

October 3, 2013

Via electronic mail to SoftwareRoundtable2013@uspto.gov

Attention: Seema Rao, Director, Technology Center 2100

IBM Corporation comments in response to “Discussion Regarding Strategies for Improving Claim Clarity: Glossary Use in Defining Claim Terms”

IBM thanks the United States Patent and Trademark Office (USPTO) for the opportunity to comment on potential strategies to improve patent clarity, including the possible use of glossaries in patent applications to assist examiners in claim interpretation. IBM strongly supports the USPTO’s effort.

In response to the Questions:

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

1. Through 6.

IBM has no comments to provide because it does not routinely use glossaries, at present.

1. B. For Those Who Do Not Routinely Use a Glossary (or Definition) Section in a Patent Application: Why do you not use a glossary section?

We do not use one at present because of the potential burden it would pose in terms of time, money, and narrowing effect on claims.

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

Chief among these issues and concerns is the burden of additional time and money. On balance, IBM believes that the benefit from using glossaries would outweigh the burden if their use would become widespread. IBM proposes the use of the following in order to reduce this burden:

- In the short term, default dictionaries as a source of definitions¹; and
- In the long term, automated analytics tools to generate proposed glossaries².

¹ See Diana Roberts, Manny Schecter, and Alison Mortinger, “A case for adopting controlling dictionaries in the USPTO”, *Intellectual Asset Management*, Issue 39, January/February 2010, pages 51 to 55.

² See Manny Schecter and Alison Mortinger “Using analytics to generate glossaries in patent applications”, *Intellectual Asset Management* Issue 62, November/December 2013, pages 23 to 26.

See item F for more details on these proposals.

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?

Incentives in the form of reduced fees would motivate IBM to participate; accelerated examination might also provide incentive for others to participate in such 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?

Any overall program should be uniformly applied across all technologies. However, for the purposes of a pilot program, IBM suggests that several representative technical areas be chosen; at least one from each technical center. This way, any technology-specific issues can be discovered as part of the pilot.

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?

IBM does not believe that there should be mandatory restrictions on the length of each definition, the number of alternatives provided in a definition, or the number of definitions in the glossary section. The focus should be on the significant terms in the claims (i.e. all claim terms that are not common words), and a definition must be provided for each significant term. The examiner should decide the sufficiency of the definitions, taking 37 CFR Section 1.105 (Rule 105) and 35 USC 112 into account, and determine if the information “reasonably necessary to properly examine” the application has been provided, as well as whether the definitions are “definite.”

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).

A separate section, with its own heading, titled “Glossary,” in the specification, would best serve the public. Including the definitions in an appendix or as an IDS submission would be harder to reliably locate within the prosecution history.

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.

Glossary definitions must stand alone and should not simply refer to other sections or text within the specification or incorporate by reference a definition (or portion) from another document. Definitions must be clear and easy to locate as part of the patent document, and should not depend on text that itself is unclear.

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”.

Glossary definitions should be finalized as soon as possible so that both the examiner and the applicant can rely on them during prosecution. (However please see the discussion in item F for amending claims and adding new significant claim terms during prosecution.) Disavowal of the definitions after they have been finalized and during later stages of prosecution should not be permitted.

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

Alternative definitions for the same claim term that are inconsistent with each other should not be permitted. Such a practice would introduce indefiniteness and reduce clarity.

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.

Rather than focusing on such minimum criteria such as defining 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, the foundational requirement for a complete glossary should be to define all non-common claim terms.

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

Definitions should be clear and concise. There may be instances where the use of a synonym or an example will be sufficient, just as many words in a standard dictionary have a clearly understood single word definition.

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

See footnote 2.

E. Potential Features of a Possible Glossary Pilot Program.

1. For Patent Applications Not Yet Filed,

IBM agrees that an applicant should be able to participate in the program “on demand” by including in the specification a glossary of the proper format (according to the pilot guidelines) and requesting that an application be admitted to the pilot program.

2. For Pending, Unexamined Patent Applications,

IBM agrees that an applicant should be able to participate either by request, or by invitation of the USPTO, and also by submitting a glossary by preliminary amendment following the pilot guidelines. In addition to specific reference to precise locations in the specification which provide support for the definitions (as opposed to generic references), IBM believes that an applicant should be able to cite a relevant technical dictionary published at or before the application filing date.³ This may be necessary to provide a complete glossary, which should have a definition for every non-common claim term.

F Miscellaneous

Ways to reduce the burden on applicants

In the short term, incentives should be provided in order to encourage applicants to provide glossaries. If a claim term is not listed in the glossary, then the definition will be obtained by defaulting to a designated dictionary, and if not present in that source, to the common meaning.⁴ In the long term, an analytical tool should be developed that would automatically generate a proposed glossary of claim terms from a hierarchy of multiple sources yet still allow the applicant to be his or her own lexicographer.⁵

Adding significant claims to terms during prosecution

During prosecution, if a new significant term is added to a claim, and that term is not included in the glossary (which should have been finalized early on), then the glossary must be amended. In such an instance, if the definition cannot be found in the specification, then in order to avoid introducing new matter, IBM believes that the definition should be limited to the common meaning. This meaning can be obtained from an appropriate dictionary published as of the filing date, and may be as simple as selecting the definition from those included in the United States Patent Classification

³ See Roberts, Schechter, and Mortinger, “A case for adopting controlling dictionaries”

⁴ Ibid.

⁵ See Schechter and Mortinger, “Using analytics to generate glossaries”

(USPC) glossaries (see either the consolidated USPC glossary at http://www.uspto.gov/web/patents/classification/glossary/glossary_alpha.htm or the individual class definition/glossaries, for example Class 438 (Semiconductor Device Manufacturing: Process) <http://www.uspto.gov/web/patents/classification/uspc438/defs438.htm#C438S058000>)

Conclusion

In conclusion, IBM supports the use of glossaries defining all non-common claim terms in patent applications in order to improve patent quality. Use of glossaries would reduce ambiguity and make definitions clear on the record, as part of the issued patent. This in turn would reduce litigation, enhance the availability for a thoughtful design around, and generally increase the overall efficiency of the patent system in promoting innovation. Although there will be a slight additional burden on applicants and examiners, which can be reduced by the use of automated analytics,⁶ the burden will be outweighed by the benefit from using glossaries as proposed.

Respectfully submitted,

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⁶ Ibid.