

# Glossary Pilot Program

## Frequently Asked Questions

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## **Glossary Pilot Information**

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### **1. *What is the effective date of the Glossary Pilot Program?***

- The Glossary Pilot Program will start June 2, 2014.

### **2. *How long will the Glossary Pilot run?***

- The Glossary Pilot Program will run for six (6) months from its effective date or until the USPTO accepts 200 grantable petitions to make special under the Glossary Pilot Program, whichever occurs first.

### **3. *Can the applicant also file a request to enter the First Action Interview Pilot Program?***

- Yes. Applications accepted into the Glossary Pilot Program that also participate in the First Action Interview (FAI) Pilot Program must meet all the requirements of the FAI pilot program, to include the lower claim number limitations, and all other requirements of the FAI pilot program.

## **Entry Requirements**

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### **4. *What types of applications are eligible for the Glossary Pilot Program?***

- In order to participate in the Glossary Pilot Program, applications must be filed on or after June 2, 2014, and be one of the following types of application: (a) Original, non-reissue, non-provisional utility applications filed under 35 USC 111(a) that do not claim the benefit of a prior filed U.S. application (i.e., cannot be a continuation or divisional application), except the applications can claim benefit of a provisional application; or (b) continuation-in-part applications claiming the benefit of a prior non-provisional utility application under 35 USC 120 or 365(c) filed for the purposes of providing a glossary in accordance with this pilot program. The applications cannot be international applications, national stage applications filed under 35 USC 371, design applications, or plant

applications. The application also cannot participate in any Patent Prosecution Highway (PPH) program.

**5. *Is the Glossary Pilot Program open to utility applications across all technologies?***

- No, the application must be classified in one of the U.S. patent classification (“USPCs”) examined by USPTO Technology Center 2100, 2400, or 2600, or the Business Methods area of Technology Center 3600 when the petition decision is rendered. A list of the USPCs examined by these Technology Centers and eligible for participation in the Glossary Pilot Program is available here [USPC Classes](#).

**6. *How does the applicant file a petition to participate in the Glossary Pilot Program?***

- Applicants who wish to participate in the Glossary Pilot Program must provide, upon the filing of an eligible patent application: a petition to make special using Form [PTO/SB/436](#), and meet the requirements and conditions as stated in the Glossary Pilot Program’s [Federal Register Notice](#).

**7. *What fees are required to participate in the Glossary Pilot Program?***

- No additional fees are required for submission of a petition to make special using Form PTO/SB/436 in order to participate in the Glossary Pilot Program. All regular examination-related fees are still applicable.

**8. *How can an applicant determine if an application is subject to classification in one of the USPCs examined by eligible USPTO Technology Centers?***

- Applicants should consult the [USPC Classes](#) information to ensure their application would be subject to examination by USPTO Technology 2100, 2400, or 2600, or the Business Methods area of Technology Center 3600.

## **Glossary Requirements**

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### **9. *Are there any requirements with respect to the glossary or the definitions included in the glossary?***

- Yes. The following requirements apply:
- (1) The glossary must be placed at the beginning of the detailed description portion of the original specification, identified with a heading, and presented on filing the application. The glossary cannot be, for example, a separate paper, an appendix to the specification, or part of an information disclosure statement. Additionally, the glossary cannot be a follow-on submission made after the filing date of the application.
- (2) The glossary definitions cannot rely upon other parts of the specification for completeness, or upon any incorporation by reference to other sources such as patents, published patent applications, or non-patent literature references.
- (3) A glossary definition establishes scope for a term by presenting a positive statement of what the term means. A glossary definition cannot consist solely of a statement of what the term does not mean, and cannot be open-ended.
- (4) Definitions provided in the glossary cannot be disavowed elsewhere in the application. For example, a definition cannot be presented in the glossary along with a sentence that states that the definition is not to be considered limiting.
- (5) A glossary definition may include the usage of examples, synonyms, and exclusions. However, the glossary definition cannot consist solely of a list of examples, synonyms, and/or exclusions.
- (6) The glossary should include definitions that will assist in clarifying the claimed invention and creating a clear application file wrapper history .
- For more details on the requirements and/or conditions, see the [Federal Register Notice](#).

**10. *Is the applicant allowed to disavow the definitions in the glossary section after filing?***

- No, a definition cannot subsequently be disavowed once it has been defined in the glossary section submitted on filing.

**11. *Is applicant allowed to delete a term and/or definition from the glossary section?***

- No. Except for the correction of typographical errors, no defined term and its definition can be amended, altered or deleted in the glossary section during examination.

