

**From:** Dowd, Matthew  
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**To:** QualityApplications\_Comments  
**Cc:** Walker, Helgi  
**Subject:** Comments on the Preparation of Patent Applications (Docket No. PTO-P-2011-0046)

Please find attached:

- Comments of the Coalition for Patent Fairness, in response to the Request for Comments on Preparation of Patent Applications, 78 Fed. Reg. 2960 (Jan. 15, 2013) (Docket No. PTO-P-2011-0046).

Please do not hesitate to contact us if you have any questions.

Best regards,  
Matthew Dowd

Matthew J. Dowd | Attorney At Law | **Wiley Rein LLP** | 1776 K Street NW | Washington, DC 20006  
(Tel) 202.719.7343 | (Fax) 202.719.7049 | [MDowd@wileyrein.com](mailto:MDowd@wileyrein.com)



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## I. INTRODUCTION

The Coalition for Patent Fairness (“Coalition”) is a diverse group of companies dedicated to enhancing U.S. innovation, job creation, and competitiveness in the global market by modernizing our nation’s patent system. Coalition member companies, which include Adobe, Cisco Systems, Dell, Google, Intel, Intuit, Oracle, RIM, SAP, Symantec, and Verizon, are active participants in the patent system and collectively own tens of thousands of patents and file thousands of patent applications each year. These highly innovative companies in the software, computer technology, and telecommunications industries believe that now, more than ever, it is important to have a patent system that ensures that all companies, both large and small, can devote all resources to productive, pro-growth innovation in the marketplace instead of burdensome, unjustified patent litigation that stifles such innovation.

These comments address the PTO’s January 15, 2013 request for comments relating to claim clarity in the preparation of patent applications.<sup>1</sup> Specifically, the PTO is “focusing on potential practices that applicants can employ at the drafting stage of a patent application in order to facilitate examination and bring more certainty to the scope of issued patents.”<sup>2</sup> The Coalition applauds the PTO’s insightful efforts to improve patent quality by focusing on the issue of claim clarity. As the PTO recognizes, the precision of claims in issued patents is of utmost importance. In general, the PTO should implement procedures that maximize precision of claim language without creating unnecessary procedures.

The PTO should adopt, as mandatory procedures, the proposals to require:

A.2: Identifying corresponding support in the specification for each claim limitation.

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<sup>1</sup> Request for Comments on Preparation of Patent Applications, 78 Fed. Reg. 2960 (Jan. 15, 2013) (“Request for Comments”).

<sup>2</sup> *Id.* at 2960.

B.1: Explaining ambiguous terms of degree, such as “about” and “essentially.”

The remaining proposals do not further the PTO’s goal of improving claim clarity and potentially impair the examiner’s ability to objectively determine patentability for the reasons set forth below.

**II. THE IMPORTANCE OF CLAIM CLARITY FOR IMPROVING THE U.S. PATENT SYSTEM**

The claims define the scope of the property right granted to the inventor.<sup>3</sup> The claims are the basis upon which a patent owner can sue a party for alleged infringement of a patent. Accordingly, “[c]laim construction is the single most important event in the course of a patent litigation.”<sup>4</sup> A patent is a property right, and the claims serve to define its limits.

Clarity in claim scope is of the utmost importance because the claims set forth “all to which [the patentee] is entitled” while, at the same time, “apprising the public of what is still open to them.”<sup>5</sup> Congress codified the requirement for clear property lines in 35 U.S.C. § 112: “The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the inventor or a joint inventor regards as the invention.”<sup>6</sup> The Supreme Court has also emphasized the necessity of clear, understandable claim scope. In *Evans v. Eaton*, the Court noted that one of the objectives of patent law was to “put the public in possession of what the applicant claims as the invention, so as to ascertain if the claimed

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<sup>3</sup> *Markman v. Westview Instruments, Inc.*, 517 U.S. 370, 373 (1996) (“The claim ‘define[s] the scope of a patent grant.’ (quotation omitted)); *Altoona Publix Theaters v. Am. Tri-Ergon Corp.*, 294 U.S. 477, 487 (1935) (“Under the statute, it is the claims of the patent which define the invention.”); *Computer Docking Station Corp. v. Dell, Inc.*, 519 F.3d 1366, 1374 (Fed. Cir. 2008) (“The words of the claims define the scope of the patented invention.”).

<sup>4</sup> *Retractable Techs., Inc. v. Becton, Dickinson & Co.*, 659 F.3d 1369, 1370 (Fed. Cir. 2011) (Moore, J., dissenting from the denial of the petition for rehearing en banc).

<sup>5</sup> *McClain v. Ortmyer*, 141 U.S. 419, 424 (1891).

