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**From:** Raymond Parker III

**Sent:** Tuesday, October 09, 2007 11:56 PM

**To:** Markush.Comments

**Subject:** Spam: Markush Proposed Rule Making

Attached are my comments to the proposed rule making regarding Markush claims.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

**Federal Register Notice: 72 Fed. Reg. 44992 (August 10, 2007)**

**Action: Response to Notice of Proposed Rulemaking**

**Title: Examination of Patent Applications That Include Claims Containing Alternative Language”**

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 223 13-1450

Sir:

This paper is in response to the 72 Fed. Reg. 44992 (August 10, 2007), entitled “Examination of Patent Applications That Include Claims Containing Alternative Language”.

I. Proposal To Limit A Claim To A Single Invention

35 U.S.C. § 121<sup>1</sup>, provides the legal standard for patent examiners, and practitioners, to determine the number of inventions within a patent application. The statute requires that there be more than one “*independent and distinct*” (emphasis added by submitter) invention claimed in a single application to allow proper issuance of a restriction requirement.<sup>2</sup> Thus, the Patent Office has properly acknowledged that 35 USC 121 gives the Patent Office the right to limit a claim to single invention at 72 Fed. Reg. 44993, Col 2. Respondent takes no exception to this proposal provided the Patent Office abides by the

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<sup>1</sup> See 35 U.S.C. § 121 states, “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. If the other invention is made the subject of a divisional application that complies with the requirements of section 120 of this title it shall be entitled to the benefit of the filing date of the original application. A patent issuing on an application with respect to which a requirement for restriction under this section has been made, or on an application filed as a result of such a requirement, shall not be used as a reference either in the Patent and Trademark Office or in the courts against a divisional application or against the original application or any patent issued on either of them, if the divisional application is filed before the issuance of the patent on the other application. If a divisional application is directed solely to subject matter described and claimed in the original application as filed, the Director may dispense with signing and execution by the inventor. The validity of a patent shall not be questioned for failure of the Director to require the application to be restricted to one invention.” Emphasis in bold.

<sup>2</sup> “A Markush-type claim is directed to “independent and distinct inventions,” if two or more of its members are so unrelated and diverse that a prior art reference anticipating the claim with respect to one of the members would not render the claim obvious under 35 U.S.C. 103 with respect to the other member(s). *In re Weber, Soder, and Boksay*, 198 U.S.P.Q. 328 at 332. However, when a Markush grouping does not contain “independent and distinct” inventions, “the substances grouped have a ‘community of chemical or physical characteristics’ which justify their inclusion in a common group, and that such inclusion is not repugnant to principles of scientific classification, within the meaning of such decisions as *Ex parte Burke*, *supra*, and *In re Swenson et al.*, *supra*.”). *In re Jones*, 74 U.S.P.Q. 149 at 151.

statutory requirements and case law.

While 35 U.S.C. §121 does not detail how Markush claimed subject matter should be handled in prosecution, case law has established those details in the judicially created doctrine of “Markush practice”. For chemical patent practice, this doctrine focuses primarily upon the principles of the *Harnish cases*, which provides the bases<sup>1</sup> upon which an improper Markush group would require restriction. Specifically, the *Harnish cases* provide an approach to evaluate Markush groups. In part, in determining the propriety of a Markush grouping, the compounds must be considered as wholes and not broken down into elements or other components. The *Harnish cases* also provide the requisite elements that satisfy the PCT Rule 13.2 Unity of Invention standard, i.e., that individual compounds encompassed by a Markush structure must share a “single structural similarity” and a “common utility”. This case law must be recognized and procedurally practiced by the USPTO for compliancy to the statutory mandate of 35 U.S.C. § 121. Without accord between the statute and case law, the appropriate application of laws regarding Restriction practice in the United States is not correctly effectuated regarding Markush-type claims.

**II. Proposal To Specify That When Subject Matter That Reads On Multiple Species Is Defined In A Single Claim Using Alternative Language, The Claim Is Limited To A Single Invention When At Least One Of The Following Two Conditions Is Met: (1) All Of The Species Encompassed By The Claim Share A Substantial Feature Essential For A Common Utility, Or (2) All Of The Species Are *Prima Facie* Obvious Over Each Other.**

Respondent first takes exception that the Patent Office assumes that the use of alternative language in a claim thus means that the claim is directed to a multiplicity of species. In fact one or more terms used in the alternative could be generic whereby the claim encompassing such term could solely encompass alternative subgeneric embodiments rather than being only encompassing a multiplicity of species. Furthermore terms used in the alternative could be directed to both generic terms and single elements such the claim could encompass both species and subgeneric embodiments. Of course terms used in the alternative could be directed to single elements only and thus would then give rise to a claim that is directed solely to a multiplicity of species. However, there should be no requirement that a claim using terms in the alternative should only relate to a multiplicity of species as such would deny applicants their right to define their claimed invention in a single claim, as such is the right of the applicant and not the Patent Office to define the invention.

