

-----Original Message-----

From: Louis J. Hoffman

Sent: Tuesday, October 09, 2007 8:37 PM

To: Markush.Comments

Cc: Sean Brennan; Ron Reardon

Subject: NAPP comments attached

Dear Sir or Madam,

Please review the comment attached of the National Association of Patent Practitioners, regarding the proposed Markush claim rules published for comment.

Regards,

Louis J. Hoffman

Government Affairs Committee Chair & Board Member

National Association of Patent Practitioners

480-948-3295

**RESPONSE TO THE USPTO REQUEST FOR COMMENTS ON
PROPOSED CHANGES TO RULES REGARDING
EXAMINATION OF PATENT APPLICATIONS THAT INCLUDE CLAIMS
CONTAINING ALTERNATIVE LANGUAGE**

**Submitted by: The National Association of Patent Practitioners
Sean Brennan, Vice President and Member, Government Affairs Committee
October 9, 2007**

INTRODUCTION

The following comments are submitted in response to the Request for Comments on the USPTO's Notice of proposed rulemaking entitled "Examination of Patent Applications That Include Claims Containing Alternative Language." Federal Register, Vol. 72, No. 153, August 10, 2007, pages 44992-45001.

The National Association of Patent Practitioners (NAPP) is a nonprofit trade association for patent agents and patent attorneys. NAPP has approximately 450 members in 13 countries. The practices of the practitioner members are focused primarily on patent prosecution, namely practice before the USPTO. As part of NAPP's mission, we aim to create a collective nationwide voice to address issues relating to patent prosecution practice. Additional information about NAPP can be found at www.napp.org.

NAPP speaks on behalf of patent agents and attorneys whose practice generally involves active prosecution before the USPTO. Those members most interested in the subject volunteered to work on drafting or reviewing these comments.

NAPP welcomes the opportunity to comment on the PTO's proposed rules for examination of patent applications that include claims containing alternative language, and hopes that the PTO will seriously consider the comments of NAPP and other interested parties, and revise the proposed new rules accordingly.

SUMMARY OF PROPOSED RULE CHANGES

The PTO proposes to change certain portions of 37 C.F.R., *inter alia*, to require that a claim be limited to a single invention (proposed new 37 C.F.R. §§ 1.75(a); 1.140), to specify the format in which claims reciting alternatives can be written (proposed new 37 C.F.R. §§ 1.75(j)(k)), and to allow an examiner to object to (and, presumably, refuse

to examine) certain types of claims that recite alternatives (proposed new 37 C.F.R. § 1.142(d)).

GENERAL COMMENTS

These proposed rule changes, which would place limitations on an applicant's ability to claim a plurality of species of a generic invention, follow closely on the heels of new rules, soon to be implemented, limiting the number of claims that will be examined in an application and limiting the number of continuing applications available by right to an applicant,¹ as well as proposed rule changes regarding Information Disclosure Statements² and practice before the Board of Patent Appeals and Interferences.³ They thus continue disturbing recent trends by the PTO to attempt to limit an applicant's ability to thoroughly and adequately claim his or her invention, to make patent prosecution more difficult and time-consuming for applicants, and to place more of the burden and expense of examination upon applicants.

An additional concern raised by these trends is that, if examiners do less and less of the work of search and examination (a result that flows from the recently enacted and presently proposed rule changes), United States patent applications will suffer from less rigorous, more piecemeal examination, resulting in potentially weaker patent protection for inventors, at substantially higher cost.

The PTO's apparent attempt to extend restriction practice by introducing a mechanism for intra-claim restriction raises additional concerns. Such a mechanism would be fraught with the same deficiencies already plaguing inter-claim restriction practice; including inconsistency among examiners in applying criteria for restriction, lack of factual support for restriction requirements, and the contribution to the examination backlog resulting from the conversion of a single application into multiple divisional applications.⁴ See "Response to the USPTO Request for Comments: Green

¹ 72 *Fed. Reg.* 46716, August 21, 2007

² 71 *Fed. Reg.* 38808, July 10, 2006

³ 72 *Fed. Reg.* 41472, July 30, 2007

⁴ 35 U.S.C. § 121, first sentence

Paper Concerning Restriction Practice” (August 5, 2005), available at napp.org/resources/NAPP_Green_Paper_Comments.pdf.