<sup>6</sup> 35 U.S.C. § 112(b).

invention is in common use, or is already known, and to guard against prejudice or injury from the use of an invention which the party may otherwise innocently suppose not to be patented.”<sup>7</sup> More recently, the Court again emphasized that, with a patent, “like any property right, its boundaries should be clear.”<sup>8</sup> This is an essential part of the *quid pro quo* that underlies the policy of patent protection. In exchange for time-limited exclusionary rights, the applicant must inform the public of exactly what the patent covers. According to the Court,

This clarity is essential to promote progress because it enables investment in innovation. A patent holder should know what he owns, and the public should know what he does not.<sup>9</sup>

Both the patent applicant and the PTO bear the duty of ensuring that a patent issues with unambiguous claims.<sup>10</sup> The PTO is the gatekeeper, with the examiner critically reviewing the claims offered by the applicant. The patent applicant has the obligation of claiming only that which he or she “regards as the invention.”<sup>11</sup> When an applicant employs language which is ambiguous and fails to provide in the specification any basis for ascertaining clearly the meaning of those terms, the applicant has not satisfied his obligation.

Patents that issue with ambiguous or poorly drafted claims are a substantial problem.<sup>12</sup> Ambiguous claims: (1) cause unnecessary litigation; (2) deter innovation; and (3) delay the

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<sup>7</sup> 20 U.S. (7 Wheat.) 356, 434 (1822).

<sup>8</sup> *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 535 U.S. 722, 730 (2002).

<sup>9</sup> *Id.*

<sup>10</sup> See *United Carbon Co. v. Binney & Smith Co.*, 317 U.S. 228, 236 (1942) (“The statutory requirement of particularity and distinctness in claims is met only when the inventor clearly distinguishes what is claimed from what went before in the art and clearly circumscribes what is foreclosed from future enterprise.”).

<sup>11</sup> 35 U.S.C. § 112(f).

<sup>12</sup> See, e.g., Christa J. Laser, *A Definite Claim on Claim Indefiniteness: An Empirical Study of Definiteness Cases of the Past Decade with a Focus on the Federal Circuit and the Insolubly Ambiguous Standard*, 11 Chi. Kent J. Intell. Prop. 25 (2010).

prosecution of patent applications protecting commercially valuable inventions. These scenarios create costs borne by competitors or the public.<sup>13</sup> We address each of these scenarios in turn below.

When claims are ambiguous, an inordinate amount of time and money are spent litigating issues that could have—and should have—been addressed during prosecution. Vague and ambiguous claims permit patent holders to attempt to stretch those claims years later to capture successful products that truly bear no connection to what the inventor invented or disclosed. Frequently, courts will conduct claim construction, or *Markman*, hearings to take evidence as to the proper meaning of basic, scientific, or technical terms. Defendants accused of infringement often have to expend significant sums in hiring technical experts to present evidence to a court on the meaning of claim terms. The parties will likely engage in discovery, including depositions of the expert witnesses.

All of this activity—at a cost that almost always exceeds the cost of originally prosecuting the patent application—is directed to resolving disputes that could have been avoided in the first place if the patent applicant had provided more specificity as to the meaning of claim terms in the patent application. The Coalition recognizes that not all potential ambiguity can be addressed *ex ante* during patent prosecution. Nonetheless, simply because some possible claim construction disputes may be hard to predict is no reason to excuse the

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<sup>13</sup> *Enzo Biochem, Inc. v. Applera Corp.*, 605 F.3d 1347, 1348 n.2 (Fed. Cir. 2010) (Plager, J., dissenting from denial of rehearing) (noting that the patent prosecution literature encourages patent applicants to draft claims in a purposefully ambiguous manner to impose these costs on competitors); see also Stephen M. McJohn, *Patents: Hiding From History*, 24 Santa Clara Comp. & High Tech. L.J. 961, 971 (2008) (“[E]xperts in claim drafting offer the following advice to inventors and patent drafters: Do not define the terms used in your claims; do not identify the category of invention in the preamble to the claims; do not identify features of the invention as ‘important;’ and do not even use the word ‘invention’ in the written description. Such claim drafting has been described as a trend toward ‘intentional obscurity.’”).

patent applicant from as clearly and concisely as possible claiming the invention during prosecution of the patent application.

Second, ambiguous claims deter innovation—the engine that has sustained the U.S. economy for decades. Firms also review patents in litigation for the purpose of determining how to “design around,” *i.e.*, to design an unquestionably non-infringing alternative.<sup>14</sup> Vague claim language, coupled with aggressive patent owners that accuse all implementations of a given function, makes it difficult to devise and implement any alternatives. With indeterminable claim scope, innovators and competitors are unable to determine the areas of potential research free from intellectual property rights.<sup>15</sup> This “zone of uncertainty” directly undermines the public notice function of the patent system.

