

Markush Groups and Other Alternative Claim Language

MPEP 2117

Definition

- ▶ **I. MARKUSH CLAIM** A "Markush" claim recites a list of alternatively useable members. In re Harnisch, 631 F.2d 716, 719-20 (CCPA 1980); Ex parte Markush, 1925 Dec. Comm'r Pat. 126, 127 (1924). The listing of specified alternatives within a Markush claim is referred to as a Markush group or Markush grouping. Abbott Labs v. Baxter Pharmaceutical Products, Inc., 334 F.3d 1274, 1280-81, 67 USPQ2d 1191, 1196-97 (Fed. Cir. 2003) (citing to several sources that describe Markush groups). Claim language defined by a Markush grouping requires selection from a closed group "consisting of" the alternative members. Id. at 1280, 67 USPQ2d at 1196. See [MPEP § 2111.03](#), subsection II, for a discussion of the term "consisting of" in the context of Markush groupings.
- ▶ A Markush grouping is proper if the members of a group share a single structural similarity and a common use.

Example

- ▶ An alloy comprising:
 - at least 75% iron;
 - at least 15% chromium; and
 - at least 5% of a material from the group consisting of copper, tungsten, and tin or a combination thereof.

Improper Markush Grouping

- ▶ A Markush claim contains an "improper Markush grouping" if either: (1) the members of the Markush group do not share a "single structural similarity" or (2) the members do not share a common use.

Other Alternative Language

- ▶ **MPEP 2173**
- ▶ **II. "OPTIONALLY"** Another alternative format which requires some analysis before concluding whether or not the language is indefinite involves the use of the term "optionally." In *Ex parte Cordova*, 10 USPQ2d 1949 (Bd. Pat. App. & Inter. 1989) the language "containing A, B, and optionally C" was considered acceptable alternative language because there was no ambiguity as to which alternatives are covered by the claim. A similar holding was reached with regard to the term "optionally" in *Ex parte Wu*, 10 USPQ2d 2031 (Bd. Pat. App. & Inter. 1989). In the instance where the list of potential alternatives can vary and ambiguity arises, then it is proper to make a rejection under **35 U.S.C. 112(b)** and explain why there is confusion.

“Optionally” Example

- ▶ An alloy consisting of:
 - iron;
 - chromium; and
 - optionally tin.

“Or”

- ▶ *Brown v. 3M*, 265 F.3d 1349 (Fed. Cir. 2001)
- ▶ “Or” may be used
- ▶ “at least one database file stored in the memory containing records with year-date data with years being represented by at least one of two-digit, three-digit, or four-digit year-date data representations”
- ▶ A, B, or C means: A, or B, or C, or any combination of A, B, and C

Additional Reading

- ▶ “Conjunctions and/or Patent Claims”

<https://www.ipwatchdog.com/2013/10/17/conjunctions-andor-patent-claims/id=45733/>