2d at 2003 (emphasis added).
46. Id.
48. Id. at 1381, 63 U.S.P.Q.2d at 1463.
The gene and enzyme were claimed to be useful in detoxifying compounds commonly found in pesticides and chemical warfare agents such as nerve gases.\textsuperscript{49} Claims 53 through 64 of the application were finally rejected by the examiner for six separate reasons under §102(a), § 102(b), or alternatively under § 103.\textsuperscript{50}

McDaniel appealed these rejections to the Board and stated that claims 53-64 were “all properly of a single group.”\textsuperscript{51} The Board therefore grouped all the claims together on appeal, and it selected claim 53 as representative of the entire group.\textsuperscript{52} The Board affirmed the §102 rejections, which it applied to all of the claims, and found it unnecessary to separately consider the rejection of the claims under §103.\textsuperscript{53} McDaniel then appealed the Board’s decision to the Federal Circuit.\textsuperscript{54}

The Court determined that McDaniel failed to meet both requirements of 37 C.F.R. § 1.192(c)(7) in his appeal brief, because he affirmatively stated that “claims 53-64 are all properly of a single group” and argued patentability generally, without setting forth separate reasons for patentability with respect to any one or more claims separately from the others.\textsuperscript{55} The Board interpreted McDaniel’s statement and his general argument to mean that, as to the questions of patentability raised by the appeal, the claims “stand and fall together.”\textsuperscript{56}

Moreover, at oral argument before the Federal Circuit, McDaniel was asked specifically about this issue, and he affirmed his position that all claims stand or fall based on claim 53.\textsuperscript{57} The Court therefore concluded that, “[b]y failing to argue for separate patentability of his claims in his brief to the Board, and by stating in that brief that “claims 53-64 are all properly of a single group, ... McDaniel has waived the right to insist that the Board separately review the patentability of individual claims within each group of rejected

\begin{itemize}
\item \textsuperscript{49} \textit{Id.} at 1381, 63 U.S.P.Q.2d at 1463.
\item \textsuperscript{50} 35 U.S.C. §§ 102(a), 102(b), 103 (2000). \textit{See} \textit{McDaniel}, 293 F.3d at 1381-82, 63 U.S.P.Q.2d at 1463-64.
\item \textsuperscript{51} \textit{McDaniel}, 293 F.3d at 1382, 63 U.S.P.Q.2d at 1464.
\item \textsuperscript{52} \textit{Id.} at 1382, 63 U.S.P.Q.2d at 1464.
\item \textsuperscript{53} \textit{Id.} at 1382, 63 U.S.P.Q.2d at 1464.
\item \textsuperscript{54} \textit{Id.} at 1382, 63 U.S.P.Q.2d at 1464.
\item \textsuperscript{55} \textit{Id.} at 1383, 63 U.S.P.Q.2d at 1465.
\item \textsuperscript{56} \textit{Id.}, 63 U.S.P.Q.2d at 1465; \textit{see also} \textit{In re Battison}, 139 Fed. Appx. 281, 284 (Fed. Cir. 2005).
\item \textsuperscript{57} \textit{In re} McDaniel, 293 F.3d 1379, 1383, 63 U.S.P.Q.2d 1462, 1465 (Fed. Cir. 2002).
\end{itemize}
Accordingly, the Court found that the Board did not err in selecting claim 53 as the representative claim for the purpose of deciding the appeal of the rejections under § 102, encompassing claims 53-54 and 58-63, because all of those claims shared a common ground of rejection with claim 53.59

However, the Court held that the Board did err when it selected claim 53 as a representative claim for the purpose of deciding the appeal of claims 55-57.60 The examiner under § 103 rejected those claims on a different ground than the § 103 rejection of claim 53, since the § 103 rejections of claims 55-57 cited an additional reference that was not included in the combination of references cited against claim 53.61 That is, claims 55-57 did not share a common ground of rejection with claim 53.62 The Court stated:

C.F.R. § 1.192(c)(7) does not give the Board carte blanche to ignore the distinctions between separate grounds of rejection and to select the broadest claim rejected on one ground as a representative of a separate group of claims subject to a different ground of rejection. The applicant has the right to have each of the grounds of rejection relied on by the Examiner reviewed independently by the Board. ... Simplification and expedition of appeals cannot justify the Board’s conflating separately stated grounds of rejection by selecting, for the purpose of deciding an appeal as to one ground of rejection, a representative claim which is not itself subject to that ground of rejection. 37 C.F.R. § 1.192(c)(7) does not override an applicant’s right under the statute to have each contested ground of rejection by an examiner reviewed and measured against the scope of at least one claim within the group of claims subject to that ground of rejection.63

Therefore, even though the applicant erroneously stated in his appeal brief that the rejected claims all stand or fall together, and then affirmed that position during oral argument before the Federal Circuit, the Board was not entitled to rely on the applicant’s statements and designate a single representative claim for purposes of deciding the

58. Id. at 1383, 63 U.S.P.Q.2d at 1465.
59. Id. at 1384, 63 U.S.P.Q.2d at 1465.
60. Id. at 1384, 63 U.S.P.Q.2d at 1465.
61. Id. at 1384, 63 U.S.P.Q.2d at 1465.
62. Id. at 1384, 63 U.S.P.Q.2d at 1465.
appeal of multiple grounds of rejection. The Board was required to give separate treatment to each separately rejected group of claims.

McDaniel therefore imposed an additional duty on the Board with respect to the selection of representative claims. The Board could no longer rely on an appellant's assertion in his brief that certain claims stand or fall together for purposes of appeal. Instead, the Board was required to perform at least some minimal review of the examiner's grounds of rejection and verify that the appellant had not incorrectly grouped together claims that were not subject to a common ground of rejection.

C. Recent Amendments To The Rules Attempt To Shift The Burden Back To The Appellant To Designate Claims For Separate Treatment By The Board

In August 2004, the PTO enacted significant changes to the rules governing practice before the Board, including the rules relating to use of representative claims on appeal. Under the revised regulations, the "grouping of claims" requirement set forth in former Rule 192(c)(7) has been removed. Instead, the new rule provides that, for each ground of rejection applying to two or more claims, "the claims may be argued separately or as a group." When an appellant elects to argue multiple claims as a group, the representative claims procedure is automatically activated. Rule 41.37 provides that when multiple claims subject to the same ground of rejection are argued as a group by the appellant, "the Board may select a single claim from the group of claims that are argued together

