



DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

[Docket No.: PTO-P-2013-0041]

Glossary Pilot Program

AGENCY: United States Patent and Trademark Office, Commerce.

ACTION: Notice

SUMMARY: The United States Patent and Trademark Office (USPTO or Office) is initiating a Glossary Pilot Program to study how the inclusion of a glossary section in the specification of a patent application at the time of filing the application improves the clarity of the patent claims and facilitates examination of patent applications by the USPTO. Currently, there is no requirement that a glossary section be provided by an applicant as part of the patent application specification. In order to participate in the Glossary Pilot Program, an applicant will be required to include a glossary section in the patent application specification to define terms used in the patent application. The pilot is testing to see if definitions in the glossary section enhance patent quality and improve the clarity of patent claims, by enabling the USPTO and the public to more fully understand the meaning of the patent claims. This notice outlines conditions, eligibility

requirements, and guidelines of the pilot program, which will govern acceptance of an application into, and examination under, the Glossary Pilot Program. Applications accepted into this pilot program will receive expedited processing by placing them on an examiner's special docket prior to the first Office action, and will have special status up to issuance of a first Office action.

DATES: Effective Date: June 2, 2014.

Duration: The Glossary Pilot Program will run for six months from its effective date or until the USPTO accepts 200 grantable petitions under this pilot program, whichever occurs first. The USPTO may extend the pilot program (with or without modification) for an additional six months. The USPTO reserves the right to terminate the pilot program at any time.

FOR FURTHER INFORMATION CONTACT: Seema Rao, Director Technology Center 2100, by telephone at 571-272-0800; by facsimile transmission to 571-273-0800; or by electronic mail at seema.rao@uspto.gov.

SUPPLEMENTARY INFORMATION:

I. Background.

On June 4, 2013, the White House Office of the Press Secretary issued a press release titled "FACT SHEET: White House Task Force on High-Tech Patent Issues," which listed a series of Legislative Recommendations and Executive Actions "designed to protect innovators from frivolous litigation and ensure the highest-quality patents in our system." See The White House

Web site at <http://www.whitehouse.gov/the-press-office/2013/06/04/fact-sheet-white-house-task-force-high-tech-patent-issues>. Executive Action 2 relates to developing strategies to improve claim clarity, specifically with regard to functional claiming in the context of software, such as by the use of glossaries in patent application specifications.

In response to this executive action, the USPTO sought public input on the idea of using glossaries to improve claim clarity, particularly a pilot program focused on the use of glossaries in patent applications. The USPTO held a Software Partnership Meeting on October 17, 2013, at U.C. Berkeley School of Law about Strategies for Improving Claim Clarity through the use of glossaries that included presentations from the USPTO and members of the public. The meeting announcement, agenda, presentations, and video transcript of the meeting are available on the USPTO Web site at http://www.uspto.gov/patents/init_events/glossary_initiative.jsp. Eight written comments were received and also are available on the Web site at the above link. After considering the public input, the USPTO designed the Glossary Pilot Program outlined herein to be flexible, accommodate various application drafting styles, and provide useful glossary information for examiners to utilize during examination.

II. Glossary Pilot Program Structure.

Applicants who wish to participate in the Glossary Pilot Program must provide, upon the filing date of an eligible patent application: (1) a petition to make special using Form PTO/SB/436 (titled “Certification And Petition To Make Special Under The Glossary Pilot Program”); and (2) a formal glossary section as part of the patent application specification. Form PTO/SB/436 is available at http://www.uspto.gov/patents/init_events/glossary_initiative.jsp. Use of this form

will help the USPTO to quickly identify Glossary Pilot Program submissions and facilitate timely processing of such submissions. The Office of Management and Budget (OMB) has determined that, under 5 CFR 1320.3(h), Form PTO/SB/436 does not collect “information” within the meaning of the Paperwork Reduction Act of 1995.

No fee is required for submission of petitions using Form PTO/SB/436. The \$130.00 fee for a petition under 37 CFR 1.102 (other than those enumerated in 37 CFR 1.102(c)) is hereby sua sponte waived for petitions to make special based upon the procedure specified in this notice.