Third, imprecise claim drafting impedes the patent examination process and delays the process for inventors who are trying to protect valuable inventions. When claims are ambiguous, patent examiners face more difficulty; it becomes more time-consuming for the examiner to ascertain the closest prior art and to apply that art against the presented claims.

One valuable and underused statute is 35 U.S.C. § 112, and in particular subparagraphs (a) and (b). A patent applicant fails to satisfy his side of the *quid pro quo* of a patent grant, as set forth in that statutory provision, when he uses ambiguous claim terms or when the specification fails to provide sufficient guidance as to the scope of particular claim terms.<sup>16</sup> “A description of

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<sup>14</sup> *Vitronics Corp. v. Conceptoronic, Inc.*, 90 F.3d 1576, 1583 (Fed. Cir. 1996) (“[C]ompetitors are entitled to review the public record, apply the established rules of claim construction, ascertain the scope of the patentee’s claimed invention and, thus, design around the claimed invention.”).

<sup>15</sup> *See Universal Oil Prods. Co. v. Globe Oil & Refining Co.*, 322 U.S. 471, 484 (1944) (explaining that claim precision is “essential to warn the industry concerned of the precise scope of the monopoly asserted”).

<sup>16</sup> *See All Dental Prodx, LLC v. Advantage Dental Prods., Inc.*, 309 F.3d 774, 779 (Fed. Cir. 2002) (“The primary purpose of the definiteness requirement is to ensure that the claims are written in such a way that they give notice to the public of the extent of the legal protection

the claimed invention allows the [PTO] to examine applications effectively; courts to understand the invention, determine compliance with the statute, and to construe the claims; and the public to understand and improve upon the invention and to avoid the claimed boundaries of the patentee's exclusive rights.”<sup>17</sup>

To this end, the definiteness requirement of 35 U.S.C. § 112(b) should be strictly enforced. The Coalition applauds the PTO for taking steps in the right direction on this issue. In 2008, the PTO’s Deputy Commissioner for Patent Examination Policy, John Love, issued a memorandum titled “Indefiniteness rejections under 35 U.S.C. 112, second paragraph.”<sup>18</sup> In the memorandum, Commissioner Love instructed examiners that, “[i]f the language of a claim, considered as a whole in light of the specification and given its broadest reasonable interpretation, is such that a person of ordinary skill in the relevant art would read it with more than one reasonable interpretation then a rejection of the claim under 35 U.S.C. 112, second paragraph, is appropriate.”<sup>19</sup>

Additional progress occurred in the form of the Board’s opinion in *Ex parte Miyazaki*.<sup>20</sup> In that case, the Board of Patent Appeals and Interferences (now the Patent Trial and Appeal Board) held that, “if a claim is amenable to two or more plausible claim constructions, the USPTO is justified in requiring the applicant to more precisely define the metes and bounds of the claimed invention by holding the claims unpatentable under 35 U.S.C. § 112, second

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afforded by the patent, so that interested members of the public, e.g., competitors of the patent owner, can determine whether or not they infringe.”).

<sup>17</sup> *Ariad Pharm. Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1345 (Fed. Cir. 2010) (en banc).

<sup>18</sup> Memorandum from John Love, Deputy Commissioner for Patent Examination Policy, to Technology Center Directors and Patent Examining Corps (Sept. 2, 2008), *available at* <http://www.uspto.gov/web/patents/memoranda.htm>.

<sup>19</sup> *Id.*

<sup>20</sup> No. 2007-3300, 2008 WL 5105055 (Bd. Pat. App. & Inter. Nov. 19, 2008).

paragraph, as indefinite.” As is clear from *Miyazaki*, the Board’s analysis of the indefiniteness issue fully appreciated the problems caused by ambiguous claim terms.

The PTO’s efforts are laudable steps in attempting to improve the clarity of issued patent claims and the overall quality of U.S. patents. The Coalition applauds the PTO’s current request for comments on its proposed procedures to further advance these aims. As explained above, improving the clarity of claim scope will directly improve the quality of issued patents and would yield dividends for all those involved in, and potentially affected by, the U.S. patent system. And the patent applicant is generally in the best position to improve the quality of the patent the PTO eventually issues.<sup>21</sup> Accordingly, the PTO should implement procedures that will maximize the precision of claim language. Once these procedures are in place, the PTO should encourage examiners to strictly apply them and support the examiners in these rejections. When examiners understand that these types of rejections will be upheld on appeal, it will be possible for the corps to improve the quality of issued patents.

### **III. COMMENTS IN RESPONSE TO THE PTO’S SPECIFIC PROPOSALS**

The PTO has asked for “public comment on advantages and disadvantages of applicants employing the [certain] . . . practices” with respect to claim clarity. The Coalition appreciates the opportunity to provide its comments in response to the PTO’s important request.

