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From: Moore, Steven J.

Sent: Wednesday, September 19, 2007 10:43 AM

To: Markush.Comments

Subject: Comments on Proposed Rules on "Examination of Patent Applications That Include Claims Containing Alternative Language" - 72 Fed. Reg. No. 154 (August 10, 2007)

The Honorable Jon W. Dudas

Dear Under Secretary Dudas:

As an attorney representing numerous clients, I appreciate the opportunity to offer comments to the U.S. Patent and Trademark Office on its Proposed Rules entitled "Examination of Patent Applications that Include Claims Containing Alternative Language, published at 72 Fed. Reg. 41472 et seq. on July 30, 2007.

First, I must lodge my disagreement with the Office's characterization of such Proposed Rules as "interpretative" versus "substantive." Clearly these rules impact the ability of an applicant to adequately claim the applicant's invention, and to claim the same in the best possible fashion. In conjunction with the new continuation rules, it is asserted that such Proposed Rules deny many applicants their right to obtain claims covering the full scope of their inventive concepts. It is asserted that the Office has failed to meet its obligations under the Regulatory Flexibility Act and the Administrative Procedure Act.

Among other factors, the Section 1.75 is objected to in that it requires a Jepson claim "[w]here the application describes a claimed invention as an improvement." This is irrespective of whether such Jepson claim format allows an applicant to fully covers the inventive concept, or adequately cover all aspects of the invention. The same section is objected to in that it does not allow any alternative to be defined as a set of further alternatives of the claims. As understood by the Office, such "nested" claims are commonplace in chemical and pharmaceutical patents, and are frequently necessary to adequately define the scope of the invention at hand.

Section 1.140 sets for a requirement for a claim to be limited to a single invention. In conjunction with the new continuation rules promulgated the USPTO, such section may not allow an applicant an opportunity to full cover each of the inventive concepts in the applicant's application. It is noted that Section 1.142 does not require an Examiner to cause a restriction requirement.

Sincerely,

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