

From: Winkler, Michael
Sent: Monday, March 18, 2013 4:56 PM
To: QualityApplications_Comments
Subject: ABA-IPL Comments Relating to Preparation of Patent Applications

Please find attached comments in response to the Request for Comments on Preparation of Patent Applications, submitted on behalf of ABA Section of Intellectual Property Law Chair Joseph Potenza.

Please feel free to contact us if there are any questions.

Thank you.

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March 18, 2013

Via Electronic Mail

QualityApplications_Comments@uspto.gov

Attn: Nicole D. Haines
Mail Stop Comments– Patents
Commissioner for Patents
P.O. Box 1450
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Re: Request for Comments on Preparation of Patent Applications, 78 Fed. Reg.
2960 (Jan. 15, 2013)

Dear Commissioner Focarino:

I am writing on behalf of the American Bar Association Section of Intellectual Property Law (the “Section”) to provide comments in response to the request the United States Patent and Trademark Office (the “Office” or the “USPTO”) published in the Federal Register on Jan. 15, 2013 (“request for comments”). The views expressed herein are those of the ABA Section of Intellectual Property Law, not the American Bar Association as a whole, its House of Delegates, or its Board of Governors.

The request for comments inquires whether certain practices should be used by applicants to place applications in a better condition for examination. The Section understands and agrees with the Office’s desire to improve the quality of issued patents, and to reduce the USPTO’s own costs in examining applications. The Section is concerned, however, that, should the practices suggested in the request for comments become requirements, they would in many instances cause confusion, create pitfalls for the unwary, and unduly shift the examination burden to applicants. The Section’s detailed comments follow.

I. Clarifying the Scope of the Claims

A. Topic II(A)(1): multi-part template for claims

Topic II(A) requests comment on the following proposal:

Presenting claims in a multi-part format by way of a standardized template that places each claim component in separate, clearly marked, and designated fields. For instance, a template may facilitate drafting and review of claims by separately delineating each claim component into separate fields for the preamble, transitional phrase, and each particular claim limitation.

The Section is concerned that this proposal, if made a requirement, would be unduly burdensome on applicants. While in some instances it may be a simple matter to break a claim up into distinct elements, that is not always the case. Moreover, parsing the claim in this fashion may have unintended consequences for the applicant in downstream litigation. For these reasons, the Section opposes adoption of this proposal as a requirement.

The Section recognizes, however, that in some cases there may be value to both the Office and applicants in presenting the claims in this fashion. The Section suggests that the Office consider offering the standardized claiming template not as a requirement, but as a suggestion for applicants who wish to streamline the application process. If the Office takes this approach, applicants should be given appropriate warnings regarding potential downstream disadvantages.

B. Topic II(A)(2): identifying corresponding support

Topic II(A)(2) requests comment on:

Identifying corresponding support in the specification for each of the claim limitations utilizing, for example, a claim chart or the standardized template described above. This practice could be particularly beneficial where claims are amended or where a continuing application (continuation, divisional, continuation-in-part) is filed.

This proposal is similar to regulations that were litigated unsuccessfully by the USPTO in 2008-2009, see *Tafas v. Dudas*, 541 F.Supp.2d 805, 817, 86 USPQ2d 1623, 1632 (E.D. Va. 2008) (“shifting the examination burden away from the USPTO” to applicants is beyond the USPTO’s authority), *rev’d Tafas v. Doll*, 559 F.3d 1345, 90 USPQ2d 1129 (Fed. Cir. 2009), *district court decision reinstated sub nom. Tafas v. Kappos*, 586 F.3d 1369, 1371, 92 USPQ2d 1693, 1694 (Fed. Cir. 2009). The Section opposes the USPTO’s suggested change.

Under current practice, the examiner can make a rejection if the claims are not supported by the specification. This practice limits expenditure and burden to only those circumstances where the examiner identifies a support issue. Requiring the applicant to provide this information preemptively would shift costs and burden disproportionately to the public.

