

From: Hal Wegner [email redacted]
Sent: Wednesday, May 06, 2015 9:08 AM
To: WorldClassPatentQuality
Subject: Testimony Responsive to "Request for Comments on Enhancing Patent Quality"

Herewith is my testimony Responsive to the *Request for Comments on Enhancing Patent Quality*, 80 Federal Register 6475 (February 5, 2015).

Respectfully submitted,

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May 6, 2015

Hon. Michelle K. Lee
Under Secretary of Commerce
U.S. Patent and Trademark Office
Alexandria, Virginia
via email: WorldClassPatentQuality@uspto.gov

Re: “Drafting, the 800 Pound Gorilla Outside the Regulatory Cage”,
Testimony Responsive to the *Request for Comments on Enhancing
Patent Quality*, 80 Federal Register 6475 (February 5, 2015)

Dear Ms. Lee:

This submission addresses the most critical area for quality reform but one that is missing in your proposal: Registration candidates should be compelled to learn “best practices” patent drafting techniques which is best accomplished by the Office providing a *concise* best practices guideline *and* registration examination *testing* on this material.

The current examination falls short while the *Manual of Patent Examining Procedure* gives at best mixed – and often wrong – advice on patent drafting. The testimony identifies the problem and spells out a plan of action. A statement of the writer’s interest and affiliation is found at page 3.

Respectfully submitted,

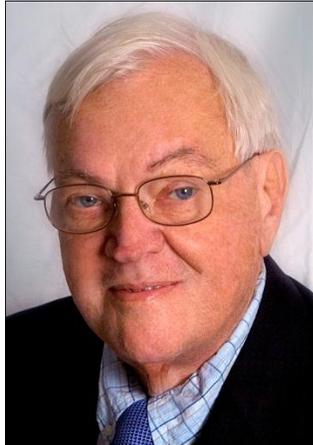
Hal Wegner

Harold C. Wegner

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Statement of Interest



HAROLD C. WEGNER is an Expert Patent Consultant following his retirement from Foley & Lardner LLP where he had practiced for twenty years.

This testimony is submitted *pro bono* on his own behalf and not on behalf of any person or corporation or other organization.

This testimony is based upon the writer's current study of patent drafting in connection with a book, **PATENT DRAFTING**, planned for publication in 2016.

Particularly after work on the book has been finished, Prof. Wegner will be available to cooperate with colleagues on matters involving patent drafting and procurement strategies as well as opinions and other patent matters.

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Appendix: An Excerpt from a work scheduled for publication in 2016:

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I. OVERVIEW

The Patent Office focus on quality patents announced in the *Federal Register* is to be applauded. The single most important quality reform is that better patent applications be prepared and prosecuted – resulting in correspondingly better patents. See § II, *Draftsmanship, Missing in the Quality Initiative*. The initiatives, piecemeal, may make some sense, but not in the context of the ignored shortcomings in the existing *Rules of Practice in Patent Cases* and the *Manual of Patent Examining Procedure*. See § II-A, *Quality Initiatives that Ignore Existing Shortcomings*. Perhaps the best example of this approach is the proposal for an entire section of definitions in an application, while ignoring the existing rule that requires a *Summary of the Invention* that must disclose the “nature” of the invention but is silent as to definitions of elements at the point of novelty. See § II-B, *The “Glossary” Initiative*.

The 800 pound gorilla *not* in the quality initiative room is the *absence* of a quality initiative focused upon teaching patent drafting skills. See § III, *Patent Drafting Skills*. In the first instance, the Patent Office should provide teaching materials on “best practices” patent drafting *and* focus much of the registration examination grade on testing on this information. By testing on this information this would ensure that the patent registration examination courses would focus on this subject and also guarantee that candidates would digest this material. See § III-A, *The Patent Office should Teach Patent Drafting Skills*.

II. DRAFTSMANSHIP, MISSING IN THE QUALITY INITIATIVE

Missing from the quality initiatives is a focus on seeing that high quality *applications* are filed in the first place. In contrast, the *Federal Register* announcement says that its quality initiative notice asks for “guidance to direct its continued efforts towards enhancing patent quality. ... [T]he USPTO is launching a *comprehensive and enhanced quality initiative*.” (emphasis added). That there is nothing in the several proposals that focus on a best practices approach to patent drafting speaks for itself.

A. Quality Initiatives that Ignore Existing Shortcomings

Some of the quality initiatives appear to have come out of the blue – or, at least from somewhere outside the mainstream of the Patent Office procedures without regard to existing shortcomings in the *Manual of Patent Examining Procedure*. For example, under “best practices” of patent drafting it is useful to include in the *Summary of the Invention* a definition of claim elements at the point of novelty. One would think that a well-crafted Rule or the Manual would include a statement that the elements of the claimed invention and definitions at the point of novelty should be included in the *Summary of the Invention*. Instead, the relevant rule and the *Manual of Patent Examining Procedure* say nothing about reciting the elements of the invention nor definitions of elements. Instead, the relevant rule and the *Manual of Patent Examining Procedure* speak about the requirement that this section of the application include a discussion of the “nature” of the invention – an anachronistic statutory requirement of the 1836 Patent Act that has not been a statutory feature of the patent law since January 1, 1953.

B. The “Glossary” Initiative

Instead of fixing the *Manual* to instruct applicants how to draft a *Summary of the Invention* with definitions at the point of novelty, rather, the obsolete teachings of the rule and the *Manual* are ignored and, instead, a broad “glossary” section with definitions is proposed: “[A]s a further initiative to enhance clarity in patent claims, the USPTO has launched a voluntary glossary pilot program. This pilot program provides a framework for applicants in certain fields of art to include definitions of key claim terms within the patent specification in exchange for expedited examination through a first Office action”.

III. PATENT DRAFTING SKILLS

A. The Patent Office should Teach Patent Drafting Skills

The most fundamental reform to improve patent quality is to teach prospective patent practitioners how to draft a patent application. This is not only practical but also consistent with the primary licensure responsibility of the Office to make sure that patent practitioners know how to draft a patent application: The patent registration examination, *by statutory mandate*, authorizes the Patent Office to require for licensure a demonstration that a prospective patent practitioner is “possessed of the necessary qualifications to render to applicants ... valuable service, advice, and assistance in the *presentation of their applications* ... before the Office[.]” 35 U.S.C. § 2(b)(2)(D).

The Patent Office should provide a “best practices” *Manual* of how to *draft* a patent application in a concise format of, say, no more than 150 pages. Instead, the *Manual of Patent Examining Procedure* focuses on *procurement* issues and not on the presentation of an optimum patent document. (Instead of 150 pages, the *Manual of Patent Examining Procedure* now approaches 3700 pages of text.)

If there were a concise text on how to draft a patent application, *and if the patent registration examination focuses a substantial percentage of questions on patent drafting*, then prospective patent practitioners would concentrate their study on patent drafting. Now, with the absence of a Patent Office text showing how to draft an application, coupled with an absence of relevant test questions on patent drafting, prospective candidates *and the patent registration preparation courses* focus their attention on procurement issues.

The absence of adequate testing on patent drafting coupled with the absence of “best practices” information to prepare for the test leaves the Office with candidates who *pass* the test but know nothing or next to nothing about the “best practices” for drafting a patent application.

If new registrants learn the *right way* to draft patent applications, their clients will be better served and, from the standpoint of Office efficiency, the work of the examiner will be greatly minimized.

The double play of “*Manual of Patent Application Drafting*” coupled with testing keyed to that document will ensure that the new generation of patent practitioners will be properly trained.

B. Myriad *Manual* Shortcomings and Contradictions

The *Manual* is a poor reference work to teach the “best practices” for drafting a patent application. With nearly 3700 pages of text and contradictions within this treatise, the *Manual* as a teaching tool for patent drafting is an illusory tool, one that should be recognized as such.

Numerous examples of the problems with the *Manual* are documented in the excerpt from *Patent Drafting* which follows as an appendix.

Appendix: An Excerpt from a work scheduled for publication in 2016:

**PATENT DRAFTING: A Holistic Best Practices Drafting
Approach to the *Leahy Smith America Invents Act***

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6[e] Guidance on how to Draft a Meaningful Patent Application

- 6[e][1] Some Manual “Rules” are not based on the Current Patent Law
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6[f] Lessons to be Learned from the Manual

- 6[f][1] Gaining Allowance, without Validity Focus
- 6[f][2] Allowance through a More Circuitous Route
- 6[f][3] Allowance with Undercut Substantive Rights
- 6[f][4] Manual Guidance, Some Good, Some Less Relevant
- 6[f][5] Danger in *MPEP* Reliance, *Hill-Rom*, a Case Study
 - 6[f][5][A] Outdated Advice on Practice Changes
 - 6[f][5][B] Reluctance to Admit Repudiation of Patent Office Practice
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6[g] Judicial Guidance on Non-Statutory Patentability Requirements

6[h] The “Gist” as an Example of an Antiquated Requirement

6[i] “Summary of the Invention” and the Glossary Initiative

- 6[i][1] Patent Office Rule 73 and MPEP 608.01(d)
- 6[i][2] What the Manual Should (but doesn’t) Require
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- 6[j][2] Early Statutory Origins for the “Nature” Requirement
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6[k] Background of the Invention

- 6[k][1] “Field of the Invention”
- 6[k][2] Prior Art “Information”
- 6[k][3] Discussion of “Problems” of the Invention
- 6[k][4] Problems with a “Background” Section
- 6[k][5] KSR-Related Problems with “Problems”

6[l] Abstract of the Disclosure

- 6[l][1] No Penalty for an Abstract that Defines the Invention
- 6[l][2] Abstract may lead to a Judicially Narrowed Claim Interpretation
- 6[l][3] PCT Abstract Information
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§ 6[d] *The Manual, Origins and Purpose*

§ 6[d][1] *The 1920 Origins of the Manual*

The *Manual* has a heritage dating back to 1920 to what became known as “Wolcott’s Manual”. “One of the most fruitful endeavors of the [Patent and Trademark Office] Society in the area of education was the publication of the first Manual of Patent Office Procedure. The first Manual was written by two employees of the Office and was published in 1920 by the Society. This Manual, with its eight revisions, often referred to as Wolcott's Manual, was the only procedural manual available until 1949 when the Patent Office assumed the publication of the Manual of Patent Examining Procedure.” *About PTOS*, Patent and Trademark Office Society, available at http://www.ptos.org/about_ptos.html (last visited February 19, 2015).

