



April 15, 2013

Hon. Teresa Stanek Rea
Acting Under Secretary of Commerce for Intellectual Property
and Director of the U.S. Patent and Trademark Office
600 Dulany Street
P.O. Box 1450
Alexandria, VA 22313

Submitted via: QualityApplications_Comments@uspto.gov

Re: IPO Response to the USPTO's "Request for Comments on Preparation of Patent Applications," 78 Fed. Reg. 2960 (January 15, 2013)

Dear Director Rea:

Intellectual Property Owners Association (IPO) submits the following comments pursuant to the USPTO's "Request for Comments on Preparation of Patent Applications," 78 Fed. Reg. 2960 (Jan. 15, 2013) (the "Federal Register notice").

IPO is a trade association representing companies and individuals in all industries and fields of technology who own or are interested in intellectual property rights. IPO's membership includes more than 200 companies and more than 12,000 individuals who are involved in the association either through their companies or law firms or as IPO individual members.

The Federal Register notice asks the public to consider potential best practices aimed at improving patent application quality "in order to facilitate examination and bring more certainty to the scope of issued patents." The notice provides some suggestions that could be helpful to some applicants on a case by case basis, but would not apply to all applicants in all situations. IPO opposes requiring applicants to comply with any of the suggested best practices.

IPO understands, however, the difficulty of construing patent claims, and shares the USPTO's views about granting patents directed to patentable subject matter and containing claims that are reasonably clear as to meaning and scope. IPO believes that enhanced examiner training on claim construction, based upon the Patent Act and the ever-evolving legal precedent, would be helpful. IPO also believes that examiners should be encouraged to identify claim construction issues during the early stages of the examination process and engage in constructive dialogues so that such issues can be resolved without delay.

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In construing claim limitations the “[US]PTO applies to the verbiage of the proposed claims the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in the applicant’s specification.” *In re Morris*, 127 F.3d 1048, 1054 (Fed. Cir. 1997). “The reason [for this standard of claim construction in the USPTO] is simply that during patent prosecution when claims can be amended, ambiguities should be recognized, scope and breadth of language explored, and clarification imposed.” *In re Zletz*, 893 F.2d 319, 321 (Fed. Cir. 1989) (citations omitted). With these principles in mind, IPO presents the following comments on the specific best practices suggested in the Federal Register notice.

A. Clarifying the Scope of the Claims

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.”

IPO believes that such templates may be useful to pro se inventors and some practitioners. Such templates may be problematic, however, in applications that originate from non-U.S. countries, and that contain claims not in the template format. Amending such claims by way of a preliminary amendment upon filing would consume scarce resources. Moreover, applicants are reticent to amend original claims until receiving an office action on the merits.

As discussed below, the determination on whether a claim component is a preamble or a claim limitation is best made when issues arise in prosecution.

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.”

IPO believes requiring applicants to duplicate information that is already contained in the specification would be unduly burdensome and potentially harmful. For example, the application may describe five embodiments but the claim chart may mistakenly list only four of the five. Such an error could limit the claims to the four identified embodiments even though support for the fifth embodiment can be found within the specification. The estoppel effects of such a practice could negatively affect claim construction in litigation or any post grant review, or have other unintended consequences.

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

IPO does not believe there is any reason an applicant would describe an example as limiting rather than illustrative.

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

This issue is best resolved during the examination process, as needed. Whether a preamble is intended to be a limitation can depend on the context of the entire pending claim, the issues encountered during prosecution, and the prior art. After the examiner has construed the entire claim, applicants will be in a better position to agree or disagree with the proposed construction and respond appropriately.

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.”

This issue is also best resolved during the examination process, as needed. If particular claim language is problematic for an examiner as to whether Section 112(f) applies, a dialogue between the applicant and the examiner should quickly resolve the issue.

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.”

This suggestion raises several concerns. For example, providing such code may needlessly require disclosure of trade secrets. Secondly, such code may be large and result in a significant burden to produce the needed documentation. Further, if multiple codes support the same function, producing a single code could potentially artificially limit the claims.

B. Clarifying the Meaning of Claim Terms in the Specification

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.”

This issue can be resolved during prosecution in the context of a pending rejection. Adverbs and adjectives have historically been helpful in creating patents that prevent “unscrupulous copyists” from artificially evading infringement by making minor changes that avoid the literal language of a claim. Requiring finite definitions for such terms defeats the purpose of using them.

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.”

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This should be left to the discretion of the applicant. Many patent specifications are already drafted with a list of definitions. It is also unclear what the USPTO considers as potentially ambiguous, distinctive, and specialized terms. Therefore, it is best for the examiners to raise these issues during examination.

Moreover, defining technology by way of a single English language sentence is inherently difficult. The English language can be imprecise and almost every word can take on different meanings depending on the context in which it is used. These issues are best resolved during the examination process by way of a dialogue between the examiner and the applicant.

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."

Per the principles set forth in *In re Morris, supra*, the entire specification must be reviewed to determine the meaning of particular claim language. In addition, as a number of different dictionaries may be required to define a long list of claim terms, this suggestion could create an undue burden on the applicant at the time of filing.

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IPO thanks the USPTO for considering these comments and would welcome any further dialogue or opportunity to provide additional information to assist in the Office's efforts on this issue.

Sincerely,



Richard F. Phillips
President