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**From:** Lynne Anderson

**Sent:** Tuesday, October 16, 2007 5:43 PM

**To:** Markush.Comments

**Subject:** Comments - Notice of Proposed Rule Making ?Examination of Patent Applications That Include Claims Containing Alt

Ms. Fonda -

Thank you very much for permitting us to late-file the above-referenced comments. We apologize for any inconvenience this may have caused you.

Regards,

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October 16, 2007

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Mail Stop Comments - Patents  
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Attention: Ms. Kathleen Kahler Fonda

IBM Corporation Comments in response to Notice of Proposed Rule Making  
*"Examination of Patent Applications That Include Claims Containing  
Alternative Language"*, 72 Fed. Reg. 44992 (August 10, 2007)

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IBM appreciates the United States Patent and Trademark Office's (USPTO) efforts in their continuous pursuit of enhancing its ability to reduce pendency and grant quality patents. We agree with the USPTO that improving patent quality promotes innovation, which benefits all members of society. We also agree that practices that consume a disproportionate amount of the Office's resources should be scrutinized and revised when appropriate. However, we are concerned that rule changes themselves carry an implementation cost for the Office and the patent bar. Thus, such changes should be limited to those whose benefits outweigh their implementation costs. Therefore, we appreciate the opportunity to express our concerns and offer the following comments, as well as alternatives to the proposed rule changes.

### **SPECIFIC RULE COMMENTS**

#### **Rule 1.75(a) - Claims**

*The proposed rule indicates an absolute requirement that a claim contain no more than one invention.*

However this seems to be contradicted by the discretionary terms of proposed rule 1.146(b) and arguably proposed rule 1.142. We would prefer to see the relationship of these rules clarified as to when one is subject to the other. For example, a clarification could be that rule 1.75(a) is subject to the examiner's discretion under proposed rule 1.146(b) or oppositely that the examiner's discretion under proposed rule 1.146(b) is subject to the requirements of proposed rule 1.75(a). Given the discretionary nature that

the Office appears to desire in connection with alternative claiming, we would suggest that proposed rule 1.146(b) and discretionary aspects of proposed rule 1.142 be applicable notwithstanding proposed rule 1.75(a). Alternatively, we would recommend that added requirement of proposed rule 1.75(a) itself be made discretionary.

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

*The proposed rule states in part, that two or more independent and distinct inventions may not be claimed in a single claim. A claim that reads on multiple species using alternative language would be limited to a single invention if all the species meet at least two conditions, one of which is that the species share a substantial feature essential for a common utility.*

The Federal Register notice states that the USPTO's primary concern is that searching a Markush group with patentably distinct elements is time consuming and thus burdensome. However, most Markush groups link elements that have a "common function," that is, the elements do the same thing in the claim, which may not be because of a "substantial feature" in common. Therefore, we suggest that the term "common utility" include "common function." We also suggest that the USPTO consider following the EPO and PCT procedure for handling the situation of lack of unity of invention since lack of unity of invention and excessive searching when there is lack of unity of invention are the reasons given by the PTO for the proposed rule change. In EPO and PCT practice, when the claims initially presented for examination are determined to lack unity of invention, all claims can be examined by paying for a search fee for each invention presented in the initial claims. In the EPO and PCT examination, if unity of invention is determined not to be present by the examiner, the applicant can pay to have all distinct inventions searched in one application. Therefore, we propose that where the members of a Markush group are patentably distinct from each other and have a "common function", the applicant be permitted to either file divisional applications for each member of the group not examined in the initial application or to pay an additional search fee to have each member of the group examined in the initial application.

Furthermore, with respect to proposed rule 1.140, a scenario that could be impacted would be one where there is no patentable generic concept ab initio or where the generic concept is found to be unpatentable. In such instance, the "limitations" from proposed rule 1.140 would pertain.

