

Texas Intellectual Property Law Journal
Fall, 1997

CHAPTER 2100 OF THE MANUAL OF PATENT EXAMINING PROCEDURE--A MEANS FOR PERSUASION

James E. Ruland^{a1}

Copyright (c) 1997 by the State Bar of Texas, Intellectual Property Law Section; James E. Ruland

Table of Contents

I.	Background	49
II.	Chapter 2100	52
	A. 35 U.S.C. § 101	52
	B. 35 U.S.C. § 102	53
	C. 35 U.S.C. § 103	53
	D. 35 U.S.C. § 102 and 103	56
	E. 35 U.S.C. § 112	57
	1. First Paragraph	57
	2. Second Paragraph	58
	3. Sixth Paragraph	58
III.	Conflicting Sections	59
IV.	Conclusion	64

I. Background

A new argumentative arrow was added to a patent practitioner's quiver in September 1995. This new weapon is Chapter 2100 of the Manual of Patent Examining Procedure (MPEP).¹ Chapter 2100 incorporates case law from the United States Supreme Court, United States Court of Customs and Patent Appeals, and its successor, the United States Court of Appeals for the Federal Circuit. The *50 case law pertains to 35 U.S.C. § 101,² 35 U.S.C. § 102,³ 35 U.S.C. § 103,⁴ and the first, second, and sixth paragraphs of 35 U.S.C. § 112.⁵

Chapter 2100 is useful in all areas of patent prosecution dealing with patentability, but is particularly helpful in responses to claims rejected because of anticipation under 35 U.S.C. § 102 or because of obviousness under 35 U.S.C. § 103. A practitioner may rebut a prima facie finding of anticipation or obviousness by arguing to the Patent and Trademark Office (PTO) that a judicially created doctrine refutes the prima facie finding.

Unfortunately, merely stating the judicial rule without citing supporting facts from the case that created or clarified the rule is usually unpersuasive. Often, a dispute as to the application of the rule arises between the practitioner and the examiner. A practitioner could summarize a case that created the rule, but this would be time consuming. Furthermore, an inadvertent error in summarizing the case may lead to a charge of inequitable conduct against the practitioner in subsequent litigation. Of course, a practitioner may always appeal the examiner's decision. However, this is a costly procedure, which smaller clients may not be able to afford.

One way around this dilemma is to cite a case that creates or clarifies the rule. The examiner may read the case that illustrates the rule and its application. However, it may be that citing case law to examiners is of little benefit because most examiners are not lawyers, but are engineers, chemists, or biologists.⁶ Therefore, case law has little influence in persuading them of patentability.

Furthermore, this approach is not practical from the examiner's standpoint. Examiners' performance and compensation are substantially based on the number of cases they handle during a given period.⁷ If they exceed their quota, they receive a bonus.⁸ Some examiners may be reluctant to research a cited case, read several pages of the opinion, analyze and compare the opinion with the case in question, and determine the accuracy of the practitioner's argument. This process takes time. Many examiners fail to consider the cited cases because such evaluation impedes their efficiency.⁹

*51 On the other hand, citing the MPEP may help avoid many of the pitfalls of simply citing cases.¹⁰ This is because the examiner is trained with the MPEP at the PTO Academy.¹¹ Furthermore, the Commissioner of the PTO charges the examiner to follow the MPEP.¹² As one commentator has noted, "a n MPEP section that supports the practitioner's position is like a glistening jewel to be displayed with appropriate grandeur."¹³

More important than just reciting judicial rules, Chapter 2100 in some situations cites cases with sufficient facts to clarify the rule. Citing Chapter 2100 is much more efficient from an examiner's standpoint. The MPEP is in each examiner's office. Some judicial rules are presented with summarized facts from a case or cases that clarify the rule. Instead of reading pages of an opinion if case law is cited, the examiner needs to read only a paragraph. Thus, citing Chapter 2100 aids the examiner by articulating and defining judicial doctrines in a clear and concise manner.

As an example, the well-known judicial doctrine that "obviousness can only be established by combining or modifying the teachings of prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so" is incorporated in Chapter 2100.¹⁴ To support this rule, summaries of the cases *In re Fine*¹⁵ and *In re Jones*¹⁶ are included. These facts clarify the rule and can aid in rebutting a prima facie obviousness rejection.

