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June 2, 2015

Hon. Michelle K. Lee  
Under Secretary of Commerce  
U.S. Patent and Trademark Office  
Alexandria, Virginia  
via email: [WorldClassPatentQuality@uspto.gov](mailto:WorldClassPatentQuality@uspto.gov)

Re: *Supplement to Testimony submitted May 6, 2015, styled as  
“Drafting, the 800 Pound Gorilla Outside the Regulatory Cage”,  
Testimony Responsive to the Request for Comments on Enhancing  
Patent Quality, 80 Federal Register 6475 (February 5, 2015)*

Dear Ms. Lee:

Further to my testimony referenced above, attached please find a draft of *Limelight Spotlight*: This paper focuses upon patent licensure including reforms for the current system of practitioner registration and the adequacy *vel non* of the *Manual of Patent Examining Procedure* as a tool to teach patent drafting.

“Patent quality” and your “Glossary Initiative” are also highlighted in *Limelight Spotlight*.

*Limelight Spotlight* is presently a draft paper that is being circulated as such with the idea that if you or other experts wish to comment on any point in the draft that requires further elaboration or clarification, input would be welcome.

*Limelight Spotlight* includes a discussion of the importance of patent quality and suggests ways to enhance the ability of the new quality leader to effectively perform her duties. See § IV-G, *The Patent “Quality Czarina”* (pp. 33-34).

*Limelight Spotlight* also includes a discussion of your “Glossary Initiative”. See § III-A, *The Glossary Initiative, the Emperor’s New Clothes* (pp. 16-17).

If you or your colleagues have any comments you wish to share, they would be most welcome. Please let me know when I may expect to receive such comments.

Thank you very much for your continued public service.

Respectfully submitted,

*Hal Wegner*

Harold C. Wegner

**From:** Hal Wegner [email redacted]  
**Sent:** Tuesday, June 02, 2015 11:49 AM  
**To:** WorldClassPatentQuality  
**Subject:** Patent Quality Testimony and a new paper, "Limelight Spotlight", focusing on Licensure Reforms

Hon. Michelle K. Lee  
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Dear Ms. Lee:

Further to my testimony referenced above, attached are comments and a draft paper, *Limelight Spotlight*, that focuses upon critical aspects relating to patent quality.

Thank you very much for your continued public service.

Respectfully submitted,

Harold C. Wegner

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# ***LIMELIGHT SPOTLIGHT***

## **Failure of Statutory Patent Licensure<sup>\*</sup>**

Harold C. Wegner

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<sup>\*</sup>This is a discussion draft for comment only. This version June 3, 2015.

This work is a *pro bono* effort of the writer that is without sponsorship from any person or organization including any law firm or corporate organization.

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## Wegner, *Limelight Spotlight*

### I. OVERVIEW

Just as the early twentieth century coal miner carried a caged canary into the depths of the mine to see whether it would succumb to carbon monoxide poisoning – the trigger announcing the presence of this poisonous gas – *Limelight Networks, Inc. v. Akamai Techs., Inc.*, 134 S. Ct. 2111 (2014), is the “patent canary”, the signal to the patent community that the licensure system is broken as *thousands* of patents have suddenly become recognized as worthless. *See* § II, *The Limelight Canary in the Patent Coal Mine*.

This paper explores the patent licensure system that ensured what happened in *Limelight* and – without major changes in the system – will create future “Limelights” where costly patent mistakes are made at the forefront of American technology at its intersection with the patent system. *See* § III, *PTO Failure to Teach Patent Drafting*. A critical aspect to the current problems is directly attributable to the radical departure from a licensure examination that had required patent drafting skills. *See* § IV, *Agency Licensure to Practice Patent Law*.

A variety of options are open to the Patent Office to modify the current licensure system to better ensure that the imprimatur of licensure provides a realistic assurance to the public that each patent practitioner is “possessed of the necessary qualifications to render to applicants \* \* \* valuable \* \* \* advice \* \* \* before the Office” as set forth in the Leahy Smith America Invents Act. Leahy Smith America Invents Act, 35 U.S.C. § 2(b)(2)(D). *See* § V, *Reforms Beyond Practitioner Candidate Education*.

## II. THE *LIMELIGHT* CANARY IN THE PATENT COAL MINE

*Limelight* bluntly demonstrates that the patent licensure system is broken. The Patent Office *may* require licensure of practitioners who appear before the Agency, which it in fact has done since the first statutory authorization to do so during the Great Depression. Those who gain registration licensure carry the imprimatur of the Agency that they do, indeed, possess the “necessary qualifications” to draft and prosecute patent applications.

Little more than a generation ago the licensure examination was a real test of patent drafting skills: A Candidate for licensure was required to *actually draft patent claims* as part of the licensure examination. Two things happened at about the same time. First, the Office abolished any test for practical drafting skills while newly minted practitioners long on software science but short on law – and untrained in patent drafting – started the internet method patenting era thanks to the second development, the holding in *State Street Bank & Trust Co. v. Signature Financial Group, Inc.*, 149 F. 3d 1368 (1998), that internet business method claiming is to patent-eligible subject matter under 35 USC § 101. *See* § III-A, *State Street Bank Start of the Business Method Patent Era*.

## Wegner, *Limelight Spotlight*

### A. *State Street Bank* Start of the Business Method Patent Era

For nearly a decade beginning in the late twentieth century there was a growing flood of multi-step internet business method patents filed, often without regard to whether a single direct infringer (alone or with its agent) performed all steps of the claim. This era of uncertainty commenced with *State Street Bank*, a green light that business methods are patent eligible, and ended when a panel of the Federal Circuit said that *yes* a direct infringer must perform “all elements” of the claimed invention.

Internet business method claims became popular already in the last century, spurred on by the Federal Circuit opening the door to patent-eligibility for this modern technology in *State Street Bank*. It took several years for the first wave of patents to be granted and then several more for the Federal Circuit to reach a decision whether an internet method claim with plural steps has a direct infringer when one actor performs (or directs) less than all the steps of the claim. Nine years after *State Street Bank* the Federal Circuit reached the issue in *BMC Res., Inc. v. Paymentech, L.P.*, 498 F.3d 1373, 1380 (Fed. Cir. 2007). It concluded that where less than “all elements” of the claim are practiced by an individual (or his agent), that individual is not a direct infringer. The final nail in the coffin as far as public attention was concerned was the Supreme Court decision in *Limelight* which did not address the direct infringement issue. The coffin remained shut as to direct infringement in the remand in *Limelight Networks* where a split panel reaffirmed the holding in *BMC v. Paymentech*. See *Akamai Techs., Inc. v. Limelight Networks, Inc.*, \_\_\_F.3d \_\_\_ (Fed. Cir. 2015).

## Wegner, *Limelight Spotlight*

Just as the death of a canary in the coal mine was a signal to miners to flee the poisonous atmosphere, so, too, did *Limelight* broadcast far and wide the failure of the Patent Office to properly teach patent drafting as so many thousands of internet method claims were effectively killed by poor “wordsmithing”.

### **B. The Post-*State Street Bank* Business Method Patenting Flood**

*State Street Bank!* The brand new field of software patenting of “business methods” exploded on the scene with the Federal Circuit holding that as to business method software patents, such “[c]laims should not be categorized as methods of doing business. Instead such claims should be treated like any other process claims.” *State Street Bank*, 149 F. 3d at 1377.

*State Street Bank* sent a clear signal to the software industry to race to the Patent Office to file applications on all manner of software technology. It was not the specific *holding* of patent-eligibility but rather the broad statement of patent-eligibility for software technology that was important.

(It must also be remembered that there was peace in the Supreme Court patent valley where the last major patent-eligibility decisions was the *Diehr* case that predated the commencement of the Federal Circuit, and where a computer-implemented invention was held patent-eligible in *Diamond v. Diehr*, 450 U.S. 175, 188 (1981). It was more than a decade after *State Street Bank* and nearly thirty years after *Diehr* that the Supreme Court changed course and tightened the belt on software patent-eligibility in *Bilski v. Kappos*, 561 U.S. 593 (2010); but, by then the rush to patent software had long been in full swing.

## Wegner, *Limelight Spotlight*

*State Street Bank* created the urgent need for software engineers to enter the patent field to draft the many patent applications needed to satisfy the business interests of the software industry. One after another, experienced software experts passed the patent licensure examination, armed with a bunch of answers to multiple choice questions that left them without patent drafting skills. It is no wonder that so many software patent applications of the era have beautifully crafted technical explanations of their inventions but with only secondary – if at all – focus on proper patent draftsmanship.

Just shortly before *State Street Bank* the Patent Office effectively abandoned test for – and thus any incentive for bar review schools to train for – how to draft patent claims. The current examination system differs radically from the system used until the 1990's, prior to *State Street Bank*. Up until that time the candidate was given an essay question that tested his actual ability to draft claims keyed to a hypothetical invention disclosure. It was not a matter of *identifying* a point in the *Manual* that was the focus of the question: Rather, the Candidate was forced to *draft claims* for the hypothetical invention. There was furthermore a sufficient point value for the claim drafting exercise such that failure to draft proper claims meant that the Candidate would fail the examination. As a result, the patent bar review courses included a focus on practical claim drafting skills.

## Wegner, *Limelight Spotlight*

As a result of the abdication of testing for practical patent drafting skills, it is no wonder that patent drafting proficiency for the current generation has gone downhill. As the new generation of Ph.D software and biotechnology engineers and scientists have taken over the drafting of the high technology inventions of the current era they have utilized their expertise to draft intricate and scientifically accurate descriptions of the embodiments of the inventions entrusted to their draftsmanship – but at the expense of the fundamentals of what it takes to draft a proper patent application.

As the current generation of newly minted patent practitioners has for the most part gained their licensure *without* any meaningful study of how to draft a patent application it has become more of a hit or miss proposition whether claims are procured that cover their business needs of their inventors.

The common denominator for far too many of the internet method patents filed in the years following *State Street Bank* was a simple narrative claim that described each of the steps without regard to whether there was a direct infringer or not. Thus, a remote terminal banking invention might involve a customer at a remote cash machine terminal transmitting a signal to the bank whereupon the bank's central computer would "crunch" the information and then send a signal back to the remote terminal that would trigger an information display or dispense cash. A narrative explanation transformed into claim language would thus read:

## Wegner, *Limelight Spotlight*

A method for a customer to procure cash at a remote terminal from a bank which comprises:

- (a) the customer transmits a first signal from the remote terminal to the bank;  
and
- (b) a central computer crunches the information generated by the first signal whereupon the bank transmits a second signal to the customer whereupon cash is generated for the customer at the remote terminal.

