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Mail Stop Comments Patents
Commissioner of Patents
P.O. Box 1450
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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: "Rejections Under 35 U.S.C. § 112 (Section 112) Should be Made and Maintained More Frequently"

Proposal for Study: Applicable Section 112 rejections are often not made or, if made, are quickly withdrawn during examination, resulting in broad claims that are susceptible to multiple interpretations and that lack support in the specification.

Explanation: Section 112's requirements serve a critical role in ensuring that patents have clear boundaries, an issue of ever-growing importance in crowded fields such as software and hardware. For example, a single feature on a semiconductor chip, such as out-of-order execution, might potentially invoke a hundred patents, the chip itself thousands. In order for market participants in such intensely crowded fields to know where the public domain ends and private right begins, it is essential that patents give clear notice of their claimed territory. Examiners are uniquely well-positioned to serve as gatekeepers of Section 112 requirements. For example, Examiners are able to ask questions of Applicants about Section 112 issues and to require Applicants to pinpoint the true invention. It is Intel's experience, however, that Section 112 rejections are often never made throughout examination or, if made, are too easily overcome

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by Applicants. Lack of rigorous examination of Section 112 results in a higher frequency of amorphous patents that bear little resemblance to the patent specification.

Intel proposes two methodologies to investigate the effective use of Section 112 to reject broad and ambiguous claims. First, the USPTO should review the frequency of Section 112 rejections compared to other types of rejections. Specifically, the case study should investigate cases containing at least one rejection under a Title 35 ground and determine what percentage of those rejections are based on Section 112.

Second, the USPTO should investigate whether Section 112 rejections, once made, are maintained throughout examination, and whether the rate of maintenance differs as compared to other Title 35 grounds. This case study would analyze the cases in which a Section 112 rejection is made and determine the percentage of those cases that result in a final office action based on Section 112 or in an abandonment of the application. The study would also review whether final Section 112 rejections are appealed by the Applicant.

Discovery of either trend could lead to examination guidance or training materials for Examiners that emphasize the importance of making and maintaining Section 112 rejections for claims that are susceptible to multiple interpretations or are unsupported by the specification. For example, the guidance could encourage Examiners to require Applicants to define and identify specification support for key claim terms—such as terms that were coined by the Applicant or are central to the invention. As a future development, the USPTO could also implement search tools to assist an Examiner in identifying portions of the specification relevant to selected claim terms to identify potentially unsupported claim language.

Sincerely,

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