


EXHIBIT Y



MEMORANDUM

Date: September 2, 2008

To: Technology Center Directors
Patent Examining Corps

From: John Love  ORIGINAL SIGNATURE
Deputy Commissioner for Patent Examination Policy (DCPEP)

Subject: Indefiniteness rejections under 35 U.S.C. 112, second paragraph

In light of recent decisions rendered by the Court of Appeals for the Federal Circuit (CAFC) on indefiniteness, it has come to my attention that a clarification regarding indefiniteness rejections under 35 U.S.C. 112, second paragraph, is needed. The purpose of this memorandum and the companion memorandum entitled “Rejections under 35 U.S.C. 112, second paragraph, when examining means (or step) plus function claim limitations under 35 U.S.C. 112, sixth paragraph” is to remind the examining corps of the appropriate use of indefiniteness rejections under 35 U.S.C. 112, second paragraph. The primary purpose of the definiteness requirement for claim language is to ensure that the scope of the claims is clear so that the public is informed of the boundaries of what constitutes infringement of the patent. This memorandum focuses on rejections under 35 U.S.C. 112, second paragraph, indefiniteness.

On January 17, 2003, the DCPEP issued a memorandum giving advanced notice to the patent examining corps regarding changes to MPEP 2173.02 clarifying rejections made under 35 U.S.C. 112, second paragraph, in light of *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 122 S. Ct. 1831 (2002).¹ The January 17, 2003, DCPEP memorandum noted that Office policy is not to employ *per se* rules to make technical rejections. However, this Office policy should not be interpreted as discouraging the use of 35 U.S.C. 112, second paragraph, to make appropriate rejections where there is evidence on the record that an issue of indefiniteness exists.

The CAFC recently articulated the importance of addressing issues of indefiniteness during examination stating,

We [the CAFC] note that the patent drafter is in the best position to resolve the ambiguity in the patent claims, *and it is highly desirable that patent examiners demand that applicants do so in appropriate circumstances* so that the patent can be amended

¹ Memorandum from Stephen G. Kunin, Deputy Commissioner for Patent Examination Policy to the Technology Center Directors and the Patent Examining Corps, Advance Notice of changes to MPEP 2173.02 clarifying Office Policy with respect to rejections made under 35 U.S.C. 112, second paragraph in view of the Supreme Court holding in *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 122 S. Ct. 1831, 62 USPQ2d 1705 (2002).

during prosecution rather than attempting to resolve the ambiguity in litigation.² [Emphasis added]

The CAFC noted that claims were held indefinite in circumstances where a claim (1) recites a means-plus-function limitation without disclosing corresponding structure in the specification;³ (2) includes a numeric limitation without disclosing which of multiple methods of measuring that number should be used;⁴ (3) contains a term that is completely dependent on a person's subjective opinion;⁵ and (4) if a term does not have proper antecedent basis where such basis is not otherwise present by implication or the meaning is not reasonably ascertainable.⁶ The common thread, in all these circumstances is that claims are found indefinite only where a person of ordinary skill in the art could not determine the metes and bounds of the claims.⁷ If the language of a claim, considered as a whole in light of the specification and given its broadest reasonable interpretation, is such that a person of ordinary skill in the relevant art would read it with more than one reasonable interpretation then a rejection of the claim under 35 U.S.C. 112, second paragraph, is appropriate.⁸ Where the claim is subject to more than one interpretation and at least one interpretation would render the claim unpatentable over the prior art, examiner should reject the claim as indefinite under 35 U.S.C. 112, second paragraph, and should reject the claim over the prior art based on the interpretation of the claim that renders the prior art applicable.⁹ Any rejection under 35 U.S.C. 112, second paragraph, should include an analysis as to why the language, phrase(s) and term(s) used render the claim vague and indefinite.

This memorandum will address rejections under 35 U.S.C. 112, second paragraph, in the following situations:

- (I) When a claim term lacks a clear and precise definition; and
- (II) When a claim limitation lacks proper antecedent basis.