As a matter of patent law dating back to the nineteenth century “all elements” of a claimed invention must be practiced by a direct infringer, so, *here*, the narrative claim has no direct infringer and there is thus no patent infringement of this narrative claim.

Rather, proper wordsmithing requires that the steps be recast under the “all elements” rule so there is a single direct infringer. For example, in the narrative claim example above, the customer could be the direct infringer by voicing all the steps to the customer’s actions:

A method for a customer to procure cash at a remote terminal from a bank which comprises:

- (a) the customer transmits a first signal from the remote terminal to the bank;  
and
- (b) **the customer receives a signal from** a central computer **which has crunched** the information generated by the first signal whereupon the bank **has transmitted** a second signal to the customer whereupon cash is generated for the customer at the remote terminal.

## Wegner, *Limelight Spotlight*

### C. The Failed *Limelight* Approach, “Worst Practices”

The *Limelight* issue was new for internet method claims in the sense that *Limelight* is fact-specific to internet process inventions. Otherwise, it is just another application of the “all elements” rule that to find direct infringement, the infringer must perform each and every element of the claimed combination. The “all elements” precedents date back to the early nineteenth century and became entrenched as a bedrock principle of the Federal Circuit in *Pennwalt v. Durand-Wayland*, 833 F.2d 931 (Fed. Cir. 1987)(en banc)).

*Pennwalt* broke no new legal ground but in turn was a reaffirmation of a series of Supreme Court cases dating back to the early nineteenth century. In the wake of *State Street Bank*, there were only two possible outcomes to the question whether the narrative method claim with different actors would reach a result of infringement. *First*, under the *Pennwalt* case the likely answer – which the Federal Circuit ultimately chose – was that there is no infringement without a single direct infringer of all the elements (or where some of the elements are performed under his direction. *Second*, it was an open question whether “joint infringement” would be found. But, no matter *which* outcome could have been predicted it was clear that the only safe course of action was to operate under the assumption that *Pennwalt* would be followed for internet method claims. Since the choice of whether to follow *Pennwalt* was simply one of wordsmithing, the only correct answer at the time was to follow the *Pennwalt* solution.

## Wegner, *Limelight Spotlight*

While it is certainly true that at the time there was no *definitive* answer to the question whether there is direct infringement in the factual setting of the *Limelight* case, it is also true that that the issue was well understood. While no one could accurately predict at that time what the Federal Circuit or the Supreme Court would say in a test case, at the same time a safe course of action was known very early on. Indeed, the Federal Circuit petitioner to the Federal Circuit leading to the en banc consideration of that case described the problem as one of “wordsmithing”. Donald R. Dunner *et al.*, *Combined Petition for Panel Rehearing and Rehearing En Banc of Plaintiff-Appellant Akamai Technologies, Inc.* Not later than 2003 his partner and popular patent circuit lecturer Thomas Irving warned his followers of this “common patent drafting error[ ]”. Ken Hobday, *The Incredibly Ever-Shrinking Theory of Joint Infringement: Multi-Actor Method Claims*, 38 Cap. U.L. Rev. 137 (2009)(citing Thomas Irving in 2003 as speaking “passionately about common patent drafting errors” in situations such as later occurred in *Limelight*).

Already in 2001 the “all elements” rule was discussed in the context of internet claiming at a major international conference in Tokyo featuring later to be Under Secretary of Commerce David Kappos and then Circuit Judge Rader. See Harold C. Wegner, *E-Business Patent Infringement: Quest for a Direct Infringement Claim Model* 14 (SOFTIC 2001 Symposium) (noting the need to draft claims to have “a single, direct infringer for every claim”), available at [http://www.softic.or.jp/symposium/open\\_materials/10th/en/wegner-en.pdf](http://www.softic.or.jp/symposium/open_materials/10th/en/wegner-en.pdf)

**D. *BMC v. Paymentech*, the Bombshell a Decade after *State Street Bank***

Given that the backlog of patent applications in the examination queue particularly for emerging technologies such as software and further that, *after* going through this queue and gaining a patent, it then takes several years for a patent infringement suit to wend its way up to the Federal Circuit, it was only in 2007 that the Federal Circuit dropped its *BMC v. Paymentech* bombshell decision that the narrative internet claim lacks a direct infringer, whereupon there is no infringement at all.

*BMC v. Paymentech* was truly explosive within the software patent engineering community. A large segment of that group had run afoul of the “all elements” rule. Intellectual Property Owners took up the cause for the patentees who have been left with worthless claims: “[T]he advice on better claiming is cold comfort for owners of the many thousands of already-issued patents.” Unsuccessful brief *amicus curiae* of the Intellectual Property Owners Association supporting petition for rehearing en banc in *Muniauction, Inc. v. Thomson Corp.*, 532 F.3d 1318, 1327 (Fed.Cir.2008)(discussing the statement by the Court in *BMC Resources*, 498 F.3d at 1381, that proper claim drafting avoids the single infringer issue).

In her analysis of what she correctly sees as the pioneering software technology in the *Limelight* case, Circuit Judge Moore points out that “[w]ithout the innovative technology protected by the [Akamai] patent-in-suit, the Internet as we know it would not exist.” *Akamai Technologies, Inc. v. Limelight Networks, Inc.*, \_\_\_ F.3d \_\_\_, \_\_\_ (Fed. Cir. 2015)(Moore, J., dissenting), *on remand from Limelight Networks, Inc. v. Akamai Techs., Inc.*, 134 S. Ct. 2111 (2014).

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Given that the domestic software patent drafters were unaware of the “all elements” rule, the impact of *BMC v. Paymentech* and *Limelight* was devastating. As quoted by Circuit Judge Moore:

"[The *Limelight* rule that follows *BMC v. Paymentech*] improperly and unnecessarily renders worthless an entire class of interactive method patents and will undermine the public's confidence in patents and in the patent system as a whole." *Id.* (quoting Brief of Amicus Curiae Boston Patent Law Association)

"[*BMC* and *Muniauction*] have changed the law to create a gaping hole in liability for patent infringement' and the *Akamai* panel decision has 'destroyed thousands of duly issued patent claims.' *Id.* (quoting Brief of Amicus Curiae Cascades Ventures, Inc.)

"[S]trict application of the single entity rule 'encourages collusion among collaborating parties to escape infringement liability[,] eviscerates a large number of method patent claims in the field of personalized medicine, as well as many other fields, and significantly weakens the U.S. patent system.'" *Id.* (quoting Brief of Amicus Curiae Myriad Genetics, Inc.)

"[T]his Court's single entity rule invites would-be infringers to circumvent a particularly valuable subset of biotechnology patents by 'dividing up' steps of patented methods for separate practice, and avoiding the kinds of formal legal relationships that were only recently established by this Court as a predicate to infringement liability." *Id.* (quoting Biotechnology Amicus Brief)

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"Without judicial recourse, the 'direction or control' standard will render thousands of socially valuable and otherwise valid process patents unenforceable." *Id.* (quoting Stacie L. Greskowiak, *Joint Infringement After BMC: The Demise of Process Patents*, 41 LOY. U. CHI. L.J. 351, 403 (2010))

"[M]any thousands of patents may become worthless under the stringent 'control or direction' standard set forth in the *Muniauction* decision." *Id.* (quoting Alice Juwon Ahn, *Finding Vicarious Liability in U.S. Patent Law: The "Control or Direction" Standard for Joint Infringement*, 24 BERKELEY TECH. L.J. 149, 171 (2009)).

"The loophole [created by *BMC*] is a serious one. It encourages potential infringers of process patents to enter into conspiracies to circumvent infringement liability by dividing steps among the parties so long as there is no controlling or directing party." *Id.* (quoting Long Truong, *After BMC Resources, Inc. v. Paymentech, L.P.: Conspiratorial Infringement as a Means of Holding Joint Infringers Liable*, 103 NW. U. L. REV. 1897, 1899 (2009))

"The [*Muniauction*] decision creates a catch-22 situation because it is unlikely for vicarious liability relationships to exist across the Internet. Due to *Muniauction*, not only are many Internet software patents now unenforceable, but many other network and communication patents may also be unenforceable." (*Id.* quoting Dolly Wu, *Joint Infringement and Internet Software Patents: An Uncertain Future?*, 91 J. PAT. & TRADEMARK OFF. SOC'Y 439, 441 (2009))

### III. PTO FAILURE TO TEACH PAENT DRAFTING

It is unfair to blame *Limelight* on the software engineers who joined the patent profession in the late 1990's and thereafter because to become licensed as practitioners because the Patent Office touts the *Manual of Patent Examining Procedure* as the source for how to study for the patent examination and, indeed, the Patent Office repeatedly stresses this nearly 3700 page tome as the source of knowledge for patenting at the Patent Office. It is difficult to conceive of a more more archaic or incomprehensible document than the *Manual of Patent Examining Procedure*. See § III-A, *The Glossary Initiative, the Emperor's New Clothes*.

Beyond the absence of coherent instructions on patent drafting, the Candidate for licensure is not forced to study patent drafting at all as there is a paucity of questions on the licensure examination dealing with patent drafting. See § III-B, *What the Newly Minted Practitioner Knows about Drafting*. An experienced professor will explain to his class the five or six or so important topics that *must* be studied for a final examination, and test on, say, two or three. In this way the candidate focuses on *all* the potential subjects. The patent licensure examination stands naked as to the paucity of patent drafting questions. There clearly is no need to study patent drafting to prepare for the test. See § III-C, *Patent Drafting Skills are not Required for Licensure*. All in all, in the end, the *Limelight* problem boils down to English language usage. When it comes to patent infringement, it's always been a question of "wordsmithing." See § III-D, *Bottom line, it's "Wordsmithing!" It's all about the "words"*.

## Wegner, *Limelight Spotlight*

### A. The *Glossary Initiative*, the Emperor's New Clothes

"[The Emperor] was very proud of his new, magical suit. At first, people gasped when they saw a nearly-naked Emperor walking through the town. Then they remembered that only fools couldn't see these magical clothes, so they began cheering and congratulating the Emperor on a magnificent suit of clothes. Suddenly, one small child spoke the truth. She pointed at the Emperor and said, 'The Emperor is only wearing his underwear.' Everyone in the crowd gasped."

Hans Christian Anderson, THE EMPEROR'S NEW CLOTHES (1837)

The conventional wisdom is that the *Manual of Patent Examining Procedure* is a monumental tome that is the source of all wisdom from the Patent Office on how to draft and prosecute a patent application.

