Intellectual Property Law Section of the State Bar of Nevada

March 8, 2019

The Honorable Andrei Iancu
Under Secretary of Commerce for Intellectual Property and
Director of the United States Patent and Trademark Office
U.S. Patent and Trademark Office
600 Dulany Street
Alexandria, VA 22314 Via email: 112Guidance2019@uspto.gov

Re: Request for Comments on The Computer-Implemented Functional Claim Limitations Guidance

Dear Under Secretary Iancu:

The Intellectual Property Law Section of the State Bar of Nevada is pleased to have this opportunity to present its views on the USPTO's Patent Application Examination Procedures pertaining to Patent Subject Matter Eligibility. These comments are in response to the January 7, 2019 Federal Register Notice, Vol. 84, No. 4, requesting public comment on the USPTO's Computer-Implemented Functional Claim Limitations Guidance for Examining Computer-Implemented Functional Claim Limitations for Compliance With 35 U.S.C. 112 (the "112 Guidance").

This position is being presented only on behalf of the Intellectual Property Law Section of the State Bar of Nevada. This position should not be construed as representing the position of the Board of Governors or the general membership of the State Bar. The Intellectual Property Law Section is a voluntary section composed of lawyers practicing in intellectual property law.

In general, the Computer-Implemented Functional Claim Limitations Guidance raises some concerns regarding the interpretation and application of the holdings in the U.S. Court of Appeals for the Federal Circuit (''Federal Circuit'') *Williamson v. Citrix Online*, LLC, 792 F.3d 1339, 1349 (Fed. Cir. 2015) decision.

Specifically, in the *Williamson* decision, the Federal Circuit described specific guidance for reviewing claims under 35 U.S.C. § 112(f) that does not appear to be addressed in the Computer-Implemented Functional Claim Limitations Guidance.

For example, for the computer-implemented invention at issue in *Williamson*, the Federal Circuit applied a two-step analysis for interpreting means-plus-function claims under Section 112(f) including:

STEP 1) identify the function being claimed; and

STEP 2) determine what structure is performing the function.

Following this two-step process becomes critical as a computer-implemented Section 112(f) claim limitation requires the specification to disclose an algorithm for performing the claimed specific computer function, or else the claim is indefinite under 35 U.S.C. 112(b). *See Net MoneyIN, Inc. v. VeriSign, Inc.*, 545 F.3d 1359, 1367 (Fed. Cir. 2008).

In addition, the 112 Guidance instructs Examiners to *"determine whether the specification discloses the computer and the algorithm(s) that achieve the claimed function in sufficient detail that one of ordinary skill in the art can reasonably conclude that the inventor possessed the claimed subject matter at the time of filing"*.

However, it does not appear that the 112 Guidance considers that the algorithm(s) may be positively recited in the claim language without the claims reciting a specific computer function. This may frequently occur when the claims do not include the term "means for" and are not written in "means-plus-function" format. As such, the USPTO should consider clarifying that the functions of the computer-implemented inventions may also be understood by one of ordinary skill in the art based on the claimed algorithm, without a positive recitation of the function in the claim.

Moreover, the *Williamson* decision was a fact-intensive analysis by the Federal Circuit, which ultimately turned on expert witness testimony. The USPTO should use caution when citing to excerpts of the case in an effort to summarize the detailed analysis conducted in *Williamson*. For example, the following excerpt used in the 112 Guidance can be misleading:

"For example, in Williamson, the Federal Circuit found that the term ''distributed learning control module'' is a means-plus-function limitation that performs three specialized functions (i.e., ''receiving,'', ''relaying,'' and ''coordinating''), which ''must be implemented in a special purpose computer.'' Williamson, 792 F.3d at 1351–52."

The above-excerpt appears to inform Examiners that any language recited after the term "module" is a claimed function, or more broadly, that any limitation beginning with the terms "receiving", "relaying", and "coordinating" are functions rather than claimed steps in an algorithm.

Accordingly, the USPTO should consider revising the 112 Guidance to require Examiners to follow the two-step analysis set forth in *Williamson* when interpreting claims under 112(f) without the express term "means for" in the claim language, and to consider the entire claim language to determine whether other claim limitations and/or claim language may describe structure. The Examiners should also be required to identify the specific claim language considered to recite a claimed function to allow Applicants to rebut the Examiners' assertions of the claimed function and to identify sufficient structure which may include a claimed algorithm.

We appreciate the opportunity to provide these comments on the USPTO's Computer-Implemented Functional Claim Limitations Guidance for Examining Computer-Implemented Functional Claim Limitations for Compliance With 35 U.S.C. 112.

Sincerely,

Herbert R. (Dick) Schulze, USPTO Reg. No. 30,682, Nevada Bar No. #11,708
Chairperson, Intellectual Property Law Section of the State Bar of Nevada

Seaton J. Curran, USPTO Reg. No. 62026, Nevada Bar No. #11096
Chairperson, Legislative Committee, IP Law Section of the State Bar of Nevada