64. See id. at 1384-85, 63 U.S.P.Q.2d at 1466.
65. But see Chief Judge Mayer's dissent arguing that McDaniel is the master of his own case. Id. at 1387, 63 U.S.P.Q.2d at 1468 (Mayer, C.J., dissenting). The Chief Judge argues that, in stating that claims 53-64 stand or fall together, McDaniel waived any argument that claims 55-57 are patentable for reasons independent of claim 53, and therefore he should be held to his position. Id. at 1387, 63 U.S.P.Q.2d at 1468.
66. But see Checkpoint Sys., Inc. v. U.S. Int'l Trade Comm'n, 54 F.3d 756, 760, 35 U.S.P.Q.2d 1042, 1046 (Fed. Cir. 1995). Checkpoint argued that the International Trade Commission erred as a matter of law by considering claim 1 of the '076 patent as representative of claims 25-27 of the '473 patent. Id. at 760, 35 U.S.P.Q.2d at 1046. The court said that because Checkpoint failed to raise the issue with the full commission in its petition for review of the Initial Determination, the issue was not properly before the court on appeal. Id. at 760, 35 U.S.P.Q.2d 1046.
68. See id.
69. Id.
70. See id.
to decide the appeal with respect to the group of claims as to the ground of rejection on the basis of the selected claim alone.\textsuperscript{71}

However, apparently in direct response to the \textit{McDaniel} decision, the PTO has attempted to shift the burden back onto the appellant to separately argue any claims that do not stand or fall with the other rejected claims.\textsuperscript{72} The rule states, "[n]otwithstanding any other provision of this paragraph, \textit{the failure of appellant to separately argue claims which appellant has grouped together shall constitute a waiver of any argument that the Board must consider the patentability of any grouped claim separately.}"\textsuperscript{73} In appellant's brief, any claim argued separately should be placed under a subheading identifying the claim by number, and claims argued as a group should be placed under a subheading likewise identifying those claims by number.\textsuperscript{74} The rule cautions that a "statement which merely points out what a claim recites will not be considered an argument for separate patentability of the claim."\textsuperscript{75}

In the wake of these revisions to the rules, the continuing viability of \textit{McDaniel} has been questioned.\textsuperscript{76} In its response to comments submitted before the new rule was enacted, the PTO explained that the waiver provision of Rule 41.37 reflects the view expressed in Chief Judge Mayer's dissent in \textit{McDaniel}, where he stated:

\begin{quote}
McDaniel is the master of his own case ... and in stating that claims 53-64 stand or fall together, he has waived any argument that claims 55-57 are patentable for reasons independent of claim 53. Therefore, I would hold him to his position, as the Board of Patent Appeals and Interferences did.\textsuperscript{77}
\end{quote}

\textsuperscript{71} Id.

\textsuperscript{72} See id.

\textsuperscript{73} Id. (emphasis added). \textit{See also} MPEP, supra note 6, § 1205.02, at 1200-15 (8th ed., 3d rev., Aug. 2005) (citing In re McDaniel, 293 F.3d 1379, 1384, 63 U.S.P.Q.2d 1462, 1465-66 (Fed. Cir. 2002)).

\textsuperscript{74} 37 C.F.R. § 41.37(c)(1)(vii) (2005). \textit{See also} MPEP, supra note 6, § 1205.02, at 1200-15 (8th ed., 3d rev., Aug. 2005) (providing examples of acceptable headings for claims that are grouped together and those which are argued separately, and indicating that the best practice is to use a subheading for each claim for which separate consideration by the Board is desired.)


\textsuperscript{76} Hyatt v. Dudas, 393 F. Supp. 2d 1, 7-8 (D.D.C. 2005).

Judge Mayer's comments are clearly at odds with the majority of the Court, however, which held that the Board erred in selecting claim 53 as a representative claim for purposes of deciding the appeal of claims 55-57 because claims 53 and 55-57 did not share a common ground of rejection. As previously noted, the Federal Circuit held that the Board does not have "carte blanche to ignore the distinctions between separate grounds of rejection and to select the broadest claim rejected on one ground as a representative of a separate group of claims subject to a different ground of rejection." In doing so, the Court made it clear that the appellant has a right to have each of the grounds of rejection relied on by the Examiner reviewed independently by the Board.

As a result, it is doubtful that the courts would hold that new Rule 41.37 allows the appellant to waive this important right and relieves the Board of its duty to review the examiner's grounds of rejection and verify that the appellant has not incorrectly grouped together claims that were not subject to a common ground of rejection. Accordingly, McDaniel likely remains good law, and any waiver will be deemed effective only to the extent that claims grouped together are subject to the same grounds of rejection by the examiner.

D. The Representative Claims Procedure Utilized During An Appeal To The Board Remains Limited In Practice

While the regulations create a representative claims procedure that may be implemented when an applicant appeals to the Board, it is a process that remains limited in practice. The applicant may choose to argue claims separately or as a group. The Board may decide the appeal on the basis of a single claim only when the applicant elects group treatment for multiple claims subject to the same ground of rejection. Further, based on the Court's holding in the McDaniel case, even where an applicant erroneously contends that claims stand or fall together, the Board may not rely on the applicant's statement where all claims were not rejected for the same reasons. Any waiver...

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78. McDaniel, 293 F.3d at 1384, 63 U.S.P.Q.2d at 1465.
79. Id. at 1384, 63 U.S.P.Q.2d at 1465-66.
80. Id. at 1384, 63 U.S.P.Q.2d at 1466.
82. See id.
83. See McDaniel, 293 F.3d at 1384, 63 U.S.P.Q.2d at 1465.
of separate treatment will be effective only to the extent that the
claims in question were subject to the same grounds of rejection.  

III. REPRESENTATIVE CLAIMS IN LITIGATION

In patent infringement litigation, it has become a relatively
common practice for the outcome of a case to be determined on the
basis of a few representative claims selected by the patent owner. In
many patent cases, the parties will voluntarily stipulate or agree to the
use of representative claims, as an accommodation intended to narrow
the issues in the litigation. In other instances, however, the patent
owner may be ordered by the trial court to select representative
claims.

It has been argued that the use of representative claims is
warranted when there are a multitude of claims at issue, in order to
eliminate unnecessary, repetitious discovery and proofs and to reduce
the complexity and duration of discovery, trial preparation and the
trial. The purpose of representative claims is to allow "an efficient
and manageable trial," and "to enable a jury to adequately perform its
duty." Representative claims are intended to "prevent confusion"

84. See id. at 1384, 63 U.S.P.Q.2d at 1465.
85. See Panduit Corp. v. Dennison Mfg. Co., Inc., 836 F.2d 1329, 1331, 5 U.S.P.Q.2d 1266, 1268 (Fed. Cir. 1987) ("The term 'representative claims' is well understood in patent litigation.").
86. See, e.g., Technitrol, Inc. v. U.S., 440 F.2d 1362, 1363 n.1, 169 U.S.P.Q. 732 n.1 (Ct. Cl. 1971) ("The parties have agreed that four claims . . . are representative of the claimed subject matter of the patent, and therefore the scope of the patent can be determined by reference to those claims."); Remishaw PLC v. Marposs Societa' Per Azioni, 974 F. Supp. 1056, 1061 (E.D. Mich. 1997) (parties agreed to try their case on the basis of representative claims, and resolution of those claims would "constitute a final resolution of all the asserted patents as if the case had been tried without representative claims"); Thomson, S.A. v. Quixote Corp., 166 F.3d 1172, 1173, 49 U.S.P.Q.2d 1530 (Fed. Cir. 1999) (parties agreed to base outcome of trial on representative claims); Lizardtech, Inc. v. Earth Res. Mapping, Inc., 35 Fed. Appx. 918, 920-921 (Fed. Cir. 2005).
87. See Verizon Cal., Inc. v. Ronald A. Katz Tech. Licensing, L.P., No. 01-CV-09871 RGK (RCx), 2003 U.S. Dist. LEXIS 23553, at *4 (C.D. Cal. Dec. 2, 2003) ("Due to the large number of patents and claims at issue, . . ., the Court ordered Katz to identify no more than three representative claims per patent for its infringement case and no more than twenty claims for a claim construction hearing.").
and to prevent the trial of a patent infringement action from becoming unduly protracted.90

