

**From:** Matt Rainey [redacted]

**Sent:** Monday, April 11, 2011 5:50 PM

**To:** SEGuidelines112

**Subject:** Intellectual Ventures-Comments on Notice of Supplementary Guidelines for Determining Compliance With 35 U.S.C. 112, 76 Fed. Reg. No. 27 (pp 7162-75) (February 9, 2011)

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

Attn: Caroline D. Dennison, Legal Advisors, Office of Patent Legal Administration,  
Office of the Associate Commissioner for Patent Examination Policy,

Dear Under Secretary Kappos,

The attached Comments by Intellectual Ventures, LLC are submitted in response to the Notice of Supplementary Guidelines for Determining Compliance With 35 U.S.C. 112 and for Treatment of Related Issues in Patent Applications published at 76 Fed. Reg. No. 27 (pp. 7162-75) on February 9, 2011.

Very truly yours,

--Matt Rainey

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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

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**In re: Docket No. PTO-P-2010-0088**

**76 Fed. Reg. 7162  
(February 9, 2011)**

***Comments by Intellectual Ventures, LLC on the Supplementary  
Examination Guidelines for Determining Compliance With 35 U.S.C.  
112 and for Treatment of Related Issues in Patent Applications***

**Attention:**

The Honorable David J. Kappos  
Under Secretary of Commerce for Intellectual Property  
and Director of the United States Patent and Trademark Office  
Mail Stop Comments - Commissioner for Patents  
P.O. Box 1450  
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Attn: Caroline D. Dennison

**Submitted by:**

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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re: Docket No. PTO-P-2010-0088 )  
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For: **Supplementary Examination** )  
**Guidelines for Determining Compliance** )  
**With 35 U.S.C. 112 and for Treatment** )  
**of Related Issues in Patent Applications** )  
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**76 Fed. Reg. 7162** )  
**(February 9, 2011)** )

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

By email to: [SEGuidelines112@uspto.gov](mailto:SEGuidelines112@uspto.gov)

Dear Under Secretary Kappos:

In reply to the Notice of Supplementary Guidelines for Determining Compliance With 35 U.S.C. 112 and for Treatment of Related Issues in Patent Applications,<sup>1</sup> Intellectual Ventures, LLC (IV) submits the comments below.

**I. Summary**

The Notice explains that its guidelines regarding compliance with 35 U.S.C. 112 (“§112”) are offered as part of an effort to “enhance patent quality and continually improve patent examination,” specifically by ensuring that patents issue “with clear and definite claim language.”<sup>2</sup> The Notice appears to comprehensively survey recent Federal Circuit decisions on §112 issues,

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<sup>1</sup> 76 Fed. Reg. 7162-75 (February 9, 2011) (the “Notice”)

<sup>2</sup> Notice at 7163.

with the stated goal of updating the Manual of Patent Examination Procedure (the “M.P.E.P.”) to reflect current case law.<sup>3</sup>

We support the Office’s efforts to provide the examining corps with guidance regarding controlling §112 case law.<sup>4</sup> Providing clear and current guidance to examiners ultimately benefits the public by increasing the degree to which issued patents conform to statutory requirements. Such guidance also benefits applicants and the Office by clarifying expectations and decreasing the likelihood of time-consuming miscommunication between applicants and examiners regarding questions of §112 compliance.

However, we note that §112 inquiries are often nuanced and highly fact-dependent. As discussed below, we urge the Office to emphasize to examiners the necessity of providing clear and specific reasons for any §112 rejection, because unlike prior art rejections, these reasons are typically the sole evidentiary basis for the §112 rejection. We also urge the Office to clarify the specific aspects of the Notice discussed below.

Moreover, we note that although the examples and “best practices” given in the Notice may apply to some applications, other applications nevertheless may fully comply with §112 even if they do not fall squarely within the Notice’s guidelines. We urge the Office to emphasize to examiners that the guidelines are interpretive rather than substantive, and that the relevant rules, statutes, and cases are the controlling authorities for examination of any application.<sup>5</sup>

## **II. Comments on 112 Guidelines as presented in the Notice**

As a threshold matter, we note that evaluation of an application for §112 compliance is a fundamentally different type of inquiry than the assessment of novelty or nonobviousness. The latter involves a comparison of claim features to a separate written document to determine whether there is correspondence. Although examiners and applicants may disagree as to how a prior art reference should be interpreted, it is a fairly objective (even if not necessarily simple) matter to determine whether the prior art discloses the claimed features.

