

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re:
Strategies for Improving Claim Clarity:
Glossary Use in Defining Claim Terms

COMMENTS OF PUBLIC KNOWLEDGE AND THE ELECTRONIC FRONTIER FOUNDATION

Charles Duan
PUBLIC KNOWLEDGE
1818 N Street NW, Suite 410
Washington, DC 20036

Julie Samuels
Daniel Nazer
ELECTRONIC FRONTIER FOUNDATION
815 Eddy Street
San Francisco, CA 94109

October 24, 2013

Contents

I.	The Importance of Clarity in Claim Terms	3
II.	A Clear File Wrapper Promotes Clean, Predictable Claim Construction	3
III.	Recommendations for Interview Procedure	4
	A. Revisions to the Interview Request Form (PTOL-413A)	5
	B. Form Paragraphs to Use with the Interview Summary Form (PTOL-413)	5
	C. Revised Forms PTOL-413A and PTOL-413 and File Wrappers	7
IV.	Third Party Participation	8
V.	Conclusion	10

**COMMENTS OF PUBLIC KNOWLEDGE AND THE ELECTRONIC FRONTIER
FOUNDATION ON THE UNITED STATES PATENT AND TRADEMARK OFFICE
SOFTWARE PARTNERSHIP MEETING**

Public Knowledge and the Electronic Frontier Foundation (“EFF”) respectfully submit the following comments in response to the Notification of a Software Partnership Meeting on October 17, 2013. Representatives from each organization attended the meeting and are happy to discuss these and other matters further.

Public Knowledge and EFF support the use of glossaries to improve clarity of claim terms, both in specifications of filed applications and by submission via preliminary amendment in filed applications. The inclusion of clarifying definitions in the file wrapper provides greater public notice of the meaning and scope of claims in issued patents, thereby advancing the public interest in disclosure and the fundamental public notice function.

Because of the added value associated with glossaries and claim term definitions placed in the file record, **we recommend the further use of glossary-like information in other aspects of patent prosecution.** For example, claim terms are often discussed during interviews between applicants and examiners. Creating a record of those definitions, as part of the interview summary, would further advance the same public notice interests as the placement of glossaries in specifications or preliminary amendments. It would further assist in expediting prosecution, as applicants and examiners would have a written, detailed memorial of the content of the interview.

Accordingly, we provide suggested additions to the interview forms and processes to gather this information. These include additions to the interview request form (PTOL-413A) to enable applicants to identify relevant claim terms and definitions, and suggested form paragraphs that may be incorporated as appropriate into the interview summary form (PTOL-413 or PTOL-413B).

I. The Importance of Clarity in Claim Terms

The Patent Act requires that a patent must conclude with “one or more claims particularly pointing out and distinctly claiming the subject matter which the inventor or a joint inventor regards as the invention.” 35 U.S.C. § 112(b) (emphasis added). This provision establishes a key requirement of the patent system: patents must inform potential infringers, in advance, of what the claims cover and what they do not cover. As the Supreme Court has explained, a patent claim secures “all to which [the patentee] is entitled” while “apprising the public of what is still open to them.” *McClain v. Ortmayer*, 141 U.S. 419, 424 (1891).

Repeatedly, the Supreme Court has said that patent “boundaries should be clear. This clarity is essential to promote progress, because it enables efficient investment in innovation.” *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 535 U.S. 722, 731 (2002). A clear definition of patent scope serves multiple purposes: the “limits of a patent must be known for protection of the patentee, the encouragement of the inventive genius of others, and the assurance that the subject of the patent will be dedicated ultimately to the public.” *Gen. Elec. Corp. v. Wabash Appliance Corp.*, 304 U.S. 364, 368–69 (1938).

Ambiguous patent claims create a “zone of uncertainty which enterprise and experimentation may enter only at the risk of infringement claims” and thereby “discourage invention only a little less than unequivocal foreclosure of the field.” *United Carbon Co. v. Binney & Smith Co.*, 317 U.S. 228, 236 (1942). Accordingly, the PTO should implement rules of examination procedure that minimize the possibility of allowance of ambiguous claims.

