

March 15, 2013

Writer's Direct Contact
415.268.7455
MJacobs@mofo.com

The Honorable Teresa Stanek Rea
Acting Under Secretary of Commerce for Intellectual Property and
Acting Director of the United States Patent and Trademark Office
Mail Stop Comments – Patents
P.O. Box 1450
Alexandria, VA 22313-1450
Attention: Nicole D. Haines, Legal Advisor

Via email

Re: Comments on Preparation of Patent Applications 78 Fed. Reg. 2960 (January 15, 2013)

Dear Ms. Rea:

We write in response to the Request for Comments on Preparation of Patent Applications published at 78 Fed. Reg. 2960 on January 15, 2013. We appreciate the opportunity to comment.

The perspective we offer below is based on our combined experience as intellectual property litigators representing patentees and accused infringers in federal courts throughout the United States, the International Trade Commission, and private arbitral fora. Our comments may not reflect the views of our colleagues or clients.

We applaud the efforts of the Patent and Trademark Office to clarify the scope and meaning of patent claims. Many of the proposals in the Request appear to be common sense, “low hanging fruit” opportunities to promote consistency of interpretation and reduce the expense of patent litigation while not unduly burdening applicants or examiners.

Hon. T. Rea
March 15, 2013
Page Two

Identifying whether the claim preamble is intended to be a limitation on claim scope and presenting claims in a multi-part format to identify the preamble, transitional phrase, and claim limitations.

We support these proposals. A simple check box filled at the time of application could sidestep one of the more imponderable questions of claim construction. This proposal has the additional merit of not upsetting the expectations of owners of existing patents. Distinguishing the preamble, transitional phrase, and the body is also helpful because it would remove any doubt about the language to which the check box choice would apply.

The question of whether the preamble is limiting can in some instances be case dispositive. Yet, in our experience, claims are not interpreted until fairly late in litigation. Some jurisdictions do not construe terms until dispositive motions are filed. Furthermore, we observe courts limiting (sometimes quite strictly) the number of claim terms that will be construed. It would be of considerable benefit to the parties to know from the start whether the preamble is a limitation.

Currently there is no “litmus test” to determine whether a preamble is limiting. *Catalina Mkt’g Int’l, Inc. v. Coolsavings.com, Inc.*, 289 F.3d 801, 808 (Fed. Cir. 2002). As a general rule preambles are not limiting, but may be limiting if they give “life, meaning and vitality” to the claim or define the “essence of the invention.” *Id.*; *Griffin v. Bertina*, 285 F.3d 1029, 1033 (Fed. Cir. 2002). A preamble that provides an antecedent basis for subsequent limitations may be limiting. *Catalina*, 289 F.3d at 808. But a preamble merely “extolling the benefits or features” of the invention is not. *Id.* at 809. Neither is a preamble that defines the context in which the invention operates. *Boehringer Ingelheim Vetmedica, Inc. v. Schering-Plough Corp.*, 320 F.3d 1339, 1345 (Fed. Cir 2003).

As many commentators have noted, these rules can be difficult to apply. In *Marrin v. Griffin*, for instance, a divided Federal Circuit panel affirmed a district court’s judgment of invalidity after finding that the preamble “scratch-off label for permitting a user to write thereon without the use of a marking implement” was a non-limiting statement of purpose. 599 F.3d 1290, 1295 (Fed. Cir. 2010). The dissent criticized the majority for “delete[ing] material limitations in the claim because they appear in the preamble” and then “constru[ing] the claims contrary to the deleted limitations so as to broaden the claims into invalidity.” *Id.* at 1296. In another recent case, the Federal Circuit reversed the Board of Patent Appeals and Interferences’ finding that “for verifying the accuracy of logical-to-physical mapping software” was a non-limiting “statement of intended purpose.” *In re Jasinski*, 2013 U.S. App. LEXIS 3219 (Fed. Cir., Feb. 15, 2013). The Federal Circuit agreed with the patent applicant that the preamble was “the essence of the invention.”