Even after Wolcott’s Manual was superseded in 1949 by the first edition of the *Manual of Patent Examining Procedure* it continued to be cited. Wolcott, *Manual of Patent Office Procedure*, 9th Edition, 1947, is cited for example in *In re Hirschhorn*, 162 F.2d 489, 494 (C.C.P.A., 1947)(Hatfield, J.); *In re Blair*, 162 F.2d 469, 470 (CCPA 1947); *In re Hitchings*, 342 F.2d 80, 83 (CCPA 1965)(A. Smith, J.)(citing *Ex parte Davidson*, 58 USPQ 343 (Pat. Off. Bd. App. 1943)(version not identified)); *In re Strain*, 187 F.2d 737, 739 (CCPA 1951)(Garrett, C.J.).

Since 1920 the *Manual* and predecessor publication known as “Wolcott’s Manual” have been the primary guidance for the Patent Examiner as to everything procedural going on at the Patent Office.

In fact, the *Manual* was not a brand new endeavor but, rather, the continuation of the work of Clinton Leroy Wolcott who was the author of the

major procedural work of the then Patent Office Society (later restyled as the Patent and Trademark Office Society), a voluntary professional organization comprised of Commerce Department employees. The Wolcott work is traced back to 1920 by the Society:

“One of the most fruitful endeavors of the Society in the area of education was the publication of the first Manual of Patent Office Procedure. The first Manual was written by two employees of the Office and was published in 1920 by the Society. This Manual, with its eight revisions, often referred to as Wolcott's Manual, was the only procedural manual available until 1949 when the Patent Office assumed the publication of the Manual of Patent Examining Procedure.”

About PTOS, Patent and Trademark Office Society, available at http://www.ptos.org/about_ptos.html (last visited February 19, 2015)

§ 6[d][2] The 1949 First Edition, the Examiner’s Procedural “Bible”

The once sole and still primary purpose of the *Manual* is to provide instructions to the examining corps.

Prior to the first edition of the *Manual of Patent Examining Procedure* in 1949 the previous year the Commerce Department published Ernest A. Faller, *Manual of Patent Office Procedure* (1948). The *Foreword* of Faller’s work opens with a statement titled *The Objective and Scope of the Manual*:

“The purpose of the manual is three fold, first, to serve as an adequate text for new Examiners to study, second, to serve as a standard reference work for the examining corps, and third, to assist in promoting uniformity of practice among all the divisions of the Office.”

Wegner, *Drafting, the 800 Pound Gorilla Outside the Regulatory Cage*

The *Manual* most assuredly was not originally designed to deal with substantive patent law: “Purely substantive aspects of patent law have been omitted except where they make the practice clearer.” *Id.*

The opening paragraph of the *Introduction*, § 1-1, *Scope and Authority of Manual* repeats the opening quotation from the *Foreword*, but in the same section immediately thereafter adds in upper case: “THE MANUAL SETS FORTH PRACTICE BINDING UPON THE EXAMINER.”

The 1949 original first edition of the *Manual of Patent Examining Procedure* was announced in the pages of the *Journal of the Patent Office Society* as “reference work for patent Examiners[.]” C.E. Haglund, *Manual of Patent Examining Procedure*, 32 J. Pat. Off. Soc’y 35 (1950). In a brief elaboration, Haglund explained that “[t]his Manual contains instructions to Examiners as well as other material in the nature of information and interpretation and generally outlines the current procedures which the Examiners are required or authorized to follow in the normal examination of applications.” *Id.*

§ 6[d][3] Authorship of the Early Editions of the *Manual*

A great deal of the original versions of the *Manual* persists in the most recent versions. The *Manual of Patent Examining Procedure* today still has much of the content taken from the 1940’s and 1950’s when its collective authorship consisted largely of senior career lawyer-examiners who represented much of the cream of the patent profession who entered government service during the Depression and stayed to make examination a career job. Until the mid-1960’s *all senior patent examiners (at GS-13 and above) were members of the bar*. A great many of the leaders of the examining corps through the mid-1960’s who came to the Office in the Depression also chose not to enter private practice keyed to

Wegner, *Drafting, the 800 Pound Gorilla Outside the Regulatory Cage*

religious prejudice that existed at the time. Their expertise in Patent Office practice was superb.

Patent attorneys must carefully scrutinize the use of the *Manual* as a practice guide:

§ 6[d][4] The *Manual* as a Guide to Permitted Procedures

If the goal of the reader is to understand the *regulations* and practice preferred by the examiners, there is no better tool than the *Manual* as can be seen from the background of the early authors as career examiners. *See* § 913, *Authorship of the Early Editions of the Manual*

Indeed, the *Manual* is indispensable to understand formalities and specific issues of procedural practice.

If the goal of the reader is to do no more than *gain allowance* of claims, there is also no better tool than the *Manual*.

§ 6[d][5] Theoretical Advice as a Practice Guide

But, if the goal of the reader is to obtain meaningful patent coverage with claims of appropriate scope and best able to sustain validity, the *Manual* is a hit or miss proposition based almost entirely on a theoretical approach by the authors of the early years: These authors consisted almost entirely – if not totally – of career examiners *who never drafted a single claim for a patent application nor was involved in opinions on patent validity and infringement nor involved in enforcement proceedings.*

§ 6[d][6] *Manual as the Primary Teaching Tool for Practitioners*

On the one hand, the *Manual* is a tertiary resource that has no value as an authoritative source to the extent that it is inconsistent with either the patent law or the *Rules of Practice in Patent Cases*. See § 6[a], *The Manual, a Tertiary Level of Authority*, the *Manual of Patent Examining Procedure*.

On the other hand, the *Manual* is the primary *teaching* source for would be practitioners seeking to be registered to practice at the Patent and Trademark Office: The *Manual* has the imprimatur of the Office in this teaching role; it thus has a greatly magnified level of importance – going far beyond its original purpose as guidance for the examining corps.

The *Manual* historically has been the “bible” for training prospective patent practitioners: The *Manual* is the *primary source* for questions on the patent registration examination, so it is natural that the prospective patent practitioner – after all concerned about *passing the examination* – will focus his study on the *Manual*.

The continued dominance of the *Manual* as the initial training tool for prospective patent attorneys is seen in the official guidance on preparations for and taking the patent registration examination:

**PTO Official Guidance on the Patent Registration Examination:
The Central Role of the *Manual of Patent Examining Procedure****

IX. THE EXAMINATION

A. Source of Examination Questions: *** Before taking this examination, an application should be familiar with the *** procedures as related in the *Manual of Patent Examining Procedure (MPEP)* ***. Questions on the examination are based on the MPEP and other published USPTO policy and procedure reference materials.” ***

D. Examination Preparation Materials: The MPEP and other reference materials are available on the USPTO web site. ***

* * *

X. TEST ADMINISTRATION

C. WHAT TO BRING TO THE TESTING CENTER: ***

DO NOT BRING reference materials *** into the testing center. ***

An applicant admitted to the USPTO Administered examination will be furnished a paper copy of the reference materials during the examination. ***

* *General Requirements Bulletin for Admission to the Examination for Registration to Practice in Patent Cases before the United State Patent and Trademark Office*, United States Patent and Trademark Office, Office of Enrollment and Discipline (OED)(May 2014), pp. 20-24.

To the extent that the *Manual* provides incomplete or incorrect guidance for the prospective patent practitioner, virtually the entire population of patent practitioners builds its basic foundation of knowledge of patent drafting and prosecution skills from this source.

§ 6[e] Guidance on how to Draft a Meaningful Patent Application

There are two major shortcomings to use of the *Manual* as a guide for how to draft claims for meaningful coverage.

First of all, and most obviously, the authors of the early years had no practical experience on which to base advice as to how to draft claims for meaningful protection: Their main tasks were to “reject” or “allow” applications, and not to craft claims that would make for a strong and enforceable patent.

Second, and perhaps more importantly, the instructions in the *Manual* on how to draft an application are in part entirely anachronistic: To follow the *Manual* a *Summary of the Invention* an application should include text “indicating [the] nature * * * [of the invention

The *Manual* is indeed a very important tool for practitioners to get to know in detail the fine points of the *Rules of Practice in Patent Cases* and their further interpretation in the *Manual*. Insofar as formal content of an application, deadlines and so forth, the *Manual* is of undeniable importance and worth.

