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From: Dana Colarulli

Sent: Monday, October 15, 2007 8:35 PM

To: Markush.Comments

Cc: Herbert C. Wamsley

Subject: IPO Comments on Proposed Rules on Markush Claiming (72 Fed Reg 44992)

Importance: High

Attached, please find IPO's comments on proposed USPTO rules on 72 Fed Reg 44992.
Please contact me if you have any questions.

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October 15, 2007

The Honorable Jon Dudas
U.S. Patent & Trademark Office (USPTO)
Mail Stop Comments—Patents, Commissioner for Patents
P.O. Box 1450
Alexandria, VA, 22313-1450
Attention: Kathleen Kahler Fonda

Submitted by email to markush.comments@uspto.gov

Re: Comments on Proposed Rules related to “Examination of Patent Applications That Include Claims Containing Alternative Language,” 72 Fed. Reg. 44992 (Aug. 10, 2007)

Intellectual Property Owners Association (IPO) submits the following comments in response to the Office’s request contained in its notice of proposed rule making related to so-called Markush claims. We appreciate the opportunity to comment.

IPO believes that patent examiners currently have the available tools to manage many of the issues raised in the notice. We believe adoption of some of the proposed rules may increase the Examiner’s workload, not reduce it. Detailed comments on our views are included below.

IPO is a trade association representing intellectual property owners in all industries and fields of technology. Our current membership includes more than 200 companies and more than 10,000 individuals involved in IPO through their companies or in other member classes. IPO corporate members file about 30 percent of the patent applications filed in the USPTO by U.S. nationals.

Comments on Proposed Treatment of Claims that Recite Alternatives

The Office proposes to encourage applicants who use alternative language to provide an explanation as to why the claim is directed to a single invention. Under the proposed rules, an applicant may explain, for example, that the species share a substantial feature for a common utility. Alternatively, applicants may explain that the species are *prima facie* obvious over each other.

For small molecule claims, for example, a claim reciting a genus that covers all of the specific compounds made and contemplated should be sufficient in most cases to meet the first requirement of substantial feature of a common utility. If the genus is not commensurate in scope with the teachings or is indefinite for any number of reasons, the Examiner can raise objections under 35 USC § 112 paragraphs 1 or 2. Another issue that may arise is a case where hundreds of compounds are claimed by chemical name - but not by structure - in alternative form without reference to a genus. In such a case, the Examiner may properly reject the claims on the grounds that examination is unduly burdensome and require that the applicant show the common structural feature of the

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listed compounds. In such a case, including chemical structures along with or in place of the chemical names should suffice in showing the shared structural feature.

As to the suggested alternative, it is hard to imagine that Applicants would ever want to admit that species are *prima facie* obvious over each other. Indeed, this suggestion is in direct contravention to nearly 50 years of case law. In *In re Ruff*, 118, USPQ 340, 347 (CCPA 1958), the CCPA explained, “To rely on an equivalence known only to the applicant to establish obviousness is to assure that his disclosure is a part of the prior art. The mere statement of this proposition reveals its fallaciousness.”

Thus, if applicants were to admit that their species are *prima facie* obvious over each other, they could not overcome a reference that anticipated one of the species by simply excising that offending species from the claim. The Office should observe the rule in *Ruff*.

Comment on Proposed Rules §1.75(a)

Proposed Rule §1.75(a) requires that “a claim must be limited to a single invention”, and thereby prevents an Examiner from examining a claim that contains more than one invention, but whose examination does not impose a serious burden on the Office. We believe that claims which recite more than one invention, but do not impose a serious examination burden on the Examiner, should be examined together in order to increase efficiency of examination for the Applicant and the Office.

Comment on Proposed Rule §1.75(j)(1)

Proposed Rule §1.75(j)(1) reads: “The number and presentation of the alternatives in the claim does not make the claim difficult to construe.” We believe the proposed rule is unclear in that there is no guidance for applicants to understand what it means for “the number and presentation of the alternatives” to “not make the claim difficult to construe.” Should the Office reject applicants under this Proposed Rule, how are applicants to rebut such a finding and argue that their claims are not difficult to construe? What is the standard under which an Examiner would find that a claim is “difficult” to construe, as opposed to a claim which merely required some effort to construe? We believe that this Proposed Rule is too vague to be part of the standard for determining a proper Markush-type claim.

Comment on Proposed Rule §1.75(j)(2)

The Office proposes in Rule §1.75(j)(2) that “no alternative be defined as a set of further alternatives within the claim” for a claim that reads on multiple species by using alternative language. In other words, the Office proposes to eliminate so-called nested claims. We find this proposed rule objectionable for two reasons: First, applicants have a statutory right to claim what they consider their invention to be; accordingly, any administrative rule that adversely impacts such a right would represent an improper appropriation of Applicants’ rights. Second, as a practical matter, the Office’s proposed rule would, in many instances, add dramatically to the length of claims since nesting often serves as an easy claim drafting shorthand.

Consider, for example, a claim that includes “a fastener selected from the group consisting essentially of: a bolt, a screw, and an adhesive, and wherein the adhesive is glue or cement.” In the above example, glue and cement are “nested” in the sense that they are alternatives of “adhesive” which itself is an alternative of “fastener.” Nevertheless, a person of ordinary skill in the art would easily recognize what the patentee is claiming. On the other hand, if one were to write out every example of glue and adhesive to avoid the nesting problem, the claim could go on for a column or more.

