

GLOSSARY PILOT



Examiner Training



Training Overview

- Background
 - Terminology
 - Historical Issues/White House Initiative
 - Preliminary Investigations
- Glossary Pilot
 - General Structure
 - Requirements
 - SPE & Examiner Roles
 - Pre and Post Examination Surveys

Glossary Pilot



Background



Glossary: Terminology

- **Definition:** an explanation provided in the disclosure that provides meaning and scope to a term or phrase. The definition can be broad in scope. The definition cannot be solely a list of examples.
- **Relevant or Key term or phrase:** a technical, structural, or functional term or phrase pertinent to the scope of the claimed invention.



Glossary: Terminology

- **Glossary or glossary section:** A glossary is a single grouped collection of definitions where substantially all the definitions are contained in a relatively contiguous portion of the disclosure. It should have an appropriate heading but does not have to be specifically labeled with a heading “Glossary” or “Definitions”. A glossary cannot be solely a table of acronyms or parts listing.



Functional Claims: Issues

- Historical issues with functional terms in software related patent applications:
 - 35 USC 102/103: Prior Art
 - 35 USC 112(a): Scope/Breadth
 - 35 USC 112(b): Clarity; no Metes and Bounds
 - 35 USC 112(f): Unclear whether invoked
 - 35 USC 101: ineligible subject matter



The White House Executive Action

EXECUTIVE ACTIONS:

2. “Tightening Functional Claiming. The AIA made important improvements to the examination process and overall patent quality, but stakeholders remain concerned about patents with overly broad claims — particularly in the context of software. The PTO will provide new targeted training to its examiners on scrutiny of functional claims and will, over the next six months develop strategies to improve claim clarity, such as by use of glossaries in patent specifications to assist examiners in the software field.” *(emphasis added)*

FACT SHEET: White House Task Force on High-Tech Issues, 6/4/2013



Preliminary Investigations

Pre-Pilot investigations:

- OPQA review of allowed applications – quality
- Patents analysis of issued applications - efficiency
- Focus sessions with examiners and patent management
- External stakeholder input at three roundtable events held in New York, Silicon Valley and Berkeley
- Written comments from the public



Preliminary Investigations: Conclusions

- OPQA and Patents studies: no statistical correlation between a glossary and quality or efficiency of examination.
 - Problems:
 - small sample size
 - low frequency of glossaries/definitions, and
 - variation in quality of definitions.
- A structured glossary pilot should provide a more conclusive determination of the effects of a glossary on patent examination.



Preliminary Investigations: Conclusions

- Internal stakeholders generally expect that a well-structured glossary section will improve the examination process.
- External stakeholders expectations are mixed, with a sizeable minority supporting the concept of a glossary section in their applications.
- (See [Glossary Microsite](#) for more information)

Glossary Pilot



Structure, Entry
Requirements, SPE &
Examiner Roles, Surveys



Glossary Pilot: Overview

- Pilot Structure
 - Technology Centers
 - 2100, 2400, 2600, 3600 (BM AUs only)
 - Total number of applications
 - 200
 - 50 applications per TC
 - Start and End dates
 - June 2, 2014
 - 6 months or 200 applications accepted into the pilot, whichever comes first



Glossary Pilot: Entry Requirements

- Applicant's Requirements (set forth in FR Notice: **79 FR 17137**)
 - File a Petition to Make Special in a utility application (decided by TC POC)
 - Meet Filing Conditions and Requirements
 - No fee required for the petition*



Glossary Pilot: Entry Requirements

A. Filing Conditions:

- 1) The application must be:
 - a) an original, non-reissue, non-provisional utility application filed under 35 U.S.C. 111(a) that does not claim the priority to a prior filed non-provisional U.S. application (i.e., cannot be a continuation or divisional application), except the application can claim benefit of a provisional application, **or**
 - b) a Continuation-in-part



Glossary Pilot: Entry Requirements

A. Filing Conditions – cont.

- 2) Application must be submitted in English and contain a Glossary section in the specification at the time of filing.
- 3) ADS must include all benefit and priority claims
- 4) A Petition to Make Special (**PTO/SB/436**) must be filed concurrently with the filing of the application.



Glossary Pilot: Entry Requirements

A. Filing Conditions – cont.

- 5) Must contain at least 1 claim, including 4 or fewer independent claims and 30 or fewer total claims *and* no multiple dependent claims*
 - a) Preliminary Amendment required to correct
- 6) Invention must be classified in TCs 2100, 2400, 2600 or 3600 (Business Methods Only)
- 7) Filed via EFS-Web
- 8) If filed with another accelerated examination request, must satisfy all conditions and requirements of the other procedures



Glossary Pilot: Entry Requirements

B. Requirements (6 items):

- 1) Glossary must be a sub-section at the beginning of the detailed description portion of the original specification and presented at time of filing. It must be filed at the time of filing the application
 - a) It cannot be filed via amendment on a date after filing.

