

I wrote about this same general subject nearly 2 years ago[\[1\]](#), but believe it is worth repeating, as I still routinely see what I think is an overuse of the classic “Markush” type claim structure, where the Applicant does not really intend that the claim including the Markush type claim language be “closed”.

As I wrote previously, a 2016 Federal Circuit case, *Multilayer Stretch Cling Film Holdings, Inc., v. Berry Plastics Corporation*, highlights the fact that classic Markush type claim structure is going to be presumed to be a “closed” claim, with respect to what is recited in the Markush listing.

“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.[\[2\]](#)

While variations in phrasing are sometimes encountered, the key language in a classic 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.”

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. The classic Markush format using the phrasing “consisting of” should only be used where the applicant really intends the listed grouping to be “closed”

rather than “open”. This is also illustrated in a 2017 Federal Circuit case, *Shire Development v. Watson Pharma* (Fed. Cir. 2017) [3]. In that case, at issue was a drug used to treat ulcers. The claim included the following limitation:

“said outer hydrophilic matrix ***consists of*** compounds selected from the group ***consisting of*** polymers or copolymers of acrylic or methacrylic acid, alkylvinyl polymers, hydroxyalkyl celluloses, carboxyalkyl celluloses, polysaccharides, dextrans, pectins, starches and derivatives, alginic acid, and natural or synthetic gums” [3], emphasis added

During litigation, the patentee tried to argue that the claim was not closed, but allowed other materials to be included in the claimed outer hydrophilic matrix. The patentee lost such arguments.

The outcome in both the *Multilayer Stretch Cling Film Holdings* case and the *Shire Development* case was that the use of the closed “consisting of” phrasing in the Markush-type claim results in at least a strong presumption that the listed grouping is closed.

I have found that practitioners often use the classic Markush type claim structure where they simply wish to list various alternatives, without necessarily thinking about whether they really intend to adopt a “closed” claim format with respect to the listing of alternatives. Very often in my experience, a practitioner would be better off trying to use different phrasing, such as “wherein ____ comprises at least one of A, B, or C”, which preserves a broader, open-ended construction for this portion of the claim.

In some cases, an Examiner may object to the practitioner’s use of language that does not match the classic Markush type structure, e.g., perhaps citing MPEP 2173.05(h), which sanctions the use of classic Markush type claim structure, but also states “It is improper to use the term “comprising” instead of “consisting of””, citing to *Ex parte Dotter*, 12 USPQ 382 (Bd. App. 1931). However, as noted in Dennis Crouch’s “Patentlyo” blog [4], this obscure reference in the MPEP may not actually be from the Dotter case, but from *In re Harnish*, 631 F.2d 716, 723 (C.C.P.A. 1980). Crouch notes that in *In re Harnish*, the court did not actually

provide any reasoning for such an objection to use of the transition phrase “comprising” rather than “consisting of”, and the claim in that case does not seem to have actually used “comprising” at all, but admittedly was an open-ended, very complex, chemical claim. [5] In analyzing the propriety of the claim in *Harnish*, the court states “As stated above, we decide this and like cases on their facts on a case-by-case basis”[6]. The court further stated “we are aware of an applicant’s right to define what he regards as his invention as he chooses, so long as his definition is distinct, as required by . . . § 112” [7]. There is evidence that the objection in *Harnish* may have had more to do with the scope, enablement, unity of invention, and clarity issues, than anything else, which is particularly so given the complex chemical nature of the claim at issue in *Harnish*[4]-[6]

In the end, 2173.05(h) states that “Alternative expressions are permitted if they present no uncertainty or ambiguity with respect to the question of scope or clarity of the claims”, and that classic Markush format is simply one acceptable form of such alternative expression.

Where the claim is sufficiently clear to meet the standards of section 112, I believe it can be perfectly appropriate to use a structure such as “wherein ____ comprises at least one of A, B, or C”, in many situations. Such language is certainly worth presenting in prosecution where the applicant wishes to preserve an “open” scope to the claim.

[1] <https://www.wnlaw.com/blog/rethinking-use-markush-type-claiming-structure/>

[2] *Multilayer Stretch Cling Film Holdings, Inc. v. Berry Plastics Corporation*, 831 F. 3d 1350, 1357 (Fed. Cir. 2016).

[3] *Shire Development, LLC, v. Watson Pharmaceuticals*, 848 F. 3d 981 (Fed. Cir. 2017).

[4] <https://patentlyo.com/patent/2017/02/consisting-provides-infringement.html>

[5] *In re Harnish*, 631 F.2d 716, 717 (C.C.P.A. 1980)

THINKING ABOUT MARKUSH-TYPE CLAIM STRUCTURE – AGAIN
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[6] *In re Harnish*, 631 F.2d 716, 722 (C.C.P.A. 1980)

[7] *In re Harnish*, 631 F.2d 716, 721 (C.C.P.A. 1980)