

From: [Brandon R. Theiss](#)
To: [112Guidance2019](#)
Subject: Comments on Examining Computer-Implemented Functional Claim Limitations for Compliance with 35 U.S.C. 112
Date: Friday, March 8, 2019 2:36:45 PM
Attachments: [icon-contact_fc8b5c5c-ab2b-4bc9-b1b8-0b3a8fa59f1d.png](#)
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[icon-in_9644189e-35ce-489a-a602-84e73cc86cd8.png](#)
[5630597_1.pdf](#)

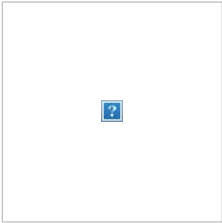
Dear Sir or Madam,

Please see the attached comments response to the request for comments titled "Examining Computer-Implemented Functional Claim Limitations for Compliance with 35 U.S.C. 112."

In addition, please confirm receipt of this email and one attachment.

Regards,

Brandon R. Theiss



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March 8, 2019

Hon. Andrei Iancu
Deputy Under Secretary of Commerce for
Intellectual Property and Deputy Director of
the United States Patent and Trademark Office
600 Dulany Street
Alexandria, VA 22313
Via e-mail: 112Guidance2019@uspto.gov

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

Dear Deputy Director Iancu:

The USPTO revised guidance for “Examining Computer-Implemented Functional Claim Limitations for Compliance with 35 U.S.C. 112” (hereinafter, “112 Guidance”) mischaracterizes and overextends the holding in *EON Corp. IP Holdings LLC v. AT&T Mobility LLC*, 785 F.3d 616 (Fed. Cir. 2015). Specifically, the 112 Guidance States “the requirement for the disclosure of an algorithm cannot be avoided by arguing that one of ordinary skill in the art is capable of writing software to convert a general purpose computer to a special purpose computer to perform the claimed function” (112 Guidance, pg. 19). In support of this statement, the 112 Guidance concludes that the Federal Circuit in *EON Corp. IP Holdings LLC* “disagree[d] [with the argument] ‘that a microprocessor can serve as sufficient structure for a software function if a person of ordinary skill in the art could implement the software function’ [and] not[ed] that ‘we have repeatedly and unequivocally rejected this argument: a person of ordinary skill in the art plays no role whatsoever in determining whether an algorithm must be disclosed as

structure for a functional claim element.”(112 Guidance, pg. 12) (internal markings omitted). However, *EON Corp. IP Holdings LLC* expressly stated that, in some circumstances, the person of ordinary skill in the art *does* play a role in determining whether the Applicant must disclose the algorithm. The 112 Guidance does not explain this limitation on the *EON Corp.* holding and, thus, is misleading.

The Federal Circuit in *EON Corp. IP Holdings LLC* specifically stated that the “case law regarding special purpose computer-implemented means-plus-functions claims is divided into two distinct groups: First, cases in which the specification discloses no algorithm; and second, cases in which the specification does disclose an algorithm but a defendant contends that disclosure is inadequate.” (*EON Corp. IP Holdings LLC*, 785 F.3d at 623-24) (internal citation omitted). The court expressly stated that only in the first case “[w]here the specification discloses no algorithm, [is] the skilled artisan's knowledge [] irrelevant.” (*Id.* at 624). However, in the second case “[w]here the specification discloses an algorithm that the accused infringer contends is inadequate, . . . the disclosure's sufficiency [is] based on the skilled artisan's perspective.”(*Id.*). Therefore, the court in *EON Corp. IP Holdings LLC* held that the person skilled in the art does have a role in assessing the adequacy of a disclosed algorithm.

In practice, the adequacy of the disclosed algorithm (the second case) is most frequently at issue before the USPTO, because the disclosure of the algorithm can be in numerous forms. For example, the Federal Circuit expressly states that the specification can “express that algorithm 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.”(*Finisar Corp. v. DirecTV Grp., Inc.*, 523 F.3d 1323, 1340 (Fed. Cir. 2008))(internal citation omitted). Accordingly, if the specification includes a flow chart showing the functionality of the algorithm, the person of



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ordinary skill in the art then plays a critical role in determining the adequacy of the disclosure.

Therefore, the 112 Guidance should be revised to reflect that the person of ordinary skill **must be** considered when the specification includes any form of flow chart or diagram of the claimed functionality as instructed by the Federal Circuit in *EON Corp. IP Holdings LLC*.

The views expressed in this letter are the personal views of the author and they do not reflect the view of any firm client or the firm.

Respectfully submitted,

By:  _____

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BRT/