- 2) The Glossary definitions must be ***“self-contained”***



Glossary Pilot: Entry Requirements

B. Requirements (cont.)

- 3) Each definition must establish limits for the scope of the term or word it defines.
 - a) The definitions provided in the glossary *are* the controlling definitions of the terms or words they define.



Glossary Pilot: Entry Requirements

B. Requirements (cont.)

- 4) Glossary definitions cannot be disavowed elsewhere in the application.
- 5) Glossary definitions cannot **solely** consist of a list of examples and/or synonyms or negative statements*



Glossary Pilot: Entry Requirements

B. Requirements (cont.)

- 6) Glossary definitions should include key terminology that will assist in clarifying the record. *Note: Functional terms defined shall include the associated structure(s) disclosed for performing the function*



Glossary Pilot: Entry Requirements

- ✓ What if fulfillment of requirement 6 is questionable?
- ✓ What if one definition in a glossary section does not meet the requirement but the other definitions do?



Glossary Pilot: Definition Examples

- Metadata:
 - *Example (1):* Supplemental data *describing* primary data.
 - *Example (2):* Supplemental data *which can* describe primary data.
 - *Example (3):* Supplemental data *which does not* describe primary data.
 - *Example (4):* Metadata includes type, size, author, date and other similar data.



Glossary Pilot: Exclusions

- Applicant cannot participate in PPH
- Applicant cannot disavow, alter or supplement the meaning of any term defined in the Glossary section submitted on filing.
- Applicant cannot delete any definitions.
- Applicant cannot amend the claims to more than 4 independent and 30 total claims after the petition is granted and before the first action.*



Glossary Pilot: Impact on Examination

- Any claim term that is not defined in the glossary section submitted on filing will be interpreted in accordance with the Office's standard policy, practice and procedure for claim interpretation. See MPEP 2111
- The examiner will consider the glossary section as controlling for the meaning of the terms defined in the glossary section.



Glossary Pilot: Application Status

- Applications are also eligible for participation in the First Action Interview Pilot Program.
- The application is removed from “Special” status after First Action (FA). The FA can be a restriction requirement or an action on the merits.
- Upon the filing of an amendment or response to the FA, the application will be placed on the examiner’s Regular Amended Docket.



Glossary Pilot: POC & SPE Roles

- **POCs will:**
 - Grant or Deny Petitions
 - Send notice to Applicants
 - Notify Training Personnel of case and volunteer examiner (Note: Examiner will be noticed of date/time for training before first case docketed)
 - Granted Petitions will be then forwarded to the SPE for docketing to volunteer examiner
 - Docket cases to volunteer examiners after petition is granted
- **SPEs will:**
 - Ensure cases are being examined timely (same as today).
 - Approve othertime after completion of surveys



Glossary Pilot: Examiner Role

- Examiners will:
 - Examine the application *normally*.
 - Fill out Pilot Survey
 - A single survey completed at the time of examination for *each* pilot case to properly record data.
 - Fill out Non-Pilot survey
 - To be completed after the first pilot case.
 - To cover up to 5 cases (would like to be completed within a 2 bi-week period).
 - Manage docket under normal DM requirements.



Glossary Pilot: Docket Management

- Manage all DM issues the same as today.
 - See [Docket Management Manual](#) on PAP Taskforce Homepage
 - Glossary Pilot cases are placed on “Special New” docket
 - 14 Expected Average Days, 28 Ceiling Control Days
 - cases can become ceiling exceeded if not completed before the 28 day ceiling.
 - Examiners in a Part-time program - DM exceptions apply



Glossary Pilot: FITF

- Glossary Pilot and FITF
 - Most cases will be examined under AIA law, but some may be examined under pre-AIA law*
 - Volunteer examiners required to take *all* AIA training prior to examining Glossary Pilot applications, which includes:
 - Comprehensive Training
 - AIA Indicator Training
 - Hands On Workshop (see [FITF - HOW](#) for more information)



Pilot Case Survey Instructions

- Instructions on top of survey!
- Do a survey at the time of examination for *each* case to properly record data.
 - Only if the first action is a FAOM or Allowance
 - Restrictions: please wait and fill out form when an action on the merits is completed
 - Overtime given after completion and submission of survey
- After each survey is completed then send *each* Pilot Case Survey form to the Glossary@uspto.gov email box and cc: your SPE.



Glossary Pilot: Pilot Case Survey

Glossary Survey

Instruction: For each Glossary Pilot application, please complete this survey in its entirety after First Office Action on the Merits only (not at time of written restriction).

Email survey to: Glossary@uspto.gov and cc your SPE.

Other time (1 hour) will be authorized when the survey is completed and emailed.

