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April 18, 2011

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

Attn : Robert Stoll, Commissioner for Patents

Re: Comments on *Supplementary Examination Guidelines for
Determining Compliance With 35 U.S.C. 112 and for Treatment of
Related Issues in Patent Applications*

Dear Under Secretary Kappos:

I am writing on behalf of the American Bar Association Section of Intellectual Property Law (the "Section") to provide comments in response to the United States Patent and Trademark Office's (the "Office") invitation for public comment on the *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 (PTO-P-2010-0088, Feb. 9, 2011)* ("the Guidelines"). These comments have not been approved by the ABA House of Delegates or Board of Governors, and should not be considered to be views of the American Bar Association.

The Section appreciates the comprehensive review of recent applicable case law provided in the *Federal Register*. While generally in support of the Guidelines, the Section suggests that there are four issues that should be addressed to enhance the effectiveness of the Guidelines.

Examiner Training

The Section notes that the Guidelines incorporate aggressive procedures to encourage clear Examiner guidance regarding claims that the Examiner believes do not meet the criteria set out for written description, enablement and "means for" or step by step claims under §112(6). The Section supports the concept that application of the rules outlined by the Guidelines is reasonable for proper efficiency of Office operations and common fairness to applicants. However, the Section submits that it is presently not feasible to expect Examiners to do their jobs under the Guidelines without substantial and immediate training both within and without the Office to lend assistance to them.

Proper analysis of 35 U.S.C. §112 and accompanying documentation of the record in accordance with the Guidelines is necessarily a complex analysis that may vary by art unit. The Examiner procedures for evaluating the degree of definiteness presented require the Examiner to understand whether there is proper support for an indefiniteness finding given the language chosen by the applicant, the specification support to the defined claim language, and the level of skill of those persons having ordinary skill in the relevant art. If an Examiner concludes that a claim is indefinite, he or she is required to explain their reasons in a clear and concise writing including analysis of the exact language of indefiniteness perceived, and detailing the failures of the applicant to meet the standard. The indefiniteness analysis is complicated by nuances of the language. Two reasonable interpretations of a claim is a necessary showing for the indefiniteness rejection, but is not a *sufficient* showing. For example, two different dictionaries may define the same word differently; however, a word having two different, but mirror image meanings, is very likely not indefiniteness. A showing of genuine ambiguity, with two possible claim interpretations should be required for every indefiniteness rejection. However, proper analysis, documentation, and consistent resolution cannot be readily ascertained from simply reading the Guidelines.

In addition to the inherent complexity, the Guidelines include new, expansive rules to control the patentability of computer/software related inventions. Still further, the challenge is compounded by the relative newness of the development of §112 law from the Federal Circuit which the Examiners must understand and consistently apply. Though key cases are outlined in the Guidelines, there have been many key industry-defining decisions under §112 with divisive philosophies presented throughout the majorities and dissents of these cases. Despite the helpful nature of the Guidelines, the Section maintains that the analysis is complex and Examiner inconsistencies are likely to persist without appropriate Examiner training.

The Section suggests that Examiners should receive intensive training to ensure a clear understanding of the developed law, to facilitate a consistent application of the analysis procedures for Examiners, and to highlight art unit specific issues. Ideally, the training program should include a hierarchy of USPTO seasoned veterans to teach on a rolling or continuous basis new and not so new Primary Examiners with the ultimate goal of proven uniformity. Testing should be made mandatory on a periodic month basis to support uniformity or the creation of an equivalent infrastructure. The Guidelines provide a useful resource for Examiners and applicants. However, the Guidelines must be supplemented with Examiner training to ensure consistent analysis, documentation, and appropriate application of the Guidelines.