The *Manual of Patent Examining Procedure* is monumental in terms of its vast length of nearly 3700 pages, but miniscule as to what it teaches as to patent drafting. In the principal section relevant to patent drafting, MPEP § 608.01, when stripped down to exclude reproductions from the statute and the *Rules of Practice in Patent Cases*, contains only a scant few words of advice directed to practitioners – all of which is reproduced in an appendix to this paper.

The obscurity of the *Manual of Patent Examining Procedure* is manifested by the many months of trials of the “glossary initiative” of the incumbent Under Secretary in charge of the Patent Office. See the Appendix, *Glossary Initiative and the Summary of the Invention*. In essence, the Under Secretary has proposed that a section be devoted to a “glossary” as part of her *Glossary Initiative*, a collection of definitions of elements of the claimed invention. What the Under Secretary and her colleagues in the leadership of the Office have failed to acknowledge is that the *Summary of the Invention* should be the place for definitions. In the exposition of

## Wegner, *Limelight Spotlight*

the reasons for definitions there is no mention that definitions are useful for the applicant to cabin an otherwise “broadest reasonable interpretation” of terms in trials at the Patent Trial and Appeal Board. While the applicant may not want definitions for all terms, certainly at the point of novelty the ability to cabin the “broadest reasonable interpretation” can be valuable.

Beyond the shortcomings of the *Glossary Initiative* and its failure to deal with the *Summary of the Invention* one may well ponder whether *any* of the leadership of the Patent Office over the past sixty (60) years has considered this particular section in detail as a featured item of the *Summary of the Invention* is the requirement to disclose the “nature” of the invention. This was a statutory requirement at the time of the First Edition of the *Manual* but has not been a part of Title 35 of the United States Code since December 31, 1952.

The *Summary of the Invention* is not unique in the *Manual* for anachronistic requirements or points out of touch with “best practices”, but is given only as one example.

### **B. What the Newly Minted Practitioner Knows about Drafting**

The patent drafting proficiency of a newly minted practitioner – agent or attorney – is zero or next to zero, if all that practitioner has done is to study for and pass the registration examination. The examination is “difficult” only in the sense that the candidate to pass must focus upon a very minute fraction of the 3700 electronic pages of the *Manual of Patent Examining Procedure* to learn the *Manual* interpretation of the fact areas to which the examination is directed.

## Wegner, *Limelight Spotlight*

In fact, passing the examination requires *zero* practical patent drafting skills to answer the questions that may be relevant to questions relevant as to how to draft a patent application. In at least one test that was randomly sampled, only six (6) percent of the questions were relevant to the patent drafting process, and none of the six questions required more than memorization of terms for multiple choice answers – and if the candidate is aware of the portions of the *Manual* used for the test, he will have plenty of time to look up the appropriate *Manual* portion *because the examination is open book*. Patent bar review courses tout their laser focus on the test question issues: If the candidate quickly skims the examination and answers right off the bat, say, fifty questions in 90 minutes, this leaves 270 minutes to verify answers to twenty questions – or nearly fifteen (15) minutes each in the well-indexed *Manual*. As the multiple choice questions are constructed in a manner where the Candidate can cull obviously wrong answers from the selection of five choices, guessing as to the remaining thirty questions should provide a safety margin for anyone to pass the examination.

## Wegner, *Limelight Spotlight*

### C. Patent Drafting Skills are not Required for Licensure

To be sure, to make the examination a simple exercise the Candidate needs to know the *Patent Office interpretation* of the law as stated in its “bible”, the *Manual of Patent Examining Procedure*. But, what does this “patent bible” say, for example, about patent infringement issues of claim drafting?

<b><i>Relevant MPEP Index Citations to “All Elements” Rule</i></b>	
Infringement	NONE <sup>a</sup>
Divided Infringement	NONE
Joint Infringement	NONE

<sup>a</sup> Cf. MPEP 2204, *Time for Filing Prior Art or Section 301 Written Statements* (timing of submissions under 35 USC § 301 including when patent is in litigation)

What does it say about the leading cases on the “all elements” rule?  
Nothing, absolutely nothing (as seen from the chart on the following page):

## Wegner, *Limelight* Spotlight

<b>Relevant MPEP Index “All Elements” Rule Citations</b>	
Case	Cites
<i>Barrett v. Hall</i> , 2 F.Cas. 914 (No. 1047)(D. Mass. 1818)	NONE
<i>Brooks v. Fiske</i> , 56 U.S. (15 How.) 211 (1853) <sup>b</sup>	NONE
<i>Prouty v. Draper</i> , 41 U.S. (16 Pet.) 335 (1842) <sup>b</sup>	NONE
<i>Vance v. Campbell</i> , 66 U.S. (1 Black) 427 (1861) <sup>b</sup>	NONE
<i>Gould v. Rees</i> , 82 U.S. (15 Wall.) 187 (1872) <sup>b</sup>	NONE
<i>Dunbar v. Myers</i> , 94 U.S. (4 Otto) 187 (1876) <sup>b</sup>	NONE
<i>Water-Meter Co. v. Desper</i> , 101 U.S. (11 Otto) 332 (1879) <sup>b</sup>	NONE
<i>Case v. Brown</i> , 69 U.S. (2 Wall.) 320 (1864) <sup>b</sup>	NONE
<i>Gill v. Wells</i> , 89 U.S. (22 Wall.) 1 (1874) <sup>b</sup>	NONE
<i>Fuller v. Yentzer</i> , 94 U.S. (4 Otto) 288 (1876) <sup>b</sup>	NONE
<i>Gage v. Herring</i> , 107 U.S. (17 Otto) 640 (1882) <sup>b</sup>	NONE
<i>Fay v. Cordesman</i> , 109 U.S. 408 (1883) <sup>b</sup>	NONE
<i>Rowell v. Lindsay</i> , 113 U.S. 97, 102 (1885) <sup>b</sup>	NONE
<i>Sargent v. Hall Safe &amp; Lock Co.</i> , 114 U.S. 63 (1885) <sup>b</sup>	NONE
<i>Brown v. Davis</i> , 116 U.S. 237 (1886) <sup>b</sup>	NONE
<i>Yale Lock Mfg. Co. v. Sargent</i> , 117 U.S. 373 (1886) <sup>b</sup>	NONE
<i>McClain v. Ortmyer</i> , 141 U.S. 419 (1891) <sup>b</sup>	NONE
<i>Wright v. Yuengling</i> , 155 U.S. 47(1894) <sup>b</sup>	NONE
<i>Black Diamond Coal v. Excelsior Coal</i> , 156 U.S. 611 (1895) <sup>b</sup>	NONE
<i>Cimiotti Unhairing v. American Fur Ref.</i> , 198 U.S. 399 (1905) <sup>b</sup>	NONE
<i>Pennwalt v. Durand-Wayland</i> , 833 F.2d 931 (Fed. Cir. 1987)(en banc))	NONE <sup>c</sup>
<i>Warner-Jenkinson Co. v. Hilton Davis Chemical Co.</i> , 520 U.S. 17 (1997)	NONE <sup>d</sup>
<i>BMC Resources v. Paymentech</i> , 498 F.3d 1373 (Fed. Cir. 2007)	NONE
<i>Muniauction, Inc. v. Thomson Corp.</i> , 532 F.3d 1318 (Fed. Cir. 2008)	NONE
<i>Akamai Tech. v. Limelight Networks</i> , 629 F.3d 1311 (Fed. Cir. 2011) <sup>e</sup>	NONE

<sup>b</sup> cited in *Pennwalt v. Durand-Wayland*, 833 F.2d 931, 949-51 (Fed. Cir. 1987)(en banc)) (Nies, J., additional views)

<sup>c</sup> Cf. MPEP § 2184, *Determining Whether an Applicant Has Met the Burden of Proving Nonequivalence After a Prima Facie Case Is Made* [R-11.2013](on line version last visited May 28, 2015)(“[U]nless an element performs the identical function specified in the claim, it cannot be an equivalent for the purposes of 35 U.S.C. 112(f) . . . .”)(citing *Pennwalt*)

<sup>d</sup> MPEP 2183 , *Making a Prima Facie Case of Equivalence*; MPEP § 2184, *Determining Whether an Applicant Has Met the Burden of Proving Nonequivalence After a Prima Facie Case Is Made*; MPEP § 2186, *Relationship to the Doctrine of Equivalents*

<sup>e</sup> *Overturned*, 692 F.3d 1301 (Fed. Cir. 2012)(en banc) rev’d, *Limelight Networks, Inc. v. Akamai Techs., Inc.*, 134 S. Ct. 2111 (2014), *subsequent proceedings on remand, Akamai Technologies, Inc. v. Limelight Networks, Inc.*, \_\_\_ F.3d \_\_\_ (Fed. Cir. 2015)

## Wegner, *Limelight Spotlight*

Thus, the patent examination does not follow the pattern of the typical state bar examination. When an attorney at law has just passed a state bar examination he has had at least three years of full time legal education and undoubtedly taken a meticulous bar review course. A well drafted bar examination includes a wide variety of subjects which may or may not be tested in a particular year. The point of providing a diversity of topics is to ensure that both the law school and the bar review course each cover these several topics. Whether a new attorney ever studies any of these subjects again may or may not be the case, but the well crafted bar examination ensures that all the basic course work is covered.

And what patent drafting skills are tested on the licensure examination?

<b>October 2003 Patent Registration Examination Contents of the Test</b>	
Specification: “Background of the Invention”	0 %
Specification: “Summary of the Invention”	0 %
Specification: “Detailed Description of the Invention”	0 %
Specification: “Abstract of the Disclosure”	0 %
Claims: <i>Pennwalt</i> “All Elements” Rule	0 %
Claims: Subgeneric Definition Support Issues	0 %
Claims: Prosecution History Estoppel	0 %
Claims: Doctrine of Equivalents	0 %
Claims: Technical Issues <sup>a</sup>	6 %
All Other issues beyond Patent Drafting <sup>b</sup>	94 %
<sup>a</sup> The six questions involved antecedent basis in independent claim (morning session Question 33); transition phrase (morning session Question 40; afternoon session Question 44); multiple dependent claiming (morning session Question 41); dependent claims under 35 USC § 112 ¶ 4 (morning session Question 43); dependent claim must limit earlier claim (morning session Question 49).	
<sup>b</sup> E.g., technical filing requirements; patentable subject matter, novelty and nonobviousness (35 USC §§101-103) and all issues relating to prosecution.	

## Wegner, *Limelight Spotlight*

Even though the newly minted patent practitioner may not know anything about patent drafting when he commences his career as a patent draftsman, the obvious answer is that he will learn his mistakes through the feedback of the patent examiner when his claims are rejected. But, this will not be the immediate case because the applications drafted today will often not get their first action on the merits for two or three years. In the meantime, the patent practitioner has developed a routine, a set of habits in patent drafting untested in the crucible of examination.

