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THE “REGARDS AS HIS INVENTION” REQUIREMENT OF SECTION 112, PARAGRAPH 2 OF THE PATENT ACT: ENSURING THAT THE INVENTOR CLAIMS WHAT HE REGARDS AS HIS INVENTION

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Table of Contents

I.	Introduction	257
II.	The Origin of the “Regards as His Invention” Requirement	258
III.	The Application of the “Regards as His Invention” Requirement	261
	A. In the Patent and Trademark Office	261
	1. The “Mental Steps” Cases	262
	2. The “Inoperative Species” Cases	264
	3. The “Overclaiming” Cases	265
	B. By the Courts	267
IV.	Ensuring That the Inventor Claims What He Regards as His Invention	270
V.	Conclusion	271

I. Introduction

Section 112, paragraph 2 of the Patent Act provides that “[t]he specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant *regards as his invention*.”¹ The failure to particularly point out and distinctly claim the invention is frequently a basis for attacking and occasionally invalidating a patent claim.² But paragraph 2 provides another, less obvious, basis for rejecting and invalidating patent claims. When the record reflects a discrepancy between what the applicant has claimed and *258 what he regards as his invention, this paragraph has been used by the Patent and Trademark Office (PTO) to reject claims, and by the courts to invalidate them.³

This Article addresses the requirement in section 112, paragraph 2 that the applicant claim what he “regards as his invention.”⁴ Part II discusses the requirement’s historical origin. Part III explains the manner in which the “regards as his invention” requirement has been applied by the PTO and the courts. Finally, Part IV offers practical advice to the practitioner on how to avoid the potentially disastrous consequences of claiming something other than what the inventor genuinely regards as his invention.

II. The Origin of the “Regards as His Invention” Requirement

The first Patent Act of 1790, and the Patent Act of 1793 which replaced it, contained no specific requirement that the patentee claim “what he regarded as his invention.” The 1790 Act’s counterpart to the current section 112 provided that the grantee or grantees of each patent shall, at the time of granting the same, deliver to the Secretary of State a specification in writing, containing a description, accompanied with drafts or models, and explanations and models ... of the thing or things, by him or them invented or discovered, and described as aforesaid, in the said patents; which specification shall be so particular, and said models so exact, as not only to distinguish the invention or discovery from other things before known and used, but also to enable a workman or other person skilled in the art or manufacture, whereof it is a branch, or wherewith it may be nearest connected, to make, construct, or use the same, to the end that the public may have the full benefit thereof, after the expiration of the patent term⁵

The 1793 Act merely restated this requirement, concluding that the inventor

shall deliver a written description of his invention, and of the manner of using, or process of compounding the same, in such full, clear and exact terms, as to distinguish the same from all other things before known, and to enable any person skilled in the art or science, of which it is a branch, or with which it is most nearly connected, to make, compound, and use the same.⁶

In 1822, the U.S. Supreme Court in *Evans v. Eaton*⁷ addressed the requirements of the patent specification under the 1793 Act. Writing for the majority, Justice Storey stated that the specification has two objectives, one of which “is to make known the manner of constructing the machine ... so as to enable artizans to make and use it, and thus to give the public the full benefit of the *259 discovery after the expiration of the patent.”⁸ The second objective, according to Storey, is “to put the public in possession of *what the party claims as his own invention*, so as to ascertain if he claim anything that is in common use, or is already known, and to guard against prejudice or injury from the use of an invention which the party may otherwise innocently suppose not to be patented.”⁹ As the Court explained: “We do not say that the party is bound to describe the old machine; but we are of opinion that he ought to describe *what his own improvement is*, and to limit his patent to such improvement.”¹⁰

The second objective was expressly incorporated into the Patent Act of 1836, which directed that the inventor shall deliver a written description of his invention or discovery, and of the manner and process of making, constructing, using, and compounding the same, in such full, clear, and exact terms, avoiding unnecessary prolixity, as to enable any person skilled in the art or science to which it appertains, or with which it is most nearly connected, to make, construct, compound, and use the same ... and shall particularly specify and point out the part, improvement, or combination, *which he claims as his own invention or discovery*.¹¹

This requirement was carried forward in the Patent Act of 1870, which contained a provision, R.S. 4888, requiring the inventor to file in the Patent Office a written description of the invention with the Patent Office, including

the manner and process of making, constructing, compounding, and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art or science to which it appertains, or with which it is most nearly connected, to make, construct, compound, and use the same; ... and he shall particularly point out and distinctly claim the part, improvement, or combination *which he claims as his invention or discovery*.¹²

The Patent Act of 1952 did not significantly alter the long-standing requirements of patent specifications, except to require separate paragraphs for the written description and the statement of what the applicant regarded as his invention in order to emphasize the “distinction between the description and the claim.”¹³