Hon. T. Rea
March 15, 2013
Page Three

Marrin and *In re Jasinski* have in common that the patentees were championing narrower constructions of their patents by treating their preambles as limitations. It is hard to see why a patentee who wishes to narrow his or her claim should not be allowed to do so (at least during prosecution). Oddly, if the examiner in *In re Jasinski* had accepted the applicant's argument that the preamble was limiting, that would have made it so. Clear reliance on a preamble during prosecution can distinguish a claimed invention from the prior art and render the preamble a claim limitation. *Catalina*, 289 F.3d at 808-809.

One thread in the Federal Circuit's preamble cases appears to be that the patentee's intent controls when that intent is made plain in prosecution. Thus, in *Marrin* the majority indicated that it would have found the preamble to be limiting if the patentees had relied on it in prosecution. 599 F.3d at 1294. The majority found, to the contrary, that the patentees "did not consider the writing use for their claimed invention as being patentably significant." *Id.* Similarly, preambles of claims written in Jepson form are generally considered to be limiting because the patentee's "choice" of the Jepson form "evidences the [patentee's] intention 'to use the preamble to define, in part, the structural elements of his claimed invention.'" *Epcon Gas Sys', Inc. v. Bauer Compressors, Inc.*, 279 F.3d 1022, 1029 (Fed. Cir. 2002).

Providing a check box would allow an applicant to show clearly whether he or she considers the preamble to be "patentably significant." Doing so is more equitable and logical than relying on the examiner's rejections to force the patentee (sometimes) to make a clear choice.

Should the patent office require applicants to state their intent to treat the preamble as patentably significant, then it makes a great deal of sense to ask the applicant also to visually distinguish the preamble from the transitional phrase and the remaining body of the claim. That would help the public understand which claim language is and is not considered to be limiting.

We perceive few disadvantages. There are only two scenarios to consider. First, the applicant could designate the preamble as limiting. If the applicant's choice is consistent with existing law then the claims are clearer but not changed. Furthermore, expressly assigning "patentable significance" to a preamble would make it a limitation under the rules applied in *Marrin* and other cases. In case of doubt, the examiner could require the applicant to amend his or her claim to restate the preamble limitations in the body of the claim. If the preamble limitations are already part of the claim, it is hard to see why it would harm the applicant to add them again.

In the other scenario, the applicant does not designate the preamble as limiting. Here again, if the choice is consistent with existing law then the claims are made clearer but not changed.

Hon. T. Rea
March 15, 2013
Page Four

If the choice is contrary to law as the examiner understands it, then the examiner can request that the applicant delete the potentially limiting preamble language to remove any doubt. Would it harm the applicant to delete non-limiting claim language? We do not see why it would. Of course, if there is prior art that is overcome only by the preamble, then the claim can be rejected on that basis.

Identifying corresponding support in the specification for each of the claim limitations utilizing, for example, a claim chart, particularly when a continuing application is filed.

Litigating the priority date of claims of continuation-in-part patents is a logistical challenge. The issue turns in part on whether the parent application contained an adequate written description. That is a question of fact. *Ariad Pharm., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1351 (Fed. Cir. 2010). It is therefore often necessary to present the amendment history to the trier of fact by preparing “redline” documents showing the changes. Redlines prepared for litigation are not self-authenticating, however, and they may require the testimony of a sponsoring witness to be presented as evidence in court.

Requiring applicants to prepare a chart or other document specifically identifying the alleged support in parent applications would ameliorate this problem. Such a document would provide a common point of reference for the parties and their experts to use in presenting their arguments to the trier of fact. In the case of a continuation-in-part having multiple parent applications, moreover, such a chart may help clarify which of several priority dates are alleged to apply to each claim.

The chart would not need to be exhaustive to be useful. If the applicant can show adequate support for each claim then it is irrelevant that there may be more support elsewhere in the priority specification. To the contrary, requiring identification of all possible support in the priority application(s) may make the exercise less useful. Applicants may fear that their claims will be read in light of only those portions of the specification specifically identified as corresponding support rather than the specification as a whole. That may lead applicants to chart unnecessarily broad swaths of disclosure, thus somewhat diminishing the clarity achieved through the exercise.

Expressly identifying 35 U.S.C. 112(f) clauses and corresponding disclosure.

