

**United States Patent and Trademark Office
Notification of Next Software Partnership Meeting
October 17, 2013**

Discussion Regarding Strategies for Improving Claim Clarity: Glossary Use in Defining Claim Terms

I. Introduction

The United States Patent and Trademark Office (USPTO) is hosting a Software Partnership Meeting on October 17, 2013, at U.C. Berkeley School of Law from 8:30 a.m. to 12:30 p.m. This meeting will provide a forum for stakeholders and the USPTO to discuss, *inter alia*, potential strategies to improve clarity, including the possible use of glossaries in patent applications to assist examiners in claim interpretation. To facilitate that discussion, the USPTO provides the following questions and possible pilot glossary programs.

Stakeholders are welcome to submit responses and/or comments about the questions and possible pilot glossary programs in advance for discussion at the Software Partnership Meeting. Advance responses and/or comments should be submitted by Thursday, October 3, 2013. Alternatively, written responses and/or comments can be submitted for consideration by the USPTO no later than Thursday, October 17, 2013.

Responses and/or comments should be sent by electronic mail addressed to: SoftwareRoundtable2013@uspto.gov. Comments also may be submitted by mail addressed to: Mail Stop Comments—Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313–1450, marked to the attention of Seema Rao, Director, Technology Center 2100. Although comments may be submitted by mail, the USPTO prefers to receive comments via the Internet.

II. Questions

A. *For Those Who Routinely Use a Glossary (or Definition) Section in a Patent Application:*

1. What impacts on prosecution have you seen from using glossaries (e.g., efficiency, clarity, number and type of rejections)?
2. How do you evaluate the impact of glossaries on prosecution?
3. Please provide specific examples where the use of a glossary was helpful during and/or after prosecution (i.e., litigation, re-exam, re-issue, licensing).
4. Do you provide a separate glossary section in the specification (i.e., under its own heading)? Why or why not?

5. Do you use a single composite glossary or divide the glossary into different subsections for specific types of definitions (i.e., subsections for claim terms, acronyms, non-claim terms)? Why or why not?
6. Do you utilize a particular format for the definitions within the glossary (e.g., tables, formulae, bulleted list)? Why or why not? If possible, please provide an example of your preferred format.

B. For Those Who Do Not Routinely Use a Glossary (or Definition) Section in a Patent Application:

1. Why do you not use a glossary section?
2. Do you foresee any issues or concerns with the use of glossaries during and/or after prosecution? If so, what issues or concerns?

C. Possible Glossary Pilot Program Structure

The Office is contemplating a pilot examination program to explore the feasibility of using glossaries for claim terms in patent applications to improve claim clarity. The Office is seeking feedback on the following aspects of the potential structure of a possible glossary pilot program:

1. What incentives, if any, could the USPTO provide to encourage you to participate in a glossary pilot program and provide a glossary for claim terms in applications under the pilot?
2. For the technological areas where you practice, which specific areas would benefit from the use of a glossary in the specification? Why?

D. Form and Content for a Glossary to be Supplied in a Possible Glossary Pilot Program

To assist in designing a possible glossary pilot program, the USPTO is seeking feedback on the form and content of definitions to be provided in a glossary section of the specification that is consistent with the written description, enablement, and definiteness requirements in 35 U.S.C. § 112 and the broadest reasonable interpretation standard for claim construction employed by the USPTO.

1. What restrictions, if any, should be placed on the format of the glossary section; such as limits on the length of each definition, the number of alternatives provided in a definition, and the number of definitions in the glossary section?
2. Please comment if the following glossary criteria should be used in determining whether an application is eligible for admission into a potential glossary pilot program:
 - a. The glossary must be a separate section in the specification with its own heading entitled "Glossary." The glossary cannot be an appendix or submitted as an Information Disclosure Statement (IDS).
 - b. The glossary definitions must "stand alone" and cannot simply refer to other sections or text within the specification or incorporate by reference a definition (or portion) from another document.
 - c. A definition in the glossary cannot be disavowed by the disclosure or during prosecution; for example, by stating "the definition presented in the glossary is not limiting."
 - d. Alternative definitions for the same claim term that are inconsistent with each other are not permissible.
 - e. The glossary, at least at a minimum, must define functional claim terms, the structure associated with any claimed function, abbreviations/acronyms, evolving technology nomenclature, relative terms, terms of art, and unique words that lack an ordinary and customary meaning.
 - f. A definition cannot consist only of a list of synonyms or examples.
3. What other criteria would you recommend for a glossary definition?

E. Potential Features of a Possible Glossary Pilot Program

The USPTO has identified potential variations of a possible glossary pilot program. Each variation is discussed in more detail herein. For each variation, the term "pilot guidelines" means the guidelines that will be developed after taking stakeholder input into account.

1. For Patent Applications Not Yet Filed

- An applicant requests to participate in a glossary pilot program for a patent application to be filed.
- The applicant submits a glossary in the original specification following pilot guidelines.

2. For Pending, Unexamined Patent Applications

- An applicant requests to participate, or alternatively, the USPTO invites an applicant to participate in a glossary pilot program in a pending, unexamined patent application.
- The applicant submits a glossary via a preliminary amendment following pilot guidelines. The preliminary amendment must include specific reference to the precise locations in the originally filed disclosure where support for the definitions in the glossary is found. Generic references to the originally filed disclosure for support are not permitted.

F. Miscellaneous

1. Please provide any other information regarding the use of a glossary or a possible glossary pilot program not addressed above that you think is important for the USPTO to consider.