

**From:** Vincent Cortese  
**Sent:** Monday, April 15, 2013 5:07 PM  
**To:** QualityApplications\_Comments  
**Subject:** Comments on Preparation of Patent Applications

To the Honorable Commissioner for Patents:

The United States Patent and Trademark Office (the "Office") has requested comments regarding the preparation of patent applications. In the Notice published January 15, 2013 in Vol. 78, No. 10 of the Federal Register (the "Request for Comments"), the Office has requested comments on particular topics. We address certain of these topics in turn in the following comments.

#### A. Clarifying the Scope of the Claims

In the introductory paragraph under section A of the Request for Comments, the Office has stated that "[t]he boundaries of patent protected subject matter should be clearly delineated and the scope of each claim made clear on filing of a patent application to facilitate examination and the publishing and patenting of claims that best serve the public notice function." We believe that patent applications which are written to comply with current laws and regulations necessarily satisfy this general statement, in that by complying with current requirements, claim scope is clearly delineated by the language of the claims and the supporting disclosure, which together comprise the specification. If the scope of the claims is not clearly delineated by the specification, then a proper indefiniteness rejection may be issued to ascertain the scope of the claims. If such a rejection is not remedied during prosecution, no patent would grant from the application. Therefore, any patent granted under current laws and regulations presumably contains claims which are clearly delineated.

In subsection 1 of section A of the Request for Comments, the Office has proposed requiring a template to place the preamble, transition, and claim limitations in separate fields. We do not believe that doing so would provide any benefit to the public, as claims which are drafted according to current practice typically recite these aspects of a claim in a plain language format which has proven to be quite effective, without the necessity of breaking the claim out into separate fields. We also believe that breaking the claims out into separate fields may harm the public's ability to understand claim language, because it would place the claim into an artificial template which may be confusing to the public. Writing the claims in a plain language format provides normal grammatical structure which can be understood by the public.

In subsection 2 of section A of the Request for comments, the Office has proposed requiring identification of support in the specification for each of the claim limitations, perhaps by requiring preparation and maintenance of a claim chart at filing and during prosecution of a patent application. This proposal would substantially increase the costs associated with preparing a new patent application and prosecuting patent applications. The costs associated with patent applications are already quite high, to the point where many inventors with limited resources are unable to engage the services of patent attorneys to file patent applications on their

behalf. If the costs were increased, a greater number of inventors would be unable to obtain patents to protect their inventions, and technological development would be greatly harmed.

Furthermore, it is sometimes inappropriate to pinpoint one single location within a patent specification where support for a particular claim limitation may be found. To require that a specific location within a specification be pointed to for support of a particular claim limitation may result in misidentification of the support, which could later harm the scope of the claim during litigation. Under the current legal structure, the entire specification must be considered in determining the claim scope. To identify particular limited portions of the specification for each claim limitation would encourage the patent Examiner to focus only on those particular portions, and the Examiner would therefore not obtain a full appreciation of the technology being claimed. All of these issues would harm both the applicant and the general public, because it would be more difficult for the applicant to obtain a patent, and the public would not necessarily have the benefit of public disclosure provided by the granting and issuance of a published patent.

In subsection 4 of section A of the Request for Comments, the Office proposes requiring that applicants identify whether the claim preamble is intended to be a limitation on claim scope. Under current law and practice, the claim preamble is only limiting when an applicant relies on the preamble to argue that the claims are entitled to patent protection. Requiring an applicant to indicate whether the preamble is limiting at the time of filing may unduly restrict the scope of the claim, in that it may not be necessary for the applicant to rely on the preamble in order to obtain a patent. In this instance, the preamble would be limiting without any benefit to the applicant. We do not see how this would benefit the applicant or the public.

In subsection 5 of section A of the Request for Comments, the Office proposes requiring applicants to identify means-plus-function claim limitations and pointing out where in the specification corresponding structures, materials, or acts are disclosed that are linked to the means-plus-function claim limitations. This proposal would substantially increase the costs associated with preparing a new patent application and prosecuting patent applications. The costs associated with patent applications are already quite high, as discussed above.