In discussing the requirement that the applicant particularly point out and distinctly claim what he regards as his invention, early cases tended to differentiate between the prior art and what the applicant actually claimed as new. For example, *260 in *General Electric Co. v. Wabash Appliance Corp.*,¹⁴ the U.S. Supreme Court invalidated claims relating to filaments for an electric incandescent lamp, because after comparing the claim language with the descriptions of the prior art, the Court concluded that the patentee “did not adequately set out ‘what he claim ed to be new’” and did not “make claim to a distinct improvement.”¹⁵ Four years later, relying on its decision in *General Electric*, the Court in *United Carbon Co. v. Binney & Smith Co.*¹⁶ held certain patent claims invalid for indefiniteness because they failed to give adequate “notice required by the

statute.”¹⁷ Confusing the requirements of claim definiteness and claim distinctness with novelty, the Court held that “the statutory requirement of particularity and distinctness in claims is met only when the inventor clearly distinguishes what is claimed from what went before in the art and clearly circumscribes what is foreclosed from future enterprise.”¹⁸

The requirement that patent claims conform to what the inventor regards as his invention began to form out of the judicial and legislative mist from which the patent law was shaped in the early 1800s. Yet, it was many years before the courts first addressed the circumstance where the claims—though sufficiently distinct to meet the requirements of particularity and distinctness—covered subject matter that the applicant did not “regard as his invention.” Even today, claims are rarely rejected or invalidated because of a failure to meet the “regards as his invention” requirement, and this potential snag in the law is widely unappreciated by patent practitioners.

Among the earliest cases to squarely address the effect of a discrepancy between an applicant’s claims and what the applicant regards as his invention, was a patent infringement action brought in the Southern District Court of New York in 1956. In *Guide v. Desperak*,¹⁹ the court invalidated a patent because the claims covered more than what the applicant invented.²⁰ The claims at issue covered a sewing machine attachment by which precut, circular material in flat form could be *261 sewn together with spiral stitching.²¹ At trial, the plaintiff’s expert witness testified that the inventive aspect of the patent was the use of a U-shaped bar to hold the hemispherical workpiece in place.²² Relying on the U.S. Supreme Court’s decision in *Lincoln Engineering Co. v. Stewart-Warner Corp.*,²³ the district court held that the claims describing that feature were too broad since they merely improved upon one element of an old combination.²⁴ Drawing upon Justice Storey’s opinion in *Evans v. Eaton*, the court held that claims to combinations which incorporate more than the applicant’s invention violate section 112.²⁵

On appeal, the Second Circuit reversed the district court’s decision regarding section 112, stating that an old combination containing an improvement in a single element could nevertheless be patented.²⁶ However, the court ultimately affirmed the lower court’s finding of invalidity on the alternate ground of obviousness.²⁷

Guide signaled the beginning of the intermittent, but oft-times fatal, scrutiny of the “regards as his invention” requirement of section 112, paragraph 2. In cases that followed, the PTO and the courts began to reject or invalidate claims where the record reflected that such claims did not correspond to what the applicant regarded as his invention. As will be seen, this problem has arisen in a variety of contexts.

III. The Application of the “Regards as His Invention” Requirement

A. In the Patent and Trademark Office

Another early case to deal with the “regards as his invention” requirement, *In re Borkowski*,²⁸ made clear that claims are presumptively considered to cover what the applicant regards as his invention in the absence of contrary evidence in the record.²⁹ In *Borkowski*, the examiner rejected the applicant’s claims under section 112, paragraph 2 because the examiner concluded that the claims were broader than the disclosure.³⁰ However, Justice Rich of the Court of Customs and Patent Appeals *262 (CCPA), reversed the Patent Office Board of Appeals (which had affirmed the examiner’s rejection) stating:

We cannot agree that § 112 permits of such an approach to claims. The first sentence of the second paragraph of § 112 is essentially a requirement for *precision and definiteness* of claim language. If the scope of subject matter embraced by a claim is clear, and if the applicant has not otherwise indicated that he intends that claim to be of a different scope, then the claim does particularly point out and distinctly claim the subject matter which the applicant regards as his invention. That is to say, if the “enabling” disclosure of a specification is not commensurate in scope with the subject matter encompassed by a claim, that fact does not render the claim imprecise or indefinite or otherwise not in compliance with the *second* paragraph of § 112; rather, the claim is based on an *insufficient disclosure*.³¹

The cases where the PTO has rejected a patent for failing to meet the “regards as his invention” requirement can be organized into three categories: (1) cases avoiding application of the mental steps doctrine; (2) chemical cases where the claims encompass inoperative species; and (3) “overclaiming” cases where the claims are broader than the invention described in the specification.

1. The “Mental Steps” Cases

Section 101 of the Patent Act, which defines patentable subject matter, has been held to exclude such things as scientific theories, pure mathematics, and laws of nature.³² Under the so-called “mental steps doctrine,” no patent can be obtained for methods involving human participation as an essential element.³³ The “regards as his invention” requirement has come up several times in the context of the mental steps doctrine.