35 U.S.C. § 112 currently requires “a written description of the invention [that is] in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains....” Requiring applicants to submit a claim chart to identify support would in some circumstances be burdensome and duplicative of information already provided. Notably, claim charts are difficult to prepare where the specification and drawings show multiple embodiments covered by a generic claim. For these reasons, the Section opposes adoption of this proposal as a requirement. Again, the Office might consider recommending proactive identification of support (with or without a claim chart) for applicants who wish to streamline the application process. If the Office takes this approach, applicants should be given appropriate warnings regarding potential disadvantages.

C. Topic II(A)(3): indicating whether examples in the specification are intended to be limiting or merely illustrative

35 U.S.C. § 112(a) and (b) make clear that examples in the specification are non-limiting, at least in the “broadest reasonable interpretation” claim interpretation regime that applies during USPTO examination. If an applicant intends an element in the specification to limit the invention, the applicant can include the limitation in the claim itself. Applicants may also already disclaim subject matter in the specification. *See e.g.*, MPEP § 2111.01(II). Therefore, the Office should assume that applicant’s examples are non-limiting, unless there is a clear disavowal in the specification. In the Section’s view, requiring applicants to affirmatively state whether their intentions are contrary to the default condition will lead to confusion and potential prejudice. Specifically, unsophisticated applicants may unnecessarily limit the scope of their inventions by indicating that their examples are intended to be limiting. For these reasons, the Section opposes adoption of this proposal.

D. Topic II(A)(4): Identifying whether the claim preamble is intended to be a limitation on claim scope

Under current examination practice, claim preambles are presumed to be non-limiting. If the applicant wants the preamble to be limiting, the applicant makes a specific request in only those rare cases where warranted. The applicant can either make a showing that the preamble is limiting, or else copy features from the preamble into the claim elements.

Because of this default presumption, there is no need for a required statement from the applicant here. In the Section’s view, this proposal is unnecessary and may create pitfalls for unsophisticated applicants.

E. Topic II(A)(5): identifying § 112(f) claim limitations

Topic II(A)(5) requests comment on:

Expressly identifying clauses within particular claim limitations for which the inventor intends to invoke 35 U.S.C. 112(f) and pointing out where in the specification corresponding structures, materials, or acts are disclosed that are linked to the identified 35 U.S.C. 112(f) claim limitations. 35 U.S.C. 112(f) replaces 35 U.S.C. 112, 6 for means-plus-function limitations.

Under current examination practice, all claim language is presumed to fall within the broader interpretation rules applicable to language *not* governed by 35 U.S.C. § 112(f) unless the language includes a “means” clause. If the applicant wants the narrower construction imposed by § 112(f), and prior art comes to light that makes the difference between § 112(f) and non-§ 112(f) claim interpretation relevant, the applicant must provide the information required by 37 C.F.R. § 41.37(c)(1)(iii) and MPEP § 2181(III).

In the Section’s view, a proposal to always require a preemptive statement that the default rule applies is unnecessary. Until prior art comes to light that makes the difference between § 112(f) and non-§ 112(f) relevant, a preemptive identification is only “theoretically” useful. On the other hand, such a requirement will likely impose an unnecessary burden on many applicants and may cause some to unnecessarily narrow the claim scope of their claims. For these reasons, the Section opposes adoption of this proposal.

F. Topic II(A)(6): disclosure of algorithms

Topic II(A)(6) requests comment on:

Using textual and graphical notation systems known in the art to disclose algorithms in support of computer-implemented claim limitations, such as C-like pseudo-code or XML-like schemas for textual notation and Unified Modeling Language (UML) for graphical notation.

Nearly fifty ago, the courts determined that express disclosure of an algorithm is not required for patentability of a software invention that is not claimed as part of a means plus function limitation.¹ The above proposal appears to be contrary to prevailing law, and thus may be viewed as impermissible substantive rulemaking. The Section would most likely not support a proposal in which the USPTO seems to be exceeding its statutory rule making authorization.

¹ *In re Naquin*, 398 F.2d 863, 866, 158 USPQ 317, 319 (CCPA 1968)

If the Office believes that these types of notation systems would assist the examination process, it should encourage applicants to use them. In the Section's view, however, it should not be a requirement.

