

SUMMARY OF EXAMINATION PROCEDURE FOR DETERMINING COMPLIANCE WITH 35 U.S.C. § 112

1. Determine what applicant has invented and is seeking to patent

- Review the complete specification, including the detailed description of the invention, any specific embodiments that have been disclosed, and the claims.
- Determine what, precisely, the applicant has invented and how the claims relate to and define that invention.

2. Interpret the claims

- Give the claim its broadest reasonable interpretation consistent with the specification as it would be interpreted by one of ordinary skill in the art. (MPEP 2111)
- Ascertain the boundaries of the subject matter encompassed by each claim. (See PART 1, section II of the 2011 Supplementary 112 Guidelines)
- Determine whether the claim limitation invokes § 112, ¶6. (See PART 1, section III.C. of the 2011 Supplementary 112 Guidelines)
 - If § 112, ¶6 is invoked, construe the § 112, ¶6 limitation to cover the corresponding structure, material, or acts described in the specification and equivalents thereof that perform the stated function.
- Determine the effective filing date of each claim. (MPEP 201.11 & 706.02)

3. Conduct a thorough search of the prior art

- Determine the state of the art.
- Identify prior art references that are material to the patentability of the claimed invention.

4. Determine whether the written description supports the claimed invention under 35 U.S.C. 112, ¶1 (written description requirement)

- Based on the written description, determine whether one of ordinary skill in the art would recognize that the applicant was in possession of the claimed invention as a whole at the time of filing the application. (See PART 2, section I of the 2011 Supplementary 112 Guidelines and MPEP 2163)
- If the description lacks sufficient detail to support the claim, reject the claim as containing subject matter not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. (FP 7.31.01)

5. Determine whether the disclosure enables the full scope of the claimed invention under 35 U.S.C. § 112, ¶1 (enablement requirement)

- Based on the broadest reasonable interpretation of the claim, determine if the disclosure enables one skilled in the art to make and use the full scope of the claimed invention without undue experimentation at the time of filing the application. (MPEP 2164)
- If the disclosure is not enabling, reject the claims as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.
FP 7.31.02. If the disclosure is not enabling due to the scope of the claims, use FP 7.31.03.

6. Confirm whether the best mode of practicing the claimed invention is disclosed in the application under 35 U.S.C. § 112, ¶1 (best mode requirement)

- Assume that the best mode is disclosed in the specification, unless there is evidence to show that the inventor possessed a best mode for practicing the invention at the time of filing the application and the written description did not disclose the best mode. (MPEP 2165) FP 7.31.04 for cases in which there is evidence of concealment of the best mode.

7. Determine whether the claims comply with § 112, ¶2 requirements (are the claims definite?)

- Under the broadest reasonable interpretation of the claim, are the metes and bounds of the claimed invention clear? (See PART 1, sections II-III of the 2011 Supplementary 112 Guidelines and MPEP 2173 et seq.)
 - Determine whether there is more than one reasonable interpretation of what is covered by the claim.
 - Check for terms that might render the claim “vague and indefinite,” such as:
 - Functional terms (does the claim merely recite a problem to be solved or result obtained vs. particular structure, materials or steps for resolving the problem or achieving the result?),
 - Terms of degree and subjective terms (does the specification provide some standard for measuring the degree or the scope of the subjective term?), and
 - Unclear Markush groups (can one skilled in the art envision all of the members?).
 - Check for inconsistencies between the claim and specification that prevent the scope of coverage from being determined (can one skilled in the art readily determine the meaning of the terms by reference to the specification?).
 - For each § 112, ¶6 limitation, determine whether the written description discloses the corresponding structure, material, or acts to the claimed function. If there is no disclosed structure or if the disclosure fails to link the disclosed structure, material, or acts to the function, reject under § 112 ¶2. (See PART 1, section III.C. of the 2011 Supplementary 112 Guidelines)
- If the metes and bounds are not clear, reject as being indefinite as failing to particularly point out and distinctly claim the subject matter that applicant regards as his invention. FP 7.34.01.

8. Determine whether the claims comply with § 112, ¶4 proper dependent claim requirements

- If a dependent claim fails to specify a further limitation of the subject matter or include all the limitations of the claim upon which it depends, the dependent claim should be rejected under § 112, ¶4 as unpatentable.

9. Clearly communicate findings, conclusions and their bases in an Office action

- When making a rejection under 35 U.S.C. § 112, identify the particular claim language that gives rise to the rejection. Then state the specific reason that the identified language does not comply with the relevant paragraph.

10. Practice compact prosecution / evaluate claims for patentability under all applicable statutes

- Evaluate claims for patentability under 35 U.S.C. § 101, 102, 103, and non-statutory double patenting and include findings in Office action.
- Raise any formal objections to the application in Office action.
- Attempt resolution through an interview.