

From: Paschall, Jim
Sent: Friday, March 15, 2013 6:12 PM
To: QualityApplications_Comments
Subject: Honeywell Comments on Patent Preparation Practice

Dear Director Terry Rea,

Attached please find comments of Honeywell International Inc. pursuant to the USPTO's "Request for Comments on Preparation of Patent Applications," 78 Fed. Reg. 2960 (Jan. 15, 2013). Thank you for your consideration of these comments.

Best regards,
James C. Paschall

Patent Counsel
Law Department
UOP LLC
25 E. Algonquin Road
Des Plaines, IL 60017-5017
Phone - 847.391.2355
Fax - 847.391.2387
james.paschall@honeywell.com
www.uop.com

Honeywell International Inc.
101 Columbia Road
Morristown, NJ 07962

March 15, 2013

Submitted to: QualityApplications_Comments@uspto.gov

Hon. Terry Stanek Rea
Acting Under Secretary of Commerce for Intellectual Property
and Acting Director of the USPTO
600 Dulany Street
P.O Box 1450
Alexandria, VA 22313

Re: Request for Comments on Preparation of Patent Applications, 78 Fed. Reg. 2960 (January 15, 2013)

Dear Director Rea:

Honeywell International Inc. (Honeywell) is submitting the following comments pursuant to the USPTO's "Request for Comments on Preparation of Patent Applications," 78 Fed. Reg. 2960 (Jan. 15, 2013) (the "Federal Register notice").

Honeywell (www.honeywell.com) is a Fortune 100 diversified technology and manufacturing leader, serving customers worldwide with aerospace products and services; control technologies for buildings, homes and industry; turbochargers; and performance materials. Based in Morris Township, New Jersey, Honeywell's shares are traded on the New York, London, and Chicago Stock Exchanges. For more news and information on Honeywell, please visit www.honeywellnow.com.

Honeywell is grateful to the United States Patent and Trademark Office (Office) for the opportunity to comment on the proposed practices on the preparation of patent applications. Honeywell supports the Office's ongoing commitment to seek public input to improve the clarity of patents, particularly of patent claims, but believe many of the proposed practices are already standard. While appreciating the intent to make claims more clear, Honeywell believes additional proposed practices that are not standard, would result in an additional burden on the applicant that would not be proportional to the improvement in patent clarity. Moreover, some non-standard practices would force applicants to narrow their claim scope prior to prosecution without the necessity of avoiding prior art, thereby diminishing the general efficacy of patents in excluding others from usurping patented inventions.

The Federal Register notice sets forth a number of proposed practices regarding patent preparation practice to which Honeywell provides the following general comments to the specific proposed practices.

A. Clarifying the Scope of the Claims

1. Presenting claims in a multi-part format by way of a standardized template that places each claim component in separate, clearly marked, and designated fields. For instance, a template may facilitate drafting and review of claims by separately delineating each claim component into separate fields for the preamble, transitional phrase, and each particular claim limitation.

While Honeywell appreciates the effort to make patent claims more clear, most practitioners already provide claims with a preamble and a transitional phrase. Applicants are required to separate steps or elements by indentations. 37 C.F.R. 1.75(i). Consequently, if claim components are not sufficiently delineated, the Office may object to the claim. It is submitted that fitting all claims into a template would represent an unnecessary effort in a vast majority of applications that would provide no additional clarity to the claim scope over that required by existing Patent Rules.

2. Identifying corresponding support in the specification for each of the claim limitations utilizing, for example, a claim chart or the standardized template described above. This practice could be particularly beneficial where claims are amended or where a continuing application (continuation, divisional, continuation-in-part) is filed.

The Patent Rules currently require support for claim limitations: “[C]laims must find clear support or antecedent basis in the description so that the meaning of the terms in the claims may be ascertainable by reference to the description.” 37 CFR 1.75(d)(1). Office procedure allows objection to the claims if support is not in the specification: “If the specification does not provide the needed support or antecedent basis for the claim terms, the specification should be objected to under 37 CFR 1.75(d)(1)” and the applicant be required to make an appropriate amendment to the description without introducing new matter or amend the claim. MPEP 2173.03. It is submitted that existing rules are adequate to ensure that support for claim limitations is provided in the specification. If the Office believes claim(s) lack support as required in the Patent Rules, the existing remedy is to object to the claim. Requiring applicants to provide a claim chart to identify support for each claim limitation would place an additional burden on applicants during the application preparation stage.

3. Indicating whether examples in the specification are intended to be limiting or merely illustrative.

It is submitted that this practice would not improve clarity in the claims because, as currently seen in applications, applicants often initially consider examples to be illustrative.

4. Identifying whether the claim preamble is intended to be a limitation on claim scope.

Generally speaking, preambles that limit structure or manipulation are taken as a claim limitation, but preamble statements merely reciting purpose or intended use do not. *Rowe v. Dror*, 112 F.3d 473, 478, 42 USPQ2d 1550, 1553 (Fed. Cir. 1997). Current Office practice of denying patentable weight to all recitations in the claim preamble unless the applicant amends to move that recitation into the body of the claim has proven effective in resolving ambiguity in the import of the claim preamble when necessary to avoid prior art. In light of the practice on the part of the Office, requiring applicants to take a position on the preamble before prosecution would seem to be unnecessary.

