USPTO and Federal District Courts
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Supplementary §112 Examination Guidelines

- The Supplementary 35 U.S.C. § 112 Examination Guidelines were published in the Federal Register on February 9, 2011.

- **Purpose**: Assist the Examining Corps in evaluating claims for compliance with § 112, ¶2, and other patentability requirements related to enhancing the quality of patents.

- **Goal**: Ensure that the scope of any patent rights granted is clear and supported by the invention disclosed to the public.
Guideline Content

- Guidance for determining, under the broadest reasonable interpretation, whether the metes and bounds of the claimed invention are clear under § 112, ¶2
- Guidelines for treatment of dependent claims that do not comply with § 112, ¶4
- Factors to be considered when examining functional claim language to determine whether the claim scope is clear and precise under § 112, ¶2
- Guidance for determining whether a claim limitation invokes § 112, ¶6 and whether a § 112, ¶6 limitation complies with § 112, ¶2
Supplemental information for examining computer-implemented functional claim limitations with respect to written description and enablement requirements under §112, ¶1, and rejections under §§ 102 and 103

Guidance for examining Markush claims with respect to the definiteness requirement under §112, ¶2, and a judicially based rejection as an “improper Markush grouping”
Examination Procedure

- Determine what has been invented and what the applicant is seeking to patent
- Interpret the claims
- Conduct a thorough search of the prior art
- Determine whether the written description supports the claimed invention under 35 U.S.C. § 112, ¶1 (written description requirement)
- Determine whether the disclosure enables the full scope of the claimed invention under 35 U.S.C. § 112, ¶1 (enablement requirement)
Examination Procedure (continued)

- Confirm whether the best mode of practicing the claimed invention is disclosed in the application under 35 U.S.C. § 112, ¶1 (best mode requirement)

- Determine whether the claims comply with § 112, ¶2 requirements (are the claims definite?)

- Determine whether the claims comply with § 112, ¶4 proper dependent claim requirements

- Clearly communicate findings, conclusions and their bases in an Office action

- Practice compact prosecution / evaluate claims for patentability under all applicable statutes
The Office emphasizes giving claims their **brodest reasonable interpretation** (BRI) consistent with the specification as it would be interpreted by one of ordinary skill in the art at the time the invention was made.

BRI emphasis ensures that issued claims are proper in accordance with 35 U.S.C. § 112, second paragraph.
Broadest Reasonable Interpretation (cont)

- Examiner claim construction employs BRI to ascertain the scope and meaning of claim terms.

- Examiners give claim terms their plain meaning unless the application clearly sets forth a different definition in the specification as filed.
  
  - Plain meaning means the ordinary and customary meaning given to that term by those of ordinary skill in the art at the time of the invention.

  - Sources of the meaning include words of the claims, specification, drawings, and prior art.
Definiteness

- Emphasize use of the definiteness requirement of § 112, second paragraph.

- Using BRI examiners are to determine if the metes and bounds of the claimed invention are clear.

  - The reasonableness component is emphasized.
  
  - The distinction between claim breadth and indefiniteness is also emphasized.
Definiteness (continued)

Issues addressed:

- Terms of degree
- Subjective terms
- Correspondence between specification and claims
- Improper dependent claims
- Functional claiming
- § 112, ¶6, lack of corresponding structure
- Computer-Implemented Functional Claiming issues
- Markush groups
Compact Prosecution

- Clearly articulate all appropriate rejections and objections early in the prosecution.
- Attempt resolution through an interview.
- Evaluate claims for compliance with every statutory requirement for patentability and reject each claim on all reasonable grounds to avoid piecemeal examination.
Conclusion

- Stakeholder communication, outreach and collaboration a top Agency priority
- Stakeholder feedback and input is critical to the process of finding robust solutions
Thank You