Software Partnership Meetings

• Two Software Partnership meetings planned for the fall of 2013
  – The first meeting will be held mid to late October at Silicon Valley.
  – The second meeting will be held at the end of October or early November at the USPTO’s Alexandria Campus.
Software Partnership Meetings

• Silicon Valley Software Partnership Meeting
  – Discuss USPTO’s efforts on the White House Executive Actions
  – Feedback from last Software Partnership meeting and FR notices
  – Discussion on improving claim clarity by exploring the feasibility of using glossaries in patent applications

• Alexandria Software Partnership Meeting
  – Discuss accessing prior art, including patent documents and NPL
  – Seek suggestions from public on enhancing prior art resources
Improving Claim Clarity – Scrutiny of Functional Claims

• Training on 35 U.S.C. § 112(f) provided to Examining Corps June/July 2013
  – Identifying Limitations that Invoke 112(f)
  – Making the Record Clear

• Additional training being planned

*Training material including slides and CBTs are available on our website at http://www.uspto.gov/patents/law/exam/examguide.jsp
Improving Claim Clarity – Increased Recordation

• Continue to develop examiner training that focuses on clarifying the patent examination record

• Conduct multiple internal focus sessions to identify ways to effectively clarify the record by increased recordation

• Outreach efforts for stakeholder engagement and feedback
  – AIPLA Partnering in Patents (October 23, 2013)
Improving Claim Clarity - Glossary

• Discussion session at Software Partnership meeting to explore use of glossaries

• Potential Glossary Pilot to promote submission of a glossary to enhance claim clarity

• FR notice seeking public comments
Compact Prosecution Training

- Compact prosecution training provided to Examining Corps May/June 2013

- Training covered:
  - Enhancing clarity, correctness, and completeness of a FAOM
  - Employing interviews to achieve compact prosecution
Guidance Updates – *CLS Bank*

*CLS Bank et al. v. Alice Corp*

- Memorandum was issued on May 13, 2013
- Provided overview of the *CLS Bank* decision
- Notified examiners that there is no change, at present, in examination procedure for evaluating subject matter eligibility

*Application to extend the time to file a petition for writ of certiorari has been granted.*
Guidance Updates – *Myriad*

**Association for Molecular Pathology v. Myriad Genetics, Inc.**

- Memorandum was issued on June 13, 2013
- Provided overview of the *Myriad* decision
- Provided preliminary guidance to examiners on evaluating nucleic acid-related technology
  - Significantly changes the Office’s examination policy relating to isolated nucleic acids
  - Examiners should reject product claims drawn solely to naturally occurring nucleic acids or fragments thereof

* Additional guidance and training is planned.
Questions and Comments?

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