

*Before the*  
United States Patent & Trademark Office  
Alexandria, VA

*In re*

Request for Comments in Response to  
Questions Regarding Strategies for  
Improving Claim Clarity: Glossary Use in  
Defining Claim Terms

Docket No. PTO-P-2012-0052

**COMMENTS OF  
COMPUTER & COMMUNICATIONS INDUSTRY ASSOCIATION**

In its Notification of the October 17, 2013, Software Partnership Meeting, the USPTO solicited responses and/or comments about the questions it posed in the Notification. The Computer & Communications Industry Association (CCIA)<sup>1</sup> submits the following comments.

**I. Summary**

CCIA supports the USPTO's efforts to tighten functional claiming. We believe that the most effective way to do this would be to apply 35 U.S.C. § 112(f) more broadly to all software-related patent applications. This is because the largest single problem with software-related patents is that unless they expressly use means-plus-function language (i.e., the term "means for") in the claims, they are interpreted as claiming every possible way of implementing the claimed invention. Accordingly, we are pleased to see the USPTO's efforts to improve examiner training with respect to § 112(f).

With respect to the particular questions posed by the USPTO in its Notification, CCIA generally supports the suggested requirements for the form and content of a glossary. One particular concern that CCIA would like to see addressed is the abuse of alternative definitions. As explained below, the number of possible combinations of definitions grows exponentially as more definitions with alternatives are added. Accordingly, CCIA believes that the number of definitions that use alternatives should be sharply restricted.

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<sup>1</sup> CCIA is an international nonprofit membership organization representing companies in the computer, Internet, information technology, and telecommunications industries. Together, CCIA's members employ nearly half a million workers and generate approximately a quarter of a trillion dollars in annual revenue. CCIA promotes open markets, open systems, open networks, and full, fair, and open competition in the computer, telecommunications, and Internet industries. A complete list of CCIA members is available at <http://www.ccianet.org/members>.

CCIA also recommends that glossaries be external to the specification, for at least two reasons. First, this would allow a glossary to be modified as new terms are determined to require definition. Second, an examiner would be able to propose definitions for terms, which an applicant could either adopt or provide a substitute definition for. As described below, this would reduce the burden on applicants as well as improving clarity and consistency in prosecution.

## **II. Responses to Questions**

CCIA submits the following responses to the questions in Section D:

### **Form and Content for a Glossary to be Supplied in a Possible Glossary Pilot Program**

*1. What restrictions, if any, should be placed on the format of the glossary section; such as limits on the length of each definition, the number of alternatives provided in a definition, and the number of definitions in the glossary section?*

CCIA does not believe that it is necessary to limit the number of definitions or the length of each definition. Each definition should be clear and unambiguous, and the glossary should include definitions for any term used in the claims that is susceptible to multiple interpretations or is not a standard industry term.

The number of alternatives in a single definition is not critical. Rather, it is the number of definitions that have alternatives that matters. If more than one definition uses alternatives, the possible number of combinations of alternatives grows exponentially. For example, if a glossary contains three definitions with three alternatives each, that would be twenty-seven possible combinations of definitions. The number of definitions that use alternatives should be limited to no more than one in order to avoid this problem.

*2. Please comment if the following glossary criteria should be used in determining whether an application is eligible for admission into a potential glossary pilot program:*

*a. The glossary must be a separate section in the specification with its own heading entitled "Glossary." The glossary cannot be an appendix or submitted as an Information Disclosure Statement (IDS).*

CCIA believes that the glossary should be separate from the specification. CCIA's reasoning is explained below in response to Question 3.

*b. The glossary definitions must "stand alone" and cannot simply refer to other sections or text within the specification or incorporate by reference a definition (or portion) from another document.*

CCIA supports these criteria.

*c. A definition in the glossary cannot be disavowed by the disclosure or during prosecution; for example, by stating “the definition presented in the glossary is not limiting.”*

CCIA supports these criteria.

d. Alternative definitions for the same claim term that are inconsistent with each other are not permissible.

CCIA supports these criteria.

*e. The glossary, at least at a minimum, must define functional claim terms, the structure associated with any claimed function, abbreviations/acronyms, evolving technology nomenclature, relative terms, terms of art, and unique words that lack an ordinary and customary meaning.*

CCIA supports these criteria.

*f. A definition cannot consist only of a list of synonyms or examples.*

CCIA supports these criteria.

### *3. What other criteria would you recommend for a glossary definition?*

CCIA recommends that glossaries be external to the specification, similarly to information disclosure statements. Although a glossary must still be subject to the limitation on new matter, an applicant should be able to add definitions if, during prosecution, it becomes clear that such definitions are necessary.

Further, examiners should be able to propose definitions for the glossary. Currently, if an examiner determines that a term is indefinite, the examiner is encouraged to provide an interpretation of the term as part of any prior art rejection. *See* MPEP § 2173.06 I. Similarly, an examiner should be able to propose a definition for a term if the term is not already defined in the glossary and such a definition would assist in prosecuting the application. The applicant would be able to either adopt the examiner’s proposed definition or provide an alternative definition.

This process would speed up prosecution and reduce the burden on the applicant to determine every term that requires definition. Examiners could build up appropriate dictionaries of common terms that could be shared within art areas. As a result, definitions for common terms could achieve some level of harmonization within art areas, improving clarity and consistency in prosecution.

### **III. Conclusion**

In conclusion, we believe that glossaries have the potential to help in improving patent quality. We look forward to continuing to participate in the Software Partnership to help the USPTO develop an effective pilot program.

Respectfully submitted,

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