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From:

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To: patent_quality_comments

Subject: Response to Request for Comments PTO-P-2009-0054

Attached.

Regards,

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March 1, 2010

To: United States Patent & Trademark Office

From: Michael Risch, West Virginia University College of Law¹

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Re: Request for Comments on Enhancement in the Quality of Patents

Docket No. PTO-P-2009-0054

I respectfully submit my comments in response to the above request for comments. I have previously written about substantive law changes that would improve patent quality. *See, e.g.,* Michael Risch, *Everything is Patentable*, 75 TENN. L. REV. 591 (2008) (suggesting more rigorous patentability standards) and Michael Risch, *The Failure of Public Notice in Patent Prosecution*, 21 HARV. J.L. & TECH. 179 (2007) (suggesting that broadest reasonable construction requirement harms patent quality).

My understanding is that the requested comments should be targeted at procedural changes that can be observed, measured, and incentivized. Based on this more limited mandate, these comments focus on some of the proposals I made in *The Failure of Public Notice in Patent Prosecution*. The comments primarily relate to the suggestions set forth in Section V(3) of the Request for Comments relating to the comprehensive first office action and to quality procedures that will help clarify claim construction.

In general, the suggestions made in Section V(3) relating to examiner identification of problem language are better than the alternative. The troubling aspects of the proposals are more systemic. For example, clarity with respect to how the examiner interprets the broadest reasonable construction of a term does nothing to aid courts in construing such claims in litigation. Similarly, requiring examiners to point out problems is more easily said than done. One could, of course, require a full claim chart, but that would likely be too costly.

The following are some suggested rules and methods for implementation and measurement.

1. **Improving Written Description for Claim Clarity.** One of the primary causes of unclear claim language is a failure of the written description (whether viewed as enablement or as both enablement/written description) to provide a sufficient basis to support claim language. This is exacerbated by the broadest reasonable construction rule, which can cause a break between the description and the claims. The following are some suggestions to improve written description along with ways to measure compliance.
 - a. *Reject all inadequately described claims.* The best way to encourage applicants to adequately describe a claim is to reject any claim that is unsupported. Thus, examiners should freely reject any claim that is not clearly supported in the specification. To be sure, they do this now, but I suspect that the applicant is given the benefit of the doubt on many occasions. Applicants

¹ University affiliation is provided for identification only. These comments reflect the views of the author and no others, including West Virginia University.

with rejected claims can argue in response to an office action that the claims are, in fact, supported in the description. This would create a record about the meaning of the claims. Furthermore, applicants faced with the risk of losing a priority date due to an undescribed claim will, over time, better support their claims.

Properly measuring and incentivizing such rejections may prove difficult, however. One can easily measure the number of written description rejections, but rewarding examiners for such rejections may lead to over-rejecting by the examiner corp. Quality control would need to be implemented to ensure that rejections were proper.

- b. *Requiring antecedent basis for amended claims.* In a related vein, one significant cause of unclear or invalid claims is the claim amendment process. Claims are added or amended late in the process for a variety of reasons, whether to provoke an interference, to respond to an office action, to cover later introduced competing products, or for “clarity.” Unfortunately, amended claims often fail to have any antecedent basis in the specification. This may be due memory loss during the passage of time, to the copying of claims from another application, to the assignment of different prosecuting attorneys and/or examiners, to simple lack of time and attention. Ensuring that amended claims are supported by the specification, would improve patent quality by improving claim validity and clarity.

One way to improve the claim amendment process would be to require that each claim amendment be coupled by a statement by the applicant pointing out the support for such an amendment in specification. This requirement would surely increase the costs of the applicant, but not by too much. Assuming that qualified prosecutors are supposed to be ensuring such support anyway, then writing the basis down should add little time. If prosecutors are not ensuring such support, then the quality mechanism will force such consideration.

This is a quality procedure that is easily measured. Either amendments are accompanied by a statement of support or they are not. Indeed, it is the statement that provides value – it may not even be necessary to “examine” the statement, though examiners would certainly be aided by the additional information.

- c. *Active amendment suggestions.* Examiners rarely, if ever, suggest alternative claim language that would be acceptable to either avoid the prior art or to promote clarity. However, the rules allow some examiner amendments,² and customary practice could be changed. Patent examiners should readily suggest examiners amendments that would at least clarify claims. Trademark examiners do this on a frequent basis. The number of such suggestions is

² 37 C.F.R. §1.21(g); MPEP §714E.

easily measured, though incentives for such suggestions may be harder to define.

A more difficult question is whether examiners should suggest amendments relating to patentability, especially avoidance of prior art. On the one hand, examiners could probably aid patent quality by doing more than rejecting claims. On the other hand, it may not be in the best interest of the public for examiners to be involved in defining the scope of patents – at least with respect to helping more patents issue.

However, if most prosecutors are experienced and/or sophisticated, then they will likely find a way around the prior art – perhaps even a way that reduces patent quality. If so, then examiners would hardly harm the system by providing input. *See, e.g.*, MPEP §706 (“Although this part of the Manual explains the procedure in rejecting claims, the examiner should never overlook the importance of his or her role in allowing claims which properly define the invention.”).

