USPTO Director Issues Precedential Review Decision Regarding Multiple Dependent Claims

Director Katherine Vidal of the U.S. Patent and Trademark Office ("USPTO") issued a precedential review decision with respect to the interpretation of multiple dependent claims, in a case of first impression before the Patent and Trial Appeal Board ("PTAB"). In the review of the PTAB's final written Decision and Order, the Director modified it consistent with her determination of the treatment of multiple dependent claims, which are claims that refer to and incorporate by reference more than one other claim.

More specifically, at issue in the *inter partes* review captioned, Nested Bean, Inc. v. Big Beings Pty Ltd., was the interpretation of 35 U.S.C. § 112, fifth paragraph, which is the controlling statute for multiple dependent claims. The Patent Owner contended that the statute requires the PTAB to consider the patentability of each claim referenced separately. In contrast, the Petitioner argued that if any claim of a multiple dependent claim is unpatentable, then the entire claim is unpatentable. For the reasons that follow, the Director agreed with the Patent Owner.

35 U.S.C. § 112, fifth paragraph, states in relevant part, "[a] multiple dependent claim shall be construed to incorporate by reference all the limitations of the particular claim in relation to which it is being considered." The related Codified Rule, 37 C.F.R. § 1.75(c) states, in relevant part, "[a] multiple dependent claim shall be construed to incorporate by reference all the limitations of each of the particular claims in relation to which it is being considered." With other statutes and Rules considered, the Director reasoned that the plain language of 35 U.S.C. § 112, fifth paragraph, conveys that a multiple dependent claim is the equivalent of several single dependent claims.

In addition to relying upon the applicable statute and Rules, the Director also considered Federal Circuit case law, legislative history, and USPTO procedure.

More specifically, with respect to precedent, neither party identified a judicial or administrative decision addressing the issue at hand. However, the Director found that Federal Circuit cases identified were supportive of the Patent Owner's position.

The Director found that USPTO guidance and procedures further supported the Patent Owner's interpretation. For example, the Manual for Patent Examining Practice (M.P.E.P.) advises examiners that "a multiple dependent claim must be considered in the same manner as a plurality of single dependent claims." M.P.E.P. § 608.01(n)(I)(B)(4).[1] Further, as the Director found, the USPTO claim fee structure is such that applicants must pay separately for each multiple dependent combination, e.g., for a multiple dependent claim that refers to three independent claims, the USPTO charges for three dependent claims.

Thus, after reviewing the PTAB's Decision and the relevant information, Director Vidal

acknowledged that it was an issue of first impression before the Board. And based on the plain meaning of the statute, 35 U.S.C. § 112, fifth paragraph, requires that the patentability of a multiple dependent claim be considered separately with respect to each claim to which it refers. Accordingly, the Director's Review Decision modifies the PTAB's final written Decision and Order consistent with her interpretation of determining the patentability of multiple dependent claims, each separately as if multiple single dependent claims.

The Director's Review Decision clarifies the interpretation of U.S. patents containing multiple dependent claims and determining the patentability thereof. In particular, a patentee now knows that each claim of a multiple dependent claim should stand or fall by itself, independent of the invalidity of other dependent claims of the same multiple dependent claim.

[1] Eighth Ed., Rev. 7 (July 2008), which was the version in effect as of the earliest priority date of the relevant patent.