

From: David Testardi  
Sent: Monday, March 31, 2008 4:51 PM  
To: Markush.Comments  
Subject: Comments on "Examination of Patent Applications That Include Claims Containing Alternative Language" Proposed Rules

Sirs/Madams,

Attached please find my comments (in pdf format) to the Federal Register notice published on March 10, 2008 regarding the "Examination of Patent Applications That Include Claims Containing Alternative Language" Proposed Rules.

Thank you very much.

Sincerely,

David Testardi  
Reg. 33,639

# *Comments Regarding the "Examination of Patent Applications that Include Claims Containing Alternative Language" Proposed Rule Making*

Dear Sirs/Madams,

I would like to make the following comments regarding the "Examination of Patent Applications that Include Claims Containing Alternative Language" proposed rule making.

This proposed rule making unfortunately shows a marked misunderstanding of basic patent law, and the proposed rules are contrary to both case law and statute.

## **Comment on Rule 75:**

It is well known that the legal term "invention" is reserved for that subject matter which is properly recited in a patent claim. An invention is no more than and can be no less than the claim recitation. A claim therefore cannot cover more than one invention.

To say that "[a] claim must be limited to a single invention" is both unclear and confusing, and shows a stark misunderstanding of the basic legal term "invention" which has been well-settled for decades. Specifically, an invention (singular) is defined by a claim (singular), perfectly and precisely. A patent may, however, cover more than one claimed "invention", with the number of claimed inventions being *exactly* linked to the number of claims.

See *Gould, Inc. v. U.S.*, 579 F.2d 571, 576, 198 USPQ 156 (Ct. Cl. 1978):

It is also important to keep in mind that each claim of a patent is a separate and distinct invention.

See also *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993):

It is axiomatic that the claims define the invention which an applicant believes is patentable.

To make the term "invention" in proposed 37 CFR 1.75(a) represent some abstract and constructed regulated concept of disclosure (as the USPTO proposes to do here) is nothing less than a corruption of decades of jurisprudence and precise usage of a specific legal term. Moreover, if USPTO regulators will read even a half-dozen well-written patent applications, they will see that attorneys do not use the term "invention" to describe something abstract or constructed in the specification other than the claims; rather, they always use (or always should use) language such as, "In a *preferred embodiments* of the invention, ..." when it is necessary to describe specific details that may or may not be exactly representative of the claimed invention.

Regarding the requirement that inventions which are described as an "improvement" in the application be claimed in Jepson format, again this shows a misunderstanding of what an "invention" is. Moreover, the practical effect of this requirement (when coupled with KSR and the current inequitable conduct and malpractice landscape) will merely be to *prevent practitioners from describing inventions as improvements* (because if they do, their clients will be limited to only Jepson claims and that may open the door for a charge of malpractice), even though such description might otherwise have made it easier for an Examiner to properly understand the claimed invention. (As the USPTO regulators should be well-aware, there is *no statutory requirement that the invention be describe as, or even be, an improvement over the prior art.*)

## Comment on Rule 140

Again, the abstract and constructed misuse of the word "inventions" in proposed 37 CFR 1.140(a) is objectionable, and shows a basic misunderstanding of patent law terminology. Moreover, the phrase "[t]he species share a substantial feature essential for a common utility" is vague and unclear and cannot be correctly interpreted to mean (as the USPTO has apparently done in the Discussion of Specific Rules on page FR 44997) "share a utility that complies with ... 35 U.S.C. 101" because doing so renders the regulatory words "substantial feature essential for" altogether meaningless. Such an interpretation would not be a preferred judicial construction of the proposed Rule.

As a real-world example of the problems that the language of proposed Rule 140 creates, please consider the following hypothetical.

Amorphous diamond-like carbon is a well known protective film material that can be doped with nitrogen, hydrogen, fluorine, or other elements to improve its film properties (e.g. its adhesion, its toughness, etc.) Dependent claims for a newly configured and surfaced drill bit might recite:

2. The drill bit as recited in claim 1, further comprising a dopant in the protective carbon film.<sup>1</sup>
3. The drill bit as recited in claim 2, wherein the dopant is selected from the group consisting of: nitrogen and hydrogen.

