

February 12, 2016

The Honorable Michelle K. Lee
Under Secretary of Commerce for Intellectual Property &
Director of the United States Patent and Trademark Office
Mail Stop Comments Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450
Attention: Michael Cygan, Senior Legal Advisor, Office of Patent Legal Administration, Office
of the Deputy Commissioner for Patent Examination Policy

Via email: TopicSubmissionForCaseStudies@uspto.gov

Re: Case study for USPTO: Examiner reliance on In re Van Geuns

Dear Director Lee:

We propose a case study focused on difficult cases, to measure the extent to which examiners refer to intrinsic evidence from the specification and claims when interpreting the ordinary meaning of a word or phrase in a claim? We propose that the study focus on a subset of non-compact prosecution cases, in which the decision *In re Van Geuns* has been cited repeatedly. The office actions sampled should be scored for whether they mention and explicitly take into account the context in which a term is used throughout the claims and specification, consistent with how the PTAB takes intrinsic evidence into account. What quality of exchange is taking place during prosecution of these cases regarding interpretation of claim terms on which allowance depends?

Excellence in patent examination is enhanced by a studied understanding of claim terms. Customer service is enhanced by ability and willingness, when necessary, to state the examiner's interpretation of a claim term on which allowance depends.

The MPEP suggests and the Federal Circuit has ruled that the primary sources for understanding are words and phrases in the claims and specification, both of which can be challenging to read. This intrinsic evidence is evaluated from the perspective of one skilled in the art who has studied the specification.

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Under time and productivity pressures, the old examination technique of drawing a picture of what the claim covers sometimes gives way to word searches. The submitters have seen this happen many times in software applications. A hierarchy of proper sources for claim meaning has been established by the courts: intrinsic evidence is most often determinative of claim term meaning; dictionaries can be consulted, but the applicable definition must be chosen to be consistent with the specification; personal opinions of attorneys and examiners are not approved sources for meaning of claim terms. Nonetheless, resort to personal opinions is a cognitive shortcut that is often adopted. For instance, supervisors who participate in interviews as persons having negotiation authority, but who have limited time to prepare, are prone to offer personal opinions without citing context in the claims or specification.

The null hypotheses that we propose for the PTO to test are: (1) Examiners who cite *In re Van Geuns* do so after evincing a study and understanding of the instances in which key terms are used throughout the claims and specification; and (2) Examiners who cite *In re Van Geuns* give the same level of attention to context and intrinsic evidence as found in PTAB decisions. A set of example PTAB decisions is available from the submitters.

The applications to sample are readily selected. Based on a preliminary data pull, we suggest that “difficult” cases be operationalized depending on filing date. For cases filed in 2012 and later, a difficult case would be one having three or more office actions already. For cases filed before 2012, a difficult case would have four or more office actions. From the preliminary pull, we estimate that more than 2,000 applications examined in the last five years qualify as difficult cases in which the examiner cited *In re Van Geuns*.

Citation of *In re Van Geuns* for the proposition that it is improper to import limitations from the specification into the claims signals a particular kind of disagreement between the applicant and examiner over the significance of the specification in claim interpretation, which is the proposed focus of study. Selection of sample cases could, optionally, be further qualified based on whether one or more claim term interpretations have emerged as important to prosecution. Applying these criteria, a distinct set of applications can be identified and sampled.

In the course of designing this study, one should consider two causal factors that potentially would contribute to rejection of the null hypotheses. First, there appears to be a lack of software tools that bring out and easily highlight context for understanding key phrases. Second, it is widely acknowledged that it is difficult to understand what it means to interpret the claims consistent with the specification without importing limitations from the specification into the claims. The training materials for examiners on claim interpretation are not nearly as strong as the materials distributed to District Court judges, despite examiners’ focus on at least implicit claim interpretation.

The software factor could be addressed directly as part of this study. Accompanying this proposal is a prototype software module, a Word macro that is available for the PTO to deploy at no cost. Using the prototype macro, an examiner can explore how selected words in the claim are used throughout the claims and specification. In operation, the user selects a phrase in a claim, runs the macro, and selects a color to apply to non-noise words in the phrase. The macro assigns different shades of color to the selected words, searches the entire document for all forms of the

words, and color codes the words found. The context with which claim interpretation is to be consistent jumps off the paper, is easily seen. The macro is short enough that OCIO could readily verify that it is safe (or rewrite it) and deploy it to a study group. Alternatively, the PTO may already have a similar tool that could be studied.

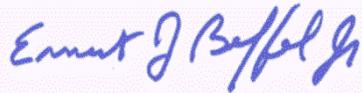
It would be interesting to study whether practices of the subgroup of examiners who regularly cite *In re Van Geuns* would change if they had a handy software tool for revealing context. Focus groups and A/B tests are alternative study techniques.

The claim interpretation training factor could be discussed with focus groups, but A/B tests are not applicable, due to the vetting required for new training materials. Improving the training around interpretation of claim terms consistent with the specification without importing limitations into the claims is an ambitious effort, beyond the scope of this Notice.

As requested in the Notice, we identify individual patent attorneys Charles Bieneman, David Stein and Ernie Beffel as the submitters. This submission represents their personal views and should not be attributed to their clients or their respective law firms.

We express appreciation for consideration of this proposal.

Best regards,

A handwritten signature in blue ink that reads "Ernest J. Beffel, Jr." The signature is written in a cursive style and is positioned above the printed name.

Ernest J. Beffel, Jr., Reg. No. 43,489