



October 4, 2013

Director of the United States Patent and Trademark Office
United States Patent and Trademark Office
Mail Stop Patent Board
P.O. Box 1450
Alexandria, VA 22313-1450

Via email: SoftwareRoundtable2013@uspto.gov

Attn: Seema Rao, Director Technology Center 2100

BSA | The Software Alliance's comments in response to the Discussion Regarding Strategies for Improving Claim Clarity: Glossary Use in Defining Claim Terms

Dear Commissioner:

BSA | The Software Alliance is pleased to have the opportunity to present its views on the recent Software Roundtable discussion regarding "Strategies for Improving Claim Clarity: Glossary Use in Defining Claim Terms."

Background

BSA is the leading global advocate for the software industry. It is an association of world-class companies that invest billions of dollars annually to create software solutions that spark the economy and improve modern life. Through international government relations, intellectual property enforcement and educational activities, BSA expands the horizons of the digital world and builds trust and confidence in the new technologies driving it forward.

BSA and its members have been active participants in the USPTO's Software Roundtable series. BSA believes intellectual property rights are the cornerstones of innovation — giving creators confidence that it is worth the risk to invest time and money in developing and commercializing new ideas. For the software industry in particular, robust intellectual property protections are fundamental to ongoing innovation and technology advances. Software patents are an indispensable part of these protections. That is why all of BSA's members support ongoing efforts to enhance the patent system and in particular improve the quality of software patents. The United States Patent Office is the world's leader. For

that to remain the case, it must evolve in ways that reflect and enable the pace of innovation in the US technology sector.

At the same time, BSA is mindful that our patent system traditionally has not had different rules for different industries. BSA believes that is an important reason why the United States has the world's best patent system and why the US tech industry is a global leader.

Computer software is ubiquitous in our society. It is used not just for word processing and number crunching but also for designing bridges, diagnosing diseases and efficiently managing our energy infrastructure. Most of the technologies we encounter every day — from cell phones and antilock brakes to airplane flight controls and pacemakers — utilize software. It therefore is not hyperbole to conclude “most of the planet is currently run by software,” including “financial systems, energy production, transportation networks and a host of other fundamental systems are run using software.”¹

Investment in software reflects its critical importance to American industry. In 2008, companies invested approximately \$46.9 billion in research and development for software and computer-related services — approximately 16 percent of *total* industrial R&D expenditures for the nation.² Software companies accounted for \$21.6 billion of foreign direct investment in the United States in 2009.³ Venture capital firms invested approximately \$18 billion between 2007 and 2010 in software companies.⁴

Software firms are leading innovators, “with 77 percent of companies” engaged in software development “reporting the introduction of a new product or service compared to the 7 percent average for all nonmanufacturing industries.”⁵ The information technology industry has been described as “the key factor responsible for reversing the 20-year productivity slow-down from the mid-1970s to the mid-1990s and in driving today’s robust productivity growth.”⁶

The software industry also contributes to the economy by creating high-paying American jobs. Software companies and related services employ approximately 2 million US workers

¹ Henry J. Cittone, *Some Math Is Hard, Some Not: Rules for Patentable Subject Matter of Software*, 38 *Rutgers Computer & Tech. L.J.* 193, 193-94 (2012).

² Nat’l Sci. Bd., *Science and Engineering Indicators*, at 4-21 & 4-23 (2012), <http://tinyurl.com/amb2uao>.

³ *Id.* at 6-46, tbl. 6-7.

⁴ *Id.* at 6-58, to -60 & fig. 6-51.

⁵ Nat’l Sci. Bd., *supra*, at 6-47.

⁶ Robert D. Atkinson & Andrew S. McKay, *Digital Prosperity: Understanding the Economic Benefits of the Information Technology Revolution 10* (Info. Tech. & Innovation Found. 2007), <http://tinyurl.com/yv5jnw>.

in jobs that pay approximately twice the national average salary.⁷ Moreover, software accounts for approximately \$36 billion of US exports, and leading software companies make as much as 60 percent of their revenue on overseas sales.

Responses to Discussion Topics

Because BSA is an association, our responses here represent only the views and practices that all of our members hold in common. In some cases, individual member companies may have additional views or practices that are not represented in these comments.

II A. For Those Who Routinely Use a Glossary (or Definition) Section in a Patent Application:

This section applies to those who routinely use a glossary or definition section in a patent application. BSA does not have specific comments on this section because our members typically do not use glossaries. As a general matter, however, BSA has been a strong supporter of finding ways to develop a common nomenclature for describing computer implemented inventions. A common nomenclature would help the entire ecosystem. It would help the USPTO understand and prosecute patent applications. It would aid the public in understanding the metes and bounds of issued patents, and it would benefit inventors by bolstering their ability to explain the true nature and scope of their inventions. Developing a common nomenclature has served other technologies, such as pharmaceuticals and biotechnology, quite well.