The original 1949 First Edition of the *Manual* modestly stated its goal to provide guidance to Patent Examiners, while the Foreword to 2014 Fourth Edition boldly proclaims its mission “to provide [] patent examiners, *applicants, attorneys, agents, and representatives of applicants* with a reference work on the practices and procedures relative to the prosecution of patent applications before the USPTO.” (emphasis added). In contrast, the authors of the original 1949 First Edition more modestly and realistically stated the mission of this work as “contain[ing] instructions to Examiners . . .” C.E. Haglund, *Manual of Patent*

Examining Procedure, 32 J. Pat. Off. Soc’y 35 (1950). Secondly, the *Manual* “as well [contained] other material in the nature of information and interpretation and generally outlines the current procedures which the Examiners are required or authorized to follow in the normal examination of applications.” *Id.* The *Manual* was, indeed, nothing more nor less than a “reference work for patent Examiners[.]” *Id.*

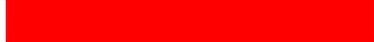
But, the *Manual* has its limitations in terms of value to practitioners: As a way to teach practitioners how to draft and prosecute patent applications to obtain proper coverage with claims of varying scope and effective protection and to obtain claims that will stand up before a jury, it is necessary that a practice guide as advertised in the Foreword should be drafted by those with practical skills in drafting and prosecuting claims – and with experience in enforcement proceedings in the District Court. But, particularly, the early versions of the *Manual* were drafted essentially by career examiners without real world drafting and enforcement experience. Much of what was originally written has been retained.

The value of the *Manual* as a practice guide to drafting and prosecuting an application has been relatively diminished since the original 1949 First Edition, which devoted nearly 90 pages of its just over 200 pages total –over 40 percent of its total content –to its three chapters devoted to the critical elements of patent drafting and prosecution involved in the daily practice of patent law.

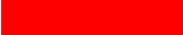
Wegner, *Drafting, the 800 Pound Gorilla Outside the Regulatory Cage*

The 2014 Ninth Edition of the *Manual* has ballooned in overall size to a monstrous level on the rise to approach 4000 pages, up from the initial 1949 level of just over 200 pages – an increase of seventeen (17) times the original volume.

Today, just six (6) percent of the *Manual* is in the chapter devoted to the examination of a new application, while twice that volume is devoted to the *Patent Cooperation Treaty*:

Manual of Patent Examining Procedure		
A Relatively Minor Focus the		
Main Drafting and Examination Chapters		
Ninth Edition (2014)		
Chapter/Year	% of Entire Volume of the <i>Manual</i>	
Application ^a	6 %	
Examination ^b	10 %	
Restriction; Double Patenting ^c	2 %	
Patent Cooperation Treaty ^d	12 %	
^a § 600, <i>Parts, Form, and Content of Application</i>		214/3678 pp. 6 %
^b § 700, <i>Examination of Applications</i>		364/3678 pp. 10 %
^c § 800, <i>Division; Double Patenting</i>		76/3678 pp. 2 %
^d § 1800, <i>Patent Cooperation Treaty</i> (including App. T; AI)		426/3678 pp. 12 %

The emphasis of the *Manual* has strayed from the objectives of the original 1949 First Edition:

Manual of Patent Examining Procedure			
Decreased Focus on the Main			
Drafting and Examination Chapters			
First Edition (1949) vs. Ninth Edition (2014)			
Chapter/Year		% of Entire Volume of the <i>Manual</i>	
§ 600 ^a	1949	10 %	
	2014	6 %	
§ 700 ^b	1949	21 %	
	2014	10 %	
§ 800 ^c	1949	9 %	
	2014	2 %	
^a § 600, <i>Parts, Form, and Content of Application</i>		1949: 21/215 10 %	2014: 214/3678 6 %
^b § 700, <i>Examination of Applications</i>		1949: 46/215 21 %	2014: 364/3678 10 %
^c § 800, <i>Division; Double Patenting</i>		1949: 19/215 9 %	2014: 76/3678 2 %

§ 6[e][1] Some *Manual* “Rules” are not based on the Current Patent Law

While *Manual* interpretations of the statute and case law bear close scrutiny, instructions on how to draft or prosecute an application need not be followed if there is no statutory or proper regulatory basis. A good example is the requirement of the Rules of Practice in Patent Cases that the “nature” of the invention should be explained. This *was* tied to a statutory provision of the nineteenth century but has long lacked statutory basis.

§ 6[e][2] “Most Attorneys Follow the *Manual*”

Defenders of the *Manual of Patent Examining Procedure* who suggest that most applicants follow this document in drafting their patent applications are out of touch with reality.

If the *Manual of Patent Examining Procedure* were in fact carefully followed in patent drafting, every patent would include the “nature of the invention” as a featured part of the application. Thus, to follow the *Manual a Summary of the Invention* must “indicat[e] [the] nature * * * [of the invention.]” See § 831, *Patent Office Rule 73 and MPEP 608.01(d)* (quoting MPEP 608.01(d), *Brief Summary of Invention*, quoting 37 C.F.R. § 1.73, *Summary of the invention*). Similarly, the *Manual* suggests that the specification include an “object” of the invention and a “gist” of the invention.

In fact, if one takes a representative sample of patents from domestic organizations, one finds that fewer than twenty percent set forth an “object” of the invention and only 0.25 % express a “gist” of the invention, both features that the *Manual of Patent Examining Procedure* mandates should be included in a properly drafted patent.

MPEP Drafting “Requirements”: American and Japanese Usage^{*}

Manual Mandated Provision	United States	Japan
“Nature” of the Invention	~ 0 %	~ 0 %
Object of the Invention^b	19 %	57 %
Gist of the Invention^c	0.25 %	2.8 %
Background of the Invention^d	57 %	54 %
Background...including “problems”^e	6 %	2 %
“Means” Claim (at least one per patent)^f	13 %	7.1 %

^a This survey is limited to the “important” cases which is arbitrarily based upon a survey of patents which contain at least one priority claim to either a domestic provisional application or a Japanese “home country” application (2011).

Methodology: Denominator (base search): A search was conducted on Lexis for utility and design patents for one week (November 29, 2011). The base for the search was for patents for American owned patents was [ASSIGNEEATISSUE("united states") and "provisional application" and date(November 29, 2011)] while for Japanese owned patents the base was [ASSIGNEEATISSUE(japan) and PRIORITY-COUNTRY(japan) and date(November 29, 2011)]

^b *Numerator:* Object search added to base search [object! w/4 invention]

^c *Numerator:* Gist search added to base search [gist w/4 invention]

^d *Numerator:* Background” search added to base [background w/4 invention]

^e *Numerator:* *Id.* with “problems; added to base [background w/4 invention w/100 problems]

^f *Numerator:* Means” search added [CLAIMS(means)]

§ 6[e][3] **The *Manual* does not Show how to Gain Meaningful Coverage**

It is extremely important to understand the patent law and case law in formulating a patent drafting strategy. All too often newcomers to the profession seize upon the *Manual of Patent Examining Procedure* – the “MPEP” – as their “bible” to draft and prosecute patent applications. This is a most serious mistake.

The *Manual* does teach how to draft and prosecute patent applications that fit best the Examiner’s conception of what a patent application should like and how prosecution should proceed. But, for the most part, the authors of the *Manual* are career Examiners who have little if any experience in patent drafting nor enforcement of patents.

Certain aspects of the *Manual* represent clearly poor practices for a patent applicant. Blindly following the *Manual* in drafting an application leads to unnecessary time expenditures and, more importantly, to a work product that will be inferior as to scope of protection and validity of the patent.

§ 6[f] **Lessons to be Learned from the *Manual***

§ 6[f][1] **Gaining Allowance, without Validity Focus**

Although recent years have seen the introduction of highly skilled *outside practitioners* join the Patent Office, the bulk of the *Manual* is based on writings from an earlier generation when career Patent Office officials *without outside training* were responsible for *Manual* authorship.

As such experts had a narrow focus on *patentability* – as opposed to enforcement or other post-patenting consequences – the *Manual* is focused on how an application proceeds to the stage of allowance *without significant concerns for validity or enforcement consequences of procurement*.

At this stage, there was no business concern for the newcomer concerning how claims are interpreted after grant; the doctrine of equivalents was a theoretical concern as were the competing doctrines such as prosecution history estoppel and disclosure-dedication. At this stage, even if the patent application was subject to licensing or other negotiations, the newcomer was focused only on the procurement aspect.

Seemingly the entire focus was on getting claims allowed by the Examiner: Here, the best teaching tool to reach this goal was the bible of the patent examiner, the *Manual of Patent Examining Procedure*. As noted earlier in this chapter, the *Manual* teaches how to examine and not how to draft meaningful claims that will provide broad and enforceable coverage.

Some of the most technologically talented patent practitioners found great success in achieving the goal of gaining prompt patent grants that met with the guidance of the *Manual*. Many, *perhaps most* of the patent applications drafted today are with the pen of such practitioners who, because of their expertise in achieving the goal of smooth allowance under the *Manual* guidance, have *stayed* within the sphere of patent drafting and procurement, *without* significant involvement in infringement and validity counseling or patent litigation.

§ 6[f][2] **Allowance through a More Circuitous Route**

Drafting a patent application under the guidance of the *Manual* suggests a drafting practice that is costly in time, an expense in dollars for the extra hours that a practitioner needlessly spends in drafting as well as an indefinite and sometimes fatal cost in a delayed filing under the unforgiving absolute time bar where an independent competitor wins the race to the Patent Office by a single day.

For example, the *Manual* suggests crafting a patent application with a *Background of the Invention*, discussion of “problems” and “solutions”, “advantages” of the invention. It suggests a *Summary of the Invention* that includes a *Field of the Invention*. The *Manual* suggests a recitation of “objects” of the invention. But, each of these suggestions has no statutory basis.