By contrast, assessing §112 compliance typically involves an inquiry that is confined to the application itself, where the standard of evaluation involves the judgment of a person of ordinary skill with respect to the application. Because drafting a §112 rejection does not require making comparisons between claims and other documents, there is a greater risk of such rejections being merely conclusory, and thus difficult for applicants to overcome or rebut.

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<sup>3</sup> *Id.*

<sup>4</sup> We note that many of the cases cited in the Notice are not referenced in the current edition of the M.P.E.P., suggesting that the proposed revision is timely.

<sup>5</sup> This position is consistent with the Office’s stated position that the guidelines are interpretive rather than substantive. Notice at 7163.

A. Each §112 rejection should be based upon explicitly stated findings and reasons.

In discussing the specific issue of indefiniteness under §112, the Office does address the issue of providing a “clear record,”<sup>6</sup> stating that “the examiner should clearly communicate . . . any findings and reasons which support the rejection and avoid a mere conclusion that the claim term or phrase is indefinite.”<sup>7</sup> As phrased (“*any* findings...”), may suggest that in some instances, there may be no stated “findings and reasons” in support of the rejection. Because a §112 is grounded solely in the examiner’s reasoning with no requirement for extrinsic evidence, we believe that it should always be the case that specific “findings and reasons” must be articulated to support a §112 rejection, and a “mere conclusion” as to any §112 issue should not be acceptable.<sup>8</sup>

B. The Office should explicitly instruct examiners that, during examination, a claim must be given its broadest reasonable interpretation consistent with the specification.

The Notice makes reference to use of the *broadest reasonable interpretation* to examine a claim to determine if the claim language is definite.<sup>9</sup> The Office correctly notes that “the best source for determining the meaning of a claim is the specification” and that “[w]hen the specification sets a clear path to the claim language, the scope of the claims is more easily determined and the public notice function of the claims is best served.”<sup>10</sup> We are concerned, however, that the Notice suggests the examiner can ignore the specification and substitute the examiner’s own meaning for a claim term, which must then “be rebutted by the applicant by clearly setting forth a different definition of the term in the specification.”<sup>11</sup>

We encourage the Office to emphasize grounding the “broadest reasonable interpretation” inquiry in the objective teaching of the specification, rather than in any subjective meaning attributed to a particular claim term by the examiner.<sup>12</sup> We believe the quality and efficiency of the patent prosecution process will suffer if the examiner is allowed to choose claim term meanings apart from the teaching of the specification. Accordingly, we encourage the Office to remind the examiner that the broadest reasonable interpretation inquiry requires, at the outset, a careful study of the specification.

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<sup>6</sup> *Id.* at 7169.

<sup>7</sup> *Id.* (emphasis added).

<sup>8</sup> Put another way, if no specific reasons can be articulated in support of a §112 rejection, such a rejection is simply improper.

<sup>9</sup> Notice at 7164.

<sup>10</sup> *Id.*

<sup>11</sup> *Id.*

<sup>12</sup> *See, e.g., In re Suitco Surface*, 603 F.3d 1255, 1260 (Fed. Cir. 2010) (“the broadest-construction rubric coupled with the term ‘comprising’ does not give the PTO an unfettered license to interpret claims to embrace anything remotely related to the claimed invention. Rather, claims should always be read in light of the specification and teachings in the underlying patent.”)

C. The Office should explicitly instruct examiners that a specification should not be objected to as lacking claim “support” simply because the specification does not use a glossary or contain verbatim claim language.

The Notice makes reference to 37 C.F.R. 1.75(d)(1), which requires that claim terms find “clear support or antecedent basis in the description so that the meaning of the terms in the claims may be ascertainable by reference to the description.”<sup>13</sup> The Notice acknowledges that “the exact claim terms are not required to be used in the specification,” but nevertheless encourages applicants to “use glossaries as a best practice” and encourages examiners to object to specifications that do not provide the needed support or antecedent basis for claim terms.<sup>14</sup>

Although the Office does acknowledge that neither glossaries nor exact claim terminology is required to satisfy the “clear support” requirement, the Office has expressed a strong preference for the use of glossaries. We are concerned that the emphasis on glossary use may create a perception within the examining corps that a glossary is effectively a requirement, or may encourage examiners to reflexively object to the specification instead of considering the question of support from the perspective of one of ordinary skill.<sup>15</sup>

We encourage the Office to clearly instruct examiners that, despite the Notice’s emphasis on the use of glossaries, the mere absence of a glossary or verbatim correspondence of claim language to the specification should not trigger a conclusion that an application fails to meet the requirements of Rule 1.75(d)(1). Rather, examiners should investigate the substance of such issues. If an objection is warranted, examiners should provide clear reasons as to why support is lacking, rather than mere conclusory statements that identify a discrepancy without also identifying a lack of support.