One wonders whether any claim is ever really limited to a single invention. (See comments on Judge Rich’s concurrence in *In re Weber, infra.*) In particular, open claim language, utilizing the term “comprising,” can almost surely be considered to cover a number of unrecited alternatives. It is NAPP’s opinion that giving examiners the authority to restrict within a claim will open a Pandora’s Box of complicated claim construction issues and burgeoning divisional filings. At a time when the Office seeks to simplify and streamline the patent application process, such a course seems ill-advised.

In this context NAPP also notes that the Office has presented no evidence of how these proposed rule changes would reduce the current and projected “backlogs” in the PTO. To the contrary, it would appear that the proposed changes, if enacted, would result in increased filing of divisional applications, thereby exacerbating the “backlog.” If, on the other hand, the purpose of these and other new rules is to discourage applicants from filing as many patent application as they otherwise might by, *inter alia*, raising the specter of the prohibitive expense of filing and prosecuting innumerable divisional applications, it would seem surprising coming from an agency tasked to provide services to the public.

On the whole, NAPP believes that the proposed changes, like the previous proposals mentioned above, are unduly punitive to applicants and will lead to increasingly inadequate and piecemeal patent protection for American innovators at higher cost. Furthermore, the proposed rule changes have no basis in the statute and they conflict with controlling case law (see next section).

STATUTORY AUTHORITY AND CONTROLLING CASE LAW

Lack of Statutory Authority

NAPP is not aware of any section of the Statute that would allow an examiner either to: (1) refuse to examine a claim or (2) require an applicant to re-draft a claim as a condition for it to be examined; nor has the Office identified any such section in its Notice of proposed rule making. To the contrary, the statute requires that an application in compliance with 35 U.S.C. § 111 be examined without any further prerequisites:

The Director shall cause an examination to be made of the application and the alleged new invention; . . .
(35 U.S.C § 131, emphasis added)

Conflict with Controlling Case Law

None of the cases cited by the PTO in the Notice support the legality of the proposed changes. Furthermore, careful review of the case law relied upon by the Office in the Notice reveals that implementation of the proposed changes would conflict with existing case law.

Initially, NAPP believes that the Office has overinterpreted dicta from *In re Ruff*. At issue in *Ruff* was whether an applicant's disclosure of equivalence between two members of a Markush group sufficed to render one member of the group unpatentable when the other member was found in the prior art. The salient finding of *In re Ruff* was that "actual equivalence is not enough to justify refusal of a patent on one member of a group when another member is in the prior art. The equivalence must be disclosed in the prior art or be obvious within the terms of Section 103." 118 USPQ 348 (CCPA 1958).

In *In re Haas*, 486 F.2d 1053, 179 USPQ 623 (CCPA 1973) ("*Haas I*"), the Court held that withdrawal of a Markush claim in the application at issue as well as prospectively in all subsequent applications, on the basis of its content, was tantamount to rejection and was improper. The proposed new rules, by potentially requiring an applicant to re-draft a Markush-type claim (proposed new Sections 1.142(d) and 1.146(b)), could result in a similar permanent withdrawal of the original claim. Such practice on the part of the Office would appear to be prohibited by *Haas I*.