5. Expressly identifying clauses within particular claim limitations for which the inventor intends to invoke 35 U.S.C. 112(f) and pointing out where in the specification corresponding structures, materials, or acts are disclosed that are linked to the identified 35 U.S.C. 112(f) claim limitations.

The Federal Circuit has ruled that the Office should consider the structure disclosed in the specification corresponding to means language when rendering a patentability determination. *In re Donaldson Co.*, 16 F.3d 1189, 1195, 29 USPQ2d 1845, 1850 (Fed. Cir. 1994) (in banc). Consequently, the Office may determine that a clause should be treated as a means or a step plus function recitation that invokes 35 U.S.C. 112(f). MPEP 2181. Moreover, the Office may reject a claim under 35 U.S.C. 112(b) if the specification “fails to link or associate the disclosed structure, material, or acts to the claimed function, or if there is no disclosure (or insufficient disclosure) of structure, material, or acts for performing the claimed function.” MPEP 2181. Consequently, during prosecution, the Office may construe a claim limitation to be a means clause and identify the structure, material or act in the specification to which the means clause is limited if the claim so construed can be rejected over appropriate prior art. At that point, the applicant can choose to argue against the construction, amend his claim so as to not invoke 35 U.S.C. 112(f) or identify another structure, material or act in the specification that he contends is associated with the means clause. Accordingly, the applicant should not be required to elect a narrowed claim construction before being confronted with prior art that would help frame the election in prosecution.

6. Using textual and graphical notation systems known in the art to disclose algorithms in support of computer-implemented claim limitations, such as C-like pseudo-code or XML-like schemas for textual notation and Unified Modeling Language (UML) for graphical notation.

Honeywell has no comment on this proposed practice.

B. Clarifying the Meaning of Claim Terms in the Specification

1. Indicating whether terms of degree--such as substantially, approximately, about, essentially--have a lay or technical meaning and explaining the scope of such terms.

It is a reasonable presumption that all “terms of degree” in a patent claim would have a technical meaning. Additionally, Office practice requires a determination that the specification provide a standard for measuring the “degree” used in a “term of degree” or that one of ordinary skill could nevertheless ascertain the scope of the claim. MPEP 2173.05(b). Otherwise, the Office may reject the claim for indefiniteness under 35 U.S.C. 112(b). If the Office cites prior art that it contends teaches within the recited “term of degree”, then the applicant has the option of amending to include a precise limitation in the claim to distinguish the teaching. It is submitted that the applicant should not be required to elect a narrowed claim term before being confronted with prior art that would frame the election in prosecution. Requiring this practice would narrow the claim scope and hence diminish the ability of patent claims to exclude.

2. Including in the specification a glossary of potentially ambiguous, distinctive, and specialized terms used in the specification and/or claims, particularly for inventions related to certain technologies, such as software.

The claims must particularly point out and distinctly claim the subject matter of the invention. 35 U.S.C. 112(b). Consequently, definitions of potentially ambiguous, distinctive, and specialized terms must be apparent in the specification and drawings or be ascertainable to one of ordinary skill in the art. MPEP 2173.05(b). Providing a glossary of definitions for such terms is a practice which many practitioners use. However, providing a glossary should not be the only acceptable way to provide these definitions especially when a term definition can be readily electronically searched in a patent specification.

3. Designating, at the time of filing the application, a default dictionary or dictionaries (e.g., a technical dictionary and a non-technical dictionary) to be used in ascertaining the meaning of the claim terms.

As previously stated, claims must particularly point out and distinctly claim the subject matter of the invention, 35 U.S.C. 112(b), and definitions of claim terms must be apparent. However, a patent applicant is free to be his or her own lexicographer. *Process Control Corp. v. HydReclaim Corp.*, 190 F.3d 1350, 1357, 52 USPQ2d 1029, 1033 (Fed. Cir. 1999). Dictionary definitions may be used to define claim terms in the absence of a definition in the intrinsic evidence comprising the specification, drawings, and prosecution history. Requiring a patent applicant to designate a dictionary may bind a patentee to a construction of a claim term that is out of accord with the intrinsic evidence. The Federal Circuit concluded that if extrinsic reference sources, such as dictionaries, evidence more than one definition for the claim term, the intrinsic record must be consulted to

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identify which of the different possible definitions is most consistent with applicant's use of the term. *Brookhill-Wilk 1, LLC v. Intuitive Surgical, Inc.*, 334 F.3d 1294, 1300, 67 USPQ2d 1132, 1137 (Fed. Cir. 2003). It is submitted that the methodology announced by the Federal Circuit would provide a more reasonable claim construction than would a designated dictionary that may provide an unintended, arbitrary claim construction.

Honeywell appreciates consideration of the above comments by the Office.

Sincerely,

HONEYWELL INTERNATIONAL INC.

/James C. Paschall/

James C. Paschall
Registration No. 36,887
Senior Patent Attorney
Performance Materials and Technologies