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**To:** 112Guidance2019 <112Guidance2019@USPTO.GOV>  
**Subject:** The Internet Association's Comments on PTO-P-2019-0059

Dear Senior Legal Advisors Haines and West,

Please find attached the Internet Association's comments on the USPTO Notice: Examining Computer-Implemented Functional Claim Limitations for Compliance With 35 USC 112 (PTO-P-2018-0059).

Best regards,  
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

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Examining Computer-Implemented Functional Claim Limitations  
for Compliance With 35 U.S.C. 112

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Docket No. PTO-P-2018-0059

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**COMMENTS OF THE INTERNET ASSOCIATION**

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March 8, 2019

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## **I. Commenter's Interest And Initial Statement**

The Internet Association is the unified voice of the Internet economy, representing the interests of America's leading Internet companies and their global community of users.<sup>1</sup> The Association is dedicated to advancing public policy solutions to strengthen and protect Internet freedom, foster innovation and economic growth, and empower users. The members of the Internet Association have extensive experience with computer-implemented functional claim language in patent examination, litigation, and post-grant review proceedings. Indeed, the Internet Association's members bring particular expertise to these issues because innovation in computer-implemented functions—both eligible and ineligible—are integral to their businesses.

The Internet Association applauds the USPTO for its continued serious examination of the Section 112 caselaw and related issues. The Internet Association does not object to the substance of the revised Section 112 Guidance. It appears that the Guidance will move USPTO examination practice toward conformance with recent caselaw. Unfortunately, the Guidance does not address several Section 112 issues that repeatedly cause uncertainty in the construction of claims in the Office and the courts.

The Association believes that structural change is needed in examination practice to ensure that Section 112 is properly enforced during examination and that claim construction is more easily performed once the claims are issued. The proposed changes would primarily require patent applicants to present their understanding of functional claim language when they submit claims for examination.

In particular, the Office should require applicants to address the status of novel functional claim elements under Section 112(f) and provide information addressing claim construction and related Section 112 issues more directly during prosecution. The USPTO should also require patent applicants to express their claims in terms that find antecedent basis in the specification. The increased burden on patentees is slight. Patent applicants should understand the claims they present and their own specification better than anyone.

If the USPTO adopts this more direct approach, the benefits would be significant. The Office and applicants could clarify claim scope, reduce issues of indefiniteness, and provide a better understanding of claim support for computer-implemented functional claim limitations throughout prosecution. As a result, patent owners and the public will face less uncertainty

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<sup>1</sup> The Internet Association's members include Airbnb, Amazon, Ancestry, Coinbase, DoorDash, Dropbox, eBay, Etsy, Eventbrite, Expedia, Facebook, Google, Groupon, Handy, HomeAway, IAC, Intuit, Letgo, LinkedIn, Lyft, Match Group, Microsoft, Pandora, PayPal, Pinterest, Postmates, Quicken Loans, Rackspace, Rakuten, Reddit, Snap Inc., Spotify, Stripe, SurveyMonkey, Thumbtack, TransferWise, TripAdvisor, Turo, Twilio, Twitter, Uber, Upwork, Vivid Seats, Yelp, Zenefits, and Zillow Group.

regarding claim scope during litigation, pre-litigation enforcement efforts, and post-grant proceedings.

## **II. The Section 112 Guidance Rightly Moves Current USPTO Examination Practice Toward Conformance With Recent Federal Circuit Caselaw<sup>2</sup>**

The Section 112 Guidance addresses multiple aspects of Section 112 caselaw. In each case, it appears that the Office has captured the substance of the caselaw. Two areas warrant comment because there the Guidance deftly addresses issues that might otherwise lead to confusion.