As explained further in Section III of this notice, the glossary section should contain definitions of claim terms as well as any other terms applicant deems appropriate that satisfy the requirements of this notice. The requirements placed upon glossary definition submissions are designed to promote participation by providing participants the flexibility to select which terms to define and how best to define the selected terms. Receiving a variety of glossary submissions from different participants will afford the USPTO the opportunity to evaluate their effectiveness in clarifying claim language. The pilot program will be limited to certain software-related technology examination areas within the USPTO.

The Glossary Pilot Program will run for six months or until the USPTO accepts 200 grantable petitions under this pilot program, whichever occurs first. Applications eligible for participation in the pilot program must be classified in technological fields that fall under the examination jurisdiction of USPTO Technology Centers 2100, 2400, and 2600 or the Business Methods area of Technology Center 3600. In order for the USPTO to accept an application into the pilot

program, the application must meet all of the conditions and requirements set forth in Section III of this notice, and applicant also must submit a completed Form PTO/SB/436. The USPTO may reevaluate the workload and resources needed to administer the pilot program at any time. The USPTO will provide notice of any substantive changes to the program at least thirty (30) days prior to implementation of the change.

Applications that meet the conditions and requirements of this notice will be accepted into the Glossary Pilot Program. Although new patent applications are normally taken up for examination in the order of their United States filing date, applications accepted into this pilot program will receive expedited processing by placing them on an examiner's special docket prior to the first Office action, and will have special status up to issuance of a first Office action. These applications will then be placed on the examiner's regular amended docket after applicant's response to the first Office action, unless designated special in accordance with another established procedure (e.g., Accelerated Examination, Prioritized Examination, Special Based on Applicant's Age, etc.).

III. Conditions And Requirements For Participation In The Glossary Pilot Program.

A. Conditions: A petition to make special under the Glossary Pilot Program (Form PTO/SB/436) will be granted in an application if the requirements in Section III.B and the following conditions are all satisfied:

(1) The application must be: (a) an original, non-reissue, non-provisional utility application filed under 35 U.S.C. 111(a) that does not claim the benefit of a prior filed U.S. application (i.e.,

cannot be a continuation or divisional application), except the application can claim benefit of a provisional application; or (b) a continuation-in-part application claiming the benefit of a prior non-provisional utility application under 35 U.S.C. 120 or 365(c) filed for the purposes of providing a glossary in accordance with this program. The application cannot be an international application, national stage application filed under 35 U.S.C. 371, design application, or plant application. Further, the application cannot also participate in any Patent Prosecution Highway (PPH) program.

(2) Upon filing, the application must contain a specification in the English language including a glossary section that meets all the Requirements in section III.B of this notice.

(3) Upon filing, all benefit and priority claims must be included in an application data sheet (see 37 CFR 1.76 and 1.78). If the application claims priority to one or more foreign applications, a copy of each such foreign application must be submitted concurrently with the filing of the application. If any prior-filed application (U.S. or foreign) is not written in the English language, an English-language translation of such prior-filed application must be submitted concurrently with the filing of the application with a statement that the translation is accurate. This requirement is intended to assist the examiner, by ensuring that the examiner is timely provided with the documentation needed to confirm that the definitions in the glossary are supported in the priority document(s). In order to make and perfect benefit and priority claims, the application must still satisfy all applicable conditions and regulations, including 37 CFR 1.55, 1.76, and 1.78.

(4) A completed Form PTO/SB/436 (titled “Certification And Petition To Make Special Under The Glossary Pilot Program”) must be filed concurrently with the filing of the application.

Form PTO/SB/436 is available at

http://www.uspto.gov/patents/init_events/glossary_initiative.jsp.

(5) Upon filing, the application must contain at least one claim, but no more than four independent claims, and thirty total claims. The application must not contain any multiple dependent claims. For applications containing more than four independent claims or thirty total claims, or any multiple dependent claims, applicant must file a preliminary amendment in compliance with 37 CFR 1.121 canceling the excess claims and/or the multiple dependent claims at the time the application is filed.

(6) In order to be eligible for the Glossary Pilot Program, the application must be classified in one of the U.S. patent classifications (USPCs) examined by USPTO Technology Centers 2100, 2400, or 2600 or the Business Methods area of Technology Center 3600 when the petition decision is rendered. The USPTO Office of Patent Classification provides listings of the USPCs that are examined by particular art units, and makes these listings available at

<http://www.uspto.gov/patents/resources/classification/index.jsp>, under the heading

“Relationships between classifications and organizations.” The applicant may not know the classification of the application at the time of filing the application. The USPTO will determine whether this requirement is satisfied once the application is in condition for examination and the petition is being decided.

