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**From:** Berridge, William P.

**Sent:** Friday, September 28, 2007 11:25 AM

**To:** Markush.Comments

**Subject:** Examination of Patent Applications that Include Claims Containing Alternative Language

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MESSAGE:

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Please consider the attached comments.

<<AltLang.pdf>>

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September 28, 2007

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**By E-mail**

Attn: Kathleen Kahler Fonda, Legal Advisor  
Office of the Deputy Commissioner for Patent Policy

Re: Proposed Rule Changes for Examination  
of Patent Applications that Include Claims  
Containing Alternative Language

Sir:

Please consider the following comments relating to proposed rule changes of August 10, 2007 for examination of patent applications that include claims containing alternative language.

The proposed rules appear to be a further attempt by the Patent Office to reduce its backlog by discouraging or preventing innovators from protecting their inventions with U.S. patents. This is a misguided approach that damages U.S. competitiveness and embarrasses the United States in the international community.

The proposed rules would adversely impact Applicants and United States competitiveness, while not advancing the goals of enabling the Office to do a more thorough and more reliable examination of claims containing alternative language. They impose burdens and expenses that exceed those of any other patent system in the world, harming the goals and efficiencies of international harmonization of patent practice, driving up costs of U.S. entities that file internationally, and harming the protection of intellectual property in the United States. I believe that the proposed rules should be withdrawn in their entirety. If any consideration is given to implementing any variation on them, such consideration should be postponed until after the effects of the ill-considered August 21, 2007 rules have been observed.

Any legitimate goal of the proposed rules could be addressed by enforcement of existing *Markush* practice limitations. The only rational change to restriction rules that is currently necessary is to prohibit Examiners from issuing second or subsequent action Restriction Requirements that, under the new definition of divisional applications, short-change Applicants out of the Paris-Convention-mandated right to file divisional applications. Rule 1.142(a) should be so modified.

(1) Proposed Rule 1.75(a), limiting a claim to a single invention, is contrary to the statute and controlling legal precedent set by the United States Court of Customs and Patent Appeals.

Proposed Rule 1.75(a) adds the sentence, "A claim must be limited to a single invention." However, many inventions encompass a number of other inventions. Otherwise, there would be no such thing as an improvement patent. Furthermore, under *In re Weber*, 580 F.2d 455, 458 (CCPA 1978), "it is apparent that [35 U.S.C.] §121 provides the Commissioner with the authority to promulgate rules designed to restrict an application to one of several claimed inventions when those inventions are found to be 'independent and distinct.' It does not, however, provide a basis for an examiner acting under the authority of the Commissioner to reject a particular *claim* on that same basis." *Id.* Moreover, as the Court concluded, if a single claim is required to be divided up and presented in several applications, that claim would never be considered on its merits. *Id.* The totality of the resulting fragmentary claims would not necessarily be the equivalent of the original claim. Further, since the sub-genus would be defined by the Examiner rather than by the Applicant, it is not inconceivable that a number of the fragments would not be described in the specification. *Id.* Thus, the proposed practice will lead to an inability to protect complete inventions in the United States, leaving foreign patents without such artificial restrictions stronger and more complete than U.S. patents. It would further selectively harm U.S. entities whose international filings will be based on claims drafted for U.S. practice, and add major expense to PCT practice because U.S. claims could not match those presented in PCT applications for examination throughout the rest of the world.

The proposed rule attempts to codify intra-claim restriction. However, such a rule would contradict the court's clear precedent that 35 U.S.C. §121 does not provide the Commissioner with the authority to reject a claim simply because it encompasses more than one invention and would be detrimental to the rightful interests of U.S. and foreign innovators. Therefore, Rule 1.75(a) should not be amended to include this statement.

(2) Proposed Rule 1.75(d)(2), requiring an Applicant seeking the benefit of a prior-filed application to disclose the subject matter that was not disclosed in the prior-filed application, and identify which claim or claims in the application are disclosed in the manner provided by the first paragraph of 35 U.S.C. §112 in the prior-filed application, is unduly burdensome to Applicants.