First, construction of functional claim limits and means-plus-function claims under Section 112(f) has been made perhaps more difficult by recent developments. The Guidance recognizes that the presumption based on the recitation of “means” was weakened in *Williamson*.<sup>3</sup> As a result, it will be more difficult to discern whether a particular claim is meant to invoke Section 112(f). The Guidance properly would find claims indefinite when its claim construction is “inconclusive” as to whether Section 112(f) is invoked.<sup>4</sup> When the meaning of a claim is unclear, the claim is indefinite, and the agency should resist calls to treat such claims in any other way.

Second, compliance with written description and enablement under Section 112(a) is a requirement whether functional claims are considered means-plus-function claims or not. The Guidance recognizes this and properly links indefiniteness of computer-implemented means-plus-function claims for failure to disclose an algorithm “sufficient to perform the entire claimed function(s)” with a lack of written description.<sup>5</sup> The Guidance further applies the statutory requirements to non-112(f) claims by requiring that the “specification must describe the claimed invention in sufficient detail (e.g., by disclosure of an algorithm) to establish that the applicant had possession of the claimed invention.”<sup>6</sup> This point—that “software-related claims” need to be supported by “the algorithm(s) that achieve the claimed function” regardless of whether they are means-plus-function claims—is undoubtedly correct.<sup>7</sup>

Commenter notes that the Section 112 Guidance continues to place the burden heavily on the Examiners when construing claims and when determining written description and enabling

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<sup>2</sup> Examining Computer-Implemented Functional Claim Limitations for Compliance With 35 U.S.C. 112 Dkt. No. PTO-P-2018-0059, 84 Fed. Reg. 57 (Jan. 7, 2019) (“Section 112 Guidance” or “Guidance”).

<sup>3</sup> Section 112 Guidance at 58, col. 2 (citing *Williamson v. Citrix Online, LLC*, 792 F.3d 1339 (Fed. Cir. 2015)).

<sup>4</sup> *Id.* at 60, col. 3.

<sup>5</sup> *Id.* at 60, col. 2, 61, col. 1.

<sup>6</sup> *Id.* at 61, col. 1.

<sup>7</sup> *Id.* at 61, col. 3.

support for the claims. The Office should consider a broader structural change—one that requires applicants to act as partners in the examination of their computer-implemented functional claims.

### **III. Structural Change Is Needed; Applicants Should Do More To Preemptively Address Section 112 Issues**

Too often, in cases involving computer-implemented functional claim limitations, the scope of the patent claims does not become clear until the completion of lengthy and expensive litigation. This lack of clarity harms the public, raises litigation costs, and ultimately retards innovation.

Four questions repeatedly arise when interpreting patent claims with functional claim elements:

1. Whether functional claim limitations are to be read as means-plus-function claims under 35 U.S.C. § 112(f).<sup>8</sup>
2. Whether claim language limits the scope of claims.
3. Whether claims cover subject matter not described and enabled as required by Section 112.<sup>9</sup>
4. Whether claim scope is limited by the patentee's arguments during prosecution.

The Internet Association proposes that the USPTO change its Section 112 examination practice to better address each of these questions during prosecution. The proposed changes would help Examiners understand pending claims and ensure that claims issued by the Office have sufficient support in the specification and a clearer scope.

### **IV. Patent Applicants Should Address Whether Functional Claim Limitations Are Intended As Means-Plus-Function Claims When Presenting The Claims**

Applicants are entitled to provide claims in means-plus-function form or to provide claims that recite functions and corresponding structure for performing that function.<sup>10</sup> Unfortunately, it is often difficult to understand which interpretation a court or the PTAB will ultimately choose in construing functional claim limitations. By the time a claim reaches litigation, the present patent owner may have no way of knowing the intent when the claims were filed or may have incentives to press the choice that best serves their litigation position.

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<sup>8</sup> Pre-AIA 35 U.S.C. § 112, sixth paragraph.

<sup>9</sup> See also 37 C.F.R. 1.71.

<sup>10</sup> See 35 U.S.C. § 112(f).

