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From: Rick Neifeld  
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To: Markush.Comments  
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Subject: Comments

Comments on proposed rules to limit alternative claiming, published at  
72 FR 44992

By: Rick Neifeld, Patent Attorney

1. "§ 1.75 Claims.

(a) The specification must conclude with a claim particularly pointing out and distinctly claiming the subject matter which the applicant regards as his or her invention or discovery. A claim must be limited to a single invention."

Comment: The term "invention" is not defined. Therefore, the proposed rule is indefinite.

2. "1.75 (e) Where the application describes a claimed invention as an improvement, any independent claim should contain in the following order:

(1) A preamble comprising a general description of all the elements or steps of the claimed invention which are conventional or known;  
(2) A phrase such as ''wherein the improvement comprises''; and  
(3) Those elements, steps, and/or relationships which constitute that portion of the claimed invention which the applicant considers as the new or improved portion."

Comment: 1.75(e)(1) violates an inventor's right to claim his invention. Just because an applicant's invention is an improvement on specified prior technology, does not mean that it necessarily requires all elements of the prior technology. However, 1.75(e)(1) requires the applicant to limit his claim to include all elements of the prior technology.

3. "1.75 (j) A claim that reads on multiple species by using alternative language must meet the following conditions:

(1) The number and presentation of alternatives in the claim does not make the claim difficult to construe;  
(2) No alternative is defined as a set of further alternatives within the claim; and  
(3) No alternative is encompassed by any other alternative within a list of alternatives, unless there is no other practical way to define the invention.  
(4) Each alternative within a list of alternatives must be substitutable one for another."

Comment: 1.75(j)(1) requires completely subjective judgement, and therefore its application is inherently arbitrary and capricious.

4. "1.75(k) A claim may not incorporate another part of the specification or drawings by reference, unless there is no other practical way to define the invention. If a claim incorporates another part of the specification or drawings by reference, and that portion of the specification or drawings sets forth alternatives, the claim must comply with, and is subject to the provisions of, paragraph (j) of this section and § 1.140."

Comment: Do means plus function recitations "incorporate[] another part of the specification or drawings by reference" within the meaning of proposed 1.75(k)?

5. "§ 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 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."

Comment: The word "invention" is indefinite, and therefore "limited to a single invention" is also indefinite.

Why not provide consideration of comments explaining the existence of "substantial feature essential for a common utility"?

6. "§ 1.141 Different inventions in one application filed under 35 U.S.C. 111(a).  
(a) Two or more independent and distinct inventions should not be claimed in one application. \*\*\*  
(d) Any claim that recites both an elected and a non-elected invention in the alternative will be objected to as failing to comply with § 1.75(a). Any non-elected invention must be canceled before the claim will be allowed, subject to reconsideration and review as provided in §§ 1.143, 1.144 and 1.181."

Comment: Examiner's often game the system by arbitrarily selecting classification and other information in order to support a requirement for restriction. Will the applicant be allowed to cite information in the prosecution file during the course of prosecution to rebut the presumption the a claim recited both elected an non elected inventions. For example, the classification of the art cited against the examined claims?

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