There is not one single significant "feature" that nitrogen shares with hydrogen, other than being "matter". Moreover, if a feature of the genus is chosen ("dopant", which just means one material mixed into another in small amounts, in claim 2) to show a common feature rather than common utility, then all species will always share the genus feature, making 37 CFR 1.140(a)(1) perhaps meaningless in practice (again, not a preferred judicial construction).

Would proposed 37 CFR 1.140(a)(1) render the above claim 3 objectionable? How can what is or is not a substantial, essential "feature" be determined? My questions are not rhetorical.

---

<sup>1</sup> "[A]pparatus claims cover what a device *is*, not what a device *does*." Hewlett-Packard Co. v. Bausch & Lomb Inc., 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990) (emphasis in original)

## Comment on Rule 141

It is alleged in proposed Rule 141 by the USPTO that "[t]wo or more independent and distinct inventions *should not* be claimed in one application." If this is so, then isn't it hypocritical to be changing Rule 145 (at the same time as proposing Rule 141) to permit Examiners not to restrict claims after original presentation, where they are now required to restrict such claims? Why the double standard between what the applicant should now not do and what the Examiner may soon do?

It is well known that public notice is best served when related inventions (apparatus and method of making, apparatus and method of using, related species, etc.) appear in a single patent, rather than being strewn over six different patents because of arbitrarily regulated requirements.

Again, the abstract and constructed misuse of the word "invention" in proposed 37 CFR 1.141(a) is objectionable, and shows a basic misunderstanding of patent law terminology.

NB: This author believes the reason Rule 145 is being changed has nothing to do with alternative claim language, but rather has to do with a loophole that would otherwise exist in the ill-conceived Claims and Continuation Rules were Rule 145 not changed from its present wording.

## Comment on Rule 142

Again, the abstract and constructed misuse of the word "inventions" in proposed 37 CFR 1.142(b) is objectionable, and shows a basic misunderstanding of patent law terminology. A claim cannot by definition cover plural inventions (since it is a single invention), regardless of whether alternative language is employed.

## Comment on Rule 146

This proposed Rule is the epitome of regulatory hand-waving, double-speak, and unfairness. The scenario that proposed Rule 146 effectively regulates is this:

- 1) Applicant files application with an independent genus claim properly directed to a "single invention" (even as defined in proposed Rule 140) with the breadth of multiple species (say, ABCDE) which are covered in dependent claims;
- 2) Examiner requires applicant to elect one species for initial search and examination (say, applicant elects D);  
[NB: Why would a prudent Examiner narrowly search a single species D when he was faced with the possibility of allowing a genus claim covering ABCDE?]
- 3) Examiner doesn't find elected species (D), but by chance finds another species (say, he finds B) that was not elected for initial search and examination;  
[NB: Then what was the purpose of the original election requirement if the Examiner would need to search for the other species ABCE anyway to examine the genus claim? The answer will become apparent below, unfortunately.]

4) Examiner can now restrict applicant under proposed Rule 146 to originally elected species (D), even though the independent genus claim was properly directed to a "single invention" under proposed Rule 140.

[NB: Oh, that was the purpose of the election requirement, to force the applicant to accept a patent that covers less than a "single invention". Well, how unfair is that?]

This proposed Rule is designed to force patent applicants to obtain patents which cover less than a "single invention", even as the term "single invention" is improperly construed in the proposed new Rules. Under this proposed Rule (as shown in the example above), the claims in a can be restricted (by the USPTO) to cover only one-fifth of an invention, rather than a "single invention". *Please note that 35 USC does not give the USPTO regulatory power to restrict claims directed toward a single invention: a statutory restriction pursuant to 35 USC 121 is only proper when "two or more independent and distinct inventions are claimed in one application", and pursuant to 35 USC 2, the USPTO may only establish regulations which are "not inconsistent with law".* That is, there is no basis in law for the unfair result that would be created by 37 CFR 1.146, nor (for that matter) is there any basis in reason. Moreover, 35 USC 101 states:

"Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor..."

35 USC 101 does not state you may obtain two patents on a single invention (and in fact proscribes such conduct), so my question is, in the hypothetical above, will the applicant be prevented by statute from obtaining patents directed to the other species (ABCE), since they form a "single invention" (by the USPTO's abstract and constructed definition) with the elected species (D), as set forth in 37 CFR 1.146(a)? Again, my question is not rhetorical.

Thank you.

Sincerely,



---

David A. Testardi  
Registered Patent Attorney  
Reg. 33,639