



Pillar 1 — Proposal 3: Clarity of the Record

Summary: In order for the patent system to fulfill its critical role in promoting innovation, patents must not only fully comply with all statutory requirements, but also contain an Official record that is unambiguous and accurate. Such a complete record provides patent boundaries that are clearly defined to the benefit of the patent owner, the courts, third-parties, and the public at large, giving inventors and investors the confidence to take the necessary risks to launch products and start businesses, and the public the benefit of knowing the precise boundaries of an exclusionary right. The USPTO is actively pursuing further measures and initiatives for enhancing the clarity and completeness of all aspects of the Official record during prosecution of an application as part of its continued commitment to issuing patents that clearly define the scope of the rights therein, that are within the bounds of the patent statutes as interpreted by the judiciary, and that provide certainty as to their validity to encourage investment in research, development, and commercialization. Accordingly, the USPTO is initiating a discussion to identify procedures that could be made part of standard examination practices to improve the clarity of the prosecution record.

| Concept | Brainstorming Questions |
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| General | <ul style="list-style-type: none"> • What have you seen in Office actions that have helped clarify the Official record and should, therefore, be considered routine practice? • What downstream (litigation/enforcement) issues should the USPTO consider when proposing additional requirements, such as a statement of claim construction, for the purpose of clarifying the Official record? |
| Claim Construction | <ul style="list-style-type: none"> • Should the USPTO create a more detailed prosecution record that defines the scope of a patent through explicit claim construction? If so, how could the USPTO best achieve this? |
| Memorializing the Oral Record | <ul style="list-style-type: none"> • What are the advantages and disadvantages of making the substance of interviews more extensive on the record? For example, should applicant-examiner interviews be recorded and/or transcribed and, if so, how should the cost of recordation and/or transcription be recovered by the Office? • Would it be helpful for the USPTO to provide an explanation on the record concerning the decision made in a pre-appeal conference or appeal conference not to re-open prosecution? If so, what should such an explanation include and should applicant have a right to comment on this explanation? |
| Reasons for Allowability | <ul style="list-style-type: none"> • When during prosecution should an examiner provide reasons for why a claim is allowable, and what should such reasons for allowability include to aid in determining the scope of a patent? |