In re Prater,³⁴ one of the earliest such cases, involved an appeal to the CCPA from the Patent Office Board of Appeals. The Patent Office Board of Appeals had affirmed the examiner’s rejection of the applicant’s method and apparatus claims, which were directed to the processing and analysis of spectrographic data used to produce quantitative spectrographic charts.³⁵ The PTO took the position that the process claims were readable on mental processes, since the only physical limitation was the generation of tangible graphs, which the PTO argued could be accomplished by merely sketching the results on paper.³⁶ The appellants acknowledged in their appeal brief that the process claims (viewed apart from the disclosure) were broad *263 enough to cover the process of drawing the graphs by hand.³⁷ However, in seeking to avoid a section 101 rejection, the appellants urged that the claims could not be viewed in the abstract but had to be read in light of the specification (which disclosed that the process was to be carried out on a digital computer). Thus, the appellants contended that the patent only covered the machine-implemented process.³⁸ Nevertheless, the CCPA held the claims to be invalid under section 112, paragraph 2:

Inasmuch as claim 9, thus interpreted, reads on subject matter for which appellants do not seek coverage, and therefore tacitly admit to be beyond that which “applicant regards as his invention,” we feel that the claim fails to comply with 35 U.S.C. § 112 which requires that “[t]he specification shall conclude with one or more claims particularly pointing out and distinctly claiming *the subject matter which the applicant regards as his invention.*” This is true notwithstanding appellants’ disclosure of a *machine-implemented* process.³⁹

Refusing to read limitations from the specification into the claims, the Court stated that “claims not yet patented are to be given the broadest reasonable interpretation consistent with the specification *during the examination of a patent application* since the applicant at that time may then *amend* the claims.”⁴⁰ Having rejected the claim in question under section 112, paragraph 2, the court found it unnecessary to address the section 101 patentable subject matter issue.⁴¹

Prater highlights an important issue that runs through the “regards as his invention” cases—the evidence supporting a rejection for failure to meet the “regards as his invention” requirement is, in most cases, unwittingly supplied by either the inventor or his counsel. This problem, and strategies for avoiding it, will be considered in Part IV.

Shortly after the decision in *Prater*, the CCPA decided *In re Bernhart*⁴² and *In re Mahoney*,⁴³ two cases in which the mental steps doctrine was again at issue. In both of these cases, the CCPA reversed the PTO’s “regards as his invention” *264 rejections.⁴⁴ In both cases, however, the process claims survived a section 112, paragraph 2 attack for two reasons. First, the specifications were directed only to machinery for carrying out the processes.⁴⁵ Second, the claims in *Bernhart* required both a digital computer and a planar plotting apparatus to carry out the method,⁴⁶ while the claims in *Mahoney* contained the terms “bit stream” and “bit,” both of which could only be read as excluding mental performance of the claimed processes.⁴⁷ Thus, the CCPA found no discrepancy between what the claims covered and what the inventor regarded as his invention.⁴⁸

More recently, in *In re Foster*,⁴⁹ the CCPA upheld a section 112, paragraph 2 rejection of method claims directed to the processing of seismograms to compensate for signal distortion. The rejection was upheld because the term “signals,” as used in the claims, could be construed to include visible patterns generated by manual manipulation.⁵⁰ Here, as in *Prater*, the applicants’ counsel rushed in to save the claims from a section 101 rejection, taking the position that the applicants intended the claims to cover only the machine implementation of the process as opposed to any mental implementation of it. This probably saved the claims from a section 101 death by “hanging,” only to perish by a section 112, paragraph 2 “shooting.” The court, quoting the Patent Office Board of Appeals, explained:

To the extent that appellants have declared their intention not to claim herein a procedure that could be carried out manually but nevertheless have presented claims 26 and 27 which are so broad as to embrace a manual computation, or at most one using an electric desk calculator, these claims fail to point out that which appellants regarded as their invention as is necessary under 35 U.S.C. section 112.⁵¹

2. The “Inoperative Species” Cases

The inventor may also find himself faced with a section 112, paragraph 2 rejection if his claims are drawn to chemical compositions that read on a substantial number of inoperative species. In *In re Corkill*,⁵² the claims on appeal involved a detergent composition that called for, *inter alia*, an aluminosilicate ion exchange *265 material with a particle size diameter between 0.1 microns and 10 microns.⁵³ Three inconsistent declarations were filed on behalf of Corkill. At least one of these declarations stated that particles larger than 10 microns were unacceptable,⁵⁴ while another declaration indicated that agglomerates up to 100 microns in diameter would lead to acceptable results.⁵⁵

Corkill argued that simple experimentation would show which particles were deficient in achieving the desired exchange rate and should therefore be excluded.⁵⁶ However, the Federal Circuit, relying on the declarations submitted by the inventor, stated that the evidence submitted by Corkill showed that the claims did not correspond in scope to what the inventors regard as their invention.⁵⁷ “Claims which include a substantial measure of inoperativeness,” said the court, “are fairly rejected under 35 U.S.C. section 112.”⁵⁸

3. The “Overclaiming” Cases

In other cases, claim rejection has been upheld on the grounds that the claims were too broad because they covered subject matter not disclosed in the specification. While this could be viewed as a section 112, paragraph 1 inadequate disclosure problem, the PTO has often-times addressed this issue as a violation of the “regards as his invention” requirement of section 112, paragraph 2.