Thus, the patent examination does not follow the pattern of the typical state bar examination. When an attorney at law has just passed a state bar examination he has had at least three years of full time legal education and undoubtedly taken a meticulous bar review course. A well drafted bar examination includes a wide variety of subjects which may or may not be tested in a particular year. The point of providing a diversity of topics is to ensure that both the law school and the bar review course each cover these several topics. Whether a new attorney ever studies any of these subjects again may or may not be the case, but the well crafted bar examination ensures that all the basic course work is covered.

## Wegner, *Limelight Spotlight*

### C. Bottom line, it's "Wordsmithing!" It's all about the "words".

As concluded by Professors Donald S. Chisum and Janice M. Mueller, the "problem" in the *Limelight* is one that can be avoided through "clear and thoughtful drafting of both method and system claims ...." *Takeaways from Seattle Summer 2014 Seminars*, Chisum Patent Academy (blast email August 23, 2014).

The patentees in *Pennwalt* and *Akamai* both came up short because they didn't master the right wording for their claims. Indeed, the use of the English language is critical to claiming success. Beyond the "all elements" rule switching a two or three letter preposition can make all the difference in the unforgiving world of patent interpretation. *Chef America, Inc. v. Lamb-Weston, Inc.*, 358 F.3d 1371 (Fed. Cir. 2004), is perhaps the most extreme example where the use of "to" in the claim (instead of "at") made an otherwise perfectly reasonable claim nonsensical: The inventor developed a flash baking process to produce a flaky dough product where the raw dough was exposed very briefly to near incineration temperatures. But, instead of claiming heating "at" the very high temperature the claim reciting heating "to" that high temperature: Now, the patentee was left with a process where the product was not a delightful bakery product but ashes.

#### IV. AGENCY LICENSURE TO PRACTICE PATENT LAW

##### A. Imprimatur of Agency Licensure

Patent Office licensure gives the registered patent practitioner the Agency's imprimatur that he is "possessed of the necessary qualifications to render to applicants \* \* \* valuable \* \* \* advice \* \* \* before the Office[.]" *Leahy Smith America Invents Act*.\*

Agency licensure at the Patent and Trademark Office: Just what does the imprimatur of Agency licensure at the Patent Office really convey? In theory, one could come up with the thought that the person has years of experience in a technical field of importance to an individual scientist or engineer and years of legal experience. Or, at least *some* technical skills in the area of interest and at least some period of training in patent legal skills, just as a new lawyer has extensive legal education and has passed a difficult State bar examination.

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\* *Leahy Smith America Invents Act*, 35 U.S.C. § 2(b)(2)(D) ("SPECIFIC POWERS.— The Office ... may establish regulations, not inconsistent with law, which ... may govern the recognition and conduct of agents, attorneys, or other persons representing applicants or other parties before the Office, and may require them, before being recognized as representatives of applicants or other persons, to show that they are of good moral character and reputation and are possessed of the necessary qualifications to render to applicants or other persons valuable service, advice, and assistance in the presentation or prosecution of their applications or other business before the Office[.]").

## Wegner, *Limelight Spotlight*

The reality does not match the imprimatur.

The patent Agency examination for registration today is far different from little more than a generation ago when a candidate for licensure had to pass a very difficult test that included an actual patent drafting question where the Candidate had to *actually draft a patent claim*. Licensure today provides a faux imprimatur that the practitioner has patent drafting skills. (Today, there is a *de minimis* focus on anything to do with actual drafting of applications and, for whatever few questions there are, they are of sufficient point value to deny registration even if all such questions are missed. All questions in any event are multiple choice where a best guess will ensure a correct answer for a significant number of the questions.)

A registered practitioner is also fully licensed to be lead counsel at trials at the Patent Trial and Appeal Board. Such trials are the new creation of the *Leahy Smith America Invents Act*. A licensed practitioner is automatically given the imprimatur to be a lead counsel at such trials even though that person need have absolutely no legal training in court or other trial procedures. The licensure examination has *never* tested the trial skills of a Candidate who could be, for example, a twenty-one year old freshly minted B.S. in engineering with not even a glimmer of an idea of ever attending law school. The licensure examination has neither testing for nor does the Office provide in its *Manual* any teaching materials for how to practice as a trial attorney.

## **Wegner, *Limelight Spotlight***

Finally, licensure carries the imprimatur of technical abilities to deal with complex technical issues of importance to the brave new worlds of advanced biological sciences and the ever more complex world of software engineering. Yet, a traditional B.S. in engineering in the “old” fields that permit an understanding of how to make a muffler is sufficient for the registration imprimatur to deal with the most complex high technology issues of the current era. If one possesses a Ph.D. in complex molecular biology and has had, say, ten years in the laboratories in this specialty, that person when licensed as a registered practitioner has had no test to ensure abilities in software engineering, yet the licensure does not indicate a specialty so that this Ph.D. in complex molecular biology has the full imprimatur of licensure to draft software patents.

### **B. The Three-Fold Guild Exclusion to Limit the Profession**

In most fields of practice before the Federal Government the Administrative Procedure Act permits representation by counsel without special licensure requirements. This permits the best and the brightest lawyers to enter Agency practice almost everywhere *but* the patent field to practice their craft.

At the Patent Office there is an arbitrary exclusion to even *sit* for the registration examination to those who, with exceptions not statistically relevant, can establish that they have had a certain number of college credit hours in an arbitrary list of subjects. The alternative of showing, for example, a high score on the Graduate Record Examination in a particular engineering or science field is not an option to showing proficiency in a technical field.

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The registration examination is a second, artificial barrier to becoming a registered practitioner. The test *is* difficult in the sense that one cannot take the examination, cold, and expect to pass – or even to pass with a few months study (without a preparation course). This is because the registration examination is a multiple choice test where one has to study a roughly 3700 page *Manual of Patent Examining Procedure* to pass the examination. (But, the preparation courses essentially guarantee passing the examination on the first or second try because the practitioner test focuses on roughly five percent of the content of the *Manual* with repeating test issues on the examination.)

The third barrier is citizenship and residency which precludes the many registered practitioners of foreign nationality to maintain active registration unless they have reside in the United States with certain visa status. Hundreds of highly experienced practitioners from abroad, licensed as patent attorneys in their own countries, have spent several months or years in the United States and have been licensed to practice in America, but upon returning to their home countries surrender their active licensure (unless they are American citizens).

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### D. The Artificially Small Pool of Skilled Talent for American Industry

The three-fold licensure discrimination has devastating implications for the American inventor.

In the first instance, the American inventor should have the confidence in a governmental imprimatur of licensure that the licensed practitioner is able, for example, to help the software engineer with his most complex and difficult patent trial in defense of his patent rights. Yet, the imprimatur extends to someone without any legal training (e.g., the twenty-one year old B.S. graduate with zero legal skills) nor relevant engineering skills (e.g., the Ph.D. in biotechnology who has spent ten years as a post-doctoral scientist). Even the day to day gristmill of patent drafting is open to the new B.S. graduate who has never even been tested nor studied patent drafting.

In the second place, the practitioner licensure barrier *is* real to exclude even technically trained lawyers, particularly the most skilled trial lawyers at the top of their profession. Precisely *why* would the very top trial lawyer choose to become a patent trial attorney by setting aside a significant chunk of time to learn the test questions for the patent licensure examination? If trial attorneys were permitted to be lead counsel at patent trials at the Agency they would bridge the ever widening gap within the patent field between registered practitioners who for the most part keep their noses to the grindstone of daily preparation and prosecution of patent applications vis a vis patent trial lawyers in the trial courts who have become a clear class above the practitioner bar. (Why is integration of the two practice areas important: Think about *Limelight*! If there were integration of the two practice areas the top patent trial lawyers would have appreciated the direct infringer issue

## Wegner, *Limelight Spotlight*

and educated their Agency practitioner colleagues and avoided the *Limelight* disaster.)

In the third place, denial of licensure to overseas practitioners means that the major overseas corporations that file many *tens of thousands* of patent applications each year are excluded from “home country” representation before the Agency. If practitioner licensure were open, for example, to the skilled Japanese *benrishi* who have *also* been registered to practice in the United States (but have become inactive upon returning to Japan because of their citizenship), then an appreciable number of American patent applications of *foreign* origin would be principally represented by overseas based licensed practitioners.

As things stand today, several major law firms that have a high standing among domestic industries each file a few *thousand* patent applications per year *for foreign applicants*. If the foreign applicants were able to shift their work to local registered practitioners this would then open the door for broader use of these top American firms for *domestic* patent interests.

### **E. Winners and Losers**

The winners of the practice exclusions are the Agency-licensed practitioners who are pleased with the guild-like exclusion that limits the profession. Their talents are highly sought after and expensive due to the scarce supply of experienced talent. The losers include the American economy where domestic industry is deprived of the best patent talent so that as in *Limelight* valuable, exclusive rights are lost. The losers include the individual inventor, the academic research community and American industry at large: Each must compete for precious legal talent keyed to the artificial scarcity of talent.

**F. Whither a “Manual of Patent *Drafting* Procedure”**

But, the licensure process is a failure as to certification of patent drafting skills because essentially *no* substantive patent drafting skill is required to pass the patent registration examination. This means that the preparatory courses do not focus on drafting skills because to do so would dilute efforts to ensure that the candidates pass the examination: All efforts are devoted to teaching how to pass the *examination* aspects of the licensure examination.

The problem of the licensure process also resides to a great extent upon the overwhelming emphasis the Patent Office in its testing procedure places upon it *Manual of Patent Examining Procedure*. But, as seen from the title, this is NOT a “*Manual of Patent Drafting Procedure*”. Virtually nothing in MPEP § 608.01 of the main Chapter 600 has anything to do with teaching how to *draft* a patent application.

There examples where the *Manual of Patent Examining Procedure* comes up short in its treatment of drafting skills:

1. The *Manual*, instead of teaching that the claims represent the centerpiece of the application, gives no clue that it is imperative that the claims *always* be drafted ahead of the *Summary of the Invention* and other complementary portions of the application. Any other drafting technique turns the drafting process upside down where the claims are matched to the rest of the specification and notice versa as should be done.