At the same time, BSA is cognizant that one of the cornerstones of the US Patent system is that it allows inventors to be their own lexicographers. This is a vital aspect of our patent system because oftentimes there are not perfect terms currently in use to describe groundbreaking inventions. Therefore, inventors also need the freedom to describe their inventions in ways they believe to be most appropriate. Striking the right balance between burdening inventors with stringent rules related to clarity and allowing inventors the latitude to draft applications in a manner that best describes the invention is key.

II B. For those who do not routinely use a glossary (or definition section) in a patent application:

1. Why do you not use a glossary section?

BSA members currently do not routinely add glossaries to their applications because oftentimes it would require additional time and expense. There is also a concern regarding the potential narrowing or preclusive effect of including a glossary.

⁷ Source: BSA | The Software Alliance

2. Do you foresee any issues or concerns with the use of glossaries during and/or after prosecution? If so, what issues or concerns?

The biggest concern BSA members have is the additional resources required to include a glossary. BSA is confident, however, that the potential benefits of using glossaries are very high. Although, we believe for a glossary system to really work, it would need to be widely adopted. We also believe that while it might require additional resources at the front of the prosecution process, the addition of a glossary potentially could alleviate confusion during examination, which would result in a more efficient examination. BSA proposes that the use of default dictionaries would be, at least one way to reduce the burdens on the front end without detracting from the benefits of including a glossary.

II C. Possible glossary pilot program structure

1. What incentives, if any, could the USPTO provide to encourage you to participate in a glossary pilot program and provide a glossary for claim terms in applications under the pilot?

BSA believes that reducing fees or providing an accelerated examination would create ample incentives for many of its members to participate in a glossary pilot program.

2. For the technological areas where you practice, which specific areas would benefit from the use of a glossary in the specification? Why?

BSA believes that a glossary program should be uniformly applied to all technologies. This is because there is no specific technical areas that would benefit more than any other from the use of a glossary. For the purposes of a pilot program, however, we suggest testing it throughout all technical areas. This would help the PTO understand whether any specific issues arise based on particular technologies.

II D. Form and Content for a Glossary to be Supplied in a Possible Glossary Pilot Program

1. What restrictions, if any, should be placed on the format of the glossary section; such as limits on the length of each definition, the number of alternatives provided in a definition, and the number of definitions in the glossary section?

At this point, BSA does not believe that any restrictions should be placed on the glossary.

2. Please comment if the following glossary criteria should be used in determining whether an application is eligible for admission into a potential glossary pilot program:

- a. The glossary must be a separate section in the specification with its own heading entitled "Glossary." The glossary cannot be an appendix or submitted as an Information Disclosure Statement (IDS).

With the understanding that not all applications will require the use of a glossary, BSA believes this is a reasonable requirement for inventors to participate in the glossary pilot program.

- b. The glossary definitions must "stand alone" and cannot simply refer to other sections or text within the specification or incorporate by reference a definition (or portion) from another document.

BSA believes this a reasonable policy.

- c. A definition in the glossary cannot be disavowed by the disclosure or during prosecution; for example, by stating "the definition presented in the glossary is not limiting."

BSA believes this a reasonable policy.

- d. Alternative definitions for the same claim term that are inconsistent with each other are not permissible.

While BSA believes this a valid goal, we also understand that in practice it is very hard to create black and white rules. Alternative definitions that are clearly inconsistent with each other would be inappropriate. In many cases, however, there are nuanced alternatives that might appear inconsistent at first blush when in reality they are not. Thus, the PTO should provide clear guidance to examiners not to simply reject alternative definitions unless it is abundantly clear they are inconsistent.

- e. The glossary, at least at a minimum, must define functional claim terms, the structure associated with any claimed function, abbreviations/acronyms, evolving technology nomenclature, relative terms, terms of art, and unique words that lack an ordinary and customary meaning.

BSA, again, believes this is a worthy goal, but in practice it may be difficult to enforce effectively. BSA would be concerned if examiners relied on form over substance in rejecting perfectly valid arguments by patentees based on an overly strict reading of a PTO policy.

- f. A definition cannot consist only of a list of synonyms or examples.

BSA does not agree with this proposition. While in most cases the use of synonyms or examples would not be adequate to define a term, there may be instances where it is the best way. Thus, examiners should rely on the PTO's current tests under 35 U.S.C. 112 to determine the adequacy of a definition.

- g. What other criteria would you recommend for a glossary definition?

BSA does not have any additional criteria at this time.

Conclusion

BSA supports the Patent Office's efforts on this subject. We look forward to working with the PTO as this initiative moves forward.

Sincerely,

A handwritten signature in blue ink, appearing to read "Tim Molino", is written on a light-colored rectangular background.

Tim Molino
Director, Government Relations