I. Rejections under 35 U.S.C. 112, second paragraph, based upon a lack of a clear and precise definition of claim terms (see MPEP 2173.02)

The examination of claims for compliance with the requirement for definiteness under 35 U.S.C. 112, second paragraph, should focus on whether the claims meet the threshold requirements of clarity and precision, and not whether more suitable language or modes of expression are available. The essential inquiry pertaining to this requirement is whether the claims set out and describe a particular subject matter with a reasonable degree of clarity and particularity. Definiteness of claim language must be analyzed, not in a vacuum, but in light of the content of the particular application disclosure, the teachings of the prior art, and the claim interpretation that would be given by one having ordinary skill in the pertinent art at the time the

² *Halliburton Energy Services, Inc. v. M-I LLC*, 514 F.3d 1244, 1255, 85 USPQ2d 1663 (Fed. Cir. 2008).

³ *Halliburton*, 514 F.3d at 1246, 85 USPQ2d at 1658 (Citing *Biomedino, LLC v. Waters Techs. Corp.*, 490 F.3d 946, 950 (Fed. Cir. 2007)).

⁴ *Id.* (Citing *Honeywell Int'l, Inc. v. Int'l Trade Comm'n*, 341 F.3d 1332, 1340 (Fed. Cir. 2003)).

⁵ *Id.* (Citing *Datamize, LLC v. Plumtree Software, Inc.*, 417 F.3d 1342, 1350 (Fed. Cir. 2005)).

⁶ *Id.* (Citing *Energizer Holdings, Inc. v. Int'l Trade Comm'n*, 435 F.3d 1366, 1370-71 (Fed. Cir. 2006)).

⁷ *Id.*

⁸ MPEP 2173.05(a); *see also* MPEP 2143.03 subsection I and 2173.06

⁹ *Id.*

invention was made.¹⁰ To assist in understanding the scope of a claim and/or meaning of a claim term, applicants may provide definitions of the claim terms in the written description of the specification. Such a disclosure is helpful to the public, and applicants are fully within their rights to do so, as they may be their own lexicographers.¹¹ Applicants can define in the claims what they regard as their invention essentially in whatever terms they may choose, so long as any special meaning assigned to a term is ***clearly set forth in the specification***.¹² However, providing a definition of a claim term in the written description does not preclude a finding of indefiniteness of the claim term. The clarity of the provided definition of a term in a claim must also be evaluated from the perspective of one of ordinary skill in the art. If an examiner, when evaluating a claim term's disclosed definition, concludes the definition is not clear and precise and one of ordinary skill in the art would consider the term indefinite (*e.g.*, the definition's broadest reasonable interpretation results in more than one meaning and/or interpretation), then a rejection under 35 U.S.C. 112, second paragraph, would be appropriate. Furthermore, inconsistency between a claim term and the specification disclosure may make an otherwise definite claim term take on an unreasonable degree of uncertainty.¹³

If a claim term is not used or defined in the specification and the meaning of the claim term is not discernible, a rejection under 35 U.S.C. 112, second paragraph, would be appropriate. If the claim term is discernible, however, a rejection under 35 U.S.C. 112, second paragraph, would not be appropriate. For example, the court determined that the claim term "surrender value protected investment credits" which was not defined or used in the specification was discernible and hence not indefinite because "the components of the term have well recognized meanings, which allow the reader to infer the meaning of the entire phrase with reasonable confidence".¹⁴ 37 CFR 1.75(d)(1) requires that "the terms and phrases used in the claims must find clear support or antecedent basis in the description so that the meaning of the terms in the claims may be ascertainable by reference to the description." Therefore, if the claim term is not used or defined in the specification, but the meaning of the claim term is discernible, an objection to the specification under 37 CFR 1.75(d)(1) would be appropriate rather than a rejection under 35 U.S.C. 112, second paragraph.

II. Rejections under 35 U.S.C. 112, second paragraph, based upon a lack of proper antecedent basis in the claims (see MPEP 2173.05(e))

Sometimes it is unclear whether a particular limitation refers to an element that was previously presented, either in the same claim or a preceding claim. When this occurs, a claim should be rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to point out and distinctly claim the invention due to a lack of antecedent basis. In rare circumstances a lack of explicit antecedent basis may not render the claim indefinite if the scope of the claim is reasonably ascertainable by one of ordinary skill in the art.¹⁵ Examiners should not make *per se* technical rejections when the claim is otherwise clear, *e.g.*, use of "the" instead of "a" when a claim element is first introduced.

