

**From:** Linda Shapiro  
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**To:** QualityApplications\_Comments  
**Subject:** Response to "Request for Comments on Preparation of Patent Applications"

March 1, 2013

My comments are as follows:

### **A. Clarifying the Scope of the Claims**

While this goal is a worthy one, I foresee several substantial problems based on my experience preparing applications for domestic clients and prosecuting applications prepared by foreign clients.

The claim chart proposed in item 2 is similar to the claim chart required for appeal briefs. Even when a patent application is well-written, preparing the claim chart is an extremely time-consuming process, easily adding many hours, and potentially thousands of dollars to the cost of preparing a patent application. For individuals and small businesses, this added expense may be prohibitive.

For patent applications originating outside the U.S., this will be another requirement that is out of sync with patent practice outside the U.S. Foreign applicants almost uniformly balk at making preliminary amendments to bring applications into line with U.S. practice, beyond deleting multiple claim dependencies. Unless a claim chart were made a pre-examination formalities requirement, I foresee that the foreign applicants I represent would defer the preparation of a claim chart until required in a first Office Action, thus diluting the value of the claim chart.

The requirements of items 3-6 would be relatively easy to implement for applications prepared by U.S. practitioners; but again, it is most unlikely that they would be included in applications prepared outside the U.S. Again, unless these requirements were made pre-examination formalities requirements, I foresee that the foreign applicants I represent would defer complying with them until required in a first Office Action.

### **B. Clarifying the Meaning of Claim Terms in the Specification**

As with goal "A," this goal is worthy, but presents substantial practical issues.

None of these items is likely to be included in patent applications prepared outside the U.S., and their addition following filing in the U.S. would in many (perhaps most) cases constitute "new matter."

Also, in my experience, inventors rarely consider the terms that they use in the specification to be "potentially ambiguous." I don't know what "distinctive" is supposed to mean in this

context. “Specialized” is itself a very relative term, and I personally don’t know how I would decide that a term is “specialized” versus “not specialized.”

As I have prosecuted a number of applications relating to zoom lens technology, I decided to look at the abstracts of recently-published applications including “zoom lens” in their titles. The abstract of US2013/0010174 reads “A zoom lens including first to fifth lens units in order from an object side toward an image. The refractive powers of the first to the fifth lens units are positive, negative, positive, negative and positive, respectively. The distance between the first and the second lens units is increased at the time of zooming from the wide angle end to the telephoto end, and the distance between the second and the third lens unit is decreased at the time of zooming from the wide angle end to the telephoto end. The first lens unit and the fourth lens unit are fixed for the zooming. When M2 and M3 are the amounts of movement of the second lens unit and the third lens unit at the time of zooming from the wide angle end to the telephoto end, respectively, the conditional expression;  $0.2 < |M2/M3| < 5.0$  is satisfied.” It would not be unreasonable to identify at least “zoom,” “object,” “image,” “positive,” “negative,” and “fixed” as “specialized” terms, because they all have different meanings depending on their context, and they have “special” meanings in the optics art; yet it is unlikely that anyone with any familiarity with optics would consider them “potentially ambiguous.”

Preparing a glossary, like preparing a claim chart, also is likely to add considerably to the expense of preparing a patent application.

In any event, if I supply definitions, potentially adding pages to the specification, is an Examiner actually going to read them and then spend the time to consider whether prior art that uses the same terms is using them the same way? Based on my experience in those applications where I have included definitions, the answer is “no.”

With respect to designating a default dictionary or dictionaries at the time of filing, in my experience, there are a number of arts (optics and microscopy being two examples), where I have yet to find a comprehensive technical dictionary. Textbooks may be a better resource than dictionaries in some cases.

Also, for applications claiming priority to foreign applications written in a language other than English, it might be necessary to be able to designate non-English language dictionaries as the default dictionaries.

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