The Coalition notes that, as a general matter, the Request for Comments describes the proposed practices as “potential practices” to which an applicant “can”—not must—adhere. Rather than suggested procedures, the PTO should require compliance with the proposed

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<sup>21</sup> *Halliburton Energy Servs., Inc. v. M-I LLC*, 514 F.3d 1244, 1255 (Fed Cir. 2008) (“We note that the patent drafter is in the best position to resolve the ambiguity in the patent claims, and it is highly desirable that patent examiners demand that applicants do so in appropriate circumstances so that the patent can be amended during prosecution rather than attempting to resolve the ambiguity in litigation.”).

changes that will improve claim clarity. Absent mandatory compliance with important procedures, many patent applicants will choose to ignore them, believing that complying with the procedures adds expense. That shifts expenses to the courts and defendants during patent litigation, when the courts and targets of patent infringement suits attempt to determine the correct scope of the claims. As the recipient of the patent grant, the applicant is the best-situated party to bear these costs. With that background and introduction, the Coalition presents below its specific comments in response to the individual proposals presented by the PTO.

**A. Proposal A.1: Presenting Claims In A Multi-Part Format By Way Of A Standardized Template**

The PTO seeks comment on the following procedure:

*Presenting claims in a multi-part format by way of a standardized template that places each claim component in separate, clearly marked, and designated fields. For instance, a template may facilitate drafting and review of claims by separately delineating each claim component into separate fields for the preamble, transitional phrase, and each particular claim limitation.*

The Coalition is neutral regarding this proposal and suggests further study and more information to determine if this will improve claim clarity or otherwise aid in examination.

Presenting claims in a multi-part format may benefit patent applicants, the PTO, and the public. Having the applicant identify the various components of the claim, such as the preamble, transitional phrase, and claim limitations, in a uniform way should aid the examiner during prosecution. For particularly complex claims, the examiner is first faced with the task of determining the individual elements of the claim. A template may assist the examiner in distinguishing the preamble of the claim from the remainder of the claim. As discussed in more detail below, a claim's preamble is an oft-litigated source of ambiguity in claim scope. By presenting claims in a standardized multi-part format through the use of a standardized template,

the examiners will more readily be able to identify which portions of the claim constitute the preamble. From there, the examiners can then assess whether the preamble limits the claim.

While the proposal may have benefits, the PTO must proceed cautiously in its application. In particular, an examiner may rely too heavily on the applicant's identification of the various claim components, including the individual claim limitations. Regardless of the particular format or presentation of the claims, the PTO must independently examine the claims. The examiner must also communicate in the record any disagreement with applicant's template designations.

Additionally, the uniform presentation of claims may not always be possible. Optimal templates may differ depending on the particular technology area and the particular art unit. In fact, the PTO may determine that, for certain technologies, no template is necessary for the efficient examination of the claims.

Accordingly, the Coalition respectfully suggests that the PTO work with the patent community to develop templates and to determine if those proposed templates will help to meet the PTO's goals. Furthermore, any templates the PTO is considering for possible implementation should be published so that members of the patent community can provide additional feedback.

**B. Proposal A.2: Identifying Corresponding Support In The Specification For Each Claim Limitation**

The PTO seeks comment on the following procedure:

*Identifying corresponding support in the specification for each of the claim limitations utilizing, for example, a claim chart or the standardized template described above. This practice could be particularly beneficial where claims are amended or where a continuing application (continuation, divisional, continuation-in-part) is filed.*

The advantages of this proposal *strongly* outweigh any potential disadvantages. Requiring applicants to identify corresponding support in the specification for each claim limitation will assist examiners in more efficiently considering whether an application satisfies the requirements of § 112. It will also help examiners identify the boundaries of the claim and create a clearer record on claim scope.

One major problem with unclear claim scope is the difficulty in determining which written description support, if any, in the specification further defines potentially ambiguous claim terms. By requiring the patent applicant to identify specific support in the specification for each claim limitation, even those limitations that are not potentially ambiguous, the examiner, the applicant, and the public will be better able to determine the scope of the claims. The applicant should identify specification support for any amended claim in an original application, and for all claims that claim priority to a continuation, divisional, continuation-in-part, provisional application, or other priority document.

A serious problem in patent litigation occurs when a patentee tries to distort the meaning of claim terms by relying on purported disclosure in the specification that does not support the claim element. This problem frequently occurs when patent owners assert patents obtained through continuations against technologies that were developed many years after the filing date of the original application for the first parent patent. Fuzzy claim scope allows patent owners to argue that claims cover products and services that were never contemplated by the inventors as being a part of their invention. When this happens, a patent claim becomes “a nose of wax, which may be turned and twisted in any direction, by merely referring to the specification, so as

to make it include something more than, or something different from, what its words express.”<sup>22</sup>  
And the claims fail to serve their intended public-notice purpose.<sup>23</sup>

This proposal will allow the public to more accurately determine the enforceable scope of issued patents. The Federal Circuit has repeatedly emphasized that the specification is often the best evidentiary source for understanding claim terms.<sup>24</sup> By identifying which portions of the specification provide written description support for particular claim elements, the patent applicant will further elucidate the proper claim scope and thus minimize the potential ambiguity in claim scope.

