

February 12, 2016

U.S. Patent and Trademark Office
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450
Office of Deputy Commissioner for Patent Examination Policy
Office of Patent Legal Administration
Attn: Michael Cygan
Senior Legal Advisor

Via email TopicSubmissionForCaseStudies@uspto.gov

Re: AIPLA Comments on Submission of Topics for USPTO Quality Case Studies 80 Fed. Reg. 79277 (December 21, 2015)

Dear Mr. Cygan:

The American Intellectual Property Law Association (“AIPLA”) is pleased to present the following comments to the USPTO Request for Submission of Topics for USPTO Quality Case Studies, in response to an invitation for written comments. 80 Fed. Reg. 79277 (December 21, 2015).

AIPLA is a national bar association of approximately 14,000 members who are primarily lawyers engaged in private or corporate practice, in government service, and in the academic community. AIPLA members represent a wide and diverse spectrum of individuals, companies, and institutions involved directly or indirectly in the practice of patent, trademark, copyright, trade secret, and unfair competition law, as well as other fields of law affecting intellectual property. Our members represent both owners and users of intellectual property. Our mission includes helping establish and maintain fair and effective laws and policies that stimulate and reward invention while balancing the public’s interest in healthy competition, reasonable costs, and basic fairness.

Title: Consistency in the Handling of Claims with Limitations Under § 112(f)

Proposal for study: AIPLA proposes a study to identify applications having means-plus-function limitations and determine whether such limitations are being consistently handled as required by the Examiner Training Materials on §112(f) dated May 2014.

Explanation: As set forth in the Examiner Training Materials, the broadest reasonable interpretation (BRI) is restricted for claim elements that are subject to § 112(f). In particular, the “BRI = corresponding structure, material, or acts disclosed in the specification, and equivalents, for performing the recited function.” (See slide 9 of the PowerPoint presentation dated May 5,

2014 entitled, “35 USC 112(f): Broadest Reasonable Interpretation and Definiteness of § 112(f) Limitations”). Our members note that Examiners sometimes do not follow the training materials and interpret claims subject to § 112(f) too broadly. Failure to follow the guidance causes delays in patent prosecution as applicants need to file a response indicating the inapplicability of the prior art due to the improper determination of BRI and the Examiner needs to perform an additional search and issue what is often a second non-final Office Action.

We propose that the USPTO initiate a study to identify applications with claims receiving rejections under 35 U.S.C. §§ 102 or 103 that include the term “means” or other nonce words and do not recite sufficient structure. The Office should review the rejections to ensure that the USPTO guidance is being properly and consistently applied. This would allow for a more consistent, uniform application of §112(f), a clearer record, and fewer RCEs. Identifying these rejections would allow for better compact prosecution stemming from better understanding between Examiner and applicant regarding meaning of the claim language.

AIPLA appreciates the opportunity to propose case studies to improve the quality of examination and, thus, to improve the quality of issued patents. We look forward to working with the Office in the implementation of these or any other case studies.

Respectfully Submitted,



Denise W. DeFranco

President

American Intellectual Property Law Association