Nor have courts found particular consistency when addressing this aspect of claim construction. While the presence or absence of the words “means for” in the claims provides a presumption, the en banc Federal Circuit has held that the presumption is not dispositive.<sup>11</sup> As the Guidance recognizes, this presumption was recently weakened in *Williamson* and can no longer be considered “strong.”<sup>12</sup> The reduced presumption was necessitated by the proliferation of “generic placeholders” that “may invoke 35 U.S.C. 112(f).”<sup>13</sup> It is more difficult than ever to discern whether a claim with functional elements should be read to invoke Section 112(f).

The Section 112 Guidance partially addresses this issue by rightly starting with claim construction. But the Guidance places the burden on the Examiner to decide what the claim limitations mean and whether to address the applicability of Section 112(f).<sup>14</sup> Where the Examiner says nothing, the applicant typically says nothing regarding which claim construction is appropriate and the public is left without notice.

Applicants need not and should not wait to “respon[d] to the Office action” in which the Examiner raises claim construction.<sup>15</sup> Rather, patent applicants should be required when submitting their claims to explicitly state whether novel functional elements in the claims are meant to invoke Section 112(f) or not. “Novel” here, as in the Guidance, meaning any element the patentee believes recites in some part “the novel aspect of the claimed invention.”<sup>16</sup>

If the applicant asserts that novel functional limitations are not means-plus-function limits, the applicant should be required to explain how the claim recites the necessary structure to perform the function. Likewise, the applicant should be required to point out “the corresponding structure, material, or acts described in the specification” for means-plus-function claims.<sup>17</sup> In either case, the applicant presents a roadmap whereby the Examiner, and eventually the public, can better understand what the inventor “regards as the invention.”<sup>18</sup> Once the applicant's position is on the record, the Examiner can consider and address the claim construction as discussed in the Section 112 Guidance.<sup>19</sup>

The proposed change has several benefits. Disputes regarding the language would be resolved earlier in the examination process. The Examiner’s ability to examine the claims would

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<sup>11</sup> *Williamson v. Citrix Online, LLC*, 792 F.3d 1339, 1348 (Fed. Cir. 2015) (en banc in relevant part).

<sup>12</sup> Section 112 Guidance at 58, col.2 (citing *Williamson*).

<sup>13</sup> *Id.* at 59, col. 1.

<sup>14</sup> *Id.* at 59, col. 2.

<sup>15</sup> *Id.* at 59, col. 2.

<sup>16</sup> *Id.* at 62, col. 3.

<sup>17</sup> 35 U.S.C. § 112(f).

<sup>18</sup> 35 U.S.C. § 112(c).

<sup>19</sup> Section 112 Guidance at 59, col. 2.

be enhanced. When the claims issue, the public will be better informed as to the patent owner and the USPTO's understanding of the scope and support for the claims.

## **V. Patent Applicants Should Identify Any Non-Limiting Claim Language When Presenting The Claims**

The effort devoted to litigating whether a claim's functional language is considered limiting or is merely a statement of intended use or otherwise nonconsequential verbiage could be saved by a default rule: all language in a claim is limiting absent agreement to the contrary between the USPTO and the applicant.

This question often arises with preambles: "The determination of whether a preamble limits a claim is made on a case-by-case basis in light of the facts in each case; there is no litmus test defining when a preamble limits the scope of a claim."<sup>20</sup> Respectfully, without a "litmus test," the question has no easy answer, and the resulting litigation is expensive and uncertain.<sup>21</sup> Too often, even with the benefit of a litigation record, the Federal Circuit finds it difficult to determine "when and to what extent claim preambles limit the scope of the claims."<sup>22</sup>

As Judge Dyk has pointed out, "a rule recognizing that all preambles are limiting would make better sense and would better serve the interests of all concerned."<sup>23</sup> The USPTO should implement just such a rule and remove this inherent ambiguity in nearly every claim it examines and issues.

