

REPORT

NEW USPTO GLOSSARY PILOT PROGRAM FOR SOFTWARE AND BUSINESS METHOD-RELATED PATENT APPLICATIONS**June 16, 2014**

The United States Patent and Trademark Office ("USPTO"), as part of an Obama administration executive action, formalized a Glossary Pilot Program (hereinafter the "Glossary Pilot") that is designed to promote the use of glossaries of claim terms to enhance patent clarity. The Glossary Pilot, which is currently only applicable to software and business method-related technology areas, started June 2, 2014, and runs through December 31, 2014, or until the USPTO accepts 200 grantable petitions under the Glossary Pilot, whichever occurs first. The USPTO is authorized to extend the program for an additional six months.

Under the Glossary Pilot, an applicant must provide a glossary of claim terms in the specification. Applicants participating in the Glossary Pilot will receive, at no additional cost, expedited processing until a first Office Action. Examiners must construe patent claims in view of the glossary in the specification.

I. Requirements For Participation in the Glossary Pilot Program

The Glossary Pilot is only available for software and business method-related applications in USPTO Technology Centers 2100, 2400, 2600, or 3600 (Business Methods). The following criteria must be met to be eligible for the Glossary Pilot:

(1) the application must be:

(a) an original, non-reissue, non-provisional, English-language utility application filed under 35 U.S.C. §111(a) that does not claim the benefit of a prior filed U.S. application (*i.e.*, cannot be a continuation application, divisional application, national phase application, reissue application, design application, or plant application); or

(b) an English-language continuation-in-part application claiming the benefit of a prior non-provisional utility application or international application under 35 U.S.C. §§120 or 365(c) filed for the purposes of providing a glossary in accordance with this program;

(2) the application must include:

(a) an Application Data Sheet including all benefit and priority claims;

(b) a copy of any foreign application from which priority is claimed under 35 U.S.C. §119(a)-(d); and

(c) if any prior-filed application from which priority is claimed (U.S. or foreign) is in a foreign language, (i) an English translation of the prior-filed application, and (ii) a statement that the translation is accurate;

(3) the application must contain:

(a) at least one claim, but no more than four independent claims and thirty total claims, and no multiple-dependent claims; and

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(b) a formal glossary section, with its own heading, written in English, and placed at the beginning of the detailed description portion of the patent application specification, that:

(i) contains positive statements of definitions, which may include but cannot rely solely on examples, synonyms, and exclusions, cannot be open-ended (*e.g.*, "or the like"), and cannot be only negative (*i.e.*, what a term is not), for the following types of claim terms:

- (a) key claim terminology, such as a term with a special definition;
- (b) substantive terms within the context of the invention;
- (c) abbreviations;
- (d) acronyms;
- (e) evolving technological nomenclature;
- (f) relative terms;
- (g) terms of degree; and
- (h) functional terminology (including identifying corresponding structure for 35 U.S.C. §112(f) functional limitations);

(ii) does not rely upon other literature, patents or parts of the specification for completeness;

(iii) does not include definitions that are disavowed elsewhere in the specification; and

(iv) cannot be later deleted or amended except to correct typographical errors.

(4) the application cannot participate in the Patent Prosecution Highway (PPH) Program, but the application may be further accelerated in accordance with other established procedures (*e.g.*, Accelerated Examination, Prioritized Examination, Special Status based on an applicant's age, etc.); and

(5) the application and all follow-on papers must be filed electronically.

II. Effect on Examination

All applications accepted for participation in the Glossary Pilot will be given expedited processing by placing the application on an examiner's special docket prior to the first Office Action. The application will be placed on the examiner's regular amended docket after the applicant's response to the first Office Action, unless it has been designated special in accordance with another established procedure. Accordingly, applications in the Glossary Pilot will only be expedited until the first Office Action is received.

During examination, examiners must construe the claims in accordance with the definitions provided in the glossary. As such, examiners should not apply an overly broad meaning to claim terms during examination.

If an application claims the benefit of an earlier application under 35 U.S.C. §119 the claims that include terms defined in the glossary will be checked to ensure that the definitions in the glossary are supported by the priority application under 35 U.S.C. §112(a). If a definition of a particular claim term is not supported by the priority application, any claim that includes the particular claim term will not be entitled to the filing date of the priority application. An applicant cannot subsequently disavow the meaning of a term defined in the glossary or amend the glossary to attempt to regain the filing date of the priority application.

If an application does not fully comply with the requirements in section I above, the USPTO will issue a Notice, and the applicant will be given a non-extendible period of the longer of one month or thirty days to correct the deficiency, if correctable. If the deficiency is not corrected in this time period, the application will be taken up for examination in accordance with standard examination procedures—but any glossary in the application will still control the interpretation of the defined claim terms.

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III. Analysis and Recommendations

At the time of drafting an application, it may not be possible to foresee the scope of each claim term that might be desirable to cover other products or processes in the marketplace. The glossary must expressly define claim terms, and the glossary may result in an unanticipated and unwanted narrowing of the claim scope. Thus, there is a risk that the glossary may hinder the patent owner's ability to enforce the patent.

Preparing a glossary that affords adequate scope to each defined claim term will likely require significant time and cost to prepare. For example, applications claiming priority under 35 U.S.C. §119 must be carefully reviewed to ensure that any definitions provided in the glossary are supported by the priority application under 35 U.S.C. §112(a). As mentioned above, any claim including a defined claim term whose glossary definition is not supported by the priority application will not be entitled to the filing date of the priority application. By losing the filing date of the priority application a claim will be subject to more prior art. Further, any claim losing a filing date of a priority application filed prior to March 16, 2014, will irreversibly cause the entire application to be subject to post-AIA 35 U.S.C. §§ 102 and 103 during examination. A translation of any foreign priority application will also require significant time and cost to prepare.

In most cases, we believe that the additional costs to prepare a glossary and translate any foreign priority application, along with the risk of potentially narrowed claim scope, may outweigh the benefit of expedited prosecution until a first Office Action. If expedited prosecution is desired, the USPTO offers Prioritized Examination that provides expedited prosecution without the risks associated with the Glossary Pilot and has a \$4000 fee (\$2000 small entity and \$1000 micro entity) that will likely be close to the additional cost of preparing a glossary and a translation of any foreign priority application.

Of course, in certain instances in which the invention requires that many of the claim terms be defined in the specification for the claims to be understood, a glossary might be drafted as an alternative to including definitions in other parts of the specification to take advantage of expedited processing until a first Office Action. A glossary may also facilitate allowance of claims because it can potentially be used in a way that prevents Examiners from interpreting claims unreasonably broadly to read on unrelated prior art.

In view of the potential risks and benefits, the determination of whether to use the Glossary Pilot should be made on a case-by-case basis, with a particular focus on the balance between expedited prosecution and the potential limits to claim scope.

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Oloff PLC is a full-service Intellectual Property law firm based in historic Alexandria, Virginia. The firm specializes in patent, copyright, trademark, and antitrust law and litigation, and represents a large and diverse group of domestic and international clients, including businesses ranging from large multinational corporations to small privately owned companies, major universities, and individual entrepreneurs.

This Special Report is intended to provide information about legal issues of current interest. It is not intended as legal advice and does not constitute an opinion of Oloff PLC. Readers should seek the advice of professional counsel before acting upon any of the information contained herein.

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