For the purposes of this survey:

A **relevant term or phrase** is related to a technical, structural, or functional term or phrase that affects the scope of the invention. This does not include legal phraseology (e.g. "consisting essentially of," "comprising," "said," etc.).

A **definition** is an explanation provided in the disclosure that limits the scope of a relevant term or phrase. The definition can be broad in scope. The definition cannot be solely a list of examples.

A **glossary** is a single grouped collection of definitions where substantially all the definitions are contained in a relatively contiguous portion of the disclosure. The glossary is not labeled with a heading "Glossary" or "Definitions". A glossary cannot be solely a table of acronyms or parts listing.

A **glossary section or definition section** is a labeled glossary with a heading "Glossary" or "Definitions".

A **disavowal** is any statement that essentially withdraws a previously asserted definition (e.g. the definition presented is not limiting).

Examiner Name: _____ Art Unit: _____

Please use the following when completing the survey: for all Yes answers use [X]

Application No.	Class / subclass	Assignee	Office Action Type		Are there definitions in the disclosure (pick all that apply, indicate the number of definitions)?		What types of relevant terms are defined (pick all that apply)?						Did the claims contain any defined relevant terms?		Was there any disavowal of a definition in the specification?		Did you issue 112 rejection based on a defined term?		D reje t	
			Non-Final	Allowance	Dispersed throughout	Glossary Section	Functional Terms	Structural Elements	Abbreviations or Acronyms	Substantive Terms	New Technical Terms	Relative Terms or Terms of Degree	Other *	Yes	No	Yes	No	112(a)/ 112(1st)		112(b)/ 112(2nd)
example	717/001	clark	X		3	8	X				X	X		X		X		X	X	
99123654	370/001	disco		X											X		X		X	



Glossary Pilot: Non-Pilot Case Survey

- Non-Pilot Case Survey
 - To be completed after first pilot case completed
 - One survey to cover Office actions completed within a 2 bi-week period.
 - 5 applications
 - FAOM (new cases or RCEs)
 - Electronic spreadsheet – emailed to Glossary@uspto.gov and cc:SPE



Glossary Pilot: Non-Pilot Case Survey – cont.

For the purposes of this survey:

A **relevant term or phrase** is related to a technical, structural, or functional term or phrase that affects the scope of the invention. This does not include legal phraseology (e.g. "consisting essentially of," "comprising," "said," etc.).

A **definition** is an explanation provided in the disclosure that limits the scope of a relevant term or phrase. The definition can be broad in scope. The definition cannot be solely a list of examples.

A **glossary** is a single grouped collection of definitions where substantially all the definitions are contained in a relatively contiguous portion of the disclosure. The glossary is not labeled with a heading "Glossary" or "Definitions". A glossary cannot be solely a table of acronyms or parts listing.

A **glossary section or definition section** is a labeled glossary with a heading "Glossary" or "Definitions".

A **disavowal** is any statement that essentially withdraws a previously asserted definition (e.g. the definition presented is not limiting).

Examiner Name: _____ Art Unit: _____

Please use the following when completing the survey: for all Yes answers use [X] for all No answers use [leave blank]

Application No.	Class / subclass	Assignee	Office Action Type				Are there definitions in the disclosure (pick all that apply, indicate the number of definitions)?				What types of relevant terms are defined (pick all that apply)?						Did the claims contain any defined relevant terms?		Was there any disavowal of a definition in the specification?		Did you i
			FAQM	Final	Allowance	Other	No	Dispersed throughout	Glossary	Glossary Section	Functional Terms	Structural Elements	Abbreviations or Acronyms	Substantive Terms	New Technical Terms	Relative Terms or Terms of Degree	Other	Yes	No	Yes	No
example	717001	clark		X					8	X			X	X		X		X		X	
99123654	370001	cisco	X				X										X			X	X



Non-Pilot Case Survey Instructions

- Instructions on top of survey!
- Do survey at the time of examination for each case to properly record data.
- Once all 5 cases are completed then you can send the *single* Non-Pilot Case Survey form to the Glossary@uspto.gov email box (cc: SPE).



Glossary Pilot: Other Time Code

- Today's training
 - 1 hour of other time
- Pilot Case Surveys
 - 1 hour of other time for **each** survey completed
- Non-Pilot Case Survey
 - 1 hour for completion of **entire** survey

Time Code: **ATRRAIN-0000-090145**



Points of Contact

- TC POCs
 - TC 2100: Christyann Pulliam
 - TC 2400: Beatriz Prieto
 - TC 2600: Jinsong Hu
 - TC 3600: Namrata Boveja
- Glossary Microsite - PAI (Internal)
 - <http://w-pattr-600.etc.uspto.gov/ron/pabst/glossary.html>
- Glossary Microsite (Public)
 - http://www.uspto.gov/patents/init_events/glossary_initiative.jsp

Thank You!



Questions?