This proposed policy would likely require a rule change. The Office should consider an addition to Rule 1.75, which currently fails to address when a preamble, or other language, is considered non-limiting. The new Rule 1.75(j) could read:

(j) Absent agreement by the Office to the contrary, Claims in any form shall be construed to include all the limitations recited in the claim regardless of whether the limitation appears in a preamble.

Under this rule, patent applicants would better define their claim in the Office and save considerable resources for the Office and the courts. The default rule would be all claim

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<sup>20</sup> MPEP 2111.02 (citing *Catalina Mktg. Int'l v. Coolsavings.com, Inc.*, 289 F.3d 801, 808 (Fed. Cir. 2002)).

<sup>21</sup> See e.g., *Georgetown Rail Equip. Co. v. Holland L.P.*, 867 F.3d 1229, 1236 (Fed. Cir. 2017) ("Whether to treat a preamble as a limitation is a determination resolved only on review of the entire patent to gain an understanding of what the inventors actually invented and intended to encompass by the claim.") (citation and ellipses removed).

<sup>22</sup> See *Bell Commc'ns Research, Inc. v. Vitalink Commc'ns Corp.*, 55 F.3d 615, 620 (Fed. Cir. 1995) (gathering treatises).

<sup>23</sup> *Am. Med. Sys., Inc. v. Biolitec, Inc.*, 618 F.3d 1354, 1364 (Fed. Cir. 2010) (Dyk, J., dissenting).



language is limiting. But the applicant could initially identify any claim language they consider non-limiting and the Examiner could respond. Regardless of how the issue arises, the Examiner may, of course, dispute the applicant’s characterization of the claim scope. In which case, the Examiner’s position should be placed on the record, and the dispute resolved, e.g., by amendment, before the patent issues.

The burden on patentees would be slight—having just drafted the claim they are in the best position to understand whether the preamble or other language in the claim is intended to be non-limiting.

## **VI. Patent Applicants Should Point Out The Section 112 Support For Their Claims When Presenting The Claims**

A failure to require clear Section 112 support is often at the center of claim construction disputes in the Office and before the courts. Patent applicants should be required to provide a roadmap of support for the Examiner’s use in prosecution and for the public’s use in understanding the issued claims. This may be done in two independent but reinforcing ways: (1) applicants should draft claims with technical language that has antecedent support in the specification, and (2) applicants should point out the support for their claims in the disclosure.

### **A. Patent applicants should craft claims with clear antecedents in the specification**

In claim construction, the specification “is the single best guide to the meaning of a disputed term.”<sup>24</sup> “Usually it is dispositive.”<sup>25</sup> These principles apply in both the district courts and the Office, even under the broadest reasonable claim construction.<sup>26</sup>

But the specification is of little use in understanding claim terms that do not appear in the written disclosure. Such terms play an outsized role in patent disputes because language unmoored from the inventor’s disclosure is inherently susceptible to varied construction based on the exigencies of litigation.<sup>27</sup> Patentees sometimes press the narrower construction of such

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<sup>24</sup> *Phillips v. AWH Corp.*, 415 F.3d 1303, 1315 (Fed. Cir. 2005) (en banc) (internal quotation marks and citation omitted).

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

<sup>26</sup> See, e.g., *Hamilton Beach Brands, Inc. v. f’real Foods, LLC*, 908 F.3d 1328, 1339 (Fed. Cir. 2018).