Although Chapter 2100 incorporates case law, sometimes the PTO interpretation of the law conflicts with the Federal Circuit's precedents. In one instance, that court admonished the PTO when it failed to follow precedents.¹⁷ Unfortunately, as this Article will show, the PTO has failed to follow the Federal Circuit precedents in some sections of Chapter 2100 as well. The PTO either chooses one rule without considering other precedents or chooses rules that are outdated.

*52 This Article explores beneficial sections of Chapter 2100 from a practitioner's perspective, sections that conflict with Federal Circuit precedent, and arguments for overcoming these sections if cited or followed by an examiner.

II. Chapter 2100

Chapter 2100 is divided into sections which are further divided into subsections. These sections and subsections contain headings that typically convey a judicial rule. Utility under 35 U.S.C. § 101 is covered in MPEP Section 2105, portions of Section 2106, and Section 2107.¹⁸ Sections 2131-2138 provide guidance for anticipation.¹⁹ Tests for obviousness are provided under sections 2141-2146,²⁰ while guidance for interpreting the first, second, and sixth paragraphs of 35 U.S.C. § 112 is provided in sections 2161-2186.²¹

A. 35 U.S.C. § 101

Several sections in the MPEP aid the practitioner in responding to an examiner's utility rejection. For a general utility rejection, Section 2107 clarifies judicial doctrines such as "real world value,"²² "wholly inoperative inventions,"²³ "incredible utility,"²³ and "therapeutic or pharmacological utility."²⁴ In addition, the examiner receives guidelines, such as "an asserted utility creates a presumption of utility,"²⁵ along with case summaries. For example, the summarized cases *In re Jolles*²⁶ and *Cross v. Iizuka*²⁷ clarify therapeutic or pharmacological utility.²⁸ For specific art fields, Section 2105 may be consulted for a rejection dealing with patenting living organisms²⁹ and headings I-IV of Section 2106 discusses the utility requirements for patenting computer programs.³⁰

*53 B. 35 U.S.C. § 102

Sections 2131-2138 provide directives, judicial rules, and case law for applying anticipation rejections.³¹ In Section 2131, the rule "TO ANTICIPATE A CLAIM, THE REFERENCE MUST TEACH EVERY ELEMENT OF THE CLAIM" is found in a heading.³² This rule may be cited to rebut an anticipation rejection when the supposedly anticipatory reference contains less than all of the claim's elements. Section 2131 is also broken into subsections that provide judicial rules and summarize cases dealing with multiple reference anticipation rejections³³ and genus-species situations.³⁴

MPEP sections 2132-2138 define different sub-parts of 35 U.S.C. § 102(a)-(g). Some key terms such as "known or used" and "in this country" in 35 U.S.C. § 102(a) and "on sale" and "public use" in 35 U.S.C. § 102(b) are defined in sections 2132³⁵ and 2133³⁶ respectively. In addition, various subsections provide tests for establishing a rejection and requirements for exceptions to these rejections. For example, Subsection 2132.01 provides the test for establishing a prima facie rejection under 35 U.S.C. § 102(a) and the guidelines for establishing an exception showing the reference's disclosure was the applicant's own work.³⁷ Citing these sections may aid in rebutting a 35 U.S.C. § 102(a) rejection. Subsection 2133.03(e) provides guidelines for applying an experimental use exception to the public use bar under 35 U.S.C. § 102(b).³⁸ Other sections provide definitions and judicial rules for the other parts of 35 U.S.C. § 102.³⁹

C. 35 U.S.C. § 103

Many practitioners have experienced an inappropriate rejection for obviousness. MPEP sections 2141-2146 provide guidance for applying a 35 U.S.C. § 103 obviousness rejection.⁴⁰ Section 2141⁴¹ lists the four factual inquiries for *54 applying an obviousness rejection as described in *Graham v. John Deere Co.*⁴² In addition to the *Graham* inquiries, Section 2141⁴³ also prescribes the basic considerations that apply to obviousness rejections:

- (1) the claimed invention must be considered as a whole;
- (2) the references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination;
- (3) the references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention; and
- (4) the standard with which obviousness is determined must be a reasonable expectation of success.⁴⁴

These judicially created tenets may be relied on if an examiner makes an improper obviousness rejection, such as not considering all the limitations of the claim.

