Memorandum

Date: January 17, 2003

To: Technology Center Directors
Patent Examining Corps

From: Stephen G. Kunin
Deputy Commissioner for Patent Examination Policy


This memorandum clarifies Office policy with respect to rejections made under 35 U.S.C. § 112, second paragraph. The guidance provided herein is effective immediately and should be applied by all Office personnel. These changes will be published in the next revision of the MPEP.

As noted in MPEP § 2173.02, during examination of claims for compliance with the requirements for definiteness under 35 U.S.C. § 112, second paragraph, some latitude in the manner of expression and the precision of terms should be permitted even though the claim language is not as precise as the examiner might desire. In reviewing a claim for compliance with 35 U.S.C. § 112, second paragraph, the examiner must consider the claim as a whole to determine whether the claim apprises one of ordinary skill in the art of its scope and, therefore, serves the notice function required by 35 U.S.C. § 112, second paragraph by providing clear warning to others as to what constitutes infringement of the patent. See Solomon v. Kimberly-Clark Corp., 218 F.3d 1372, 1379, 55 USPQ2d 1279, 1283 (Fed. Cir. 2000). If the language of the claim is such that a person of ordinary skill in the art could not interpret the metes and bounds of the claim so as to understand how to avoid infringement, a rejection of the claim under 35 U.S.C. § 112, second paragraph would be appropriate. See Morton Int’l, Inc. v. Cardinal Chemical Co., 5 F.3d 1464, 1470, 28 USPQ2d 1190, 1195 (Fed. Cir. 1993). However, if other modes of expression selected by applicants satisfy the statutory requirements of 35 U.S.C. § 112, second paragraph, but the examiner merely wants the applicant to improve the clarity or precision of the language used, the claim must not be rejected under 35 U.S.C. § 112,
second paragraph, rather, the examiner should suggest improved language to the applicant.

For example, a claim recites "a suitable liquid such as the filtrate of the contaminated liquid to be filtered and solids of a filtering agent such as perlite, filtration powder, etc." The mere use of the phrase "such as" in the claim does not by itself render the claim indefinite. Office policy is not to employ per se rules to make technical rejections. Examples of claim language which have been held to be indefinite set forth in MPEP §2173.05(d) are fact specific and should not be applied as a per se rule. The test for definiteness under 35 U.S.C. § 112, second paragraph is whether "those skilled in the art would understand what is claimed when the claim is read in light of the specification." Orthokinetics, Inc. v. Safety Travel Chair, Inc., 806 F.2d 1565, 1576, 1 USPQ2d 1081, 1088 (Fed. Cir. 1986). If one skilled in the art is able to ascertain in the example above, the meaning of the terms "suitable liquid" and "solids of a filtering agent" in light of the specification, 35 U.S.C. § 112, second paragraph is satisfied.

If upon review of the claim as a whole in light of the specification, the examiner determines that a rejection under 35 U.S.C. § 112, second paragraph is not appropriate in the above-noted example, but is of the opinion that the clarity and the precision of the language can be improved by the deletion of the phrase "such as" in the claim, the examiner may make such a suggestion to the applicant. If applicant does not accept the examiner's suggestion, the examiner should pursue the issue.

If upon review of a claim in its entirety, the examiner concludes that a rejection under 35 U.S.C. § 112, second paragraph is appropriate, such a rejection should be made and an analysis as to why the phrase(s) used in the claim is "vague and indefinite" should be included in the Office action. If applicants traverse the rejection, with or without the submission of an amendment, and the examiner considers applicants' arguments to be persuasive, the examiner should indicate in the next Office communication that the previous rejection under 35 U.S.C. § 112, second paragraph has been withdrawn and provide an explanation as to what prompted the change in the examiner's position (e.g., examiners may make specific reference to portions of applicants' remarks that were considered to be the basis as to why the previous rejection was withdrawn).

By providing an explanation as to the action taken, the examiner will enhance the clarity of the prosecution history record. As noted by the Supreme Court in Festo Corp. v. Shoketsu Kinzoku Kogyo Katsuuki Co., 122 S.Ct. 1831, 1838, 62 USPQ2d 1705, 1710 (2002), a clear and complete prosecution file record is important in that "[p]rosecution history estoppel requires that the claims of a patent be interpreted in light of the proceedings in the PTO during the application process." In Festo, the court held that "a narrowing amendment made to satisfy any requirement of the Patent Act may give rise to an estoppel." With respect to amendments made to comply with the requirements of 35 U.S.C. § 112, the court stated that "[i]f a § 112 amendment is truly cosmetic, then it would not narrow the patent's scope or raise an estoppel. On the other hand, if a § 112 amendment is necessary and narrows the patent's scope—even if only for the purpose of better description—estoppel may apply." Id., at 1840, 62 USPQ2d at 1712. The court further stated that "when the court is unable to determine the purpose underlying a narrowing amendment—and hence a rationale for limiting the estoppel to the surrender of particular equivalents—the court should presume that the patentee surrendered all subject
matter between the broader and the narrower language... the patentee should bear the burden of showing that the amendment does not surrender the particular equivalent in question."  Id., at 1842, 62 USPQ2d at 1713. Thus, whenever possible, the examiner should make the record clear by providing explicit reasoning for making or withdrawing any rejection related to 35 U.S.C. § 112, second paragraph.