

From: mkm@mkmoran.com
To: [FOIA Requests](#); [FOIA Requests](#)
Subject: FOIA request for examiner training materials
Date: Monday, March 15, 2021 3:54:56 PM

Dear FOIA Office:

Please provide the requested material for Requests 1(a), 1(b), 2, and 3 in its native electronic form such as Excel, Microsoft Word or PDF documents, preferably by email to mkm@mkmoran.com, or via some other electronic form that preserves all document integrity.

Request 1(a):

Please provide any documents relating to examination for:

- indefiniteness or
- claim language not entitled to weight

applicable to a patent application claim that is directed to a component, and defines the component via its interaction with a workpiece, or environmental or complementary computer/component.

Request 1(b):

Please provide any documents relating to the term “positively recited,” either to define the term, or to set standards for examination of claim language that is either “positively recited” or “not positively recited.”

Context for requests 1(a) and 1(b).

If component X is only useful when used in combination with Y, but X is sold separately from Y, a patent application must claim X separately from Y. Examples include when computers X and Y are owned by different parties, or X is a replaceable part that works with a reusable Y, or X is a surgical instrument to be used with patient Y. In such cases, a viable patent claim must recite X as a discrete component. Often the best way to claim X is via its interaction (structural or functional) with Y. Y is often recited in functional language. An example claim might something like this:

An apparatus comprising:

a component X designed to do A, to send message B to a component Y (or perform action B on a Y), the Y being designed to respond to B by doing C and returning result D;

component X being further designed to react to D by doing E.

The request seeks any documents, either from OPLA or 3700, to suggest that advises examiners that claim language reciting interactions with or actions of a workpiece, or environmental or cooperating or mating component Y, is either indefinite, or is to be denied patentable weight.

Known documents. MPEP § 2173.02 and § 2173.02(II) discuss claims that claim one apparatus via its interrelationship with another, in its discussion of *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565, 1 USPQ2d 1081 (Fed. Cir.1986).

I fully expect that the answer is that no responsive documents exist, and in that case, a statement to that effect is fully responsive.

Request 2:

Please provide any documents directed to examination under § 102 or § 103 of claims with language *outside the claim preamble* thought to include “statement of intended use.”

Known documents. MPEP § 2103(II) states that “intended use” language may “raise a question,” but apparently MPEP Chapter 2100 gives no guidance for how that question is to be resolved. This request is directed to any documents that are issued to examiners as guidance for that question.

Request 3.

Please provide any documents directed to examiners’ authority to rely on or obligations to be bound by decisions of courts, and precedential, informative, and/or nonprecedential decisions of the PTAB.

GENERAL

- Requests 1(a), 1(b), 2, and 3 seek documents directed to examiners in Group 3700, including documents issued to the entire patent examining corps and to examiners in Group 3700.
- Requests 1(a), 1(b), 2, and 3 seek examiner guidance, memoranda, examiner training materials, examiner performance plan or other evaluation materials, or other documents directed to examiners’ examination of patent applications.
- Requests 1(a), 1(b), and 2 seek documents issued or in effect any time 1/1/2016 to present.
- Request 3 seeks documents issued or in effect any time 1/1/2011 to present.

Thank you.

Maura K. Moran

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