Section 2143 may be relied upon to challenge an examiner's finding that a claim is prima facie obvious.⁴⁵ Section 2143 is divided into three subsections that cover the three judicially created criteria that must be met:

- 1) there must be some suggestion or motivation--either in the references themselves or in the knowledge generally available to one of ordinary skill in the art--to modify the reference or to combine the reference teachings;
- 2) there must be a reasonable expectation of success; and
- 3) the prior art reference (or references when combined) must teach or suggest all the claim limitations.⁴⁶

Subsection 2143.01⁴⁷ is very helpful to a practitioner in rebutting a prima facie case of obviousness because it lists judicial rules that clarify when a suggestion or motivation may or may not be found. One such rule is that “THE PROPOSED MODIFICATION CANNOT RENDER THE PRIOR ART UNSATISFACTORY FOR ITS INTENDED PURPOSE,”⁴⁸ which is listed as a heading. More *55 importantly, the MPEP provides a summary of *In re Gordon*,⁴⁹ the case that created the rule.

The court in *Gordon* determined that a prior art filter assembly for oil and water could not render obvious an invention for a filter for air and blood.⁵⁰ The Board of Patent Appeals and Interferences (BPAI) had ruled that it would be obvious to modify the filter assembly for oil and water by turning it upside down.⁵¹ The Federal Circuit held that turning the oil and water filter assembly upside down would render it inoperable, and thus the modification would render it unsatisfactory for its intended purpose.⁵²

If faced with an obviousness rejection and this rule is applicable, a practitioner should respond to the rejection by stating this rule and citing this section. In addition, the practitioner may draw analogies to the examiner’s combination of references with the facts from *Gordon*. Therefore, referring to the case summary of *Gordon* in Subsection 2143.01⁵³ allows the examiner to verify the practitioner’s argument.

Subsections 2143.02 and 2143.03 explain judicial doctrines pertaining to the requirement of a reasonable expectation of success and the requirement that all claim limitations must be taught or suggested.⁵⁴

Section 2144 lists sources of material an examiner may use to make an obviousness rejection.⁵⁵ A key subsection for a practitioner is Subsection 2144.03, which provides guidance for relying upon common knowledge or “well known” prior art.⁵⁶ Many practitioners have experienced a plethora of obviousness rejections that include a reference disclosing a portion of the claimed invention combined with the knowledge of a person of ordinary skill in the art.⁵⁷ Subsection 2144.03 provides ammunition for a practitioner by requiring the examiner, upon challenge, to cite a reference to support his or her position.⁵⁸

*56 Another subsection of interest, Subsection 2144.05, provides guidance as to when to apply an obviousness rejection to a claim citing a range of components.⁵⁹

In addition, subsections 2144.08 and 2144.09 may be useful in responding to an examiner in chemical cases.⁶⁰ Subsection 2144.08 deals with “Obviousness of Species When Prior Art Teaches Genus,”⁶¹ and Subsection 2144.09 explores the propriety of an obviousness rejection when the reference has a close structural similarity to that of the claim.⁶²

In headings, Section 2145 includes several arguments that a practitioner should avoid.⁶³ These arguments include arguing the age of a reference.⁶⁴ However, other arguments are presented that a practitioner may want to cite, such as the prior art reference teaches away from the invention.⁶⁵

D. 35 U.S.C. §§ 102 and 103

Sections 2111-2116 and Sections 2121-2129 in Chapter 2100 apply to both anticipation and obviousness.⁶⁶ Sections 2111-2116 govern the interpretation of various types of claims.⁶⁷ Helpful subsections include Subsection 2111.02, which describes the interpretation of claim preambles,⁶⁸ and Subsection 2111.03, which discusses various types of transitional phrases.⁶⁹

Sections 2121-2129 provide rules and cite cases regarding the requirements of a reference to be cited as prior art.⁷⁰ These sections are useful for challenging the applicability of a cited reference. Section 2121 discusses the disclosure threshold for a reference to constitute prior art.⁷¹ Subsection 2121.01 discusses prior art *57 operability requirements⁷² and Subsection 2121.02 discusses and cites cases pertaining to what compounds and compositions constitute enabling prior art.⁷³

Other pertinent sections include Subsection 2126.01 and Section 2128.⁷⁴ Subsection 2126.01 instructs that the date a foreign patent becomes available as a reference is usually the date of patent enforceability.⁷⁵ Although Subsection 2126.01 does mention an exception to this rule-- countries that maintain patent secrecy when rights are awarded⁷⁶--it fails to mention other exceptions, such as the publication of a patent prior to issuance. However, this section does suggest referring to MPEP