The Federal Rules of Civil Procedure provide some general authority for the creation of the representative claims procedure. The fundamental purpose of the Federal Rules is to secure "the just, speedy and inexpensive determination" of civil actions brought in the district courts.91 Courts are vested with an inherent power to manage their affairs as an independent branch of government.92 Federal Rule 16(c) empowers the district courts to take appropriate actions intended to simplify the issues, avoid unnecessary proof and cumulative evidence, adopt special procedures for managing potentially difficult or protracted actions that may involve complex issues, and otherwise facilitate the just, speedy and inexpensive disposition of the action.93

A. A Finding Of Invalidity Of The Representative Claims Will Generally Apply To All Other Asserted Claims As Well

The Patent Act requires an independent analysis of the validity of each claim in a patent.94 Unlike an appeal from a final rejection by the examiner, where claims will stand or fall together if the patentee elects to treat them as a group, in the district courts the validity of each claim must be adjudged separately.95 Each claim is presumed valid independent of the validity of the patent's other claims.96 The

90. PATENT LAW PRIMER, supra note 5, § 5, at 21 (1998).
91. FED. R. CIV. P. 1.
92. In re Baker, 744 F.2d 1438, 1441 (10th Cir. 1984) (en banc); Roadway Express, Inc. v. Piper, 447 U.S. 752, 764-66 (1980); Link v. Wabash R.R. Co., 370 U.S. 626, 630-31 (1962) (district courts have an inherent power to exercise the control necessary to manage their own affairs in order to achieve "the orderly and expeditious disposition of cases").
93. FED. R. CIV. P. 16.
94. 35 U.S.C. § 282 (2000) ("A patent shall be presumed valid. Each claim of a patent (whether in independent, dependent, or multiple dependent form) shall be presumed valid independently of the validity of other claims; dependent or multiple dependent claims shall be presumed valid even though dependent upon an invalid claim.").
95. CHISUM ON PATENTS, supra note 8, § 8.06[5][d], at 8-271 (quoting Shelcore, Inc. v. Durham Indus., 745 F.2d 621, 624-25, 223 U.S.P.Q. 584, 586-87 (Fed. Cir. 1984)).
burden is on the party challenging the validity of the claims to show by clear and convincing evidence that the patent is invalid.97

Accordingly, the general rule is that a party cannot show that all claims of a patent are invalid by presenting evidence directed at only one claim.98 A party challenging the validity of a claim, absent a pretrial agreement or stipulation, must submit evidence supporting a conclusion of invalidity for each contested claim.99 However, where the parties stipulate to representative claims, a validity resolution for the representative claims will generally apply to other claims as well.100

In Panduit Corp. v. Dennison Manufacturing Co., the Court rejected the defendant’s argument that a finding of validity of the representative claims did not extend to the remaining claims.101 The court observed that the term “representative claims” was well understood in patent litigation, and the procedure to be followed was familiar to any experienced patent litigator.102 At the time of trial, the


98. Gardner v. TEC Sys., Inc., 725 F.2d 1338, 1339 n.1, 220 U.S.P.Q. 777, 778 n.1 (Fed. Cir. 1984) (trial court erred in adjudging the patent in suit as invalid for obviousness under § 103 where only claims 1, 3, 4 and 8 were tried by the parties and considered by the court; the trial court’s decision must be limited to the claims in suit). See also ROBERT L. HARMON, PATENTS AND THE FEDERAL CIRCUIT § 19.3(g), at 1096 (6th ed. 2003) (“Each claim of a patent is presumed valid independently of the validity of any other claim. For this reason, where a defendant does not counterclaim for invalidity of all claims, a judgment of invalidity encompassing all claims must be reversed where it appears that the validity of certain claims was not actually litigated at trial.”).


100. Miles Labs., Inc. v. Shandon, Inc., 997 F.2d 870, 879, 27 U.S.P.Q.2d 1123, 1129 (Fed. Cir. 1993) (district court did not err in holding that the claims dependent upon a claim found to be invalid for obviousness were likewise invalid). In Miles, the parties entered into a stipulation which provided, “The ‘460 patent contains seven claims. Claim 1 is the only independent claim. Claims 2 through 7 depend directly or indirectly from claim 1. Consequently, claim 1 is the broadest claim and can be considered to be representative of the claims in this patent.” Id. at 879, 27 U.S.P.Q.2d at 1129. See also Baxter Int’l, Inc. v. COBE Labs., Inc., 88 F.3d 1054, 1057, 39 U.S.P.Q.2d 1437, 1439 (Fed. Cir. 1996) (“Where the parties stipulate to representative claims, ... a validity resolution for the representative claims applies to the other claims as well.”) (quoting Miles, 997 F.2d at 879, 27 U.S.P.Q.2d at 1129); N.V. Akzo v. E.I. Dupont de Nemours, 810 F.2d 1148, 1152, 1 U.S.P.Q.2d 1704, 1708 (Fed. Cir. 1987) (a finding of invalidity of a broad representative claim applied to all the other claims of the patent in suit); IRWIN M. AISENBERG, MODERN PATENT LAW PRECEDENT, Representative Claim, at 1044 (5th ed. 2003).


102. Indeed, the court commented that, “[f]or Dennison to suggest at this point that the
stipulation was understood by the parties, their counsel and the court to mean that four claims selected by plaintiff would represent all of the claims in the case, and whatever result the court reached as to those four claims would be the result for all claims. The defendant's appeal was therefore dismissed as "an unquestionably frivolous and flagrant abuse of the judicial process."

More recently, however, the Federal Circuit affirmed a district court's ruling denying defendants' motion to extend a judgment of invalidity of three asserted claims to all the remaining claims of the patents in suit. The court observed that in a pretrial stipulation, plaintiffs asserted infringement only as to three claims, and the defendants asserted invalidity only as to those three claims. At trial, the defendants did not offer evidence as to the invalidity of any other claims in the patents in suit. Although plaintiffs' attorney stated at trial that the representative claims would dictate the outcome, the court understood his comments to be directed to infringement only, and he did not address the issue of validity. As a result, the district court's judgment of invalidity was properly limited to the claims asserted at trial.