The patent at issue in *In re Cormany*⁵⁹ involved a solvent known as methylchloroform, which could be used for industrial degreasing in both liquid and vapor phases.⁶⁰ Claim 12 of the patent called for the addition of nitromethane and nitroethane in sufficient quantity to stabilize liquid methylchloroform refluxing under atmospheric conditions.⁶¹ The PTO rejected this claim for indefiniteness under section 112, paragraph 2 because the degree of stabilization was not clearly defined.⁶²

Looking to the patent, the court pointed out that the claim was not indefinite because the specification clearly disclosed the use of as little as 0.5 weight percent *266 nitroalkane.⁶³ However, when the court reviewed the two Rule 132 affidavits filed in the case, it became clear that the appellants did not regard the addition of 0.5 weight percent nitroalkane alone as being sufficient to stabilize the compound. Therefore, this parameter was not regarded as being within the scope of the invention.⁶⁴ Applying the “regards as his invention” requirement, the court held:

Appellants’ affidavits make clear that this is not an “amount ... large enough to stabilize” under the test conditions prescribed in these claims and that they do not regard it as within their invention. These claims, therefore, do not particularly point out and distinctly claim *what appellants regard as their invention* and do not comply with § 112, second paragraph. For this reason alone their rejection must be affirmed.⁶⁵

In *In re Conley*,⁶⁶ the PTO rejected a claim involving an invention that related to paper coatings and to a method of producing an improved dry particulate coating pigment.⁶⁷ The PTO rejected the process claims for indefiniteness under section 112, paragraph 2 because they called for, *inter alia*, the forming of “a satin white composition in aqueous suspension” but did not specify the operative proportions of satin white and kaolinate required.⁶⁸ The CCPA reversed, finding that the claims *were* definite because, according to the court, it was clear that if a person “formed a satin white compound in aqueous suspension,” that person would infringe the claim.⁶⁹ In a separate part of the opinion relating to the “regards as his invention” requirement, the court pointed out:

[O]ccasionally the first sentence of the second paragraph of § 112 has been relied upon as a basis for rejection of a claim, not because of “indefiniteness” of the claim language but because the language used did not particularly point out and distinctly claim the subject matter *which the applicant regards as his invention*. This portion of the statutory language has been relied upon in cases where some material submitted by applicant, *other than his specification*, shows that a claim does not correspond in scope with what *he regards* as his invention. There has been no reliance here on anything other than appellants’ specification to suggest this as a basis for the second paragraph rejection made.⁷⁰

The CCPA's holding in *Conley* echoes its earlier holding in *Borkowski*, namely that there is no basis for rejection under the "regards as his invention" requirement of section 112, paragraph 2 unless there is evidence *beyond the specification* *267 suggesting a difference between what is claimed and what the applicant "regards as his invention."⁷¹ The same variance between the scope of the specification and the claims resulted in a PTO rejection under the "regards as his invention" requirement in *In re Ehrreich*.⁷²

B. By the Courts

The "regards as his invention" requirement can also be violated where evidence in the record shows that inventorship has been incorrectly identified. In *Bontrager v. Steury Corp.*,⁷³ the prosecution history indicated irregularities in the filing of the Bontrager patent application.⁷⁴ Moreover, Bontrager admitted at trial that his patent claims covered subject matter conceived by one of his colleagues.⁷⁵ On that record, the Indiana district court held that the failure to join the colleague as an inventor, while including his concepts in the patented claims, rendered the claims invalid under section 112.⁷⁶

A somewhat similar problem occurred in *Brennan v. Mr. Hanger, Inc.*⁷⁷ There, evidence produced at trial showed that certain claim language had been added at the suggestion of the PTO examiner after all the claims had been rejected in view of the prior art.⁷⁸ Unfortunately the patent specification did not mention the relationship described in the examiner's suggested language, much less disclose its functional significance.⁷⁹ Indeed, the application's drawings and specification *268 showed a structure that was directly contrary to the revised claim language.⁸⁰ The trial court held the claims to be invalid under 35 U.S.C. § 112, ¶1 because the specification failed to disclose the claimed invention. However, the court went on to say that claim 1 "clearly did not satisfy the requirement of 'particularly pointing out and distinctly claiming' the alleged invention, as established by 35 U.S.C. § 112, and *would probably be invalid* for that reason if no other."⁸¹

