Commissioner of Patents and Trademarks
Patent and Trademark Office (P.T.O.)

IN RE APPLICATION OF ALFRED A. FRESSOLA
Patent Application 07/1230,748
Attorney Docket No. 407,001
February 19, 1992
***1** Filed: August 10, 1988

Harry F. Manbeck, Jr.

Commissioner of Patents and Trademarks

ON PETITION

This is a decision on a petition under 37 CFR § 1.181, filed October 19, 1990, to withdraw the objection of claims 19-21 for having multiple sentences and to modify the Manual of Patent Examining Procedure (MPEP) § 608.01(m) to permit multiple sentence claims.

The petition is denied.

BACKGROUND

Independent claim 19 was objected to as written in the form of nine individual sentences rather than as a single sentence required by the Patent and Trademark Office (PTO) under MPEP § 608.01(m) (5th ed., Rev. 13, Nov. 1989). Claims 20 and 21 are written in single sentence form but are dependent upon claim 19 and, therefore, were similarly objected to.

Petitioner contends that MPEP § 608.01(m) has no basis in Title 35of the United States Code or in Title 37 of the Code of Federal Regulations to prohibit the allowance of a claim having multiple sentences.

OPINION

The statutory requirement for claims is contained in 35 U.S.C. § 112, second paragraph, which states that

> The specifications shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

The statute does not prescribe a set claim form; nor is a set claim form required by 37 CFR § 1.75. The single sentence claim requirement of MPEP § 608.01(m) is a matter of form under PTO practice. In reviewing the lawfulness of MPEP provisions, as stated in Patlex Corp. v. Mossinghoff, 758 F.2d 594, 606, 225 USPQ 243, 252, modified, reh'g granted in part, 771 F.2d 480, 226 USPQ 985 (Fed.Cir.1985):

> The PTO operates in accordance with detailed rules and regulations, including those set out in the Manual of Patent Examining Procedure

(MPEP) which is made available to the public and which has been held to describe procedures on which the public can rely. In re Kaghan, 387 F.2d 398, 401, 156 USPQ 130, 132 (CCPA 1967). Our standard for review is whether the rule or procedure is within the agency's statutory authority and is reasonably related to the purposes of the enabling legislation, Mourning v. Family Publications Service, Inc., 411 U.S. 356, 369 (1973), and does no violence to due process. Mathews v. Eldridge, 424 U.S. 319 (1976). [Cross-citations omitted.]
The single sentence claim requirement is within the PTO's statutory authority and is consistent with the statutory purpose of 35 U.S.C. § 112 ¶ 2.

***2** Modern claim practice is an end result of over 155 years of evolution since the first requirement for a claim was enacted in the Patent Act of 1836, Ch. 357, 5 Stat. 117, Sec. 6 (July 4, 1836). See A.W. Deller, Chap. I, "History and Evolution of Patent Claims," Patent Claims (2d ed. 1971); N.J. Brumbaugh, "History and Purpose of Claims in United States Patent Law," Patent Office Papers (Vol. II) (1915); R.C. Faber, Landis on Mechanics of Patent Claim Drafting 1 (3d ed. 1990) ("[V]arious rules and practices have grown up by case law, Commissioner's regulations, and custom since 1836 as to how and how not to fulfill the statutory mandate...."). As to the claim form, as stated in Robb, Patent Essentials 133 (1922):

> No mode of claiming is specified [in the patent statute], but in the absence thereof the Commissioner of Patents is within the general powers given him by statutory authority when he requires certain forms to be followed in the interest of efficient administration of his office. It is in this way that the general forms of claims discussed herein have become those commonly required as proper and best practise.

While claim practice has undergone significant changes since 1836, it appears that Office practice has always required claims to be submitted in single sentence format. Insofar as can be determined, no claim of the over five million patents issued since 1836 contains more than a single sentence.

From 1836, when the Patent Office was created, to the present, the Office has published rules of practice governing Office procedure, even though the Commissioner did not have express statutory authority to make rules until 1870. See H. Wamsley, The Rulemaking Power of the Commissioner of Patents and Trademarks (Part 1), 64 J.Pat.Off.Soc'y 490, 499-504 (1982). The single sentence claim format requirement, in the form of model claims in the Patent Office rules of practice and later in the express form of MPEP § 608.01(m), can be traced continuously from 1836 to the present. The Patent Office pamphlet entitled "Information to Persons Having Business to Transact at the Patent Office" (July 1836), set out a model application form adopted by the Office for the guidance of applicants which concluded with a single sentence claim. In the "Rules and Directions for Proceedings in the Patent Office" (August 1, 1869), the model forms were moved to an appendix of forms. In the introduction to the 1869 rules, inventors and attorneys were recommended to conform as nearly as possible to these forms and the Office appears to have required applications to conform to these model forms. "A new set of Rules adopted in 1879 ... retained its general form during sixty nine years except for one short interval." A.R. McCrady, Patent Office Practice 2 (3d ed. 1950). The appendix of forms to the rules of practice from 1869 to 1949 contained model application forms having only single sentence claims. Thus, the