Conversely, another court refused to preclude evidence relating only to non-representative claims, even though the parties had stipulated to a representative claims process. In W.R. Grace & Co. v. Viskase Corp., the parties agreed that claims 1, 2 and 7 of the patent court and the parties intentionally tried this case in a way that left unresolved the question of the validity of 24 of the 28 claims plaintiff was asserting is outside the bounds of legitimate advocacy," and it characterized the assertions of defendant's counsel before the district court as "absurd" and "disappointing." Id. at 1331, 5 U.S.P.Q.2d at 1268.

103. Id. at 1330, 5 U.S.P.Q.2d at 1267 (quoting Judge Grady's memorandum opinion dated September 11, 1987).

104. Id. at 1331, 5 U.S.P.Q.2d at 1268. But see Datascope Corp. v. SMEC, Inc., 776 F.2d 320, 327, 227 U.S.P.Q. 838, 844 (Fed. Cir. 1985) (patent claims not at issue were improperly held invalid, where SMEC did not counterclaim for a declaratory judgment of invalidity of all claims).


106. Id. at 1313, 75 U.S.P.Q.2d at 1253.

107. Id. at 1313, 75 U.S.P.Q.2d at 1253.

108. Id. at 1313, 75 U.S.P.Q.2d at 1253.

109. Id. at 1313, 75 U.S.P.Q.2d at 1253; see also Verizon Cal. Inc. v. Ronald A. Katz Tech. Licensing, L.P., No. CV 01-9871-RGK (RCx) (C.D. Calif. Mar. 3, 2004) (order re representative claims) (lack of specificity in the scheduling order creating the representative claims process supported a conclusion that the representative claims were only a "test case" designed to advance settlement of the entire dispute; there must be an agreement and understanding between the parties about the significance of the representative claims if they are to dispose of all causes of action).
were representative of the claims at issue.\textsuperscript{110} The defendant then moved to exclude any evidence of validity or infringement regarding any patent claim other than the three representative claims.\textsuperscript{111} The district court denied defendant's motion, stating that merely because Grace agreed that three claims were "representative" did not mean that Grace agreed that these three claims were "exclusive."\textsuperscript{112} The court held that the stipulation between the parties was not preclusive in nature, and the defendant could not be permitted to bar evidence relating to most of Grace's claims through a "strained reading" of the pretrial stipulation and order.\textsuperscript{113}

### B. A Determination That One Representative Claim Is Infringed Will Generally Apply To All Asserted Claims

Just as the validity of claims must be determined on a claim-by-claim basis, infringement must likewise be adjudged with respect to each individual claim.\textsuperscript{114} "Infringement generally exists if any one of a patent's claims covers the alleged infringer's product or process."\textsuperscript{115} Nevertheless, as with determinations of validity, a finding that the representative claims are infringed will likely apply to the remaining asserted claims as well.

For example, in \textit{McDonnell Douglas Corp. v. United States}, the Court of Claims observed that the parties "have treated [claims 1 and 6] as representative of the claims allegedly infringed, and so shall we."\textsuperscript{116} As a result, the court limited its analysis to those representative claims and concluded that the plaintiff had no valid

\begin{itemize}
  \item \textsuperscript{111} \textit{id}.
  \item \textsuperscript{112} \textit{id}.
  \item \textsuperscript{113} \textit{id} at \*7-*8.
  \item \textsuperscript{114} \textit{Chisum on Patents}, \textit{supra} note 8, \S 18.03, at 18-71 ("Determination of infringement requires a construction of the meaning of the claim language and then application of the claims as construed to the accused product or process."); Phillips v. AWH Corp., 415 F.3d 1303, 1312 (Fed. Cir. 2005) (en banc) ("It is a 'bedrock principle' of patent law 'that the claims of a patent define the invention to which the patentee is entitled the right to exclude."); Autogiro Co. of Am. v. U.S., 384 F.2d 391, 395-96, 155 U.S.P.Q. 697, 701 (Ct. Cl. 1967) ("The claims of the patent provide the concise formal definition of the invention... It is to these wordings that we must look to determine whether there has been infringement.").
claim against defendant for patent infringement because the invention had not yet been reduced to practice when McDonnell Douglas first disclosed it to the government.117

Nevertheless, a finding of infringement may not extend to claims that were not actually asserted in the action. In Tol-O-Matic, Inc. v. Proma Produkt-Und Marketing Gesellschaft m.b.H., the parties stipulated that claim 25 was representative of claims 25-31, the only claims that were litigated.118 Tol-O-Matic, the alleged infringer, only requested jury findings on claim 25.119 After claims 25-31 were found not infringed, Tol-O-Matic asserted that claims 1-24 and 32 had also been placed in issue by the pleadings and that the judgment of noninfringement should have included these claims.120 The court disagreed and stated that pleadings do not suffice to support a judgment when the subject matter was not litigated, or fairly placed in issue, during the trial. There must be sufficient and explicit notice of the claims at risk.121

C. It Is Unclear How Courts Will Treat Cases With Mixed Findings Of Validity And/Or Infringement

It is relatively clear that a finding of validity or infringement relating to the representative claims will apply to the remaining asserted claims.122 However, the outcome seems less than certain where a trial court finds either that only some of the representative claims are valid and that others are invalid, or that only some of the representative claims are infringed and others are not.123 It is unclear precisely how courts will apply a split outcome to the other asserted claims.124

In Paper Converting Machine Co. v. Magna-Graphics Corp., the parties addressed the possibility of a split outcome in their stipulation

117. See id. at 163, 214 U.S.P.Q. at 862.
120. Id. at 1554, 20 U.S.P.Q.2d at 1339.
121. Id. at 1554-55, 20 U.S.P.Q.2d at 1339-40.
122. See supra Section II-A and II-B.
123. See supra Section II-A and II-B.
124. Statistical data indicates that a split decision of this sort may be an unlikely result in any event. See John R. Allison and Mark A. Lemley, Empirical Evidence on the Validity of Litigated Patents, 26 A.I.P.L.A. Q. J. 185, 245 (1998). In 86.7 percent of cases reviewed involving multiple patents in suit, the patents in the case were either all held valid together or all held invalid together. Id. Courts produced “mixed” results in only 13.3 percent of cases. Id.
providing for the use of representative claims.\footnote{125} There, the parties agreed that:

Representative claims in suit are nos. 1, 4, 5 and 13. If any of said claims is held to be valid and infringed by the accused machine, plaintiff shall be entitled to an injunction restraining defendant from infringement of such claim \textit{all other claims} of the patent in suit that are generally similar to it; whereas if none of claims 1, 4, 5 and 13 is held valid and infringed, then plaintiff will not assert that any other claim of the patent in suit is infringed.\footnote{126}

Notably, although the court found that claims 1, 4, 5 and 13 were valid and infringed, and it awarded injunctive relief and treble damages, the court did not consider which other claims of the patent were "generally similar" to the representative claims.\footnote{127}

Even in the relatively unlikely event of a mixed decision, collateral estoppel may apply to nonlitigated claims of a patent where the issue of invalidity common to each action is substantially identical.\footnote{128} "It is the issues litigated, not the specific claims around which the issues were framed, that is determinative."\footnote{129} As a result, where only some of the representative claims are found to be invalid, the patent owner may nevertheless find that it is collaterally estopped from litigating the validity of other, non-representative claims in the future.