D. The Office should not propose use of 37 CFR 1.105 to determine the meaning of a claim term.

The Notice suggests using a requirement for information under 37 CFR 1.105 in order to determine the meaning of a claim term.<sup>16</sup> However, we believe that Rule 105 requests are neither intended nor appropriate for this purpose, but rather that Rule 105 requests are meant to assist the Examiner in fact-finding. As such, a proper Rule 105 request seeks factual information, not

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<sup>13</sup> Notice at 7166.

<sup>14</sup> *Id.*

<sup>15</sup> Although 37 C.F.R. 1.75(d)(1) is an administrative rule, it overlaps to some extent with the written description requirement of 35 U.S.C. §112, para. 1. The test for written description support is “whether one of ordinary skill would understand from the specification that the applicant had possession of what is claimed.” *Ariad Pharms., Inc. v. Eli Lilly & Co.*, 498 F.3d 1336, 1351 (Fed. Cir. 2010). If a claim satisfies the statutory written description requirement, then by extension it should satisfy the Office’s support rule.

<sup>16</sup> Notice at 7168 (“requir[ing] identification of the corresponding structure, material, or act”); *id.* at 7169 (“when the examiner determines that more information is necessary to ascertain the meaning of a claim term”).

opinion nor speculation, and not information that requires an applicant to provide a claim interpretation.

Section 1.105 provides in part:

- (a) (1) In the course of examining or treating a matter in a pending or abandoned application filed under 35 U.S.C. 111 or 371 (including a reissue application), in a patent, or in a reexamination proceeding, the examiner or other Office employee may require the submission, from individuals identified under § 1.56(c), or any assignee, of such information as may be reasonably necessary to properly examine or treat the matter, for example:
  - . . . .
  - (3) *Requirements for factual information* known to applicant may be presented in any appropriate manner, for example:
    - (i) A requirement for *factual information*;
    - (ii) Interrogatories in the form of specific questions seeking applicant's *factual knowledge*; or
    - (iii) Stipulations *as to facts* with which the applicant may agree or disagree.<sup>17</sup>

As noted in Section 704.11 of the MPEP:

The terms “factual” and “facts” are included in 37 CFR 1.105 to make it clear that it is *facts and factual information, that are known to applicant*, or readily obtained after reasonable inquiry by applicant, that are sought, and that *requirements under 37 CFR 1.105 are not requesting opinions that may be held or would be required to be formulated by applicant*. Where the factual information requested related to the subject application, and details thereof, applicant would be expected to make a reasonable inquiry under the circumstances to find the factual information requested (37 CFR 10.18(b)(2)). Applicant need not, however, derive or independently discover a fact, such as by experimentation, in response to a requirement for information. *The purpose of 37 CFR 1.105 is to improve patent quality, and render better decisions, and not to put applicants in jeopardy of meeting their duties of candor and good faith in their replies to a requirement for information.*<sup>18</sup>

(Emphasis added in above excerpts.)

We encourage the Office to remove any suggestion that an examiner might appropriately use 37 CFR 1.105 *per se* to determine the meaning of a claim term. The specification is already before the examiner. If the examiner is unable to ascertain the meaning or scope of a claim term by reference to the specification, the examiner can reject the claim and require the applicant to ad-

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<sup>17</sup> 37 CFR § 1.105 (emphasis added).

<sup>18</sup> MPEP § 704.11 (emphasis added)

dress the rejection. We urge that it would not be proper to use Rule 105 in effect as an indefiniteness rejection.

E. The Office should clarify that the *Aristocrat* standard does not apply to every computer-implemented feature, but rather is specific to computer-implemented means-plus-function elements.

The Notice included an extensive discussion of the relationship of indefiniteness under 35 U.S.C. §112, second paragraph to computer-implemented means-plus-function limitations.<sup>19</sup> In particular, the Notice discussed the Federal Circuit’s holding in the *Aristocrat* case that the “corresponding structure” for a computer-implemented means-plus-function limitation is more than simply a general purpose computer, but instead extends to the algorithm that transforms the general purpose computer to perform the recited function.<sup>20</sup> If the specification does not disclose a particular algorithm, the means-plus-function claim may be invalid as indefinite.<sup>21</sup>

The Notice appears to correctly explain the salient aspects of *Aristocrat*. However, we feel that it is important to clearly instruct examiners that *Aristocrat* only applies to computer-implemented claims that are *also* means-plus-function claims. That is, the Office should clearly instruct examiners that a separate, threshold inquiry is necessary to determine whether a computer-implemented feature is a means-plus-function element before *Aristocrat* is considered. We are concerned that without clear instruction on this point, examiners might conclude that a computer-implemented invention is subject to the *Aristocrat* analysis even though it does not invoke means-plus-function interpretation.