In other cases, the distinction between what is claimed and what the applicant "regards as his invention" is clear. In *General Electric Co. v. United States*,⁸² two claims in suit were held invalid because the prosecution history revealed that the subject matter of the claims added during prosecution was clearly not what the applicants regarded as their invention.⁸³ Claims 35 and 36 in this case were drawn to a positional control system used to maintain positional correspondence between two objects while eliminating the problem of "hunting."⁸⁴ The specification stated that the anti-hunting means recited in the claims was intended to generate a modifying signal only during changing drive motor current conditions.⁸⁵ Moreover, the applicants argued during prosecution of the patent that the anti-hunting means responded only to changes in the current supplied to the driving motor.⁸⁶ However, the claims failed to recite a transformer, which the specification noted was an essential element of the combination because it prevented generation of a modifying signal by the anti-hunting means under constant current drive motor conditions.⁸⁷ Finding that the combination as claimed was inoperative, the court held the claims to be invalid under section 112, paragraph 2.⁸⁸

In *Inpro, Inc. v. A.W. Chesterton Co.*,⁸⁹ the inventor's own pretrial deposition was his undoing, leading ultimately to summary judgment on the basis that all of the claims in suit were invalid under 35 U.S.C. § 112, ¶2.⁹⁰ The patent-in-suit covered a labyrinth seal "used in bearing housings to prevent egress of lubricating fluid and *269 the ingress of contaminants."⁹¹ During his deposition, the inventor identified three features that he believed distinguished the claimed invention from prior art seals: (1) the slots in the flange of the rotating cap; (2) the exit hole used to expel contaminants; and (3) the recess in the stationary ring, which had a certain minimum depth to contain and control contaminants.⁹² The inventor also testified that the invention would not work satisfactorily without the exit hole.⁹³ Rebuffing the patentee's efforts to read these limitations into the claims,⁹⁴ the court held the claims invalid under section 112, paragraph 2 because they omitted critical limitations and elements that the applicant regarded as essential to his invention.⁹⁵

Although the Federal Circuit has yet to affirm the invalidation of a patent claim in an infringement action based upon a discrepancy between what is claimed and what the applicant regards as his invention, the court's opinion in *Stiftung v. Renishaw, PLC*⁹⁶ suggests that, on proper facts, it would endorse such a holding.⁹⁷ The patent at issue in *Stiftung* involved devices for measuring the dimensions of objects to extremely fine precision. The district court invalidated claim 3 of the patent under section 112, paragraph 2, for failure to claim what the inventor regarded as his invention, on the theory that the claim failed to recite any electrical circuitry or other signaling means (which the specification stated was necessary for a complete probe).⁹⁸ However, claim 3 was not directed to a probe *per se*, but rather to a device whose function was simply to mount a stylus in a position-determining apparatus—a device that had utility separate and apart from any signaling means.⁹⁹

Consequently, the Federal Circuit reversed the district court, pointing out that the *270 district court's holding was based on a misconstruction of the claim and a misunderstanding of the applicable provisions of patent law.¹⁰⁰

IV. Ensuring That the Inventor Claims What He Regards as His Invention

An analysis of the foregoing cases reveals that the evidentiary basis for rejecting or invalidating claims under the “regards as his invention” requirement of section 112, paragraph 2 is usually a matter of inattentive patent prosecution or perhaps inadequate witness preparation. As these cases make clear, arguments made during prosecution, as well as declarations and depositions submitted by or on behalf of the inventor, can supply the factual basis necessary to support a “regards as his invention” rejection or invalidation.

Several lessons can be learned from these cases that may assist counsel in ensuring that the inventor correctly and consistently claims what he regards as his invention. First, the inventor must be correctly identified, and if necessary, inventorship should be corrected during the prosecution of a patent. Patent counsel must resist the temptation to assist the inventor by suggesting technical and engineering details concerning the invention; claiming concepts suggested by patent counsel could violate the “regards as his invention” requirement if the counsel is not named as a co-inventor. Also, counsel should make sure that any claim language introduced at the suggestion of the patent examiner is within the scope of what the inventor regards as his invention. It is good practice to review such proposed claims with the inventor before the notice of allowance and to have the inventor execute a supplemental declaration.¹⁰¹

Second, counsel should ensure that the inventor and other witnesses fully understand the theory of the invention, how it advances the art, and which elements and limitations in the claims are essential to the invention. Although counsel should not “coach” a witness as to the facts, it is counsel's responsibility to make sure that the inventor or witness understands what the claimed invention is, how it differs from the prior art, and how careless answers to questions concerning what the inventor regards as his invention could have an adverse impact on the patent's validity.¹⁰²

Third, counsel should make sure that all attorneys involved in prosecuting a patent application understand the invention; that they communicate with the inventor concerning the invention at all times during the prosecution of the application; and *271 that they do not advance arguments inconsistent with what the applicant “regards as his invention.”

Fourth, patent counsel should be circumspect about arguments made to the PTO concerning claim coverage. If the claims, read literally, are at variance with statements about what the invention is intended to cover, this could create a “regards as his invention” problem.

Finally, counsel should ensure that the claims recite the features the inventor regards as being essential to the invention. This requires communication at the time of disclosure and throughout the prosecution of the case, as well as careful preparation of the inventor in the event he testifies at a deposition or trial in a patent infringement case.