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2. The *Manual*, instead of teaching that the disclosure *as filed* should have generic claims of decreasing scope, suggests that such telescoping claims *should* be submitted but that this can be done in response to the first action which would create a “written description” problem for new supporting language. See MPEP 608.01(m), *Form of Claims* (“[E]ach applicant [should] include[ ], at the time of filing or no later than the first reply, claims varying from the broadest ... to the most detailed that he or she is willing to accept.”)
3. The *Manual*, instead of teaching that in an unpredictable technology plural examples should be given, is silent as to the need to *disclose* plural representative examples *in the original specification* even though obvious from in view of a single example provided by the inventor. *Abbvie Deutschland GmbH & Co. v. Janssen Biotech, Inc.*, 759 F.3d 1285, 1299-1300 (Fed. Cir. 2014)(Lourie, J.).
4. The *Manual*, instead of teaching the “all elements” rule for direct infringement, is silent on this point. See generally *Pennwalt Corp. v. Durand-Wayland, Inc.*, 833 F.2d 931 (Fed. Cir. 1987) (en banc); *TecSec, Inc. v. IBM Corp.*, 731 F.3d 1336 (Fed.Cir. 2013)(Reyna, J., dissenting).
5. The *Manual* teaches neither that the *Summary of the Invention* should have a verbatim recitation of the elements of the claimed invention, including a specific definition of an element at the point of novelty to cabin an otherwise “broadest reasonable interpretation” in a patent trial at the Patent Office.
6. The *Manual*, instead of teaching that the *Summary of the Invention* should preferably name plural alternatives to a single exemplified embodiment to avoid a narrowed claim construction, is silent on this point. *Honeywell Intern., Inc. v. United States*, 596 F.3d 800, 816 (Fed. Cir. 2010)(Mayer, J., dissenting in part)(quoting *LizardTech, Inc. v. Earth Res. Mapping, Inc.*, 424 F.3d 1336, 1345 (Fed.Cir.2005).

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7. The *Manual*, instead of teaching that the “best mode requirement” is met by a good faith effort to set forth the best mode, fails to mention that the *Leahy Smith America Invents Act* eliminated the best mode defense to patent infringement and, in any event, authorizes the filing of a continuation-in-part to *add* the best mode contemplated without forfeiture of priority to the original application.
8. The *Manual*, instead of teaching that the elements of the invention should be consistently described in identical wording of claims throughout, in the *Summary of the Invention, Detailed Description of the Invention* and *Abstract of the Disclosure*, says nothing about the need for consistent wording. See, e.g., *Tate Access Floors, Inc. v. Maxcess Technologies, Inc.*, 222 F.3d 958, 965 n.2 (Fed. Cir. 2000)(citing *Hill-Rom Co. v. Kinetic Concepts, Inc.*, 209 F.3d 1337, 1341 n.\* (Fed. Cir. 2000))
9. The *Manual*, instead of teaching that a *Background of the Invention* can create problems of admission of prior art, there is no mention of this difficulty. The *Manual*, instead of teaching that disclosing the “gist” of the invention has no statutory meaning, simply suggests that the “gist” can be disclosed. *Aro Manufacturing Co. v. Convertible Top Replacement Co.*, 365 U.S. 336, 345 (1961)( “In determining obviousness, there is ‘no legally recognizable or protected ... ‘gist’ ... of the invention.’” )
10. The *Manual*, instead of teaching that the Rule requiring disclosure of the “nature” of the invention has lacked a statutory basis since January 1, 1953, is silent on this point. See P. J. Federico, *Commentary on the New Patent Act* [1954], reproduced at 75 J. Pat. And Trademark Off. Soc’y 161, 201-02 (1993).

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11. The *Manual*, while not pointing out that the “field” of the invention has no statutory value, fails to note that if the applicant identifies a particular “field” of the invention which is common to the most pertinent prior art, this may have negative implications as to nonobviousness.
12. The *Manual*, instead of teaching that the *Abstract of the Disclosure* should use verbatim language taken from the claims to avoid an admission that results in a narrowed scope of interpretation, fails to mention the narrowed construction that can be given to claims through failure to use verbatim language. See *Hill-Rom Co. v. Kinetic Concepts, Inc.*, 209 F.3d 1337, 1341 n.\* (Fed. Cir. 2000)(Bryson, J.); *Tate Access Floors, Inc. v. Maxcess Technologies, Inc.*, 222 F.3d 958, 965 n.2 (Fed. Cir. 2000).

### G. The Patent “Quality Czarina”

Quality patents.

This should be a primary goal of the Patent Office, to issue quality patents. Under Secretary of Commerce Michelle K. Lee has emphasized her recognition of the importance that the Office issue only quality patents. One of her latest moves in recognition of this focus is the creation of a “Quality Czarina” leadership position near the top of the Agency, more formally the Office of Deputy Commissioner for Patent Quality.

[http://www.uspto.gov/patents/init\\_events/Deputy\\_Commissioner\\_for\\_Patent\\_Quality.jsp](http://www.uspto.gov/patents/init_events/Deputy_Commissioner_for_Patent_Quality.jsp) (last visited June 1, 2015).

The Quality Czarina “manages and leads the Patent Organization’s quality initiatives. [The person] is responsible for sustaining the high quality of the USPTO’s patent examination processes and products by implementing and maintaining a comprehensive quality management system.” *Id.*

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A condition precedent to a quality patent is a quality patent *application* that is filed in the first instance. It does no good to monitor the procurement process without first tackling the fundamental point that there must be quality patent applications filed in the first place. For there to be a true quality initiative that in the end is successful in establishing a track record for establishing quality patents there are three conditions that are vital to the undertaking for the person holding the Quality Czarina position.

First, the Office must create a *Manual of Patent Drafting Procedure* which has more than the ten pages of drafting material in the current *Manual of Patent Examining Procedure*. Second, the Office must restructure the registration examination to provide critical test questions with a high point value that test *actual drafting expertise*. There is nothing extraordinary or revolutionary about a drafting exercise on the examination. This was the normal situation until the early 1990's. Third, the Office must give the "Quality Czarina" a Czar-like ability to intervene in activities of the Office to ensure quality draftsmanship.

But, the three steps outlined here go only part of the way. It ensures that there is a quality patent *if the best prior art was cited in the application or found by the Examiner*. More important than a formally proper document is the issue whether the claims as granted are novel and nonobvious. Here, there is nothing that can be done from a quality review standpoint until the results at the Patent Trial and Appeal Board in their patent trials become known. Here, the Quality Czarina must be able to intervene in the work of the PTAB to monitor what it does and evaluate the quality of patents from the perspective of novelty and nonobviousness.

## V. REFORMS BEYOND PRACTITIONER CANDIDATE EDUCATION

### A. Automatic Licensure for Attorneys at Law

The whispered fear of the Agency-licensed practitioner is that if lawyers without licensure were permitted to practice at the Patent Office that they would overwhelm the field and take bread away from the table of the narrowly focused patent practitioner.

The patent user community should be so lucky.

The experience from abroad is that although members of the legal profession are often admitted as a matter of right into the local patent profession, very few choose to go this route.

Thus, if the global experience is any indication of what would happen if patent Agency representation were opened to members of the general bar, there is nothing to fear as to the daily practice of drafting and prosecuting patent applications. In Germany the *Rechtsanwälte* and in Japan the *Bengoshi* – the “lawyers” – have a right to practice before their national patent offices with establishment neither of technical skills nor patent practice skills. Very, very few choose to practice at the Agency level in their countries.

If general lawyers did choose to go into patents on a large scale, the European Patent Office would be flooded with *Rechtsanwälte* plying their trade in Munich. The practitioner who *does* choose to practice at the Agency is the exception.

But, the *Rechtsanwalt* who practices at the European Patent Office is a great rarity. Another exception is Eiji Katayama, renowned as one of the leading *Bengoshi* in his country with an expertise in bankruptcy law who was, for example,

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counsel in the reorganization of Japan Air Lines. Yet, he is *also* a leading patent practitioner by virtue of his *Bengoshi* status where he has a specialty in pharmaceutical patents where he has no technical training. (He *does* have an engineering degree from Kyoto University.) Yet, Mr. Katayama's own practice in patents is focused on complex proceedings on appeal. But, his law firm *does* have a substantial local Agency practice that benefits from the integration of both *Bengoshi* and the *Benrishi* of the local patent bar.

### **B. Continued Agent Registration under the "Old" System**

There will always be a need for patent practitioners who, for whatever reason, are not law school graduates. The patent registration examination should be *continued* under the procedure that was used up until the 1990's.

*First*, the examination should be given only once or twice per year, instead of on a daily basis where the Candidate learns whether he has passed *at the time of the examination* and the Candidate can take – and retake – the examination as often as necessary, provided there is a one month interval between taking each examination.

With a daily examination with instant results and no penalty for retaking the examination month by month there is no great pressure on the candidate to thoroughly study the material.

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**Second**, the examination should be permitted to be taken as a matter of right *only twice*. If the Candidate fails the examination then a petition must be filed to take the examination a third time where the petitioner explains precisely how he has studied since the last examination, detailing the steps he has used to make sure he has mastered the subject matter of the examination.

**Third**, the “Jancin Committee” model should be followed for future tests for measuring skills in patent drafting. Under the leadership of IBM’s representative to the Patent Office, Julius Jancin, also a former President of the American Intellectual Property Law Association, an *ad hoc* committee of patent practice experts from that Association helped create essay questions for the registration examination. While the principal draftsmanship of the questions on claim drafting stayed with the Patent Office, the Jancin Committee, for example, fashioned a difficult “Steenbock question” that tested the Candidate’s ability to understand whether a continuation-in-part claim was barred by the intervening disclosure of the parent application. See *In re Ruscetta*, 255 F.2d 687 (CCPA 1958)(Rich, J.)(citing *In re Steenbock*, 83 F.2d 912 (CCPA 1936)).

**Fourth**, and above all, a concise “Manual of Patent Drafting Procedure” should be created.

### C. Separate Licensure for PTAB Practice

A separate licensure should be crafted for practice at the Patent Trial and Appeal Board, the “PTAB”.

The Patent Office imprimatur that a twenty-one year old, freshly minted patent agent has the ability to be lead counsel in patent trials at the PTAB is ludicrous.

An attorney at law should be *automatically* admitted to practice as a lead counsel at the PTAB in any matter.

A patent agent should be able to be registered to practice upon establishing special procedural skills necessary for such practice. There is precedent for special licensure of patent agents based upon the Japan model:

Historically, in Japan the general lawyer, the *bengoshi*, could be automatically licensed to practice in the field of the *benrishi*, the patent attorney, while the *benrishi* could not appear in court appellate proceedings that were the exclusive realm of the *benrishi*. The Japanese system was modified to permit *benrishi* the qualification to appear in court in appellate proceedings as *fuki-benrishi* but only upon a special licensure that established their facility with legal proceedings in the courts.

