

From: Sam Rimell [srimell@yahoo.com]
Sent: Tuesday, February 14, 2006 9:32 PM
To: AB94Comments
Subject: Treatment of Markush claims under new rules

The US Patent and Trademark Office has requested comments on the treatment of Markush claims within the context of the proposed rule changes to 37 CFR Part 1 (as published in the Federal Register on January 3, 2006 and the Request for Comments on page 64).

It is my opinion that a Markush style claim should be treated as a single claim under the new rules, for two reasons:

(1) In patent examination, Markush style claims are examined as if they are limited to one of the recited alternatives. Accordingly, it would not be reasonable to assume that such claims require all the recited alternatives, and thus each grouping treated as a "seperate claim". Individual Markush groupings have never been treated as separate claims, and so there is no logic to assuming that they carry the examination burden of seperate claims. They simply do not carry such a burden.

(2) The proposed test for determining the presence of "seperate claims" in a Markush grouping (described on page 64, third column of the rule discussion) is unusually ambiguous, and would be difficult to apply. The test of having examiners determine the presence of a "common core structure" in Markush groupings is vague and would not likely produce consistent decision making. It would simply delay prosecution while the applicant and examiner get bogged down trying to sort out the issue in each Markush claim. It is much more likely to slow down prosecution, rather than achieve the desired aim of speeding it up.

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