**12. *What if an applicant decides NOT to define a claim term in the glossary section?***

- Any claim term that is not defined in the glossary section submitted on filing will be subject to Office standard policy, practice and procedure for claim interpretation. See, e.g., MPEP 2111.

**13. *What legal effect will the definitions in the glossary section have during prosecution?***

- Where an explicit definition is provided by an applicant for a term, that definition will control Office interpretation of the term as it is used in the claims. See MPEP 2111.01 IV.

## **Petition**

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### **14. Which document code in EFS-Web must the applicant select to file a petition to make special in order to participate in the Glossary Pilot Program?**

- The applicant should select the document code “PET.GLOSSARY” when filing a petition to make special using Form [PTO/SB/436](#).
- The applicant may access the EFS-Web [Quick Start Guide](#) for assistance with filing the petition to make special.

### **15. How will the applicant know if a petition to make special in order to participate in the Glossary Pilot Program was granted?**

- The applicant will receive a written decision stating that the petition was granted. Additionally, applicant can find out that a petition was granted by electronically accessing the file history of the application via “Private PAIR.” For information on [Private Pair](#), visit:  
[http://www.uspto.gov/patents/process/status/private\\_pair/index.jsp#heading-1](http://www.uspto.gov/patents/process/status/private_pair/index.jsp#heading-1)

### **16. How will the applicant know if a petition to make special in order to participate in the Glossary Pilot Program was dismissed?**

- The applicant will receive a written decision stating that the petition was dismissed, along with reasons for the dismissal. Applicant will be given 30 days to correct the deficiencies, if possible, and request reconsideration of the petition. A failure to respond will only result in the application not participating in the pilot, and not result in abandonment of the application. No new matter can be added to correct a deficiency, instead applicant would need to file a CIP if new matter is necessary to correct the deficiency. Additionally, applicant can find out whether a petition was dismissed by electronically accessing the file history of the application via “Private PAIR.” For information on [Private Pair](#), visit:

[http://www.uspto.gov/patents/process/status/private\\_pair/index.jsp#heading-1](http://www.uspto.gov/patents/process/status/private_pair/index.jsp#heading-1)

**17. If the applicant received a decision dismissing a petition to make special in order to participate in the Glossary Pilot Program, can applicant file a petition requesting supervisory review of the decision?**

- Yes. Applicant can file a petition under 37 CFR 1.181 if applicant believes that a decision dismissing a petition to make special in order to participate in the Glossary Pilot Program is not proper. Applicant should review the reason(s) stated in the decision dismissing the petition to make special and make a determination that an error was made by the Office in not granting the petition before filing a petition under 37 CFR 1.181.

**18. Who can the applicant contact if he/she has any questions about a decision dismissing a petition to make special in order to participate in the Glossary Pilot Program?**

- The applicant should contact the person who signed the decision dismissing the petition to make special if there is a question about the dismissal.

## **Status**

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**19. My application has been granted special status under the Glossary Pilot Program. Will the application remain in that special status until either issuance or abandonment of the application?**

- No. The Glossary Pilot Program grants special status only up to issuance of the first Office Action.

**20. If the examiner only issues a restriction requirement as my first action in an application that has been accepted in the Glossary Pilot Program, will my application still be treated as special for issuance of the First Office Action on the merits?**

- No, an application accepted in the Glossary Pilot Program will only be treated as special up to issuance of a first action. A written restriction requirement is considered an Office action. See MPEP 810. Therefore, if the first action in an application accepted into the pilot contains only a restriction requirement, then all subsequent examination will be conducted in accordance with standard Office policy, practice and procedure. Applicants should factor this loss of special status into their consideration of whether to make a telephonic election.

**21. *Can I file a preliminary amendment after my application has been accepted into the pilot?***

- Yes. Any preliminary amendment filed after the application has entered into the pilot but before the issuance of the first Office action will be entered unless such amendment causes the application to be non-compliant with the pilot's requirements.

**22. *How will I know if the limit of 200 granted petitions to make special in order to participate in the Glossary Pilot has been reached?***

- The Office posts statistics, including the number of granted petitions to make special in order to participate in the [Glossary Pilot Web site](#). In addition, the Office will post a message in EFS-Web if/when the number of granted petitions is close to the limit.

**Contact**

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**23. *Who can the applicant contact if he/she has any questions regarding the Glossary Pilot Program?***

- General questions or concerns about the Glossary Pilot Program can be directed to this email address: [Glossary@uspto.gov](mailto:Glossary@uspto.gov). Applicants may also contact: Seema Rao, Director, Technology Center 2100 (571) 272-0800.