

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re: Software Partnership

For: **Possible Pilot Glossary Programs**

**Requested Comments Regarding Strategies for Improving Claim Clarity
Using Glossaries to Define Claim Terms**

Via Email to: SoftwareRoundtable2013@uspto.gov

Mail Stop Comments – Patents
Commissioner for Patents
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Attention: Seema Rao, Director, Technology Center 2100

Dear Ms. Rao:

In response to the request for comments regarding possible pilot glossary programs, the undersigned respectfully submit the following comments.

General Comments

Clarity within patent claims, and within the disclosure relied upon for support, should be the goal of every patent practitioner. However, certain approaches to clarity can unduly prejudice patent applicants, who may receive less patent protection than they would have been entitled to.

A rigidly-structured glossary is unlikely to meet the goals of clarity while simultaneously allowing patent applicants to claim the broadest inventive concept to which they are entitled. However, recent decisions by the Federal Circuit and the Patent Trials and Appeals Board leave patent applicants who choose to obfuscate key elements of their claims vulnerable to challenges, or even unintended interpretations, under 35 U.S.C. § 112.

A. Software is not irreconcilably different from other statutory subject matter.

The goals of patent clarity are universal, whether an application under examination relates to biotechnology, mechanical, or, in this case, software endeavors. Recently, however, the focus has been strictly on software patents. This is best evidenced by the White House's Executive Action relating to tightening functional claiming, which is specifically focused on software.

Software cannot be singled out for a unique application of the law. All technologies should be treated equally. Equal treatment requires that all technologies should be examined equally under 35 U.S.C. §§ 101, 102, 103, and 112. The tools for enforcing clarity of claims and their supporting disclosures are already present in the statute. With proper examiner training, as the USPTO is encouraging through its series of training modules, it is possible to better understand issues of claim interpretation during prosecution.

The written description and enablement requirements of 35 U.S.C. § 112(a) are structured around the understanding of a “person skilled in the art to which it pertains.” This level of understanding carries with it the understanding that an applicant need not disclose concepts that would be understood by such a person skilled in the art. As stated in MPEP 2164.01, with regard to enablement, “[a] patent need not teach, and preferably omits, what is well known in the art.” This standard has long been recognized by the Federal Circuit. It would be improper to eviscerate this standard in order to require the resolution of terms that a skilled artisan in a corresponding software area would understand. Software is a highly-predictable field requiring minimal enabling disclosure.

The proper focus for software patent clarity is therefore not on satisfaction of the enablement requirement, which should be a low bar commensurate with the predictability of software, but on the written description requirement.

B. Clear software applications need not be arduously detailed.

Applications should be well-drafted in order to clearly convey possession of the claimed invention. One such way to achieve clarity in satisfaction of the written description requirement may be through the use of a glossary demonstrating that the inventor considered a specific interpretation of a claim term as relevant to the invention. Typically, an example (or a series of examples) of something covered by a claim term would serve as a sufficient definition to convey that the inventor had possession of the claimed invention. This approach is typically both sufficiently broad and sufficiently clear.

Consider, for example, the implementation of a novel piece of software, such as a novel database, on a “computer-readable medium.” The specification discloses that a computer-readable medium includes, by way of non-limiting example, a hard drive, a CD, a flash drive, a DVD, RAM, or ROM. The details of this medium are irrelevant – storing the inventive software on such a medium would work equally well even if the medium were a futuristic quantum data storage device not specifically mentioned in the disclosure. In this instance, the applicant has done sufficient work to convey possession of the fact that the software is stored in a “computer-readable medium,” whatever form that may take.

Similarly, detailed algorithms should not be required in satisfaction of the written description requirement for, *e.g.*, the novel database. In the software field, an inventive concept can be mocked up in a number of different ways, and conveyed to a non-inventor software developer for implementation. Such sparse specifications are routinely used in the

software industry, and the intended software is produced from them. The USPTO should not require any more written description (or enablement) than the typical skilled artisan would need. For example, flow charts are often used in the industry to convey the concept. Any competent software engineer can write the code that implements the flow charted concept. The USPTO should not require more than what the ordinary software engineer would need to reduce the concept embodied in the flow chart(s) to practice.

C. Examiners should focus on identifying support for new claim language.

While properly applying these standards, examiners should be on the lookout for 35 U.S.C. § 112(a) issues where they are most likely to appear: during amendment of the claims or during filing of new claims in a continuation.

Unlike first-filed originally presented claims, amended or continuation claims can inadvertently introduce new matter, unsupported by the original disclosure. Examiners need to assess whether such terms are clearly supported by the original disclosure, and present their findings in the written record.