In *In re Weber*, the CCPA held that the Office could not reject a claim for misjoinder under 35 U.S.C. § 121. Importantly, the *Weber* Court also commented negatively on the approach now being proposed by the Office:

As a general proposition, an applicant has a right to have *each* claim examined on the merits. . . . If, however, a single claim is required to be divided up and presented in several applications, that claim would never be considered on its merits. The totality of the resulting fragmentary claims would not necessarily be the equivalent of the original claim. 198 USPQ 328, 331 (CCPA 1978), emphasis in original

Recently, the Office has made much of its need to alter long-established practices to solve internal problems of pendency and productivity. Yet the *Weber* Court was clear on the relative priorities of the Office's concerns and an applicant's rights:

Even though the statute allows the applicant to claim his invention as he sees fit, it is recognized that the PTO must have some means for controlling such administrative matters as examiner caseloads and the amount of searching done per filing fee [footnote omitted]. But, in drawing priorities between the Commissioner as administrator and the applicant as beneficiary of his statutory rights, we conclude that the statutory rights are paramount. 198 USPQ 328, 332 (CCPA 1978)

In his concurrence in *Weber*, Judge Rich also pointed out that the Office did not have the authority, under 35 U.S.C. § 121, to divide up a single claim:

Ever since *Ex parte Eagle*, 1870 C.D. 137 (Com'r Pats. 1870), at least, the expression used in § 121, "two or more . . . inventions are claimed," has connoted separate claims to separate inventions. It has no reference to generic or broad claims which "embrace" (the term used by the examiner and the board herein) or "cover" (the term used in the solicitor's brief in support of the board) two or more inventions. 198 USPQ 328, 333 (CCPA 1978)

In its proposed new rules, the Office eschews use of the terms "embrace" or "cover," substituting "limited to" (proposed new Section 1.75(a)), "reads on" (proposed new Sections 1.75(j) and 1.140), "recites" (proposed new Section 1.142) and "directed to" (proposed new Section 1.146(a)). Despite the new wording, the similarity is clear, and Judge Rich's comments are as apt now as they were in 1978.

Further comments by Judge Rich, in his concurrence in *Weber*, seem prescient in retrospect:

The practice here challenged [rejection of a Markush claim for "misjoinder"] is tantamount to a refusal by the PTO to examine a single Markush claim in a single application because, in its opinion, it is *broad* enough to "embrace" or "cover" a plurality of inventions which, if presented separately, would be separately patentable, *assuming* any one of them to be prior art. . . .

The fault in the PTO position is that it overlooks the obvious fact that almost any reasonably broad claim

“embraces” or “covers” a multiplicity of inventions, in the sense of “dominating” them, which inventions might be separately patentable if and when presented in separate applications. Logically, this is not a sufficient excuse for refusing to examine a claim on its merits for compliance with 35 USC 101, 102, 103 and 112. . . .

So the discretionary power to limit one application to one invention is no excuse at all for refusing to examine a broad generic claim - - no matter how broad, which means no matter how many independently patentable inventions may fall within it. (198 USPQ 328, 333-334 (CCPA 1978) (emphasis in italics in original; emphasis underlined added))

Finally, *In re Harnisch* considered whether a claim could be rejected under a Board-derived “doctrine” of an “improper Markush group.” The *Harnisch* Court declined to adopt such a doctrine, stating:

. . . we decide this and like cases on their facts on a case-by-case basis. It should also be clear from what we have said that we adhere to our holdings in *In re Weber, supra*, and *In re Haas (Haas II) supra*. 206 USPQ 300, 305 (CCPA 1980)

In summary, the statute does not provide for, nor have the Courts ever condoned, an “improper Markush group”-type rejection (*Weber*). Moreover, the Court has found that refusal to examine a claim is tantamount to rejection (*Haas I*).

Consequently, NAPP believes that any attempt by the Office to limit applicants’ ability to claim their invention, as set out in the proposed new rules, would deny applicants their statutory rights and would fly in the face of controlling case law.

COMMENTS RELATED TO SPECIFIC PROPOSED RULES

Proposed revisions to Section 1.75

Proposed Section 1.75(j)(1) would require that, for claims reading on multiple species using alternative language, “[t]he number and presentation of alternatives in the claim [must] not make the claim difficult to construe[.]” However, no criteria for how to determine ease or difficulty of claim construction are provided. This would seem to be, at best, a highly subjective standard, rife with possibilities for misinterpretation and

misuse, and subject to inconsistent application by the Office, as is current restriction practice.

