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Sent: Monday, April 11, 2011 6:00 PM

To: SEGuidelines112

Subject: Microsoft Comments on Section 112 Supplementary Examination Guidelines

Microsoft is pleased to provide the attached Comments on the USPTO's *Supplementary Examination Guidelines for Determining Compliance With 35 U.S.C. 112 and for Treatment of Related Issues in Patent Applications*. Our comments are provided in both Word and PDF document formats.

If you have any questions or need additional information, please do not hesitate to contact us.

Best regards,

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*** Transmitted via email only: SEGuidelines112@uspto.gov ***

Re: Supplementary Examination Guidelines for Determining Compliance With
35 U.S.C. 112 and for Treatment of Related Issues in Patent Applications
Docket No.: PTO-P-2010-0088
Written Comments by Microsoft Corporation

Microsoft appreciates the opportunity to offer input on the Request for Comments on Supplementary Examination Guidelines for Determining Compliance With 35 U.S.C. 112 and for Treatment of Related Issues in Patent Applications published in the Federal Register on February 11, 2011. We support the objectives underlying the proposed guidelines, to-wit: to assist USPTO (Office) personnel in the examination of claims in patent applications for compliance with 35 U.S.C. 112, second paragraph. This effort to provide clarification of examination methodology is beneficial not only to Office personnel, but to the public and to patent practitioners who seek to better understand the methodology by which their patent applications are examined. Such clarification will operate to streamline prosecution and provide a basis for more orderly communications between the Office and the public.

In general, we agree with the majority of the proposed guidelines and express appreciation to the Office for taking the action of providing the proposal and inviting comments in an effort to optimize patent quality. In particular, we express our appreciation for the emphasis the Office is putting on principles of compact prosecution, which is vital to reducing the application backlog in the Office and reducing prosecution costs for applicants. Specific comments are listed below and are directed to particular portions of the proposed guidelines as indicated by the reference numerals preceding each comment.

Part 1

II.A. Broadest Reasonable Interpretation

We agree with the statement that “[d]uring examination, a claim must be given its broadest reasonable interpretation consistent with the specification as it would be interpreted by one of ordinary skill in the art” and that “words of the claim must be given their plain meaning, unless such meaning is inconsistent with the specification.” Furthermore, we would add that if a definition of a claim term is clear in the specification, there is no legitimate reason for requiring the definition to be inserted into the claim itself. We appreciate the emphasis on the term “consistent with the specification,” as this discourages use of the “broadest reasonable interpretation” phrase to force applicants to amend claims to include language from the specification even in instances where the meaning of a claim term would be clear to one of ordinary skill in the art from reading the specification. Additionally, we would add that an ambiguity regarding the interpretation of claim terms in light of the specification can be resolved by a statement on the record by an applicant, as such statements are sufficient and binding against the applicant.

III.B. Correspondence Between Specification and Claims

Even though the proposed guidelines imply that glossaries are optional, inclusion or lack of inclusion of a glossary is of no consequence to a discussion of the practical requirements of specification support for a claim term. Combining a discussion of finding specification support in the same paragraph with a discussion of glossaries in the proposed guidelines could give the impression that the lack of inclusion of a glossary-like definition of a term in a specification will render a claim indefinite. But a supporting definition may still be found in the specification without requiring language to be added. Furthermore, language added to the specification may raise new matter issues, which will only impede prosecution further. We feel that a discussion of the Office preference for a glossary does not need to be included in this document.

III.C.3. Computer-Implemented Means-Plus-Function Limitations

We generally agree with the discussion on computer-implemented means-plus-functions limitations, and with the passage defining the corresponding structure of means-plus-function limitations as being “the special purpose computer as programmed to perform the disclosed algorithm.” However, the level of detail required of the algorithm should be more clearly defined in the guidelines. In other words, while it is desirable to avoid an algorithm described in such general terms as to give no practical guidance to one skilled in the art to implement the invention, it is also desirable to avoid requiring a level of detail in the algorithm that practically entails providing program code in the application. We believe that the algorithm should be

sufficiently detailed to describe and define the patentably distinct character of the claims, considered in light of the knowledge of one skilled in the art.

We also find it encouraging that the Office has chosen to address the sometimes problematic interpretation of a specification that provides support for a means-plus-function type claim in the manner of stating that the implementation of the function may be accomplished with software, hardware, or a combination thereof. By clearly stating that “the examiner should not construe the limitation as covering pure software implementation,” we feel that the proposed guidelines correctly and adequately address the issue of how to interpret this language.

