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From: Donahue, Dennis

Sent: Friday, August 24, 2007 12:00 PM

To: Markush.Comments

Subject: Comments On Proposed Rules for Markush Claims

Dear Commissioner:

Please review and consider my comments on the Office's proposed rules for Markush claims.

In both the Summary and Supplementary Information (Background Information) sections of the proposed rules, the consumption of "disproportionate amount of Office resources as compared to other types of Claims" is identified as a reason for the proposed changes to the rules. There is another statement about the number of alternative inventions that are claimed: "Applicants sometimes use Markush or other alternative formats to claim multiple inventions and/or to recite hundreds, if not thousands, of alternative embodiments of a single invention in one claim."

Clearly, something must be done when hundreds or thousands (or perhaps even dozens) of alternative embodiments are being recited in a single claim. However, I agree with the USPTO's statement in the proposed rules that there should be a balance between the interests of the USPTO and applicants who use Markush groups in a much more limited manner, such as claiming two or three species of an invention expressly in a Markush claim format. Many times, these species can be identified in a larger group and one of the independent claims is directed to the overall group (A) with dependent claims then directed to each of the species (A', A'' & A''').

My practice is directed to the mechanical and electronic arts, and I had found that Patent Examiners would typically restrict the invention to only one of the species to prosecute the application for the genus claim and one species, which according to the current version of 37 C.F.R. §1.141(a), the limitations from the allowable genus claim could then be incorporated into the claims directed to the non-elected species so that all of the claims could remain in one patent. I used these very small Markush groups to show the Patent Examiners that the species were all related and since the groups were so small in number, the Patent Examiners were required to maintain the group in the same application under MPEP §803.02.

Now, under the proposed rules, not only would an applicant be forced to divide out only a couple of species to a larger coherent generic grouping, the USPTO is removing the exception to Section 1.141(a) without incorporating a positive statement about generic claims into the rules (see below for current version of section & proposed change duplicated from Discussion of Specific Rules - emphasis added). In particular, the new rules should include a positive form of the generic claims statement (i.e., "If the application includes an allowable generic claim, restriction would be improper and the generic claim would define a single invention."). The positive form of this statement would fit well in the new Section 1.140 (duplicated below with proposed statement emphasized). Otherwise, the exception should remain in Section 1.141(a). Also, if the disproportionate amount of Office resources is going to the applications with Markush groups having hundreds, or even dozens, of alternative embodiments,

there should be some threshold which permits a reasonable number of species. In the proposed change to Section 1.140 below, I have used five (5) species because it fits with the new rules on the number of independent claims that are permitted without having to submit an Examination Support Document.

§ 1.141 Different inventions in one national application.

(a) Two or more independent and distinct inventions may not be claimed in one national application, except that more than one species of an invention, not to exceed a reasonable number, may be specifically claimed in different claims in one national application, provided the application also includes an allowable claim generic to all the claimed species and all the claims to species in excess of one are written in dependent form (§ 1.75) or otherwise include all the limitations of the generic claim.

Section 1.141: Section 1.141(a) is proposed to be revised by replacing “may not” with the more permissive term “should not” in the context of claiming two or more independent and distinct inventions in one application. The proposed revision is consistent with current practice as the Director has not made restriction mandatory. Furthermore, the “exception” language in paragraph (a), i.e., that different species may be specifically claimed in different claims provided the application also includes an allowable claim generic thereto, is proposed to be deleted. **If the application includes an allowable generic claim, restriction would be improper and the generic claim would define a single invention.**

§ 1.140 Requirement for a claim to be limited to a single invention in an application filed under 35 U.S.C. 111(a).

(a) Two or more independent and distinct inventions may not be claimed in a single claim. See § 1.75(a). A claim that reads on multiple species using alternative language is limited to a single invention when all the species encompassed by the claim meet at least one of the following two conditions:

(1) The species share a substantial feature essential for a common utility, or

(2) The species are prima facie obvious over each other.

(b) The presentation of a claim that reads on ~~multiple~~ **more than five (5)** species using alternative language (§ 1.75(j)) may be accompanied by a statement explaining why the claim is limited to a single invention. Such a statement shall be considered by the Office if filed by the applicant at the same time as the presentation of such a claim and may be considered by the Office if filed by the applicant after the presentation of such a claim but before the mailing date of any restriction requirement or action on the merits.

(c) More than one species of an invention, not to exceed a reasonable number, may be specifically claimed in different claims in one national application, provided the application also includes an allowable claim generic to all the claimed species and all the claims to species in excess of one are written in dependent form (§ 1.75) or otherwise include all the limitations of the generic claim.

If this rule goes into effect as proposed, multiple species of genus inventions will still be included in the same application, but it may be harder for the Patent Examiners to appreciate the extent to which they need to search the prior art because all of the claims could be directed to generic terms that cover each one of the species.

Thank you for considering my comments.

Sincerely,

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