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The *Manual* also suggests special emphasis in the *Summary of the Invention* as well as the *Abstract of the Disclosure* that differs from the claim wording. This added material requires once again comes at a time cost.

§ 6[f][3] Allowance with Undercut Substantive Rights

Every time there is a needless *Background of the Invention*, “problems”, or “objects” set forth in the specification there is the opportunity that there may be an *admission* of motivation to make the claimed invention creating a greater likelihood that the claims of the resultant patent will be held invalid as obvious.

Every time there is a discussion of patentability in an *Information Disclosure Statement* there is a chance that the argument creates a prosecution history limitation to the effective scope of the patent claims after grant. Nothing in the *Manual* emphasizes the point that the duty of disclosure is to *identify* the prior art (as opposed to *characterizing* the prior art).

§ 6[f][4] *Manual* Guidance, Some Good, Some Less Relevant

Literally thousands of details of varying importance – and correctness – are given in the *Manual of Patent Examining Procedure*. So, too, there are several very excellent books showing what *can be done* in drafting patent applications and, particularly, patent claims.

§ 6[f][5] Danger in MPEP Reliance, *Hill-Rom*, a Case Study

As a primary reference, teaching tool for an Agency with a multi-billion dollar budget where the *Manual* now runs to roughly 3800 pages, one would think that it would be a very wise investment for the Patent Office to devote, say, one hundred senior officials to carefully revise this important reference work. But, the *Manual* does have skilled leaders but is woefully, very understaffed.

The problems of the *Manual* are encapsulated in the Patent Office reaction to the Federal Circuit decision in *Hill-Rom Co. v. Kinetic Concepts, Inc.*, 209 F.3d 1337 (Fed. Cir. 2000)(Bryson, J.), where the Federal Circuit utilized a statement in an *Abstract of the Disclosure* to interpret the claims of a patent in direct repudiation of the mandate of the final sentence of the original 37 CFR § 1.72(b) to assure the public that “[t]he abstract will not be used for interpreting the scope of the claims.”

The practical impact of *Hill-Rom* is considered elsewhere. See §1[g][1], *Uniquely Tailored “Abstract of the Disclosure”* (discussing *Hill-Rom*, 209 F.3d at 1341 n.*; *Tate Access Floors, Inc. v. Maxcess Technologies, Inc.*, 222 F.3d 958, 965 n.2 (Fed. Cir. 2000).

The purpose of *this* section is to review how the *Manual* procedurally treats changes in practice generated by the judicial system.

§ 6[f][5][A] Outdated Advice on Practice Changes

It took four (4) years for the *Manual* to be revised to reflect the change in practice generated by the *Hill-Rom* case: Until its May revision, MPEP § 608.01(b), *Abstract of the Disclosure* (May 2004), the *Manual of Patent Examining Procedure* in revisions up to that date continued to quote the final sentence of the original 37 CFR § 1.72(b) to assure the public that “[t]he abstract will not be used for interpreting the scope of the claims.”

§ 6[f][5][B] Reluctance to Admit Repudiation of Patent Office Practice

The May 2004 revision of the *Manual* makes no reference to *Hill-Rom* or *Tate Access* in its revision that *does* however, remove the quoted last sentence of 37 CFR § 1.72(b).

Buried deep in text of sections hundreds of pages away *Hill-Rom* is mentioned in sections that deal with subject matter of no direct relevance to someone drafting an abstract for an original application. See MPEP § 1302.04, *Examiner’s Amendments and Changes* [R-2](8th ed. May 2004) (“As noted by the court in recent decisions, the abstract may be used to determine the meaning of claims.”)(citing *Hill-Rom* and *Pandrol USA, LP v. Airboss Railway Products, Inc.*, 320 F.3d 1354, 1363 n.1 (Fed. Cir. 2003)); see also § 2181, *Identifying a 35 U.S.C. 112, Sixth Paragraph Limitation*, § IV, *Determining Whether 35 U.S.C. 112, First Paragraph Support Exists* (8th ed. May 2004).

§ 6[f][5][C] “Basic Nature” of the Invention

Further guidance of an equally helpful nature is provided later in the same section of the *Manual*: “If the patent is of a *basic nature*, the entire technical disclosure may be new in the art, and the abstract should be directed to the entire disclosure. If the patent is in the *nature of an improvement* in an old apparatus, process, product, or composition, the abstract should include the technical disclosure of the improvement.” (emphasis added).

The United States patent system also is the most liberal system of its kind in the world in permitting an unlimited number of claims and – most unique of all – a virtually unlimited number of “mulligans” – the chance to start prosecution all over again in a continuing application.

A patent applicant has a *right* to draft claims and a specification in a particular manner; he has a *right* to presentation of an unlimited number of claims; and he has a still further *right* to prosecution “mulligans”. Such details cumulatively may be overwhelming and counterproductive.

6[f][6] Applications filed on “Carbon Paper”, Outdated Advice

Outdated advice in the *Manual* is perhaps most graphically seen in the continued instructions concerning the acceptance of new applications that are “mimeographed” or a “nonsmearing carbon copy.” See MPEP § 608.01, *Specification* (“All papers which are to become a part of the permanent records of the U.S. Patent and Trademark Office must be legibly written either by a

typewriter or mechanical printer in permanent dark ink or its equivalent in portrait orientation on flexible, strong, smooth, nonshiny, durable, and white paper. Typed, mimeographed, xeroprinted, multigraphed or nonsmearing carbon copy forms of reproduction are acceptable.”)

§ 6[g] Judicial Guidance on Non-Statutory Patentability Requirements

Beyond the now anachronistic requirement for an “object” or “nature” of the invention, there is a whole host of other points that are raised as relevant which have no statutory basis, including “novel element”, “essence”, “gist” and “key” features, “inventive concept”, “heart”, “essence” or “thrust” of the invention. *See W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1548 (Fed. Cir. 1983)(Markey, C.J.)(quoting *Aro Manufacturing Co. v. Convertible Top Replacement Co.*, 365 U.S. 336, 345 (1961)) (“In determining obviousness, there is ‘no legally recognizable or protected 'essential', 'gist', or 'heart' of the invention”); *SRI Intern. v. Matsushita Elec. Corp. of America*, 775 F.2d 1107, 1128 n.7 (Fed. Cir. 1985)(en banc)(Markey, C.J., joined by P. Newman, J., additional views) (“Reliance on a finding that a ‘novel element’, or ‘essence’ (or ‘gist’, or ‘key’) of a structural invention lies in the operation of a specification-described embodiment of the claimed structure would render meaningless the statutory requirement for claiming, 35 U.S.C. Sec. 112, the statutory requirement for treating claims individually, 35 U.S.C. Sec. 282, and the entire examination system centering on the allowance or rejection of claims.”); *Pennwalt Corp. v. Durand-Wayland, Inc.*, 833 F.2d 931, 949 (Fed. Cir. 1987)(en banc)(Nies, J., additional views) (“It is axiomatic under our precedent that one cannot obtain patent protection for an *inventive concept* or for the *heart* or ‘*essence*’ of an invention or for an achieved result. ... The statute requires that the inventor particularly point out and distinctly claim the subject matter of his invention. 35 U.S.C. Sec. 112,

second paragraph (112-2) (1982). A patent claim is not intended to be and cannot be only a general suggestion of an invention. The invention is defined by the limitations set out in the claim which thereby fix the scope of protection to which the patentee is entitled. The limitations defining the invention tell the public what it cannot make, use, or sell. Equally important, the limitations defining the invention tell the public what it can make, use, or sell without violating the patentee's rights.”); *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1547 (Fed. Cir. 1983)(Markey, C.J.) (“[W]e note [the patentee’s focus on one feature] which it called the ‘thrust of the invention’. That approach is repeated throughout [it’s] briefs, which refer repeatedly to the ‘thrust of the invention’, to ‘the inventive concept’, and to the claims ‘shorn of their extraneous limitations’. That facile focusing on the ‘thrust’, ‘concept’, and ‘shorn’ claims, resulted in treating the claims at many points as though they read differently from those actually allowed and in suit.”); *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 1540 (Fed. Cir. 1983)(Markey, C.J.) (“Judge Boyle's reference to ‘the heart of invention’ was here a harmless fall-back to the fruitless search for an inherently amorphous concept that was rendered unnecessary by the statute, 35 U.S.C.”); *CLS Bank International v. Alice Corp. Pty. Ltd.*, 717 F. 3d 1269 (Fed. Cir. 2013)(en banc)(Rader, C.J., joined by Linn, Moore, O’Malley, JJ., concurring in part and dissenting in part), *aff’d sub nom Alice Corp. v. CLS Bank International*, 134 S. Ct. 2347 (2014) (“It would be improper for the court to ignore [claim] limitations and instead attempt to identify some ‘gist’ or ‘heart’ of the invention. See [*Diamond v. Diehr*, 450 U.S. 175, 188 (1981)] (it is improper to dissect the claims; they must be considered as a whole)”).

§ 6[h] The “Gist” as an Example of an Antiquated Requirement

As previously noted in § 6[g], *Judicial Guidance on Non-Statutory Patentability Requirements*, the courts have said that there is no basis for a “gist” of the invention in patent law. Since the 1952 Patent Act, “[t]here is ‘no legally recognizable or protected 'essential' element, 'gist' or 'heart' of the invention in a combination patent.’ *Aro Mfg. Co. v. Convertible Top Replacement Co.*, 365 U.S. 336, 345 (1961). ‘The invention’ is defined by the claims[.]” *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1565 (Fed. Cir. 1991)(Rich, J.).