\textbf{D. A Finding Of Invalidity Of Representative Claims May Extend To Claims Not Asserted In The Action}

In \textit{Blonder Tongue Laboratories, Inc. v. University of Illinois Foundation}, the Supreme Court held that a judgment of invalidity in a suit against one infringer accrues to the benefit of any other accused infringer unless the patent owner shows that it did not have a fair opportunity procedurally, substantively and evidentially to pursue its claim the first time.\footnote{130} Moreover, \textit{Blonder-Tongue} has been extended to claims not actually adjudicated as invalid, to the extent those

\begin{flushleft}
\footnote{125}{Paper Converting Mach. Co. v. Magna-Graphics Corp., 680 F.2d 483 (7th Cir. 1982).}
\footnote{126}{\textit{Id.} at 485 (emphasis added).}
\footnote{127}{\textit{See Id.} at 485-86.}
\footnote{128}{Westwood Chem., Inc. v. U.S., 525 F.2d 1367, 1372 (Ct. Cl. 1975).}
\footnote{129}{\textit{Id.}}
\footnote{130}{Blonder-Tongue Labs., Inc. v. Univ. of Ill. Found., 402 U.S. 313, 333 (1971); CHISUM ON PATENTS, \textit{supra} note 8, \S 19.02[2][a], at 19-52.}
\end{flushleft}
claims present issues that are common to claims previously found to be invalid.  

In Bourns, Inc. v. United States, the Court of Claims explained that it made sense to extend the Blonder-Tongue ruling to claims that have not been litigated, because the nature of patentees is to seek multiple duplicative claims. Courts have long recognized that the claims of a patent may be repeated and duplicated, varying one from the other only in certain minor details. Claims may be multiplied because there are several facets to an invention or because the applicant hopes to define the scope of the invention in different ways. However, the court observed:

The realities of patent practice suggest that, merely because the invention, the patentee's contribution to the art, is presented in varying language or varying combinations of elements does not necessarily mean that the issues bearing on the nonobviousness of that concept or contribution vary from one claim to the next. ... That each of several differently worded claims may present identical issues is apparent from the rather common practice of selecting representative claims and stipulating that the validity of a group of claims may be determined on the basis of the representative claims.

The court then held that a finding of validity is applicable to unadjudicated claims where it is shown that the adjudicated and unadjudicated claims presented identical issues.

As a result, a finding of invalidity of the representative claims will likely extend not only to other claims that were asserted by the patentee in the litigation, but also to unasserted claims to the extent that identical issues are involved. Further, it is unlikely that a

131. See Bourns, Inc. v. United States, 537 F.2d 486, 187 U.S.P.Q. 174 (Ct. Cl. 1976); see also CHISUM ON PATENTS, supra note 8, §§ 19.02[2], at 19-51, 19.02[2][c], at 19-63.


133. Id. at 491, 187 U.S.P.Q. at 178.

134. Id. at 492, 187 U.S.P.Q. at 178.


137. See Symbol Techs., Inc. v. Lemelson Med., Educ. & Research Found., L.P., No. CV-S-01-701-PMP (RJJ) (D. Nev. May 27, 2004) (order denying motion to alter or amend judgment). The district court's findings and conclusions regarding lack of enablement applied to all of Lemelson's patent claims. Id. at 3-4. The evidence supporting a finding of lack of enablement applied to Lemelson's "invention" and not merely to any representative claim or asserted claim at issue. Id. at 4. Collateral estoppel therefore precluded Lemelson from relitigating this issue. Id.

Similarly, the court's finding of infringement was not limited to the 76 representative claims: "Under the claim interpretation made by the Court, none of the remaining patent claims could be
patent owner could successfully argue that such collateral estoppel effect should not apply to unasserted claims because the determination of invalidity was reached in a case tried on the basis of representative claims. Although Blonder-Tongue lists a number of factors that are relevant to a determination of whether a patentee had a "fair opportunity procedurally, substantively, and evidentially to pursue his claim," the courts have been extremely reluctant to find that a patent owner did not enjoy a full and fair opportunity to litigate its claims.

E. Courts Are Skeptical Of Arguments Contending That A Court-Imposed Representative Claims Process Violates The Patent Holder's Constitutional Rights

In many cases, the parties will agree to try their entire case on the basis of a few representative claims. Although it has not addressed the question directly, the Federal Circuit apparently believes that district courts also have the authority to order a patent owner to designate representative claims that will determine the outcome of all claims asserted. For instance, in ReRoof America, Inc. v. United Structures of America, Inc., plaintiff ReRoof argued that the trial court abused its discretion by forcing it to select five representative claims (i.e., a single claim from each of the five patents-in-suit) out of the 18 "illustrative" claims that ReRoof was previously ordered to designate. ReRoof claimed that limiting it to

inflicted because all of the remaining claims contain one or more limitations construed by the Court to lead to a finding of noninfringement." Id. Collateral estoppel therefore precluded relitigation of those issues as well. Id.

138. Some of the factors relevant to this determination include: (1) whether the patentee was the party instituting the prior suit and chose the forum; (2) whether the patentee had an incentive to conclude the litigation against the defendant in the prior case; (3) whether the first validity determination was based on the standards announced in Graham v. John Deere Co., 383 U.S. 1 (1966); (4) whether the decisions of the district court and appellate court indicate that those courts "wholly fail to grasp" the technical subject matter of the patents and the issues in the suit; and (5) "whether without fault of his own the patentee was deprived of crucial evidence or witnesses in the first litigation." See CHISUM ON PATENTS, supra note 8, § 19.02[2][b], at 19-54.

139. Id.


142. Id. at *4.
only five claims disabled it from proving the full range of the defendant's infringing activities. 143

The Federal Circuit held that ReRoof failed to show that it was prejudiced by the court-ordered reduction in the number of claims it was allowed to present to the jury. 144 In the first place, ReRoof acknowledged that the court did not err by initially requiring it to reduce its claims for trial to the 18 illustrative claims. 145 Further, the various claims of the five patents-in-suit overlapped "very substantially," and the court observed that in light of the way the jury disposed of the five tried claims, it was convinced there was no reasonable likelihood that a trial including the 13 untied claims would have resulted in a verdict affording ReRoof any relief. 146

Likewise, in Kearns v. General Motors Corp., the Federal Circuit held that the trial court did not abuse its discretion by dismissing Kearns' case against General Motors (GM) with prejudice, where Kearns ignored multiple district court orders requiring him to identify which claims he was asserting and then to limit the asserted claims to no more than one representative claim per patent-in-suit. 147 Instead of doing as the court required, Kearns indicated that he was asserting every claim of every patent he owned, not just the five patents-in-suit. 148 The district court considered other options before dismissing the case, including allowing the special master to designate a limited number of claims or having the trial court designate the claims on its own, but it decided that dismissal was more appropriate in light of Kearns' repeated refusal to obey pretrial orders. 149 The Federal Circuit found that Kearns' refusal to prosecute prejudiced GM, and therefore the decision of the district court dismissing the case was affirmed. 150

