

From: Michael Walker  
Sent: Wednesday, April 09, 2008 6:23 PM  
To: Markush.Comments  
Subject: Comments from DuPont

(See attached file: Comments on Claims Containing Alternative Language  
April 9, 2008.pdf)

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April 9, 2008

Docket No. PTO-P-2006-0004

Email: markush.comments@uspto.gov

Mail Stop Comments – Patents  
The Honorable Jon Dudas  
Director  
United States Patent and Trademark Office  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, Virginia 22313-1450

Attn.: Kathleen Kahler Fonda  
Legal Advisor  
Office of Patent Legal Administration

Re: Comments from E. I. du Pont de Nemours and Company  
Regarding the USPTO's Proposed Rules Relating to the  
Examination of Patent Applications That Include Claims  
Containing Alternative Language

Dear Commissioner Dudas:

In response to the Proposed Rulemaking Proposed Rules Relating to the Examination of Patent Applications That Include Claims Containing Alternative Language, published August 10, 2007, at 72 FR 44992 as supplemented by a notice at 73

FR 12679 which inter alia extended the comment period to April 9, 2008, E. I. du Pont de Nemours and Company ("DuPont") submits the following comments.

A. Proposed Rule 1.75(j)(2): Eliminating Claims Describing Nesting Species Represents Substantive Change that Adversely Affects Chemical Patent Practice.

DuPont's businesses include a wide variety of businesses that conduct research toward discovering new and complex organic and organo-metallic chemical compounds. Genus claims for complex organic and organo-metallic compounds have long depended on nested alternatives in order to encompass the full scope of an invention conceived by inventors. The current format permits the inventors to claim what the inventors regard as the full scope of their invention in a claim of reasonable length. The Proposed Rules change the current practical means of using the Markush format but do not provide another suitable and practical claiming method to achieve the same claim scope. DuPont believes this change in Markush practice is a significant substantive change to patent claiming practices and is inconsistent with at least 35 U.S.C. § 112, ¶ 2. *Cf., Tafas v. Dudas*, E.D. Va., Case 1:07cv846 (April 1, 2008).

Without the ability to claim, in a practical manner, variations of a general inventive concept in connection with complex organic and organo-metallic compounds, the value of an invention may be considerably diminished. DuPont is concerned that, if implemented, one result of the Proposed Rules will be that its inventors' concepts may be more readily copied by others who do not spend the time and money to do the original research and development work. Consequently, the value of and rewards from DuPont's research and development efforts could be diminished in fields such as crop protection chemistry.

DuPont submits that rather than being difficult to understand, claims using nested alternatives as currently permissible represent the most efficient way of presenting a chemical claim scope that should ordinarily be understood by persons having sufficient expertise with addressing such claims. Moreover, DuPont submits that if there is a basis for balancing Office efforts versus an inventor's ability to effectively claim an invention's full scope, the need for this claim technique should clearly outweigh any extra effort the Office might need to make to examine such claims.

B. Proposed Rule 1.144: Creates A Waiver Deadline That Is Impractical to Meet

DuPont objects to the time limit for petitioning for review of a restriction requirement in Proposed Rule 1.144. Where a restriction requirement is made, it is often made final in a first Office Action on the merits; and Applicant's consideration of that first Office Action is often timed to be finalized by a shortened statutory response period of three months. Under these circumstances, if Applicant targets the three months date, then the period for petitioning for restriction review will have lapsed. Moreover, DuPont

believes that current practices, which allow for petition up until the Notice of Appeal, permit both Applicant and the Examiner further opportunity to assess and comment on the interrelatedness of various aspects of claims as well as the reasoning (and possibly even technical errors) used in imposing a restriction requirement in the first instance.

Thank you for your consideration of these comments.

Respectfully submitted,

/s/ P. MICHAEL WALKER

**E. I. DU PONT DE NEMOURS AND COMPANY**

By: P. Michael Walker

Associate General Counsel

Chief Intellectual Property Counsel