

**From:** [Ira Richardson](#) on behalf of [WA IPLaw Admin](#)  
**To:** [112Guidance2019](#)  
**Subject:** IBM Corporation Comments in Response to "Examining Computer-Implemented Functional Claim Limitations for Compliance With 35 U.S.C. 112"  
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**Attachments:** [112 Guidance 2019.pdf](#)

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*(See attached file: 112 Guidance 2019.pdf)*

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IBM Corporation Comments in Response to "Examining Computer-Implemented Functional Claim Limitations for Compliance With 35 U.S.C. 112", 84 Fed. Reg. 57 (January 7, 2019).

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IBM thanks the United States Patent and Trademark Office ("Office") for the opportunity to provide comments on the Computer-Implemented Functional Claim Limitations for Compliance with 35 U.S.C. 112 Guidance ("Guidance"). We appreciate the Office's continuing commitment to enhance quality and consistency of patent application examination, and particularly the Office's effort in the recent Guidance to achieve consistency in the application of 35 U.S.C. 112.

We applaud the Office for establishing functional claim language Guidance that promotes thorough consultation and accurate examination of the specification to determine the corresponding structure, material, or act performing the claimed function being construed under 35 U.S.C. 112. Moreover, we commend the Office for encouraging clarity of the record by directing examiners to establish the meaning of each claim term, consistent with the specification, and to expressly state in the Office action if a claim is being interpreted according to 35 U.S.C. 112(f).

As the Office recognizes, clarity of the record is a key component of improving patent quality. It is critical that the public is provided clear notice as to the metes and bounds of an invention. As Judge Giles Rich said, "**the name of the game is the claim...** [and] the function of claims is to enable everyone to know, without going through a lawsuit, what infringes the patent and what does not."<sup>1</sup>

IBM advocates for the examiner's claim construction to be explicit on the record. A clear description of the examiner's claim construction allows the examiner and applicant to work together to clarify the scope and boundaries of the applicant's invention. The members of the public and patentees should all have an interest in improving clarity of the record to define the structure and make the boundaries of a claim understandable in order to avoid the burden of unnecessary litigation or work-arounds caused by ambiguities.

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<sup>1</sup> See Rich, Giles S. "The Extent of the Protection and Interpretation of Claims—American Perspectives." 21 INT'L REV. INDUS.PROP. & COPYRIGHT L. 497, 499, 501 (1990) as quoted in *Hilton Davis Chem. Co. v. Warner-Jenkenson Co.*, 62 F. 3d 1512, 1539 (Fed. Cir. 1995) (emphasis in original).

We assert that claim construction should be addressed early in prosecution because it establishes the basis on which the rest of the examination occurs. Accordingly, it is important that the examiner initially focus on claim construction, so inextricably linked with the examiner's 35 U.S.C. 112 analysis, before determining whether the claims satisfy the other statutory requirements. IBM contends that thorough and accurate examination under 35 U.S.C. 112 to establish clear and definite claim language early in the examination will promote compact prosecution and increase the efficiency and quality of patent examination.

Further, IBM emphasizes that any time an examiner's position regarding claim construction changes, particularly if that change in position leads to a claim allowance or a withdrawal of a rejection, the change in position and the basis for that change in position should be made clear on the record. For example, if during an Examiner Interview an applicant demonstrates that a term in the claim is defined or limited in the specification, and the examiner's new understanding of the claim term renders the claim allowable, then the examiner should reflect the understood meaning of that claim term and source for the meaning in the interview summary or the next Office action.

We appreciate the Office renewing the 35 U.S.C. 112 discussion. We encourage the Office to continue to provide guidance and education to examiners on their essential role in establishing clarity of the record.

#### Conclusion

IBM commends the Office for its focus on patent quality and its efforts to improve its 35 U.S.C. 112 Guidance. Patent applications, thoroughly examined with a focus on clarity of the record, provide more certainty to the metes and bounds of resulting issued patents. This certainty drives innovation, reduces unnecessary litigation, and benefits patentees and the public alike. We thank the Office for considering our comments.

Respectfully submitted,

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