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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:** "Claims in Continuing Applications Should Receive More 35 U.S.C. § 112 (Section 112) Scrutiny Than Original Applications."

**Proposal for Study:** Claims in continuing applications may deviate further from the first application than permitted by Section 112.

**Explanation:** It has been Intel's experience that examination of claims in divisional, continuation, and continuation-in-part applications often deserve more Section 112 scrutiny than examination of original applications, because Applicants have adjusted claim language over time. The result is an increased incidence of vaguely drafted claims that do not provide clear notice of the claimed invention, are not supported by the original specification, or both. The USPTO would strike a better policy balance by requiring a stricter correlation to language and claim element combinations that were explicitly described together in the original application. Other jurisdictions require such a correlation to varying degrees. For example, the European Patent Office's stance on Article 123(2) of the European Patent Convention is quite strict.

Intel proposes a case study to investigate whether continuing applications receive less Section 112 scrutiny than original filings. Specifically, the USPTO should review whether

continuing applications result in the same or even fewer office actions and, specifically, Section 112 rejections compared to first applications. Such a trend would indicate that continuing applications receive less rigorous Section 112 examination than needed, because the scrutiny likely should be increased over original applications. Intel proposes that it may be rational to limit the study to continuation or divisional applications after a certain threshold of family members exist such as three, four, or more family members.

One potential improvement would be to provide additional Examiner training to emphasize that continuing applications, particularly after some threshold number have been filed in a single priority chain, should receive more Section 112 scrutiny than original applications. We often find that Section 112 issues arise in later-filed applications. Thus, when Applicants add new claims via continuing applications, Examiners should closely examine the specification to determine whether the combination is supported in the specification and unambiguous. Because the Examiner is already familiar with the prior art in many cases, additional time may be available to more carefully assess Section 112 support for claims. If the case study shows that later-filed applications tend to be weaker on explicit support for claim language, the USPTO has the opportunity to require Applicants to explicitly articulate the support under 37 C.F.R. § 1.105.

Sincerely,



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Director of Intellectual Property Policy  
Intel Corporation



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