

*Before the*  
**United States Patent and Trademark Office**  
Alexandria, VA

*In re*

Examining Computer-Implemented  
Functional Claim Limitations for  
Compliance with 35 U.S.C. § 112

Docket No. PTO-P-2018-0059

**COMMENTS OF  
COMPUTER & COMMUNICATIONS INDUSTRY ASSOCIATION**

On January 7, 2019, the United States Patent and Trademark Office (“the Office”) requested comments on its revised guidance on examining computer-implemented functional claim limitations with respect to 35 U.S.C. § 112 (“the Guidance”).<sup>1</sup> The Computer & Communications Industry Association (“CCIA”)<sup>2</sup> appreciates the Office’s efforts to ensure that examiners apply recent case law regarding § 112 and computer-implemented inventions.

The Guidance clearly identifies the concern regarding pure functional claiming, particularly with respect to computer-implemented inventions, and identifies for examiners how the Federal Circuit’s recent decisions should impact examination of this type of claim.

While the Guidance sets forth these concerns and a guide for examination, recent cases such as *Williamson*<sup>3</sup> and *Aristocrat*<sup>4</sup> have not yet been consistently and fully applied by examiners. Further, the Guidance represents a significant change from prior examination practice. While CCIA understands that training is planned as part of the implementation of the Guidance, training alone may not suffice to ensure compliance with the Guidance. Examiners, particularly experienced examiners who have applied § 112 in a particular way for many years, may fail to comply with the Guidance absent review and monitoring.

In order to maximize compliance, the Office should also consider implementation of two temporary transition programs.

First, the Office should create a monitoring program to measure compliance with the Guidance. Such a monitoring program would allow the Office to understand whether and how frequently examiners comply with the Guidance and to identify potential areas for further emphasis or new guidance.

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<sup>1</sup> 84 Fed. Reg. 57 (Jan. 7, 2019).

<sup>2</sup> CCIA is an international nonprofit membership organization representing companies in the computer, Internet, information technology, and telecommunications industries. Together, CCIA’s members employ nearly one million workers and generate approximately a quarter of a trillion dollars in annual revenue. CCIA promotes open markets, open systems, open networks, and full, fair, and open competition in the computer, telecommunications, and Internet industries. A complete list of CCIA members is available at <http://www.ccianet.org/members>.

<sup>3</sup> *Williamson v. Citrix Online, LLC*, 792 F.3d 1339 (Fed. Cir. 2015).

<sup>4</sup> *Aristocrat Techs. Australia Pty Ltd. v. Int’l Game Tech.*, 521 F.3d 1238 (Fed. Cir. 2008).

Second, a temporary pre-allowance review system which would provide a second review of applications for compliance with the § 112 requirements prior to allowance should be put in place. As examiners become more experienced with the application of the Guidance, such a secondary review system could be phased out. However, absent a review system to incentivize a change by examiners towards compliance with the Guidance, examiners may continue to apply the law as they originally learned it, not the law as it currently stands, leading to the issuance of invalid patents.

CCIA appreciates the Office's willingness to consider these comments.

Respectfully submitted,

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