Comments in response to Request for Comments and Notice of Roundtable Events for Partnership for Enhancement of Quality of Software Patents 78 FR 292 (January 3, 2013)

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I am responding to Topic 1: Establishing Clear Boundaries for Claims That Use Functional Language. My concern is that it conflates two different subsections of 35 U.S.C. § 112 by trying to shoehorn subsection (a)'s teaching requirement into subsection (f)'s determination of the scope of a functional claim element for software-related inventions.

One of the most important tasks for an examiner is checking that specification fully teaches what is being claimed, as required by subsection (a). The grant of a patent implicitly states that the examiner has made such a determination. If examiner, presumably with more than ordinary skill in the art, does not understand how to make and use invention, claims should be rejected. Courts are required to give strong deference to the examiner's determination by requiring clear-and-convincing evidence that the specification does not teach the claimed invention, and while the issue may be raised in the new post-grant opposition proceedings, it cannot be considered during reexamination.

The Federal Circuit, in cases such as *Sitrick v. Dreamworks* (516 F.3d 993, 85 USPQ2d 1826, Fed. Cir. 2008), requires that the specification enable the full scope of each and every claim, including the limitations added in a dependent claim. Because it may not be possible to add new matter to specification to support claims rejected by the examiner because of lack of enablement (although the claim might be able to be narrowed, with strong prosecution history estoppel), notice that this will be strictly enforced should produce better disclosure.

Subsection (f) plays an entirely different role. It provides the rule for how a claim element written in functional terms should be interpreted, allowing the element to be limited to things that are described in the specification and their equivalents. This is particularly useful when there is not a collective term that covers the desired scope of the element, or the collective term is too broad. This prevents a claim element from becoming too wordy, as would be the case if a Markush claim element were used that listed all the alternatives described in the specification.

The key to functional claiming is the determination of those portions of the specification that describe the functional element. Since the Federal Circuit's *Donaldson* decision (16 F.3d 1189, 29 USPQ2d 1845. Fed. Cir. 1994), an examiner cannot simply say that the element covers *all* means for performing the structure.

This creates a problem for the examiner, since it may not be clear what portions of the specification the applicant feels discloses the structure or material to support the functional claim element (or the acts to support a "step for" claim element). This also creates a problem in claim interpretation if the patent is being litigated.

The one place where the scope of a functional claim element is clear is when the claim is appealed to the Board (and possibly from there to the Federal Circuit). The rule covering briefs submitted by the applicant to the Board states:

> if the claim contains a means plus function or step plus function recitation as permitted by 35 U.S.C. 112, sixth paragraph, then the concise explanation must identify the structure, material, or acts described in the specification in the Record as corresponding to each claimed function with reference to the specification in the Record by page and line number or by paragraph number, and to the drawing, if any, by reference characters.

37 CFR 41.37(c)(1)(iii).

The Office should suggest by regulation that for each claim element, the applicant file an examination support document that particularly points out those portions of the specification that support that claim element. If an applicant does not file such a document at the time of the application or any amendment that add a functional claim element, the examiner should make the determination as part of the record, and the applicant should be charged a fee to cover the estimated cost in extra examiner time. If the Office does not feel that 35 U.S.C. § 41(d)(1)(A) permits such a fee, it should seek authorization from Congress.

Not only will this help the examiner, but it will provide the public accurate notice of the scope of a claim necessary for them to make decisions on whether they are infringing or not.

If the Office decides to make an expanded view of functional claiming an alternative to the examiner determining whether an application supports the full scope of a claim, there are a number of uncertainties that need to be addressed.

First of all, how narrowly should the specification be read? If specification indicates how to implement the claimed invention using the Motif window system, is it limited to that? A specific computer like a SPARCstation? If source code included, that specific program? What if the technique is "portable" and can be run on a number of computers? Should the patent be limited only to those computers actually mentioned in the specification?

And what are the "equivalents" of what is described in the specification? Are they frozen in time, or do they include computers that are developed after the grant of the patent? It would be helpful if the applicant were to indicate the attributes of functional claim element that makes it equivalent to what is described in the specification.

To be successful, the patent system must be realistic in light of claim elements that can be implemented on a computer using well-known techniques, with the novelty and nonobviousness of the invention being in the combination of techniques that are claimed. Sometimes, a description of what may be done will be sufficient to support a claim element (for example, "sorting" where the particular sorting technique is immaterial to the claimed invention). Sometimes, a flowchart or other description may be all that is necessary to describe the technique. And source code is very seldom useful, as programming languages change.