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**From:** Russel, Jeffrey  
**Sent:** Monday, September 10, 2007 12:16 PM  
**To:** Markush.Comments  
**Subject:** Comment with respect to proposed Rule 1.140(a)(1)

Director Dudas:

With respect to proposed 37 CFR 1.140(a)(1), it does not appear that this condition would be sufficient to meet the goals of the proposed rulemaking, i.e. to limit the claims to a single invention and to avoid examination of claims such as those which occur in the examples at 1322 OG 24, column 1. In particular, "a substantial feature essential for a common utility" is defined at 1322 OG 27, column 1, as being "a feature, such as a particular structure, material, or act, without which the claimed alternatives would not retain the shared utility". With respect to, e.g., the cited Example 24 of the PCT Guidelines, the heterocycle C would appear to satisfy the requirement for "a substantial feature essential for a common utility", because it is unlikely that the claimed pharmaceutical compounds would retain the intended utility in the absence of such a heterocycle C. Because the pharmaceutical compound of the Example appears to satisfy proposed Rule 1.140(a)(1), it would then become necessary to examine the approximately  $2.564 \times 10^{23}$  possible species mentioned in the OG Notice. Similarly with respect to the examples in Section 2, numbers (2) and (3), the claimed protein and polypeptide all have a polypeptide backbone in common, which appears to satisfy the requirement for a substantial feature essential for a common utility, i.e. a feature without which the claimed alternatives would not retain the shared utility. Again, because the proposed rule is so easily satisfied, any number of proteins and peptides grouped together in a single claim using alternative language would have to be searched and examined by the Office.

It is believed that further refinement of what constitutes a "substantial feature essential for a common utility" will be necessary. Possibilities include shifting to a "necessary and sufficient" type of definition, or to an additional requirement that the substantial feature must itself define over the prior art, as occurs in PCT Rule 13.2.

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