



April 15, 2013

[Via Email: QualityApplications\\_Comments@uspto.gov](mailto:QualityApplications_Comments@uspto.gov)

U.S. Patent and Trademark Office  
Mail Stop Comments – Patents, Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450  
Docket No: PTO-P-2011-0046

**Re: Comments of AbbVie Inc. in Response to the PTO’s Request for Comments on Preparation of Patent Applications**

Dear Sir or Madame,

AbbVie Inc. respectfully requests the United States Patent and Trademark Office (“PTO”) consider the following comments in response to its “Request for Comments on Preparation of Patent Applications” 78 Fed. Reg. 2960-61 (January 15, 2013). AbbVie appreciates the PTO’s decision to solicit comments on its proposed rules in advance of rulemaking and welcomes the opportunity to provide input on the proposed rules.

The PTO has requested comments on the advantages and disadvantages of applicants employing certain practices when preparing their patent applications to enhance the quality of issued patents and the efficiency of patent prosecution. Specific practices for which the PTO seeks comment include defining terms of degree, including a glossary in the specification, designating a default dictionary at the time of filing, identifying support in the specification, and designating whether the preamble is a claim limitation.

Overall, AbbVie is concerned that these proposed rules will have negative consequences for inventors. AbbVie respectfully submits that the current PTO practices and the substantial body of existing case law adequately provide sufficient guidance to facilitate examination and provide certainty for the scope of issued patents. The proposed changes merely increase administrative burden and delay for applicants without providing any meaningful advantage for clarifying claim terms.

Additionally, while these proposed rules may be an attempt to address concerns made by certain industries, these concerns are not shared across all industries. Nevertheless, the PTO will implement these changes for all applications. Because the rule changes are not needed for all types of applications, at the very least, these rules should be made optional to an inventor.

***Defining Terms of Degree***

AbbVie respectfully submits that the current PTO practices and the substantial body of existing case law adequately provide sufficient guidance regarding the meaning of terms of degree. Specifically, MPEP §2173.05(b) provides a detailed, step-by-step guidance on terms of degree and how to meet the requirements of 35 U.S.C. 112, second paragraph. This current guidance is sufficient to obtain quality claims during patent prosecution. Any further requirements only increase the administrative burden and allow others to argue for very narrow claim scope in future proceedings to the detriment of the inventor.

***Designating a Default Dictionary at the Time of Filing***

AbbVie further submits that it is unnecessary for the PTO to require an inventor to designate, at the time of filing, a default dictionary to determine claim meaning. Identifying any particular extrinsic reference at the time of filing, *e.g.* a technical dictionary, is unnecessary for most claims and would only add to the inventor's administrative burden of locating appropriate source documents. This rule will particularly impact unsophisticated, but worthy inventors. To remedy claim ambiguity during prosecution, particular claim terms can be identified by the examiner and defined by the inventor to provide additional context for the claims.

***Including Glossary of Terms***

Similarly, the existing PTO rules provide adequate guidance for inventors to define terms themselves. Indeed, MPEP §2111.01 already allows an Applicant to be his own lexicographer. This provision allows an inventor to define terms needed for interpretation of the patent rights claimed. Nevertheless if, during prosecution, any inventor insufficiently defines necessary terms in the specification, examiners have the opportunity to address such deficiencies during prosecution. (*See*, MPEP §2173.02). Any additional interpretation of the claims is best addressed in the U.S. courts.

***Identifying Support in the Specification***


AbbVie respectfully submits that the rule requiring an inventor to identify corresponding support in the specification for all claim limitations is an undue burden on inventors and could cause significant unfair prejudice during litigation and other post-grant proceedings. This rule has the potential to unfairly turn inadvertent omissions into very narrow claims if an inventor mistakenly fails to identify one out of a number of examples in the specification. If the PTO is concerned with identifying support in continuation, divisional, or continuation in part

applications for particular claims, this can be (and already is) resolved on a case-by-case basis during prosecution, without a blanket rule as to all claims.

***Designating Whether the Preamble is a Claim Limitation at the Time of Filing***

AbbVie respectfully submits that the rule requiring an inventor to designate the construction of the preamble at the time of filing is unnecessary and could cause unfair prejudice. There is already abundant case law to help the inventor, the examiner, and the public determine whether the preamble serves as a claim limitation. *See e.g., Symantec Corp. v. Computer Associates* (Fed. Cir. 2008). If there is an issue of ambiguity during prosecution, the inventor and the examiner can resolve it in the context of the prior art at that time. The public, in turn, can review the patent record as a whole in connection with the current case law to determine whether a person of skill in the art at the time of filing would have given the preamble no effect or whether it is properly viewed as a claim limitation. Any further requirements may unnecessarily impact claim scope of a legitimate inventor during claim construction in litigation or other post-grant review.

Respectfully,



Karen Nelson  
Senior Counsel  
AbbVie Inc.