(7) The application and all follow-on papers must be filed via EFS-Web.

(8) If applicant also requests advancement of examination based on another established procedure (e.g., Accelerated Examination, Prioritized Examination, Special Based On Applicant's Age, etc. in addition to the Glossary Pilot Program), then the application must satisfy all of the conditions and requirements of the other procedure(s), including payment of any fees required by the other procedure(s), in addition to the conditions and requirements specified herein for the Glossary Pilot Program. For example, if applicant is requesting participation in both the Glossary Pilot and Accelerated Examination programs, then the application must comply with the lower claim cap (i.e., 3 or fewer independent claims and no more than 20 claims total) for the Accelerated Examination program in order to be accepted into both programs.

B. Requirements: A timely petition to make special under the Glossary Pilot Program (Form PTO/SB/436) will be granted in an application that satisfies all the conditions of Section III.A and complies with all the following requirements:

(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 limits 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 record. Suggestions for definitions include key claim terminology (such as a term with a special definition), substantive terms within the context of the invention, abbreviations, acronyms, evolving technological nomenclature, relative terms, terms of degree, and functional terminology including 35 U.S.C. 112(f) functional limitations (previously 35 U.S.C. 112, sixth paragraph). If a definition is provided in the glossary for any 35 U.S.C. 112(f) functional limitations, then an additional suggestion would be to include the

identification of the corresponding structure for performing the claimed function, in addition to any disclosure of the structure elsewhere in the specification.

C. Decision on Petition to Make Special Under the Glossary Pilot Program (Form PTO/SB/436):

If applicant files a petition using Form PTO/SB/436, the USPTO will decide the petition once the application is ready for examination. If the petition is granted, the application will receive expedited processing up until the time of the first Office action, in accordance with all applicable laws, regulations, and policies. In particular, the application will be placed on the examiner's special docket prior to the first Office action, and will have special status up to issuance of the first Office action. Thereafter, the application will be placed on the examiner's regular amended docket, unless designated special in accordance with another established procedure (e.g., Accelerated Examination, Prioritized Examination, Special Based On Applicant's Age, etc.).

If applicant files an incomplete Form PTO/SB/436, or if an application accompanied by Form PTO/SB/436 does not comply with the requirements set forth in this notice, the USPTO will notify the applicant of the deficiency by issuing a notice, and applicant will be given only one opportunity to correct the deficiency, if correctable. If applicant still wishes to participate in the Glossary Pilot Program, applicant must make appropriate corrections within one month or thirty (30) days of the mailing date of the notice, whichever is longer. The time period for reply is not extendable under 37 CFR 1.136(a). If applicant fails to correct the deficiency indicated in the notice within the time period set forth therein, the application will not be eligible for the Glossary Pilot Program, and the application will be taken up for examination in accordance with standard examination procedures, unless designated special in accordance with another

established procedure (e.g., Accelerated Examination, Prioritized Examination, Special Based On Applicant's Age, etc.). An originally-filed glossary providing explicit definitions on the record will control the interpretation of the relevant claim terms, whether or not the petition is granted.

D. Interviews: Standard interview practice and procedures applicable to regular *ex parte* prosecution will be available for applications participating in the Glossary Pilot Program. Applications accepted into the Glossary Pilot Program that also participate in the First Action Interview (FAI) Pilot Program must meet all the requirements and procedural limitations of the FAI Pilot Program.

E. Examination: During examination, in applications claiming benefit of an earlier application under 35 U.S.C. 119, claims that include terms defined in the glossary section will be examined to ensure they comply with the requirements of 35 U.S.C. 112(a) in order to determine their effective filing date in accordance with standard examining procedure. An applicant cannot subsequently disavow the meaning of any term that has already been defined in the glossary section submitted on filing. Except for the correction of typographical errors, the glossary definitions cannot be amended or deleted during examination. The examiner will consider the glossary section as controlling for the meaning of the terms defined in the glossary section.

Dated: March 24, 2014.

Michelle K. Lee
Deputy Under Secretary of Commerce for Intellectual Property and
Deputy Director of the United States Patent and Trademark Office

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