

March 15, 2013

The Honorable Teresa Stanek Rea
Acting Under Secretary of Commerce for Intellectual Property and
Acting Director of the United States Patent and Trademark Office
United States Patent and Trademark Office
600 Dulany Street
Alexandria, VA 22314

Via email: QualityApplications_Comments@uspto.gov

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

Dear Acting Under Secretary Rea:

The American Intellectual Property Law Association (AIPLA) is pleased to have the opportunity to present its views in response to the United States Patent and Trademark Office (Office) “Request for Comments on Preparation of Patent Applications” (“Notice”), as published in the January 15, 2013 issue of the Federal Register, 78 Fed. Reg. 2960.

AIPLA is a national bar association whose approximately 15,000 members are primarily lawyers in private and corporate practice and government service and in the academic community. AIPLA represents a wide and diverse spectrum of individuals, companies, and institutions involved directly or indirectly in the practice of patent, trademark, copyright, and unfair competition law. Our members represent both owners and users of intellectual property.

We appreciate the Office’s efforts at improving the quality of issued patents. The Notice is specifically directed to “practices that applicants can employ,” and we direct our comments accordingly.

The Notice seeks input on various practices that might be used during the preparation of patent applications to place them in “better condition for examination.” The practices fall into two general categories, “A. *Clarifying the Scope of the Claims*” (six questions), and “B. *Clarifying the Meaning of the Claim Terms in the Specification*” (three questions). AIPLA first provides general comments and then addresses each particular inquiry.

General Comments

The Notice seeks comments on a variety of proposed practices that might help clarify the scope and content of patent claims. The premise of the inquiry is that patent applicants could facilitate the examination process by submitting certain comments about the claims to the Office before the patent application is examined. Extensive legal precedent has developed around many of the

proposed practices. Drafting patent application descriptions that support claim scope and meaning in the clearest context possible is already considered a best practice. While we agree that the problems addressed by the Notice are important and that solutions should be found, AIPLA believes the Office should not institute additional mandatory or recommended practices as outlined in the Notice, except as specifically noted below.

As a preliminary matter, we believe that this proposal is premature. The U.S. has just undergone a monumental change to its patent system, and the implementing regulations for the reforms are still being put into place (the first-inventor-to-file rules only take effect later this week). The new rules already place enormous burdens on applicants and practitioners by changing practices, each with new and unforeseen pitfalls. Thus, this is not a good time to add additional new and major changes to patent application drafting procedures.

Further, the imposition of additional procedures during patent application preparation will invariably drive up the cost of seeking patent protection, particularly for small and medium-size enterprises. Setting forth written descriptions of technologies and improvements that are novel and nonobvious is already an inherently challenging exercise. Additional formal requirements would significantly drive up costs, increase uncertainty, and create unnecessary barriers for inventors seeking to protect their innovations.

We believe that there are many simpler ways to address the concerns underlying the questions in the Notice. For example, the concerns could be readily addressed by an Examiner-requested interview prior to a first office action, to facilitate a better understanding of the technology and terminology used in an application. The Office has already recognized that this is a reasonable solution. See, for example, the Supplementary Examination Guidelines for Determining Compliance with 35 U.S.C. 112 and for Treatment of Related Issues in Patent Applications, 76 Fed. Reg. 7162, 7169-70, February 9, 2011. The Office states on page 7169:

For example, the examiner may initiate an interview to discuss, among other issues, the broadest reasonable interpretation of a claim, the meaning of a particular claim limitation, and the scope and clarity of preamble language, functional language, intended use language, and means-plus function limitations, etc.

The Notice seeks comment on the central issue of patent claim construction and interpretation. As noted in Section 2111 of the Manual of Patent Examining Procedures (MPEP), pending claims must be “given their broadest reasonable interpretation consistent with the specification.” As established by a unanimous Supreme Court in *Markman v. Westview Instruments, Inc.*, claim construction is a question of law.¹ The Federal Circuit’s en banc opinion in that case, which was affirmed by the Supreme Court, outlined a variety of factors to be used in considering claim scope and content, including the written description of the invention, the prosecution history, dictionaries, and expert testimony.² It is the record *as a whole* that must be reviewed, beginning with the patent application’s entire description.

