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October 5, 2007

The Honorable John Doll
Commissioner for Patents
The United States Patent and Trademark Office

Re: A Patent Agent's Comments on USPTO's Proposal of "Examination of Patent Applications That Include Claims Containing Alternative Language"
Proposed rules published in the Federal Register/ August 10, 2007

Dear Commissioner Doll,

We are a patent agent office in Israel, part of a British company.
This contribution is based on our experience in patenting and engineering R&D.
Goal: To define inventions more precisely and unambiguously.
The contribution relates to two issues: Solving alternative language inherent in commonly used words in a language, and a new claims structure which is precise, concise and suitable for automatic processing.

1. We found there is ambivalence inherent in the English language, and indeed in any Language. A word may have several meanings. A patent claim containing one or more such words may render the claim ambiguous.
The patent system is now international, and should take into account patents in other languages such as Japanese, Chinese, Russian, German, Korean, etc. This is important in translations filed with new applications, and also in patent searches. It is difficult to preserve the precise meaning of words in a translation; some meanings may be lost, new meanings added.

Also problematic is the ruling that "applicants are their own lexicographers" per MPEP 2173.01 . This goes as far as permitting "Terms used contrary to their ordinary meaning" per MPEP 2173.05(a)III.
From our experience, such license causes much unnecessary work to Examiners and Agents. Each time a claim is evaluated, it should be read together with the disclosure, to ascertain the meaning of the terms there.
How can a patent search be performed, when each patent uses different terminology? How can automatic tools be used?

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The proposed solution:

A. Applicants should be required to use standard, accepted terms, preferably with reference to accepted standards, i.e. in English - Webster's or Collins. A scientific approach should be taken in patenting: in science, every term is precisely defined. All the scientists and engineers in a field, worldwide, recognize the meaning of such terms as voltage, permeability, mass, gravity.

Rationale:
a. USPTO has determined that only a reasonable number of cited prior art references should be filed; filing too many references is an attempt to obfuscate matters, to hide the actually relevant prior art.
Similarly, it can be argued that using special rather than standard terms is an attempt to present an invention as special, when in truth it is not.

b. If the terms are not clear and exact, the applicant fails in his duty to disclose the invention. 35 U.S.C. 112 does not permit the applicant to invent new words, but requires that "The specification shall contain a written description... in such full, clear, concise and exact terms..." .

c. Indeed, this is to break with the past, but Patent Offices are paying now a heavy price for this license; it may have helped inventors in the past, when there were not libraries available nor the Internet. It is not fit in the information age, and considering the multitude of prior art patents.

d. In the UK IPO new Test for Patentability, backed by the Court of Appeal, the first step is to properly construe the claim. Indeed, how can the invention be evaluated if the claim is unclear? And how can it be clear when the words' meaning is ambiguous?

B. For non-standard terms in evolving new technologies per MPEP 2173.05(a)II, the applicant should try to use terms from other patent applications, technical literature, etc. - and to show such attempts in the application.
Each new term should be clearly and precisely defined using standard terms.
Rationale: In the unlikely case that a new word has to be coined, the applicant can still look in a dictionary and use standard words to define it.

C. Each significant term in a claim should also be given a classification number. For example, "barrel" as a nautical term, to distinguish from its use in drinks or weapons. The assigned number accompanies each term during translation, so there are no meanings lost nor added. If necessary, a term may be assigned a plurality of numbers.
Rationale: The meaning(s) of each term can be precisely controlled, despite peculiarities in any specific language. The system is international.

D. Compliance with the above requirements should be checked at filing. If found lacking, the applicant should be required to file corrections.
Rationale: Patent applications which are not true invention disclosures should be filtered out at an early stage, to save work and resources in filing, managing, searching, examination, correspondence, etc.

E. If the applicant claims there is no prior art: when reaching examination, the applicant should be required to correct the terms he uses, referring to the prior art found by the Examiner. To amend "the examiner ... is encouraged to suggest alternatives that are free from objection" in MPEP 2173.05(a)II.
Rationale: It is applicant's, not Examiner's, duty to clarify the invention. This will level the field to facilitate the examination using standard terms.

F. Applications which do not comply with the above requirements should not be published and should not be cited as prior art.
Rationale: Only actual invention disclosures are prior art. A scientific approach - Technical articles are also being reviewed prior to publication. Accumulating unclear prior art only adds Sisyphic work at the Patent Office.

G. USPTO may help inventors find the suitable terms in each field, providing for example a dictionary or a visual dictionary online - a worthy investment.

2. New method for drafting claims

At present, patent claims are drafted in a storytelling approach, to tell a story in the author's own style, more concise or verbose as he may seem fit. No automatic means can be used to compare claims, only a human can read the sentences there and possibly understand their meaning.

The proposed solution:

A. An addition to the claim should be written in a concise, commonly accepted form, akin a mathematical formula or table. It can define the parts comprising a new system, and the interconnections between them.

Rationale:
a. Such a description may be easier to read - it separates the essential components from ancillary wordage.
b. Sentences may have different structures in various languages. Some changes in meaning may occur in the translation, even when each word in itself is translated correctly. A mathematic formula is understood worldwide.
c. The new method will allow automatic processing of claims, to compare a multitude of claims in a multitude of patents, very fast.
Quantitative results may be obtained, to indicate the measure of likeness, or

difference, between different inventions.

B. The description itself may also contain such a concise description, in addition to the regular parts. This creates clear, precise, well defined links between the description and the claims.

C. A system drawings may be made to also contain such a concise description. For example, a block diagram may be described in mathematical form as a bi-dimensional table, one dimension detailing the topology and the other dimension - the text in the blocks there.

D. A method drawings may be made to also contain such a concise description. For example, a flowchart may be described in mathematical form as a bi-dimensional table, one dimension for the topology and one for the text.

Benefits:

a. This is an attempt to overcome peculiarities in a language, relating to sentences building and understanding. Such sentences may be ambivalent or unclear. Claims may be verbose. The new concise claim form is international.

b. The new approach will pave the way to using automatic tools to aid in the substantive examination process, now performed manually.
Automatic comparison of claims, description and drawings can be performed.

c. A concise expression can be used together with well-defined terms, to expedite the examination, reduce the backlog and achieve higher quality patents. Examiners can exchange results to prevent a duplication of efforts.

Notes: The above-presented method is patent pending.
The moral right of the authors has been asserted.
If the USPTO accepts our method, we shall be honored to grant USPTO a free license to use it on its premises. An infringement study should be performed.

Respectfully submitted,

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