

# Appendix V - 35 U.S.C. 112 Specification Requirements

2161 Three Separate Requirements for Specification Under 35 U.S.C. 112(a) or Pre-AIA 35 U.S.C. 112, First Paragraph

2161.01 Computer Programming and 35 U.S.C. 112(a) or Pre-AIA 35 U.S.C. 112, First Paragraph

I. DETERMINING WHETHER THERE IS ADEQUATE WRITTEN DESCRIPTION FOR A COMPUTER-IMPLEMENTED FUNCTIONAL CLAIM LIMITATION

II. BEST MODE

III. DETERMINING WHETHER THE FULL SCOPE OF A COMPUTER-IMPLEMENTED FUNCTIONAL CLAIM LIMITATION IS ENABLED

2162 Policy Underlying 35 U.S.C. 112(a) or Pre-AIA 35 U.S.C. 112, First Paragraph

2163 Guidelines for the Examination of Patent Applications Under the 35 U.S.C. 112(a) or Pre-AIA 35 U.S.C. 112, para. 1, "Written Description" Requirement

2164 The Enablement Requirement

2165 The Best Mode Requirement

2171 Two Separate Requirements for Claims Under 35 U.S.C. 112 (b) or Pre-AIA 35 U.S.C. 112, Second Paragraph

2172 Subject Matter Which the Inventor or a Joint Inventor Regards as The Invention

2172.01 Unclaimed Essential Matter

2173 Claims Must Particularly Point Out and Distinctly Claim the Invention

2173.01 Interpreting the Claims

2173.02 Determining Whether Claim Language is Definite

2173.03 Correspondence Between Specification and Claims

2173.04 Breadth Is Not Indefiniteness

2173.05 Specific Topics Related to Issues Under 35 U.S.C. 112(b) or Pre-AIA 35 U.S.C. 112, Second Paragraph

2173.05(a) New Terminology

2173.05(b) Relative Terminology

I. TERMS OF DEGREE

## II. REFERENCE TO AN OBJECT THAT IS VARIABLE MAY RENDER A CLAIM INDEFINITE

### III. APPROXIMATIONS

- A. "About"
- B. "Essentially"
- C. "Similar"
- D. "Substantially"
- E. "Type"

### IV. SUBJECTIVE TERMS

- 2173.05(c) Numerical Ranges and Amounts Limitations
- 2173.05(d) Exemplary Claim Language ("for example," "such as")
- 2173.05(e) Lack of Antecedent Basis
- 2173.05(f) Reference to Limitations in Another Claim
- 2173.05(g) Functional Limitations
- 2173.05(h) Alternative Limitations
- 2173.05(i) Negative Limitations
- 2173.05(j) Old Combination
- 2173.05(k) Aggregation
- 2173.05(m) Prolix
- 2173.05(n) Multiplicity
- 2173.05(o) Double Inclusion
- 2173.05(p) Claim Directed to Product-By- Process or Product and Process
- 2173.05(q) "Use" Claims
- 2173.05(r) Omnibus Claim
- 2173.05(s) Reference to Figures or Tables
- 2173.05(t) Chemical Formula
- 2173.05(u) Trademarks or Trade Names in a Claim
- 2173.05(v) Mere Function of Machine

2174 Relationship Between the Requirements of 35 U.S.C. 112(a) and (b) or Pre-AIA 35 U.S.C. 112, First and Second Paragraphs

2181 Identifying and Interpreting a 35 U.S.C. 112(f) or Pre-AIA 35 U.S.C. 112, Sixth Paragraph Limitation

2183 Making a Prima Facie Case of Equivalence

2184 Determining Whether an Applicant Has Met the Burden of Proving Nonequivalence After a *Prima Facie* Case Is Made

2185 Related Issues Under 35 U.S.C. 112(a) or (b) and Pre-AIA 35 U.S.C. 112, First or Second Paragraphs

2186 Relationship to the Doctrine of Equivalents