The proposed practice would be particularly beneficial where claims are amended or where a continuing application (continuation, divisional, continuation-in-part) is filed. When claims are amended during prosecution or when different claims are presented in subsequent applications, such as continuations, divisionals, and continuation-in-parts, the examiner must always reassess whether the new or amended claims satisfy the written description requirement of 35 U.S.C. § 112(a).<sup>25</sup> Recognizing these benefits, the Coalition strongly supports extending this rule to require a patent applicant to show support in any *provisional* application or other priority document for the claimed subject matter. Indeed, an application claiming the benefit of a provisional application must show support in the original filing for all limitations in the

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<sup>22</sup> *White v. Dunbar*, 119 U.S. 47, 51 (1886).

<sup>23</sup> *Id.* at 52 (“The claim is a statutory requirement, prescribed for the very purpose of making the patentee define precisely what his invention is, and it is unjust to the public, as well as an evasion of the law, to construe it in a manner different from the plain import of its terms.”).

<sup>24</sup> *Kinik Co. v. Int’l Trade Comm’n*, 362 F.3d 1359, 1365 (Fed. Cir. 2004) (“The words of patent claims have the meaning and scope with which they are used in the specification and the prosecution history.”); *Moba, B.V. v. Diamond Automation, Inc.*, 325 F.3d 1306, 1315 (Fed. Cir. 2003) (“[T]he best indicator of claim meaning is its usage in context as understood by one of skill in the art at the time of invention.”).

<sup>25</sup> *See, e.g., Purdue Pharma L.P. v. Faulding Inc.*, 230 F.3d 1320 (Fed. Cir. 2000).

subsequent nonprovisional application. In litigation, the question of whether a provisional application supports the claimed subject matter is a question of fact that can consume considerable resources. The PTO is in the best position to analyze the applicant's assertion of priority and apply all of the available prior art.

Additionally, under this proposal, a patent applicant must not be permitted to offer generic, non-responsive answers when identifying the support in the specification. A non-responsive submission, for example, would be when an applicant would respond, "Look to the entire specification." Such a generic answer offers no useful information to assist the PTO and the public in interpreting the scope of the claim and resolving potential ambiguity in claim scope. If an applicant does not provide more specific detail, then the examiner should inform the applicant of this failure and provide the applicant an opportunity to cure the failure. In the case of a claims treated under § 112(f), the applicant must expressly link the structure in the specification.

Of course, there will be times when an examiner contends that the applicant has not complied with the requirement of the above proposal, but the applicant disagrees. If the applicant disagrees with the examiner's position, the applicant should be permitted to challenge the examiner's decision through a petition to the Director, rather than an appeal to the Patent Trial and Appeal Board.

The above proposed procedure could be implemented without significant additional cost to the patent prosecution process. Current MPEP guidelines suggest that applicants identify support for claim amendments when responding to office actions.<sup>26</sup>

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<sup>26</sup> MPEP § 714.02 and § 2163.06 ("Applicant should . . . specifically point out the support for any amendments made to the disclosure."); *id.* § 2163.04 ("If applicant amends the claims and points out where and/or how the originally filed disclosure supports the amendment(s), and the

**C. Proposal A.3: Indicating Whether Examples Are Limiting Or Illustrative**

The PTO seeks comment on the following procedure:

*Indicating whether examples in the specification are intended to be limiting or merely illustrative.*

This proposal will not help to improve claim clarity or the patent application process, and thus it should not be implemented. Almost every patent application already has boilerplate language indicating that the examples are non-limiting.<sup>27</sup> Thus, applicants will simply state that all examples are illustrative and this will have no effect on claim clarity and will do nothing to aid in examination.

**D. Proposal A.4: Identifying Whether The Preamble Is Limiting**

The PTO seeks comment on the following procedure:

*Identifying whether the claim preamble is intended to be a limitation on claim scope.*

To the extent that having the applicant identify corresponding structure ever became a substitute for careful, independent review by an examiner, this proposal will not improve claim clarity or the examination process. Whether a preamble is limiting is a question of law and the applicant's intent is irrelevant to this determination. Accordingly, the PTO should not implement this proposal as drafted.

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examiner finds that the disclosure does not reasonably convey that the inventor had possession of the subject matter of the amendment at the time of the filing of the application, the examiner has the initial burden of presenting evidence or reasoning to explain why persons skilled in the art would not recognize in the disclosure a description of the invention defined by the claims.”).