¹ 517 U.S. 370, 384 (1996).

² 52 F. 3d 967 (Fed. Cir. 1995), *aff’d*, 517 U.S. 370 (1996).

The Notice suggests that the Office review of patentability (and any subsequent interpretation of an issued patent) would be aided by the applicant's self-initiated analysis of the meaning and intent of claim language. Claims are interpreted with due consideration of the environment in which they are drafted and in view of the prior art as a whole at the time of the invention or as of the effective filing date. Rather than adding clarity, the further remarks and formalities suggested by the Office instead would add a layer of ambiguity to what is already a highly subjective exercise. Once the examiner has examined the claims, a sworn statement by the inventor(s) or others skilled in the art—those in the best position to understand the invention—can be submitted if the applicant needs to contest the examiner's interpretation of claim terms. However, this should not be required as a matter of course. The focus must begin and remain on the claims in light of the specification during the examination process. As the late Judge Rich famously said, “the name of the game is the claim.”³ The same sentiment was repeated in *In re Hiniker*, where Judge Lourie found that the applicant's disclosures and proffered facts were not commensurate with the claim scope.⁴

Similarly, in *Festo Corp. v. Shoketsu Kinzoku Kogyokabushiki Co.*, Justice Kennedy noted that “the nature of language makes it impossible to capture the essence of a thing in a patent application,”⁵ and that “[p]rosecution history estoppel requires that the claims of a patent be interpreted in light of the proceedings in the PTO during the application process.”⁶ The application process is a burden-shifting exercise that begins upon application filing. The patent application is the starting point, and the Office is obligated to begin its review under the statutory premise that “(a) person shall be entitled to a patent unless” the Office establishes otherwise.⁷ Thus, the initial patent application has the benefit of a rebuttable presumption of sufficiency under the law.

AIPLA is also concerned about the international ramifications of the suggested practices. Patent applications are often filed in the United States as part of global filing strategies. The implications of adding specific explanatory notes, definitions, and clarifying remarks at the start of, rather than during, prosecution is concerning since this is beyond the scope of normal examination practices. In addition, international filers will be facing a number of new and complex procedures, for example, in relation to the European Unitary Patent. This is an additional reason why it would not be a good time to introduce additional burdensome and unnecessary changes of procedure.

Many of the issues in the Notice have been addressed by the Office in the past. It might be useful if existing Office training materials and guidance on the topics addressed in the Notice were assembled and disseminated both within the Office and to applicants, without creating new mandatory or recommended procedures.

³ See Giles Sutherland Rich, *Extent of Protection and Interpretation of Claims--American Perspectives*, 21 Int'l Rev. Indus. Prop. & Copyright L. 497, 499 (1990).

⁴ *In re Hiniker Co.*, 150 F.3d 1362 (Fed. Cir. 1998) (emphasis added).

⁵ 535 U.S. 722, 731 (2002).

⁶ *Id.* at 733 (emphasis added).

⁷ 35 U.S.C. §102.

The following comments address the specific inquiries of the Notice.

Under the heading “**Clarifying the Scope of the Claims**,” the Office asks for comments on the advantages and disadvantages of the following practices:

1. 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.

Comments

Although the specific example provided may seem reasonable and helpful, a standardized claim format is impractical. Patents are intended to protect inventions of all kinds, some of which do not lend themselves to standardized claim formats. Applicants are, under the law, entitled to claim that which they believe to be their inventions. In some cases, claims are drafted creatively to accurately cover what the applicant regards as the invention. Any effort to develop a standardized claim format must be undertaken with great caution so as to allow applicants sufficient flexibility to adequately claim their inventions.

