

A case for adopting controlling dictionaries in the USPTO

Ambiguous language in patent applications can cause significant problems with examination and later with patent enforcement. The solution is to introduce easily accessible controlling dictionaries that will leave no one in any doubt as to what words mean

By **Diana Roberts, Manny W Schechter** and **Alison Mortinger**

The phrase “May I have the definition, please?” is familiar to anyone who has ever watched a spelling bee. When a spelling bee contestant is presented with an unknown or difficult word to spell, she may ask the judge for the word’s definition. A definition allows the speller to be certain she is thinking of the correct word, and perhaps discern the origin of the root of the word (eg, Greek or Latin). With this information, she is better equipped to determine the correct order of the word’s letters and advance to the next round.

Similar to the spelling bee contestant, a patent examiner in the US Patent and Trademark Office (USPTO) often has to determine the meaning of words – namely, those used in patent applications. A patent application includes a written description, or specification, that is intended to describe precisely the invention, and concludes with one or more claims that define the metes and bounds of the invention. Should a patent application become a patent, it is the patent’s claims that must place the public on notice as to what the patentee owns, and thus what the patentee may exclude others from using, making or selling. Therefore, it is vital that the meaning of the claims be unmistakably clear and supported by the

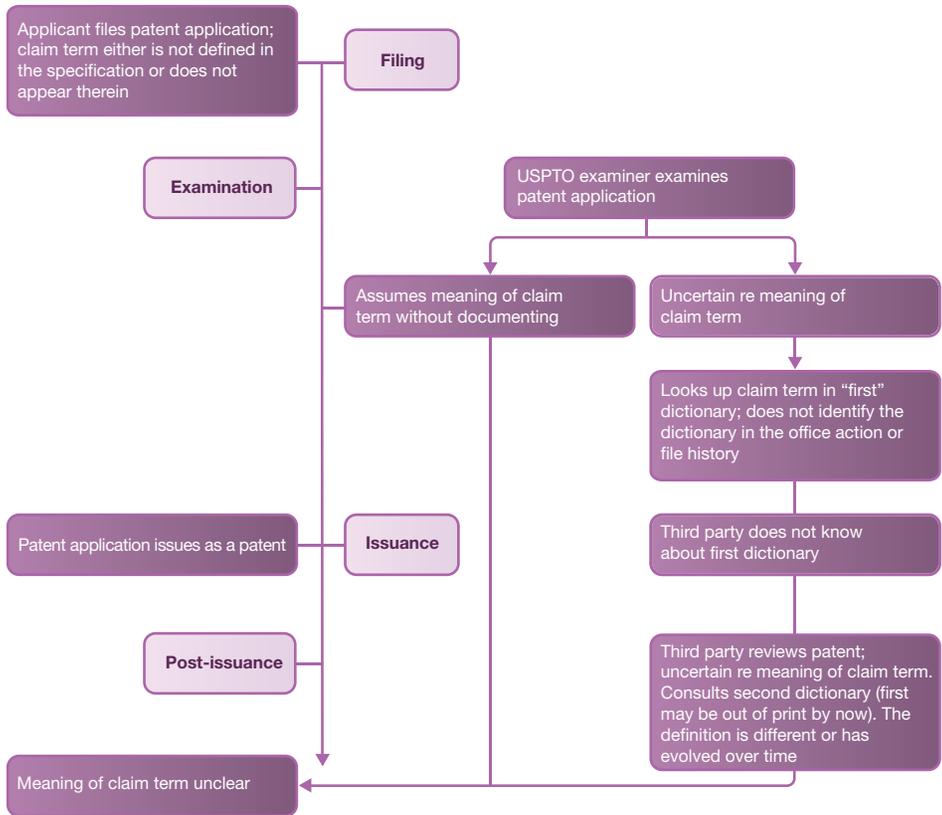
specification, as the claims are read in view of the specification.

But first, a patent application must be rigorously examined by a patent examiner before it can be issued as a patent. Referring to Figure 1, which provides a high-level overview of the current examination process, the patent examiner will search patent and scientific databases for relevant prior art, meaning information related to the claimed invention that was published before a given date. The examiner will compare the prior art to the claims to determine whether they meet patentability requirements, such as novelty and non-obviousness. When making this determination, the claims will be given their “broadest reasonable construction” (see *In re Am Acad Of Sci Tech Ctr*, 367 F3d 1359, 1364 (Fed Cir 2004)). And if the examiner is uncertain or in doubt about the meaning of particular terms in the claims, the examiner will initially refer to the claims themselves to provide guidance as to their meaning. If this proves to be unhelpful, the examiner will next refer to the applicant’s specification to help determine the meaning of the claim terms. Nevertheless, if the examiner still remains uncertain about a claim term, he or she may refer to one or more technical dictionaries, treatises or other literature for assistance.

