Patent Public Advisory Committee Meeting

Software Partnership & Application Preparation Notices

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Deputy Commissioner for Patent Examination Policy
May 16, 2013
Software Partnership Notice

  - Requested public comments by April 15, 2013*
  - Announced listening sessions in Silicon Valley & New York City in February 2013

*Deadline was extended due to public request
Software Partnership Comments

• 98 comments received
  – Law Professors
  – Patent Practitioners
  – Corporations
  – Independent Software Developers; and
  – Software Coalitions
Common Themes

- Potential for improvements:
  - **35 U.S.C. § 112**, specifically paragraphs (a), (b) and (f)
  - Clarity of record
  - Focus on quality and consistency of actions
  - Prior art resources

- No software specific rules

  – Requested public comments by April 15, 2013*
  – Identified nine potential practices that applicants could employ to clarify claim scope and meaning
  – Received 28 comments from patent practitioners, corporations, and software coalitions

*Deadline was extended due to public request
• Common Themes

  – Advantages:
    • Clarity of record
    • Clarity of claim scope/meaning

  – Disadvantages:
    • Burdensome and costly
    • Negative impact on claim scope
    • Lack of harmonization with global patent practice
Next Steps

• Internal Team
  – Reviewing Comments
  – Developing Plan of Action
  – Examiner Training on 35 U.S.C. § 112(f)

• Additional Partnership Meetings
  – Topics for Further Discussion