Subsection 901.05, section F, and to CHISUM ON PATENTS, Section 3.06 4 n.2⁷⁷ for further clarification.⁷⁸ Section 2128 discusses guidelines for using printed publications as prior art, such as establishing the required level of public accessibility⁷⁹ and the date the publication was available as a reference.⁸⁰

E. 35 U.S.C. § 112

Patentability requirements for the first, second, and sixth paragraphs of 35 U.S.C. § 112 are provided in Sections 2106, 2161-2165, 2171-2174, and 2181-2186.⁸¹

1. First Paragraph

The requirements of the first paragraph of 35 U.S.C. § 112 are broken into three parts in Chapter 2100: 1) written description (Section 2163);⁸² 2) enablement (Section 2164);⁸³ and 3) best mode (Section 2165).⁸⁴ Subsection 2106.01 discusses *58 written description, enablement, and best mode requirements for computer programs.⁸⁵

2. Second Paragraph

Patentability requirements for the second paragraph of 35 U.S.C. § 112 are in Sections 2171-2174. Section 2171 lays out the two requirements set forth in the second paragraph:

- 1) the claims must set forth the subject matter that applicants regard as their invention; and
- 2) the claims must particularly point out and distinctly define the metes and bounds of the subject matter that will be protected by the patent grant.⁸⁶

One subsection that may be of particular interest relates to breadth of claims. Subsection 2173.04⁸⁷ restates case law that “breadth of a claim is not to be equated with indefiniteness.”⁸⁸ A practitioner may bring this subsection to the attention of an examiner who rejects a claim as too broad. Other subsections of Section 2173 deal with claim terminology,⁸⁹ negative limitations,⁹⁰ and rejection bases such as aggregation⁹¹ and prolix.⁹²

3. Sixth Paragraph

Patentability requirements of the sixth paragraph of 35 U.S.C. § 112⁹³ are set forth in MPEP Sections 2181-2186.⁹⁴ Section 2181 provides guidance with regard to claim language.⁹⁵ Although no magic language need appear within a claim to fall *59 within the sixth paragraph, it must be clear that the claim element is identified by the function it performs as opposed to its specific structure.⁹⁶

Section 2183 provides guidance for the examiner in making a prima facie case of equivalence against a claimed “means plus function” limitation for determining anticipation or obviousness.⁹⁷ An examiner makes a prima facie case of equivalence by citing a prior art element that performs the specified claim function and is not excluded by any explicit definition provided in the applicant’s specification for an equivalent.⁹⁸ Once the examiner makes a case of equivalence, the burden shifts to the applicant to show that the prior art element is nonequivalent to the element disclosed in the specification.⁹⁹ Section 2184 provides guidance for the examiner in determining whether an applicant has met the burden of proving nonequivalence after a prima facie case has been made.¹⁰⁰ Arguments to establish nonequivalence include:

- 1) teachings in the specification that particular prior art is not equivalent;
- 2) teachings in the prior art reference itself that may tend to show nonequivalence; or
- 3) Rule 132 affidavit evidence of facts tending to show nonequivalence.¹⁰¹

A practitioner may use these sections to verify that a “means plus function” claim is being properly examined.

III. Conflicting Sections

What the PTO gives, however, it also takes away. Sometimes the PTO ignores Federal Circuit decisions. Prior to *In re Donaldson Co.*,¹⁰² the PTO instructed examiners to interpret “means plus function” claim language without referring to the specific embodiments in the specification.¹⁰³ After the Federal Circuit decision, the *60 PTO gave directives to the examiners to refer to the specification as mandated by the Federal Circuit.¹⁰⁴

Unfortunately, despite the Federal Circuit’s criticism in *Donaldson*, the PTO still sometimes ignores Federal Circuit mandates. This failure to follow precedent is sometimes incorporated into Chapter 2100. While some of the offending sections take a single view from splintered precedents, others seem to incorporate out-of-date judicial decisions.

One overly broad doctrine, incorporated in Subsection 2131.05, deals with anticipatory prior art.¹⁰⁵ This tenet states that arguments of nonanalogous art or teaching away are not pertinent to an anticipation rejection.¹⁰⁶ The MPEP cites *Twin Discs, Inc. v. U.S.*¹⁰⁷ and *In re Self*¹⁰⁸ to support this rule.