#### F. P-Licensure for Five Years

Licensure as a patent practitioner should be provisional for a five year period. This would be identified, for example, by a patent practitioner with the Registration Number of “25,258” as “25,258P”. The work product of a provisionally registered practitioner would be randomly sampled or at the suggestion of a Technology Center Director.

Just as an IRS audit occurs only very infrequently, the *possibility* of such an audit helps mold the conduct of the average taxpayer. So, too, should a “P” registration make the individual practitioner during his first five years conscious that his work can be monitored to provide an incentive to keep studying the practice.

#### G. “Canadian” Reciprocal Licensure

For many years Canadian patent agents have been admitted to practice in the United States *without* an examination. The system works extremely well, as evidenced by the fact that the average American patent practitioner has little if any knowledge of or recognition that the practice exists.

The Canadian model should be carefully studied to see whether similar reciprocal arrangements can be worked out with *at least* Japan and the countries forming the European Patent Convention.

## H. Hardball! The Head in the Sand Option

Attempts to reform the system in the past have met with failure as the Patent Office has played hardball. Indeed, it is largely within the discretion of the Office whether it will pursue reforms such as suggested in this paper. The extreme deference that the judicial system has paid to the Patent Office in its licensure procedures is manifested by the result in *Lacavera v. Dudas*, 441 F.3d 1380 (Fed. Cir. 2006), which speaks for itself.

The issue is not whether the Patent Office has the authority to continue with a head in the sand approach that everything regarding licensure is fine. Rather, the real issue is whether the Patent Office chooses to exercise its discretion to upgrade the licensure situation to avoid more canaries dying in the patent coal mines.

## VI. CONCLUSION

Given the arbitrary nature of the current registration system and the flaws exposed through *Limelight* it is time to seriously study precisely *how* to revamp the current system, and not *whether* to do so. Failure to reform the system is a lose-lose scenario for both the community of patent system users *and* for patent practitioners. For the inventor and other users of the system, the *Limelight* fiasco is self-evident: Without reform the users of the patent system will continue to get uneven service from the practitioner community because the mere fact of the imprimatur today means little. For the patent practitioner, there *will* be reform at some point in time: It is better for the practitioner community to help serve the national interest by improving the system in a way that will help the practitioner community survive, as opposed to a head in the sand approach where the user community takes charge and imposes reforms that will hurt the practitioner community.

APPENDIX I  
MANUAL OF PATENT EXAMINING PROCEDURE  
MPEP § 608.01 DISCLOSURE  
SUBSTANTIVE PATENT DRAFTING INSTRUCTIONS

**Manual of  
PATENT  
EXAMINING  
PROCEDURE**

Original Ninth Edition, March 2014

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The relevant drafting comments in § 608.01 (without quotations of statute or Rules) amount to about three to four printed pages out of the nearly 3700 pages of the *Manual of Patent Examining Procedure*, or a small fraction of one percent of the total volume as set forth on the following page:

**Wegner, *Limelight Spotlight***

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\* Manual of Patent Examining Procedure (Ninth Edition, March 2014), pdf version of each chapter/section used for page count, as downloaded April 23, 2015, <http://www.uspto.gov/web/offices/pac/mpep/index.html>

**MANUAL OF PATENT EXAMINING PROCEDURE  
MPEP § 608.01 DISCLOSURE  
SUBSTANTIVE PATENT DRAFTING INSTRUCTIONS**  
quotations from Title 35 and 37 CFR omitted

**MPEP § 608.01(b) Abstract of the Disclosure**

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**I. GUIDELINES FOR THE PREPARATION OF PATENT ABSTRACTS**

**A. Background**

The Rules of Practice in Patent Cases require that each application for patent include an abstract of the disclosure, 37 CFR 1.72(b).

The content of a patent abstract should be such as to enable the reader thereof, regardless of his or her degree of familiarity with patent documents, to determine quickly from a cursory inspection of the nature and gist of the technical disclosure and should include that which is new in the art to which the invention pertains.

**B. Content**

A patent abstract is a concise statement of the technical disclosure of the patent and should include that which is new in the art to which the invention pertains.

If the patent is of a basic nature, the entire technical disclosure may be new in the art, and the abstract should be directed to the entire disclosure.

If the patent is in the nature of an improvement in old apparatus, process, product, or composition, the abstract should include the technical disclosure of the improvement.

In certain patents, particularly those for compounds and compositions, wherein the process for making and/or the use thereof are not obvious, the abstract should set forth a process for making and/or a use thereof.

If the new technical disclosure involves modifications or alternatives, the abstract should mention by way of example the preferred modification or alternative.

The abstract should not refer to purported merits or speculative applications of the invention and should not compare the invention with the prior art.

Where applicable, the abstract should include the following: (1) if a machine or apparatus, its organization and operation; (2) if an article, its method of making; (3) if a chemical compound, its identity and use; (4) if a mixture, its ingredients; (5) if a process, the steps. Extensive mechanical and design details of apparatus should not be given.

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With regard particularly to chemical patents, for compounds or compositions, the general nature of the compound or composition should be given as well as the use thereof, e.g., “The compounds are of the class of alkyl benzene sulfonyl ureas, useful as oral anti-diabetics.” Exemplification of a species could be illustrative of members of the class. For processes, the type reaction, reagents and process conditions should be stated, generally illustrated by a single example unless variations are necessary.

### C. Language and Format

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The abstract should be in narrative form and generally limited to a single paragraph within the range of 50 to 150 words. The abstract should not exceed 15 lines of text. Abstracts exceeding 15 lines of text should be checked to see that it does not exceed 150 words in length. \*\*\* The form and legal phraseology often used in patent claims, such as “means” and “said,” should be avoided. The abstract should sufficiently describe the disclosure to assist readers in deciding whether there is a need for consulting the full patent text for details.

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### D. Responsibility

Preparation of the abstract is the responsibility of the applicant. Background knowledge of the art and an appreciation of the applicant’s contribution to the art are most important in the preparation of the abstract. \*\*\*

### E. Sample Abstracts

(1) A heart valve which has an annular valve body defining an orifice and a plurality of struts forming a pair of cages on opposite sides of the orifice. A spherical closure member is captively held within the cages and is moved by blood flow between open and closed positions in check valve fashion. A slight leak or backflow is provided in the closed position by making the orifice slightly larger than the closure member. Blood flow is maximized in the open position of the valve by providing an inwardly convex contour on the orifice-defining surfaces of the body. An annular rib is formed in a channel around the periphery of the valve body to anchor a suture ring used to secure the valve within a heart.

(2) A method for sealing whereby heat is applied to seal, overlapping closure panels of a folding box made from paperboard having an extremely thin coating of moisture-proofing thermoplastic material on opposite surfaces. Heated air is directed at the surfaces to be bonded, the temperature of the air at the point of impact on the surfaces being above the char point of the board. The duration of application of heat is made so brief, by a corresponding high rate of advance of the boxes through the air stream, that the coating on the reverse side of the panels remains substantially non-tacky. Under such conditions the heat applied to soften the thermoplastic coating is dissipated after completion of the bond by absorption into the board acting as a heat sink without the need for cooling devices.

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(3) Amides are produced by reacting an ester of a carbonized acid with an amine, using as catalyst an dioxide of an alkali metal. The ester is first heated to at least 75°C under a pressure of no more than 500 mm. of mercury to remove moisture and acid gases which would prevent the reaction, and then converted to an amide without heating to initiate the reaction.

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### MPEP § 608.01(c) Background of the Invention

The Background of the Invention may include the following parts:

(1) Field of the Invention: A statement of the field of art to which the invention pertains. This statement may include a paraphrasing of the applicable U.S. patent classification definitions. The statement should be directed to the subject matter of the claimed invention.

(2) Description of the related art including information disclosed under 37 CFR 1.97 and 37 CFR 1.98: A paragraph(s) describing to the extent practical the state of the prior art or other information disclosed known to the applicant, including references to specific prior art or other information where appropriate. Where applicable, the problems involved in the prior art or other information disclosed which are solved by the applicant's invention should be indicated. See also MPEP § 608.01(a), § 608.01(p) and § 707.05(b).

### § 608.01(d) Brief Summary of Invention

“37 C.F.R. 1.73 **Summary of the invention.** A brief summary of the invention indicating its nature and substance, which may include a statement of the object of the invention, should precede the detailed description. Such summary should, when set forth, be commensurate with the invention as claimed and any object recited should be that of the invention as claimed.”

Since the purpose of the brief summary of invention is to apprise the public \*\*\* of the nature of the invention, the summary should be directed to the specific invention being claimed, in contradistinction to mere generalities which would be equally applicable to numerous preceding patents. That is, the subject matter of the invention should be described in one or more clear, concise sentences or paragraphs. Stereotyped general statements that would fit one application as well as another serve no useful purpose and may well be required to be canceled as surplusage, and, in the absence of any illuminating statement, replaced by statements that are directly on point as applicable exclusively to the case at hand.

The brief summary, if properly written to set out the exact nature, operation, and purpose of the invention, will be of material assistance in aiding ready understanding of the patent in future searches. The brief summary should be more than a mere statement of the objects of the invention, which statement is also permissible under 37 CFR 1.73.

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The brief summary of invention should be consistent with the subject matter of the claims. \*\*\*

### **608.01(g) Detailed Description of Invention**

A detailed description of the invention and drawings follows the general statement of invention and brief description of the drawings. This detailed description, required by 37 CFR 1.71, MPEP § 608.01, must be in such particularity as to enable any person skilled in the pertinent art or science to make and use the invention without involving extensive experimentation. An applicant is ordinarily permitted to use his or her own terminology, as long as it can be understood. Necessary grammatical corrections, however, should be required by the examiner, but it must be remembered that an examination is not made for the purpose of securing grammatical perfection.

The reference characters must be properly applied, no single reference character being used for two different parts or for a given part and a modification of such part. See 37 CFR 1.84(p). Every feature specified in the claims must be illustrated, but there should be no superfluous illustrations.

The description is a dictionary for the claims and should provide clear support or antecedent basis for all terms used in the claims. See 37 CFR 1.75, MPEP § 608.01(i), § 608.01(o), and § 1302.01, and § 2111.01.

For completeness of the specification, see MPEP § 608.01(p).