II. Clarifying the Meaning of Claim Terms in the Specification

A. Topic II(B)(1): terms of degree

Topic II(B)(1) requests comment on:

Indicating whether terms of degree—such as substantially, approximately, about, essentially—have a lay or technical meaning and explaining the scope of such terms.

If the examiner has a question as to definiteness, the examiner raises a rejection under § 112(b). Any question as to scope under § 102/§ 103 is resolved in favor of the broadest reasonable interpretation (technical or lay), whichever is broader. This forces the applicant to make the clarification on the record, but only for terms where a difference in meaning matters. Applicants have the option to provide this information preemptively, but it should not be required.

Requiring applicants to provide this information preemptively, before any issue exists, would unduly shift the examination burden to applicants.

This requirement would lead to additional costs at filing, as well as additional costs in prosecution, if the examiner believes that a term is one of degree when it is not. This kind of dispute will create satellite disputes that will further slow the process.

Moreover, the Federal Circuit has not held that terms of degree are *per se* indefinite, even when not explicitly defined in the specification. By forcing such a requirement on applicants, the USPTO may be seen as engaging in substantive rulemaking.

For these reasons, the Section opposes adoption of this proposal.

B. Topic II(B)(2): Glossary

Topic II(B)(2) requests comment on:

Including in the specification a glossary of potentially ambiguous, distinctive, and specialized terms used in the specification and/or claims, particularly for inventions related to certain technologies, such as software.

When an application uses specialized terms, examiners often ask for clarification of terms via requirement for information under 37 C.F.R. § 1.105. This practice works well. Applicants have the option to avoid such requirements by including definitions in the specifications.

Requiring applicants to provide this information preemptively, before any issue exists, would unduly shift the examination burden to applicants. The Section is also concerned that this proposal would lead to additional disputes. The task of identifying “potentially ambiguous, distinctive, and specialized terms” would itself be fraught with difficulty, as reasonable minds can differ on what is ambiguous. The Section thus opposes adoption of this proposal.

C. Topic II(B)(3): designating dictionaries

Topic II(B)(3) requests comment on:

Designating, at the time of filing the application, a default dictionary or dictionaries (e.g., a technical dictionary and a non-technical dictionary) to be used in ascertaining the meaning of the claim terms.

The Section opposes such a requirement.

Under current law, the USPTO is required to examine claims under the “broadest reasonable interpretation.” The proposed regulation would potentially force the USPTO to act inconsistent with this requirement. In particular, such a regulation would, as a practical matter, lead the USPTO to act impermissibly in cases where the “default dictionary” gave a definition either broader or narrower than the proper “broadest reasonable interpretation.”

Further, no single dictionary is perfect. For example, the definition of “thread” in the Microsoft Computer Dictionary, 5th Ed., is simply wrong. One cannot know this *a priori*.

The Section believes that it is far less expensive overall for the examiner to look up definitions for the handful of terms that might be at issue in a specific application, rather than to put applicants to the burden of consulting whatever dictionary might be applicable for *every* claim term before filing.

The proposal might also create copyright issues if the applicant must submit copies of the default dictionary to complete the record.

For these reasons, the Section opposes adoption of this proposal.

III. Conclusion

The Section has submitted a number of helpful comments in response to prior requests for comment, namely Request for Comments on Request for Continued Examination (RCE) Practice, 77 Fed. Reg. 72830 (Dec. 6, 2012), Setting and Adjusting Patent Fees, 77 Fed. Reg. 55028 (Sept. 6, 2012), and Comment Request on Information Collection, Patent Processing (Updating), 77 Fed. Reg. 16813 (Mar. 22, 2012). The Section urges the USPTO to consider those comments, as they are pertinent to the instant request for comments and offer helpful suggestions for achieving the USPTO’s goals as expressed therein.

Commissioner for Patents
U.S. Patent and Trademark Office
March 18, 2013
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If you have any questions on our comments or would wish for us to further explain any of our comments, please feel free to contact me. Either I or another member of the leadership of the Section will respond to any inquiry.

Very truly yours,

A handwritten signature in cursive script, appearing to read "Joseph M. Potenza".

Joseph M. Potenza
Section Chair
American Bar Association
Section of Intellectual Property Law