single sentence format was an implicit requirement of Office rules from 1836 to 1949; claims presented in multiple sentence form could be "objected to" as not conforming to the model claim forms. Since the rules of practice from 1879 to 1949 were established by the Commissioner pursuant to statutory authority, the model forms adopted by the Office as an appendix to the rules, including the single sentence claim format, are presumed to be consistent with law.

***3** In 1949, an extensive revision of the rules was adopted and utility application forms were removed from the appendix of forms. In the same year, the first edition of the MPEP was published, MPEP (Nov. 1949), and the formal requirements of the application were expressly described in sections of Chapter 600, entitled "Parts, Form and Content of Application." The single sentence claim requirement in MPEP § 608.01(m) (Nov. 1949) is considered to merely expressly describe longstanding Office practice. Therefore, the compliance of the single sentence requirement with statutory authority and the purpose of the statute did not change. Over two and one-half million patents have issued since the publication of the 1949 version of MPEP § 608.01(m).

The original reason for the single sentence format does not appear to be a matter of historical record; however, it appears to have been based on existing practice. As noted in Deller, page 11:

> For years, it appeared that patentees voluntarily summarized their invention in claims at the end of the specification. As noted hereinbefore, the Act of 1836 made this practice mandatory.

For example, the patent of John Nash, issued October 14, 1823, for an "Improvement in Plows," concludes with the claim:

> I claim--
>
> The manner of putting this plow together by the loops and hinge, as also the shoulder and mortise or box, and likewise the sword or edge in lieu of a colter.

The single sentence claim form where the claim is the object of a sentence starting with "I claim" is readily apparent in this 168-year old claim, issued 13 years before the 1836 Act. It may be argued that the 1836 Act was intended to require this particular claim form. Whatever the original reason, it is as true today as when stated 110 years ago in Ex parte Skinner, 1881 Dec. Comm'r Pat. 12, 17-18 (Comm'r Pat.1881), that:

> The Office for a long time past has sent forth to the public in its rules of practice, for instruction and guidance, a form of specification and of claims, in which a claim is found in all respects similar to the one under consideration, though not in its precise form (see form 13, claim 2). That form of claim being in accordance with the statute as construed by the courts, and having been adopted by the Office to guide applicants in preparing their applications, should not be changed except for reasons showing that a change is absolutely necessary. If the statute is changed, or the courts announce a different rule from that heretofore given, compliance with such statute or decision should be made; but until such change is made in one of the ways mentioned the practice of the Office should remain what it is now. Stability in practice is as essential as stability in law.

See also Ex parte Buffalo Pitts Company, 89 Off.Gaz.Pat. Office 2069 (Dec. 5, 1899) ("Uniformity is necessary to the proper conduct of affairs of the Patent Office."). It can be argued that, after over 155 years of continuous practice and five million patents, the single sentence claim format is no longer just a formal requirement, but is,

by tradition, the proper and only way of drafting a claim in compliance with the statutory requirement of 35 U.S.C. § 112 ¶ 2.

***4** The single sentence claim form is universally recognized by patent authorities as the accepted claim form under PTO practice. See I. Kayton, Patent Preparation & Prosecution Practice 2-15 (1979):

> Although there is some permissible variation in the format there is no leeway with respect to there being a single period in the claim. Were a claim to have a period in the middle of its body so that it constitutes more than one sentence, it would be considered an indefinite definition of the invention and would be invalid on that basis, although there is probably no case that so holds. The absence of such a case is due, no doubt, to the fact that the Patent Office would not permit a patent to issue with a plural- sentence claim.

See also C.S. Whitman, Patent Laws 304-7 (1870) (same model applications as forms 15, 16 and 17 of 1869 rules); 2 Chisum, Patents § 8.06[1][a] (1990) (citing MPEP § 608.01(m)); J. Landis, Mechanics of Patent Claim Drafting 7 (2d ed. 1974) ("The origin of this 'single sentence rule' is unknown to this author, but it seems to have been standard practice for as long as anyone remembers."); P.D. Rosenberg, Patent Law Fundamentals 38 (1975); R.B. Hildreth, Patent Law--A Practitioner's Guide 182 (1988). Rules of claim drafting and claim construction have developed around the single sentence format over a 155- year period. The allowance of multiple sentence claims would destroy this remarkable uniformity of practice.