<sup>27</sup> See, e.g., *Arlington Indus. Inc. v. Bridgeport Fittings, Inc.*, 632 F.3d 1246, 1257 (Fed. Cir. 2011) (Lourie, concurring in part and dissenting in part) (noting that “in frequent boilerplate,” a patent applicant “indicate[s] that the invention isn’t to be limited to what is expressly disclosed (as if they were unable to describe anything else they actually invented)”).

The proper inquiry is not what the inventor intended but how the claim is properly construed.<sup>28</sup> Indeed, “a claim preamble has the import that the claim as a whole suggests for it.”<sup>29</sup> The applicant’s intent cannot overcome well-settled canons of claim construction. For example, “preamble language that merely states the purpose or intended use of an invention is generally not treated as limiting the scope of the claim.”<sup>30</sup> All canons of claim construction focus on the text of the claim when read in the context of the patent application as a whole. Thus, merely asking what an applicant intended with a particular preamble does not conform to proper claim construction principles.

Should the PTO choose to adopt this proposal, the PTO must make clear that the examiner must not defer to the applicant’s identification of whether the preamble limits the claimed invention. The examiner must independently construe the claim and determine whether one of ordinary skill in the art would read the preamble as limiting or not. Any statements from the applicant about whether the preamble is limiting must be considered in light of all the evidence about the scope of the claims.

Importantly, even if the applicant does state that the preamble is limiting, the examiner’s search and examination should not be so limited. Relevant prior art is more likely to be identified when the claim is read broadly. This conforms to the PTO’s broadest reasonable interpretation rule applied during prosecution.<sup>31</sup>

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<sup>28</sup> *Phillips v. AWH Corp.*, 415 F.3d 1303, 1313 (Fed. Cir. 2005) (en banc) (“The inquiry into how a person of ordinary skill in the art understands a claim term provides an objective baseline from which to begin claim interpretation.”).

<sup>29</sup> *Bell Commc’ns Research, Inc. v. Vitalink Commc’ns Corp.*, 55 F.3d 615, 620 (Fed. Cir. 1995).

<sup>30</sup> *Bicon, Inc. v. Straumann Co.*, 441 F.3d 945, 952 (Fed. Cir. 2006).

<sup>31</sup> See *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004) (applying the broadest reasonable claim construction “in light of the specification as it would be interpreted by one of ordinary skill in the art”); *In re Morris*, 127 F.3d 1048, 1054-55 (Fed. Cir. 1997); *In re*

If the PTO adopts this proposal, when the applicant changes the designation of a preamble from non-limiting to limiting, this change should be considered as an amendment that surrenders claim scope in a way that an amendment to a claim limitation surrenders claim scope. The scope of a claim with a non-limiting preamble is generally broader than an analogous claim in which the preamble is limiting. Thus, when an applicant states to the PTO that he is changing his interpretation of the preamble, he is putting the public on notice that scope of the claims is narrower than as originally presented. Accordingly, prosecution history estoppel should apply to the narrowed claim.<sup>32</sup>

**E. Proposal A.5: Identifying § 112(f) Limitations**

The PTO seeks comment on the following procedure:

*Expressly identifying clauses within particular claim limitations for which the inventor intends to invoke 35 U.S.C. 112(f) and pointing out where in the specification corresponding structures, materials, or acts are disclosed that are linked to the identified 35 U.S.C. 112(f) claim limitations.*

To the extent that having the applicant identify corresponding structure ever became a substitute for careful, independent review by an examiner, this proposal would not improve claim clarity. Rather, it could mislead examiners to rely on the applicant's intent rather than the legal question of claim scope. The PTO should not implement that proposed procedure as drafted.

The "intent" of the inventor is not the proper focus on the inquiry of whether a claim is to be construed according to 35 U.S.C. § 112(f). Although intent may be exhibited in the intrinsic record of the application, the question of claim construction asks not what the inventor's

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*Zletz*, 893 F.2d 319, 321 (Fed. Cir. 1989) ("During patent examination the pending claims must be interpreted as broadly as their terms reasonably allow.").

<sup>32</sup> See *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 535 U.S. 722, 733-34 (2002).

intentions were, but what the patent application and the prosecution history provides, by way of documentary evidence, for determining how one of ordinary skill in the art would understand the claim scope.

The procedures governing the examination of means-plus-functions claims offer a fertile ground for improving the examination process. One particularly difficult area of examination is determining when the presumption against means-plus-function claiming is overcome. Examiners would benefit from training on this subject. In particular, examiners should consider this on an element-by-element basis. Bare-bones structure in a preamble is not enough to avoid § 112(f) for the remainder of the claim. If a discrete claim limitation is functional, then that term should be limited to the structures described in the specification and equivalents. Once an examiner has determined that a claim term is functional, the examiner should more closely scrutinize § 112(f) claims and should ensure that all the corresponding structures in the specification are identified expressly and clearly in the written record. Rather than simply assume that sufficient structure is disclosed in the patent application, the examiner must carefully examine the application and indicate to the applicant the identifiable structures associated with the functions recited in the claims.