### **608.01(h) Mode of Operation of Invention**

The best mode contemplated by the inventor of carrying out his or her invention must be set forth in the description. See 35 U.S.C. 112. There is no statutory requirement for the disclosure of a specific example. A patent specification is not intended nor required to be a production specification. *Spectra-Physics, Inc. v. Coherent, Inc.*, 827 F.2d 1524, 1536, 3 USPQ2d 1737, 1745 (Fed. Cir. 1987); *In re Gay*, 309 F.2d 769, 135 USPQ 311 (CCPA 1962). The absence of a specific working example is not necessarily evidence that the best mode has not been disclosed, nor is the presence of one evidence that it has. *In re Honn*, 364 F.2d 454, 150 USPQ 652 (CCPA 1966). In determining the adequacy of a best mode disclosure, only evidence of concealment (accidental or intentional) is to be considered. That evidence must tend to show that the quality of an applicant's best mode disclosure is so poor as to effectively result in concealment. *Spectra-Physics, Inc. v. Coherent, Inc.*, 827 F.2d 1524, 1536, 3 USPQ2d 1737, 1745 (Fed. Cir. 1987); *In re Sherwood*, 613 F.2d 809, 204 USPQ 537 (CCPA 1980).

The question of whether an inventor has or has not disclosed what he or she feels is his or her best mode is a question separate and distinct from the question of sufficiency of the disclosure. *Spectra-Physics, Inc. v. Coherent, Inc.*, 827 F.2d 1524, 1532, 3 USPQ2d 1737, 1742 (Fed. Cir. 1987); *In re Glass*, 492 F.2d 1228, 181 USPQ 31 (CCPA 1974); *In re Gay*, 309 F.2d 769, 135 USPQ 311 (CCPA 1962). See 35 U.S.C. 112 and 37 CFR 1.71(b).

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If the best mode contemplated by the inventor at the time of filing the application is not disclosed, such defect cannot be cured by submitting an amendment seeking to put into the specification something required to be there when the application was originally filed. In re Hay, 534 F.2d 917, 189 USPQ 790 (CCPA 1976). Any proposed amendment of this type should be treated as new matter.

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MPEP 608.01(m), *Form of Claims* (“[E]ach applicant [should] include[ ], at the time of filing or no later than the first reply, claims varying from the broadest ... to the most detailed that he or she is willing to accept.”)

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The form of claim required in 37 CFR 1.75(e) is particularly adapted for the description of improvement-type inventions. It is to be considered a combination claim. The preamble of this form of claim is considered to positively and clearly include all the elements or steps recited therein as a part of the claimed combination.

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### 608.01(n) Dependent Claims [R-11.2013]

#### I. MULTIPLE DEPENDENT CLAIMS

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Generally, a multiple dependent claim is a dependent claim which refers back in the alternative to more than one preceding independent or dependent claim.

35 U.S.C. 112(e) ... authorize[s] multiple dependent claims in applications as long as they are in the alternative form (e.g., “A machine according to claims 3 or 4, further comprising ---”). Cumulative claiming (e.g., “A machine according to claims 3 and 4, further comprising ---”) is not permitted. A multiple dependent claim may refer in the alternative to only one set of claims. A claim such as “A device as in claims 1, 2, 3, or 4, made by a process of claims 5, 6, 7, or 8” is improper. 35 U.S.C. 112 allows reference to only a particular claim. Furthermore, a multiple dependent claim may not serve as a basis for any other multiple dependent claim, either directly or indirectly. These limitations help to avoid undue confusion in determining how many prior claims are actually referred to in a multiple dependent claim.

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### **III. INFRINGEMENT TEST**

The test as to whether a claim is a proper dependent claim is that it shall include every limitation of the claim from which it depends 35 U.S.C. 112(d) ... or in other words that it shall not conceivably be infringed by anything which would not also infringe the basic claim. Another requirement is that the dependent claim must specify a further limitation(s) of the subject matter claimed.

A dependent claim does not lack compliance with 35 U.S.C. 112(d) ... simply because there is a question as to the significance of the further limitation added by the dependent claim.

Thus, for example, if claim 1 recites the combination of elements A, B, C, and D, a claim reciting the structure of claim 1 in which D was omitted or replaced by E would not be a proper dependent claim, even though it placed further limitations on the remaining elements or added still other elements.

Examiners are reminded that a dependent claim is directed to a combination including everything recited in the base claim and what is recited in the dependent claim. It is this combination that must be compared with the prior art, exactly as if it were presented as one independent claim.

#### **MPEP § 608.01(o) Basis for Claim Terminology in Description**

The meaning of every term used in any of the claims should be apparent from the descriptive portion of the specification with clear disclosure as to its import; and in mechanical cases, it should be identified in the descriptive portion of the specification by reference to the drawing, designating the part or parts therein to which the term applies. A term used in the claims may be given a special meaning in the description. See MPEP § 2111.01 and § 2173.05(a). Usually the terminology of the original claims follows the nomenclature of the specification, but sometimes in amending the claims or in adding new claims, new terms are introduced that do not appear in the specification. The use of a confusing variety of terms for the same thing should not be permitted.

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#### **MPEP § 608.01(p) Completeness of Specification**

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The contents of an application, to be complete, must include a specification containing a written description of the invention using such description and details as to enable any person skilled in the art or science to which the invention pertains to make and use the invention as of its filing date. 35 U.S.C. 112. At least one specific operative embodiment or example of the invention must be set forth. The example(s) and description should be of sufficient scope as to justify the scope of the claims.

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For the written description requirement, an applicant's specification must reasonably convey to those skilled in the art that the applicant was in possession of the claimed invention as of the date of invention. See MPEP § 2163 et seq. for further guidance with respect to the evaluation of a patent application for compliance with the written description requirement.

An applicant's specification must enable a person skilled in the art to make and use the claimed invention without undue experimentation. The fact that experimentation is complex, however, will not make it undue if a person of skill in the art typically engages in such complex experimentation. See MPEP § 2164 et seq. for detailed guidance with regard to the enablement requirement of 35 U.S.C. 112.

See also MPEP § 2161.01 regarding computer programming and 35 U.S.C. 112; and MPEP § 2181 and § 2185 regarding 35 U.S.C. 112 in the context of functional claims.

The specification should include a statement which identifies a specific and substantial credible utility for the claimed invention. This usually presents no problem in mechanical or electrical cases. Questions regarding compliance with the utility requirement arise more often in biotechnological or chemical cases.

For "Guidelines For Examination Of Applications For Compliance With The Utility Requirement of 35 U.S.C. 101," see MPEP § 2107.

## APPENDIX II

### Glossary Initiative and the Summary of the Invention

#### MPEP § 608.01(d) Brief Summary of Invention

##### “37 C.F.R. 1.73 Summary of the invention.

A brief summary of the invention *indicating its nature and substance*, which may include *a statement of the object of the invention*, should precede the detailed description. Such summary should, when set forth, be commensurate with the invention as claimed and *any object recited should be that of the invention as claimed.*”

Since the purpose of the brief summary of invention is to apprise the public \*\*\* of the nature of the invention, the summary should be directed to the specific invention being claimed \*\*\*. That is, the subject matter of the invention should be described in one or more clear, concise sentences or paragraphs. Stereotyped general statements \*\*\* serve no useful purpose \*\*\* and, in the absence of any illuminating statement, replaced by statements that are directly on point as applicable exclusively to the case at hand.

The brief summary, *if properly written to set out the exact nature, operation, and purpose of the invention*, will be of material assistance in aiding ready understanding of the patent in future searches. The brief summary should be *more than a mere statement of the objects of the invention*, which statement is also permissible under [37 CFR 1.73](#).

The brief summary of invention should *be consistent with the subject matter of the claims.* \*\*\*  
[emphasis added]

The *Summary of the Invention* should include a definition of *certain* (but not all) terms used in the claims, while the *Rules of Practice in Patent Cases* says nothing about this key feature of a patent application. At the same time the Agency’s leadership, without regard to the existing regime, has started a “pilot” to consider the possibility of an across the board set of definitions in a “glossary”: The Patent Office *Glossary Initiative* represents perhaps the best example of the failure of Agency leadership to depart from more than a century of practice, a

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failure to understand its own *Rules of Practice in Patent Cases* and its *Manual of Patent Examining Procedure*. *Glossary Initiative*, U.S. Patent and Trademark Office, <http://www.uspto.gov/patent/initiatives/glossary-initiative> (last visited March 27, 2015). Indeed, given the time and effort put into the *Glossary Initiative* by the incumbent head of the Patent Office, the *Glossary Initiative* must be regarded as the signature program of Michelle K. Lee.

In a nutshell, the Patent Office *Glossary Initiative* seeks to test the waters as to whether a new practice should be introduced to mandate a “glossary” within each patent application to provide a definition of the terms used in the application. To be sure, the *Summary of the Invention* should be a fixture of every patent application and *should* include a definition of a term at the point of novelty to cabin the “broadest reasonable interpretation” rule of claim construction at the Patent Trial and Appeal Board. But, in the Patent Office guidance on the *Summary of the Invention*, there is no mention of a such a definitional section to deal with cabining the “broadest reasonable interpretation rule”; instead, the *Rules of Practice in Patent Cases* focuses upon a disclosure of the “nature of the invention”, an archaic nineteenth century statutory provision grounded in the Patent Act of 1836 but eliminated from the patent law more than sixty (60) years ago.

This present discussion first provides a consideration of what *should* be contained in a proper *Summary of the Invention* and then discusses the guidance the Patent Office provides in its *Rules of Practice of Patent Cases* and *Manual of Patent Examining Procedure*.

The *Glossary Initiative* is perhaps the most publicized initiative of the Lee Administration. In the nearly two year period since her announcement in June 2013, there have been numerous outreach attempts to the public to urge provision of *definitions* of terminology used to define the invention. The variety of attempts to popularize this initiative are self-explanatory when viewed from the Patent Office website. <http://www.uspto.gov/patent/initiatives/glossary-initiative#heading-1>. Yet, marching to the second anniversary of the initiative, an average of just fifty (50) applications per year have entered the program out of a grand total of just over 100 granted petitions in the period through March 2015. When it is considered that there are roughly 500,000 applications filed per year, this means that only one out of every 10,000 applications filed in this period have been granted access to the program or 0.01 % of all new applications. (To be sure, the pilot program is open only to selected technologies so that, if one were to calculate usage within such selected technologies, there is still a usage on the order of less than one half of one percent.)

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Quite clearly, there is a need for definitions of *some* terms in the *Summary of the Invention* which are at the point of novelty and where a precise definition would be helpful – or where the inventor *should* provide a definition of such a term to trump the broadest reasonable interpretation” rule used at the Patent Trial and Appeal Board for its post-grant proceedings. With or without a *Glossary Pilot* applicants have been providing such definitions in a *Summary of the Invention*.