Prior to the 1952 Patent Act reference to the “gist” of an invention was made to point out the feature of the invention which today would be the feature considered to be nonobviousness. The creation of the statutory standard of nonobviousness in the 1952 Patent Act made reference to a “gist” unnecessary. Supreme Court cases prior to the 1952 Patent Act referring to the “gist” include *Deering v. Winona Harvester Works*, 155 U.S. 286, 293 (1894)(Brown, J.) (“The gist of Olin's invention seems to be in his taking the grain guide used by Green, providing it with a belt and teeth, ..., traveling faster than the main belt, and for the purpose of keeping the butts in line with the heads of the stalks.”); *Brill v. Peckham Motor Truck Wheel Co.*, 189 U.S. 57, 59 (1903)(Fuller, C.J.) (“[T]he 'gist of the invention consists in combining with the frames of the truck and the spiral springs other springs, viz., elliptical springs, between the car body and the extensions of the independent frame[.]”); *Vandenburgh v. Truscon Steel Co.*, 261 U.S. 6, 12 (1923)(Taft, C.J.) (“ No one can read the specifications and examine the drawings without perceiving that this was the gist of the Vandenburgh invention.”); *Smith v. Magic City Kennel Club*, 282 U.S. 784, 789 (1931)(Hughes, C.J.) (“[P]etitioner insists that the gist of Smith's invention was 'the straight straight

out lure carrying arm laterally extending and operating exclusively in a substantially horizontal plane.”); *Marconi Wireless Telegraph Co. of America v. United States*, 320 U.S. 1, (1943)(Rutledge, J., dissenting in part)(“Mr. Justice Parker found the gist of Marconi's invention...[to be] attainment of the maximum resonance required that means for tuning the closed to the open circuit be inserted in both.”). *See also Martocello v. Kobash*, 39 F.2d 677, 678 (CCPA 1930)(Lenroot, J.)(“[H]e had not abandoned the ball and socket support which is the gist of the invention[.]”); *In re Zuckerman*, 67 F.2d 905, 907 (CCPA 1933)(Bland, J.)(“[T]he new matter which [appellant] seeks to insert by amendment is the gist of the alleged invention, and which was not disclosed or claimed in his original application.”); *In re Dodge*, 74 F.2d 756, 757 (CCPA 1935)(Hatfield, J.)(“The gist of the claimed invention, as stated in appellant's specification, is to provide a limit ‘for the brake-applying movement of the pedal[.]’”); *Hull v. Smith*, 109 F.2d 228, 231 (CCPA 1940)(Jackson, J.)(“[T]he gist of the invention here appears to be a construction of the cathode in such a form that the activating material will not be lost from the surface of the cathode as readily as in the prior art.”); *Rosenberg v. Carr Fastener Co.*, 51 F.2d 1014, 1015 (2nd Cir. 1931)(A. Hand, J.)(“The gist of Rosenberg's invention in all his patents was a cylindrical screw having a hardened thread and threaded the entire length.”);

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Chamberlin Metal Weather Strip Co. v. Barringer, 105 F.2d 880, 881 (6th Cir. 1939)(Allen, J.)("[T]he gist of the invention was the use of a resilient metal strip maintaining itself upon the sash by clamping means alone... and that this constituted a substantial advance in the art.").

§ 6[i] “Summary of the Invention” and the *Glossary Initiative*

The *Summary of the Invention* should include a definition of *certain* (but not all) terms used in the claims, while the *Rules of Practice in Patent Cases* says nothing about this key feature of a patent application. At the same time the Agency’s leadership, without regard to the existing regime, has started a “pilot” to consider the possibility of an across the board set of definitions in a “glossary”: The Patent Office *Glossary Initiative* represents perhaps the best example of the failure of Agency leadership to depart from more than a century of practice, a failure to understand its own *Rules of Practice in Patent Cases* and its *Manual of Patent Examining Procedure*. *Glossary Initiative*, U.S. Patent and Trademark Office, <http://www.uspto.gov/patent/initiatives/glossary-initiative> (last visited March 27, 2015). Indeed, given the time and effort put into the *Glossary Initiative* by the incumbent head of the Patent Office, the *Glossary Initiative* must be regarded as the signature program of Michelle K. Lee.

In a nutshell, the Patent Office *Glossary Initiative* seeks to test the waters as to whether a new practice should be introduced to mandate a “glossary” within each patent application to provide a definition of the terms used in the application. To be sure, the *Summary of the Invention* should be a fixture of every patent application and *should* include a definition of a term at the point of novelty to cabin the “broadest reasonable interpretation” rule of claim construction at the Patent Trial and Appeal Board. But, in the Patent Office guidance on the *Summary*

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of the Invention, there is no mention of a such a definitional section to deal with cabining the “broadest reasonable interpretation rule”; instead, the *Rules of Practice in Patent Cases* focuses upon a disclosure of the “nature of the invention”, an archaic nineteenth century statutory provision grounded in the Patent Act of 1836 but eliminated from the patent law more than sixty (60) years ago.

This present discussion first provides a consideration of what *should* be contained in a proper *Summary of the Invention* and then discusses the guidance the Patent Office provides in its *Rules of Practice of Patent Cases* and *Manual of Patent Examining Procedure*.

The *Glossary Initiative* is perhaps the most publicized initiative of the Lee Administration. In the nearly two year period since her announcement in June 2013, there have been numerous outreach attempts to the public to urge provision of *definitions* of terminology used to define the invention. The variety of attempts to popularize this initiative are self-explanatory when viewed from the Patent Office website. <http://www.uspto.gov/patent/initiatives/glossary-initiative#heading-1>. Yet, marching to the second anniversary of the initiative, an average of just fifty (50) applications per year have entered the program out of a grand total of just over 100 granted petitions in the period through March 2015. When it is considered that there are roughly 500,000 applications filed per year, this means that only one out of every 10,000 applications filed in this period have been granted access to the program or 0.01 % of all new applications. (To be sure, the pilot program is open only to selected technologies so that, if one were to calculate usage within such selected technologies, there is still a usage on the order of less than one half of one percent.)

Quite clearly, there is a need for definitions of *some* terms in the *Summary of the Invention* which are at the point of novelty and where a precise definition would be helpful – or where the inventor *should* provide a definition of such a term to trump the broadest reasonable interpretation” rule used at the Patent Trial and Appeal Board for its post-grant proceedings. With or without a *Glossary Pilot* applicants have been providing such definitions in a *Summary of the Invention*.

What makes the *Glossary Initiative* all the more remarkable is that there has been for generations Patent Office Rule 73 that deals with the *Summary of the Invention* and which *should* be the focus of any revision to provide for definitions or – in the words of the Patent Office leadership – a “glossary”. Yet, Patent Office Rule 73 is a moribund never enforced regulation to implement the 1836 statutory requirement for a disclosure *not* of any definition of the invention but, rather, the “nature” of the invention. Whatever importance its nineteenth century authors may have seen in a statutory requirement for a disclosure of the “nature” of the invention this anachronistic requirement has not been part of the statute as from January 1, 1953.

If there is to be any movement to suggest “definitions” or a “glossary” the starting point should not be a *sua sponte* abrogation of the normal rulemaking process and abandonment of the existing scheme, but, rather a revision of Rule 73. Indeed, some definitions are *critical* and should be encouraged. *See* § 832[c], *Definitions at the Point of Novelty*.

§ 6[i][1] Patent Office Rule 73 and MPEP 608.01(d)

Even today, more than sixty years since a relevant statutory change, the official *Manual* guidance on how to draft a Summary of the Invention quotes the *Rules of Practice in Patent Cases* for the proposition that the “summary of the invention [should indicate] its nature ***”, which may include a statement of the object of the invention[.]” MPEP 608.01(d), *Brief Summary of Invention* (quoting 37 C.F.R. 1.73, *Summary of the invention*)(emphasis added).

More completely, the paragraph from which this statement was excerpted reads (with emphasis added):

“A brief summary of the invention indicating its *nature and substance*, which may include a statement of the *object of the invention*, should precede the detailed description. Such summary should, when set forth, be commensurate with the invention as claimed and any object recited should be that of the invention as claimed.”

Nature of the invention? Substance of the invention?

“Object” of the invention?

The *Manual* further states:

“Since the purpose of the brief summary of invention is to apprise the public, and more especially those interested in the particular art to which the invention relates, of the nature of the invention, the summary should be directed to the specific invention being claimed, in contradistinction to mere generalities which would be equally applicable to numerous preceding patents. That is, the subject matter of the invention should be described in one or more clear, concise sentences or paragraphs. ***

“The brief summary, if properly written to set out *the exact nature, operation, and purpose of the invention*, will be of material assistance in aiding ready understanding of the patent in future searches. The brief summary should be more than a mere statement of the objects of the invention, which statement is also permissible under 37 CFR 1.73.”

MPEP 608.01(d), *Brief Summary of Invention* (emphasis added).

§ 6[i][2] What the *Manual* Should (but doesn't) Require

Before considering what the *Manual* should *not* say, it is important to note what the *Manual* itself *does not* say about the content of a *Summary of the Invention*. Each of the following points *should be* in the *Manual* to reflect case law decisions over the past several decades. The absence of these features manifests a failure to update the *Manual*:

Thus, the Patent Office rule nowhere says that the *Summary of the Invention* *should contain* a verbatim recitation of claim language, *should contain* exemplification of alternate elements where an element in the claims has a limited disclosure, and *should contain* an express definition at the point of novelty, particularly as a way to cabin the “broadest reasonable interpretation” of the claims.