Thus, for example, if a generic concept of using a gaseous compound in a process were considered unpatentable, applicant would still be able to claim as a Markush\_group fluorine gas, chlorine gas, and oxygen gas where those gases shared a "common function". Otherwise, one would have to separately claim the process using each of those gases. Since the proposed rule does not clearly define "common utility" complying with the requirements of the proposed rule would force the applicant to either allege a "common utility" not fully understanding the meaning of this term which might lead to creation of some estoppel and/or to providing additional disclosure that might be inadvertently and unknowingly adverse to the applicants interest and cause the examiner to be unduly prejudiced to a conclusion of obviousness. For example, if the applicant discloses a common utility discovered by the applicant, the examiner may be tempted to consider such a revelation as part of the applicable art. Alternatively, the applicant would have to concede the obviousness of each member of the Markush group when this may be contrary to the understanding of a person of ordinary skill in the art. We do not believe that the choices made available to the applicant by the proposed rule would lead to quality patents and an expeditious examination.

**Rule 1.142** - Requirement for Restriction to a Single Invention in an Application filed under 35 U.S.C. Section 111(a)

*The proposed rule requires that if two or more independent and distinct inventions are claimed in a single application, the examiner may require the applicant to elect an invention to which the claims will be restricted. The requirement to restrict will be determined without regard to whether the plural inventions are recited in separate claims or as alternatives within a single claim.*

It is unclear as to whether discretionary restriction requirements mean that applicant can make a general appeal to the examiner's discretion as to traversal of the restriction? Also, the relationship between this discretionary language and the absolute language of rules 1.75(a) and 1.140(a) is unclear. Therefore, we request that the Office provide further clarification.

**Rule 1.144** - Petition from Requirement for Restriction

*The proposed rule provides in part that a petition must be filed within the earlier of two months of the mailing date of the final restriction requirement of the filing of a Notice of Appeal.*

It is unclear as to why it is necessary to shorten the timeline for filing a petition to review a requirement for restriction. We suggest that the

timeframe in which the applicant can file a petition should remain as stated in the present rule: any time prior to appeal (not the earlier of ...). Otherwise, applicant will be denied benefit of the knowledge of the later prosecution and prior art which may give applicant reason for later filing a petition (e.g., if something is learned from an advisory action that gives one a basis for petition).

**Rule 1.145** - Subsequent Presentation of Claims for a Different Invention in an Application Filed Under 35 U.S.C. Section 111(a)

*The rule provides that if after an office action is issued and the applicant presents an amendment with claims directed to an invention distinct from and independent of the invention previously claimed, the applicant may be required to restrict the claims to the invention previously claimed.*

We have the same concern with respect to the discretionary nature of this proposed rule as stated above in reference to proposed rule 1.142. Further, is unclear as to what the criterion is for determining whether a restriction is to be made. For example, how does one traverse/petition the examiner's use of discretion? Therefore, we request further guidance and clarification.

**Rule 1.146** - Requirement for an Election of a Single Species in an Application Filed Under 35 U.S.C. Section 111(a)

*The proposed rule provides in part that (a) If one or more claims are directed to a single invention but encompass multiple disclosed and patentably distinct species, regardless of whether the claim uses alternative language, the examiner may require the applicant to elect one species that is disclosed in the application as filed for initial search and examination. Additionally, 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.*

Although we do note that the present version of this rule also allowed for the examiner's discretion, we again have the same concern with respect to the discretionary nature of this proposed rule as stated above in reference to proposed rule 1.142. For example, how does the concept of restriction here interface with the concept of rules 1.75(j) and 1.140(a) regarding claims with alternatives having a shared feature for common utility? If there is a shared feature for common utility (e.g., that the invention involves the recognition of such shared feature for common utility), then the application

of rule 1.146(b) would not seem to be proper, but this is not clear from 1.146(b).

Additionally, there are many situations where an independent genus claim is presented with many dependent claims directly depending from the genus claim that provide specific examples of an element of the independent claim. Sometimes the independent claim captures something not intended that is taught in a reference cited by the examiner. In this situation each dependent claim should be allowable if written in independent form. From the way this rule is worded (discretion) the examiner may be able to prevent the applicant from doing this when in fact there is no significant additional searching that is necessary to examine each such dependent claim.

#### Conclusion

IBM looks forward to continuing to work with the Office in furtherance of its goal of improving patent quality and the patent process.

Respectfully submitted,

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