V. Conclusion

The requirement in section 112, paragraph 2 that patent claims particularly point out and distinctly indicate “what the applicant regards as his invention” is not widely appreciated as a basis for claim rejection or invalidation. Patent solicitors and litigators alike need to appreciate the consequences of a discrepancy between what the claims cover and what the applicant believes he invented. Such insight can be crucial in both defending and challenging patent claims.

Footnotes

^{a1} Thompson & Knight, P.C., Dallas, TX.

¹ 35 U.S.C. § 112, ¶2 (1994) (emphasis added).

2 This defect is typically referred to as “claim indefiniteness.”

3 Legal commentary on this aspect of section 112, paragraph 2 is sparse. For a general discussion, see Eric T. Jones, *The “Regards” Test of 35 U.S.C. § 112 ¶2: Inventors, Do You Really Know What Your Invention Is?*, 2 THE LAW WORKS pt. 1, April 1995 (No. 4) at 16, pt. 2, May 1995 (No. 5) at 7.

4 35 U.S.C. § 112, ¶2 (1994).

5 Act of April 10, 1790, ch. 7, § 2, 1 Stat. 109, 11 (repealed 1793).

6 Act of February 21, 1793, ch. 11, § 3, 1 Stat. 318, 321 (repealed 1836).

7 20 U.S. (7 Wheat.) 356 (1822).

8 *Id.* at 433-34.

9 *Id.* at 434 (emphasis added).

10 *Id.* at 435 (emphasis added).

11 Act of July 4, 1836, ch. 357, § 6, 5 Stat. 117, 119 (repealed 1870) (emphasis added).

12 Act of July 18, 1870, ch. 230, § 26, 16 Stat. 198, 201 (repealed 1952) (emphasis added).

13 Act of July 19, 1952, Ch. 950, § 112, 66 Stat. 792, 798 (1952); see P.J. Federico, *Commentary on the New Patent Act*, 75 J. PAT. [& TRADEMARK] OFF. SOC’YYYYY 161, 186 (1993) (formerly printed in 35 U.S.C.A. §§ 1 et seq. (1954)).

14 304 U.S. 364 (1938).

15 *Id.* at 368-70. The Court’s opinion is not a model of clarity, and it exemplifies that era’s confusion over the differences among what are now sections 102, 103, and 112 of the Patent Act. For example, the Court’s opinion seems alternatively to rest on the ground that the claims failed to distinguish over the prior art and on the ground that the claims contained indeterminate adjectives to describe the function of the composition. *Id.* at 368-71.

16 317 U.S. 228 (1942).

17 *Id.* at 233.

18 *Id.* at 236. Reaching this conclusion, the Court found it unnecessary to consider questions of novelty and invention. *Id.* at 237. Occasionally, this approach has been followed by other courts. See, e.g., *National Research Dev. Co. v. Great Lakes Carbon Corp.*, 410 F.Supp. 1108, 1120-22 (D. Del. 1975).

19 144 F.Supp. 182, 111 U.S.P.Q. (BNA) 32 (S.D.N.Y. 1956), *aff’d*, 249 F.2d 145, 115 U.S.P.Q. (BNA) 156 (2d Cir. 1957).

20 *Id.* at 187, 111 U.S.P.Q. at 36.

21 *Id.* at 183, 111 U.S.P.Q. at 33.

22 *Id.* at 184 and text accompanying n.2, 111 U.S.P.Q. at 33 and text accompanying n.2.

23 303 U.S. 545 (1938).

24 *Guide*, 144 F.Supp. at 185, 111 U.S.P.Q. at 34-35.

25 *Id.* at 185, 111 U.S.P.Q. at 35.

26 *Guide*, 249 F.2d at 147, 115 U.S.P.Q. at 158.

27 *Id.* at 148, 115 U.S.P.Q. at 158

28 422 F.2d 904, 164 U.S.P.Q. (BNA) 642 (C.C.P.A. 1970).

29 *Id.* at 909, 164 U.S.P.Q. at 646

30 *Id.*

31 *Id.* at 909, 164 U.S.P.Q. at 645-46 (citations omitted).

32 *See, e.g.*, *Diamond v. Diehr*, 450 U.S. 175, 185, 209 U.S.P.Q. (BNA) 1, 7 (1981); *Tol-O-Matic, Inc. v. Proma Product-und Mktg. Gesellschaft M.b.H.*, 945 F.2d 1546, 1552, 20 U.S.P.Q.2d (BNA) 1332, 1338 (Fed. Cir. 1991).

33 *See* 1 DONALD S. CHISUM, PATENTS, § 1.03[6] (1996).

34 415 F.2d 1393, 162 U.S.P.Q. (BNA) 541 (C.C.P.A. 1969).

35 *Id.* at 1395, 162 U.S.P.Q. at 543.

36 *Id.* at 1398, 162 U.S.P.Q. at 545.