If the PTO chooses to adopt this proposal, it is crucial that the examiner independently analyze applicant responses and not simply defer to the applicant's designation. The PTO must carefully consider whether the proposed procedure will create unintended incentives for examiners to overly rely on the applicant's assertions of which claims fall under § 112(f). Although the applicant's intent is irrelevant, once an examiner has determined that a limitation is functional, the examiner must state that clearly in the record. In response, the applicant must

expressly identify all corresponding structure in the specification. On balance, this proposal may be more harmful than helpful and will not improve claim clarity in any way.

**F. Proposal A.6: Using Textual And Graphical Notation Systems**

The PTO seeks comment on the following procedure:

*Using textual and graphical notation systems known in the art to disclose algorithms in support of computer-implemented claim limitations, such as C-like pseudo-code or XML-like schemas for textual notation and Unified Modeling Language (UML) for graphical notation.*

To the extent necessary to comply with the requirements of § 112, the PTO should be firm in requiring applicants to provide algorithms in the specification. The disclosure should be sufficient to unambiguously specify the algorithm used, including all relevant inputs and termination conditions. As a practical measure, the patent should have at least as much detail as is used for professional papers in the applicable art.

Claims that do little more than recite functions without any disclosure of how to implement the claimed functions merely patent the problem, not the solution that can be implemented. These patents generally fail to advance the constitutional objective of promoting progress in any technical area and certainly do not put the public on notice of what, if anything, has been invented.

While flowcharts are sufficient in some instances, those that simply parrot the claim language with nothing more do not provide sufficient support for patent claims related to software and some computer-based inventions. Such flowcharts combined with the supporting written description should provide specificity as to the algorithms that can be used in claimed software programs and methods. The algorithm must, at a minimum, provide a roadmap for a software developer to either build the claimed system, or to design around it. If this is impossible, then the claim is not clear enough to put the public on notice of the claim scope.

The current levels of detail deemed acceptable by the PTO are not sufficient. In many cases, the patent contains no specific details about the algorithm used to implement the claimed software or computer-based methods. In other cases, the specification discloses only flowcharts that parrot claim language. These bare-bones descriptions are not sufficient to set forth a software invention with the necessary level of claim precision.

The Coalition understands that the proper disclosure standard for computer-implemented claim limitations may be an evolving issue. It is an issue that has not been adequately policed. As the PTO implements new procedures for improving patent quality and clarifying the scope of issued claims, the PTO should encourage examiners to thoroughly examine claims to ensure compliance with the § 112 requirements.

**G. Proposal B.1: Explaining The Scope of Terms of Degree**

The PTO seeks comment on the following procedure:

*Indicating whether terms of degree—such as substantially, approximately, about, essentially—have a lay or technical meaning and explaining the scope of such terms.*

The Coalition supports this proposal. Terms of degree inject an unacceptable zone of uncertainty into claims. In the vast majority of cases, there is no accepted definition of what these relative adverbs mean, and they simply allow applicants to avoid clearly defining the bounds of their claim. Accordingly, the PTO should implement this proposed procedure.

First, the terms recited in the proposal—“substantially, approximately, about, essentially”—along with other similar terms, are not useful in the claim construction process. Rarely do such terms of degree have any inherently meaningful definition that aids one in understanding the scope of the claim. For instance, there is no agreement in any technical area on the meaning of “about.” Nor do dictionaries provide clear guidance on these terms of degree.

Without specific guidance from the inventors during prosecution, more often than not, there is simply no ability to readily ascertain the scope of claims using terms of degree.

Without a fairly strict *ex ante* rule regarding the meaning of such terms the applicant abdicates his responsibility to provide clear notice of the scope of the patent grant. And that leaves the interpretation of the claim scope to a later date, often many years in the future. Depending on the context, terms of degree, such as the ones cited in the proposal, can be entirely subjective and their meaning may depend on the eye of the beholder. The scope cannot be determined until parties expend millions of dollars through litigation. The public has little idea of what the claim really covers until experts testify in court and a judge issues a claim construction opinion.

Importantly, the patent applicant can easily obviate the future confusion by explaining, in the patent application, what is meant by “about” or other terms of degree. If an applicant chooses to use a term of degree, the applicant should be required to provide an objectively understandable explanation of the actual scope of such terms. The applicant is best-positioned to clarify the scope of inherently ambiguous terms of degree. When an applicant avoids providing the constraints on fuzzy claim terms, such as “about” and “essentially,” the applicant is avoiding the responsibility to put the public on notice of the scope of the invention. Accordingly, if the applicant cannot provide a reasonably certain definition of any terms of degree, the claim should be rejected under § 112 as being indefinite.

