



April 11, 2011

The Honorable David Kappos
Under Secretary of Commerce for Intellectual Property
and Director of the United States Patent and Trademark Office
Mail Stop Comments
P.O. Box 1450
Alexandria, VA 22313-1450

Via Email—SEGuidelines112@uspto.gov

Re: Supplementary Examination Guidelines for Determining Compliance With 35 U.S.C. 112 and for Treatment of Related Issues in Patent Applications, 76 Fed. Reg. 7162 (Feb. 9, 2011)

Dear Director Kappos:

Intellectual Property Owners Association (IPO) submits the following comments on the "Supplementary Examination Guidelines for Determining Compliance With 35 U.S.C. 112 and for Treatment of Related Issues in Patent Applications" published in the Federal Register on February 9, 2011 (Supplementary Guidelines). We thank you for the opportunity to provide these comments.

IPO is a trade association representing companies and individuals in all industries and fields of technology who own or are interested in intellectual property rights. IPO's membership includes more than 200 companies and over 11,000 individuals who are involved in the association either through their companies or as an inventor, author, executive, law firm or attorney members.

IPO thanks the U.S. Patent and Trademark Office (USPTO) for providing the public an opportunity to comment on the 35 U.S.C. § 112, Compliance Supplementary Examination Guidelines (Guidelines). The Guidelines provide useful guidance to patent practitioners as well as patent examiners in regard to compliance with these statutory provisions. These Guidelines have many positive aspects, for example, encouraging compact prosecution and reminding examiners that interviews with applicants can be a benefit to resolving 35 USC 112 issues. However, there are aspects of the Supplementary Guidelines that could be improved with clarification. Accordingly, we are asking USPTO to consider the following comments.

Sincerely,

Douglas K. Norman (handwritten signature)

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Executive Director
Herbert C. Wamsley

## Comments

### 1. Claim Construction

Section II of the Supplementary Guidelines discusses claim interpretation within the USPTO. As we understand it, the USPTO

[A]ppplies to the verbiage of the proposed claims the *broadest reasonable* meaning of the words in their *ordinary usage* as they would be *understood by one of ordinary skill in the art*, taking into account whatever *enlightenment by way of definitions or otherwise that may be afforded by the written description* contained in the applicant's specification.

*In re Morris*, 127 F.3d 1048, 1054 (Fed. Cir. 1997) (emphasis added). In other words, the “broadest reasonable” standard is tempered by:

- Giving the words of the claims their “ordinary usage,”
- Taking into account how those words are understood by one of ordinary skill in the art, and
- Taking into account enlightenment afforded by the specification by way of:
  - Definitions, or,
  - “Otherwise.”

It is the experience of IPO that many examiners, in interpreting pending patent claims, stop their analysis after the phrase “broadest reasonable” and do not properly take into account the remaining three distinct requirements set forth in *Morris*. The unreasonable claim construction proffered by many examiners increases pendency, prevents reduction in the backlog of cases pending examination, and increases prosecution costs, both for the USPTO and applicants.

IPO is concerned that this misunderstanding of the proper principles of construction of claims pending before the agency is fostered in statements in the Guidelines such as:

If the language of a claim, given its broadest reasonable interpretation, is such that a person of ordinary skill in the relevant art would read it with more than one reasonable interpretation, then a rejection under § 112, ¶ 2 is appropriate.

76 Fed. Reg. at 7164, second column, citing 2008 memorandum entitled, “*Indefiniteness rejections under 35 U.S.C. 112, paragraph*,” available at [http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/section\\_112\\_2nd\\_09\\_02\\_2008.pdf](http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/section_112_2nd_09_02_2008.pdf) (2008 Memo). The 2008 memo in turn cites MPEP 2173.05(a), 2143.03 subsection 1 and 2173.06 in support of that proposition.

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Review of the cited MPEP sections does not show direct support for the stated proposition. In relevant part, MPEP 2143.03 states:

A claim limitation which is considered indefinite cannot be disregarded. If a claim is subject to more than one interpretation, at least one of which would render the claim unpatentable over the prior art, the examiner should reject the claim as indefinite under 35 U.S.C. 112, second paragraph (see MPEP § 706.03(d)) and should reject the claim over the prior art based on the interpretation of the claim that renders the prior art applicable. *Ex parte Ionescu*, 222 USPQ 537 (Bd. Pat. App. & Inter. 1984) (claims on appeal rejected on indefiniteness grounds only; rejection reversed and case remanded to the examiner for consideration of pertinent prior art).

MPEP 706.03(d) sets forth form paragraphs for patent examiners to use in rejecting claims under 35 U.S.C. § 112, second paragraph, none of which provide support for the questioned proposition.

Many claim terms can be reasonably construed in at least two different ways. The court observed in *In re Gardner*, 427 F.2d 786, 788 (CCPA 1970):

We do not find any indefiniteness in any of the claims by reason of their failure to name a host. They are merely broad in this respect and cover the composition and the method when administered or applied to any host capable of enjoying the benefits of an antidepressant drug. Breadth is not indefiniteness.

