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Patent and Trademark Office/Rules

IDS and Markush Claim Proposals Will Not Go Final

The PTO's proposed rules on information disclosure statements and on applications containing Markush or alternative claim language will not be published as final rules by the current Administration.

The announcement was made October 24, 2008 at the AIPLA Annual Meeting in Washington, D.C. by PTO Deputy Commissioner for Patent Operations Margaret Focarino in an appearance before the AIPLA Committee on Patent-Relations with the USPTO. She made reference to May 9, 2008 Office of Management and Budget [memorandum](#) to all federal agencies on processing rules as the Administration winds down. The OMB memo stated that "regulations to be finalized in this Administration should be proposed no later than June 1, 2008, and final regulations should be issued no later than November 1, 2008."

IDS Proposal

The amendments to the information disclosure statement (IDS) rules were proposed on July 10, 2006 ([71 Fed. Reg. 38808](#)), to substantially revise 37 C.F.R. §§1.97 and 1.98. The rules would have put severe limits on the timing of filing of IDS and required "additional disclosure" for: (1) English language documents over 25 pages; (2) any foreign language document; and (3) submissions of more than 20 documents. Those additional disclosures would have to (1) identify the feature, showings or teachings that caused a document to be cited; (2) include a representative portion of the document where those features, showings or teachings may be found; and (3) correlate the features, showings or teachings to related claim or specification language.

Markush and Alternative Claim Language Proposal

The amendments on alternative claim language were proposed on August 10, 2007 ([72 Fed. Reg. 44992](#)), to require that such language, used in drafting claims that read on multiple species, maintain a certain degree of relatedness among the alternatives. The proposed revisions are designed to strictly enforce the requirement that each claim must be limited to a single invention and would have increased the examiners' right to make restriction requirements within a single claim where such claims lack unity of invention.

According to the PTO notice, "[a]pplicants should not be permitted to circumvent the [proposed rules (71 FR 61 (Jan. 3, 2006)) that limit the number of claims that may be asserted] by presenting a single claim that sets forth multiple independent and distinct inventions in the alternative." In general, a claim presenting alternatives would be considered as limited to a single invention where all the species encompassed by the claim: (i) share a substantial feature essential for a common utility, or (ii) are prima facie obvious over each other.