The proposed rule would require a claim-by-claim analysis to determine which claims have priority back to which date. This might require translation of foreign priority documents for U.S. practitioners to assist Applicants in presenting the required analysis. All of this is an expensive process that is unnecessary in the vast majority of patent applications in which the right to rely on claimed priority benefits need not be established. The August 21, 2007 rulemaking already established a system that achieves the same purpose for CIP applications, and the current system for foreign patent applications is more than sufficient considering the

small number of foreign-priority based applications that ever need to rely on a priority date. The proposed rule simply establishes further paperwork, complexity and cost with no countervailing benefit in most of the affected patent applications. It creates burdens that far exceed those of any other industrialized country's patent system. It appears to be designed solely to discourage use of the U.S. patent system, thus further weakening intellectual property protection in the United States and further damaging the United States in the international community. Moreover, a claim-by-claim analysis exposes an Applicant to the allegation of inequitable conduct if the analysis is later questioned for accuracy, thus further increasing the cost of enforcement of U.S. patents, and thus further weakening the U.S. patent system.

On its face, this burden applies mainly on foreign applicants. However, foreign countries would be justified in retaliating, thus imposing far greater burdens on U.S. applicants who file in multiple countries and thus would be faced with the same translation and review requirements in multiple foreign languages.

Thus the proposed rule should be withdrawn.

(3) Proposed Rule 1.75(j)(1), proposing that the claim language is not "difficult to construe" is unworkably subjective and overly simplified, and contrary to statute.

As proposed, Rule 1.75(j)(1) states "A claim that reads on multiple species by using alternative language must meet the following conditions: (1) the number and presentation of alternatives in the claim does not make the claim difficult to construe..." Under 35 U.S.C. §112, second paragraph, the specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the Applicant regards as his invention. There is no statutory basis for allowing the Examiner to reject a claim as merely being "difficult to construe." Such a standard is completely subjective and would allow the Examiner to freely object to a claim in any application the Examiner deems difficult. Many claims are by their very nature difficult to construe, because claims are the articulation of novel inventions. Many inventions are the result of groundbreaking discoveries and the claims that articulate those inventions may inherently be difficult to construe. By giving the Examiner authority to object to a claim on the basis that it is "difficult to construe," the Patent Office completely ignores 35 U.S.C. §112, second paragraph. The level of difficulty in interpreting a claim is not the legal standard. The Applicant is only required to "particularly point out and distinctly claim" the invention. As proposed, Rule 1.75(j)(1) ignores 35 U.S.C. §112, second paragraph and provides the Examiner with the authority to object to virtually any claim. Particularly given the poor command of the English language that many Examiners demonstrate in their Office Actions and in interviews, it creates a subjective standard that is likely to increase arbitrary and capricious decisions and generate unnecessary petitions and appeals.

Thus the proposed rule should be withdrawn.

(4) Proposed Rule 1.75(j)(2), stating that no alternative may be defined as a set of further alternatives within the claim, contrary to logic, will make claims far more complex and difficult to understand, and will require expensive and burdensome efforts by U.S. Applicants to remove the clarity and logical organization of their claims in ways unmatched by any other patent office in the world, thus putting U.S. Applicants at a commercial disadvantage relative to their foreign competitors.

The requirement that a claim that reads on multiple species by using alternative language must meet the condition that no alternative is defined as a set of further alternatives within the claim is inappropriate within many areas of technology. For example, in the pharmaceutical and chemical arts claims often contain *Markush* alternatives having further limitations defined in the claims and specification that make the claims much more readily understood to one of ordinary skill in the art.

At present, claims may be written with a logical organization and hierarchy so that Examiners and competitors can readily understand them. As with any organized writing, claims may be outlined from a higher level (e.g., A – B – C), to a lower level (e.g., wherein A may be A' or A"), to the lowest level (e.g., wherein A' may be A'+ or A'-). Thus, one can readily screen out the relevance of most prior art at the highest level (e.g., does the prior art even include A – B – C), and then work down to the lower levels only for prior art that meets the high-level criteria. This approach allows one to appreciate, and compare to the prior art or product, the invention as a whole as well as the details of the invention. It is far more manageable than a one-level listing of alternatives in which the overall structure is lost in the elimination of an organized hierarchical claim structure.

