



Clarity of the Record Pilot: Documenting Claim Interpretation

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Goals of the Pilot:

- More thoroughly document key issues of claim scope during prosecution
- Explicitly inform patent owner and public of the decision making during prosecution
- Clearly record the examiner's reasoning



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The Pilot Will Focus On:

- Going beyond the minimum requirements for establishing a *prima facie* case of unpatentability to develop enhanced clarity practices by explaining on the record how the claim is being interpreted
- Leveraging the results of the Pilot to determine “best practices”
 - Examiner-identified enhanced clarity practices
 - Benefits vs. resources
 - Evaluation of how the explanation assists in more clearly articulating prior art rejections



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Explicit Claim Interpretation

- During patent examination, claims are given their broadest reasonable interpretation (BRI) in light of the specification as it would be interpreted by one of ordinary skill in the art
 - The BRI of the claim is then used to evaluate patentability under each of the statutes
- In this Pilot, the interpretation of certain types of claim language that may benefit from explicit explanation will be addressed on the record to establish the examiner's understanding of the claim



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Explicit Claim Interpretation (cont.)

Types of claim language that may require explicit explanation:

- Special definitions of claim terms
- Optional language
- Functional language
- Intended use or result (preamble and body of claim)
- Non-functional descriptive material
- “Means-plus-function” (35 U.S.C. §112(f))
- Computer-implemented functions that invoke 35 U.S.C. §112(f) (“specialized” or “non-specialized”)



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Special Definitions – Background

- Under BRI, words of a claim are given their plain meaning, unless such meaning is inconsistent with the specification.
- Applicants can rebut the presumption that a term is given its plain meaning by clearly setting forth a **special definition** of the term in the specification.
 - When a special definition is used, it is a best practice to identify the claim term and the special definition, noting where it appears in the specification.



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Special Definitions – Pilot

In this Pilot, if a special definition is used for a claim term, the examiners will acknowledge and identify the special definition.

- By this, when the claim is examined for patentability the record will show that the claim was interpreted using the special definition.



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Optional Language – Background

Language that suggests or makes optional, ***but does not require***, a particular structure or particular steps to be performed does not limit the claim scope. Claim language that may indicate optional limitations includes:

- “adapted to/for” clauses
 - “for example” phrases
 - “such as” phrases
 - “wherein” clauses
 - “whereby” clauses
- Determination of the limiting effect of this type of language depends on the particular facts of each case; thus, it is a best practice to identify such language and explain whether it has a limiting effect on the claim scope.



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Optional Language – Pilot

In this Pilot, if language suggests or makes optional some structure or steps, examiners will identify that language and provide an explanation as to whether it imposes a limitation on the claim scope.



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Functional Language - Background

- A limitation is functional when it recites a feature by *what it does* rather than by *what it is*.
 - Must be evaluated for what it conveys to one of ordinary skill in the art – BRI will depend on whether §112(f) is invoked or not.
 - When §112(f) is not invoked, the issue of whether the BRI of the claim is limited by the function turns on the existence of a connection between the functional language and structure, material or acts recited in the claim.
- It is a best practice to state whether functional language limits the BRI of the claim and explain why.



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Functional Language – Pilot

In this Pilot, when functional language is recited in the claim without invoking §112(f), examiners will add a statement as to whether it has been given patentable weight along with an explanation.

- For example (given weight): “As recited in claim 1, function Y limits the operation of widget A.”
- For example (not given weight): “As recited in claim 2, function Y is unconnected to any structure recited in the claim and therefore imposes no limits on the claim scope.”



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Intended Use, Purpose or Result – Background

- A statement of intended use or result typically does not provide a patentable distinction **unless**:
 - some structural difference is imposed by the use or result on the structure or material recited in the claim, or
 - some manipulative difference is imposed by the use or result on the action recited in the claim
- Intended use or result can appear in a preamble or the body of a claim and is evaluated on a case-by-case basis
 - It is a best practice to identify a statement of intended use, purpose or result and indicate whether it imposes any limit on the BRI of the claim



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Intended Use, Purpose or Result – Pilot

In this Pilot, examiners will identify statements of intended use, purpose or result and indicate any limits imposed by the statements. Particular attention should be paid to preambles and whether they limit the BRI of the claim.