Self dealt with an anticipation rejection upheld by the BPAI regarding a claim for a control valve.¹⁰⁹ On appeal to the Federal Circuit, the applicant argued that an anticipatory prior art reference was nonanalogous art, taught away from the applicant’s invention, and that individuals skilled in the art would not recognize the reference as solving the long-standing problems solved by applicant’s invention.¹¹⁰ The court replied that these arguments are not applicable to an anticipation rejection and upheld the rejection.¹¹¹

However, this broad rule is not applicable in all situations. For example, a claim for a chemical process may include elements A, B, C, and D to produce product E. Under the PTO’s reasoning, this reference would anticipate a claimed process including elements A, B, and C to produce product E. However, if the first reference taught that element D was required to produce E, then it would seem that “teaching away” would be pertinent to determining patentability. To anticipate a claim, the reference must teach every element of the claim.¹¹² If the art taught that an element D must be included, then the art, although disclosing all the elements, would teach away from the claimed invention.

*61 The court in *In re Marosi*¹¹³ came to this same result. The claimed invention was a process for making zeolite compounds.¹¹⁴ The BPAI had rejected process claims on grounds of anticipation and obviousness based on a single prior art reference.¹¹⁵ Applicants asserted that the novelty of the invention was using starting materials which were essentially free of alkali metal.¹¹⁶ Applicants argued that their claimed invention differed from a prior art reference solely because of the absence of an alkali metal in their starting materials.¹¹⁷ The prior art used at least 3,819 parts per million of an alkali metal, sodium, which was regarded as an essential ingredient.¹¹⁸

The court held that the applicants’ claimed process for making zeolites was patentable, stating:

[The prior art reference], which requires alkali metal as an essential ingredient, neither anticipates nor renders obvious appellant’s process, which requires the practical elimination of alkali metal. A person of ordinary skill in the art would reasonably expect that, if what is taught as an essential ingredient is not included, an undersirable reaction or no reaction at all would occur.¹¹⁹

Thus, the court reversed the anticipation and obviousness rejection since the prior art taught away from the claimed invention.¹²⁰

If a practitioner receives a rejection of this type, citing *Marosi* is the only practical way to traverse the examiner’s rejection. Although it is preferable to cite the MPEP to persuade an examiner, sometimes it is necessary to resort to case law where no other support may be found in Chapter 2100, and hope that the examiner pulls and reads the case. Otherwise, an appeal may be in order.

Section 2114¹²¹ is also questionable. A judicial rule incorporated in that section is that “APPARATUS CLAIMS MUST BE STRUCTURALLY DISTINGUISHABLE FROM THE PRIOR ART.”¹²² This section states that an *62 apparatus claim must be patentable over the prior art in terms of structure, not function.¹²³ Many practitioners may have seen this rule cited in an office action. In practice, an examiner ignores the functional limitation of a claim when applying an anticipation or obviousness rejection. This rule originated from *In re Danley*.¹²⁴

In *Danley*, the United States Court of Customs and Patent Appeals evaluated the patentability of a power press tie rod heating system that utilized alternating current for heating the tie rods.¹²⁵ The following claim language was cited as being functional:

“the construction of the tie rod being such that alternating electric current may be passed through the tie rod to heat the same.”¹²⁶ The court held:

It is evident that the quoted expression does not constitute a structural limitation, since an alternating current *may* be passed through any tie rod which is insulated from the press frame ... appellant’s invention does not reside in a press in which it is *possible* to pass alternating current through the tie rods to heat them, but in a method and apparatus in which that is actually done. Claims drawn to an apparatus must distinguish from the prior art in terms of structure rather than function.¹²⁷

As a result, the court ignored the functional limitation to uphold an obviousness finding by the BPAI.

Although *Danley* has not been expressly overruled, a subsequent case clearly stated that functional limitations are permitted.¹²⁸ *In re Swinehart* upheld the functional limitation of transparency for a claimed composition.¹²⁹ Other cases have upheld functional limitations in method claims,¹³⁰ combination of component claims,¹³¹ and apparatus claims.¹³² The Federal Circuit has even distinguished a claim over anticipatory prior art based upon its functional limitation.¹³³

***63** The proper treatment of a functional limitation is to treat the limitation as a “means plus function” claim under 35 U.S.C. § 112.¹³⁴ Several recent cases support this treatment of functional limitations.¹³⁵