II. A Clear File Wrapper Promotes Clean, Predictable Claim Construction

The file wrapper is a key part of creating clarity in patents. The Federal Circuit has held the file wrapper as one of the four key sources to be consulted when construing a

patent. See *Phillips v. AWH Corp.*, 415 F.3d 1303, 1317 (Fed. Cir. 2005). This is because “the prosecution history provides evidence of how the PTO and the inventor understood the patent.” *Id.* (citing *Lemelson v. Gen. Mills, Inc.*, 968 F.2d 1202, 1206 (Fed. Cir. 1992))

In that same case, though, the Federal Circuit observed that the file wrapper is “less useful for claim construction purposes” because it “often lacks the clarity of the specification.” *Id.* For example, in one case, the court was unable to use a file wrapper in interpreting a patent, because it found that “[t]wo strong and contradictory interpretive strands thus run through the patent’s prosecution history.” *Athletic Alternatives, Inc. v. Prince Mfg., Inc.*, 73 F.3d 1573, 1573 (Fed. Cir. 1996). Thus, the court found the file wrapper “unhelpful as an interpretive resource.” *Id.* In contrast, in a case in which the file wrapper was clear, the Federal Circuit was able to point to two specific paragraphs from that file wrapper to assist in interpreting a claim term. See *Southwall Techs., Inc. v. Cardinal IG Co.*, 54 F.3d 1570, 1576–77 (Fed. Cir. 1995).

Accordingly, the file wrapper serves an important role in interpretation of claims, and thus serves an important role in reducing ambiguity in the patent system. But it only serves this role if the documents in the file wrapper are clear and complete.

III. Recommendations for Interview Procedure

The proposed glossary program would increase public notice and facilitate the construction of patent claims, and applying the same principles to interview practice would similarly achieve those purposes. Doing so would require minimal modification to interview procedures, and as explained in detail below, it would not increase the burden on examiners’ workloads, but rather would likely decrease the burden. Accordingly, we recommend the following modifications to interview practice.

A. Revisions to the Interview Request Form (PTOL-413A)

The following is suggested for addition to the interview request form, PTOL-413A.

Claim Terms To Be Discussed					
Claim #	Term	Proposed Definition	Discussed	Agreed	Not Agreed
(1) _____	_____	_____	☐	☐	☐
(2) _____	_____	_____	☐	☐	☐
(3) _____	_____	_____	☐	☐	☐

This additional section would allow an applicant to identify particular claim terms for discussion, and provide an opportunity for the applicant to define those terms. This would assist the examiner in preparing for the interview.

B. Form Paragraphs to Use with the Interview Summary Form (PTOL-413)

The following are three suggested form paragraphs that may be included in an interview summary, assuming the definition of one or more claim terms were discussed in that interview. The first provided paragraph may be used when the parties agree on a definition.

During the interview, the claim term [1] was discussed. Applicant proposed that the term referred to [2], and Examiner agreed.

Examiner Note:

1. In bracket 1, insert the claim term discussed.
2. In bracket 2, insert either the Applicant's provided definition of the term, a quotation from the specification, and/or a citation to the specification.

This form paragraph ensures that there is a public record of an agreed definition of a claim term. It furthermore ensures that both the applicant and the examiner are working from the same definition of the claim term, thus facilitating further prosecution and reducing

potential disagreements.

The second form paragraph may be used when the applicant proposes a definition, but the examiner disagrees and suggests an alternate definition.

During the interview, the claim term [1] was discussed. Applicant proposed that the term referred to [2]. Examiner disagreed, indicating that the broadest reasonable interpretation of the term included [3]. No agreement was reached.

Examiner Note:

1. In bracket 1, insert the claim term discussed.
2. In bracket 2, insert either the Applicant's provided definition of the term, a quotation from the specification, and/or a citation to the specification.
3. In bracket 3, insert the Examiner's alternate proposed definition.

In this case, both the applicant's and the examiner's definitions are made of record. This facilitates review of the application by other parties, such as supervisory examiners or the Board of Appeals.

In many cases where there is such a disagreement, the applicant or examiner may suggest an amendment to the claim term to further clarify the claims. If the parties agree to that amendment, the following form paragraph may be used.

During the interview, the claim term [1] was discussed. Applicant proposed that the term referred to [2]. Examiner disagreed, indicating that the broadest reasonable interpretation of the term included [3]. The parties agreed on amending the claim term to [4].

Examiner Note:

1. In bracket 1, insert the claim term discussed.
2. In bracket 2, insert either the Applicant's provided definition of the term, a quotation from the specification, and/or a citation to the specification.
3. In bracket 3, insert the Examiner's alternate proposed definition.
4. In bracket 4, insert the proposed amendment.

This form paragraph ensures that the definitions of both the original claim term and of the amended term are in the record. Having the definition of the original claim term is

important for related patents. For example, a continuation application that claims priority to the application under discussion may revert to the original claim term, so having the proposed definitions made of record will facilitate examination of that continuation application and also provide notice to the public of the meaning of the continuation application's claims.

Additionally or alternatively, the PTOL-413 form may be revised to include a table similar that suggested above with respect to Form PTOL-413A, so that the examiner may enter discussed claim constructions in tabular format on the interview summary form.