Proposed new Sections 1.75(j)(2) and 1.75(j)(3) would require that no alternative is defined as a set of further alternatives, and that no alternative is encompassed by any other alternative within a list of alternatives, respectively. The justification for these proposed rules is that their application would make it easier for an examiner to determine whether a single claim encompasses more than one invention. NAPP does not believe this is sufficient justification; rather, the Office should ensure that examiners are adequately trained to determine when more than one invention exists and that such standards are applied consistently. Arbitrary limits on claim format should not be substituted for adequate training and thorough examination.

New Section 1.140

Proposed new Section 1.140(a) states that one of the conditions for a Markush-type claim to be considered to be limited to a single invention is if all species share a substantial feature essential for a common utility. NAPP notes that, especially in the field of biotechnology, common utility is often not connected to structural similarity. For example, many different proteins, with different amino acid sequences, possess the common function of DNA binding. Thus, enactment of proposed new Section 1.140, requiring both common utility and shared features (which is interpreted to mean shared structure), would be unduly limiting in certain areas of technology.

It is also not clear what the term “substantial feature essential for a common utility” would mean in the context of claims to method inventions. The Notice states that a “feature” might be an “act” of a process claim, but it is not clear that such is an appropriate parallel, in the method context, to common structure in an apparatus or composition claim. Method or process inventions often include claims (sometimes in dependent form) that identify several alternatives for which a process can be used. For example, a process of computer control might be said to apply to control a range of different equipment or parameters. In a process claim, the inventive process may define alternative ways of doing a particular step or act. In these contexts, too, proposed Section 1.140, requiring both common utility and shared features, would be unduly limiting.

NAPP recommends that the PTO alter this rule, if the proposed rule changes are enacted, to change the language (now proposed as “The species share a substantial feature essential for a common utility”) to: “There is substantial commonality among the species with regard to utility or a feature.”

By allowing commonality among species to arise from either a shared utility or a common feature, applicants would be able to claim a wider array of alternatives in a single claim, with a clear commonality made apparent; while at the same time facilitating examination by avoiding a large number of claims reciting different alternatives.

Proposed revisions to Section 1.141

The proposed revisions to Section 1.141(b) “clarify” that a three-way restriction can be made only when the process of making, the product and the process of use are all distinct from each other. It is not clear that it would change current practice, inasmuch as three groups of claims covering independent and distinct subject matter are already properly restrictable. The PTO should explain why the “clarification” is believed needed.

Moreover, the proposed revision, without comment, appears to remove the final sentence of current Section 1.141(b), which states:

If the process of making and the product are not distinct,
the process of using may be joined with the claims directed
to the product and the process of making the product even
though a showing of distinctness between the product and
process of using the product can be made.

Whether or not the PTO “clarifies” the first sentence of Section 1.141(b), NAPP recommends retaining the above-quoted second sentence of current Section 1.141(b), as the Office has presented no reason why it should be changed and no reason is apparent.

Proposed revisions to Section 1.142

As an initial matter, NAPP notes that the proposed revisions to this section conflict with the revisions to Section 1.142 recently published (72 Fed. Reg. 46716, 46842, August 21, 2007) and scheduled to be enacted on November 1, 2007 (hereinafter “Claims/Continuation Rules”). The conflict begins with the fact that the titles of Section

1.142 are different in the Claims/Continuation Rules and in the present proposed revisions.

The present proposed revisions to Section 1.142(a) include a reference to applications filed under 35 U.S.C. 111(a); such reference is not present in Section 1.142(a) of the Claims/Continuation Rules.