None of these important elements for a *Summary of the Invention* is housed within Rule 73.

§ 6[i][2][A] Verbatim Recitation of the Claim Language

As noted earlier, there are several key requirements for an optimum *Summary of the Invention*, including a verbatim restatement of the features of the *claimed* invention.

§ 6[i][2][B] Exemplification of Claim Elements

Where an element of a claim is performed with reference to only a single feature representing that element without setting forth plural features, case law has in some instances interpreted the element as limited to the single feature; here, the *Summary* should include *alternate* examples to ensure a broad scope of protection. *See LizardTech, Inc. v. Earth Res. Mapping, Inc.*, 424 F.3d 1336, 1345 (Fed.Cir.2005); *SciMed Life Sys., Inc. v. Advanced Cardiovascular Sys., Inc.*, 242 F.3d 1337, 1341 (Fed.Cir.2001)).

§ 6[i][2][C] Definitions at the Point of Novelty

A term in the claim at the point of novelty may be expressly *defined* in the *Summary*...

§ 6[i][2][D] Cabining the “Broadest Reasonable Interpretation”

The Patent Office rule for claim construction at the Patent Trial and Appeal Board gives all terms their “broadest reasonable interpretation”. This can be mitigated by an express definition of a term in the *Summary of the Invention*.

§ 6[j] “Nature of the Invention” Rule without Current Statutory Basis

While there is no rule mandating a definitional section in the *Summary of the Invention*, there *is* a rule even today that mandates a disclosure of the “nature of the invention:

There is no better example of a provision in the first edition that was proper at the time that *remains* today – even in the Rules of Practice of Patent Cases – when long overruled either by statutory enactment or case law. The *Manual of Patent Examining Procedure* through its numerous revisions dating back to the original 1949 first edition provides a snapshot of the failure of the Office to update its guidance to keep in tune with statutory changes:

§ 6[j][1] The 1949 First Edition Correctly Cited the “Nature” Rule

The original 1949 edition of the *Manual* includes a quotation from the Rules of Practice:

Summary of the Invention. A brief summary of the invention indicating its nature and substance, which may include a statement of the object of the invention, should precede the detailed description. Such summary should, when set forth, be commensurate with the invention as claimed and any object recited should be that of the invention as claimed.

§ 608.01(d), *General Statement of Invention* (quoting Rule 73)(Original 1949 edition).

By 1961, the *same Rule 73* is recited in the same section of the *Manual* (since retitled as *Brief Summary of the Invention*). In addition, the following statement has been added to the *Manual*:

“[T]he purpose of the brief summary of invention is to apprise the public ... of the nature of the invention[.] ***

The brief summary, if properly written to set out the exact nature, operation and purpose of the invention will be of material assistance in aiding ready understanding of the invention in future searches. See [§] 905.04. ***

The brief summary of invention should be consistent with the subject matter of the claims. ***

MPEP § 608.01(d), *Brief Summary of the Invention* (Third edition 1961).

§ 6[j][2] Early Statutory Origins for the “Nature” Requirement

A “correct[]” indication of an invention’s “nature” and “design” was introduced as a statutory requirement of the 1836 patent law as a codification of the case law interpretation of the 1793 Patent Act as explained in *Hogg v. Emerson*, 47 U.S. (6 How.) 437 (1848)(Woodbury, J.).

As explained in the Curtis treatise, the 1836 patent law made it a statutory requirement that a patent “shall contain a short description * * * of the invention * * *, correctly indicating [the] nature and design [of the invention.]” George Ticknor Curtis, *A Treatise on the Law of Patents for Useful Inventions*, §221, p. 251 n.3 (Boston: Little, Brown, and Company 1873 (4th ed.))(citing *Hogg v. Emerson*, 47 U.S. (6 How.) at 482, and quoting from The act of Congress of July 4, 1836, c. 357, § 6: “[E]very patent shall contain a short description or title of the invention or discovery, correctly indicating its nature and design[.]”).

The page cited by *Curtis* from *Hogg v. Emerson* puts the 1836 statutory origin of the requirement for a disclosure of the “nature and design” of the invention in perspective as part of the evolution of the requirements to define the invention:

“[T]he revising act as to patents, in July 4th, 1836, changed the phraseology of the law in this respect, in order to conform to this long usage and construction under the act of 1793, and required not in terms any abstract of the petition in the patent, but rather 'a short description' or title of the invention or discovery, 'correctly indicating its *nature and design*,' and 'referring to the specification for the particulars thereof, a copy of which shall be annexed to the patent.' And it is that—the specification or schedule—which is fully to specify 'what the patentee claims as his invention or discovery.' Sec. 5. (5 Statutes at Large, 119.)

It was, therefore, from this long construction, in such various ways established or ratified, that, in the present patent, the schedule, or, in other words,

the specification, was incorporated expressly and at length into the letters themselves, not by merely annexing them with wafer or tape, as is argued, but describing the invention as an 'improvement, a description whereof is given in the words of the said John B. Emerson himself, in the schedule hereto annexed, and is made a part of these presents.' Hence, too, wherever this form has been adopted, either before or since the act of 1836, it is as much to be considered with the letters,— literae patentees, — in construing them, as any paper referred to in a deed or other contract. Most descriptions of lands are to be ascertained only by the other deeds and records expressly specified or referred to for guides; and so of schedules of personal property, annexed to bills of sale. *Foxcroft v. Mallett*, 4 How. 378; 21 Maine, 69; 20 Pick. 122; Phil. on Pat. 228; *Earle v. Sawyer*, 4 Mason, C. C. 9; *Ex parte Fox*, 1 Ves. & Beames, 67. The schedule, therefore, is in such case to be regarded as a component part of the patent. Peters, C. C. 394, and *Davis v. Palmer et al.*, 2 Brockenbrought, 301.

Hogg v. Emerson, 47 U.S. (6 How.) at 482 (emphasis added).

Prior to the reference in *Hogg v. Emerson* to the “nature of the invention” quoted above, the earlier history of the patent law and practice in both England and the United States is explained:

[T]he improvement referred to in the writ and in the letters-patent [in the current case], with the schedule or specification annexed, was in truth one and the same.

Coupling the two last together, they constitute the very thing described in the writ. But whether they can properly be so united here, and the effect of it to remove the difficulty, have been questioned, and must therefore be further examined. We are apt to be misled, in this country, by the laws and forms bearing on this point in England being so different in some respects from what exist here.

[T]he patent [as] first issued... contains no reference to the specification, except a stipulation that one shall, in the required time, be filed, giving a more minute description of the matter patented. (Webster on Pat. 5, 88; Godson on Pat. 6, App.) It need not be filed under two to four months, in the discretion of the proper officer. (Godson on Pat. 176.)

Under these circumstances, it will be seen that the patent, going out alone there, must in its title or heading be fuller than here, where it goes out with the

minute specification. But even there it may afterwards be aided, and its matter be made more clear, by what the specification contains. They are, says Godson on Pat. 108, 'connected together,' and 'one may be looked at to understand the other.' See also 2 Hen. Bl. 478; 1 Webst. Pat. R. 117; 8 D. & E. 95.

There, however, it will not answer to allow the specification, filed separately and long after, to be resorted to for supplying any entire omission in the patent; else something may be thus inserted afterwards which had never been previously examined by the proper officers, and which, if it had been submitted to them in the patent and examined, might have prevented the allowance of it, and which the world is not aware of, seeing only the letters-patent without the specification, and without any reference whatever to its contents. 3 Brod. & Bingh. 5.

The whole facts and law, however, are different here. This patent issued March 8th, 1834, and is therefore to be tested by the act of Congress then in force, which passed February 21st, 1793. (1 Statutes at Large, 318.)

In the third section of that act it is expressly provided, 'that every inventor, before he can receive a patent,' 'shall deliver a written description of his invention,' &c.;—thus giving priority very properly to the specification rather than the patent.

This change from the English practice existed in the first patent law, passed April 10th, 1790 (1 Statutes at Large, 109), and is retained in the last act of Congress on this subject, passed July 4th, 1836 (5 Statutes at Large, 119).

It was wisely introduced, in order that the officers of the government might at the outset have before them full means to examine and understand the claim to an invention better, and decide more judiciously whether to grant a patent or not, and might be able to give to the world fuller, more accurate, and early descriptions of it than would be possible under the laws and practice in England.

In this country, then, the specification being required to be prepared and filed before the patent issues, it can well be referred to therein in extenso, as containing the whole subject-matter of the claim or petition for a patent, and then not only be recorded for information, as the laws both in England and here require, but beyond what is practicable there, be united and go out with the letters-patent themselves, so as to be sure that these last thus contain the substance of what is

designed to be regarded as a portion of the petition, and thus exhibit with accuracy all the claim by the inventor.

But before inquiring more particularly into the effect of this change, it may be useful to see if it is a compliance with the laws in respect to a petition which existed when this patent issued, but were altered in terms shortly after.

A petition always was, and still is, required to be presented by an inventor when he asks for a patent, and one is recited in this patent to have been presented here. It was also highly important in England, that the contents of the petition as to the description of the invention should be full, in order to include the material parts of them in the patent, no specification being so soon filed there, as here, to obtain such description from, or to be treated as a portion of the petition, and the whole of it sent out with the patent, and thus complying with the spirit of the law, and giving fuller and more accurate information as to the invention than any abstract of it could.

