

From: Hans Troesch [mailto:REDACTED E-MAIL ADDRESS]
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To: SoftwareRoundtable2013
Subject: Comments relating to glossary pilot

With thanks for your consideration, the following comments reflect my views and not necessarily those of my firm or our clients.

At the end of examination, an examiner will sometimes include a statement of reasons for allowance. During the course of examination, applicants and examiners sometimes take positions that are used in litigation to interpret claim language.

Both these elements of prosecution history generally fail to contribute to clear public notice. Statements of reasons too often just parrot the claim language. And applicants' remarks are scattered throughout the history and are not easy to use in fixing the scope of the claims. In addition, neither is published by the Office.

If the examiner is going to do the work necessary to construe the claim language – and the examiner should – it would seem useful to include that construction expressly in the prosecution history, e.g., in a separate section of the action, so that (i) the applicant can address it, and (ii) the examiner can refine or correct it. Similarly, the applicant could include constructions in the applicant's papers, which the examiner could then address. These constructions would not have to address all possible issues or be complete definitions. It would be useful to the public to know how the issues that came up were resolved. For example, even if "vegetable" is not defined, clarity is improved if the record shows that for this application, a tomato is a vegetable.

Better notice to the public could be achieved by publishing this end result with the patent, but not as part of the text of the patent. Its status should be that of prosecution history, with the added weight of the formal and joint applicant-examiner attention paid to its creation.

The Office's incentives would include providing a clear record; the examiner's, the extra time allocated for the work; and the applicant's, getting the examiner pointed in the right direction. It may be that prosecution is expedited in a case because the examiner and applicant, having made their meanings explicit, are not talking past each other. In addition, because the examiner knows that the applicant's statements construing the claims will be published for the public to rely on, the examiner can also rely on the statements, to the extent they limit claim scope. This should also expedite prosecution.

Hans R. Troesch

REDACTED PHONE NUMBER (direct)