Functional limitations may be rejected under 35 U.S.C. § 112 on the grounds that the breadth of the claim language may result in a scope of protection not justified by the specification disclosure, or that the claim language renders the claim vague and indefinite.¹³⁶ In addition, an examiner may also reject a claim reciting functional limitations under 35 U.S.C. § 102 or 35 U.S.C. § 103 by showing that the prior art inherently operates the same as the claimed invention.¹³⁷ The burden then shifts to the applicant to rebut this assertion.¹³⁸

While the MPEP does not include teaching away as a way to rebut an anticipation rejection, it does incorporate sections providing the correct interpretation with regard to functional limitations. These sections should be cited if a practitioner receives a functional language rejection based upon *In re Danley*.

When confronted with an improper rejection of a functional limitation in an apparatus claim, the first section to cite is either Section 2131¹³⁹ or Subsection 2143.03,¹⁴⁰ depending on whether the functional language rejection is combined with an anticipation or an obviousness rejection. These sections state, respectively, that all claim limitations must be considered when determining patentability with regard to anticipation¹⁴¹ or obviousness.¹⁴² The next section to cite is Subsection 2173.05(g), which states that there is nothing wrong with claims having functional limitations.¹⁴³ In particular, *In re Swinehart* is cited in support.¹⁴⁴ Finally, citing Section 2181 provides proper guidance with regard to functional limitations.¹⁴⁵ The ***64** applicant should point out that an element defined by functional language should be treated as a claim in “means plus function” format.¹⁴⁶

IV. Conclusion

As illustrated, Chapter 2100 can provide powerful ammunition to a practitioner making arguments to the PTO, particularly for overcoming anticipation and obviousness rejections. However, a practitioner should also be aware that some MPEP sections incorporate only a part of case law, or may even be outdated.

Footnotes

^{a1} Kimberly-Clark Corporation, Roswell, Georgia.

¹ Manual of Patent Examining Procedure, §§ 2105-2186, at 2100-1 to 2100-165 (6th ed., 2d rev. July 1996).

² 35 U.S.C. § 101 (1994 & Supp. 1996).

- 3 35 U.S.C. § 102 (1994 & Supp. 1996).
- 4 35 U.S.C. § 103 (1994 & Supp. 1996).
- 5 35 U.S.C. § 112 (1994 & Supp. 1996).
- 6 STEPHEN A. BECKER, PATENT APPLICATIONS HANDBOOK 6-8, 6-39 (1995 ed.).
- 7 Personal e-mail from former Patent Examiner to author.
- 8 Personal e-mail from former Patent Examiner to author.
- 9 Personal e-mail from former Patent Examiner to author.
- 10 Irving Kayton, *Critical Professor Kayton-Designed Prosecution Techniques For Successful Litigation*, in ADVANCED PATENT APPLICATION AND AMENDMENT WRITING, 14-1, 14-15 (Irving Kayton et al. eds., 1993).
- 11 *Id.*
- 12 *Id.*
- 13 *Id.*
- 14 MPEP § 2143.01 at 2100-110.
- 15 837 F.2d 1071, 5 U.S.P.Q.2d (BNA) 1596 (Fed. Cir. 1988).
- 16 958 F.2d 347, 21 U.S.P.Q.2d (BNA) 1941 (Fed. Cir. 1992).
- 17 *In re Donaldson Co.*, 16 F.3d 1189, 1193-94, 29 U.S.P.Q.2d (BNA) 1845, 1848-49 (Fed. Cir. 1994).
- 18 MPEP at 2100-3 to 2100-20 and 2100-30 to 2100-43.
- 19 *Id.* at 2100-62 to 2100-100.
- 20 *Id.* at 2100-100 to 2100-129.
- 21 *Id.* at 2100-129 to 2100-165.
- 22 *Id.* § 2107 at 2100-30 to 2100-31.

23 *Id.* at 2100-31 to 2100-32.

24 *Id.* at 2100-32 to 2100-34.

25 *Id.* § 2107.01 at 2100-37.

26 628 F.2d 1322, 1326-28, 206 U.S.P.Q. (BNA) 885, 889-91 (C.C.P.A. 1980).

27 753 F.2d 1040, 1045-51, 224 U.S.P.Q. (BNA) 739, 743-48 (Fed. Cir. 1985).

28 MPEP § 2107 at 2100-32 to 2100-34.

29 *Id.* at 2100-3 to 2100-4.

