

Improving Clarity and Reasoning in Office Actions (ICR) Training

*Excerpted from the Patent Quality Community Symposium
April 27, 2016*



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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



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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)
- ❑ **35 U.S.C. 112(f): Evaluating § 112(f) Limitations in Software-Related Claims for Definiteness under 35 U.S.C. 112(b)**
 - Determining whether a sufficient algorithm is provided to support a software function



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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



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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



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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



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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



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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



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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



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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



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Improving Clarity and Reasoning (ICR) Training Resources



- **Examination Guidance and Training Materials**
<http://www.uspto.gov/patent/laws-and-regulations/examination-policy/examination-guidance-and-training-materials>
- **White House Executive Actions:** Executive Action 2: Clarity in Patent Claims
<http://www.uspto.gov/patent/initiatives/uspto-led-executive-actions-high-tech-patent-issues>
- **Software Partnership**
<http://www.uspto.gov/patent/initiatives/software-partnership>