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Determining Non-Functional Descriptive Material – Background

- Non-functional descriptive material, also called “printed matter”, refers to the content of information recited in a claim (*e.g.*, dosage instructions on a label).
 - As claims are read as a whole, non-functional descriptive matter in a claim may not be disregarded, but absent a new and unobvious functional relationship between the material and the substrate patentable weight need not be given.
- When the claim uses descriptive material, it must be determined whether that material has a functional relationship to the associated product or step.
 - It is a best practice to identify descriptive material and indicate whether it is given patentable weight by explaining whether a functional relationship is found with the product or step claimed with the descriptive material.



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Determining Non-Functional Descriptive Material – Pilot

In this Pilot, if descriptive material is claimed, examiners will identify the descriptive material, provide an explanation regarding whether a functional relationship has been found, and state whether the material is being given patentable weight.



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“Means-Plus-Function” – Background

- When functional language is used in a claim, it must be determined whether §112(f) is being invoked.
 - Use of the word “means” raises the rebuttable presumption that the claim element is to be treated under §112(f).
 - Absence of the word “means” raises the rebuttable presumption that claim element is not to be treated under §112(f).
- When a claim limitation appears in the form of a term modified by functional language, it is a best practice to note the §112(f) presumptions in the record and explain when they have been overcome.
 - This will establish whether §112(f) is invoked, which controls the BRI.



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“Means-Plus-Function” – Pilot

In this Pilot, examiners will use FP 7.30.04 to set forth the presumptions when appropriate and indicate whether a claim limitation is being interpreted under §112(f).

- Additionally, if the presumptions are overcome, the examiner should:
 - Specifically identify claim language that uses the word “means” and explain why §112(f) is not invoked
 - Specifically identify claim language that uses a generic placeholder for the word “means” and explain why §112(f) is invoked
- When §112(f) is invoked, it is a best practice to identify the corresponding structure, material or acts described in the specification as performing the function recited in the claim
 - This will clearly establish the BRI on the record for that claim limitation



Computer-Implemented Functions that Invoke 35 U.S.C. §112(f) – Background

Programmed computer functions that invoke §112(f) require a computer programmed with an “algorithm” to perform the function and fall into two types:

- Specialized - functions other than those commonly known in the art, often described by courts as requiring “special programming” for a general purpose computer or computer component to perform the function
 - ***Specialized functions requiring disclosure of an algorithm are the default rule.***
- Non-specialized - functions known by those of ordinary skill in the art as being commonly performed by a general purpose computer or computer component
 - ***It is rare that an algorithm need not be disclosed.***



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Computer-Implemented Functions That Invoke 35 U.S.C. §112(f) – Background (cont.)

- For non-specialized functions, it is best practice to indicate that a §112(f) programmed computer function does not require disclosure of an algorithm because it is a rare circumstance.
- For non-specialized functions, it is a best practice to identify the algorithm described in the specification to establish the BRI on the record.



Computer-Implemented Functions That Invoke 35 U.S.C. §112(f) – Pilot

In this Pilot, examiners will identify programmed computer functions that invoke §112(f) and indicate either that:

- the function is non-specialized and can be achieved by any general purpose computer without special programming, or
- the function is specialized and is performed with hardware and algorithm identified in the specification (describe the hardware and algorithm or indicate where they appear in the specification)



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Using the Claim Interpretation in Rejections

Once the BRI is clearly established in the record and explanation is provided regarding the types of language focused on in this Pilot, use that BRI and additional explanation when examining the claims for patentability under the statutes.

- For example, it may be appropriate in an anticipation rejection to note that an intended use is not given weight because it does not impose a limit on the claim scope as explained in the claim construction portion of the Office action.



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Recap of Pilot Goals

- Provide explanation of claim interpretation on the record so that the BRI is clearly set forth
- Inform the applicant of any additional considerations in claim interpretation, including any special definitions, terms that are not given patentable weight, invocation of §112(f), to avoid prosecution delays due to misunderstanding of the claims



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Explicit Claim Interpretation: End Goals

By providing enhanced claim interpretation on the record, this Pilot will:

- Provide an opportunity for applicant to agree or respond to the examiner's claim interpretation
- Provide information for courts and the PTAB regarding claim interpretation used by the examiner
- Provide certainty as to the boundaries of the claims and associated patent rights

Enable potential users to make informed decisions concerning scope of issued patents



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Open Discussion

- What other ways do you ensure that your claim interpretations are clear in the record?
- Do practices differ based on technology?



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Questions

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