Comments in response to
Request for Comments on Preparation of Patent Applications
78 FR 2960 (January 15, 2013)

Lee A. Hollaar
March 12, 2013

[Lee Hollaar is a professor in the School of Computing at the University of Utah in Salt Lake City, where he currently teaches intellectual property and computer law. He has been a registered patent agent since 1989, and has been a testifying expert, litigation consultant, and special master in a variety of intellectual property-related cases, including being a special master for claims interpretation. He is the author of *Legal Protection of Digital Information*, BNA Books 2002, available online at www.digital-law-online.info. The views expressed here are his own.]

I am responding to both Topic A, Clarifying the Scope of the Claims, and Topic B, Clarifying the Means of Claim Terms in the Specification.

Regarding Topic A, I believe that the required use of a "standardized template" is not necessary, and becomes less so as natural language processing (NLP) techniques advance. And depending on how it is implemented, it could be just one more artifact of electronic submission of applicants that users will curse, such as the requirement of embedding fonts in the PDF of an application.

Already there is a standard form for a claim: preamble, transition term, elements. And because only a few well-know transition terms are used ("comprising" the most common, with its alternative "including" sometimes being used, and also the more-restrictive "consisting of" or "consisting essentially of" used in special circumstances), it is easy to parse the claim into those parts.

Claim elements are also easy to identify, since applicants often include a line break after each element and indent elements at a similar level. The suggestion of a way of designated elements (such as "[a]") would make parsing those claims following the suggestion even easier (and would help in discussing the claims with the examiner and in later litigation). And because pronouns and other complications seldom used, many of the difficulties in natural language parsing simply don't exist, are relatively easy to solve, or can be determined by had in the few instances where automatic identification fails.

Identifying support in specification might be difficult if spread throughout, and might be mistaken for 112(f) structure. We see a comparable problem in the "table of authorities" in a brief, where *passim* is used instead of listing a large

number of pages. However, designating where a claim element is fully support may be desirable when that claim element has been added later in prosecution such as with an amended claim, is a dependent claim introduced after its parent claim has been allowed (which can simply prosecution by reducing the number of claims being considered while allowing a number of fall-back claims if the patent is litigated), or in a continuation-in-part.

Nobody is going to say that an example is limiting and few will say that the preamble is limiting unless they are using that as part of their claiming technique. Much like writing claims as suggested in 37 C.F.R. § 1.75(e), it is something that sounds nice but will not be used by anybody concerned about the effectiveness of their patent.

Regarding functional claiming, see my response to Request for Comments and Notice of Roundtable Events for Partnership for Enhancement of Quality of Software Patents, 78 FR 292 (January 3, 2013).

Regarding Topic B, If a claim term is unclear in any to examiner, then that claim should be rejected, allowing the applicant to show in the specification or through accepted references the meaning. In the spirit of compact prosecution, the examiner should also state an interpretation of the claim term that will be used for examination for novelty and nonobviousness. If the applicant disagrees with that interpretation in a response to the office action, that interpretation will then be on the record. If it is substantially different from the one used by the examiner for searching, a request for continued examination may be necessary to cover the extra work.

Applicants should be encouraged to clearly define terms used in unconventional ways. And having to pay an RCE fee for an additional search will encourage that.

Designating a "default dictionary … to be used for ascertaining the meaning of the claim terms," while sounding appealing, is a REALLY. BAD. IDEA. Dictionaries often provide a number of definitions for a word, and it may not be clear which is to be used. (As a non-patent example, Webster's defines "vixen" not only as "a female fox" but also as "a shrewish ill-tempered woman" and "a sexually attractive woman." There is considerable difference between those last two.) If an applicant wants to use a particular meaning for a word, it would be far better to include a clear definition at the start of the specification. ("As used in this specification, the term … means …")

Dictionaries seldom provide definitions for phrases, and combining definitions of the constituent words of a phrase may just give more confusion. For example, the primary definition of "hydraulic" is "operated, moved, or effected by means of water," and the primary definition of "ram" is "a male sheep," but the term "hydraulic ram" is not about moving sheep by water! (The phrase does occur in some unabridged dictionaries, but not in common desktop ones.)

But even more of a problem with designating a default dictionary for understanding claim terms is that an applicant would have to look up every claim term in that dictionary, to make sure that it was compatible with the dictionary definition. Similarly, the examiner must consider the definition in the designated dictionary for each and every word in the claim, because a claim interpretation not in line with that dictionary is clearly not reasonable.

It will be far easier and better for applicants to clearly define in the specification any claim term that does not have its accustom meaning, and getting a rejection and having to pay for an RCE search if the examiner finds the claim unclear.