¹⁰ MPEP 2173.02

¹¹ *Process Control Corp. v. HydReclaim Corp.*, 190 F.3d 1350, 1357, 52 USPQ2d 1029, 1033 (Fed. Cir. 1999).

¹² *Id.*

¹³ *In re Cohn*, 438 F.2d 989, 169 USPQ 95 (CCPA 1971); and MPEP 2173.03.

¹⁴ *Bancorp Services, L.L.C. v. Hartford Life Ins. Co.*, 359 F.3d 1367, 1372, 69 USPQ2d 1996, 1999-2000 (Fed. Cir. 2004).

¹⁵ *Energizer Holdings, Inc. v. Int'l Trade Comm'n*, 435 F.3d 1366, 77 USPQ2d 1625 (Fed. Cir. 2006).

The examiner should make constructive suggestions as to how to correct any antecedence problem. The following examples illustrate situations where a claim fails to properly introduce elements in such a manner that a rejection under 35 U.S.C. 112, second paragraph, is appropriate:

Example 1: Claim 1 is a method claim for capturing images. One of the steps recited in claim 1 for capturing images is “evaluating an image.” Claim 1 does not recite any structure for carrying out the step of “evaluating an image.” In claim 1, or in a claim that depends from claim 1, applicant recites for the first time “the evaluation means consists of a temperature sensor.” In this case a rejection under 35 U.S.C. 112, second paragraph, based upon a lack of proper antecedent basis for “the evaluation means” is appropriate. The recitation is unclear and imprecise because although applicant has introduced a step of evaluating an image, applicant has not previously provided any structure for carrying out the step of evaluating an image. Thus one of ordinary skill in the art does not know what applicant is attempting to further limit with respect to the limitation of “the evaluation means,” thereby rendering the claim indefinite.

Example 2: Indefiniteness due to a lack of antecedent basis may also arise when a claim includes a number of similarly worded structural elements and it is unclear whether the different recitations refer to the same or distinct elements. For example, an applicant initially introduces a claim element as “a translator controller” and later recites “the linear translator” alone or in conjunction with “the controller.” The claim is ambiguous and a rejection under 35 U.S.C. 112, second paragraph, based upon a lack of proper antecedent basis is appropriate. In this case it is unclear if the “linear translator” is a new element or is the previously introduced “translator controller.” Thus, one of ordinary skill in the art does not know if applicant is attempting to further limit the controller or to add a new element. In other words, it is unclear whether the linear translator and translator controller are the same element or different elements, and if different, how they relate to each other. (If the claim had initially introduced “a translator controller,” and later referred to “the controller,” then the claim might have been clear.)

The above aspects of applying 35 U.S.C. 112, second paragraph, serve to illustrate the critical interplay that exists between the claims and various portions of the specification, and how examining claims for indefiniteness extends beyond simply evaluating the language of the claim alone. Giving a claim its broadest reasonable interpretation and reviewing the claim as a whole in light of the specification (*i.e.*, the other claims and the written description) as understood by one of ordinary skill in the art are important steps in analyzing a claim for indefiniteness. 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, then such a rejection should be made of record. An analysis or explanation as to how and why the claim language used is unclear, such as noted in the above examples, must be included to support any determination that the claim is vague and indefinite. By providing an explanation for the action(s) taken, the examiner will enhance clarity of the record and give applicant the ability to fully and properly respond to the rejection. If applicant traverses the rejection, with or without amendment, and the examiner agrees the rejection must be withdrawn in the next Office communication. The examiner must explain on

the record what prompted the change in position (*e.g.*, by citing to the specific applicant argument, legal and/or technical authority). If the traversal and/or amendment are not persuasive to resolve the issue of indefiniteness, the examiner must maintain the rejection and explain how and why applicant's position is not persuasive, along with any pertinent information which may assist applicant in resolving the outstanding issue(s) of indefiniteness.