

Welcome to the

# **USPTO- Combined Rocky Mountain Regional Office & Technology Center 2600 Customer Partnership Meeting.**

Tuesday July 17, 2018

**[TC2600CustomerPartnership@uspto.gov](mailto:TC2600CustomerPartnership@uspto.gov)**

UNITED STATES  
PATENT AND TRADEMARK OFFICE



# Agenda

8:15 – 8:30 am	Welcome to Denver
8:30 – 9:00 am	Presentation (35 USC 112)
9:00 – 9:20 am	Q&A
9:20 – 9:30 am	Morning Break
9:30 – 10:15 am	Presentation (35 USC 101)
10:15 – 10:45 am	Q&A
10:45 am – 12:30 pm	Lunch
12:30 - 1:45 pm	Workshop
1:45 – 2:00	Afternoon Break
2:00 – 3:00	Panel discussion / Q&A

# Welcome to Rocky Mountain Regional Office

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UNITED STATES  
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# 35 U.S.C. § 112(a) and (b)

TC 2600 Customer Partnership Meeting

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UNITED STATES  
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# Objectives

- **Overview of 112 (a)**
- **How examiners are trained to evaluate certain aspects of 35 U.S.C. 112 (a)**
- **Overview of 112 (b)**
- **How examiners are trained to evaluate certain aspects of 35 U.S.C. 112 (b)**
- **Statistical 112 data for TC 2600**
- **Additional Stakeholder Training opportunities**

# **35 USC § 112 (a)**

# 35 U.S.C. 112(a)

The specification shall contain a **written description of the invention**, and of the manner and process of making and using it, **in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains**, or with which it is most nearly connected, to make and use the same, **and shall set forth the best mode contemplated by the inventor or joint inventor of carrying out the invention.**

# Three Distinct Requirements of § 112(a)

- Written description: The specification as filed must describe the claimed invention in sufficient detail so that one of ordinary skill in the art can reasonably conclude that the **inventor had possession** of the claimed invention
- Enablement: The specification must teach those of ordinary skill in the art how to **make and use the full scope** of the claimed invention without undue experimentation
- Best mode: The specification must disclose **what the inventor considers to be the best mode** of carrying out the invention



**Determining Whether the Claims  
are Fully Supported and Enabled  
by the Application Disclosure as  
Required by 35 U.S.C §112(a)**

# Examining Claims for Compliance With the Written Description Requirement

Examination of claims for written description compliance should include:

1. **A determination as to what the claim as a whole covers**
  - Each claim is given its broadest reasonable interpretation in **light** of and **consistent** with specification (MPEP 2111)
2. **A full review of the application to understand how the applicant provides support for the claimed invention including each element and/or step**
  - This review includes comparing the claim scope with the scope of the description (MPEP 2163(II))
3. **A determination as to whether the applicant was in possession of the claimed invention by considering:**
  - The variety of ways that applicant may show possession, e.g. actual reduction to practice
  - The level of skill and knowledge in the art
  - The predictability in the art

*See MPEP 2163(II)*

# Examining Claims for Compliance With the Written Description Requirement (*cont.*)

- The written description requirement applies to all claims, including original claims
- A question of adequate written description support may arise in determining whether:
  - An original claim is described sufficiently
  - A new or amended claim finds support in the disclosure as filed
  - A claim is entitled to an earlier foreign priority/domestic benefit claim filing date
  - A claim corresponding to a count in an interference proceeding is supported by the specification

*See MPEP 2163(I) and 2163.03*

# Examining Claims for Compliance With the Written Description Requirement (*cont.*)

- There is a presumption that a specification as filed provides an adequate written description of the claimed invention
- The examiner has the initial burden of presenting by a preponderance of evidence why a person skilled in the art would not recognize in an applicant's disclosure a description of the invention defined by the claims
- In rejecting a claim as lacking written description, the examiner must set forth express findings of fact which support the lack of written description conclusion

*See MPEP 2163.04*

# Examining Claims for Compliance With the Written Description Requirement (*cont.*)

To make a *prima facie* case for a lack of written description, examiners should:

- Weigh all of the evidence of record and determine whether the claimed invention as a whole is supported by a specification that provides an adequate written description
- Identify the claim limitation(s) lacking written description
- Provide reasons why a person of skilled in the art at the time the application was filed would not have recognized that the inventor was in possession of the claimed invention in view of the disclosure (written description) as filed
- When appropriate, suggest amendments to the claims to resolve the deficiency, provided the amendments would be supported by the application as filed

*See MPEP 2163.04*

# Applicant Response: Written Description

Once a *prima facie* case of lack of written description has been established, the burden shifts to the applicant to rebut. Options for an applicant response may include, but are not limited to:

- Amendment to the claims to remove/amend limitations that are not supported by the original disclosure
- Amending (without adding new matter) and/or showing that the specification provides adequate support by pointing out where in the original disclosure support exists for the limitation(s). For example:
  - By implicit or inherent disclosure
  - By incorporation by reference
  - By correction of obvious errors and/or mere rephrasing
  - By pointing to support in the drawings
- An affidavit presenting factual evidence that the original disclosure is adequate to support the claimed invention.

*See MPEP, 2163.04, 2163.07*

# Enablement

The specification shall contain a **written description of the invention**, and of the manner and process of making and using it, **in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains**, or with which it is most nearly connected, to make and use the same, **and shall set forth the best mode contemplated by the inventor or joint inventor of carrying out the invention.**

# Examining Claims for Compliance With the Enablement Requirement

- A specification must be taken as being in compliance with the enablement requirement, unless there is a reason to doubt the objective truth of the statements therein which must be relied on for enabling support. (*MPEP 2164.04*)
- To hold that a disclosure is not enabling, the examiner must establish a reasonable basis to question the enablement provided for the claimed invention supported by evidence and/or technical reasoning substantiating that the claimed invention is not enabled (*MPEP 2164.04*)



# Examining Claims for Compliance With the Enablement Requirement (*cont.*)

The examiner must evaluate whether there is a reasonable basis to question enablement by weighing the evidence of record, and providing reasons why undue experimentation would be needed to make and use the claimed invention

Factors to be weighed when evaluating whether a disclosure satisfies the enablement requirement and whether any necessary experimentation is “undue” (*i.e.*, “Wands” factors):

- Breadth of the claims;
- Nature of the invention;
- State of the prior art;
- Level of one of ordinary skill;
- Level of predictability in the art;
- Amount of direction provided by the inventor;
- Existence of working examples; and
- Quantity of experimentation needed to make or use the invention based on the content of the disclosure

*See MPEP 2164.01(a)*

# Examining Claims for Compliance With the Enablement Requirement (*cont.*)

- When the specification fails to enable the full scope of a claim, a rejection of the claim under § 112(a) is appropriate
- Burden is on the examiner to set forth a *prima facie* case providing reasons why the specification is deficient and the claim that relies thereon is rejected
  - Specifically identify the claim(s) and limitation(s) at issue
  - Weigh evidence of record related to the pertinent *Wands* factors and provide reasons why undue experimentation would be needed to make and use the claimed invention
  - The explanation of the rejection need only focus on those factors, reasons, and evidence that lead the examiner to conclude *e.g.*, that the specification fails to teach how to make and use the claimed invention without undue experimentation, or that the scope of any enablement provided to one skilled in the art is not commensurate with the scope of protection sought by the claims

*See MPEP 2164.04*

# Applicant Response: Enablement

Once a *prima facie* case of lack of enablement has been established, the burden shifts to the applicant to rebut. Options for an applicant response may include, but are not limited to:

- Amendment to the claims to remove/amend limitations that are not enabled
- Showing that the specification enables one of ordinary skill in the art how to make and use the claimed invention by pointing out where in the specification enabling disclosure exists.
  - By implicit or inherent disclosure
  - By incorporation by reference
  - By pointing to enabling disclosure in the drawings
- An affidavit presenting factual evidence that the disclosure is adequate to enable one of ordinary skill in the art to make and use the claimed invention.

