Patent Public Advisory Committee
Quarterly Meeting

Patent Examination Policy Update

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Deputy Commissioner for Patent Examination Policy
May 14, 2015
# Functional Claiming Training Update

<table>
<thead>
<tr>
<th>Topic</th>
<th>Status</th>
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<tbody>
<tr>
<td>35 USC §112(f): Identifying Limitations that Invoke §112(f)</td>
<td>Completed</td>
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<td>35 USC §112(f): Making the Record Clear</td>
<td>Completed</td>
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<tr>
<td>35 USC §112(f): Broadest Reasonable Interpretation and Definiteness</td>
<td>Completed</td>
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<td>of §112(f) Limitations</td>
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<tr>
<td>35 USC §112(f): Evaluating §112(f) Limitations in Software-Related</td>
<td>Completed</td>
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<tr>
<td>Claims for Definiteness under 35 USC §112(b)</td>
<td></td>
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<tr>
<td>Claim Interpretation: Broadest Reasonable Interpretation (BRI), plain</td>
<td>Completed</td>
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<td>and customary meaning of terms, and treating claim as a whole</td>
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<tr>
<td>Claim Interpretation: Examining Functional Claim Language</td>
<td>Spring 2015</td>
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<tr>
<td>§112(a): Written Description for all technical fields</td>
<td>Summer 2015</td>
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<tr>
<td>§112(a): Enablement for all technical fields</td>
<td>Fall 2015</td>
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101 Training Update

• Multi-phased Examiner Training
  – Phase I – Corps-wide Training on Dec. 2014 Interim Guidance
    • Completed January/February 2015
  – Phase II – TC-specific Training based on examples
    • Mostly complete
Public Comments on 2014 Interim Eligibility Guidance

• A public comment period closed on March 16, 2015
• 61 public comments were received
• Common themes:
  – Positive step in clarifying examination procedures compared to the March 2014 guidance
  – Certain areas were identified for improvement/clarification
  – Published examples useful; strong desire for additional examples
Public Comments on 2014 Interim Eligibility Guidance

• Other notable themes include:
  – Clarification regarding identifying the exceptions
    • Parameters relating to the types of abstract ideas, for example for “certain methods of organizing human activity”
    • Role of preemption as it relates to the exceptions
  – Concern over the implementation of the guidance
    • Need for training and consistent application across art areas
    • Importance of making a prima facie case, with some proposing that examiners provide factual evidence
  – Various aspects of the markedly different characteristics
Next Steps

• Complete Phase II of Examiner Training
  – Publish Workshop Training Material

• Iterative refinements to the guidance based on judicial developments and feedback from the public and the examining corps
  – E.g., additional examples are being developed
Additional Resources

• General page for examination guidance and training materials
  http://www.uspto.gov/patents/law/exam/examguide.jsp

• Specific page for the December 2014 Interim Eligibility Guidance
  • Includes the Guidance document, additional claim examples and relevant case law
  • All updates will be posted to this page
Questions and Comments

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