With respect to Section 1.142(b), the Claims/Continuations Rules retain the previous paragraph (b) which refers to withdrawal of non-elected claims from consideration. However, paragraph (b) of the present proposed revisions states that the propriety of a restriction requirement shall be determined without regard to whether the plural inventions are recited in separate claims or as alternatives within a single claim.

The Claims/Continuation Rules add new Section 1.142 (c), related to applicant's provision of a suggested requirement for restriction. In contrast, the present proposed revisions to Section 1.142 include new paragraph (c), containing the subject matter of current paragraph (b) relating to withdrawal of non-elected claims from consideration and reinstatement of withdrawn claims.

Finally, proposed new paragraph (d) relates to objection to claims that recite both an elected and a non-elected invention.

Without knowing the actual text of Section 1.142, it is difficult to provide comments. The PTO should clarify whether the present proposed revisions to Section 1.142 are intended to supplant the text of Section 1.142 as recently presented in the Claims/Continuation Rules. Alternatively, the conflicting versions should be reconciled and a new version of Section 1.142 should be published with opportunity for comment.

Proposed revisions to Section 1.143

NAPP has no comments on the proposed revisions to Section 1.143.

Proposed revisions to section 1.144

NAPP notes that proposed new Section 1.144(b) does not recite a deadline for filing a petition for review of a second restriction requirement in an application and recommends that such a deadline be explicitly provided in that section.

Proposed new Section 1.144 (c) states that the filing of a petition to withdraw a restriction requirement does not obviate applicant's obligation to timely reply to the remainder of the action. NAPP believes that a rule requiring a timely Decision on Petition is also required, *inter alia* to avoid a situation in which a decision reversing all or part of a restriction requirement is mailed after applicant has filed the response required by proposed new Section 1.144(c) on a restricted claim set. Such a requirement for timely provision of a Decision on Petition would save examiner time that might otherwise have been spent preparing an action on an incomplete claim set, and would avoid applicant's being forced to constructively accept a restriction requirement due to a delayed decision on a petition for withdrawal of the restriction.

Proposed revisions to Section 1.145

As with proposed new Section 1.142 (above), the proposed revisions to this section differ from those recited in the new Claims/Continuation Rules, most notably in that Section 1.145 as revised in the Claims/Continuation Rules does not make reference to reconsideration and review under 37 C.F.R. §1.181, as does the instant proposal.

Further, the PTO rule should address the converse of the situation stated. In instances in which an amendment does not substantially alter the claims such as to require a new restriction, the examiner ought to be barred from entering a restriction requirement. NAPP members have reported a number of cases in which an examiner has examined a claim set, in some occasions through multiple office actions and responses, and in one case even past final rejection, and thereafter issued restriction requirements, even when the amendments did not necessitate such restriction. Such is expensive for applicant and wasteful of PTO resources.

Inasmuch as one of the principal reasons put forth by the Office to support its restriction practice is search burden, NAPP sees no reason that would justify restriction among a set of claims that has already been examined. Accordingly NAPP recommends that the Office institute a rule specifying that, once a set of claims has been examined, restriction among that claim set is prohibited.

Proposed revisions to Section 1.146

Proposed new Section 1.146(a) lacks the provision, found in current Section 1.146, that a species election requirement be made on the first action in an application containing a generic claim. In the interests of efficiency, economy, and compact prosecution, NAPP believes said provision should be retained in any new rules that are promulgated, and that requirement for species election be prohibited after a first Office action.

Proposed new section 1.146(b) states that an examiner may require applicant to restrict any claim that was subject to a species election requirement (as set forth in proposed new Section 1.146(a)) to species that were searched and examined, if any species encompassed by the claim is not patentable. This implies that patentable species not searched and examined would need to be covered in one or more continuing applications, given the general inability to amend claims or introduce new claims after a final Office action. In light of the recently-enacted restrictions on the filing of continuing applications, NAPP recommends that the filing of one or more claims to species not examined in a prior application should either (1) constitute a showing sufficient to support a petition for the filing of a third or subsequent continuing application, or (2) be considered a divisional application, entitled to a set of three additional continuing applications as of right.