Compact Prosecution

Indefiniteness rejections may be subjective in terms of how a particular Examiner reads a claim term. It is often difficult to get to the real issue in the back-and-forth of written prosecution communication. These types of rejections may be more expeditiously handled by an Examiner telephoning an applicant's representative. The applicant's representative may then be able to provide clarification for the term and discuss the intent of the meaning. If the indefiniteness of the claim language is maintained, the applicant's representative could then propose, if necessary, to file an amendment of the claim. It would be helpful for the Examiner to have resolution of the language prior to searching and interpreting the language in

comparison to prior art. It may save the Examiner time in his or her examination of the application and may facilitate compact prosecution of the application. Further it is helpful to reduce ambiguities in the prosecution file history. Having claim language well defined and clear is important in a patent and early resolution of the meaning of the language is advantageous for all parties.

Cite and Follow Applicable Law

Guidance documents, such as the Manual of Patent Examining Procedure (“MPEP”) and the Guidelines, are helpful when they interpret existing law through an interpretive rule or clarify how the Office will treat or enforce a governing legal norm. Guidance documents, used properly, can channel the discretion of Office employees, increase efficiency, and enhance fairness by providing the public clear notice of the line between permissible and impermissible conduct while ensuring equal treatment of similarly situated parties. The Section encourages the Office to publish the Guidelines as an aid for Examiner understanding and training, but not as citable support for an Examiner’s rejection. The Section favors the addition of statements in the Guidelines to remind Examiners that the Guidelines may not be cited as the basis for an Examiner’s rejection.

Need for Clarity

The Section suggests that the Guidelines further clarify the applicable law that should be followed in examining patent claims for compliance with §112(2). The first step to examining a claim to determine if the language is definite is to fully understand the subject matter of the invention disclosed in the application and to ascertain the boundaries of that subject matter encompassed by the claim. This analysis is done from the perspective of a person of ordinary skill in the relevant art, determining the meaning of the terms of the claims by reading them in the context of the patent application in its entirety. The proper test is whether the scope of the claim, in context of the patent application, is clear to a hypothetical person possessing the ordinary level of skill in the pertinent art.

Accordingly, the proper analysis requires a determination giving claims their broadest reasonable construction ‘in light of the specification as it would be interpreted by one of ordinary skill in the art’. The rules of the Office require that application claims must “conform to the invention as set forth in the remainder of the specification and the terms and phrases used in the claims must 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.” 37 § C.F.R. 1.75(d)(1). Because the applicant has the opportunity to amend claims during prosecution, giving a claim its broadest reasonable interpretation will reduce the possibility that the claim, once issued, will be interpreted more broadly than is justified.

Thus, the definiteness of claim language is not analyzed in a vacuum and the proper basis for that analysis should be clear in the Guidelines. Definiteness of claim language must be analyzed from the perspective of a person of ordinary skill in the relevant art and based upon a reading of the specification. These factors in the analysis should be made clarified in the proposed Guidelines.

Conclusion

The Section suggests four enhancements to the Guidelines to facilitate consistent, compact prosecution and consistent citation of the applicable law. Accordingly, the Section strongly suggests that Examiners receive intensive training to facilitate consistent, accurate documentation surrounding 35 U.S.C. §112 rejections and appropriate analysis with reliance upon the applicable law. The Section further suggests that the Office include procedures in the Guidelines to encourage examiner-initiated interviews with Applicant's attorney upon the Examiner's first appreciation that an indefiniteness rejection may be issued, and prior to any written Office Action. Further, the Section suggests that the Office should make clear to all personnel that when an applicant challenges a statement of law in the MPEP or the Guidelines, the Office must cite a document that carries force of law. Finally, the Section suggests that the Guidelines make clear that the claims be given their broadest reasonable interpretation in light of the specification in which they appear.

The Section commends the Office for taking on this important project and appreciates the opportunity to offer comment.

Very truly yours,

A handwritten signature in black ink, appearing to read "Marylee Jenkins", with a long horizontal line extending to the right.

Marylee Jenkins
Section Chairperson
American Bar Association
Section of Intellectual Property Law