Applicants may seek progressively broader claims for specific areas of the disclosure in subsequent continuation applications. It is these claims that are most fraught with the perils of overreach in litigation. Examiners should not necessarily balk at a reasonable claim interpretation proffered by an applicant, but the record should clearly indicate what the broadest reasonable interpretation for a claim term at issue is understood to be.

Question-Specific Comments

The Office has asked a series of questions in order to consider implementation of a glossary pilot program. Our answers to these questions follow. We have addressed these questions from the perspective of applicants who consider glossaries to be a valuable addition to the specification, some of which use glossaries routinely, as well as applicants who do not see any value in the use of glossaries.

A. What impacts on prosecution have you seen from using glossaries (e.g., efficiency, clarity, number and type of rejections)?

In prosecution, we have seen glossaries generally add another layer of complexity. The chief issue is whether an examiner considers the descriptions for terms in a glossary to be definitions that control the claim construction of those terms. Without clear indication by an applicant that a glossary term is meant to be definition, many examiners require incorporation of defining text directly in the claims. Such ambiguity in whether a glossary defines terms or merely provides examples or descriptive text hurts efficiency.

B. *How do you evaluate the impact of glossaries on prosecution?*

Glossaries have little impact in prosecution of software-related cases. They are often absent and not necessary. Many software related inventions are best described using examples of claimed elements, block diagrams showing example system configurations, flow charts showing operation, and descriptions of data structures or data flow. Well-drafted claims using terminology consistent with examples and description in the specification are the most helpful to examiners for most software applications.

C. *Please provide specific examples where the use of a glossary was helpful during and/or after prosecution (i.e., litigation, re-exam, re-issue, licensing).*

We are aware of software cases where, during original prosecution and post-grant review, a well-drafted glossary that defined terms was relied upon by examiners. This glossary, an exceptional case, increased efficiency and clarity.

D. *Do you provide a separate glossary section in the specification (i.e., under its own heading)? Why or why not?*

Generally, we do not provide a separate glossary section in a new application. There are a number of reasons for this. One reason is cost: Providing a separate glossary section can add to the cost of preparation of the application; clients are reluctant to incur this additional cost. Another reason is that glossaries may inadvertently lead to limiting eventual claim scope. If a term in the glossary is defined more narrowly than it needs to be, the examiner (or ultimately the court) may fix on this narrow definition to interpret the claims. It is difficult, if not impossible, to predict the future of term interpretation. A definition that may appear reasonably broad now, may, in the future, turn out to be unnecessarily limiting.

E. *Do you use a single composite glossary or divide the glossary into different subsections for specific types of definitions (i.e., subsections for claim terms, acronyms, non-claim terms)? Why or why not?*

If we use a glossary, we typically provide a single composite glossary for all terms being defined. Acronyms are typically defined “on the fly,” that is, as they appear in the text. It would be too cumbersome to divide a glossary into multiple subsections.

F. *Do you utilize a particular format for the definitions within the glossary (e.g., tables, formulae, bulleted list)? Why or why not? If possible, please provide an example of your preferred format.*

When we use a glossary, it is typically in textual form, in a sentence or paragraph. However, we are not tied to any one format. On those occasions when we use a glossary, we will use the format that best fits the specific situation.

G. Why do you not use a glossary section?

For a number of applicants, the use of a glossary would be a significant additional cost that cannot be justified in light of the clarity provided by the balance of the specification. Many of the terms used to describe a software invention are well-understood by a PHOSITA without a glossary. Terms that require some form of definition are usually defined by way of non-limiting examples throughout the disclosure. Acronyms are defined as they are introduced. This applies to both claim terms and non-claim terms. In cases where a patent applicant is acting as his or her own lexicographer and introducing new terms, these terms, which often are few, can be defined as they are first encountered in the description. Moreover, examiners and the public benefit most from applicants' description of their new inventive contribution rather than requiring a glossary of terms, many of which are well-known to PHOSITA.

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

Even if a glossary is provided, it is unclear to what extent an examiner would be expected to honor its definitions during prosecution. In litigation, the court is not bound by the examiner's interpretations, in which case the glossary may be irrelevant. To the extent that any inconsistencies exist in terminology, they can be resolved based on the understanding of a person skilled in the art. This is routine practice in a Markman hearing, and examiners working with applicants can make these determinations of claim scope as well without the need for a glossary.

I. 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?

If the pilot is not unduly burdensome, or hampers the scope of patentability with too-rigid requirements for the glossary, then a number of existing applicants would likely participate with minimal incentive. Accelerated examination would likely make the program justifiable in exchange for the added expense of conforming the glossary to pilot program standards.