In this view, and under such laws and practice here, it will be seen that the contents of the petition, as well as the petition itself, became a very unimportant form, except as construed to adopt the specification, and the contents of the latter to be considered substantially as the contents of the former.

Accordingly, it is not a little curious, that, though the act of 1793, which is to govern this case, required, like that of 1790, a petition to be presented, and the patent when issued, as in the English form, to recite the 'allegations and suggestions of the petition,' (1 Statutes at Large, p. 321, sec. 1, and p. 110, sec. 3,) yet, on careful inquiry at the proper office, so far as its records are restored, it appears that, after the first act of 1790 passed, the petitions standing alone seldom contained any thing as to the patent beyond a mere title; sometimes fuller, and again very imperfect and general, with no other allegations or suggestions, or descriptions whatever, except those in the schedule or specification. The only exception found is the case of *Evans v. Chambers*, 2 Wash. C. C. 125, in a petition filed December 18th, 1790.

Though the records of the patent-office before 1836 were consumed [by the fire in the Patent Office] in that year, many have been restored, and one as far back as August 10th, 1791, where the petition standing alone speaks of having invented only 'an easy method of propelling boats and other vessels through the water by the power of horses and cattle.' All the rest is left to the schedule. Other petitions, standing alone, are still more meagre; one, for instance, in 1804, asks a patent only of a 'new and useful improvement, being a composition or tablets to write or draw on'; another, only 'a new and useful improvement in the foot-stove'; and another, only 'a new and useful improvement for shoemaking'; and so through the great mass of them for nearly half a century. But the specification being filed at the same time, and often on the same paper, it seems to have been regarded, whether specially named in the petition or not, as a part of it, and as giving the particulars desired in it; and hence, to avoid mistakes as to the extent of the inventor's claim, and to comply with the law, by inserting in the patent at least the substance of the petition, the officers inserted, by express reference, the whole descriptive portion of it as contained in the schedule. This may have grown out of the decision of *Evans v. Chambers*, in order to remedy one difficulty there. Cases have been found as early as 1804, and with great uniformity since, explicitly making the schedule annexed a part of the letters-patent. Proofs of this exist, also, in our reports, as early as 1821, in *Grant et al. v. Raymond*, 6 Peters, 222; and one, 1st Oct., 1825, in *Gray et al. v. James et al.*, Peters, C. C. 394; and 27 Dec. 1828, *Wilson v. Rousseau*, 4 How. 649.

Indeed, it is the only form of a patent here known at the patent-office, and the only one given in American treatises on patents. Phillips on Pat. 523. Doubtless this use of the schedule was adopted, because it contained, according to common understanding and practice, matter accompanying the petition as a part of its substance, and all the description of the invention ever desired either in England or here in the petition. Hence it is apparent, if the schedule itself was made a part of the patent, and sent out to the world with it, all, and even more, was contained in it than could be in any abstract or digest of a petition, as in the English form.

Hogg v. Emerson, 47 U.S. (6 How.) at 478-81.

The importance of the specification to interpret the scope of the patent right was emphasized by Justice Woodbury:

[W]hen we are called upon to decide the meaning of the patent included in these letters, it seems our duty not only to look for aid to the specification as a specification, which is customary, (1 Gall. 437; 2 Story, R. 621; 1 Mason, C. C. 477,) but as a schedule, made here an integral portion of the letters themselves, and going out with them to the world, at first, as a part and parcel of them, and for this purpose united together for ever as identical.

It will thus be seen, that the effect of these changes in our patent laws and the long usage and construction under them is entirely to remove the objection, that the patent in this case was not as broad as the claim in the writ, and did not comply substantially with the requirements connected with the petition.

From want of full attention to the differences between the English laws and ours, on patents, the views thrown out in some of the early cases in this country do not entirely accord with those now offered. Paine, C. C. 441; *Pennock et al. v. Dialogue*, 2 Pet. 1. Some other diversity exists at times, in consequence of the act of 1793, and the usages under it in the patent-office, not being in all respects as the act of 1836. But it is not important, in this case, to go farther into these considerations.

Hogg v. Emerson, 47 U.S. (6 How.) at 478-81.

§ 6[j][3] The 1870 Law Mandating Claims to Define the Invention

Perhaps the “nature” of the invention disclosure requirement made sense in the early to mid-nineteenth century when claims were not mandatory as the definition of the invention. But, in the 1870 law that made the patent claim the mandatory feature to define the invention, the now-anachronistic “nature of the invention” requirement was maintained: “[E]very patent shall contain a short title or description of the invention or discovery, correctly indicating its *nature and design....*” *Long v. Rockwood*, 277 U.S. 142, 146 (1928)(McReynolds, J.)(quoting Chapter 230, Act July 8, 1870, 16 Stat. 201 (Rev. Stat. § 4884; section 40, Title 35, U. S. Code (35 USCA § 43; Comp. St. § 9428)).

§ 6[j][4] Definition of Infringement in the 1952 Patent Act

As explained in the *Aro* case, the 1952 Patent Act provided an express statutory definition of infringement as 35 USC § 271(a). *Aro Mfg. Co. v. Convertible Top Replacement Co.*, 365 U.S. 336, 350 n.5 (1961). Regarding prior law, the Court in *Aro* explained that:

Although there was no statutory provision defining infringement prior to [the 1952 Patent Act], the definition [of infringement] adopted is consonant with the long-standing statutory prescription of the terms of the patent grant, which was contained in § 4884 of the Revised Statutes as follows:

“Every patent shall contain a short title or description of the invention or discovery, *correctly indicating its nature and design*, and a grant to the patentee * * of the exclusive right to make, use, and vend the invention or discovery throughout the United States * * *” (Emphasis supplied [by the Court].)

This provision is now contained without substantial change in 35 U.S.C. § 154, 35 U.S.C.A. § 154.

Aro, 365 U.S. at 350 n.5 (emphasis supplied in part by the Court and by this writer).

Quoting the words of the late Pasquale J. Federico, up through the eve of the effective date of the 1952 Patent Act, the statute required “a ... description of the invention ... correctly stating its nature and design.” P. J. Federico, *Commentary on the New Patent Act* [1954], reproduced at 75 J. Pat. And Trademark Off. Soc’y 161, 201-02 (1993). But, the statutory basis for the “nature” and “design” disclosure requirement ceased with the effective date of the 1952 Patent Act: “The old statute [before the 1952 Patent Act] required ‘a short title or description of the invention or discovery, correctly stating its nature and design’; this has been shortened to ‘a short title of the invention’ since the title is of no legal significance.” *Id.*

§ 6[k] Background of the Invention

Under Rule 77(b)(5), it is suggested that a patent applicant “should” include in the patent specification a “[b]ackground of the invention”. 37 CFR § 1.77(b)(5).

The Patent Office as part of Rule 77(b)(5), why saying there “should” be a *Background of the Invention* never says *what the content should be*.

Thus, there is nothing in the Rules that specify *what* must or should be included in the *Background*. Some guidance is provided in the *Manual of Patent Examining Procedure* provides for a three part “Background of the Invention” that provides three separate areas that should be included: Per the *Manual*, the Background of the Invention ordinarily comprises two parts:

“(1) Field of the Invention: A statement of the field of art to which the invention pertains. This statement may include a paraphrasing of the applicable U.S. patent classification definitions. The statement should be directed to the subject matter of the claimed invention.

“(2) Description of the related art including information disclosed under 37 CFR 1.97 and 37 CFR 1.98: A paragraph(s) describing to the extent practical the state of the prior art or other information disclosed known to the applicant, including references to specific prior art or other information where appropriate. Where applicable, the problems involved in the prior art or other information disclosed which are solved by the applicant's invention should be indicated. See also MPEP § 608.01(a), § 608.01(p) and § 707.05(b).”

MPEP § 608.01(c), *Background of the Invention* [MPEP 8th ed. 2004].

§ 6[k][1] “Field of the Invention”

The first part of the proposed *Background* ... of the previous section is that there should be a “field of the invention”. This is an anachronistic provision that is designed to help the *classification* clerk or examiner determine the proper *classification* of the application for assignment to the appropriate examining division or group. Thus, under the *Manual*, the “field” portion of the *Background* section is of “[a] statement of the field of art to which the invention pertains. This statement may include *a paraphrasing of the applicable U.S. patent classification definitions.*” *Id.*; emphasis supplied.

§ 6[k][2] Prior Art “Information”

The *second* part of the *Background* is to provide a “[d]escription of the related art including information disclosed under 37 CFR 1.97 and 37 CFR 1.98”. This should comprise at least one paragraph “describing to the extent practical the state of the prior art or other information disclosed known to the applicant, including references to specific prior art or other information where appropriate.

§6[k][3] Discussion of “Problems” of the Invention

The *Background* provides that “[w]here applicable, the problems involved in the prior art or other information disclosed which are solved by the applicant's invention should be indicated.”

§ 6[k][4] Problems with a “Background” Section

Provided the “information” important to an Examiner and required by Rule 56 is supplied in some form, it is completely unnecessary to supply a Background section in the patent application.

First of all, creating a *Background* section at the time of filing is very dangerous in the sense that there may be a false characterization of the true state of the art. At the time the application is filed, there remain some unpublished but prior filed patent applications that are thus completely unknown to the patent applicant; yet, *after* filing the application, when these applications are *published*, they retroactively become “prior art” under 35 USC § 102(e)(1). Then, the state of the prior art may be discovered to be different. Now, the original statement may be a misrepresentation of the true state of the art. Must there be an amendment?