*See MPEP, 2164.05, 2164.06(c)(III) and 716.09*

# Written Description vs. Enablement

Written description and enablement are separate and distinct requirements

- Some similar or overlapping analytical considerations
  - Evaluated from the perspective of a person of ordinary skill in the art
  - Not required to disclose information which is conventional/well know in the art
  - Predictability of the art
- Different Ends (Possession vs. Undue Experimentation)
  - Written description requires applicant to describe the claimed invention in sufficient detail so that one of ordinary skill in the art can reasonably conclude that applicant had **possession** of the claimed invention
  - Enablement requires applicant to convey sufficient information to one of ordinary skill in the art to make and use the claimed invention without **undue experimentation**

*See MPEP 2161, 2163(ll)(A)(3)(a), 2163.02, 2164.01*

## Knowledge Check A

Which of the following would not be considered a proper response from applicant to a 35 USC 112(a) written description rejection?

- a) A response which points out why the rejected claims are enabled.
- b) Amendment to the rejected claims to remove/amend limitations lacking support.
- c) A showing that the specification provides adequate support by pointing out where in the written disclosure or drawings the support exists.
- d) An affidavit presenting factual evidence that the disclosure is adequate to support the full scope of the claims.

## Knowledge Check A: Answer

The correct answer is **A**. The written description requirement is separate and distinct from the enablement requirement. Showing that a claimed invention is fully enabled by the disclosure does not necessarily satisfy the written description requirement of showing that the inventor had possession of the claimed invention.

# **Determining whether Claims are Definite under 35 U.S.C. § 112(b)**

# **35 U.S.C. 112(b)**

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the inventor or a joint inventor regards as the invention



# The Definiteness Requirement

- The statute requires that the claims must particularly point out and distinctly claim the subject matter which the inventor or a joint inventor regards as the invention, i.e., the claims must clearly define the boundaries of the invention
- The definiteness of claim language must be analyzed, not in a vacuum, but in light of:
  - The content of the particular application disclosure,
  - The teachings of the prior art, and
  - The claim interpretation that would be given by one of ordinary skill in the art at the time the invention was made

# Breadth is Not Indefiniteness

Breadth of a claim is not to be equated with indefiniteness. Concerns of breadth are addressed under different statutory requirements

- A claim that is broad because it reads on the prior art should be rejected under §§ 102 and/or 103
- A claim that is broad because it is not described in, or enabled by the disclosure, should be rejected under § 112(a)
- A claim that is broad because it is not clear what the claim covers and what it does not cover (unclear claim boundaries) should be rejected as indefinite under § 112(b)

*MPEP §2173.04*

# Reviewing Claims for Compliance with 35 U.S.C. §112(b)

- In reviewing a claim for compliance with 35 U.S.C. §112(b), the examiner must consider the claim as a whole to determine whether the claim apprises one of ordinary skill in the art of its scope
  - If the language of the claim is such that a person of ordinary skill in the art could not interpret the metes and bounds of the claim so as to understand how to avoid infringement, a rejection under 35 U.S.C. §112(b) would be appropriate
  - However, if the language used by the applicant satisfies the statutory requirements of 35 U.S.C. §112(b), and the examiner merely wants the applicant to improve the clarity or precision of the language used, the claim must **not** be rejected under 35 U.S.C. §112(b)

*See MPEP §2173.02 (II)*

# Resolving Indefinite Claim Language

- Examiner must identify the specific claim language that is indefinite, and explain why that language renders the boundaries of the claim unclear
  - Enough information must be provided to enable applicant to make a meaningful response
  - Provide an explanation regarding claim construction when needed to assist in clarifying position
- Whenever practicable, the examiner should indicate how the issues may be resolved, e.g., by suggesting amendments to the claims that resolve the issues

See MPEP §2173.02 III

# The Role of Examiners

Examiners have a duty to enforce § 112(b) by requiring that claim language clearly defines the boundaries of the claim scope. MPEP §2173.02 (III)

- When claim language has unclear boundaries, a rejection explaining why the claim is indefinite is appropriate.
- Such a rejection shifts the burden of clarifying the boundaries of claimed protection to the applicant, who is best suited to explain what has been invented.

*See MPEP §§ 2173.02 and 2173.02 (III) B*

# The Role of Applicants

- Applicants must satisfy §112 (b) by ensuring that the claim language clearly defines the boundaries of the claim scope sought
  - During prosecution, applicant has an opportunity and a duty to amend ambiguous claims to clearly and precisely define the metes and bounds of the claimed invention.
- It is highly desirable that applicants resolve ambiguity during examination of the application when it can be amended rather than resolving ambiguity in litigation

See MPEP §2173.02

# Applicant's Reply

- In response to a rejection for indefiniteness, applicant can:
  - explain why the language is definite, and/or
  - amend the claim to resolve the indefiniteness
- An interview may also assist in resolving issues of clarity and interpretation of claim scope
- Applicant's reply, along with the examiner's written explanation or interview summary, will provide a clear record of how the claim boundaries were defined prior to issuance

# Responding to Applicant's Reply

- When applicant's reply resolves the issue, it is a "best practice" to indicate on the record that the issue has been resolved and how it was resolved, if the record is not already clear
  - For example, if applicant argues that a certain term is definite and also amends the claim, indicate which resolved the issue
  - If the next action is a notice of allowance, reasons for allowance can include such an indication
  - If the issue was resolved during an interview, indicate such on an interview summary record
- Providing such an indication enhances the clarity of the prosecution record



## Knowledge Check B

Which of the following is the primary purpose of determining whether claim language complies with 35 U.S.C. §112(b)?

- A. To ensure the enabling disclosure of a specification is commensurate in scope with the subject matter encompassed by a claim
- B. To ensure that the scope of the claims is clear so that the public is informed of the boundaries of what constitutes infringement

## Knowledge Check B: Answer

The answer is **B**. If the language of the claim does not provide clear notice of what is claimed, the claim is indefinite and should be rejected under 35 U.S.C. §112(b).

Answer A is not correct, because concerns about whether the disclosure is commensurate in scope with the claimed invention are addressed by 35 U.S.C. §112(a).