Many claims are already drafted in the format of preamble, transitional phrase, and particular limitations. In practice, this format would not always be sufficiently flexible for an applicant to adequately claim the invention. As stated in Section 2111.03 of the MPEP, transitional phrases such as “comprising”, “consisting essentially of,” “having,” and “consisting of” define the scope of a claim “with respect to what unrecited [sic] additional components or steps, if any, are excluded from the scope of the claim. *The determination of what is or is not excluded by a transitional phrase must be made on a case-by-case basis in light of the facts of each case.*” (Emphasis added.)

2. 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.

Comments

This proposal is highly discouraged as unnecessary and unduly burdensome. Further, such a practice may move claim interpretation in the direction of central claiming, which is only now required when claims are written in means or step plus function format. The time and cost burden of adding this step to the preparation of an application far outweighs any potential benefit from this proposal. Further, it is unclear what is gained beyond that which is already common practice. Original claims are considered part of the specification as filed; to the extent that amendments are made, applicants are already obligated to avoid introduction of new matter. Therefore, no additional practices are required. For example, specification support statements are usually intended to be exemplary rather than limiting. AIPLA is concerned that the proposed practice may result in an unintended surrender of claim scope.

AIPLA also objects to additional requirements for setting forth specification support for claims. While new language or revised examples may be added to an application, in many cases the continuing application claims should continue to benefit from earlier filing dates, unless some basis for denying benefit is found during examination. Determining priority requires a claim-by-claim analysis that must be done in the context of the invention as a whole, and should be left for the examination process.

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

Comments

AIPLA opposes this practice except in post-filing situations where additional claims are being specifically submitted in light of particular prior art and enablement rejections. Otherwise, examples in the specification are, by definition, illustrative and are intended to provide description and enablement support.

If the Office finds ambiguity in determining whether examples are intended to be limiting, the best approach would be to presume that they are not considered limiting until such time as prosecution history develops that supports the opposite conclusion.

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

Comments

There is extensive case law that the effect of the preamble is to be considered on a case-by-case basis. As noted by Judge Bryson:

Whether to treat a preamble term as a claim limitation is “determined on the facts of each case in light of the claim as a whole and the invention described in the patent.” ... While there is no simple test for determining when a preamble limits claim scope, we have set forth some general principles to guide that inquiry. “Generally,” we have said, “the preamble does not limit the claims.” ... Nonetheless, the preamble may be construed as limiting “if it recites essential structure or steps, or if it is ‘necessary to give life, meaning, and vitality’ to the claim.”⁸

In the dissent to that opinion, Judge Dyk, citing *Catalina Mktg. Int’l, Inc. v. Coolsavings.com, Inc.*, agreed that “(u)nder our precedent, a preamble is construed as limiting “if it recites essential structure or steps, or if it is ‘necessary to give life, meaning, and vitality’ to the claim,” but not if “the claim body describes a structurally complete invention.”⁹

⁸ *American Med. Sys., Inc. v. Biolitec, Inc.*, 618 F.3d 1354, 1358 (Fed. Cir. 2010) (internal citations omitted).

⁹ *Id* at 1363.

AIPLA strongly urges that preamble language not be considered as a limitation on claims until such time as they are found to recite essential structures or steps and/or found to be necessary to give life, meaning, and vitality to the claim. We also urge that the Office clearly state their understanding of any preamble-limitation effect during prosecution.

5. 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.

Comments

This question has been addressed by the Federal Circuit in *In re Donaldson*,¹⁰ and the Office has provided guidance documents regarding these practices.¹¹ AIPLA considers these documents exemplary and lauds the Office for their development. We suggest that any express application of the *Donaldson* doctrine is unnecessary beyond what has already been established.

6. 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.

Comments

AIPLA has no formal objection to this practice since comments from our membership indicate that these are routine practices. Nonetheless, textual and notation systems evolve with technological development. Therefore, we urge that use of so-called “standards” be established with extreme caution and be adaptable as technological standard setting bases evolve.

Nonetheless, Section 2161 of the MPEP observes that both the written description and best mode requirements of 35 U.S.C. § 112 are low bars.