Second, even if there is no mistake in the characterization of the invention, the characterization may create a narrowed interpretation for the scope of protection under the rules of claim construction.

In the *Reading & Bates* case, the patentee initially got in trouble by describing *his own work* as part of the “Summary of the Prior Art”. *Riverwood Intern. Corp. v. R.A. Jones & Co., Inc.*, 324 F.3d 1346, 1354-55 (Fed. Cir. 2003)(Linn, J.)(discussing *Reading & Bates Construction Co. v. Baker Energy Resources Corp.*, 748 F.2d 645 (Fed.Cir.1984)). In the end, the patentee did win the case on the narrow basis that the work described was the patentee’s own work. *Riverwood*, 324 F.3d 1346 at 1355 (The court “held that the patentee's discussion of his own patent in the specification section entitled ‘Summary of the Prior Art’ did not constitute an admission that the patent was prior art. In reaching its conclusion, the court reviewed our precedent and recognized the ‘policy behind requiring a statutory basis before one's own work may be considered as prior art.’”)(citations omitted).

§ 6[k][5] KSR-Related Problems with “Problems”

The patent applicant who provides a “Background of the Invention” identifying a known problem in the art creates a problem under *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398 (2007). Admission that there is a known problem in the art invites the Examiner of the application or a court evaluating patent validity to conclude that the admission of the known problem creates a motivation to combine references, thereby rendering a possibly unobvious invention obvious.

As noted by the Chief Judge of the Federal Circuit, “[w]hen a claimed invention involves a combination of elements, however, any need or problem known in the relevant field of endeavor at the time of invention can provide a reason to combine. See *KSR* [550 U.S. at 420-21]. Moreover, the prior art need not address the exact problem that the patentee sought to resolve. *Id.*” *Tyco Healthcare Group LP v. Ethicon Endo-Surgery, Inc.*, ___ F.3d ___, ___ (Fed. Cir. 2014)(Prost, C.J.).

Institut Pasteur v. Focarino, 738 F.3d 1337 (Fed. Cir. 2013), points in the same direction:

“When there is a design need or market pressure to *solve a problem* and there are a finite number of identified, predictable solutions, a person of ordinary skill has good reason to pursue the known options within his or her technical grasp. If this leads to the anticipated success, it is likely the product not of innovation but of ordinary skill and common sense.” *Institut Pasteur*, 738 F.3d at 1344 (quoting *KSR*, 550 U.S. at 421 (2007)) (emphasis added).

In yet another case, the Federal Circuit explained that “our cases emphasize that ‘where all of the limitations of the patent were present in the prior art references, and the invention was addressed to a ‘known problem,’ ‘*KSR* . . . compels [a determination of] obviousness.’” *Stone Strong, LLC v. Del Zotto Products of Florida.*, 455 Fed. Appx. 964, 969 (Fed. Cir. 2011) (quoting *Wyers v. Master Lock Co.*, 616 F.3d 1231, 1240 (Fed. Cir. 2010), citing *Ball Aerosol & Specialty Container, Inc. v. Ltd. Brands, Inc.*, 555 F.3d 984, 993 (Fed. Cir. 2009)).

In *Schwemberger* the admission in the specification of a known problem was a basis to reach a conclusion of unpatentability:

“The *specification* ... *discloses a known problem* [M]odifying Pruitt's staple line configuration in accordance with the configuration disclosed by Schulze is no more than ‘the combination of familiar elements according to known methods . . . [with] predictable results.’ See *KSR [Int'l Co. v. Teleflex Inc.]*, 550 U.S. 398, 416 (2007)]; see also *id.* at 421 (‘When there is a *design need or market pressure to solve a problem* and there are a finite number of identified, predictable solutions, a person of ordinary skill has good reason to pursue the known options within his or her technical grasp.’). Therefore, the Board correctly determined that claim 9 is obvious over the combination of Pruitt and Schulze.” *In re Schwemberger*, 410 Fed. Appx. 298, 304 (Fed. Cir. 2010) (emphasis added)

§ 6[1] Abstract of the Disclosure

In most cases, the wording of the claims best describes the invention for anyone – whether the public or a patent practitioner. The *Manual* provides guidance that makes absolutely no sense. While the guidance is more fully quoted at the end of this section, several snippets are cited, here, that tell the whole story:

The public is told that that it should *not* focus on the wording of the claims but instead should explain “the nature and gist of the technical disclosure[.]” What, precisely is the “nature” or “gist” of the invention? Why, precisely should the *Abstract...* teach the “nature” or “gist” of the invention?

Furthermore, that the emphasis of the *Abstract...* is *not* on the invention but rather the “technical disclosure”: Thus, the *Manual* states that “[a] patent abstract is a concise statement of the technical disclosure of the patent[.]”

The reader is told not to use “[t]he form and legal phraseology of ten used in patent claims” and, indeed, not to recite the claimed invention but, instead, “[t]he abstract should sufficiently describe the disclosure[.]”

The *Manual* thus provides the following guidance:

I. GUIDELINES FOR THE PREPARATION OF PATENT ABSTRACTS

A. Background

The content of a patent abstract should be such as to enable the reader thereof, regardless of his or her degree of familiarity with patent documents, to determine quickly from a cursory inspection of *the nature and gist of the technical disclosure* and should include that which is new in the art to which the invention pertains.

B. Content

A patent abstract is a concise statement of the technical disclosure of the patent and should include that which is new in the art to which the invention pertains.

If the patent is of a basic nature, the entire technical disclosure may be new in the art, and the abstract should be directed to the entire disclosure.

If the patent is in the nature of an improvement in old apparatus, process, product, or composition, *the abstract should include the technical disclosure of the improvement.*

If the new technical disclosure involves modifications or alternatives, *the abstract should mention by way of example the preferred modification or alternative.*

With regard particularly to chemical patents, for compounds or compositions, *the general nature of the compound or composition should be given* as well as the use thereof....

C. Language and Format

The abstract should be in *narrative form* and generally limited to a single paragraph within the range of 50 to 150 words. *** *The form and legal phraseology often used in patent claims, such as “means” and “said,” should be avoided.* The abstract should sufficiently *describe the disclosure* to assist readers in deciding whether there is a need for consulting the full patent text for details.

D. Responsibility

Preparation of the abstract is the responsibility of the applicant. Background knowledge of the art and an appreciation of the applicant's contribution to the art are most important in the preparation of the abstract. ***

Source: MPEP § 608.01(b), Abstract of the Disclosure (emphasis added).

§ 6[1][1] No Penalty for an Abstract that Defines the Invention

There is no penalty against an applicant who files a proper statement of the *claimed invention* as the *Abstract of the Disclosure*. At worst, the Examiner may require a new *Abstract*....

§6[1][2] Abstract may lead to a Judicially Narrowed Claim Interpretation

Where the patent applicant drafts an *Abstract*... in accordance with the *Manual* different language will be used to describe the invention which can be used to *narrow* the effective scope of the claimed invention. *See Hill-Rom Co. v. Kinetic Concepts, Inc.*, 209 F.3d 1337, 1341 n.* (Fed. Cir. 2000)(Bryson, J.); *Tate Access Floors, Inc. v. Maxcess Technologies, Inc.*, 222 F.3d 958, 965 n.2 (Fed. Cir. 2000).

§ 6[1][3] PCT Abstract Information

It is manifest that there is no close supervision of the *Manual* which in its nearly 3700 pages offers diametrically opposing viewpoints. This is no better illustrated than in the statements in one portion of the *Manual* that say that the “gist” of the invention must be disclosed, § 6[1][3][A], *see The “Pro-Gist” Requirements for PCT Applications*, balanced by completely opposite statements elsewhere, § 6[1][3][B], *see The “Anti-Gist” Reality Elsewhere in the Manual*.

§ 6[1][3][A] The “Pro-Gist” Requirements for PCT Applications

In the discussion of the Abstract for a PCT Application, MPEP § 1826, *The Abstract*, there is a section entitled *Summary of Abstract Requirements*, that states that the *Abstract*.

“Should contain:

- (A) Indication of field of invention.
- (B) Clear indication of the technical problem.
- (C) Gist of invention's solution of the problem. ...”

Thus the PCT requirement for an *Abstract* requires identification of a “gist of [a] solution,” “the technical field” of the invention, a “technical problem” and “the gist of the solution of that problem.” See MPEP § 1826 (quoting PCT Rule 8.1(a)(i)) (“The abstract shall [contain] a summary of the disclosure as contained in the description, the claims, and any drawings; the summary shall indicate the technical field to which the invention pertains and shall be drafted in a way which allows the clear understanding of the technical problem, the gist of the solution of that problem through the invention, and the principal use or uses of the invention[.]”).

§ 6[1][3][B] The “Anti-Gist” Reality Elsewhere in the *Manual*

Yet, in another portion of the *Manual* obviously written by a completely different team, inconsistent (but correct) advice is given in MPEP § 2141.02, *Differences Between Prior Art and Claimed Invention*, at § II, *Distilling the Invention down to a “Gist” or “Thrust” of an Invention Disregards “As a Whole” Requirement*: “Distilling an invention down to the ‘gist’ or ‘thrust’ of an invention disregards the requirement of analyzing the subject matter ‘as a whole.’ *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984) (restricting consideration of the claims to a 10 % per second rate of stretching of unsintered PTFE and disregarding other limitations resulted in treating claims as though they read differently than allowed). . . .”