143. Id.
144. Id.
145. An order from the district court indicates that Reroof selected the 18 illustrative claims of its own volition, for purposes of its proposed claim construction. ReRoof Am., Inc. v. United Structures of Am., Inc., No. 96-C-388-K, at 2 (N.D. Okla. Oct. 15, 1997) (order denying motion to strike Reroof's Markman brief). Reroof originally asserted 63 claims from five patents, and the district court directed it to limit the asserted claims. Id. at 2. Reroof responded by identifying the 18 illustrative claims contained in its Markman brief. Id. It is therefore unclear that ReRoof actually acquiesced in making the first cut, as the Court suggested.
148. Id. at *1.
While many patent owners will agree to try their cases on the basis of representative claims, others may attempt to challenge the trial court's right to require them to designate a few claims that will be determinative of the outcome of the entire case. For instance, a patent owner may view this requirement as a violation of its Constitutional or other rights, or it could argue that it is entitled to a full and fair hearing on each claim that it alleges to be infringed. Serious questions may be raised concerning the trial court's ability to impose a representative claims procedure on an unwilling patent holder.

1. Courts Are Unlikely To Find That A Judicially-Imposed Representative Claims Process Violates The Patent Owner's Due Process Rights

A patent owner who has been ordered by the trial court to designate representative claims that will be determinative of its entire action, and that may also have collateral estoppel effect on other unasserted claims, may be tempted to argue that it has been deprived of due process of law. Generally, due process requires that all litigants be given notice and an opportunity to be heard. In United States v. St. Paul Fire & Marine Insurance Co., the court observed, "Due process requires that all conflicts over legal rights and obligations be adjudicated in a court of law. ... No right is more basic than the right to have a court of law adjudicate one's disputes."152 Depriving a patentee of the opportunity to present each of its claims at trial could be viewed as the equivalent of depriving the patent owner of its property rights in the independent inventions embodied in each separate claim. The courts have traditionally characterized patent as property rights.153 Many years ago, the Supreme Court stated, "A patent for an invention is as much property as a patent for land. The right rests on the same foundation, and is surrounded and protected by the same sanctions."154 The Patent Act provides that a patent grants to the patentee "the right to exclude others from making, using, offering for sale, or selling the invention

154. Id.; Patlex Corp. v. Mosinghoff, 758 F.2d 594, 599, 225 U.S.P.Q. 243, 246 (Fed. Cir. 1985) (patent property rights "fall squarely within both classical and judicial definitions of protectible property").
throughout the United States." The right to exclude recognized by a patent is the essence of the concept of property rights generally. The right to exclude others from using one's patent claims is, therefore, a fundamental right of the inventor. "It is a property right... of which the patentee cannot be deprived without due process of law." Further, each patent claim is a separate and independent invention. For that reason, infringement and validity analyses must be performed on a claim-by-claim basis. Consequently, a patent owner who is forced to proceed on the basis of representative claims may assert that he has been denied due process of law. However, such an argument may not be compelling to the courts.

In *Bourns*, the Court of Claims determined that collateral estoppel applied to unadjudicated claims where it was shown that adjudicated and unadjudicated claims presented identical issues. The court observed:

In reaching that conclusion, recognition is given to plaintiff's arguments regarding due process and the further argument that

156. Connell v. Sears, Roebuck & Co., 722 F.2d 1542, 1548, 220 U.S.P.Q. 193, 198 (Fed. Cir. 1983); see also Patlex, 758 F.2d at 599-600, 225 U.S.P.Q. at 247:

The encouragement of investment-based risk is the fundamental purpose of the patent grant, and is based directly on the right to exclude. As the Supreme Court observed in Kaiser Aetna v. United States, 444 U.S. 164, 176, 100 S.Ct. 383, 391, 62 L.Ed.2d 332 (1979), the "right to exclude others" is "one of the most essential sticks in the bundle of rights that are commonly characterized as property."

157. Johnson & Johnson, Inc. v. Wallace A. Erickson & Co., 627 F.2d 57, 59, 206 U.S.P.Q. 873, 876 (7th Cir. 1980). See also Polymer Techs., Inc. v. Bridwell, 103 F.3d 970, 976, 41 U.S.P.Q.2d 1185, 1190 (Fed. Cir. 1996) (the principal value of a patent is its statutory right to exclude; the right to exclude others from a specific market, no matter how large or how small, is an essential element of the patent right).


159. Bio-Tech. Gen. Corp. v. Genentech, Inc., 80 F.3d 1553, 1562, 38 U.S.P.Q.2d 1321, 1327 (Fed. Cir. 1996) ("Infringement of one valid and enforceable patent claim is all that is required for liability to arise."); 35 U.S.C. § 282 (2000) ("Each claim of a patent (whether in independent, dependent, or multiple dependent form) shall be presumed valid independently of the validity of the other claims; dependent or multiple dependent claims shall be presumed valid even though dependent upon an invalid claim.").

160. Compare the situation where a plaintiff sues defendant for two separate breaches of contract and five unrelated tort claims, and the trial court insists that the outcome of the entire case will be determined by a limited trial on only one contract breach and one tort. There is little chance that the appellate courts would tolerate such a result. The difference, of course, is that in a typical patent infringement case, the claims-in-suit are often closely related and overlap considerably.

each claim is to be presumed valid and treated as a complete and
independent invention. However, by focusing on the issues of fact
and law necessary to a resolution of the obviousness issue, ... a
determination can be made whether the unadjudicated claims
present any new issues which, to afford due process, would require
a trial on the merits, or whether litigation on those claims would
simply be a 'repetitious lawsuit over matters which have once
already been decided.' ... Stated otherwise, if a patentee has once
been heard on all the factual issues necessary to an obviousness
determination, and that determination already has been made
adversely to one claim, neither due process nor any provision of
the patent statute would appear to require that the patentee be
heard once again on those same issues and on the same
obviousness determination simply because a different claim is
involved. It is believed that a proper application of Blonder-
Tongue should preclude just such relitigation of the issues.162

As a result, a court would be unlikely to find that a judicially-
imposed representative claims process resulted in the denial of a
patentee’s due process rights, when all issues relating to infringement
and validity were encompassed within the trial of the representative
claims. This holds true even where the representative claims were
determinative of all asserted claims and had collateral estoppel effect
over other unasserted claims.