30 *Id.* at 2100-4 to 2100-20.

31 *Id.* at 2100-62 to 2100-100.

32 *Id.* at 2100-62.

33 *Id.* at 2100-62 to 2100-63.

34 *Id.* at 2100-63 to 2100-65.

35 *Id.* at 2100-65 to 2100-67.

36 *Id.* at 2100-67 to 2100-74.

37 *Id.* at 2100-66 to 2100-67.

38 *Id.* at 2100-74 to 2100-78.

39 *Id.* at 2100-78 to 2100-100.

40 *Id.* at 2100-100 to 2100-129.

41 *Id.* at 2100-100 to 2100-101.

42 383 U.S. 1, 18-19, 148 U.S.P.Q. (BNA) 459, 467 (1966).

43 MPEP at 2100-101.

44 *Id.*, citing *Hodosh v. Block Drug Co.*, 786 F.2d 1136, 1143 n.5, 229 U.S.P.Q. (BNA) 182, 187 n.5 (Fed. Cir. 1986).

45 MPEP at 2100-109.

46 *Id.*

47 *Id.* at 2100-110 to 2100-111.

48 *Id.* at 2100-111.

49 733 F.2d 900, 221 U.S.P.Q. (BNA) 1125 (Fed. Cir. 1984).

50 *Id.* at 902, 221 U.S.P.Q. at 1127.

51 *Id.*

52 *Id.*

53 MPEP at 2100-111.

54 *Id.* at 2100-111 to 2100-113.

55 *Id.* at 2100-113 to 2100-125.

56 *Id.* at 2100-115 to 2100-116.

57 Personal experience of the author.

58 MPEP at 2100-115.

59 *Id.* at 2100-119 to 2100-120.

60 *Id.* at 2100-122 to 2100-125.

61 *Id.* at 2100-122.

62 *Id.* at 2100-123 to 2100-125.

63 *Id.* at 2100-125 to 2100-128.

64 *Id.* § 2145(h) at 2100-127.

65 *Id.* § 2145(j)(4) at 2100-128.

66 *Id.* at 2100-43 to 2100-62.

67 *Id.* at 2100-43 to 2100-53.

68 *Id.* at 2100-45 to 2100-46.

69 *Id.* at 2100-46 to 2100-47.

70 *Id.* at 2100-53 to 2100-62.

71 *Id.* at 2100-53 to 2100-55.

72 *Id.* at 2100-53 to 2100-54.

73 *Id.* at 2100-54.

74 *Id.* at 2100-57 to 2100-58 and 2100-59 to 2100-61.

75 *Id.* at 2100-57 to 2100-58.

76 *Id.* at 2100-57.

77 1 DONALD S. CHISUM, CHISUM ON PATENTS § 3.06[4], at 3-111 n.2 (1997).

78 *Id.* Note, however, that the July 1996 edition of the MPEP does not contain § 901.05 section F.

79 MPEP at 2100-60 to 2100-61.

80 *Id.* at 2100-61.

81 *Id.* at 2100-20 to 2100-30 and 2100-129 to 2100-165.

82 *Id.* at 2100-130 to 2100-134.

83 *Id.* at 2100-135 to 2100-141.

84 *Id.* at 2100-141 to 2100-144.

85 *Id.* at 2100-25 to 2100-30.

86 *Id.* at 2100-145.

87 *Id.* at 2100-146 to 2100-147.

88 *In re Miller*, 441 F.2d 689, 693, 169 U.S.P.Q. (BNA) 597, 600 (C.C.P.A. 1971).

89 MPEP § 2173.05(b) at 2100-148 to 2100-150.

90 *Id.* § 2173.05(i) at 2100-153 to 2100-154.

91 *Id.* § 2173.05(k) at 2100-154.

92 *Id.* § 2173.05(m) at 2100-155.

93 The sixth paragraph of 35 U.S.C. § 112 provides:

An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.

94 MPEP at 2100-160 to 2100-165.

95 *Id.* at 2100-160 to 2100-161.

96 *Id.* at 2100-160.

97 *Id.* at 2100-161 to 2100-162.

98 *Id.* at 2100-161.

99 *Id.*

100 *Id.* at 2100-162 to 2100-164.

101 *Id.* at 2100-162.

102 16 F.3d 1189, 29 U.S.P.Q.2d (BNA) 1845 (Fed. Cir. 1994).