As previously noted, many of the potential issues regarding the introduction of overbroad claims likely come about in sequential continuation applications. Incentives that attach to continuation applications, as well as the original application, would afford the USPTO the benefit of these additional data points.

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

To the extent that any clarity benefit is realized by the use of glossaries, any technology area should benefit equally.

- K. *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?***

None. Clarity does not require word economy, even if that is often the case. In some situations, clarity of scope is best achieved by a serial listing of example embodiments. In other situations, a straightforward dictionary definition is best. A one-size-fits-all implementation will lead to less clarity, and deny applicants the right to truly be their own lexicographers.

- L. *Criteria 1: 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).***

This is generally acceptable, as it would be straightforward to gather definitions from elsewhere in the disclosure and place them in a common section. However, a number of suggestions presented ask that the glossary be a form of living document, to be amended during the course of prosecution in order to express the understanding between an applicant and the examiner of the scope of certain terms.

Any such document that is subject to change **cannot** form a part of the specification. Even if the ideal is that revised definitions would always be supported by the balance of the specification, and therefore not constitute the addition of new matter, applicants would be extremely reluctant to participate in something that can be so readily attacked in litigation.

To the extent that the document is intended to be amended during prosecution, it must be treated as a prosecution document – akin to a discussion of claim construction in the reply (or in the Office action, if revisions are presented by the examiner).

- M. *Criteria 2: 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.***

All definitions are made using other terms, each with their own definitions. Limiting definitions to only those that “stand alone” would eliminate definitions that, if well-crafted, can convey with precision the fact that the inventor had possession of the claimed invention by reference to supporting documentation for certain terms.

- N. *Criteria 3: 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.”***

A definition in the glossary that is disavowed by the disclosure, if the glossary is part of the specification, would be unclear and likely render associated claim terms indefinite. However, a statement that “the definition presented in the glossary is not limiting” is not a

disavowal of that definition. The definition may be in the form of non-limiting examples, such that the complete scope (e.g., the examples that have not been listed) would be readily understood by a skilled artisan.

If helpful, the statement that the definition is not limiting could be required to appear in the glossary itself. As noted above, a definition for a “computer-readable medium,” which the glossary or specification defines as including, *by way of non-limiting example*, a hard drive, a DVD, or RAM, is clear, enabling, and provides adequate written description support for the broad concept of a “computer-readable medium.” A definition that is stated as non-limiting is not necessarily improper.

O. Criteria 4: Alternative definitions for the same claim term that are inconsistent with each other are not permissible.

As long as the alternative definitions are independently consistent with the term’s usage in the claims, then alternative definitions should not pose any issues of clarity.

P. Criteria 5: 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.

Applicants will find it challenging to ensure that all of these terms are included in the glossary. The costs associated with such a robust glossary will be overwhelming, and will drive many applicants out of the pilot program. However, this is a helpful list of terms that applicants should consider defining, and there should not be any penalty for failing to define any of these terms.

Applicants should be allowed to state that terms not explicitly defined in the glossary are to be given their ordinary and customary meaning.

Q. Criteria 6: A definition cannot consist only of a list of synonyms or examples.

As stated elsewhere, a list of examples can provide more than enough information to put the public on notice, in a clear and concise manner understood by those skilled in the relevant art, of the scope of coverage of a particular claim term. This is particularly critical for elements that are not themselves entirely new, but may be utilized in a novel way – and this novel approach may be equally applicable to an entire class of elements that can best be defined by non-limiting example.

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

None. We do not definitively recommend the use of glossaries as a required part of any application.

S. Variations of glossary pilot programs

The USPTO has solicited comments regarding the implementation of a glossary pilot program for patent applications not yet filed, and for pending, unexamined patent applications. The addition of a glossary to a pending patent application is fraught with danger, even if “specific reference to the precise locations in the originally filed disclosure where support for the definitions in the glossary is found” is provided.

The only way in which a glossary might be appended to any pending application would be if it is treated as a prosecution document, and not a portion of the specification. In this capacity, it would be akin to Markman briefing – a patent owner can advocate a particular claim interpretation, but the scope of the specification itself remains unchanged.

T. Additional information

Software-related patents with a clear claim scope are important to inventors, competitors and the public. Many tools are available to the USPTO to further this aim. The PTO’s recent effort at examiner training for claim interpretation under §112(f) and making the record clear is especially helpful for software cases. Amendments and continuing claim sets should be reviewed for new matter. Applicants should be required to show support where necessary. Incentivizing applicants to provide reference numerals or identify examples of support for claims would likely be helpful. Glossaries, though, are one tool best left to an applicant’s discretion when applied to software.

Conclusion

Consideration of the above comments is respectfully requested.

Respectfully submitted,

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