2. When The Trial Court Orders A Patent Owner To
Designate Representative Claims, Seventh Amendment
Arguments May Apply

A patentee who has been ordered by the trial court to limit its
case to a few representative claims may also potentially argue that it
has been deprived of its right to a jury trial under the Seventh
Amendment to the United States Constitution.163 The Seventh
Amendment declares that in suits at common law, “the right of trial
by jury shall be preserved.”164 In Markman v. Westview Instruments,
Inc., the Supreme Court observed, “There is no dispute that
infringement cases today must be tried to a jury, as their predecessors

162. Id.
163. See Brian D. Coggio and Timothy E. DeMasi, The Right to a Jury Trial in Actions for
Patent Infringement and Suits for Declaratory Judgment, 13 FORDHAM INTLL. PROP. MEDIA &
by civil action for infringement of his patent.”); 35 U.S.C. § 284 (2000) (“When damages are
not found by a jury, the court shall assess them.”).
164. U.S. CONST. amend. VII.
were more than two centuries ago."\textsuperscript{165} Nevertheless, the Supreme Court then held that the interpretation of the words of a patent claim is a matter for the court, not the jury, thus severely circumscribing the role of the jury in patent litigation.\textsuperscript{166}

In \textit{In re Lockwood}, an important but non-precedential decision, the Federal Circuit made clear that a patentee has a right to trial by jury when legal, as opposed to equitable, rights are at issue.\textsuperscript{167} The Court explained that, in order to determine whether a particular action involves legal or equitable rights, "we examine both the nature of the issues involved and the nature of the remedy sought."\textsuperscript{168} The test for statutory actions such as patent suits involves two steps: "First, we compare the statutory action to 18th century actions brought in the courts of England prior to the merger of the courts of law and equity. Second, we examine the remedy sought and determine whether it is legal or equitable in nature."\textsuperscript{169} Thus, if a particular action involves either the adjudication of legal rights or the implementation of legal remedies, the district court must honor a request for a jury trial to the extent such a request has been made and disputed issues of fact exist. The Court concluded that the patentee was entitled to a jury trial as a matter of right on the defendant airline's counterclaim for a declaration that the patents-in-suit were invalid, because the patentee's complaint for patent infringement sought both money damages and injunctive relief.\textsuperscript{170}

It is therefore clear that, in those cases where the patentee is seeking an award of money damages, it has a right to try its case to a jury. The Supreme Court has stated that "[m]aintenance of the jury as

\textsuperscript{165} Markman v. Westview Instruments, Inc., 517 U.S. 370, 377 (1996). Note that in \textit{Markman}, the plaintiff was seeking an award of money damages. \textit{Id.} at 376.

\textsuperscript{166} \textit{Id.} at 391.

\textsuperscript{167} \textit{In re Lockwood}, 50 F.3d 966, 972 (Fed. Cir.), vacated, 515 U.S. 1182 (1995). Note that in \textit{Tegal Corp. v. Tokyo Electron Am., Inc.}, 257 F.3d 1331, 1340, 59 U.S.P.Q.2d 1385, 1391-92 (Fed. Cir. 2001), the Federal Circuit observed that it provided a relevant and detailed analysis of the right to trial by jury in a patent infringement action in the Lockwood opinion. The Supreme Court vacated Lockwood without explanation. "Thus our analysis has been neither supplanted nor questioned. Although no longer binding, we find it's reasoning pertinent." \textit{Id.} at 1340, 59 U.S.P.Q.2d at 1391-92.

\textsuperscript{168} \textit{Lockwood}, 50 F.3d at 972.

\textsuperscript{169} \textit{Id.} (quoting Chauffeurs Local No. 391 v. Terry, 494 U.S. 558, 565 (1990)). See also \textit{Markman}, 517 U.S. at 377.

\textsuperscript{170} Subsequently, in \textit{Tegal}, 257 F.3d at 1341, 59 U.S.P.Q.2d at 1392, the Federal Circuit held that a defendant, asserting only affirmative defenses and no counterclaims, does not have a right to a jury trial in a patent infringement suit if the only remedy sought by the plaintiff-patentee is an injunction. Because the action was equitable in nature and the only remedy sought (an injunction) was equitable, there was no right to a jury trial.
a fact-finding body is of such importance and occupies so firm a place in
our history and jurisprudence that any seeming curtailment of the
right to a jury trial should be scrutinized with the utmost care."\textsuperscript{171} The
patent owner who has been forced by the court to try its case on the
basis of a few representative claims may therefore be able to
successfully argue that it has been deprived of its rights under the
Seventh Amendment because the court has not permitted it to present
its claims to the jury.\textsuperscript{172} However, it may also run squarely into the
same types of arguments that would defeat a claim for denial of due
process — if all relevant issues relating to validity and infringement
are heard by the jury, it may be determined that the patentee has had
his day in court.\textsuperscript{173}

3. Courts Should Limit The Use Of Representative Claims
To Those Cases Where The Parties Agree To Be Bound
By That Procedure

Given the serious nature of the questions that exist concerning
the propriety of the representative claims process, courts would be
well advised to limit the representative claims process to those
instances where the parties express a willingness to try their case on the basis of representative claims. Courts should exercise caution in compelling parties to engage in a representative claims procedure where the parties express reluctance to do so. In cases involving reluctant parties, courts should attempt to have the parties consent to be bound by the process.

Trial judges should have the parties reach agreement on a limited number of representative claims. Although both sides will resist for fear of possibly giving up something, the narrowing process can and does work effectively. The court should encourage the defendant to agree that if it is found liable for infringing the representative claims, and those claims are not invalid, the finding of infringement will be applicable to all asserted claims. The plaintiff should be encouraged to agree that if it loses on the representative claims, it will lose on all claims. The parties may also reach consensus about what effect, if any, a damages award will have on the other asserted claims, and they may consent to try their case on the basis of a few representative models of defendant’s products. The court should allow the parties to propose the representative claims and models that will decide the case, and it should become involved only where the parties cannot come to an agreement. Thus, the representative claims procedures should be characterized by minimal court involvement and should focus on crafting an agreement where the risks are shared equally between the plaintiff and the defendant.

F. The Representative Claims Process May Provide The Best Means Of Presenting An Understandable Case To The Judge And Jury

Several commentators have stressed the advantages of avoiding the often complex and confusing process of applying patent claims to an accused activity. Cases are often decided by conscious or

175. Id.
176. Id. at 21-22. See also David F. Herr, Annotated Manual For Complex Litigation § 33.23, at 653 (4th ed. 2005) (“Cases involving multiple patents, each with multiple claims, can be a source of confusion, resulting in unduly lengthened and expanded pretrial and trial proceedings. Consider encouraging the parties to agree to proceed on a limited number of representative claims and disputed models, so that findings regarding infringement on the representative claims will apply to all claims. This may simplify the action and reduce jury confusion.”).
177. See Horowitz & Horowitz, Patent Litigation: Procedure & Tactics § 8.01[2], at 8-6.1 to 8-7.
unconscious substitution of a more convenient definition of the invention for the terms in which it is expressed in the patent.\textsuperscript{178}

When the patent owner presents a simple and straightforward position which is clear in its basic aspects to the court, it falls to the accused infringer to undertake the chore of dealing with the details of the claims, an activity which may subject him to the court’s conclusion that reliance is being placed upon technicalities and hair-splitting distinctions for the purpose of overcoming a meritorious case. The decision by the patent owner to dispense with an elaborate analysis of the claims as a part of the presentation of his case in chief normally will not result in the loss of an opportunity to make a record in this area, for the accused infringer usually challenges the showing of infringement during the presentation of his case in opposition.\textsuperscript{179}

A patent owner may therefore make a strategic decision that voluntarily limiting its case to a few, carefully selected representative claims may be its best chance of presenting a case that is comprehensible to both judge and jury.\textsuperscript{180} It has also been suggested that, since the Markman decision, trying a case on the basis of a few representative claims is advisable, since the jury must now be instructed on the interpretation of the claims.\textsuperscript{181}

\textbf{G. A Patent Owner Has Several Strategies Available For The Selection Of Representative Claims}

A patent owner who either consents to have its case tried on the basis of representative claims, or who is ordered by the court to select representative claims, will be faced with a number of different competing considerations, including validity, enforceability, and infringement of the patents-in-suit. On the one hand, the patentee will want to designate a few narrow claims that it is confident will

\textsuperscript{178} Id. at 8-7.