An intermediate position would be to allow examiners to provide acceptable claim language or require specific disclaimers, with a proviso that the claims will not be allowed without the amendment or disclaimer. Thus, amendments would be accepted by the applicant, but the examiner would have significant input to ensure clarity.

- d. *Requiring a Description of the Prior Art.* Currently, applicants need not describe the prior art or their understanding of the field. *Falkner v. Inglis*, 448 F.3d 1357, 1368. This requirement should change. Patent quality can be improved by requiring applicants to describe their invention. The proposal includes a listing of preferred reference sources, so that all who read the patent know what information the applicant used as background. The following discussion of this proposal comes from my previously published article, *The Failure of Public Notice in Patent Prosecution*.

Requiring a prior art description can be a cost effective way to incentivize clearer claiming from the outset, because failure to do so would also result in rejection of the application and a potential loss of filing date priority.

First, a description of the prior art will lead to disclosure of background information that might affect validity of the patent but that is not in writing. For example, a patent for demonstrating “how to pick up a box”³ would be interpreted very differently (or perhaps not issued) if the applicant was required to describe the history of box lifting.

Second, a description of the prior art may lead to further definition of terms used in the patent. At the very least, it gives the examiner a “baseline” to

³ U.S. Patent No. 5,498,162.

compare against. In the box lifting example, if the applicant's background description of box lifting included little information, that would send a signal to the examiner about how terms are being defined. On the contrary, if the background included a description about how people usually bend their knees, then that would shed light on a claim term "flex" which might be ambiguous otherwise.

Third, a description of the prior art keeps the construction more narrow than it might otherwise be, which offsets concerns about the broadest reasonable construction rule. Because claim terms are to be interpreted in light of their specification, an explicit discussion of prior art in the specification would help shape amorphous claim terms.

Fourth, because claim construction in litigation is informed by how one with ordinary skill in the art would construe the claim, a description of the prior art to date will make it easier for the court to understand what skills were ordinary at the time of the patent.

However, suggestions that patentees include a definitional section are likely to be too costly to be worthwhile. Applicants will expend far more than a few minutes per patent ensuring that every word in every claim is precisely defined, which defeats the purpose of claiming general inventions where words are admittedly insufficient. No matter how much time is spent creating such a lexicon by 350,000+ applicants each year, only a few patents will be disputed, and even with a lexicon the parties will find some basis for dispute in litigation. Instead of disputing claim terms, the words used in the lexicon will be considered vague.

A potential cost of requiring a description of prior art is strategic behavior in the application – for example in misstatements about what the prior art is. The Rule 56 duty of candor (as well as the risk of inequitable conduct findings) may limit this. Further, even misstated information can be helpful in defining the scope of the claims.

2. **Improving the Public Record.** Another claim quality problem relates to the public record, as represented by the prosecution history. The file wrapper can be – and is often used as – an important tool for understanding claim meaning. However, gaps in the record and a failure to acknowledge the differences between the broadest reasonable construction and the PHOSITA standards of interpretation can create problems. Some of the suggestions of Section V are clearly geared toward improving this record, but more can be done.

- a. *Improving Interview Recording.* Section V proposes steps to improve the record of interviews. These proposals seem a bit much for two reasons. First, such interviews could easily be audiorecorded, which would eliminate any

dispute about what happened. Second, these notes are mostly irrelevant. Most relevant are the actions that are “approved” in the interview and then applied.

Thus, I suggest a slightly different way to improve interview follow-up. First, the examiner must prepare a “Statement of Actions Approved” that lists the actions approved and the reasons. An amendment or allowance would be detailed here. The statement would issue as an office action, allowing for a period of time to respond or object to the changes. An objection would essentially open the issue again – rejections would be reinstated, for example. This would make the interview more like the standard written procedure, and would provide a public record of the interview that is similar to any other office action. A shorter time period could be allotted to ensure that the interview has the intended benefit of shortening pendency.

This also has the benefit of being measurable and indisputable. Every interview must be followed by a statement of actions office action, and the record of acquiescence or objection would be unequivocal. It would also motivate applicants to ensure that both sides are on the same page at the end of the interview to avoid wasted time.

- b. *Required Reasons for Allowance.* Another improvement in the record might be to require a Statement of Reasons for Allowance in every case. These statements can often be helpful in determining claim meaning, what the broadest construction was, or how the prior art was being interpreted by the examiner. Requiring a statement might further encourage examiners to record the difficult issues associated with the claims allowed so as to provide a better record.

The value of such statements would be improved if courts gave them more credence than they currently do. However, if they were required in every case, they might gain more important status with courts.

In any event, such statements are also easily measurable – either such a statement was issued or it was not. Quality control might be necessary to judge the quality of such statements.

These are just a few proposals designed to improve patent quality through the process of claim examination. The goal of these proposals is to improve the process such that the final outcomes are eventually improved through changed *ex ante* behavior and increased attention to the types of details that often slip through the cracks.

Very truly yours,
Michael Risch