37 *Id.* at 1404, 162 U.S.P.Q. at 550.

38 *Id.* at 1403, 162 U.S.P.Q. at 549-50.

39 *Id.* at 1404, 162 U.S.P.Q. at 552.

40 *Id.* at 1404-05, 162 U.S.P.Q. at 550. This approach to claim interpretation directly contrasts with the common practice in infringement actions of narrowly construing claims in light of the specification, prosecution history, prior art, and other claims. *See, e.g., In re Zletz*, 893 F.2d 319, 321, 13 U.S.P.Q. (BNA) 1320, 1321-22 (Fed. Cir. 1989).

41 *Prater*, 415 F.2d at 1405, 162 U.S.P.Q. at 551. With respect to the apparatus claims, the court did not find any mental steps issue because the claims contained means-plus-function language, which, under 35 U.S.C. § 112, ¶6, is to be “construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.” *Id.* at 1406, 162 U.S.P.Q. at 551.

42 417 F.2d 1395, 163 U.S.P.Q. (BNA) 611 (C.C.P.A. 1969).

43 421 F.2d 742, 164 U.S.P.Q. (BNA) 572 (C.C.P.A. 1970).

44 *Bernhart*, 417 F.2d at 1400, 163 U.S.P.Q. at 616; *Mahoney*, 421 F.2d at 745, 164 U.S.P.Q. at 575.

45 *Bernhart*, 417 F.2d at 1401, 163 U.S.P.Q. at 617; *Mahoney*, 421 F.2d at 745-46, 164 U.S.P.Q. at 575.

46 *Bernhart*, 417 F.2d at 1401, 163 U.S.P.Q. at 617.

47 *Mahoney*, 421 F.2d at 746, 164 U.S.P.Q. at 575-76.

48 *Id.*

49 438 F.2d 1011, 169 U.S.P.Q. (BNA) 99 (C.C.P.A. 1971).

50 *Id.* at 1015-16, 169 U.S.P.Q. at 101-02. However, the court found that claims containing the narrower term “electrical signals” were patentable because they read only on machine implementations of the process, inasmuch as those “signals” were limited to machine implementation. *Id.* at 1016, 169 U.S.P.Q. at 102.

51 *Id.* at 1015, 169 U.S.P.Q. at 101.

52 771 F.2d 1496, 226 U.S.P.Q. (BNA) 1005 (Fed. Cir. 1985).

53 *Id.* at 1497, 226 U.S.P.Q. at 1006.

54 *Id.* at 1500, 226 U.S.P.Q. at 1009.

55 *Id.*

56 *Id.* at 1501, 226 U.S.P.Q. at 1009.

57 *Id.*

58 *Id.*

59 476 F.2d 998, 177 U.S.P.Q. (BNA) 450 (C.C.P.A. 1973).

60 *Id.*, 177 U.S.P.Q. at 451.

61 *Id.* at 999, 177 U.S.P.Q. at 451.

62 *Id.* at 1000, 177 U.S.P.Q. at 451-52.

63 *Id.* at 1001, 177 U.S.P.Q. at 453.

64 *Id.* at 1002, 177 U.S.P.Q. at 453.

65 *Id.* at 1002, 177 U.S.P.Q. at 453 (emphasis added). The court also rejected the claim under the first paragraph of section 112 because there was no support in the specification for the assertion made by the Rule 132 affiant, that an amount “large enough to stabilize” the mixture must comprise at least 0.9 weight percent. *Id.*

66 490 F.2d 972, 180 U.S.P.Q. (BNA) 454 (C.C.P.A. 1974).

67 *Id.* at 974, 180 U.S.P.Q. at 455.

68 *Id.* at 974, 180 U.S.P.Q. at 455.

69 *Id.* at 976, 180 U.S.P.Q. at 456.

70 *Id.* at 976, 180 U.S.P.Q. at 456-57 (citations omitted).

71 The C.C.P.A. pointed out that this does not mean that claims cannot be rejected for indefiniteness under section 112, paragraph 2 by reference to the specification, but rather that the specification alone cannot supply evidence that what the applicant has claimed is not his invention. *Id.* at 976, 180 U.S.P.Q. at 457.

72 590 F.2d 902, 200 U.S.P.Q. (BNA) 504 (C.C.P.A. 1979). The invention in *Ehrreich* related to electrically conductive compounds for use in waveguide assemblies, which required environmental sealing and the prevention of electromagnetic radiation. *Id.* at 903, 200 U.S.P.Q. at 503. The claims called for a resin matrix loaded with silver-coated particles between 0.5 and 40 mils in size. *Id.* at 905, 200 U.S.P.Q. at 506. The specification emphasized the necessity of using coarse particles, but the claims did not define the lower limit of particle size, which the specification said was critical. *Id.* at 905, 200 U.S.P.Q. at 506. The CCPA reversed the PTO’s rejection because the rejection was not based on indefiniteness or a lack of clarity in claim language, but rather on an alleged lack of agreement between the scope of the claims and the specification. *Id.* at 905, 200 U.S.P.Q. at 506. As in *Borkowski*, the court emphasized that it was improper for the PTO to read the specification and come to its own conclusions concerning what the applicant regarded as his invention. *Id.* at 906-07, 200 U.S.P.Q. at 508.

