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<http://www.regulations.gov> (docket number PTO-P-2015-0074)

Re: Request for Submission of Topics for USPTO Quality Case Studies

Intel Corporation (Intel) submits the below topic for consideration in response to the United States Patent and Trademark Office's (USPTO) request for submissions of topics for USPTO quality case studies. *See* 80 Fed. Reg. 79277 (Dec. 21, 2015). We appreciate the opportunity to provide a submission for this important initiative.

Title: "Closer Scrutiny of Claims with Purely Functional Limitations, Regardless Whether the Term 'Means' is Used."

Proposal for Study: Claims that recite purely functional limitations, with or without the word "means," may need more rigorous examination under 35 U.S.C. § 112(f) (Section 112(f)) to determine if the specification discloses sufficient corresponding structure in view of recent precedential decisions.

Explanation: Section 112(f) requires that patents claiming a particular function are limited to the structure specifically disclosed in the specification for carrying out that function. Yet applications often fail to disclose definitive corresponding structure that is sufficiently linked to the relevant claim language. The result is an indefinite "black box" that can easily be distorted in litigation to allege that almost any structure infringes the functional limitation, even structures never envisioned by the Applicant. It has been our experience, however, that indefiniteness of such purely functional claim limitations is frequently not closely scrutinized during examination, particularly if the limitations do not recite the term "means."

Intel proposes a case study that would assess whether a representative sample of

examined, functional claims that are 1) “means” claims or 2) otherwise subject to Section 112(f) treatment under recent precedent from the United States Court of Appeals for the Federal Circuit (Federal Circuit) are supported by corresponding structure, material, or acts described in the specification. The study would also compare the results of this determination to the number of Section 112(f) rejections made for this sample of functional claims.

A determination that the sample of functional claims tends to lack support under Section 112(f) or that those claims in the sample that lack support tend not to be rejected under Section 112(f) by Examiners would indicate a need for improvements to examination of such purely functional limitations. For example, the USPTO could issue examination guidance to improve Examiners’ recognition of when claim limitations invoke Section 112(f) under recent Federal Circuit precedent and thus require definitive corresponding structure to be disclosed in the specification. For such purely functional limitations, the training materials also should encourage Examiners either to identify the determined corresponding structure themselves in writing or ask the Applicant to identify in writing the corresponding structure so that there is a record in the file history. Importantly, the identification of a mere box in a structural drawing without more should generally be considered suspect and examined closely for lack of sufficient structure. Express identification of corresponding structures during examination would provide more clarity and certainty about the patent right granted, and save countless debates years later in litigation.

Sincerely,



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