The single sentence requirement of PTO practice is a matter of form rather than a matter of substance. Hence, the claims have been "objected to" and not rejected. As stated in Robinson, Treatise on the Law of Patents § 566 (1890):

> A matter of form is one that relates to the fitness of the application for an examination on its merits, or that involves merely some rule of Office practice. A matter of substance is one that pertains to the patentability of the invention as described and claimed in the application, or to the right of the inventor to a patent upon the application presented by him.

See also McCrady, Sec. 104 (form versus substance). It is recognized that applicants have the right to define what they regard as their invention as they choose, so long as the definition is distinct, as required by 35 USC § 112 ¶ 2. In re Harnisch, 631 F.2d 716, 721, 206 USPQ 300, 305 (CCPA 1980); In re Steppan, 394 F.2d 1013, 1019, 156 USPQ 143, 148 (CCPA 1967). However, the single sentence requirement is a formal matter which does not interfere with applicant's substantive right of expression. Petitioner has not shown that the limitations of the English language prevent his invention from being expressed in single sentence form. Claim 19 is capable of being drafted in single sentence form with minor changes in punctuation and format; indeed, this has been done in allowed claim 1, which is of substantially identical scope. Since claim 19 may be redrafted without loss of meaning in a single sentence, which would be allowable, petitioner errs in contending that the claims are "effectively rejected."

***5** Petitioner argues (Petition, p. 10-11):

> [T]he Manual is to be used to provide a guideline for the internal procedures and practices of the Patent and Trademark Office so as to promote uniformity in the Patent Office. It is not to be used, and never was intended to be used, to mandate requirements on applicants in

addition to those defined by 35 U.S.C. § 112 and 37 C.F.R. § 1.75. Thus, it is respectfully submitted that the use of the Manual and, in particular, M.P.E.P. § 608.01(m), as a basis for effective claim rejection by the Patent and Trademark Office on a claim otherwise in conformance with the statutes in ultra vires.

The PTO can prescribe requirements in the MPEP, providing those requirements are not inconsistent with the statute, the rules or the case law of the PTO's reviewing court. See Patlex v. Mossinghoff, supra; Ex parte Schwarze, 151 USPQ 426 (Bd.App.1966); Ex parte Hartmann, 186 USPQ 366 (Bd.App.1974). Petitioner has not demonstrated that the single sentence requirement of MPEP § 608.01(m) is ultra vires by being in any way inconsistent with the statute, the rules or the case law. To the contrary, 155 years of experience indicates that the single sentence requirement is consistent with the statute.

Petitioner argues (Petition, p. 13):

> [I]t is submitted that the single sentence requirement of M.P.E.P. § 608.01(m) does not facilitate the understanding of claims but rather, in many cases, obscures the claim's meaning, and that such a requirement therefore clearly does not promote the public notice goal of the Patent Statutes.

The complexity of single sentence claims has been commented on. See Chisum, § 8.06[1][a] ("The single sentence format leads to extremely long and complex sentences--particularly in mechanical cases."); Faber, page 6 (when drafting claims, watching grammar to make sure the claim reads as a complete sentence is "sometimes troublesome in long, complicated claims"). Nevertheless, the courts do not appear to have had any difficulty dealing with long claims. See Chisum, § 806.01[1][a] ("[C]laim one in the Scoggin patent, held invalid by the Supreme Court in Calmar v. Cook Chemical Co. [383 U.S. 1 (1966)] contained 268 words!"). Moreover, it is not possible to generalize that multiple sentence claims are inherently more clear than a single sentence claim; any differences in readability are likely to be mostly a matter of draftsmanship. The single sentence requirement promotes clarity and precision in the definition of the invention by eliminating the verbiage required for multiple complete sentences; multiple sentence claims would more resemble a description of the invention than a distinct definition of the invention. Regardless of whether or not multiple sentence claims would be clearer, in theory, the fact that single sentence claims have been around for 155 years without any known problems evidences that the single sentence requirement is not contrary to the statutory purpose.

***6** Finally, petitioner has submitted a declaration stating (Declaration, p. 2):

> [The Primary Examiner] told me that it was his opinion that [multi-sentence] Claim 19 was clearer to him than single sentence claim 1, which is similar in scope to Claim 19....

The examiner's opinion is, of course, his own personal opinion. Opinions vary. In any case, the variable of claim draftsmanship is present and has not been accounted for. The important thing is that the examiner properly followed PTO practice and objected to the claims under MPEP § 608.01(m).

CONCLUSION

Claims 19-21 remain objected to as failing to conform to MPEP § 608.01(m). Claims 19-21 are required to be cancelled or presented in a single sentence form.

The application file is being forwarded to Group 230 so that the examiner may respond to petitioner's appeal brief to the Board.

22 U.S.P.Q.2d 1828

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