

Patent Public Advisory Committee Meeting

Software Partnership & Patent Quality Initiative Updates



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for Patent Examination Policy
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Software Partnership Meetings

- Two Software Partnership meetings planned for the fall of 2013
 - The first meeting will be held mid to late October at Silicon Valley.
 - The second meeting will be held at the end of October or early November at the USPTO's Alexandria Campus.



Software Partnership Meetings

- Silicon Valley Software Partnership Meeting
 - Discuss USPTO's efforts on the White House Executive Actions
 - Feedback from last Software Partnership meeting and FR notices
 - Discussion on improving claim clarity by exploring the feasibility of using glossaries in patent applications
- Alexandria Software Partnership Meeting
 - Discuss accessing prior art, including patent documents and NPL
 - Seek suggestions from public on enhancing prior art resources



Improving Claim Clarity – Scrutiny of Functional Claims

- Training on 35 U.S.C. § 112(f) provided to Examining Corps June/July 2013
 - Identifying Limitations that Invoke 112(f)
 - Making the Record Clear
- Additional training being planned

*Training material including slides and CBTs are available on our website at <http://www.uspto.gov/patents/law/exam/examguide.jsp>



Improving Claim Clarity – Increased Recordation

- Continue to develop examiner training that focuses on clarifying the patent examination record
- Conduct multiple internal focus sessions to identify ways to effectively clarify the record by increased recordation
- Outreach efforts for stakeholder engagement and feedback
 - AIPLA Partnering in Patents (October 23, 2013)



Improving Claim Clarity - Glossary

- Discussion session at Software Partnership meeting to explore use of glossaries
- Potential Glossary Pilot to promote submission of a glossary to enhance claim clarity
- FR notice seeking public comments



Compact Prosecution Training

- Compact prosecution training provided to Examining Corps May/June 2013
- Training covered:
 - Enhancing clarity, correctness, and completeness of a FAOM
 - Employing interviews to achieve compact prosecution



Guidance Updates – *CLS Bank*

CLS Bank et al. v. Alice Corp

- Memorandum was issued on May 13, 2013
- Provided overview of the *CLS Bank* decision
- Notified examiners that there is no change, at present, in examination procedure for evaluating subject matter eligibility

*Application to extend the time to file a petition for writ of certiorari has been granted.



Guidance Updates – *Myriad*

Association for Molecular Pathology v. Myriad Genetics, Inc.

- Memorandum was issued on June 13, 2013
- Provided overview of the *Myriad* decision
- Provided preliminary guidance to examiners on evaluating nucleic acid-related technology
 - Significantly changes the Office's examination policy relating to isolated nucleic acids
 - Examiners should reject product claims drawn solely to naturally occurring nucleic acids or fragments thereof

* Additional guidance and training is planned.



Questions and Comments?

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