From: Sundby, Suzannah
Sent: Monday, April 15, 2013 8:03 PM
To: QualityApplications_Comments
Subject: Comments on Preparation of Patent Applications

Mail Stop Comments--Patents
Commissioner for Patents
P.O. Box 1450
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ATTN: Nicole D. Haines, Legal Advisor

Dear Commissioner,

Thank you for this opportunity to comment on proposed practices that applicants can employ when drafting patent applications to facilitate examination and bring more certainty to the scope of granted patents.

The Notice states that the request for comments arose from a Software Partnership meeting, however, the scope of the request for comments is not explicitly limited to software applications. Although the U.S. Patent & Trademark Office's purpose for the Notice is commendable, I have serious concerns about any rulemaking and/or guidelines that may result.

A one-size application cannot fit all. How claims are structured, including how dependent claims branch out, and how the application body is structured, vary significantly from one technology to another. Even within a single technology, the way the application and claims are written can vary significantly as it depends on the novel aspects of the invention itself and the state of the art.

I wish one easy single application format would work for all types of inventions, as it would make my job easier and patent application drafting more economically accessible to applicants. Although my practice primarily relates to biotech, chemical, and pharmaceutical inventions, besides the countless bio/chem/pharma applications I have written and prosecuted, I have written and prosecuted a handful of software applications, prosecuted many semiconductor applications, prosecuted some mechanical applications, written and prosecuted many medical device applications, and written and prosecuted a good number of microfluidic and nanotech applications. With all of these different applications, I try to start with a basic template, but then deviate because of the particular aspects of the invention and the need to present the invention in the best manner in view of the situation (e.g., art, experiments, intended actor/user, licensee, etc.).

The primary effect the PTO wants is to achieve is to streamline examination, and make it such that an Examiner doesn't have to spend a lot of time figuring out the invention. Trying to make things that are all shapes and sizes fit in the same small box will not help. It will not help some patent attorneys/agents who write incoherently be better writers. It will not help foreign inbound

applications that are English translations not have translation issues. It will not help examiners understand what is beyond their ability to understand. It will not help examiners manage their time better.

It is possible that an invention may be so novel and ground-breaking that a standard application format may not adequately allow the invention and its novel aspects to be truly presented. Hindsight gives us plenty of examples, i.e., the first biotech cases with a biological sequence, the first antibody, or the first monoclonal antibody, etc. What happens when one must force such an invention into a box that is two sizes too small? The result would likely be a disservice to inventors and innovators. What will happen if the application is not packaged according to USPTO rules and/or guidelines? What effect will the noncompliance have on patentability and validity at the USPTO and in the courts?

Regarding the specific issues for comments, I respectfully submit:

1. "The boundaries of patent protected subject matter should be clearly delineated and the scope of each claim made clear on filing of a patent application ..."

This is already a requirement under 35 U.S.C. 112.

2. "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."

Claims are just like sentences. They can be written in different ways, e.g., the format of a sentence need not always be subject-verb. One sentence format may more accurately convey the information in a manner better than another sentence format.

3. "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."

Requiring such may substantially raise the costs (attorney/agent fees) for patent preparation and prosecution to that which is cost-prohibitive for some, if not all.

4. "Indicating whether examples in the specification are intended to be limiting or merely illustrative."

Case law is clear. Claims define the meets and bounds of the invention. If some element is meant to be a claim limitation, it should be set forth in the claims.

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

Patent attorneys are not likely willing to indicate, at the time of filing or early in prosecution, that a preamble is intended to be a limitation. Further, pro se applicants will not likely appreciate the legal issues and downstream ramifications of such.

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.”

A requirement for C-like pseudo-code, or XML, or UML will likely be a substantial burden on all types of applicants for all types of inventions. For example, there are many biotech/pharma applications that disclose an algorithm intended to be implemented with a computer. To write and prosecute such an application, one would have to keep on top of the many rules for compliance for “software disclosures” and these types of requirements will likely make some applications cost-prohibitive for many applicants as multiple attorneys (or vendors) would be required to draft a compliant application, e.g., a biotech app which has some algorithms (need a biotech patent attorney, someone to ensure algorithm compliance, someone to do the sequence listing if not the attorney, draftsperson for drawings, etc.).

7. “Indicating whether terms of degree--such as substantially, approximately, about, essentially--have a lay or technical meaning and explaining the scope of such terms.

… 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.

… 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.”

Terms are supposed to have their plain and ordinary meaning unless indicated otherwise in the specification. Requiring one to provide dictionary definitions and glossaries for every term claimed (and potential future limitations) would likely result in a significant cost burden to applicants by way of increased attorney fees, and likely extra page fees.

Summarizing above, not all patent attorneys and not all Examiners are created equal and no amount of application format standardization will make a better patent attorney or examiner. Any additional amount of standardization has the potential to be detrimental and more costly to applicants.

Thank you for this opportunity to comment.

Best regards,
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The opinions and actions expressed herein are mine and should not be attributed to any other person or client of Smith, Gambrell & Russell, LLP.

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