

From: Edward Sandor <ESandor@slwip.com>

Sent: Friday, March 8, 2019 5:39 PM

To: 112Guidance2019 <112Guidance2019@USPTO.GOV>

Subject: Comments on Examining Computer-Implemented Functional Claim Limitations for Compliance with 35 U.S.C. 112

Dear Director Iancu:

We thank the Office for the opportunity to comment on its most recent functional language guidance, Examining Computer-Implemented Functional Claim Limitations for Compliance with 35 U.S.C. 112, set forth at 84 FR 57.

Please find our comments attached.

Regards,

Edward J Sandor

Principal

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March 8, 2019

Via Electronic Delivery
112Guidance2019@uspto.gov.

United States Patent and Trademark Office
Mail Stop CFO
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Attn: Andrei Iancu, Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office

RE: Comments on Examining Computer-Implemented Functional Claim Limitations for Compliance with 35 U.S.C. 112

Dear Director Iancu:

Schwegman Lundberg & Woessner, P.A. (“SLW”) thanks the United States Patent and Trademark Office (“the Office”) for the opportunity to comment on its most recent functional language guidance, Examining Computer-Implemented Functional Claim Limitations for Compliance with 35 U.S.C. 112, (“the Guidance”) set forth at 84 FR 57.

We generally support the Office in its efforts, and believe the Guidance represents a step towards achieving reasonably consistent and predictable results across applications, art units, and technological fields. Given such, we request that the Office consider the following:

I. Part I, corresponding structural examples

The Guidance provides a list of examples of non-structural generic placeholders that may invoke 35 U.S.C. 112(f). *See* 84 FR at 59 (e.g., “mechanism for,” “module for,” “device for,” “unit for,” “component for,” “element for,” “member for,” “apparatus for,” “machine for,” or “system for.”). We propose that the Office similarly provide a list of examples of structural terms that have been found *not* to invoke 35 U.S.C. 112(f), such as, among others, “circuit,” “detent mechanism,” “digital detector,” “reciprocating member,” “connector assembly,” “perforation,” “sealingly connected joints,” and “eyeglass hanger member,” etc. *See* MPEP 2181(I)(A).

We understand that such examples are fact specific and should not be applied as *per se* rules, for either case. However, stakeholders are not concerned that their use of “means for” may not invoke 112(f) when intended; our concern is the contrary, that there is very little guidance to enable stakeholders to intentionally avoid invoking 112(f). The Guidance does not currently recite a single example of a structural term. We propose that the Office provide structural counterexamples to the non-structural examples to balance application of the Guidance.

II. Part II, 112(a) Written Description and *Vasudevan*

The Guidance cites to *Vasudevan* for the following statement: “It is not enough that one skilled in the art could theoretically write a program to achieve the claimed function, rather the specification itself must explain how the claimed function is achieved to demonstrate that the applicant had possession of it.” 84 FR at 62 (citing *Vasudevan Software, Inc., v. MicroStrategy, Inc.*, 782 F.3d 681 at 682–683 (Fed. Cir. 2015)). We recommend that the Office provide clarification, as the statement itself is misleading; *Vasudevan* fails to support the statement for which it is referred, and the first half of the statement goes too far, while the second half fails to temper the first.

The first half states, “It is not enough that one skilled in the art could theoretically write a program to achieve the claimed function,” when in fact that could absolutely be enough if the disclosure suggests it to one skilled in the art. The court in *Vasudevan* held as such, finding a material issue of fact existed to overturn a finding of summary judgement based on an expert conclusion that the specification showed that patentee had possession; no program was disclosed, but one skilled in the art could theoretically write one.

The second half then misstates the proper requirement, stating that “the specification itself must explain how the claimed function is achieved to demonstrate that the applicant had possession of it,” when the proper test, as stated in *Vasudevan*, is that “the disclosure of the application relied upon *reasonably conveys to those skilled in the art* that the inventor had possession of the claimed subject matter as of the filing date.” *Vasudevan*, 782 F.3d at 682 (quoting *Ariad Pharm., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1351 (Fed. Cir. 2010) (en banc) (emphasis added)).

In addition to the fact that the statement itself cannot be attributed or even arguably supported by *Vasudevan*, we further submit that *Vasudevan* is a poor case to provide guidance;

the Federal Circuit in *Vasudevan* did not find the language as satisfying the written description requirement, but held that the district court's determination of the claims as invalid for lack of written description at summary judgment was improper and a genuine issue of material fact did indeed exist.

We propose that the statement attributed to *Vasudevan* be omitted, as well as the paragraph of discussion of *Vasudevan* (beginning, "For example, in *Vasudevan*, the Federal Circuit...." 84 FR at 62.).

III. Part II, 112(a) Enablement

The Guidance provides the following statement, "A rejection for lack of enablement must be made when the specification does not enable the full scope of the claim." 84 FR at 62, col. 3. The proper requirement for rejection, as stated several paragraphs earlier, is when the specification does not "teach those skilled in the art how to make and use the full scope of the claimed invention without undue experimentation." *Id.* at col. 2. We recommend that the Office clarify such statement or omit the statement entirely.

V. Conclusion

We commend and support the Office in its efforts, and generally support the Office in its efforts, and believe the Guidance represents a step towards achieving reasonably consistent and predictable results across applications, art units, and technological fields.

Respectfully submitted,

/Steven W Lundberg/

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