Taking this example, it is clear on its face that it is far easier to appreciate and search the unifying features of an invention claim as:

A – B – C  
wherein A is A' or A", and  
A' is A'+ or A'-, and  
B is B' or B"

than the proposed rule claim:

A'+ – B' – C or A'- – B' – C or A" – B' – C or A'+ – B" – C or A'- – B" – C or  
A" – B" – C.

While there may be occasions of misuse of the opportunity for an Applicant to organize claims clearly and logically with nested alternatives, such abuses can be addressed with proper application of 35 U.S.C. §101 or §112 and existing *Markush* practice. It is inappropriate, arbitrary and capricious for the Patent Office to require all Applicants to eliminate the logical

organization of their claims to address such issues that arise in a small minority of applications, and that could better be dealt with in terms of the statutory requirements of utility, enablement (operability) and definiteness.

In addition, the verbose and complex claims that would be necessary under the proposed rules would not match the clear and logical claims that Applicants can obtain throughout the rest of the world. This would disadvantage all Applicants, and their competitors, who would no longer see similar patent claims in counterpart patents. It would be particularly harmful to U.S. Applicants who would be starting from the verbose, disorganized, complex claims required by the proposed U.S. rules when drafting their foreign counterpart applications.

Moreover, the comments provided by the Patent Office in the Federal Register do not clearly articulate how a claim should be presented so as not to define further alternatives within a claim. In the proposed rules, the Patent Office cites Example 24 of the PCT Guidelines to illustrate "an apparently straightforward claim which would actually be quite complex to search and examine." See Proposed Rules at p. 44994, col. 2, line 29-48. The comments make this statement but do not indicate which part of the claim is considered "straightforward" and which part of the claim makes it "quite complex to search and examine."

Claim 1 of Example 24 is directed to a pharmaceutical compound of the formula: A-B-C-D-E, wherein A is selected from C<sub>1</sub>-C<sub>10</sub> alkyl or alkenyl or cycloalkyl, substituted or unsubstituted aryl or C<sub>5</sub>-C<sub>7</sub> heterocycle having 1-3 heteroatoms selected from O and N. See *Id.* at lines 29-36. Example 24 claims several *Markush* alternatives having further alternatives within the claim. For instance, C<sub>1</sub>-C<sub>10</sub> alkyl is one alternative having numerous different alternatives within it, from straight-chain alkyl groups to branched alkyl groups. Proposed Rule 1.75(j)(2) might be construed to allow the Examiner to consider this alkyl group to encompass a list of further alternatives within the claim, because C<sub>1</sub>-C<sub>10</sub> alkyl inherently defines many different types of alkyl groups. Does the Patent Office consider C<sub>1</sub>-C<sub>10</sub> alkyl both an alternative (alkyl) and a set of further alternatives (C<sub>1</sub>-C<sub>10</sub>) within claim 24?

The comments in the Federal Register state that this appears to be a "straightforward" claim. It is far more clear, understandable and complete on its face than would be a one-level list of the many alternatives it encompasses, which would be unlikely to include all of the embodiments of the real invention, and thus would contravene the requirement of the second paragraph of 35 U.S.C. §112 of claims "particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention."

Alternatively, A is also defined to be "C<sub>5</sub>-C<sub>7</sub> heterocycle having 1-3 heteroatoms selected from O and N." In this instance, the claimed *Markush* alternative "C<sub>5</sub>-C<sub>7</sub> heterocycle" has a further *Markush* alternative directly in the claim: "having 1-3 heteroatoms selected from O and N." This feature of the claim is clear, definite and easy to understand, and narrows the scope of the C<sub>5</sub>-C<sub>7</sub> heterocycles to only those containing 1-3 O and/or N atoms. Yet, under proposed Rule

1.75(j)(2), this claim is not permitted, because that proposed rule requires that "No alternative is defined as a set of further alternatives within the claim."