Thus, proposed rule §1.75(j)(2) makes no distinction between a nesting that facilitates examination and one that makes it unduly burdensome. We propose that the test for rejection be one of undue burden of examination irrespective of the presence of nesting.

Comment on Proposed Rule §1.75(j)(3)

Rule §1.75(j)(3) requires that no alternative is encompassed by any other alternative within a list of alternatives, unless there is no other practical way to define the invention. Here, the Office proposes to eliminate so-called “double inclusion” in claims, which is addressed in MPEP 2173.05(o). We believe the proposed rule is consistent with MPEP 2173(o).

Comment on Proposed Rule §1.75(j)(4)

Rule §1.75(j)(4) requires that each alternative within a list of alternatives be substitutable one for another. It is not altogether clear what is meant by “substitutable one for another” but it seems very much like “*prima facie* obvious one for another”. For reasons discussed above, this rule would be in direct contravention to *In re Ruff*. Moreover, contrary to the statements by the Office in the Proposed Rules, it does not appear that MPEP 2173.05(h) is consistent with this proposed change. In fact, the Proposed Rule apparently contravenes the statements made in MPEP 2173.05(h):

Where a Markush expression is applied only to a portion of a chemical compound, the propriety of the grouping is determined by a consideration of the compound as a whole, *and does not depend on there being a community of properties in the members of the Markush expression.*
(emphasis added)

Accordingly, we believe that Proposed Rule §1.75(j)(4) makes a substantial and impermissible narrowing of the types of alternatives that may be provided within a Markush-type claim. Current language of MPEP 2173.05(h) only requires that “materials set forth in the Markush group ordinarily must belong to a recognized physical or chemical class or to an art-recognized class” and that where an alternative is applied to only a portion of a chemical compound the grouping is determined by a consideration of the compound as a whole, *not upon a community of properties in the members of the Markush expression.*

Because Proposed Rule §1.75(j)(4) substantially narrows what types of alternatives are allowed within a Markush-type claim, and is inconsistent with the language of MPEP 2173.05(h), we are opposed to implementation of this Proposed Rule.

Comment on Proposed Rule §1.140

INTELLECTUAL PROPERTY OWNERS ASSOCIATION

Comments on Proposed Rules on Markush Claims
October 15, 2007

Proposed Rule §1.140 defines the conditions under which a claim that uses alternative language contains more than one invention. According to Proposed Rule §1.140, a species of an alternative claim must “share a substantial feature essential for a common utility” in order for that claim to be directed to a single invention. The Office points to *In re Harnisch*, 631 F.2d 716, 206 USPQ 300 (CCPA 1980) to support the language of this Proposed Rule (72 Fed. Reg. 44992, Aug. 10, 2007, page 44996, col. 1). However, *Harnish* does not recite any such requirement:

We conclude that the board here was factually in error in not recognizing that all of appellant's claimed compounds are dyes, as confirmed by the solicitor's admission. The board's reliance on its notion that some of the claimed compounds are "no more than intermediates" overlooked the now admitted fact that they are dyes as well. Clearly, they are all coumarin compounds which the board admitted to be "a single structural similarity." We hold, therefore, that the claimed compounds all belong to a subgenus, as defined by appellant, which is not repugnant to scientific classification. Under these circumstances we consider the claimed compounds to be part of a single invention....

All the *Harnish* court held was that the claimed species were all dyes and that the claimed species shared a structural similarity which made them part of a subgenus. There is no discussion in *Harnish* of a “substantial feature”, or that such a feature would be “essential for a common utility”. We believe that the Office’s extension of the *Harnish* decision to require that species share a substantial feature essential for a common utility is improper and unduly limits the types of claims which can be properly examined using alternative language. Instead we suggest that Examiners continue to analyze whether the presented alternatives are independent and distinct from one another to properly determine whether such alternatives are directed to different inventions. We do not believe that it is necessary to change the well-used definition of “a single invention” being one that is independent and distinct solely to cover alternative claiming practice.

Comment on Independent and Distinct Requirement

We note that many of the proposed rules properly recite that claims which are “independent and distinct” from one another are directed to different inventions. This language was codified in 35 U.S.C. § 121 which states that “If two or more independent and distinct inventions are claimed in one application, the Director may require the application to be restricted to one of the inventions.” We note that in many cases the Office continues to restrict applications where the inventions are independent *or* distinct from one another, which is contrary to the statements made in the Proposed Rules and in the plain language of 35 U.S.C. § 121. We encourage the Office to follow the language of 35 U.S.C. § 121 and only restrict claims which are directed to inventions that are both independent and distinct.

Conclusion

Many of the Proposed Rules would unduly limit the protection sought by applicants. Moreover, strict adherence to the letter of some the proposed rules would necessarily result in a greater number of restrictions of inventions, which would undermine the

INTELLECTUAL PROPERTY OWNERS ASSOCIATION

Comments on Proposed Rules on Markush Claims

October 15, 2007

purpose of the rules, namely, to ease the burden of examination. The examiners already have at their disposal sufficient means to manage the problems arising in Markush practice. Adoption of §1.75 (j)(3) may aid the Office practice without compromising the rights of patent applicants.

Thank you for your consideration of our comments.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Marc S. Adler". The signature is fluid and cursive, with the first name "Marc" being the most prominent.

Marc S. Adler

President