C. Revised Forms PTOL-413A and PTOL-413 and File Wrappers

The proposed form revisions would also serve an important function when included in the file wrapper. The rules already contemplate this. For instance, the substance of an examiner interview must become part of the record. 37 C.F.R. § 1.2 requires “[a]ll business with the Patent and Trademark Office should be transacted in writing” and “[t]he action of the Patent and Trademark Office will be based exclusively on the written record in the Office.”

In addition, PTO training materials include a document on “Interview Best Practices” (2011), which states, among other things, that “[i]nterviews are well recognized as advancing prosecution.” The same document provides the practice for examiners to enter the matters of interviews into the record.

Currently, file wrappers tend to include sparse examiner notes at best. This occurs despite the fact that the Manual of Patent Examining Procedure (MPEP) § 713.04 states that a “complete written statement as to the substance of any face-to-face, video conference, electronic mail or telephone interview with regard to the merits of an application must be made of record in the application, whether or not an agreement with the examiner was reached at the interview.”

The proposed revisions to the Interview Request Form and the Interview Summary

Form would immediately create more robust file wrappers, which in turn would advance the notice function and give patentees, potential patentees, and third-party innovators concrete knowledge about what is actually claimed.

IV. Third Party Participation

It goes without saying that even those who do not directly interact with the Patent Office by, for instance, filing patent applications, are still directly impacted by the Office's policies that result in the granting and denial of applications. When patent quality suffers, the public realizes substantial social costs. Those costs are reflected in the price of goods covered, or allegedly covered, by improvidently granted patent claims. They are also reflected in the high costs associated with litigation and unnecessary licensing fees, which serve as an unjustified tax on consumers. As Justice Breyer stated recently during oral argument in *Microsoft Corp. v. i4i Ltd. Partnership*: "It's a bad thing not to give protection to an invention that deserves it; and it is just as bad a thing to give protection to an invention that doesn't deserve it. Both can seriously harm the economy." Transcript of Record at 13:22–14:1, *Microsoft Corp. v. i4i Ltd. P'ship*, 131 S. Ct. 2238 (2011) (No. 10-290).

We have been encouraged lately to see the Patent Office's inclusion of third-party stakeholders in the discussions surrounding patent policy. This is particularly the case with the introduction of the software partnership.

While we appreciate the Office's recent efforts at outreach, we fear our voices have not always been sufficiently heard. For example, we were excited to participate in this recent software partnership meeting to discuss the glossary pilot program on October 17, 2013. However, the meeting overlooked the interests of non-applicant parties in several ways. For one thing, of the four speakers selected to give comment on the proposed pilot program, three of them represented primarily patent attorneys. Furthermore, the PTO distributed a survey form to gather input on the pilot program, but every question was directed to patent applicants or attorneys.

This omission of non-applicant parties contrasts with the willingness of those same non-applicant parties to assist the PTO. Numerous software developers and other non-applicant parties contributed valuable ideas at the PTO's roundtables in February 2013, which accepted presentations from the general public. Additionally, public-private partnerships such as Peer-To-Patent and Ask Patents program have proven themselves to be both successful and popular.

Accordingly, we urge the PTO to continue to actively solicit and consider the interests of non-applicant parties in developing patent policies and programs. Specific areas in which our input would be valuable include:

1. **Improvement of patent quality.** Patents of questionable validity are a substantial drain on the American economy, as they diminish the ability of others to engage in competitive and innovative business. A patent owner can benefit from a broad, vague patent, but the public does not.
2. **Prior art searching.** Many third parties have substantial experience in industry and technology, and their knowledge is an invaluable resource to an office tasked with assessing the aptitude of those of "ordinary skill in the art." Although stricter consideration of obviousness and prior art may extend prosecution times, efficiency cannot justify the harms that invalid patents cause.
3. **Clarity in file wrappers.** Patents and prosecution histories must be complete and understandable in order to achieve fairness in the patent litigation that faces third parties. Although the PTO usually only sees a patent application up until the patent grant, there are still two decades of patent term that follow, which directly impacts non-applicant parties.
4. **Metrics for assessing performance.** Measurements of success at the PTO should focus on long-term quality of patents, as the objective of the PTO is not to issue patents but to issue good ones. Speed of examination, a common metric used by

the PTO, should not be the end goal but rather subservient to the goals of quality and clarity.

V. Conclusion

Public Knowledge and EFF appreciate the Patent and Trademark Office providing the opportunity to present comments on the glossary pilot program. We look forward to working together in further implementation of this and other programs, to ensure clarity, fairness, and efficiency within the patent system.

Respectfully submitted,



Charles Duan
PUBLIC KNOWLEDGE
1818 N Street NW, Suite 410
Washington, DC 20036
cduan@publicknowledge.org

Julie Samuels
Daniel Nazer
ELECTRONIC FRONTIER FOUNDATION
815 Eddy Street
San Francisco, CA 94109

October 24, 2013