

February 10, 2016

Via Electronic Mail

TopicSubmissionForCaseStudies@uspto.gov

Attention: Michael Cygan, Senior Legal Advisor
Office of Patent Legal Administration, Office of the Deputy
Commissioner for Patent Examination Policy

IBM Corporation Comments in response to "Request for Submission of Topics for USPTO Quality Case Studies", 80 Fed. Reg. 244 (December 21, 2015)

Title: The Impact of the US Supreme Court's Definiteness Standard in *Nautilus* on Patent Application Examination Practices

Proposal for Study: Evaluate the impact of the US Supreme Court's holding in the *Nautilus* case, effectively raising the standard for claim definiteness, on the examination and prosecution of patent applications within the US Patent Office.

Explanation:

IBM thanks the United States Patent and Trademark Office ("Office") for the opportunity to submit topics for USPTO quality case studies. We appreciate the Office's continuing commitment to enhance patent quality.

IBM recommends that the Office study the actions and practices of Examiners in examining patent applications for claim definiteness, since the US Supreme Court's decision in the *Nautilus* case in June 2014. IBM is particularly interested in whether Examiners are following the higher standard for claim definiteness described by the Supreme Court in *Nautilus* and whether Examiner rejections based on claim indefiniteness have increased in frequency since the *Nautilus* decision.

Section 112 of the Patent Act provides that "the specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the inventor or joint inventor regards as the invention." Prior to the *Nautilus* case, the US Court of Appeals for the Federal Circuit applied a more lenient test for definiteness, finding patent claims passed the definiteness test if they were "amenable to construction" and they were construed as not "insolubly ambiguous." In *Nautilus*, the Supreme Court concluded that the Federal Circuit's threshold did not "satisfy the statute's definiteness requirement." The Supreme Court replaced the "insolubly ambiguous" standard, and held that "a patent is invalid for indefiniteness if its claims, read in light of the specification delineating the patent, and the prosecution history, fail to inform, *with reasonable certainty*, those skilled in the art about the scope of the invention." (Emphasis added.)

IBM respectfully requests that the Office study whether Examiners adhere to the higher "reasonable certainty" standard in examining patent claims. We encourage the Office to compile and compare statistics on claim indefiniteness rejections before and after the *Nautilus* decision. We ask that the Office compare such statistics between the various technology centers and/or art units to determine if a variance between different Examination groups exists. We also encourage the Office to analyze Examiners rejections for claim indefiniteness to determine if they include the "reasonable certainty" standard within the reasons for rejection. We believe that the Office could use the information that it compiles from this case study to communicate to Examiners a set of best practices to be used in examining patent claims for indefiniteness. Such best practices could then raise the quality of patent claims, and ultimately the quality of issued patents.

Finally, IBM supports all efforts to increase patent quality, including the Office's Enhanced Patent Quality Initiative, and we thank the Office for considering this particular submission as a case study in its new pilot program.

Respectfully submitted,

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