*See MPEP §2173.02*

## 35 U.S.C. §112(b): Special Topics

- Topics addressed in *MPEP* §2173.05 (a) – (v):
  - New Terminology
  - Relative Terminology
  - Numerical Ranges and Amounts
  - Exemplary Language
  - Lack of Antecedent Basis
  - References to Limitations in Other Claims
  - Functional Limitations
  - Alternative Limitations
  - Negative Limitations
  - Product-By-Process or Product and Process
  - “Use” Claims
  - Trademarks or Trade Names in a Claim

# Lack of Antecedent Basis

- An indefiniteness rejection is appropriate if the lack of antecedent basis makes the claim unclear as to whether applicant is further limiting a claim limitation or introducing a new claim limitation
- For example, indefiniteness may result from a lack of antecedent basis if:
  - Reference to “said lever” without any previous recitation of any lever
  - Two different levers recited followed by the “said lever”
  - Reciting “a lever” followed by “said aluminum lever”
- Inherent components of recited elements have antecedent basis in the recitation of the component itself:
  - “the outer surface of said sphere” does not require antecedent recitation of “outer surface” which is inherent to any sphere

*See MPEP §2173.05(e)*

# Lack of Antecedent Basis (*cont.*)

- The failure to provide explicit antecedent basis for terms does not always render a claim indefinite. If the scope of a claim would be reasonably ascertainable by those skilled in the art then the claim is not indefinite. MPEP §2173.05(e)
- The Examiner should suggest corrections to antecedent problems. MPEP 2173.05(e) I
- A claim term which has no antecedent basis in the disclosure is not necessarily indefinite. MPEP 2173.05(e) II
- A claim is not *per se* indefinite if the body of the claim recites additional elements which do not appear in the preamble. MPEP 2173.05(e) III

## 35 U.S.C. § 112(f) in Relation to §§ 112(a) and (b)

- § 112(f) 3-Prong Analysis for “Means Type” Claim Limitations
  - A claim limitation should be interpreted according to §112(f) if it meets the following 3-prong analysis:
    - A. The claim limitation uses the term “means” or a term used as a substitute for “means” that is a generic placeholder (also called a nonce term or a non-structural term having no specific structural meaning) for performing the claimed function;
    - B. The term “means” or the generic placeholder is modified by functional language, typically, but not always, linked by the transition word “for” (e.g., “means for”) or another linking word or phrase, such as “configured to” or “so that”; and
    - C. The term “means” or the generic placeholder is not modified by sufficient structure or material for performing the claimed function
- The BRI of a claim limitation that is interpreted according to § 112(f) is limited to the structure, material or acts (and equivalents thereof) identified in the specification as performing the claimed function

## 35 U.S.C. § 112(f) in Relation to §§ 112(a) and (b) (cont.)

- A § 112(f) claim limitation may be indefinite under § 112(b) when:
  - Description of the corresponding structure for a § 112(f) limitation is not provided
  - Description of the structure for a § 112(f) limitation is not sufficient to perform the entire claimed function
  - No association between the structure and the claimed function corresponding to a § 112(f) limitation can be found in the specification
  - The examiner performs the 3-prong test to determine whether a limitation should be interpreted under § 112(f) and cannot come to a conclusion (should be rare)
- If a § 112(f) claim limitation is indefinite, consider § 112(a) rejections for:
  - Lack of adequate written description if the specification does not describe the claimed invention in sufficient detail that one of ordinary skill in the art can reasonably conclude that the inventor had possession of the claimed invention
  - Lack of an enabling disclosure if one of ordinary skill in the art would not know how to make and use the claimed invention without undue experimentation due to inadequate description of elements to perform the function

# **Historical use of 112 (a) and (b)**

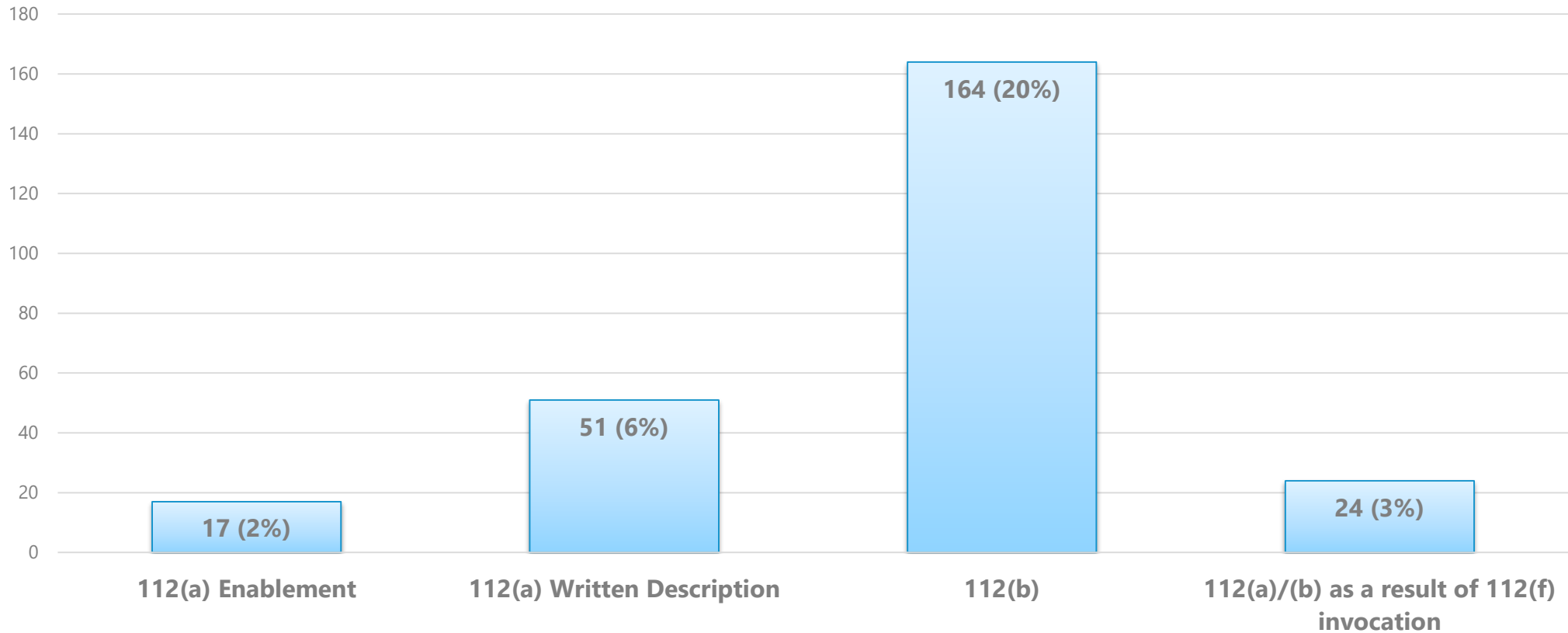


# TC 2600 35 U.S.C. 112 Analysis

- Office of Patent Quality Assurance (OPQA) routinely performs random quality reviews on applications produced by examiners.
- OPQA reviewed 833 random applications produced by TC 2600 examiners during the first half of Fiscal Year 2018
- The above applications included Non-Final Rejections and Final Rejections
- TC 2600 performed a 112 trends analysis on these applications.

# TC 2600 35 U.S.C. 112 Analysis (Cont'd)

112 Trends - TC 2600 - First Half of FY'18



■ # of Cases Containing 112 Rejection of the 833 Total Cases Sampled

# TC 2600 35 U.S.C. 112 Analysis (Cont'd)

- 112(a) - Lack of Enablement
  - 2 Percent of Non-Finals/Finals randomly sampled contained a Lack of Enablement Rejection
  - Problem
    - Claim language is more specific than the provided disclosure.
    - Ranges claimed are either too broad or open ended as compared to the disclosure.
  - Solution
    - Ensure claim scope is commensurate with the disclosed invention.