<sup>27</sup> See *Jazz Pharm., Inc. v. Amneal Pharm., LLC*, 895 F.3d 1347, 1352 (Fed. Cir. 2018) (“While claim 1 refers to ‘periodic reports,’ that specific term does not appear elsewhere in the written description.”); *Gen. Atomics Diazyme Labs. Div. v. Axis-Shield ASA*, 277 F. App’x 1001, 1007 (Fed. Cir. 2008) (“[W]e note that aside from the Abstract, which mirrors the claim language, the term ‘homocysteine conversion product’ does not appear in the specification.”); *Tandon Corp. v. U.S. Int’l Trade Comm’n*, 831 F.2d 1017, 1023 (Fed. Cir. 1987) (“The [claim] phrase ‘normal to the plane’ does not appear in the specification as filed.”).

terms.<sup>28</sup> Sometimes they argue for a broader construction of such terms.<sup>29</sup> Accused infringers, or others challenging a patent, may do just the opposite. Relatedly, patentees will often press a claim construction that exceeds the support in the specification.<sup>30</sup> While this seems counter-productive, it may be the only way the patentee can show infringement. And since claim construction is generally considered in a *Markman* hearing well before validity is contested at trial, it may be tactically advantageous to do so.

Regardless of litigation dynamics, a requirement that the claim limitations have an antecedent basis in the disclosure will inherently allow Examiners (and the public) to understand better the scope of pending (and issued) claims. This proposal could be implemented through a small change in Rule 1.75, which currently requires claims to have clear support or antecedent basis. Instead, Rule 1.75(d)(1) should be amended to read:

(d)(1) The claim or 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~~ and antecedent basis in the description so that the meaning of the terms in the claims may be ascertainable by reference to the description.

This change would benefit the Office and the public. A requirement that claim language be grounded in the specification would ease the burden of examination. During examination, the Office gives claims “their broadest reasonable construction ‘in light of the specification as it would be interpreted by one of ordinary skill in the art.’”<sup>31</sup> Claims written with the same vocabulary as the specification are inherently easier to understand and construe. Claims that are more easily understood are more easily examined for compliance with all the conditions of patentability. Likewise, claims that are more easily understood, provide the public with better notice of the metes and bounds of the invention.

The change is necessary because too often claims are issued that fail to have clear Section 112 support and that failure is not recognized during examination. This failing may only be revealed after extensive litigation or in the refusal to institute an inter partes review. The PTAB,

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<sup>28</sup> See, e.g., *Jazz Pharm.*, 895 F.3d at 1353.

<sup>29</sup> See, e.g., *Gen. Atomics*, 277 F. App’x at 1007; *Tandon Corp. v. U.S. Int’l Trade Comm’n*, 831 F.2d at 1023.

<sup>30</sup> See, e.g., *Liebel-Flarsheim Co. v. Medrad, Inc.*, 481 F.3d 1371, 1380 (Fed. Cir. 2007) (“The irony of this situation is that Liebel successfully pressed to have its claims include a jacketless system, but, having won that battle, it then had to show that such a claim was fully enabled, a challenge it could not meet.”); see also *Trs. of Bos. Univ. v. Everlight Elecs. Co.*, 896 F.3d 1357, 1365 (Fed. Cir. 2018) (“BU created its own enablement problem. ... Having obtained a claim construction that included a purely amorphous layer within the scope of the claim, BU then needed to successfully defend against an enablement challenge as to the claim’s full scope.”)

<sup>31</sup> MPEP § 2111 (quoting *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004)).

for example, has refused to institute IPRs in view of claim construction issues rooted in Section 112 failures.<sup>32</sup> Even after institution, the PTAB has been forced to terminate proceedings after realizing the claims in issue are indefinite.<sup>33</sup>

The burden on applicants would be slight. The applicant is in all cases required to draft claims “particularly pointing out and distinctly claiming” the invention.<sup>34</sup> The applicant is in the best position to do so using the same “full, clear, concise, and exact terms” required to describe and enable the invention in the disclosure.<sup>35</sup>

### **B. The Office should require applicants to point out the support in the patent disclosure for their claims**

The courts, and the Office in post-issuance proceedings, “should also consider the patent’s prosecution history” when construing the claims.<sup>36</sup> But the prosecution history is of little use if the terms were not vetted under Section 112. Very often, for example, the applicant and Examiner focus on obviousness and never address Section 112 support anywhere in the file history.