IV.B. An Office Action Should Provide a Sufficient Explanation

This portion of the proposed guidelines points out that “[i]f the language used by applicant satisfies the statutory requirement of § 112 ¶ 2, but the examiner merely wants the applicant to improve the clarity or precision of the language used, the examiner should suggest improved claim language to the applicant and not make a rejection under § 112 ¶ 2.” We want to emphasize that it is important that the examiner first make the determination whether or not Section 112 ¶ 2 has been satisfied before suggesting alternative language to the applicant. Further, when suggesting alternative language to the applicant, the examiner should make clear to the applicant that the requirements have been satisfied and, thus, no rejection is forthcoming whether or not the alternative language is included. Otherwise, applicant may not be clear as to the applicant’s options.

IV.C.1. Interpret the Claim and Apply Art With an Explanation of How an Indefinite Term is Interpreted

In this section, the goal of examination and compact prosecution are articulated and examiners are exhorted to review each claim for compliance with every statutory requirement for patentability in the examiner’s initial review of the application, and communicate all applicable grounds of rejection to the applicant in the first Office action. We believe that if this guidance is followed, it will be the single most significant improvement to compact prosecution that the Office could demonstrate. It is a shared goal of the Office and practitioners to bring prosecution of an application to a close in as little time as possible, with as few Office actions as possible. When practitioners are presented with only one or a few of the applicable rejections, it necessarily follows that it will take more than one Office action response to dispose of the application. This is an impediment to efficient prosecution, and we applaud the Office for recognizing this as an issue and addressing it here.

IV.C.2. Open Lines of Communication With the Applicant – When Indefiniteness Is the Only Issue, Attempt Resolution Through an Interview Before Resorting to a Rejection

We believe that an interview with an examiner is one of the most important and useful tools available to practitioners, and we are pleased that the Office shares this view and is

encouraging examiners to initiate interviews prior to issuing a rejection. A conversation between an examiner and the applicant can clear up many issues that can stand in the way of final disposition, and we believe that examiners should make liberal use of such methods.

Part 2

I. Determining Whether There is Adequate Written Description for a Computer-Implemented Functional Claim Limitation

In this section, the Office revisits, in some sense, the discussion included in section III.C.3 of Part 1, referenced above. This section states, “[t]he level of detail required to satisfy the written description requirement varies depending on the nature and scope of the claims and on the complexity and predictability of the relevant technology.” However, we are concerned that difficulties will arise if the proposed guidelines state that “the sufficiency of the disclosure will require an inquiry into both the sufficiency of the disclosed hardware as well as the disclosed software due to the interrelationship and interdependence of computer hardware and software.” We foresee problems with the comprehension and application of this passage as it relates to examinations of computer-implemented inventions. This passage seems to indicate that there must be a detailed disclosure of underlying hardware support for computer-implemented inventions. For most cases, it should be sufficient to state that the function may be performed in a computing device. The structure that must be adequately disclosed in the specification is the algorithm, not the specific computing device.

In re Hayes Microcomputer Products is cited in support of this proposition. We disagree with the restatement of the basis of the holding cited in the proposed guidelines, namely that in *Hayes*, “the written description requirement was satisfied because the specification disclosed the specific type of microprocessor used.” Although it is true that in *Hayes*, a preferred type of computing device (Zilog Z-8 processor) was disclosed, this was not the basis of the holding that the written description requirement was met. The court held that “[o]ne skilled in the art would know how to program a microprocessor to perform the necessary steps described in the specification. Thus, an inventor is not required to describe every detail of his invention.” Further, “[d]isclosing a microprocessor capable of performing certain functions is sufficient to satisfy the requirement of section 112, first paragraph, when one skilled in the relevant art would understand what is intended and know how to carry it out.”

We also observe that the proposed guidelines seem to be contradictory on the finding of *Hayes* when it is noted that “the Federal Circuit stressed that the written description requirement was satisfied because the particular steps, i.e., algorithm, necessary to perform the claimed function were ‘described in the specification.’” We believe that this is the primary holding of *Hayes* that should be stressed, and that the language in this portion of the proposed guidelines should be reconsidered to eliminate any ambiguity in the reading thereof.

Conclusion

In closing, we would like to commend Director Kappos and the Office for publishing these proposed guidelines. We believe that clarifying the nature of the inquiry under Section 112 during prosecution can only enhance compact prosecution. We also believe that these proposed guidelines will help examiners provide uniform examinations throughout the Office, and this will serve to provide practitioners with a better understanding of an examiner's position during prosecution. This will assist practitioners in deciding on an appropriate course of action when responding to Office actions. Microsoft supports this effort and stands ready to assist the Office in whatever way we can to see it through to full implementation.

Respectfully Submitted on behalf of MICROSOFT CORPORATION,

A handwritten signature in black ink, reading "D. Bartley Eppenauer". The signature is written in a cursive, flowing style.

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