2011

USPTO Issues Supplementary Examination Guidelines Explaining the Requirement for Clarity in Patent Claims

W. Keith Robinson
Southern Methodist University, Dedman School of Law

Rouget Henschel

USPTO issues Supplementary Examination Guidelines explaining the requirement for clarity in patent claims

IP|Business is supported by Foley & Lardner LLP [1]

The US Patent and Trademark Office (USPTO) recently published Supplementary Examination Guidelines [2] on the requirement that proper patent claims must allow the public to clearly distinguish what infringes from what does not. The Guidelines focus to some degree on computer-implemented inventions. The Guidelines acknowledge that computer implemented inventions have "unique examination issues". But the Guidelines are important to patent applicants in all fields, perhaps more so in newer technologies with developing terminology, or where the invention is otherwise difficult to put into words.

For all the apparent complexity of a patent specification, it is primarily written to satisfy two legal requirements, that is, that an inventor explains how to make and use the invention and that the claims clearly define what infringes. The relevant statute is 35 USC § 112 [3].

Section 112 requires that to obtain a patent, the applicant must provide claims whose meaning and scope are clear enough that a competitor reading the claims can determine whether ongoing or planned activities might require a license or be subject to a lawsuit for infringement of the patent. This is perhaps easier said than done for several reasons. For example, each claim must be written as a single sentence with enough detail to differentiate the prior art. Also, every word and phrase in the claim can be challenged as lacking clarity.

The Guidelines are intended to be used by Examiners to guide them in determining compliance with Section 112. As such, the Guidelines also provide insight to patent applicants facing an Examiner rejection. The Guidelines contain useful examples of when a rejection should or should not be made.

Accordingly, understanding the guidelines and the impact they have on how claim terms will be interpreted during examination is important for patent applicants.

The second paragraph of Section 112 states, "The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention."

According to the Guidelines, the best source for determining the meaning of a claim term is the specification and the greatest clarity is obtained when the specification serves as a glossary for the claim terms. Thus, including in the specification a glossary defining claim terms is a helpful tool to avoid rejections under Section 112.

The Guidelines focus on claims using functional language without defining a corresponding structure, and on so-called "means-plus-function" terms.

Regarding claims using functional language, the Guidelines state that there is nothing intrinsically wrong with functional claiming. A claim term is considered functional when it recites a feature by what it does rather than by what it is. However, the use of functional language may fail to provide a clear-cut indication of the scope of the subject matter embraced by the claim. As examples, the Guidelines mentioned claims that were invalidated for inadequately defining in the specification terms such as "fragile gel", ''comparatively large grains of such size and contour as to prevent substantial sagging or offsetting", and "commercially uniform, comparatively small, rounded smooth aggregates".

This problem may be avoided by clearly explaining in the specification what the terms mean. Without reciting the particular structure, materials or steps that accomplish the function or achieve the result, all means or methods of resolving the problem may be encompassed by the claim. Unlimited functional claim limitations that extend to all means or methods of resolving a problem may not be adequately supported by the specification.

When a claim limitation employs functional language, the examiner's determination of whether the limitation is sufficiently definite will be highly dependent on context (for example, the disclosure in the specification and the

knowledge of a person of ordinary skill in the art).

Regarding "means-plus-function" terms, the Guidelines explain that for a computer-implemented invention defined by a claim with a means-plus-function limitation, the specification must include corresponding structure that is more than simply a general purpose computer or microprocessor. A means-plus-function term generally begins with the phrase "means for" followed by the function served, for example, "means for displaying" where the function served is "displaying" and the specification discloses various types of monitors as the corresponding structure. Such claims are limited to structures disclosed in the specification and equivalent structures.

Specifically, the Guidelines state that the structure corresponding to a means-plus-function term for a computer-implemented function must include the algorithm needed to transform the general purpose computer or microprocessor disclosed in the specification. Thus, the specification must sufficiently disclose an algorithm to transform a general purpose microprocessor to the special purpose computer, so that a person of ordinary skill in the art can implement the disclosed algorithm to achieve the claimed function. The algorithm may be expressed as a mathematical formula, in prose, in a flow chart, or ‘‘in any other manner that provides sufficient structure. Mere reference to software, or a specialized computer ("bank computer") will not be sufficient disclosure because they fail to explain how the computer or computer component perform the claimed function.

Claim terms that are not in classic "means-plus-function" format may nevertheless be examined as means-plus-function claims. The Supplemental Guidelines list as examples several phrases commonly used in electrical and software applications, including "mechanism for", "module for", "device for", "unit for", "component for", "element for", "member for", "apparatus for", "machine for", or "system for".

In summary, while the Guidelines themselves are not crystal clear on some points, they provide useful insight on Examiner rejections alleging that a claim term is unclear.

W.K. Robinson [4] is an associate, and R.F. Henschel [5] is a partner with Foley &

Lardner LLP [6]

Related subjects:

1. http://www.foley.com/
2. http://edocket.access.gpo.gov/2011/pdf/2011-2841.pdf
3. http://www.uspto.gov/web/offices/pac/mpep/consolidated_laws.pdf
4. http://www.foley.com/people/bio.aspx?employeeid=23498
5. http://www.foley.com/people/bio.aspx?employeeid=22764
6. http://www.foley.com/

Related Notes

PTO Announces Proposed Rules for Supplemental Examination
By Jason Rantanen Yesterday the United States Patent and Trademark Office announced the

The Future Of Patent Licensing In Europe
For the time being, individual countries award patents as legal instruments, protecting property