## B. Clarifying the Meaning of Claim Terms in the Specification

In subsection 1 of section B of the Request for Comments, the Office requests comments on the advantages and disadvantages of applicants indicating whether terms of degree have a lay or technical meaning, and explaining the scope of such terms. An advantage may be more efficient litigation, if the patent is ever litigated. However, we believe the advantages are far outweighed by the disadvantages. One disadvantage would be increased cost of preparing an application, because of the mere fact that such language would have to be included in the specification, increasing the time and cost associated with preparing an application.

A second disadvantage is clear from the following scenario. In certain areas of technology, terms of degree may be defined based on very specific circumstances. Perhaps a term of degree recited in a patent claim could be interpreted more than one way by those of ordinary skill in the art, depending on the specific circumstances associated with the activity of a potential infringer. If the applicant were required to specifically state a definition for the term of

degree, those specific circumstances may not be adequately included within the definition, and the definition would preclude infringement under the specific circumstances. In these circumstances, defining the term of degree does not enhance the public notice function of a patent, because those of skill in the art understand the term of degree to mean different things in different circumstances. But the specific definition harms the owner of the patent by restricting the scope of the claim.

In subsection 2 of section B of the Request for Comments, the Office requests comments on the advantages and disadvantages of applicants including in the specification a glossary of potentially ambiguous, distinctive, and specialized terms used in the specification and/or claims. Again, the advantages include more efficient litigation, if the patent is every litigated. However, we believe the advantages are far outweighed by the disadvantages. In this instance, the most important disadvantage would be a drastically increased cost of preparing patent applications. In many instances, patent practitioners rely on the ordinary meaning of terms within the technology area of the patent application. Requiring applicants to define all technical terms would force patent practitioners to undertake much longer interviews with inventors to ensure that each important term within a patent application is understood in a certain way. This would also require patent practitioners to spend large amounts of time performing research and preparing the definitions of all technical terms that the inventors would typically consider to be customarily accepted as used in the field, so that the terms could not be construed against the applicant because this requirement was not complied with at the application drafting and filing stage. We believe that this proposal would unduly harm applicants by drastically increasing the costs associated with preparing patent applications.

In subsection 3 of section B of the Request for Comments, the Office requests comments on the advantages and disadvantages of requiring applicants to designating, at the time of filing, a default dictionary or dictionaries to be used in ascertaining the meaning of the claim terms. Under current law and practice, an applicant can rely on definitions of terms which are known by those of ordinary skill in the art. To require applicants to designate a limited number of dictionaries would unduly limit the potential definitions available to an applicant. This would also require extensive research on the part of the patent practitioner to identify all dictionaries which adequately define all of the important claim terms. This would have to be done in consultation with the inventor, as well. We believe that this is also unduly harmful to applicants.

## General Comments

We believe that the harm to applicants which would be incurred by the proposals set forth in the Request for Comments far outweighs any potential benefit which may be achieved by instituting the proposals. We understand and applaud the Office's efforts to reduce application pendency and increase the quality of patents. However, the harm to applicants, and to the development of technology in general, would be substantial.

Many of these proposals are issues that are only raised and addressed when a patent is litigated. In fact, the proposals cover many of the very issues that are addressed by Markman hearing briefs, which are both a time intensive and cost intensive product of patent litigation. The costs for Markman hearing briefs can range from the high tens of thousands to

hundreds of thousands of dollars for claim construction charts and briefs. Experts have estimated that a maximum of 1-2% of patents are ever litigated. (<http://www.patentlyo.com/patent/2011/12/patents-litigation-and-reexaminations.html>, last accessed April 14, 2013.) It does not seem to be cost-effective to require patent applicants to pay to have functions performed which will only need to be performed 1-2% of the time.

As discuss herein, the proposals would drastically increase the costs of preparing and prosecuting patent applications. The costs associated with patent applications are already quite high, to the point where many inventors with limited resources are unable to engaged the services of patent attorneys to file patent applications on their behalf. If the costs were increased, a greater number of inventors would be unable to obtain patents to protect their inventions, and technological development would be greatly harmed.

For these reasons, we believe that the Office should carefully consider the harm which applicants will experience if these proposals are adopted. Generally, we believe that a main function of the Office is to find ways to ensure that as many inventors as possible are able to obtain patents for their inventions, assuming, of course, that the inventions meet the legal requirements for patent protection. Adopting these proposals will only further limit the number of inventors who are able to engage patent practitioners in order to obtain patent protection for their technologies, and will dramatically limit the ability of pro se applicants to successfully prepare and prosecute a patent application to issue.

Sincerely,  
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