# TC 2600 35 U.S.C. 112 Analysis (Cont'd)

- 112(a) – Lack of Written Description
  - 6 Percent of Non-Finals/Finals randomly sampled contained a Lack of Written Description Rejection
  - Problem
    - When attempting to amend a claim to overcome the applied prior art, the claim amendments contain more detail than originally disclosed in the specification (New Matter).
  - Solution
    - Be specific as to where to find support in the specification for the amended claim limitations.

# TC 2600 35 U.S.C. 112 Analysis (Cont'd)

- 112(b) – Vague and Indefinite
  - 20 Percent of Non-Finals/Finals randomly sampled contained a Vague and Indefinite Rejection.
  - Problem
    - Over half of the 112(b) rejections made related to insufficient antecedent basis in the claims (failure to clearly refer back to a previous limitation).
    - Using relative/subjective terms (e.g. "like", "optimized", "preferably")
  - Solution
    - Proof-read for grammatical antecedent basis of "a", "the", "an" or "said" when drafting new or amended claims.
    - Refer to a previous limitation including the entire phrase which was previously cited.
    - Avoid the use of relative or subjective terms

# TC 2600 35 U.S.C. 112 Analysis (Cont'd)

- 112(a)/(b) as a result of invoking 112(f)
  - 3 Percent of Non-Finals/Finals randomly sampled contained a 112(a)/(b) rejection due to the examiner invoking 112(f)
  - Problem
    - In all instances, a generic placeholder (nonce word) triggered the 112(f) analysis, which resulted in the examiner consulting the specification for the corresponding structural support.
  - Solution
    - Carefully review claim language and amend, as necessary, to avoid unintended 112(f) invocation.

# **Additional Stakeholder Training**

# Stakeholder Training on Examination Practice and Procedure (STEPP) Program

The STEPP program is an important part of the USPTO's mission to deliver intellectual property information and education to external stakeholders and is designed to provide external stakeholders with a better understanding of how, and why, an examiner makes decisions while examining a patent application.



# STEPP Program Overview

- **Courses are led by USPTO trainers and based on material developed for training USPTO employees.**
- **Two different course formats in FY 2018:**
  - 3-Day in-person training on introductory patent examination practice and procedure in a workshop setting derived from training delivered to new USPTO examiners
  - Virtual instructor-led training (VILT) to “hop” through one or more focused topics related to examination practice and procedure derived from recent training delivered to experienced USPTO examiners
- **Courses provided are free to attend.**
- **CLE credit may be available for a STEPP course; however, CLE accreditation will generally only be applied for in the state the course is delivered from.**

# STEPP Evaluation Comments

"Truly groundbreaking excellent program. I wish it can be accessible by a lot more people and continue for a long time!"

"One of the best patent examination related training available to non-Examiner - maybe the best!"

"Great program, high quality training course. Thanks so much for all your hard work to put it together. Plan to enroll in VILT offerings in the future as well as other courses."

# Interested In Attending?

- If you are interested in attending STEPP training, review the course descriptions and sign up [online](https://www.uspto.gov/patent/initiatives/stakeholder-training-examination-practice-and-procedure-stepp#step1) (<https://www.uspto.gov/patent/initiatives/stakeholder-training-examination-practice-and-procedure-stepp#step1>)
- If you have questions or would like more information on the STEPP program, please contact us at [\*\*STEPPTraining@uspto.gov\*\*](mailto:STEPPTraining@uspto.gov)

# Summary

You should now be more familiar with the following:

- How examiners are trained to evaluate 35 U.S.C. 112 (a) and (b)
- What actions taken by examiners you may see based upon these statutory sections
- Additional Stakeholder Training

# Questions?

Thank You!



**Morning Break** – Resume at 10:00am

# **Subject Matter Eligibility: Well-Understood, Routine, Conventional Activity**

July 2018

[TC2600CustomerPartnership@uspto.gov](mailto:TC2600CustomerPartnership@uspto.gov)

UNITED STATES  
PATENT AND TRADEMARK OFFICE



# New Memorandum to the Examining Corps

*Changes in Examination Procedure Pertaining to Subject Matter Eligibility, Recent Subject Matter Eligibility Decision (Berkheimer v. HP, Inc.) 4/19/18*

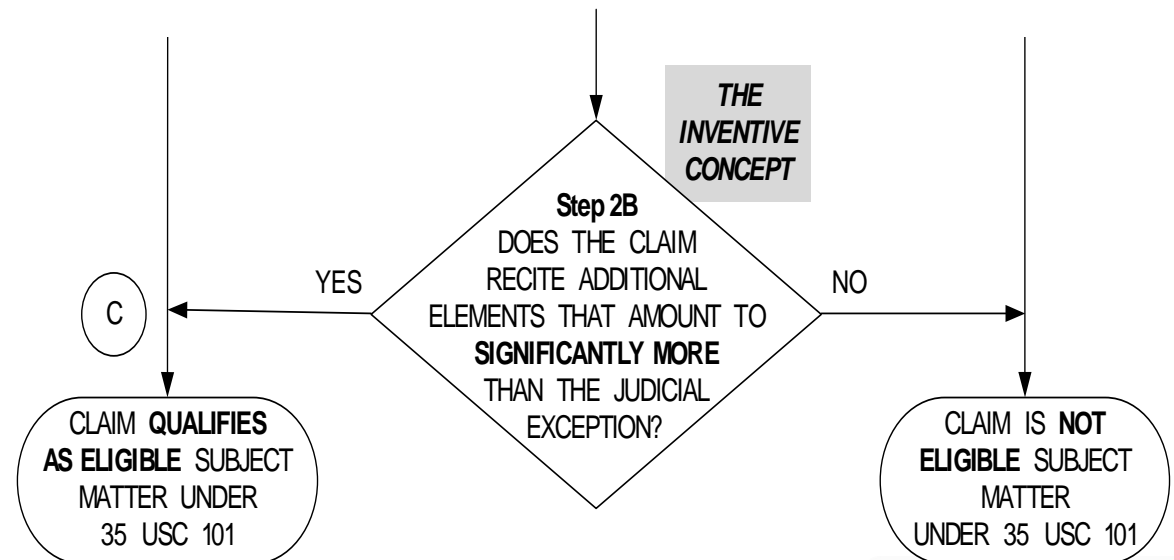
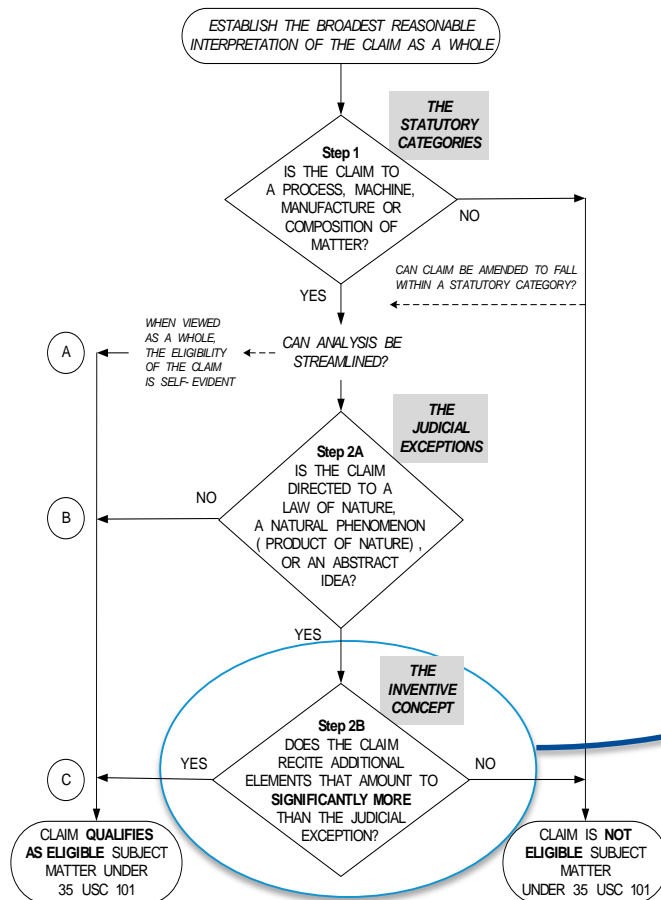
- No change to basic subject matter eligibility framework, but clarifies how to determine whether an additional element (or combination of additional elements) represents well-understood, routine, conventional activity in Step 2B
  - An examiner should conclude that an element (or combination of elements) is well-understood, routine, conventional activity **only** when the examiner can readily conclude that the element(s) is widely prevalent or in common use in the relevant industry, as explained in MPEP § 2106.05(d)(I)
  - **NEW:** Conclusion must be based upon factual determinations





