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MEMORANDUM

DATE: February 9, 2011  
TO: Patent Examining Corps  
FROM:   
Robert W. Bahr  
Acting Associate Commissioner  
for Patent Examination Policy

SUBJECT: **Supplementary Examination Guidelines for Determining Compliance with 35 U.S.C. § 112 and for Treatment of Related Issues in Patent Applications**

The attached **Supplementary Examination Guidelines for Determining Compliance with 35 U.S.C. § 112 and for Treatment of Related Issues in Patent Applications** (“guidelines”) are intended to assist USPTO personnel in the examination of claims in patent applications for compliance with 35 U.S.C. § 112, ¶ 2, which requires that claims particularly point out and distinctly claim the subject matter that applicant regards as his or her invention. These guidelines are not a comprehensive revision of the Manual of Patent Examining Procedure (MPEP), but the sections of the MPEP directly affected by these guidelines are referenced in the guidelines. The current provisions in the MPEP not revised by the guidelines remain in effect.

The guidelines highlight certain areas in which questions of definiteness commonly arise. For example, factors are provided that should be considered when examining functional claim language to determine whether the language is ambiguous or whether the boundaries of the claim scope are clear and precise. Guidance is also provided for determining whether a claim limitation invokes § 112, ¶6. Examiners are instructed to apply § 112, ¶6 to a claim limitation, not only when the phrase “means for” (or “step for”) is used, but also when the limitation uses a non-structural term that is simply a substitute for the term “means for” (such as “mechanism for”). In either instance, for § 112, ¶6 to apply, the phrase “means for” or the non-structural term must be associated with functional language and must not be modified by sufficient structure for achieving the specified function.

The guidelines also address examination of dependent claims under § 112, ¶4, and instruct examiners to reject a non-compliant dependent claim under § 112, ¶4 as unpatentable rather than objecting to the claim. The guidelines also indicate that Markush-type claims may be rejected for indefiniteness if one skilled in the art could not envision all members of the Markush group, and/or may be rejected as an “improper Markush grouping” if the members do not share a single structural similarity or a common use. Additionally, supplemental information is provided for examining computer-implemented functional claim limitations, highlighting issues that may arise under §§ 112, ¶1, 102 and 103.

The USPTO plans to provide training to examiners on the guidelines. An examination procedure summary sheet is also being provided with this memorandum to provide a checklist to aid in determining compliance with § 112.