F. In presenting examination guidance on computer-implemented functional limitations, the Office should explicitly reference the limitations of the doctrine of inherency, and should clarify that the guidance is limited to apparatus claims.

Although primarily concerned with matters relating to §112, the Notice also briefly addresses the relationship of computer-implemented functional claim limitations to the question of patentability over the prior art.<sup>22</sup> Specifically, the Notice explains that “[f]unctional language that is not limited to a specific structure covers all devices that are capable of performing the recited function,” and that if a prior art device “can inherently perform the claimed function,” a prior art rejection may be appropriate.<sup>23</sup>

The discussion of functional limitations in the Notice may be misinterpreted as having broader application than it merits, because it only obliquely refers to sections of the M.P.E.P that

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<sup>19</sup> Notice at 7168.

<sup>20</sup> *Id.* (citing *Aristocrat Techs. Australia Pty Ltd. v. Int’l Game Tech.*, 521 F.3d 1328, 1333 (Fed. Cir. 2008)).

<sup>21</sup> *Id.*

<sup>22</sup> *Id.* at 7172.

<sup>23</sup> *Id.* (emphasis added).



constrain its application. For example, M.P.E.P. §2112 explains that the bar for establishing inherency is high: it “may not be established by probabilities or possibilities” or “the mere fact that a certain thing may result from a given set of circumstances,” but instead requires that the allegedly inherent feature be “necessarily present” in the prior art reference. Moreover, in discussing functional limitations, M.P.E.P. §2114 is specifically limited to apparatus and article claims.

The Notice characterizes these M.P.E.P. sections neutrally as containing “more information” that is relevant to functional limitations.<sup>24</sup> As presented, the Notice suggests that consideration of this information is merely optional. By contrast, when examining questions of computer-implemented functional limitations, we believe that consideration of these sections is essential. To reduce the possibility that its guidance on functional limitations will be misinterpreted, we urge the Office to more explicitly reference the requisites of inherency and the limitation of its guidance to apparatus and article claims.

G. The use of alternatively phrased features in a claim should not result in any such claim being treated as a Markush claim.

The Notice encourages examiners to reject Markush claims under the “improper Markush grouping” doctrine if the species recited in such claims do not share a single structural similarity or a common use.<sup>25</sup> Additionally, the Notice broadly defines a “Markush claim” as “any claim that recites a list of alternatively usable species regardless of format.”<sup>26</sup>

We are concerned that the scope of “a list of alternatively usable species” is unclear. For example, such a “list” could conceivably include any phrases in a claim that are connected by the word “or.” Does the Office intend for *any* use of alternative language in a claim to give rise to a Markush interpretation? It is also unclear whether “alternatively usable” encompasses lists in which multiple list members may be concurrently usable (e.g., a list prefaced by “one or more of”), or whether the list members must be *strictly* alternatively usable (i.e., to the exclusion of other members).

We are further concerned that by broadening the scope of what the Office considers to be a Markush claim subject to the “improper Markush grouping” doctrine, the Office calls into question claims in issued patents that do not use the traditional Markush format and were not intended to invoke a Markush interpretation. By suggesting that such claims could be rejected under the doctrine if they were currently pending, the Office implicitly questions the validity of such claims if they appear in issued patents. We believe the Office should not inadvertently suggest an invalidity defense to issued patents via its examination guidelines, and request that the Office clarify its position on this matter. In particular, we believe that the use of alternative phrasing in a claim should not subject any such claim to Markush interpretation.

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<sup>24</sup> *Id.*

<sup>25</sup> *Id.* at 7166.

<sup>26</sup> *Id.*

### **III. Conclusion**

In summary, we support the Office's efforts to provide examiners with clear and current guidance on §112 matters. We believe that such guidance benefits the public, applicants, and the Office alike. However, because precise standards for judging §112 compliance are lacking in the respects noted above and to reduce the possibility of misinterpretation, we urge the Office to emphasize to the examining corps that (1) its guidance on §112 compliance is interpretive rather than authoritative and (2) clearly articulated reasoning in support of any rejection §112 is essential to proper examination. We also believe the guidance offered in the Notice with respect to specification support, the scope of *Aristocrat*, functional limitations, and Markush claims should be clarified in view of the discussion above.

We appreciate the opportunity to comment, and look forward to continuing to work with the Office to improve patent examination for the benefit of applicants, the public and the U.S. patent system.

Consideration of the above comments is respectfully requested.

Respectfully submitted,  
**Intellectual Ventures, LLC**

/s/

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