# Eligibility Flowchart

- Claims that do not recite a judicial exception or that are directed to an improvement in technology are eligible at Step 2A
- Claims that are directed to a judicial exception must be analyzed under Step 2B to look for an “inventive concept” in the additional elements



# Eligibility Framework MPEP 2106

- Step 1: The Four Categories of Statutory Subject Matter *MPEP 2106.03*
- Step 2A: Whether a Claim is Directed to a Judicial Exception *MPEP 2106.04*
- Step 2B: Whether a Claim Amounts to Significantly More *MPEP 2106.05*
  - 2106.05(a)-Improvements to the Functioning of a Computer or To Any Other Technology or Technical Field
  - 2106.05(b)-Particular Machine
  - 2106.05(c)-Particular Transformation
  - 2106.05(d)-Well-Understood, Routine, Conventional Activity
  - 2106.05(e)-Other Meaningful Limitations
  - 2106.05(f)-Mere Instructions To Apply An Exception
  - 2106.05(g)-Insignificant Extra-Solution Activity
  - 2106.05(h)-Field of Use and Technological Environment

# Limitations that the courts have found to qualify as “significantly more”

- Improvements to the functioning of a computer *MPEP 2106.05(a)*;
- Improvements to any other technology or technical field *MPEP 2106.05(a)*;
- Applying the judicial exception with, or by use of, a particular machine *MPEP 2106.05(b)*;
- Effecting a transformation or reduction of a particular article to a different state or thing *MPEP 2106.05(c)*;
- Adding a specific limitation other than what is well-understood, routine, conventional activity in the field, or adding unconventional steps that confine the claim to a particular useful application *MPEP 2106.05(d)*; or
- Other meaningful limitations beyond generally linking the use of the judicial exception to a particular technological environment *MPEP 2106.05(e)*.

# Limitations that the courts have found not to be enough to qualify as “significantly more”

- Adding the words “apply it” (or an equivalent) with the judicial exception, or mere instructions to implement an abstract idea on a computer *MPEP 2106.05(f)*;
- Simply appending well-understood, routine, conventional activities previously known to the industry, specified at a high level of generality, to the judicial exception *MPEP 2106.05(d)*;
- Adding insignificant extra-solution activity to the judicial exception *MPEP 2106.05(g)*; or
- Generally linking the use of the judicial exception to a particular technological environment or field of use *MPEP 2106.05(h)*.

# Well-Understood, Routine, Conventional Activity

- If the element is not widely prevalent or in common use, it should **not** be considered to be a well-understood, routine, conventional element
- The question of whether additional elements represent well-understood, routine, conventional activity is **distinct from patentability** over the prior art under 35 U.S.C. §§ 102 and 103
  - Obviousness or lack of novelty does not establish that the additional elements are well-understood, routine, conventional activities or elements to those in the relevant field. *See* MPEP 2106.05.

# Revised Examination Procedure in view of *Berkheimer*

- ***Formulating Rejections***: In a step 2B analysis, an additional element (or combination of elements) is not well-understood, routine or conventional unless the examiner finds, and expressly supports a rejection in writing with, one or more of the following four options

# Option 1 – Statement(s) by Applicant

- An explanation based on an express statement in the specification (*e.g.*, citation to a relevant portion of the specification) that demonstrates the well-understood, routine, conventional nature of the additional element(s)
  - A specification demonstrates the well-understood, routine, conventional nature of additional elements when it describes the additional element(s) as conventional (or an equivalent term); as a commercially available product; or, in a way that shows the element is widely prevalent or in common use;

or

- A statement made by an applicant during prosecution, that demonstrates the well-understood, routine, conventional nature of the additional element(s)

## Option 2 – Court Decisions in MPEP § 2106.05(d)(II)

- A citation to one or more of the court decisions discussed in MPEP § 2106.05(d)(II) as noting the well-understood, routine, conventional nature of the additional element(s)
  - The additional element in the claim must be the same as the element addressed in the court case
  - Citation should be limited to the list of cases in the MPEP



# Option 3 – Publication(s)

- A citation to a publication (*e.g.*, book, manual, review article) that demonstrates the well-understood, routine, conventional nature of the additional element(s)
  - An appropriate publication can include a book, manual, review article, or other source that describes the state of the art and discusses what is well-known and in common use in the relevant industry
    - Does not include all items that might otherwise qualify as a “printed publication” under § 102
    - Merely finding the additional element in a single patent or published application would not be sufficient to demonstrate that the additional element is well-understood, routine, conventional, *unless* the patent or published application demonstrates that the additional element is widely prevalent or in common use in the relevant field



# Publication Requirements

- Publication must:
  - Be dated on or before the effective filing date of the application, or
  - Establish that the well-understood, routine, conventional nature of the activity is on or before the effective filing date of the application
- Identify the publication in the Office action and on a PTO-892
  - *Practice Tip:* Check patents, PGPubs, and non-patent literature cited by applicant or found in the prior art search first as they will often discuss the state of the art – there should be no need for a separate search

# Option 4 – Official Notice

- A statement that the examiner is taking official notice of the well-understood, routine, conventional nature of the additional element(s)
  - Used **only** when the examiner is certain, based upon his or her personal knowledge, that the additional element(s) represents well-understood, routine, conventional activity engaged in by those in the relevant art, in that the additional elements are widely prevalent or in common use
  - MPEP § 2144.03 discusses taking official notice in the context of making a rejection under 35 U.S.C. § 103
  - If the additional element(s) is well-known, a best practice is to provide a publication before resorting to official notice

# Official Notice Practice Reminders

- Should be used only where facts asserted to be well-known, or to be common knowledge in the art, are capable of instant and unquestionable demonstration as being well-known
  - Must provide specific factual findings predicated on sound technical and scientific reasoning to support the conclusion of common knowledge
  - Identify which element is subject to notice and explicitly explain the basis on which the notice is taken so that the applicant can adequately traverse the finding in the next reply
  - Should be rare when an application is under final rejection
- When properly traversed by the applicant, examiner must provide documentary support
  - Options 1-3 above; or
  - An affidavit or declaration must be provided setting forth specific factual statements and explanation to support the finding. See [37 CFR 1.104\(d\)\(2\)](#)