The Office should require applicants to show support for the claims throughout prosecution. Presently the MPEP suggests that applicants “should show support” for claims during ex parte prosecution.<sup>37</sup> But few, if any, applicants provide such a showing.

The proposed requirement has proven workable in reexamination where patentees “must” supply an “explanation of the support in the disclosure” for new and amended claims.<sup>38</sup> Similarly, in inter partes review and post-grant review, motions to amend must set forth “[t]he support in the original disclosure of the patent for each claim that is added.”<sup>39</sup> In promulgating the later rules, the Office explained that they “enhance efficiency” because when the patent

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<sup>32</sup> See, e.g., *HTC Corp. v. U.S. Philips Corp.*, IPR2017-00856, Paper 7, at 8 (PTAB Aug. 18, 2017) (gathering cases); *Clickbooth.com, LLC, v. Essociate, Inc.*, IPR2015-00464, Paper No. 9, at 8-9 (PTAB Jul. 9, 2015).

<sup>33</sup> See, e.g., *Blackberry Corp. v. MobileMedia Ideas, LLC*, IPR2013-00036, Paper 65, at 8 (PTAB Mar. 7, 2014) (Terminating proceedings because “the scope of the claims [at issue] cannot be determined without speculation. Consequently, the differences between the claimed invention and the prior art cannot be determined.”).

<sup>34</sup> 35 U.S.C. § 112(b).

<sup>35</sup> 35 U.S.C. § 112(a).

<sup>36</sup> *Phillips*, 415 F.3d at 1317; *D'Agostino v. MasterCard Int'l Inc.*, 844 F.3d 945, 948 (Fed. Cir. 2016).

<sup>37</sup> See, e.g., MPEP § 2163 II.A. (“With respect to newly added or amended claims, applicant should show support in the original disclosure for the new or amended claims.”).

<sup>38</sup> 37 C.F.R. § 1.530(e); see also MPEP § 2250 IV(E).

<sup>39</sup> 37 C.F.R. § 42.121(b)(1); *id.* at § 42.221(b)(1).

owner cannot show support for the new claims the motion to amend need not be authorized, opposed, or decided.<sup>40</sup>

The reexamination rule (Rule 1.530(e)) reads:

(e) Status of claims and support for claim changes. Whenever there is an amendment to the claims pursuant to paragraph (d) of this section, there must also be supplied, on pages separate from the pages containing the changes, the status ( i.e., pending or canceled), as of the date of the amendment, of all patent claims and of all added claims, and an explanation of the support in the disclosure of the patent for the changes to the claims made by the amendment paper.<sup>41</sup>

A similar rule could be applied to all applications with a corresponding reduction in the need for Section 112 rejections. Applicants that cannot show support in the original disclosure for the claims would be susceptible to immediate rejection. But far more often, the applicants would file only claims where they could make the requisite showing. Thus, claims would be better understood and fewer claims would require a Section 112 rejection. Both the Examiner and the public would gain a better grasp of claim meaning and Section 112 support for claims throughout prosecution and upon issuance. This would lead to more efficient use of agency resources in examination and better-understood claims, once issued.

Examination of functional claim limitations that express “the novel aspect of the claimed invention,” in particular, could benefit from the applicant showing Section 112 support.<sup>42</sup> The change would greatly increase the Examiner’s ability to locate the alleged support, which can be presented “in any understandable terms including as a mathematical formula, in prose, or as a flow chart, or in any other manner that provides sufficient structure.”<sup>43</sup>

Requiring a showing of support for each claim would add little to the burden on patentees. Applicants are already required by rule to file claims that “conform to the invention as set forth in the remainder of the specification” with claim terms that “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>44</sup> Presumably, the applicant can readily identify the support when a claim is filed.

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<sup>40</sup> 77 Fed. Reg. 48706, Col. 3 (Aug. 14, 2012).