**A. Subproposal that All Of The Species Encompassed By The Claim Share A Substantial Feature Essential For A Common Utility.**

Respondent notes that aforesaid subproposal is in absolute contradiction to the case law regarding how to look at a Markush claim compound. In particular that case law directs only that 1) such claimed subject matter have a substantial structural feature and that the claim compounds have a common utility.<sup>3</sup>

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<sup>3</sup> “Restriction” is a generic term that includes the practice of electing between distinct inventions, including those inventions that involve Markush-type claims. U.S. patent practitioners seek guidance from two independent restriction practice sources: (a) 35 U.S.C. §121; and (b) *In re Harnisch*, 206 U.S.P.Q. 300, 631

See, In re Harnisch, 206 USPQ 300, 305 where structural feature in compounds was noted to be coumarin and compounds, not structural feature, noted to be dyes. See also Ex parte Holt and Randell, 214 USPQ 381, 386 where structure feature was noted to be piperidine derivative and compounds, not structural feature, noted to be polymer stabilizers. Furthermore, such consideration runs a foul of the base requirement that an invention should be considered in the whole, particularly as dictated by case law.<sup>4</sup>

B. Subproposal that All Of The Species Are *Prima Facie* Obvious Over Each Other.

Respondent notes that while an applicant could aver that all species encompassed by a Markush claim are *prima facie* over each other that such is not practical. Amongst a number of species covered by a genus, it is usually the case that some members have unexpectedly superior characteristics over other species. Thus, to require such averment would be tantamount to having the applicant to make a false statement.

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Respectfully submitted by Raymond S. Parker, III, Reg. No. 34,893 Dated: October 9, 2007

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F.2d 716 (hereinafter “Harnisch”) and related cases (hereinafter collectively “Harnisch cases, i.e., the Harnisch cases collectively include: In re Harnisch, 206 U.S.P.Q. 300; Ex parte Holt and Randell, 214 U.S.P.Q. 381; In re Haas, 198 U.S.P.Q. 334 (Haas II); In re Weber, Soder, and Boksay, 198 U.S.P.Q. 328; Ex parte Brouard Leroy, and Stiot, 201 U.S.P.Q. 538; In re Jones, 74 U.S.P.Q. 149; and Ex parte Dahlen and Zwilgmeyer, 42 U.S.P.Q. 208. Restriction practice, however, as applied by the USPTO in chemical patent prosecution for Markush-type claims is not aligned with 35 U.S.C. § 121 or the Harnisch cases.

<sup>4</sup> Patent law case law employs the overarching standard of considering the “invention as a whole” on various numbers of issues. For example,

§ 101 issues, see MPEP § 2106, “Finally, when evaluating the scope of a claim, every limitation in the claim must be considered. Office personnel may not dissect a claimed invention into discrete elements and then evaluate the elements in isolation. Instead, the claim as a whole must be considered. See, e.g., *Diamond v. Diehr*, 450 U.S. at 188-89, 209 USPQ at 9 (“In determining the eligibility of respondents’ claimed process for patent protection under 101, their claims must be considered as a whole. It is inappropriate to dissect the claims into old and new elements and then to ignore the presence of the old elements in the analysis. This is particularly true in a process claim because a new combination of steps in a process may be patentable even though all the constituents of the combination were well known and in common use before the combination was made.”).

§ 103 issues, see *Texas Instruments Inc. v. U.S. Intern. Trade Com’n*, 854 F.2d 1327 (unpublished opinion) “It is not proper to dissect claims and reconstruct them in piecemeal fashion by picking and choosing from among the prior art references using the patent as a blueprint. In re Kamm, 452 F.2d 1052, 1056-57, 172 USPQ 298, 301-02 (CCPA 1972). In determining obviousness, therefore, the inquiry is not whether each element existed in the prior art, but whether the prior art made obvious the invention as a whole. *Hartness Int’l, Inc. v. Simplimatic Eng’g Co.*, 819 F.2d 1100, 1108, 2 USPQ2d 1826, 1832 (Fed.Cir. 1987). Further, if prior art references require selective combination to conclude that an invention would have been obvious, there must be some teaching or suggestion in the references that would support their use in combination. *Ashland Oil, Inc. v. Delta Resins & Refractories, Inc.*, 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed.Cir.1985), cert denied sub nom., 475 U.S. 1017 (1986). . .”;

Markush issues, see Ex parte Taylor 167 USPQ 637, “...group under the Markush expression is ‘determined by a consideration of the compound as a whole, ...’”; Ex parte Brouard, Leroy and Stiot 201 USPQ 538, 540 “...the compounds as a whole must be considered, rather than ‘B’ substituents alone.”; and In re Ruff 45 CCPA 1037, 1051 “where a Markush expression is applied only to a portion of a chemical compound, the propriety of the grouping is determined by the 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.”