# ***Reminder: Consider Additional Elements Individually and in Combination***

- Additional elements must be evaluated individually and in combination to determine whether a claim includes significantly more than a judicial exception
- Must also consider the combination of elements
  - To support a rejection of a claim where the examiner takes the position that additional elements A and B are routine, the combination of A and B must be shown to represent well-understood, routine, conventional activity in the pertinent art

# Evaluating Applicant's Response

- If an applicant challenges the examiner's position that the additional element(s) is well-understood, routine, conventional activity by providing arguments and/or evidence:
  - Reevaluate whether it is readily apparent that the additional elements are in actuality well-understood, routine, conventional activities to those who work in the relevant field, and
  - If it is appropriate to maintain the rejection, specifically respond to the arguments and/or evidence as normal in accordance with MPEP 707.07(f)

# Evaluating Applicant's Response to Official Notice

- If the examiner has taken official notice and the applicant properly challenges the examiner's position by specifically pointing out the supposed errors and stating why the noticed fact is not considered common knowledge or well-known in the art
  - Reevaluate whether it is readily apparent that the additional elements are in actuality well-understood, routine, conventional activities to those who work in the relevant field, and
  - Provide one of the items in Options 1-3, or an affidavit or declaration under 37 CFR 1.104(d)(2) setting forth specific factual statements and an explanation that supports the position

# Finality and Applications in Process

- If the examiner cites to a new publication that was not previously of record in response to an argument by applicant, the next Office action may not be made final (except as discussed below)
- If the examiner responds to applicant's argument by relying upon applicant's own specification, a statement made by applicant during prosecution, or prior art already of record, or relies upon a court decision discussed in MPEP § 2106.05(d)(II), it may be appropriate to make the next action final
  - In addition, if the examiner cites a publication to rebut a challenge of official notice and that publication supports the facts taken as official notice, it may be appropriate to make the next action final



# Resources

- MPEP 2106 *et seq* for subject matter eligibility
- Section 101 microsite:  
<https://www.uspto.gov/patent/laws-and-regulations/examination-policy/subject-matter-eligibility>
- TC POC or SPE

# Questions?



**Lunch – Resume at 12:30**

# Workshop Sessions

112 (a) Written Description and Enablement

**[TC2600CustomerPartnership@uspto.gov](mailto:TC2600CustomerPartnership@uspto.gov)**

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# **Workshop: 112 (a)**

## **Written Description/Enablement**

### **Materials**

- Handouts
  - Portions of a provisional application
  - Portions of a non-provisional application
  - Original Claims
    - Questions about original claims
  - Amended Claims
    - Questions about amended claims

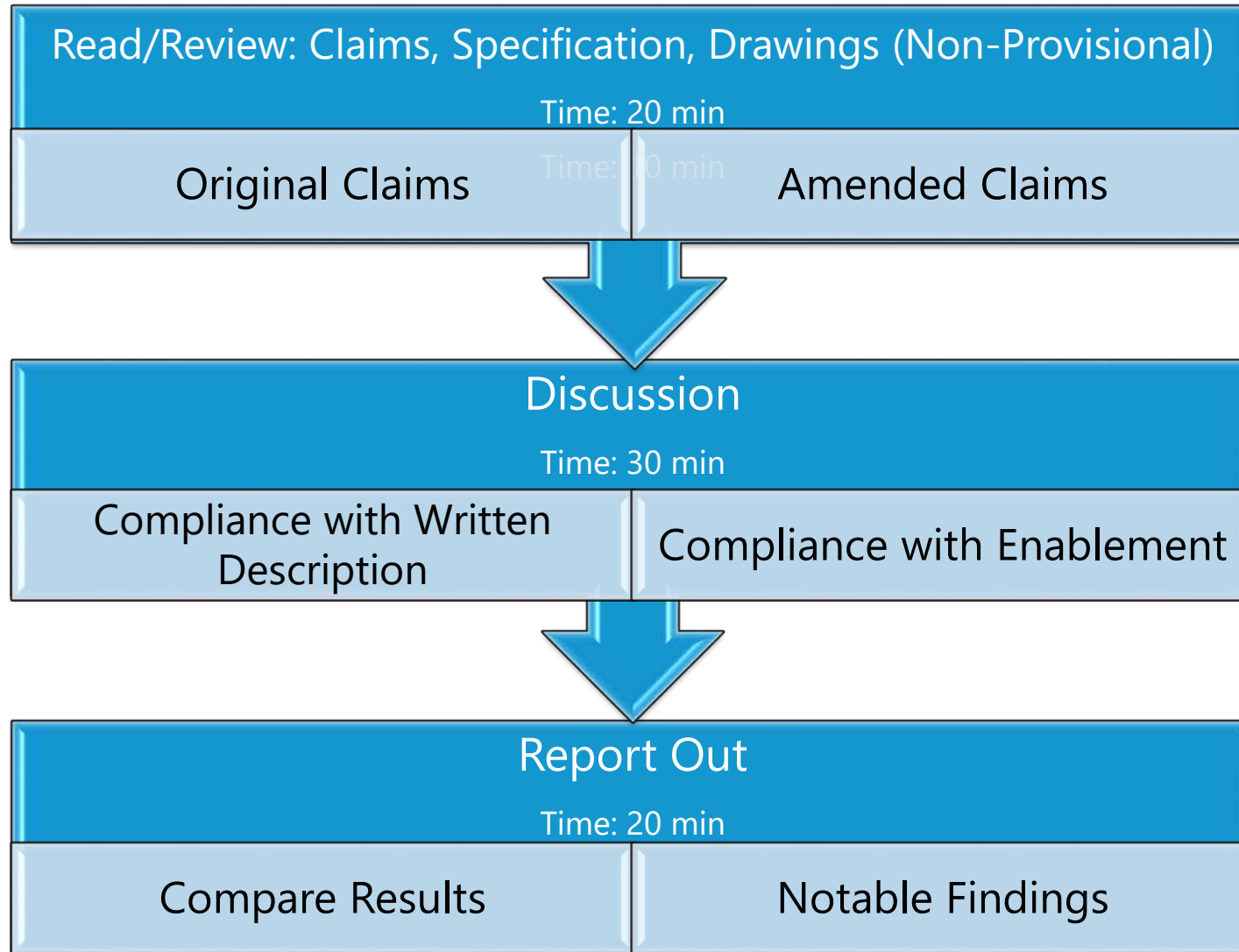
# **Workshop: 112 (a) Written Description/Enablement**

## **Put on your examiner hats!**

- Examine the original and amended claims for compliance with 112 (a) (Written Description /Enablement) using the non-provisional disclosure provided.
- The goal of this workshop is to generate discussion surrounding 112 (a)

# Workshop: Workshop: 112 (a)

## Written Description/Enablement (cont.)



# ORIGINAL CLAIMS

1. An information processing device for performing image recognition in accordance with a desired image detection rate comprising:
  - a capturing unit for capturing an image of an object;
  - an analyzing unit for analyzing pixel values of the captured image;
  - a determining unit for determining that the captured image includes a predetermined object image when the image includes predetermined pixel values corresponding to the predetermined object image; and
  - a transmitting unit for, when the image is determined to include the predetermined object, wirelessly transmitting a signal to a terminal to unlock a secured access point for a user associated with the predetermined object.
2. The information processing device of claim 1, wherein the information processing device obtains an image detection rate of at least 90% accuracy.
3. (Original) The information processing device of claim 2, further comprising a filter that prepares the captured digital image data for the analyzing unit.