The word “host” as used in the claims under review in *Gardner* was subject to more than one reasonable interpretation, yet the court reversed the indefiniteness rejection.

IPO is concerned that this proposition will result in many improper rejections under 35 U.S.C. 112, second paragraph, as it provides a *per se* rule of indefiniteness. IPO recommends that the Guidelines be amended to remove this section and any other section that creates a *per se* rule. The remainder of the Supplementary Guidelines provides a helpful analysis of indefiniteness issues in a variety of contexts.

It would be helpful to patent examiners, practitioners and the public if the USPTO emphasizes that using language to describe technology, especially cutting edge technology which does not have a well defined vocabulary, is inherently fraught with interpretation issues. The USPTO should further emphasize that the requirements of Section 112, second paragraph, must be applied, not with *per se* rules, but with a rule of reason that takes into account the inherent vagaries of describing technology in the English language.

IPO finds it helpful that the Guidelines remind patent examiners that claims must be read in light of the specification. However, an argument that references the specification in regard to construing a patent claim is usually met with a form paragraph response informing applicant that specification limitations will not be read into the claims. IPO recommends that

the USPTO provide training materials to patent examiners that set forth examples of how one appropriately reads a patent claim in light of the specification. Such guidance will not only help patent examiners but also provide a valuable resource to practitioners as to how to craft a specification and patent claims and present arguments in a response to an office action.

## **2. Interpreting Claim Limitations Under § 112, ¶6**

The Guidelines propose changing the manner in which the USPTO analyzes means or step plus function claims by way of setting forth a new presumption that, if a claim limitation uses a “non-structural” term that does not have a structural modifier, the claim is to be construed under Section 112, paragraph six. 76 Fed. Reg. 7167. IPO respectfully asks the USPTO to clarify the basis in law for this interpretation. The USPTO is also asked to confirm that terms such as “program instructions for” and “program instructions to” will *not* invoke 35 USC 112, paragraph six. For reference in this regard, *see: e.g., Affymetrix, Inc. v. Hyseq, Inc.*, 132 F. Supp. 2d 1212, 1232 (N.D. Cal. 2002) (“The Court finds that ‘computer code’ is not a generic term, but rather recites structure that is understood by those of skill in the art to be a type of device for accomplishing the stated functions.”); *Trading Technologies Intern., Inc. v. eSpeed, Inc.*, 2006 U.S. Dist. LEXIS 80153, 2006 WL 3147697, \*11-13 (N.D. Ill. 2006) (finding “program code” to not be a generic term and to have sufficient structure); *Aloft Media, LLC v. Adobe Systems Inc.*, 570 F. Supp. 2d 887, 894-96 (E.D. Tex. 2008) (finding that the “computer code” elements referenced by the “wherein” clauses showing operation of the code recite sufficiently definite structure to avoid § 112).

In addition, we ask the USPTO to consider providing more detail as to how examiners will specify what the specification identifies as the corresponding structure when the examiner determines that 35 U.S.C. § 112, paragraph six, applies (see Part 1, subpart IV, Step 3(B), of the guidelines). Absent additional details or development of a standard approach, identifying the corresponding structure may be seen by patent examiners to be a burden that will not be performed or, if performed, will be performed in a variety of different, inconsistent ways.

## **3. Computer Implemented Functional Claim Limitations**

In discussing this topic, the Guidelines observe that if the “prior art discloses a device that inherently perform the claimed function, rejection under § 102 or § 103 may be appropriate, citing, *inter alia, In re Swinehart*, 439 F.2d 210, 212–213 (CCPA 1971) (“[I]t is elementary that the mere recitation of a newly discovered function or property, inherently possessed by things in the prior art, does not cause a claim drawn to those things to distinguish over the prior art. Additionally, where the USPTO has reason to believe that a functional limitation asserted to be critical for establishing novelty in the claimed subject matter may, in fact, be an inherent characteristic of the prior art, it possesses the authority to require the applicant to prove that the subject matter shown to be in the prior art does not possess the characteristic relied on.”). 76 Fed. Reg. 7174-7175.

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The Guidelines do not adequately instruct patent examiners on how this legal principle should be applied to computer implemented inventions. In a computer implemented invention it is the recited instructions that most often distinguish the claims under review from the prior art. IPO is concerned that patent examiners could reject computer implemented claims on the basis of a reference that describes a “computer” but nowhere teaches or suggests the instructions set forth in the claim, stating the “computer” of the reference “inherently” operates, or is capable of operating, in the same manner.

IPO suggests that the USPTO expand its analysis of this section of the Guidelines. It would be helpful to patent examiners and practitioners if the USPTO would develop training materials or examples of fact situations involving claims having computer implemented steps. IPO believes that this is a particular area where such additional guidance will result in reduced pendency and, thus, reduce the backlog of applications awaiting examination.

It would be helpful for the USPTO to prepare examination guidelines concerning functional language, as it is the experience of IPO that many patent examiners are unwilling to give functional language any weight. This issue crosses all technical areas. Development of instructions and examples that guide the patent examiners on how to interpret functional claim language could advance the goals of compact prosecution.