Improving Clarity and Reasoning in Office Actions (ICR) Training

Excerpted from the Patent Quality Community Symposium
April 27, 2016

Initial Focus: Functional Language Invoking 35 U.S.C. 112(f)

- **35 U.S.C. 112(f): Identifying Limitations that Invoke § 112(f)**
  - Recognizing § 112(f) limitations that do not use classic “means for” phrasing
  - Interpreting “generic placeholders” that serve as substitutes for means (e.g., unit, mechanism)

- **35 U.S.C. 112(f): Making the Record Clear**
  - Clarifying the record to place remarks in the file regarding when 112(f) is, or is not, invoked
  - Establishing presumptions based on use of “means”
  - Providing explanatory remarks when presumptions are rebutted
Initial Focus: Functional Language Invoking 35 U.S.C. 112(f) (cont.)

- 35 U.S.C. 112(f): Broadest Reasonable Interpretation and Definiteness of § 112(f) Limitations
  - How to interpret § 112(f) limitations under the broadest reasonable interpretation (BRI) standard
  - Evaluating equivalents
  - Determining whether a § 112(f) limitation is definite under § 112(b)

  - Determining whether a sufficient algorithm is provided to support a software function

Reinforcing Claim Interpretation

- Broadest Reasonable Interpretation (BRI) and the Plain Meaning of Claim Terms
  - Using plain meaning unless the application uses a special definition or disclaims scope
  - Explaining claim interpretation on the record

- Examining Functional Claim Limitations: Focus on Computer/Software-related Claims
  - Detailed guidance on addressing issues unique to functional claim language when § 112(f) is not invoked
  - Clarifying the record by fully addressing functional claim language
Turning to Written Description and Enablement

- **Examining Claims for Compliance with 35 U.S.C. 112(a): Part I Written Description**
  - Focus on Electrical/Mechanical and Computer/Software-related Claims
  - Making the prosecution record clear regarding the adequacy of the application disclosure

- **Examining Claims for Compliance with 35 U.S.C. 112(a): Part II – Enablement**
  - Focus on Electrical/Mechanical and Computer/Software-related Claims
  - Determining whether the specification enables the full scope of claims with functional language

- **35 U.S.C. 112(a): Written Description Workshop**
  - Used as a companion to the 35 U.S.C. 112(a) Written Description training module
  - Reinforced the principles of the training

Utilizing 35 U.S.C. 112(b) to Clarify the Record

- **§ 112(b): Enhancing Clarity By Ensuring That Claims Are Definite Under 35 U.S.C. 112(b)**
  - Understand how enforcing the § 112(b) definiteness requirement enhances patent quality and clarity
  - Identify the critical roles of examiners and applicants in enhancing clarity of the claims and the prosecution record
  - Recognize the importance of explaining the grounds of rejection when the boundaries of the claim are unclear to provide a thorough written record
Focusing on Clarity in Subject Matter Eligibility Analysis

- **2014 Interim Guidance on Patent Subject Matter Eligibility**
  - Focus on 2014 Interim Guidance on Patent Subject Matter Eligibility issued December 16, 2014

- **Abstract Idea Example Workshops I & II**
  - Focus on identifying abstract ideas, evaluating additional elements, how to write a proper rejection, and identifying statutory subject matter

Highlighting Reasons for Allowance as a Tool for Clarity

- **Enhancing Clarity By Ensuring Clear Reasoning of Allowance Under C.F.R. 1.104(e) and MPEP 1302.14**
  - Improve the quality and reliability of issued patents by providing a complete file history
  - Facilitate the public's evaluation of a patent's scope and strength, as well as simplification of any potential patent litigation related thereto
  - Remind examiners that reasons for allowance should be provided in an application when the examiner believes that the record as a whole does not make clear his/her reasons for allowing a claim or claims
Improving Clarity and Reasoning (ICR) Training: Impacts

- After training, examiners are surveyed on the following
  - Class format
  - Course materials and/or examples
  - Length of the training

- More than 80% of those taking the survey agree that the format, materials, and length of the training was appropriate for their learning and retention

Upcoming Training Topics

- **35 U.S.C. 101: Subject Matter Eligibility Workshop III: Formulating a Subject Matter Eligibility Rejection and Evaluating the Applicant’s Response to a Subject Matter Eligibility Rejection**
  - Designed to assist examiners in applying the 2014 Interim Guidance on Patent Subject Matter Eligibility (Interim Eligibility Guidance) and the July 2015 Update: Subject Matter Eligibility
  - Focus on responding to applicant argument

- **35 U.S.C. 112(b): Interpreting Functional Language and Evaluating Claim Boundaries - Workshop**
  - Examples from each discipline
  - Focus on writing a complete explanation when the metes and bounds of certain language is unclear
  - Tips on making suggestions for resolving issues of unclear boundaries
Improving Clarity and Reasoning (ICR) Training Resources

- **Examination Guidance and Training Materials**

- **White House Executive Actions**: Executive Action 2: Clarity in Patent Claims

- **Software Partnership**
  [http://www.uspto.gov/patent/initiatives/software-partnership](http://www.uspto.gov/patent/initiatives/software-partnership)