

February 12, 2016

U.S. Patent and Trademark Office
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450
Office of Deputy Commissioner for Patent Examination Policy
Office of Patent Legal Administration
Attn: Michael Cygan
Senior Legal Advisor

Via email TopicSubmissionForCaseStudies@uspto.gov

Re: AIPLA Comments on Submission of Topics for USPTO Quality Case Studies 80 Fed. Reg. 79277 (December 21, 2015)

Dear Mr. Cygan:

The American Intellectual Property Law Association (“AIPLA”) is pleased to present the following comments to the USPTO Request for Submission of Topics for USPTO Quality Case Studies, in response to an invitation for written comments. 80 Fed. Reg. 79277 (December 21, 2015).

AIPLA is a national bar association of approximately 14,000 members who are primarily lawyers engaged in private or corporate practice, in government service, and in the academic community. AIPLA members represent a wide and diverse spectrum of individuals, companies, and institutions involved directly or indirectly in the practice of patent, trademark, copyright, trade secret, and unfair competition law, as well as other fields of law affecting intellectual property. Our members represent both owners and users of intellectual property. Our mission includes helping establish and maintain fair and effective laws and policies that stimulate and reward invention while balancing the public’s interest in healthy competition, reasonable costs, and basic fairness.

Title: Consistency in the treatment of claims having terms of degree.

Proposal for study: AIPLA proposes a study to determine whether claims that include terms of degree, such as “substantially,” “approximately” and “generally” are being handled consistently and according to MPEP § 2173.05(b).

Explanation: Our members have observed that some Examiners seem to believe that terms of degree inherently render claims indefinite and these Examiners do not perform the analysis set forth in the cited MPEP section. We propose that the Office identify applications having claims that were rejected under § 112(b) and that include terms of degree, such as “about,”

“substantially” and “essentially” to determine whether the rejections are consistently following the guidance from the MPEP. This pilot may assist the Office in providing a uniform approach for Examiners, reducing the need for applicants to respond to improper indefiniteness rejections, and requesting fewer claim amendments in response to such rejections.

AIPLA appreciates the opportunity to propose case studies to improve the quality of examination and, thus, to improve the quality of issued patents. We look forward to working with the Office in the implementation of these or any other case studies.

Respectfully Submitted,



Denise W. DeFranco

President

American Intellectual Property Law Association