Applicants can create a strong presumption that section 112(f) applies by using “means for” claim language. It is unlikely that any skilled claim drafter would choose “means for” language if he or she did not intend to invoke the section 112(f). Moreover, as Professor Dennis Crouch has documented, means-plus-function claiming has been in long-term

Hon. T. Rea
March 15, 2013
Page Five

decline, recently approaching 5% of non-provisional patent applications.¹ Applicants are obviously quite cognizant of the impact of choosing means-plus-function claim language. There is no additional burden placed upon them, therefore, by requiring that they state expressly that they intend to invoke section 112(f).

Requiring applicants simultaneously to identify the disclosure corresponding to the section 112(f) claim would assist the public in understanding the patent and reduce litigation costs. The corresponding disclosure defines the scope of a section 112(f) claim. As such, that disclosure should be clearly defined at the same time all other claims are defined – during prosecution, not after litigation arises. In our experience, litigating what specific part of the disclosure corresponds to the claims can be particularly burdensome. The analysis is highly fact dependent and uncertain. In many circumstances the identification of corresponding disclosure can be case dispositive, and is therefore hotly contested.

What happens if an applicant does not expressly invoke section 112(f) but nevertheless writes his or her claim in functional language? We believe that this proposal need not address that knotty problem. Focusing again on the “low hanging fruit,” we believe that it is worth putting in place procedures to clarify the relatively small percentage of patent claims that intentionally invoke section 112(f). Other functional claims may continue to be interpreted under existing law, imperfect as it may be.

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

In our view, this proposal is less likely to be helpful than others in the Request for Comment. Most patent drafters are already careful to characterize examples as non-limiting embodiments. Drafters who intend to limit a claim in accordance with a specific example may do so using claim language.

The proposed rule may generate more confusion than clarity. It would require the public to look for limitations in body of the specification as well as the claims. It is also unclear whether any examples identified as “limiting” would limit all claims or just those claims to which the examples are found to pertain. Another question is whether an applicant could rely on limiting specification examples to overcome prior art. If so, can the examiner still reject the claims and require that the limitations of the examples be incorporated into the claims? On the other hand, if the applicant cannot rely on limiting specification examples to overcome prior art, then what incentive does the applicant have to designate any example as limiting?

¹ <http://www.patentlyo.com/patent/2013/01/means-plus-function-claiming.html>

Hon. T. Rea
March 15, 2013
Page Six

Examples are not always discretely presented in the specification. Identifying which specification text constitutes an “example” may not be straightforward. Examiners may have to scrutinize specifications to ensure that all examples have been identified and labeled, thus adding to their burden.

Designating, at the time of filing the application, a default dictionary or dictionaries to be used in ascertaining the meaning of the claim terms and including in the specification a glossary of terms.

We support requiring applicants to identify default dictionaries when possible. Doing so should impose a minimal burden on applicants who are likely already familiar with dictionaries in their field of invention, if they exist. “It is of utmost importance that patents issue with definite claims that clearly and precisely inform persons skilled in the art of the boundaries of protected subject matter.” MPEP § 2173.

Designating a dictionary at the time of filing would promote precision and reduce the burden of litigation. As discussed above, courts may construe only a limited number of claim terms fairly late in litigation. A designated dictionary could reduce the number of terms requiring construction and make the scope of the claims clearer from the outset. We also note that because litigation may not arise until many years after the patent application is filed, it is sometimes difficult to discover what dictionaries persons of skill in the art were using during the relevant time. Having a clear historical record would be very helpful.

A single dictionary may not align perfectly with the applicant’s use of language. Accordingly, it would be particularly useful for applicants to define any specific terms that are not covered in the dictionary or that are defined in a way that is inconsistent with the applicant’s intent. Applicants now often use formal definitions in specifications. *See, e.g.*, U.S. Application No. 20130003179 A1 (defining “difference in refractive index in all direction,” “nano-scale,” “nano-structured,” and “plasma.”). Such definitions could be examined for definiteness during prosecution.

We strongly support the PTO’s efforts to use improved examination procedures to minimize unnecessary disputes over patent scope. For the reasons discussed above, we agree with many of the PTO’s proposals.

Hon. T. Rea
March 15, 2013
Page Seven

Sincerely,

/s/ Michael A. Jacobs

Michael A. Jacobs

/s/ Jason R. Bartlett

Jason R. Bartlett