# ANALYSIS – ORIGINAL CLAIMS

For each of the claims:

3. Analyze whether each of the claim limitations has adequate written description support in the **non-provisional** application, and

4. Identify which features are unsupported if support is lacking.

*(Questions 1 and 2 relate to 112 (f) and the provisional disclosure which are not to be considered during this workshop)*

# Report Out Questions

## Original Claims

1. Which limitations, if any, lacked written description support?
2. Which limitations, if any, were not enabled in the description of the non-provisional application?
3. If there were claim limitations that lacked support, what made the Specification deficient?

# AMENDED CLAIMS

1. (Amended) An information processing device for performing image recognition in accordance with a desired image detection rate comprising:

a capturing unit for capturing an image of an object;

an analyzing unit for analyzing pixel values of the captured image, **wherein the analyzing unit comprises a central processing unit having a memory with instructions stored therein for causing the central processing unit to analyze the pixel values of the captured image;**

a determining unit for determining that the captured image includes a predetermined object image when the image includes predetermined pixel values corresponding to the predetermined object image; and

a transmitting unit for, when the image is determined to include the predetermined object, wirelessly transmitting a signal to a terminal to unlock a secured access point for a user associated with the predetermined object.

2. (Amended) The information processing device of claim 1, wherein **the instructions stored in the memory cause the central processing unit to analyze the pixel values of the captured image according to adjacent pixel intensity difference quantization (APIDQ) histogram resulting in** the information processing device obtains an image detection rate of **[[at least]]** 90% **up to about 95%** accuracy.

3. (Amended) The information processing device of claim 2, further comprising a **Gaussian high pass** filter that prepares the captured digital image data for the analyzing unit.

# ANALYSIS –AMENDED CLAIMS

For each of the claims:

3. Analyze whether each of the claim limitations has adequate written description support in the **non-provisional** application, and

4. Identify which features are unsupported if support is lacking.

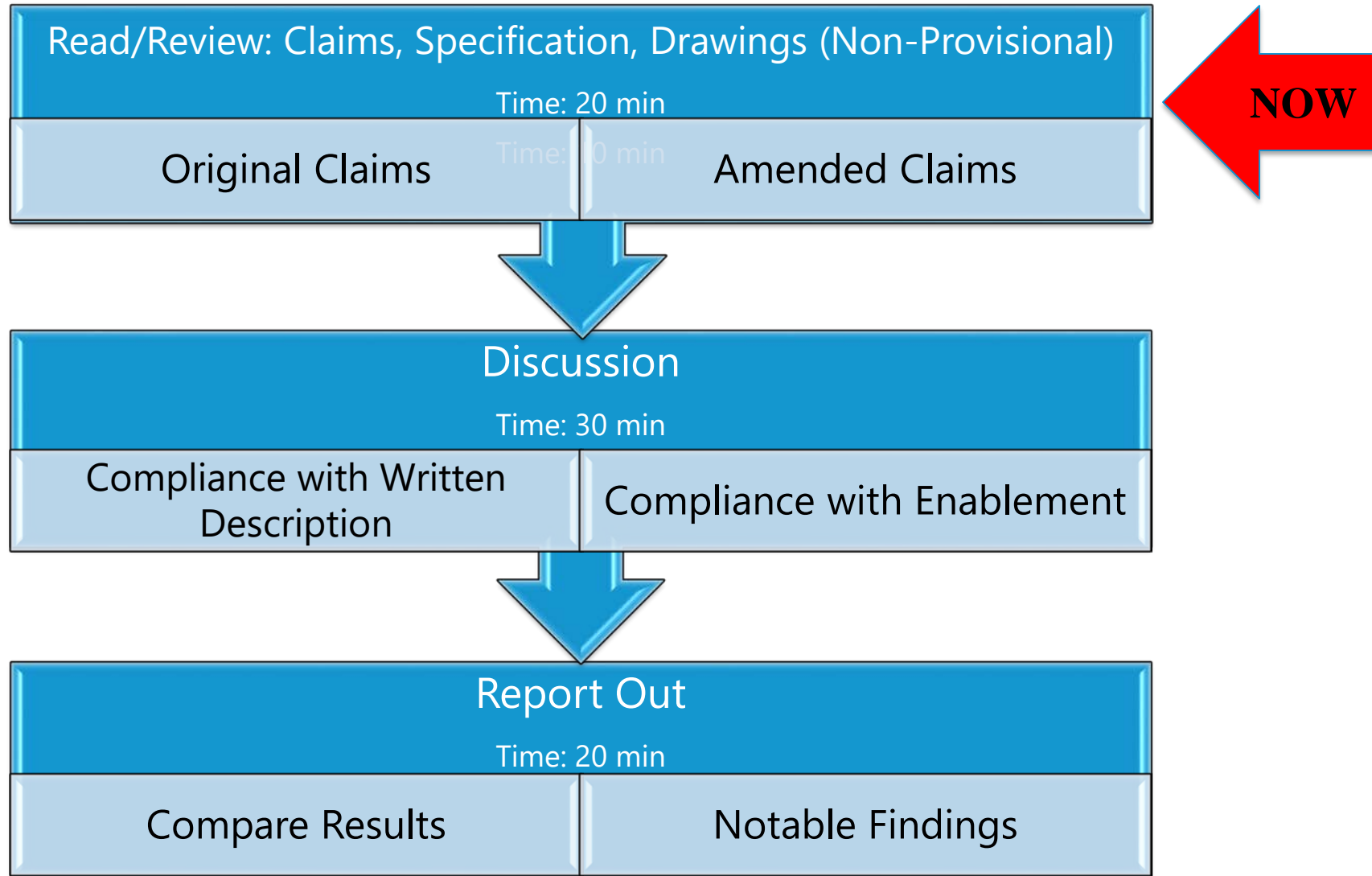
*(Questions 1 and 2 relate to 112 (f) and the provisional disclosure which are not be considered during this workshop)*