Computer-implemented inventions are often disclosed and claimed in terms of their functionality. This is because writing computer programming code for software to perform specific functions is normally within the skill of the art once those functions have been adequately disclosed. ... Nevertheless, for computer-implemented inventions, the determination of the sufficiency of disclosure will require an inquiry into both the sufficiency of the disclosed hardware as well as

¹⁰ 16 F.3d 1189 (Fed. Cir. 1994) (*en banc*).

¹¹ See, e.g., MPEP § 2181; see also Supplemental Examination Guidelines for Determining the Applicability of 35 U.S.C. 112 ¶6, 65 Fed. Reg. 38510, June 21, 2000.

the disclosed software due to the interrelationship and interdependence of computer hardware and software.¹²

Thus, the courts have held that applicants have great discretion in describing their inventions. Prescribing standard formats at the expense of this discretion is discouraged. Again, AIPLA urges the use of voluntary standards, *to the extent that they are recognized and routine*, as well as mindfulness of the rapidly changing landscape of computer implemented inventions. As conventions in the art change, standard formats would need to be revised as well.

Under “**Clarifying the meaning of claim terms**,” the Office has asked to receive comments on the following practices:

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

Comments

The purpose of the specification is to provide support for the invention as claimed. However, as Justice Kennedy has noted, language can be imprecise (see General Comments, above). The use of relative terminology adds to this imprecision. Nonetheless, claim language is intended to be interpreted in light of and consistent with the written description and is intended to convey meaning to one skilled in the art. The meaning of relative terms must be construed as understood by those of ordinary skill in the art at the time of the effective filing date of the application.

The meaning and limitations of claim language are best defined during the patent examination process by applying appropriate rejections under 35 U.S.C. §§ 102 and 103 and, where ambiguity is present, under 35 U.S.C. § 112.

2. 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.

Comments

AIPLA agrees that providing descriptive support for claim terminology is a primary purpose of the written description portion of the specification where such terms do not have clear meaning in the context of the art.¹³ However, the particular way of providing such support in the written description is within the discretion of the applicant. Therefore, there is no need to promote the use of glossaries or definitions beyond those found suitable by the applicant.

¹² See Manual of Patent Examining Procedures, §2161.01[R-9], citing *Fonar Corp. v. General Elec. Co.*, 107 F.3d 1543, 1549 (Fed. Cir. 1997), and *In re Hayes Microcomputer Prods., Inc.*, 982 F.2d 1527, 1533-34 (Fed. Cir. 1992).

¹³ See, e.g., *Regents of the University of California v. Eli Lilly & Co.*, 119 F.3d 1559 (Fed. Cir. 1997).

3. 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.

Comments

Again, the courts have provided extensive guidance as to how and when dictionaries are to be used in claim interpretation.¹⁴ It is “axiomatic” that a patentee is her “own lexicographer.”¹⁵ This is well settled in the case law, and the Office thus does not have the authority to change that by mandating the use of dictionaries.

In addition, AIPLA does not believe that there is any need for designating dictionary sources at the time of filing. Intrinsic evidence, rather than extrinsic, should be the primary focus for claim interpretation. Use of technical dictionaries should only occur where the meaning of claim terms cannot be resolved from the intrinsic evidence.

* * *

In summary, AIPLA appreciates the challenge faced by the Office and by applicants in continuing to seek higher quality patent applications, examination and patents. We would welcome the development of best practice documents and guidelines, while cautioning against the institution of additional administrative and procedural burdens. Such additional burdens may even increase rather than decrease claim interpretation ambiguities.

Thank you again for the opportunity to comment on these proposals for patent prosecution practice. We would be happy to provide any additional comments or information that would be helpful.

Sincerely,



Jeffrey I.D. Lewis

President

American Intellectual Property Law Association

¹⁴ See, e.g., MPEP § 2111; and *Phillips v. AWH Corp.*, 363 F.3d 1207 (Fed. Cir. 2004).

¹⁵ See, e.g., *Vitronics Corp. v. Conceptronic Inc.*, 90 F. 3d 1576, 1582 (Fed. Cir.1996).