

Many patent practitioners will be familiar with use of Markush-type claim limitations, particularly in the chemical arts, although Markush-type claim limitations are sometimes used in other fields as well. Although Markush-type claims have often been used as a simple and easy way to capture various alternatives for a given element in a single claim, care should be taken to ensure that the meaning intended by the practitioner and applicant is actually embodied in the particular claim language selected. A recent Federal Circuit case, *Multilayer Stretch Cling Film Holdings, Inc., v. Berry Plastics Corporation*, highlights the importance of this.

“A Markush claim is a particular kind of patent claim that lists alternative species or elements that can be selected as part of the claimed invention. ‘Markush’ was the name of an applicant for patent (Eugene A. Markush) who happened to use in a claim a type of definition of a genus or subgenus by enumeration of species” The name ‘Markush’ became attached to a type of claim expression, and that is all it connotes. Markush claims create a customized “Markush group”—a listed group of species that are useful for the purposes of the claim A Markush group lists specified alternatives in a patent claim, typically in the form: a member selected from the group consisting of A, B, and C. It is generally understood that . . . the members of the Markush group . . . are alternatively usable for the purposes of the invention.^[1]

While variations in phrasing are sometimes encountered, the key language in a Markush-type claim is typically rendered as “wherein ____ is selected from the group consisting of A, B, and C” or “wherein ____ is selected from the group consisting of A, B, C, and combinations thereof.”

In *Multilayer Stretch Cling Film Holdings*, the patent claim in question recited:

A multi-layer, thermoplastic stretch wrap film containing seven polymeric layers, comprising:

(a) two outer layers, at least one of which having a cling performance of at least 100 grams/inch, said outer layer being selected from the group consisting of linear low density

polyethylene, very low density polyethylene, and ultra low density polyethylene resins, said resins being homopolymers, copolymers, or terpolymers, of ethylene and alpha-olefins; and

(b) five inner layers, with each layer being selected from the group consisting of linear low density polyethylene, very low density polyethylene, ultra low density polyethylene, and metallocene-catalyzed linear low density polyethylene resins; said resins are homopolymers, copolymers, or terpolymers, of ethylene and C₃ to C₂₀ alpha-olefins.[2]

While there are Markush-type claim recitations in both elements (a) and (b) of claim 1, one of the key issues in *Multilayer Stretch Cling Film Holdings* was whether a Markush-type claim recitation as in element (b) is “open” or “closed”. In other words, one question considered by the court was whether Markush-type language such as “wherein ____ is selected from the group consisting of A, B, and C” allows for combinations of A, B, and/or C in a given film layer too.[3] Another question was whether such language allows for other components to be included in the film layer (e.g., would the claim cover an embodiment where the film includes material A, but also includes another material, say material D).

Such a question arises because of the use of the phrase “selected from the group consisting of” in the Markush-type claim, where “consisting of” is consistently regarded in patent terminology as triggering a “closed” type claim that excludes the presence of other elements or materials with respect to the structure it refers to.[4]

The outcome in *Multilayer Stretch Cling Film Holdings* was that the use of the closed “consisting of” phrasing in the Markush-type claim resulted in (1) the claim at least being presumed to not cover embodiments where a film layer included a combination of A, B, and C[5] and (2) the claim was construed to not cover embodiments where the film includes A (or B, or C), but also includes another material (e.g., D).[6]

Practitioners sometimes draft Markush-type claims to list alternatives, without necessarily thinking about the implication of using the traditional “selected from the group consisting of A, B, and C”, or “selected from the group consisting of A, B, C, and combinations thereof”

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by Matthew Todd

Markush phrasing. Often, it is not necessary to adopt a “closed” claim format in order to differentiate over any applicable prior art. Rather, often, alternative phrasing such as “wherein ____ comprises at least one of A, B, or C” is equally capable of differentiating over any applied art, while preserving a broader, open-ended construction of the claim.

Given the decision in *Multilayer Stretch Cling Film Holdings*, it can be beneficial to carefully consider use of the traditional “selected from the group consisting of A, B, and C” or “selected from the group consisting of A, B, C, and combinations thereof” Markush-type language, and in particular to consider using an alternative format that does not use the phrase “selected from the group consisting of” or “consisting of” where it is not intended to “close” the scope of the claim.

[1] 831 F. 3d 1350, 1357 (Fed. Cir. 2016).

[2] U.S. Patent No. 6,265,055, claim 1.

[3] *Multilayer Stretch Cling Film Holdings, Inc.*, 831 F. 3d at 1362–63.

[4] *Id.* at 1358.

[5] *Id.* at 1363.

[6] *Id.* at 1360–61.