# Report Out Questions

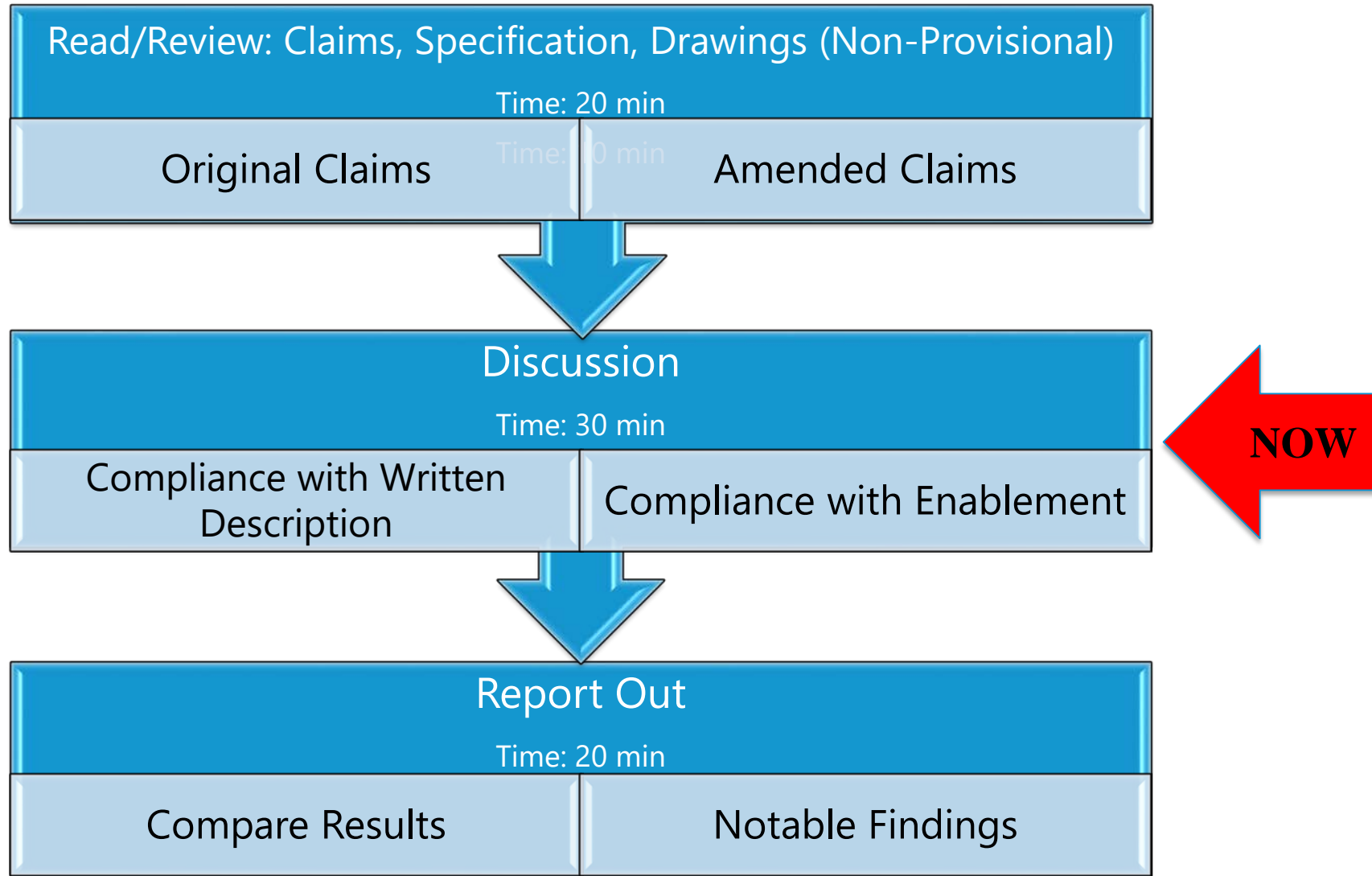
## Amended Claims

1. Which limitations, if any, lacked written description support?
2. Which limitations, if any, were not enabled in the description of the non-provisional application?
3. If there were claim limitations that lacked support, what made the Specification deficient?

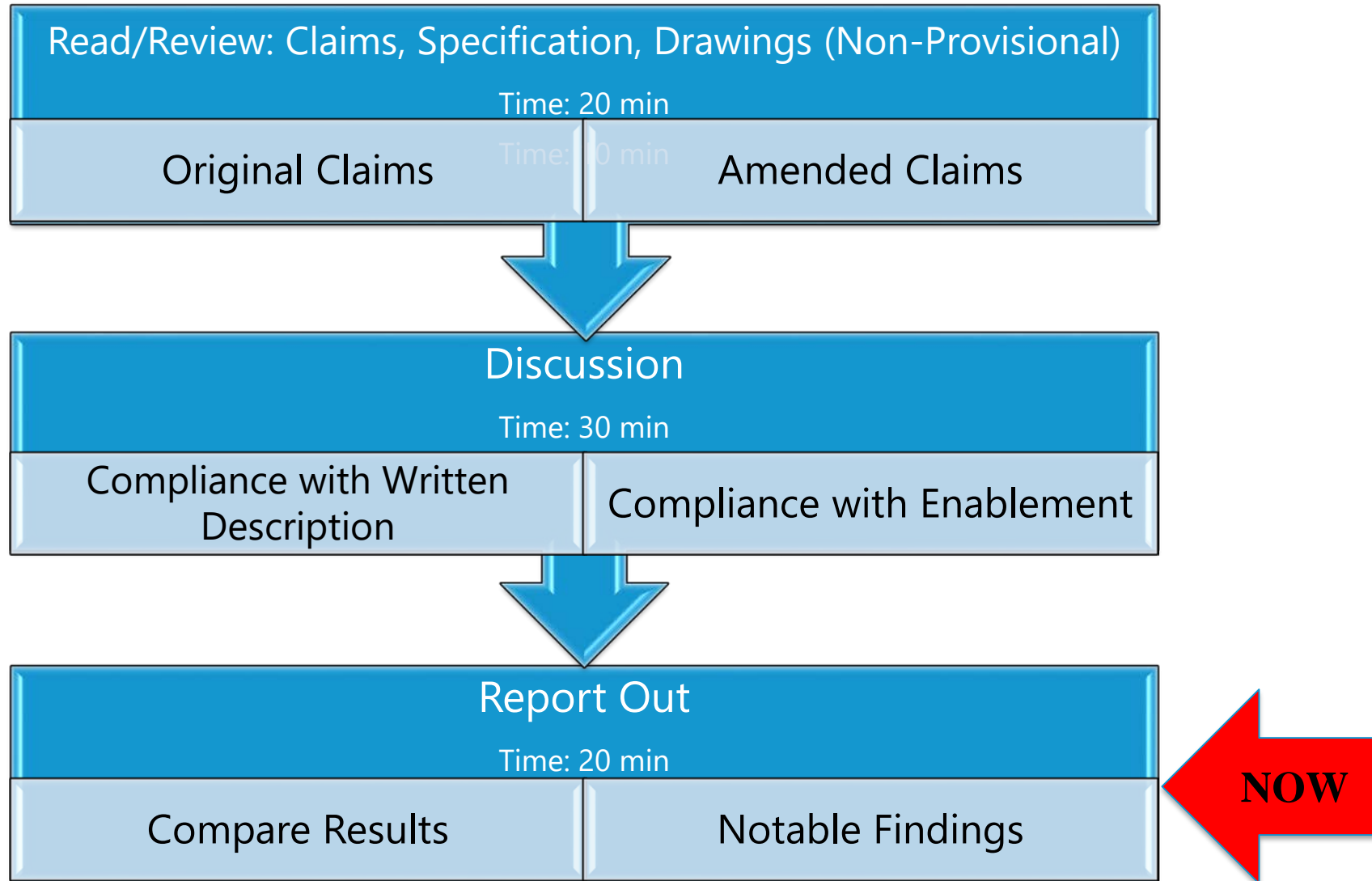
# Workshop: Workshop: 112 (a) Written Description/Enablement (cont.)



# Workshop: Workshop: 112 (a) Written Description/Enablement (cont.)



# Workshop: Workshop: 112 (a) Written Description/Enablement (cont.)





# Report Out

**Afternoon Break** – Resume at 1:45

# Panel discussion / Open Q&A

[TC2600CustomerPartnership@uspto.gov](mailto:TC2600CustomerPartnership@uspto.gov)

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**Thank you for attending today!**

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