Proposed revisions to Section 1.499

Proposed new Section 1.499 attempts to apply the proposed limitations on claiming in applications filed under 35 U.S.C. § 111(a) to national phase applications. To the extent that NAPP objects to the changes as applied to 35 U.S.C § 111(a) filings, it objects to similar changes in national phase applications. NAPP also notes that national phase applications are already governed by the PCT's unity standards and questions the PTO's authority to alter those standards unilaterally.

FURTHER SUGGESTIONS

In addition to soliciting comments on the proposed rules, the Office stated that it would welcome further suggestions for changes that would improve the examination of

claims using alternative language that appropriately balance the interests of the Office with those of applicants and the public. In this context, NAPP understand the interests of the Office to be enhancing patent quality and reducing pendency.⁵ NAPP believes that Applicant interests would best be served by facilitating the ability of an applicant to obtain adequate protection for the full scope of an invention, and that such would also benefit the public.

In the experience of NAPP and its members, most claims are not exclusively made up of alternatives. Composition claims generally include some core structure, to which additional, alternative structures may be attached or combined. Similarly, most method claims contain at least one step or act that is essential to all embodiments of the method. These core structures or essential steps are often recited in an independent claim, with alternatives then recited in claims depending therefrom.

With these considerations in mind, NAPP suggests that the PTO consider encouraging examiners to begin their search and examination by identifying the core structure or common step(s) of a claimed invention. In this way, initial examination could be focused upon the aspects of the claimed subject matter that are common to all species, rather than artificially compartmentalizing examination at the outset.

Similarly, NAPP encourages the PTO to promote (instead of discouraging through claim-counting techniques and associated fees) the use of multiple dependent claims, as allowed in many foreign patent offices. Such claims clearly identify the added features, and allow examination of claimed combinations more easily than when alternatives are placed in Markush groups or are claimed using generic language.

NAPP recommends a return to the practice of considering the claimed subject matter as a whole, expanding on a recommendation in a previous version of the MPEP (and quoted with approval in *In re Ruff*, 118 USPQ 340, 348 (CCPA1958):

Where a Markush expression is applied only to a portion of a chemical compound, the propriety of the grouping is determined by 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.
Former MPEP 706.03(y), 1953 revision

⁵ 72 *Fed. Reg.* 44992, second column

Not only for claims to chemical compounds, but also for all types of claimed subject matter, more efficient examination will result from consideration of the claimed subject matter as a whole. The time spent by examiners in trying to divide up claimed subject matter into ever-more specialized units of examination would more profitably be spent in identifying, then examining, the common features that define the invention as a whole.

Finally, NAPP recommends that any further rule changes be delayed and reconsidered until after the PTO undertakes its study⁶ of the recent GAO Report entitled “Hiring Efforts Are Not Sufficient to Reduce the Patent Application Backlog.”⁷ Part of the PTO’s study should include a realistic adjustment of production goals based upon the scope of the claims presented for examination. The current one-size-fits-all model for examination needs to change in favor of a more flexible system in which examiners are allotted time based upon the details of each case. Part of the historic problem with Markush claims is that examiners’ productivity requirement never took such cases into account. Instead of artificially narrowing a broad claim (and an applicant’s coverage) to fit an examiner’s time allotment, the PTO should develop production goals that permit an examiner to devote the resources needed, on a reasonable basis, to each case depending on the claims presented.

CONCLUSION

In conclusion, NAPP supports the efforts of the Office to increase efficiency, enhance quality, and reduce pendency; but cautions that achievement of these goals must not come exclusively at the cost of denying applicants the opportunity to claim that which they believe to be their invention and thereby preventing them from obtaining patent protection for the full scope of their invention.

⁶ See <http://www.uspto.gov/web/offices/com/speeches/07-42.htm>

⁷ GAO 07-1102, September 2007