<sup>41</sup> 37 C.F.R. § 1.530(e) (emphasis added).

<sup>42</sup> See Section 112 Guidance at 62, col.3.

<sup>43</sup> *Id.* at 62, col. 1 (quoting *Finisar Corp. v. DirecTV Grp., Inc.*, 523 F.3d 1323, 1340 (Fed. Cir. 2008)).

<sup>44</sup> 37 C.F.R. § 1.75(d)(1).

## VII. Patent Applicants Should Be Bound By Their Arguments

When patent applicants make arguments regarding claims in prosecution, the courts sometimes rely on those statements to limit claim scope under the doctrine of patent prosecution disclaimer. But the sometimes nature of “patent prosecution disclaimer” caselaw makes it difficult to understand what statements that seemingly limit claim scope will limit claim scope in court or before the PTAB.

The Federal Circuit has said that when a “patentee unequivocally and unambiguously disavows a certain meaning to obtain a patent, the doctrine of prosecution history disclaimer narrows the meaning of the claim consistent with the scope of the claim surrendered.”<sup>45</sup> But what arguments are unambiguous becomes a point of contention in litigation, and it is rarely clear whether a court will find an argument to be an “unambiguous” disavowal or not.

During prosecution, patentees will often argue that the Examiner has cited art that doesn’t fall within the scope of the claims despite the Examiner’s understanding of particular limitations. These arguments typically appear to be a disclaimer of subject matter and, further, the Examiner typically appears to accept them as such at the time presented. But subsequently, the same arguments become the topic of heated debate during enforcement when the present patent owner may deny that any disclaimer of scope was intended or made. As a result, even statements held to provide “a clear and unmistakable disclaimer” may be parsed by the Courts such that only one argument—of multiple distinctions—binds the patentee.<sup>46</sup>

Similarly, patentees often deny that any amendment is necessary or that they generally disagree with Examiner’s position, but nonetheless make an amendment and present argument regarding the scope of that amendment. This leaves open the question whether the statements constitute prosecution history disclaimer. In such situations, before accepting the amendment and granting the patent, the Examiner should require the patentee to accept and acknowledge disclaimer.

The best way to approach such arguments is for the applicant to understand that the limits expressed in response to a single office action will bind the patent applicant during examination and subsequently bind the patent owner when issued. Unless the Examiner refuses to accept the argument and requires further amendment of the claims to make express any limitation that applicants argue is inherent in the claim language.

To the extent such arguments are acceptable to the Office without amendment, e.g., when the Examiner was mistaken on the facts asserted regarding the prior art and not on the scope of

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<sup>45</sup> *Biogen Idec, Inc. v. GlaxoSmithKline LLC*, 713 F.3d 1090, 1095 (Fed. Cir. 2013) (citing cases).

<sup>46</sup> *See Omega Eng’g, Inc. v. Raytek Corp.*, 334 F.3d 1314, 1326-27 (Fed. Cir. 2003).

the claim language, the Examiner may put this conclusion on the record and obviate the default rule. Similarly, an applicant may request that its arguments not be taken as binding and should not be used in construing the claims and request the Examiner's agreement.

The Office could implement this change by promulgating a new Rule 1.75(k) that reads:

(k) Absent agreement by the Office to the contrary, Applicants shall be bound by the arguments they present, and claims will be construed in view of all arguments made by applicants regardless of whether the argument was presented to secure any pending claim.

The increased clarity provided by this approach would benefit the courts and the Office by allowing them to understand the issued claims better through the prosecution history. It would likewise assist the Examiner by removing the uncertainty whether an applicant is disclaiming subject matter by argument.

### **VIII. Conclusion**

The Internet Association applauds the USPTO for its serious consideration of Section 112 law as applied to computer-implemented functional claims. The Internet Association believes that the USPTO's approach of considering all views will lead to clearer Guidance and thanks the USPTO for the opportunity to provide its view that structural change is needed.