

IEEE-USA POSITION STATEMENT

MULTIPLE PATENT CLAIM FORMS

***Adopted by the IEEE-USA
Board of Directors (18 November 2016)***

IEEE-USA urges that the U.S. Patent and Trademark Office (USPTO), Congress and the courts not amend the patent statutes, regulations, or guidance in any way that would limit the ability of patent applicants to claim their inventions with multiple claim forms. IEEE-USA favors maintaining the status quo in which patent applicants are permitted to claim their inventions as they see fit under the law, and the USPTO is permitted to set fee levels at actual cost of examination for applications of greater-than-average complexity.

If it becomes necessary to limit multiple claiming, Congress should amend the patent statutes to make reasonable adjustments to U.S. patent law to ensure that an inventor retains the full extent of protection available to him or her even with the loss of multiple claiming.

BACKGROUND

Applicants claim their inventions using multiple claim forms, so that the true infringers of a patent—for example, the companies that are selling programs using a patented method without permission—can be treated as direct infringers, rather than contributory infringers, or inducers of infringement.

Currently, to adequately protect an invention, a patent applicant must often file multiple claims directed to a single inventive concept, to account for the following:

- Claims directed to various phases of the life cycle, or operating cycle, of the invention;
- Mating component parts, sender vs. receiver in communication systems, male vs. female connectors, and similar mating components--where the components may be practiced by different entities;
- Claims to deal with territoriality issues, such as imports, exports, international communications systems, temporary presence of vehicles, etc. (For example: in a communications system, it can be crucial to have separate claims directed to the sender, the receiver, and the switch that routes messages between them);
- Claims to deal with exhaustion, repair, replaceable, or consumable parts;
- Claims directed to literally cover foreseeable equivalents—thereby simplifying complex "doctrine of equivalents" cases--to clear literal infringement cases;
- Claims to deal with claim construction rules for means-plus-function, product-by-process, functional apparatus, structural apparatus, method-of-making, and method-of-using claims;

- Claims to deal with various limitations on damages; and
- Limitations on the doctrines of induced or contributory infringement.

Because software-based inventions require claiming in a variety of ways to get full protection, software patent applications often require several times the number of claims that suffice in other technologies. It is common for software-based inventions to claim the invention as a method or process, a system or machine, and as a medium for storing the program, to meet the concerns listed above.

Multiple claiming is an essential part of the patent system as it exists today, and allows the law to be simple and clear in other areas. The alternative—allowing claims to be evaluated with less pedantic precision—is likewise workable, and is followed in other countries; but in the United States, where claims are evaluated with great precision, multiple parallel claim forms are the necessary counterbalance.

IEEE-USA opposes measures to either cap numbers of claims, impose fees that are not correlated to examination cost, or impose administrative burdens against applications that have more than a nominal number of claims, if in the balance the expense of such burdens to patent applicants exceeds the burdens' administrative convenience. Examples include:

- Increasing fees or paper work burdens for additional claims above a predetermined number of independent claims or total claims, when the increases favor the USPTO at the expense of patent applicants; and
- Establishing guidance that compels applicants to divide their claims among multiple applications, which increases filing, prosecution, and maintenance costs to applicants, and makes enforcement and analysis considerably more difficult.

This statement was developed by the IEEE-USA Intellectual Property Committee, and represents the considered judgment of a group of U.S. IEEE members with expertise in the subject field. IEEE-USA advances the public good and promotes the careers and public policy interests of the nearly 200,000 engineering, computing and allied professionals who are U.S. members of the IEEE. The positions taken by IEEE-USA do not necessarily reflect the views of IEEE, or its other organizational units.