The goal of the proposed rule changes is allegedly to enable the Patent Office to do a better, more thorough and reliable examination of claims. However, as illustrated, proposed Rule 1.75(j)(2) objects to a "straightforward" claim by eliminating the clarifying further alternatives within the claim and requires the claim to list every possible alternative. Thus, the claim becomes more difficult to understand and search.

Additionally, the rationale for the amendments to Rule 1.75(j) provided in the Federal Register is illogical and inconsistent with proposed new Rule 1.75(k). The Patent Office explains in the Federal Register that a claim encompassing more than one embodiment by using generic "means" terminology (without the claim itself requiring selection from a list of alternatives) would not be subject to these proposed rules. According to the Proposed Rules,

[A] claim reciting the generic limitation "a means for attaching," in the context of a specification that discloses staples, tape, and glue as suitable means would encompass several species. However, the "means for attaching" limitation would not subject the claim to the provisions of §1.75(j) or (k) or §1.140 because the claimed invention does not require, and is not limited to, the means specifically disclosed in the specification. By contrast, a claim reciting the limitation "an attachment means selected from the group consisting of staples, glue or tape" would be subject to the provisions of proposed §1.75(j) and (k) and §1.140. See Proposed Rules at p. 44996 at col. 2, lines 36-53.

Of course, claims using means-plus-function language are limited to those means and their equivalents that are disclosed in the specification and their equivalents, whether or not the specification uses alternative language. See MPEP §2181. It is totally arbitrary and capricious for the Patent Office to exempt means-plus-function language from the proposed rule when a claim reciting the limitation "an attachment means selected from the group consisting of staples, glue, or tape" would be subject to the provisions of the proposed rules, while the limitation "means for attaching," based on identical language in the specification, is not so-restricted. On the other hand, bringing means-plus-function claims into the proposed rule based on the words selected to describe embodiments in the specification would further complicate examination and patent drafting, and improperly exclude the further "equivalent" alternatives that Applicants are entitled to include in their claims under §112, sixth paragraph.

Thus the proposed rule should be withdrawn.

(5) The final sentence of proposed new Rule 1.140(b) is another example of the Patent Office shirking its duty to examine patent applications and consider Applicants' good faith arguments. It deprives Applicants of due process.

This sentence indicates that Applicants can only respond to restriction and election of species requirements, however improper, before they are made by the Office. Under it, Applicants must anticipate and rebut restriction and election of species requirements in advance of such requirements being made and in advance of the Patent Office presenting any substantive rationale or *prima facie* basis for such requirements. This is a clear deprivation of due process by prohibiting Applicants from responding to objections to their patent applications.

Thus the proposed rule should be withdrawn.

(6) Proposed Rule 1.144(b) should be revised to permit filing of a petition against a final restriction requirement at the same time that a substantive response is filed to the Office Action in which the restriction requirement is made final. Having a single Office Action impose different deadlines with different extendibilities for different issues in it requires inefficiencies in analysis of overlapping issues regarding the scope and identity of the claims under consideration. This unnecessarily drives up the cost for Applicants, making the patenting process less economically feasible to small entities and other Applicants. It also creates a trap for Applicants because the cover of the Office Action identifies one deadline and one indication of "final" or "non-final" status, while a different and earlier deadline is actually imposed by the presence of a final restriction requirement buried in the text of an Office Action that may or may not be designated on its cover as "final." As long as the Petition is filed before a Notice of Appeal is filed, the Office has more than adequate time to enter a decision on the Petition before the Appeal Brief is due. Thus, no undue delay or inefficiency would result from rationalization of these deadlines.

(7) Rule 1.146, permitting restriction of an Applicant's claims to a single species is contrary to logic, public policy, statute and the U.S. Constitution.

Proposed Rule 1.146(b) states that the Examiner may require the Applicant to restrict any claim that was subject to an election requirement under paragraph (a) of this section to the one or more species that were searched and examined if any species encompassed by the claim is not patentable.