What makes the *Glossary Initiative* all the more remarkable is that there has been for generations Patent Office Rule 73 that deals with the *Summary of the Invention* and which *should* be the focus of any revision to provide for definitions or – in the words of the Patent Office leadership – a “glossary”. Yet, Patent Office Rule 73 is a moribund never enforced regulation to implement the 1836 statutory requirement for a disclosure *not* of any definition of the invention but, rather, the “nature” of the invention. Whatever importance its nineteenth century authors may have seen in a statutory requirement for a disclosure of the “nature” of the invention this anachronistic requirement has not been part of the statute as from January 1, 1953.

If there is to be any movement to suggest “definitions” or a “glossary” the starting point should not be a *sua sponte* abrogation of the normal rulemaking process and abandonment of the existing scheme, but, rather a revision of Rule 73. Indeed, some definitions are *critical* and should be encouraged. “[P]atentees can act as their own lexicographers if they ‘clearly set forth a definition of the disputed claim term’ other than its plain and ordinary meaning.” *Vasudevan Software, Inc. v. Microstrategy, Inc.*, \_\_\_ F.3d \_\_\_, \_\_\_ (Fed. Cir., 2015)(Linn, J.)(quoting *Thorner v. Sony Computer Entm't Am., LLC*, 669 F.3d 1362, 1365 (Fed. Cir. 2012), quoting *CCS Fitness, Inc. v. Brunswick Corp.*, 288 F.3d 1359, 1366 (Fed. Cir. 2002)).

### **(I) Patent Office Rule 73 and MPEP 608.01(d)**

Even today, more than sixty years since a relevant statutory change, the official *Manual* guidance on how to draft a *Summary of the Invention* quotes the *Rules of Practice in Patent Cases* for the proposition that the “summary of the invention [should indicate] its nature \*\*\* , which may include a statement of the object of the invention[.]” MPEP 608.01(d), *Brief Summary of Invention* (quoting 37 C.F.R. 1.73, *Summary of the invention*)(emphasis added).

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More completely, the paragraph from which this statement was excerpted reads (with emphasis added):

“A brief summary of the invention indicating its *nature and substance*, which may include a statement of the *object of the invention*, should precede the detailed description. Such summary should, when set forth, be commensurate with the invention as claimed and any object recited should be that of the invention as claimed.”

Nature of the invention? Substance of the invention?

“Object” of the invention?

The *Manual* further states:

“Since the purpose of the brief summary of invention is to apprise the public, and more especially those interested in the particular art to which the invention relates, of the nature of the invention, the summary should be directed to the specific invention being claimed, in contradistinction to mere generalities which would be equally applicable to numerous preceding patents. That is, the subject matter of the invention should be described in one or more clear, concise sentences or paragraphs. \*\*\*

“The brief summary, if properly written to set out *the exact nature, operation, and purpose of the invention*, will be of material assistance in aiding ready understanding of the patent in future searches. The brief summary should be more than a mere statement of the objects of the invention, which statement is also permissible under 37 CFR 1.73.”

MPEP 608.01(d), *Brief Summary of Invention* (emphasis added).

### (II) What the *Manual* Should (but doesn't) Require

Before considering what the *Manual* should *not* say, it is important to note what the *Manual* itself *does not* say about the content of a *Summary of the Invention*. Each of the following points *should be* in the *Manual* to reflect case law decisions over the past several decades. The absence of these features manifests a failure to update the *Manual*:

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Thus, the Patent Office rule nowhere says that the *Summary of the Invention should contain* a verbatim recitation of claim language, *should contain* exemplification of alternate elements where an element in the claims has a limited disclosure, and *should contain* an express definition at the point of novelty, particularly as a way to cabin the “broadest reasonable interpretation” of the claims.

None of these important elements for a *Summary of the Invention* is housed within Rule 73.

### a. Verbatim Recitation of the Claim Language

There are several key requirements for an optimum *Summary of the Invention*, including a verbatim restatement of the features of the *claimed* invention.

### b. Definition to Cabin the “Broadest Reasonable Interpretation”

A set of definitions – or “glossary” to use the terminology of the incumbent Under Secretary – should be *selectively* provided to cabin the otherwise “broadest reasonable interpretation” of elements at the point of novelty: “[P]atentees can act as their own lexicographers if they ‘clearly set forth a definition of the disputed claim term’ other than its plain and ordinary meaning.” *Vasudevan Software, Inc. v. Microstrategy, Inc.*, \_\_\_ F.3d \_\_\_, \_\_\_ (Fed. Cir., 2015)(Linn, J.)(quoting *Thorner v. Sony Computer Entm't Am., LLC*, 669 F.3d 1362, 1365 (Fed. Cir. 2012), quoting *CCS Fitness, Inc. v. Brunswick Corp.*, 288 F.3d 1359, 1366 (Fed. Cir. 2002)).

### c. Exemplification of Claim Elements

Where an element of a claim is performed with reference to only a single feature representing that element without setting forth plural features, case law has in some instances interpreted the element as limited to the single feature; here, the *Summary* should include *alternate* examples to ensure a broad scope of protection. See *LizardTech, Inc. v. Earth Res. Mapping, Inc.*, 424 F.3d 1336, 1345 (Fed.Cir.2005); *SciMed Life Sys., Inc. v. Advanced Cardiovascular Sys., Inc.*, 242 F.3d 1337, 1341 (Fed.Cir.2001)).

### (III) Anachronistic “Nature of the Invention” Requirement

While there is no rule mandating a definitional section in the *Summary of the Invention*, there *is* a rule even today that mandates a disclosure of the “nature of the invention:

There is no better example of a provision in the first edition that was proper at the time that *remains* today – even in the Rules of Practice of Patent Cases – when long overruled either by statutory enactment or case law. The *Manual of Patent Examining Procedure* through its numerous revisions dating back to the original 1949 first edition provides a snapshot of the failure of the Office to update its guidance to keep in tune with statutory changes:

#### a. The 1949 First Edition Correctly Cited the “Nature” Rule

The original 1949 edition of the *Manual* includes a quotation from the Rules of Practice:

*Summary of the Invention.* A brief summary of the invention indicating its nature and substance, which may include a statement of the object of the invention, should precede the detailed description. Such summary should, when set forth, be commensurate with the invention as claimed and any object recited should be that of the invention as claimed.

§ 608.01(d), *General Statement of Invention* (quoting Rule 73)(Original 1949 edition).

By 1961, the *same Rule 73* is recited in the same section of the *Manual* (since retitled as *Brief Summary of the Invention*). In addition, the following statement has been added to the *Manual*:

“[T]he purpose of the brief summary of invention is to apprise the public ... of the nature of the invention[.] \*\*\*

The brief summary, if properly written to set out the exact nature, operation and purpose of the invention will be of material assistance in aiding ready understanding of the invention in future searches. See [§] 905.04. \*\*\*

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The brief summary of invention should be consistent with the subject matter of the claims. \*\*\*

MPEP § 608.01(d), *Brief Summary of the Invention* (Third edition 1961).

### **b. Early Statutory Origins for the “Nature” Requirement**

A “correct[ ]” indication of an invention’s “nature” and “design” was introduced as a statutory requirement of the 1836 patent law as a codification of the case law interpretation of the 1793 Patent Act as explained in *Hogg v. Emerson*, 47 U.S. (6 How.) 437 (1848)(Woodbury, J.).

As explained in the Curtis treatise, the 1836 patent law made it a statutory requirement that a patent “shall contain a short description \* \* \* of the invention \* \* \*, correctly indicating [the] nature and design [of the invention.]” George Ticknor Curtis, *A Treatise on the Law of Patents for Useful Inventions*, §221, p. 251 n.3 (Boston: Little, Brown, and Company 1873 (4th ed.))(citing *Hogg v. Emerson*, 47 U.S. (6 How.) at 482, and quoting from The act of Congress of July 4, 1836, c. 357, § 6: “[E]very patent shall contain a short description or title of the invention or discovery, correctly indicating its nature and design[.]”).

### **c.] The 1870 Law Mandating Claims to Define the Invention**

Perhaps the “nature” of the invention disclosure requirement made sense in the early to mid-nineteenth century when claims were not mandatory as the definition of the invention. But, in the 1870 law that made the patent claim the mandatory feature to define the invention, the now-anachronistic “nature of the invention” requirement was maintained: “[E]very patent shall contain a short title or description of the invention or discovery, correctly indicating its *nature and design....*” *Long v. Rockwood*, 277 U.S. 142, 146 (1928)(McReynolds, J.)(quoting Chapter 230, Act July 8, 1870, 16 Stat. 201 (Rev. Stat. § 4884; section 40, Title 35, U. S. Code (35 USCA § 43; Comp. St. § 9428)).

**d. Definition of Infringement in the 1952 Patent Act**

As explained in the *Aro* case, the 1952 Patent Act provided an express statutory definition of infringement as 35 USC § 271(a). *Aro Mfg. Co. v. Convertible Top Replacement Co.*, 365 U.S. 336, 350 n.5 (1961). Regarding prior law, the Court in *Aro* explained that:

Although there was no statutory provision defining infringement prior to [the 1952 Patent Act], the definition [of infringement] adopted is consonant with the long-standing statutory prescription of the terms of the patent grant, which was contained in § 4884 of the Revised Statutes as follows:

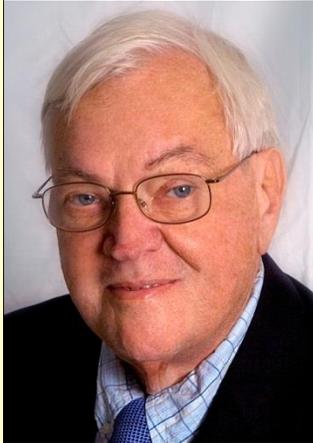
“Every patent shall contain a short title or description of the invention or discovery, *correctly indicating its nature and design*, and a grant to the patentee \* \* \* of the exclusive right to make, use, and vend the invention or discovery throughout the United States \* \* \*” (Emphasis supplied [by the Court].)

This provision is now contained without substantial change in 35 U.S.C. § 154, 35 U.S.C.A. § 154.

*Aro*, 365 U.S. at 350 n.5 (emphasis supplied in part by the Court and by this writer).

Quoting the words of the late Pasquale J. Federico, up through the eve of the effective date of the 1952 Patent Act, the statute required “a ... description of the invention ... correctly stating its nature and design.” P. J. Federico, *Commentary on the New Patent Act* [1954], reproduced at 75 J. Pat. And Trademark Off. Soc’y 161, 201-02 (1993). But, the statutory basis for the “nature” and “design” disclosure requirement ceased with the effective date of the 1952 Patent Act: “The old statute [before the 1952 Patent Act] required ‘a short title or description of the invention or discovery, correctly stating its nature and design’; this has been shortened to ‘a short title of the invention’ since the title is of no legal significance.” *Id.*

## About the Author



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