73 457 F.Supp. 526, 201 U.S.P.Q. (BNA) 813 (N.D. Ind. 1978), *aff'd*, 624 F.2d 1103 (7th Cir. 1979).

74 *Id.* at 528, 201 U.S.P.Q. at 816.

75 *Id.*

76 *Id.* at 541, 201 U.S.P.Q. at 824.

77 479 F.Supp. 1215, 203 U.S.P.Q. (BNA) 697 (S.D.N.Y. 1979).

78 *Id.* at 1227, 203 U.S.P.Q. at 707.

79 *Id.* at 1227-28, 203 U.S.P.Q. at 708.

80 *Id.* at 1227, 203 U.S.P.Q. at 707-08.

81 *Id.* at 1227, 203 U.S.P.Q. at 708 (emphasis added).

82 572 F.2d 745, 198 U.S.P.Q. (BNA) 65 (Ct. Cl. 1978). The U.S. Court of Claims, like the CCPA, was one of the predecessor courts to the U.S. Court of Appeals for the Federal Circuit. The Trial Division of the former U.S. Court of Claims is now known as the U.S. Claims Court.

83 *Id.* at 755, 198 U.S.P.Q. at 73.

84 *Id.* at 750-51, 198 U.S.P.Q. 69-70. "Hunting" is the term used to describe the oscillational interference typically associated with conventional positional servomechanisms.

85 *Id.* at 754, 198 U.S.P.Q. at 73.

86 *Id.* at 752-53, 198 U.S.P.Q. at 71.

87 *Id.* at 755, 198 U.S.P.Q. at 73.

88 *Id.* at 754-55, 198 U.S.P.Q. at 73.

89 657 F.Supp. 935, 2 U.S.P.Q.2d (BNA) 1597 (N.D. Ill. 1987).

90 *Id.* at 936, 2 U.S.P.Q.2d at 1598.

91 *Id.*

92 *Id.* at 942-43, 2 U.S.P.Q.2d at 1603-04.

93 *Id.* at 943, 2 U.S.P.Q.2d at 1604.

94 The court acknowledged that while the drawings accompanying the claims could be used as an aid in interpreting the claims, the “features not mentioned in the claims [could not] be inferred from the drawing,” and the limitations in the specification not recited in the claims could not be read into the claims where the claims do not call out such features. *Id.* at 943, 2 U.S.P.Q.2d at 1604 (citing *Environmental Designs, Inc. v. Union Oil of California, Inc.*, 713 F.2d 693, 699, 218 U.S.P.Q. (BNA) 865, 871 (Fed. Cir. 1983)).

95 *Id.* at 945, 2 U.S.P.Q.2d at 1605. Indeed, when an inventor discloses, but fails to claim in a patent application, “subject matter which [he] regards as his invention,” the unclaimed subject matter is dedicated to the public, unless, within two years from issuance, the patentee seeks a reissue patent with claims directed to that subject matter. *See Maxwell v. J. Baker, Inc.*, 86 F.3d 1098, 1106-07, 39 U.S.P.Q.2d (BNA) 1001, 1006 (Fed. Cir. 1996).

96 945 F.2d 1173, 20 U.S.P.Q.2d (BNA) 1094 (Fed. Cir. 1991).

97 The Federal Circuit has, of course, tacitly recognized the existence of such a requirement in *In re Corkill*, 771 F.2d 1496, 226 U.S.P.Q. 1005 (Fed. Cir. 1985).

98 *Stiftung*, 945 F.2d at 1179, 20 U.S.P.Q.2d at 1100.

99 *Id.* at 1180-81, 20 U.S.P.Q.2d at 1100-01. The court distinguished this case from *General Electric*, because in that case, the claim was found to be inoperative in achieving its claimed function. *General Electric*, 572 F.2d at 754-55, 198 U.S.P.Q. at 73. By contrast, in *Stiftung*, the Federal Circuit held that the claimed device *was* capable of performing its claimed purpose, namely of mounting a stylus in position-determining apparatus so as to provide for repeatable displacement and return to the rest position. 945 F.2d at 1181-82, 20 U.S.P.Q.2d at 1101.

100 *Id.* at 1182, 20 U.S.P.Q.2d at 1101.

101 37 C.F.R. § 1.67 provides for the filing of a supplemental oath or declaration when a claim is presented for a matter “originally shown or described but not substantially embraced in the statement of invention or claims originally presented.”

102 *See Eric T. Jones, The “Regards” Test of 35 U.S.C. § 112, ¶2: “Inventors, Do You Really Know What Your Invention Is?” 2 THE LAW WORKS*, pt. 3, June, 1995 (No. 6) at 10.