103 *Id.* at 1192, 29 U.S.P.Q.2d at 1848.

104 *Examination Guidelines for Claims Reciting a “Means or Step Plus Function” Limitation In Accordance With 35 U.S.C. § 112, 6th Paragraph*, 47 Pat. Trademark & Copyright J. (BNA), at 571 (April 28, 1994).

105 MPEP § 2131.05 at 2100-65.

106 *Id.*

107 231 U.S.P.Q. (BNA) 417, 424 (Ct. Cl. 1986).

108 671 F.2d 1344, 1350-51, 213 U.S.P.Q. (BNA) 1, 7 (C.C.P.A. 1982).

109 *Id.*

110 *Id.*

111 *Id.*

112 MPEP § 2131 at 2100-62.

113 710 F.2d 799, 218 U.S.P.Q. (BNA) 289 (Fed. Cir. 1983).

114 *Id.* at 800, 218 U.S.P.Q. at 290.

115 *Id.* at 801-02, 218 U.S.P.Q. at 291-92.

116 *Id.* at 800, 218 U.S.P.Q. at 290.

117 *Id.* at 801, 218 U.S.P.Q. at 291.

118 *Id.*

119 *Id.* at 803, 218 U.S.P.Q. at 292.

120 *Id.*, 218 U.S.P.Q. at 293.

121 MPEP at 2100-51.

122 *Id.*

123 *Id.*

124 263 F.2d 844, 848, 120 U.S.P.Q. (BNA) 528, 531 (C.C.P.A. 1959).

125 *Id.* at 844-45, 120 U.S.P.Q. at 528.

126 *Id.* at 845, 120 U.S.P.Q. at 529.

127 *Id.* at 847-48, 120 U.S.P.Q. at 531.

128 *In re Swinehart*, 439 F.2d 210, 169 U.S.P.Q. (BNA) 226 (C.C.P.A. 1971).

129 *Id.* at 212-14, 169 U.S.P.Q. at 228-30.

130 *See In re Caldwell*, 319 F.2d 254, 258, 138 U.S.P.Q. (BNA) 243, 247 (C.C.P.A. 1963).

131 *See In re Venezia*, 530 F.2d 956, 958-59, 189 U.S.P.Q. (BNA) 149, 151-52 (C.C.P.A. 1976).

132 *See In re Oelrich*, 666 F.2d 578, 581-82, 212 U.S.P.Q. (BNA) 323, 326 (C.C.P.A. 1981); *In re Mills*, 916 F.2d 680, 682-83, 16 U.S.P.Q.2d (BNA) 1430, 1432-33 (Fed. Cir. 1990).

133 *Lewmar Marine v. Barient, Inc.*, 827 F.2d 744, 751-52, 3 U.S.P.Q.2d (BNA) 1766, 1771 (Fed. Cir. 1987), *cert. denied*, 484 U.S. 1007 (1988).

134 *In re Chandler*, 254 F.2d 396, 117 U.S.P.Q. (BNA) 361 (C.C.P.A. 1958).

135 *See, e.g., In re Oelrich*, 666 F.2d 578, 212 U.S.P.Q. (BNA) 323 (C.C.P.A. 1981); *Raytheon Co. v. Roper Corp.*, 724 F.2d 951, 220 U.S.P.Q. (BNA) 592 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 835 (1984).

136 *In re Swinehart*, 439 F.2d 210, 213, 169 U.S.P.Q. (BNA) 226, 229 (C.C.P.A. 1971).

137 *Id.* at 212-13, 169 U.S.P.Q. at 228-29; *In re Ludtke*, 441 F.2d 660, 664, 169 U.S.P.Q. (BNA) 563, 566 (C.C.P.A. 1971).

138 *Swinehart*, 439 F.2d at 213, 169 U.S.P.Q. at 229, *Ludtke*, 441 F.2d at 664, 169 U.S.P.Q. at 566.

139 MPEP at 2100-62 to 2100-65.

140 *Id.* at 2100-112 to 2100-113.

141 *Id.* § 2131 at 2100-62.

142 *Id.* § 2143.03 at 2100-112.

143 *Id.* at 2100-152.

144 *Id.*, citing *In re Swinehart*, 439 F.2d 210, 169 U.S.P.Q. 226 (C.C.P.A. 1971).

145 MPEP at 2100-160 to 2100-161.

146 *Id.* at 2100-160.