



ARE Patent Law Alert: U.S. Patent and Trademark Office Publishes Supplementary Guidelines For Determining Compliance With 35 U.S.C. 112

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(February 10, 2011) On February 9, 2011, the U.S. Patent and Trademark Office (“PTO”) published Supplementary Examination Guidelines (“The Guidelines”) for Determining Compliance With 35 U.S.C. 112 and for Treatment of Related Issues in Patent Applications, 76 Fed. Reg. 7162 (February 9, 2011). The PTO’s guidelines reflect its understanding of existing law, as well as precedent that both the U.S. Supreme Court and the U.S. Court of Appeals for the Federal Circuit have set. These guidelines and supplemental examination information are effective as of February 9, 2011 and apply to all applications filed before, on or after the effective date of February 9, 2011.

The Guidelines provide substantial guidance to patent examiners as to accurately communicating identified deficiencies to practitioners and applicants. These Guidelines are outlined as follows:

- I. The examiner should interpret the claims by the “broadest reasonable interpretation”. The claims under examination are evaluated with a “different standard than patented claims” to determine whether the language is definite.
- II. The examiner should determine whether claim language is definite and the applicant should take care of ambiguities during prosecution “rather than attempting to resolve the ambiguity in litigation”.
- III. The examiner should establish a “clear record” in the patent prosecution history and Office actions should provide “sufficient explanation” of rejections.
- IV. The examiner should “open lines of communication with the applicant” (e.g. interviews) and ensure that the record is clear.
- V. For computer-implemented functional claim language, it is essential to review the disclosure of an application to determine if an invention is fairly disclosed rather than merely focusing on the claims alone. Specifically, examiners should determine whether the claimed invention satisfies various requirements including:



- A. providing "adequate written description for a computer-implemented functional claim limitation" and "that the inventor had possession of the claimed invention,"
- B. ensuring that enough information is provided to enable one of ordinary skilled in art to "make and use the full scope of the claimed invention without 'undue experimentation'", and
- C. ensuring that the claimed invention is patentable over the proper prior art.

A digital copy of the Supplemental Guidelines can be accessed [here](#).

Please feel free to [contact us](#) to learn more about this decision and its impact on U.S. Patent law.

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Mr. Macedo is also the author of [The Corporate Insider's Guide to U.S. Patent Practice](#), published by Oxford University Press in 2009.