\textsuperscript{179} Id.

\textsuperscript{180} The Horwitzes also argue that, in patent litigation, there is a potential hazard of becoming lost in the details and losing sight of the goal. \textit{Id.} \S 6.0112[2], at 6-5. It is therefore recommended that a dominant theme be established in every case. \textit{Id.} They stress that, unlike a proceeding before the PTO, the judge and the jury are usually possessed of little background in the technical area in dispute. \textit{Id.} at 6-6. Such arguments may also weigh in favor of the patentee agreeing to try his case on the basis of representative claims.

\textsuperscript{181} David H. Binney and Toussaint L. Myricks, \textit{Patent Claim Interpretation After Markman – How Have The Trial Courts Adopted?}, 38 IDEA 155, 185 (1997) (“Because the jury must now be instructed as to the interpretation of the claims, it may become more desirable to try the case based on representative claims, or with special verdict forms aimed at establishing whether individual elements common to more than one of the claims have been satisfied.”).
withstand any challenge to validity. Conversely, the patentee will also want to select very broad claims, so that it will be satisfied that infringement can be proven. If a plaintiff is limited to just a few claims, it would be well advised to select the narrowest claims possible where it is still reasonably certain that infringement can be proven without casting doubt upon the validity of the patents.

In addition, the patent owner selecting representative claims should also give consideration to the breadth of the injunction and the potential damages award that it can reasonably expect to receive if it proves that the selected claims are infringed. The patent owner should evaluate the impact that a final judgment on the representative claims will likely have on the defendant’s business.

In order to maximize the amount of money damages it can collect, the plaintiff patentee will want to select broad claims that will encompass as many of defendant's products as possible. In addition, the patent owner should select a few claims that are not newly issued, if it wishes to collect damages for the full six years prior to filing the complaint for infringement as authorized by 35 U.S.C. § 286 (2000). However, if the patent owner wants to maximize the length of injunction going forward after a finding of infringement, it will want to choose claims from more recently issued patents that have many years of life remaining. Again, in order to maximize the impact of an injunction, the patentee should select claims that are sufficiently broad to encompass as many of defendant's products as possible.

H. The Court And The Parties Must Consider Timing In The Selection Of Representative Claims

Another issue of concern to both parties is the point in the case when representative claims should be designated. The patent owner will want to select its representative claims fairly late in discovery, so that it can accumulate as much information as possible about the accused products or methods before designating the claims that will be determinative of its action. If plaintiff is forced to select representative claims too early in discovery, there is a danger that it will make poor and uneducated choices and the claims will not be truly representative.

The accused infringer, on the other hand, will undoubtedly argue that it will be prejudiced if plaintiff does not have to identify representative claims until the close of discovery. The defendant will contend that it may incur huge costs in having its expert witnesses evaluate infringement and validity of all asserted claims, rather than
limiting these evaluations to a few representative claims. Similarly, the defendant will object to conducting a prior art search that encompasses all asserted claims, which could be extremely expensive and time consuming.

Based on the considerations of both parties, a few guidelines can be proposed for the timing of selecting representative claims. Selection of representative claims should occur late in the discovery period, but it should not necessarily be postponed until the very end of discovery. In any event, representative claims must be identified before either party's expert reports are due, and sufficiently in advance of that date so that both party's experts will not be required to perform expensive analysis of claims that will not be presented to the jury. Identifying representative claims after the exchange of expert reports would frustrate the purpose of simplifying the issues and reducing the expense of the litigation. Likewise, selection of representative claims should also predate the Markman hearing; otherwise, the parties will be required to brief, and the court will be required to construe, all asserted claims rather than just those representative claims on which the case will turn. 182

IV. CONCLUSION

The Board and the courts frequently rely on representative patent claims to determine the patentability or infringement of a larger group of claims. This practice is justified as promoting efficiency and reducing jury confusion.

An applicant for a patent may appeal to the Board following a twice or final rejection and may elect to argue the patentability of rejected claims separately or as a group. However, the Board may decide the appeal on the basis of a single claim only when the applicant elects group treatment for multiple claims subject to the

182. Note that the Patent Local Rules of Practice for the United States District Court for the Northern District of California, which are frequently used as a model by other district courts as well, make no provision for the designation of representative claims. Patent L.R. (N.D. Cal. 2001). Local Rule 3-1 requires a party claiming patent infringement to serve on all parties a Disclosure of Asserted Claims and Preliminary Infringement Contentions, which identifies each claim of each patent in suit that is allegedly infringed by each opposing party not later than 10 days after the Initial Case Management Conference. Patent L.R. 3-1 (N.D. Cal. 2001). Local Rule 3-3 requires that, not later than 45 days afterward, each party opposing a claim of patent infringement must serve its Preliminary Invalidation Contentions, which must include the identity of each item of prior art that allegedly anticipates each asserted claim or renders it obvious. Patent L.R. 3-3 (N.D. Cal. 2001). Thus, the Local Rules actually provide for the exchange of pleadings that address all claims of all patents, instead of just the select claims that will be representative of all claims-in-suit.
same ground of rejection. Even if an applicant erroneously groups together claims that were not subject to the same ground of rejection, it is unlikely that the Board would be permitted to construe the applicant's statement as a waiver of separate treatment.

In patent litigation, a representative claims procedure may be utilized as a result of an accommodation between the parties intended to narrow the issues, or the selection of representative claims may be required by the court to prevent a protracted trial. Generally, the parties will agree that the outcome with respect to the representative claims will be determinative of all issues in the litigation. However, any determination of patent validity may also have collateral estoppel effect on other, unasserted claims, where identical issues are presented.

A disgruntled patent owner who has been ordered by the court to select only a few representative claims may attempt to argue that it has been deprived of due process or the right to a jury trial; however, the ultimate success of such arguments is questionable. Courts will likely determine that a patentee's rights have been satisfied if it has an opportunity to be heard on all of the underlying issues, even if it is prevented from arguing each asserted claim separately. As a result, patent owners should take a number of factors into consideration when selecting representative claims, including validity and infringement, as well as the potential damages award or injunction that may result from the claims that are designated. By strategically selecting a few representative claims, the patent owner may best be able to present a straightforward position that is comprehensible to both judge and jury.