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March 13, 2013

Attention: Ms. Nicole D. Haines

Re: Request for Comments on Preparation of Patent Applications
78 Fed. Reg. 2960-2961 (Jan. 15, 2013)

Dear Ms. Haines,

Ditthavong Mori & Steiner, P.C. is a full-service law firm offering our clients a full array of intellectual property services. Our talented team includes five former Administrative Patent Judges, and until just recently a former Commissioner for Patents. We have expertise in essentially every technology, for example, electronics, telecommunications, computer systems and software, biotechnology, medical devices, chemical engineering applications, petroleum refining, materials science, semiconductor fabrication, and recording media.

We commend the USPTO on its continuing efforts to improve the quality of issued patents and the efficiency of the examination process, particularly in view of the economic climate of late. However, many of the proposed practices to clarify the scope of the claims raise concerns with regard to increasing applicant's burden, particularly for applicants filing applications under 35 U.S.C. § 371 ("371 application"). Furthermore, we have concerns as to whether or not the proposed practices to clarify the meaning of claim terms in the specification would result in an improvement in the quality of issued patents. These issues are specifically addressed in turn below.

A. Clarifying the Scope of the Claims

Specifically, we have concerns regarding the practice of identifying corresponding support in the specification for each of the claim limitations. Although such practice is commonly found in the appeals process, it is done so at a late stage in prosecution where the claims are more solidified. Such a practice, at the outset, would require a significant burden to the applicant, as each claim may refer to any combination of embodiments described in the specification and that the identification of support will need to be continually updated during prosecution as the claims are amended. For example, amendments may necessitate a further selection and identification of new combinations of embodiments described in the specification. Another concern relates to the fact that a claim can cover numerous embodiments. For example, independent claims would need to identify every embodiment described in the specification to avoid unnecessarily limiting claim scope.

Furthermore, the citations may become rather lengthy as applicants would view an omission of an embodiment as conceding the breadth of the claim scope. An overly lengthy citation would essentially undermine the purpose identifying the corresponding support in the first place.

B. Clarifying the Meaning of Claim Terms in the Specification

As noted above, we have concerns as to whether or not the proposed practices to clarify the meaning of claim terms in the specification would result in an improvement in the quality of issued patents.

With regard to the practice of indicating whether terms of degree have a lay or technical meaning, many applicants would simply avoid use of such terms in the claim if required to specify a scope for such terms. As such, parameters flexible to varying embodiments, conditions, and technology would no longer be indicated by terms of degree. Therefore, many parameters critical to the invention would be difficult to distinguish from more flexible parameters.

Similarly, the proposed practice of including a glossary of potentially ambiguous, distinctive, and specialized terms may merely result in applications including long listings of broad definitions. For

example, applicants may include long comprehensive listings of terms to avoid a resolution of the proposed threshold question of whether a term is potentially ambiguous, distinctive, or specialized. Additionally, applicants attempting to avoid an unintended narrow definition of such terms may include broad definitions that are out of context of the invention. As such, the proposed practice may simply result in applications including long listings of broad definitions that merely obscure an intended meaning of claim terms.

Likewise, the proposed practice of designating a default dictionary or dictionaries would simply result in applications including long lists of dictionaries to avoid limiting the scope of claim terms.

Based on the foregoing, we are concerned that the proposed practices would merely promote an increase the use of boilerplate language in applications. Such boilerplate language is not in the context of the invention and thus may only obscure the invention and intended meanings of terms. Therefore, such practices would not be effective for clarifying the meaning of claim terms.

Conclusion

As the proposed practice of identifying corresponding support in the specification for each of the claim limitations would give rise to an excessive burden to many applicants, the USPTO should avoid requiring the proposed practice. Further, with regard to the proposed practices to clarify the meaning of claim terms, the USPTO should avoid promoting the use of out of context definitions and instead encourage claim terms to be interpreted in light of embodiments described in the specification.

Respectfully Submitted,
DITTHAVONG MORI & STEINER, P.C.

March 13, 2013
Date

Edward Wise
And
Bryan G. Dobbs