



American Intellectual Property Law Association

March 8, 2019

The Honorable Andre Iancu
Under Secretary of Commerce for Intellectual Property and
Director of U.S. Patent and Trademark Office
U.S. Patent and Trademark Office
600 Dulany Street
Alexandria, VA 22314

Via email: 112guidance2019@uspto.gov

**Re: Comments on 2019 Examining Computer-Implemented Functional Claim
 Limitations for Compliance With 35 U.S.C. § 112**

Dear Under Secretary Iancu:

The American Intellectual Property Law Association (AIPLA) is pleased to present its views on Examining Computer-Implemented Functional Claim Limitations for Compliance With 35 U.S.C. 112 published in the Federal Register Notice dated January 7, 2019, 84 Fed. Reg. 57 (hereinafter “the Guidance”). The Guidance requested comments by March 8, 2019.

The American Intellectual Property Law Association is a national bar association of approximately 13,500 members engaged in private or corporate practice, in government service, and in the academic community. AIPLA members represent a wide and diverse spectrum of individuals, companies, and institutions involved directly or indirectly in the practice of patent, trademark, copyright, trade secret, and unfair competition law, as well as other fields of law affecting intellectual property. Our members represent both owners and users of intellectual property. Our mission includes helping establish and maintain fair and effective laws and policies that stimulate and reward invention while balancing the public’s interest in healthy competition, reasonable costs, and basic fairness.

AIPLA provides these comments and suggestions, regarding the Guidance.

AIPLA applauds the Office for again providing practitioners and examiners with instructions on how to analyze patent claims including functional limitations under 35 U.S.C. §§ 112(f) and 112(b) and how to analyze claims for compliance with the enablement and written-description requirements under 35 U.S.C. §112(a). We appreciate the publication of the Guidance with the 2019 Revised Patent Subject Matter Eligibility Guidance (hereinafter “the Section 101 Guidance”) as we believe that appropriate examination of proposed claims under section 112 would obviate many section 101 rejections.

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As a preliminary matter, AIPLA encourages the Office to prepare training materials for analyzing claims under sections 112(a), 112(b), and 112(f) according to this guidance and to include materials encouraging examiners to identify and address overly broad or indefinite claims under section 112 rather than section 101. We also recommend that the Office prepare separate training materials on the role of the person having ordinary skill in the art in the analysis under each of sections 101 and 112, because the role of a person of ordinary skill is different when applying each of these sections. We further encourage the Office to make any such training materials available to the public.

The Guidance has two parts. The first concerns a review of issues under 35 U.S.C. § 112(f) and § 112(b) related to examination of computer-implemented functional claim limitations. The second concerns written description and enablement under § 112(a). We address each separately below.

Part I

We agree with the Guidance that determining the broadest reasonable interpretation (BRI) of the claim terms is the first step in analyzing a claim under sections 112(f) and 112(b). We also agree with the statement in the Guidance that “examiners should establish the meaning of each claim term *consistent with the specification* as it would be interpreted by one of ordinary skill in the art.” (Emphasis added). We recommend that the Office develop specific training materials on how to formulate the BRI of claim terms.

We are concerned about how the Guidance treats the knowledge of the person having ordinary skill in the art. For example, quoting *Blackboard, Inc. v. Desire2Learn, Inc.*, 574 F.3d 1371 (Fed. Cir. 2009), page 60 of the Guidance states, “we have repeatedly and unequivocally rejected this argument: a person of ordinary skill in the art plays no role whatsoever in determining whether an algorithm must be disclosed as structure for a functional claim element” 574 F.3d at 1385. On the same page, however, the Guidance states, if an algorithm is disclosed, “[t]he sufficiency of the algorithm is determined in view of what one of ordinary skill in the art would understand as sufficient to define the structure and make the boundaries of the claim understandable.” While both statements are true, they may be confusing as they describe different uses of ordinary skill. Similar issues are described below with the treatment of the ordinarily skilled person in the context of the written-description and enablement requirements under section 112(a).

We recommend that the examiner training materials include a segment focused solely on how the knowledge of the person having ordinary skill in the art is to be used. These materials should cover formulating the BRI of the claim, determining whether claim elements should be interpreted under section 112(f), determining whether the claim limitations are sufficiently definite under section 112(b), and determining whether claims satisfy the written-description and enablement requirements under section 112(a). The knowledge of the ordinarily skilled person is used differently in claim analysis under each of these sections. For example, the knowledge of the skilled person cannot be used to provide an algorithm when a description of the algorithm is absent from the specification. The knowledge of the skilled person, however, is relevant to determine whether a description that is provided in

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the specification is sufficient. Similarly, the BRI must be made in view of the specification as it would be understood by an ordinarily skilled person, without importing claim limitations from the specification.

Part II

We also believe it will be beneficial to train examiners on how the knowledge of the person having ordinary skill in the art is treated in examining claims under the written-description and enablement requirements of section 112(a). This training overlaps with the training described above for section 112(b) as the knowledge of the ordinarily skilled person cannot be used to provide a written description that is absent from the specification. However, it can be used to interpret the written description to determine whether the inventor was in possession of the invention when the application was filed.

Because the Guidance is a companion to the Section 101 Guidance, we believe it is important that the examiners in the electrical and computer arts receive training on how to determine whether a patent specification supports a broader claim and what role the knowledge of the skilled person has in making this determination. The examples cited at page 61 of the Guidance provide some guidance in this regard. For example, they point out that disclosure of the species must be sufficient to convey to a skilled person that the inventor possessed the genus. We believe, however, that both the examining corps and the public would benefit from additional training materials describing how to determine whether the disclosure supports a broad claim. For example, as described in *Lizardtech v Earth Resources Mapping*, 424 F.3d 1336, 1345 (Fed Cir. 2005):

A claim will not be invalidated on section 112 grounds simply because the embodiments of the specification do not contain examples explicitly covering the full scope of the claim language. That is because the patent specification is written for a person of skill in the art, and such a person comes to the patent with the knowledge of what has come before. Placed in that context, it is unnecessary to spell out every detail of the invention in the specification; only enough must be included to convince a person of skill in the art that the inventor possessed the invention and to enable such a person to make and use the invention without undue experimentation. (internal citations omitted).

This training is necessary to provide a backstop to the Section 101 Guidance so that broad claims which integrate judicial exceptions into practical applications pass section 101 and are still analyzed under section 112(a).

Finally, with the anticipated shift of rejections based on section 101 to those based on section 112, we encourage the Office to train examiners on the proper handling of Declarations under 37 C.F.R. § 1.132, which are often used to overcome rejections under section 112.

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CONCLUSION

AIPLA appreciates the USPTO's efforts to provide applicants and examiners clear guidance on how 35 U.S.C. §§ 112(a), 112(b), and 112(f) apply to computer-related inventions. We support the decision to publish the Guidance as a companion to the Section 101 Guidance as we believe the issues are closely related. We encourage the Office to provide training materials which examines the interplay among these sections. Thank you for allowing AIPLA this opportunity to provide comments on the Guidance.

Sincerely,

A handwritten signature in blue ink, appearing to read "Sheldon H. Klein". The signature is stylized and cursive, with a large initial "S" and "K".

Sheldon H. Klein
President
American Intellectual Property Law Association