**H. Proposal B.2: Including A Glossary Of Potentially Ambiguous, Distinctive, and Specialized Terms**

The PTO seeks comment on the following procedure:

*Including in the specification a glossary of potentially ambiguous, distinctive, and specialized terms used in the specification and/or claims, particularly for inventions related to certain technologies, such as software.*

This proposal could benefit the examination process, but the PTO should not create a strict requirement of a glossary. The applicant has a duty to adequately disclose the claimed invention in the specification and may choose to include a glossary. But the focus of examination should be on enforcing the requirements of § 112. While a glossary may be useful in some instances, it should not amount to a *de facto* satisfaction of § 112. As with the other proposals, the examiner must construe the claims by considering all the evidence in the specification and prosecution history—not solely information provided in response to one of the proposed procedures, in this instance a glossary provided by the applicant. To the extent that the examiner identifies terms in claims the examiner believes are ambiguous, distinctive, specialized, and otherwise not defined in the specification, the examiner should request that the applicant clarify the claim scope or face an indefiniteness rejection.

If the PTO chooses to adopt this proposal, the primary focus should be on ensuring that the application complies with 35 U.S.C. § 112 (enablement, written description, definiteness). Even with an inventor-drafted glossary, the offered definitions may not completely describe the scope of the drafted claims.<sup>33</sup> Additionally, even with such a glossary, the claims may fail to meet the § 112 requirements. For example, an inventor’s glossary, although well-intended, may itself be so ambiguous as to fail the definiteness requirement of § 112(b). If this occurs, then the examiner should continue to reject the claims for being indefinite. The PTO should remind examiners to independently assess the claims to confirm that the specification adequately supports and defines the terms used in the claims.

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<sup>33</sup> *E-Pass Techs., Inc. v. 3Com Corp.*, 343 F.3d 1364, 1369 (Fed. Cir. 2003) (“Interpretation of descriptive statements in a patent’s written description is a difficult task, as an inherent tension exists as to whether a statement is a clear lexicographic definition or a description of a preferred embodiment.”); *Toro Co. v. White Consol. Indus. Inc.*, 199 F.3d 1295, 1301 (Fed. Cir. 1999) (meaning of words used in a claim is not construed in a “lexicographic vacuum, but in the context of the specification and drawings”).

## I. Proposal B.3: Designating A Default Dictionary

The PTO seeks comment on the following procedure:

*Designating, at the time of filing the application, a default dictionary or dictionaries (e.g., a technical dictionary and a non-technical dictionary) to be used in ascertaining the meaning of the claim terms.*

This proposal likely presents too many difficulties to be implemented in a manner that would meaningfully improve patent quality or the patent examination process. Dictionaries, by definition, can aid in ascertaining the meaning of many claim terms. Indeed, as the full Federal Circuit explained, “general purpose dictionaries may be helpful” in construing claim terms under certain circumstances.<sup>34</sup>

The proposed procedure has substantial detriments that counsel against implementation of the proposal. The en banc Federal Circuit determined that certain of its prior cases had “placed too much reliance on extrinsic sources such as dictionaries, treatises, and encyclopedias and too little on intrinsic sources, in particular the specification and prosecution history.”<sup>35</sup> As the court elaborated, “[t]he main problem with elevating the dictionary to such prominence is that it focuses the inquiry on the abstract meaning of words rather than on the meaning of claim terms within the context of the patent.”<sup>36</sup>

Additional potential problems exist with the proposal. Reviewing and identifying dictionaries will add cost to the preparation and prosecution of patent applications. The proposed procedure also raises the question of how many dictionaries an applicant will be permitted to designate and whether an applicant will be permitted to designate one dictionary for

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<sup>34</sup> *Phillips*, 415 F.3d at 1314; *accord Teleflex, Inc. v. Ficosa N. Am. Corp.*, 299 F.3d 1313, 1325 (Fed. Cir. 2002).

<sup>35</sup> *Phillips*, 415 F.3d at 1320.

<sup>36</sup> *Id.*

certain claims and another dictionary for other claims. Even if a single dictionary is identified by the patent applicant, the dictionary is likely to have multiple definitions for a single term. Thus, without any requirement to connect particular dictionary definitions to particular claim terms, it is likely that the disadvantages of this proposal will outweigh the potential benefits.

#### **IV. CONCLUSION**

The Coalition applauds the PTO's efforts to consider specific proposals with the goal of improving patent quality. We believe that many of the proposals, if implemented, will advance the important goal of claim clarity in the patent prosecution process. The Coalition appreciates the opportunity to provide comments and suggestions, and the Coalition looks forward to seeing the PTO implement those procedures.