This proposed rule unfairly limits the Applicant to claiming as little as one single species in a given patent application if any species encompassed in its broadest claim is not patentable. This proposed rule gives the Examiner, rather than the Applicant, the authority to decide which species are examined, and allows Examiners routinely to avoid examining the genus encompassed by a claim. For example, if a claim is drawn to a genus that encompasses species A, B, C, D and E, the Applicant elects species A, and the Examiner finds species D unpatentable, then the Examiner can limit the examination of the application to species A and D. Even if species B, C and E are allowable and within the scope of a subgeneric claim, the Examiner has the authority to limit all of the claims to species A and D. In order to overcome the rejection, species D would need to be cancelled, leaving only claims to the elected species A. Further,

under Proposed Rule 1.142(d), the Examiner would consider species B, C and E non-elected inventions and force the Applicant to cancel any claims that encompass species B, C and E in order to allow claims to species A. Thus, the Examiner can effectively limit the claim to the elected species A even though a subgenus encompassing species A, B, C and E is allowable.

This type of examination is contrary to the second paragraph of 35 U.S.C. §112, which mandates that the claims be directed to what "applicant regards as his invention," as well as being contrary to existing Rule 1.146, which states that the Examiner "may require restriction of the claims to not more than a reasonable number of species before taking further action in the application." The proposed rule permits the Examiner to limit an Applicant's invention to as little as a single species rather than a "reasonable number of species."

To the best of my knowledge, no patent system in the history of the world has ever been so draconian as to require Applicants to limit the claims of their applications to a single species of their invention. By definition, every invention ever made has countless species, and a claim limited to only one of them would have no commercial value whatsoever.

Take, for example, the invention of a nail, which might have been generically claimed as a solid shaft with an expanded head at one end and a sharpened point at the other end. The more thorough the disclosure of options, the more narrow can the Examiner require the claims to be. For example, the disclosure could mention various head shapes (e.g., circular, triangular, hexagonal, etc.), various shaft shapes (e.g., circular, triangular, etc.), various materials (e.g., iron, steel, hardened steel, etc.). By the terms of the rule, the Examiner may require an election of a single disclosed species, and Applicant must make an election of – e.g., a nail with a hexagonal head and shaft, made of hardened steel – whether or not any of the existing claims are limited to the elected species. By the terms of the rule, then, the Examiner may point out that the generic claim is inadvertently broad enough to read on a sharpened stick, and thereby require that all examined claims be limited to the elected species, thus precluding protection for the multitude of other disclosed species. Particularly coupled with the recently issued final rules on continuation and divisional application practice, Applicant could not file a divisional application on any of the previously submitted subgeneric claims (they have been examined, albeit cursorily), and Applicant would be limited to two more continuation applications in which the Examiner could take the same approach.

This rule is thus directly contrary to the Constitutional mandate to provide meaningful exclusive rights to inventors, and to 35 U.S.C. §112, second paragraph, which permits inventors to claim what they believe to be their invention rather than being forced to claim some Examiner-mandated fragment of the scope of their invention. Coupled with Examiner production quotas, the rule will drive the statutory mandate that the government examine claims to a mandate to avoid examining claims by focusing the process on limiting examination to consideration of single species. It could be used in every patent application with any generic

claim that encompasses a single item of prior art, and its use could eviscerate the U.S. patent system.

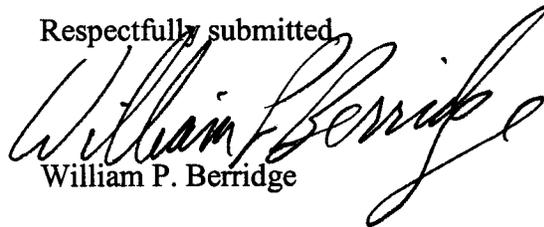
Thus the proposed rule should be withdrawn.

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As the *In re Weber* court warned, "If a single claim is required to be divided up and presented in several applications, that claim would never be considered on its merits." See *In re Weber*, at p. 458. Consequently, the Applicant would never have the opportunity to claim his invention.

For all of the above reasons, the proposed rules should not be implemented.

Respectfully submitted,



William P. Berridge

WPB:ABF:mef