Potential for problems

And herein lies the problem. One dictionary or treatise may contain definitions that are inconsistent with others. The examiner may consult a particular resource for a particular claim term to reach a determination of patentability, but if that resource remains unidentified in the public record, then the public will not know what meaning the examiner relied upon to evaluate the patent application. After the patent issues, the public (and the courts as well) may consult different resources from those used by the

Figure 1. Current process: problem of unclear claims



examiner in order to assess the scope of the claims and end up with a different definition. This directly leads to an inconsistent and unpredictable meaning for claims, especially because the meaning of words often evolves in leading-edge technologies. Even if an undefined claim term, meaning a term that has not been defined in the specification, has a discernable ordinary and routine meaning at filing, it is likely to acquire a different, perhaps broader meaning during the life of the patent. As time passes, it will become more difficult to determine the meaning of the claim term at the time the patent application was filed.

Given the above challenges, establishing and maintaining a clear meaning for claims linked to a single point in time is essential to improving patent clarity and thus patent quality. A clear meaning also enables others to avoid infringement by implementing appropriate design-arounds. On the other hand, when a patent has ambiguous claims, an industry participant may choose an unnecessarily costly design-around rather than risk treading on all possible interpretations of an ambiguous claim. In this inefficient scenario, the new design

may be abandoned as too costly or impractical. Protracted disputes between patentees and alleged infringers are also likely; parties may argue over the scope of ambiguous claims, litigation may be necessary to resolve disputes that could have otherwise been settled, and resources that could have been used for research and development may be diverted to legal fees.

To avoid claim ambiguity and its negative consequences, we propose that patent applicants and USPTO examiners (and preferably the courts as well) use the same technical dictionaries to provide one consistent, predictable meaning for claims as of the effective filing date of the application. We are proposing this date as the single point in time for determining the meaning of claims over the invention date for several reasons:

- First, it is obviously easier to determine the filing date than the invention date, as the latter may be based on information only in the possession of the inventor and subject to corroboration.
- Second, if the United States patent system moves to a first-to-file system, it is expected that the invention date will no

longer be legally relevant for purposes of claim construction, and thus our proposal would adapt easily into the new system.

- Finally, in *Phillips v AWH Corp*, No 03-1269 (Fed Cir 2005) (*en banc*), the Federal Circuit indicated that the ordinary and customary meaning of a claim term is the meaning at the time of invention: that is, as of the effective filing date of the patent application.

For those reasons, we believe the effective filing date is the most appropriate point in time for determining the literal meaning of the claims.

Our proposal is not intended to have any effect, one way or the other, on the patentee's ability to cover later technologies through the use of the doctrine of equivalents. That doctrine is designed to ensure that an infringer is held liable for insignificant alterations from the precise literal coverage of a patent claim. Rather, our proposal offers a means of establishing a consistent and reliable literal meaning for claims that could be relied upon for the life of the patent. Specifically, we propose a framework for the use of publicly available technical dictionaries whereby the USPTO would officially adopt one or more controlling technical dictionaries for patent applications in each technology centre (TC); and establish a process for defining an order of precedence for the use of such dictionaries, while at the same time allowing applicants to be their own lexicographers.

Applicants may be their own lexicographers

Under US law, patent applicants have the option to be their own lexicographers when drafting their applications. Applicants may use any term and even create their own claim terms, so long as "any special meaning assigned to a term is clearly set forth in the specification" (see *Memorandum to Technology Center Directors and Patent Examining Corps* from John Love, Deputy Commissioner for Patent Examination Policy, titled "Indefiniteness rejections under 35 US C. 112, second paragraph"). This practice would continue under our proposal. If an applicant chose to assign a specific and/or unconventional meaning to a claim term, the applicant would have to clearly define the term in the specification. A glossary or short dictionary section in the written description could be used when many terms required definition. The use of a glossary would help to make the definitions readily available to examiners and the public.

USPTO controlling dictionaries

The USPTO would establish a process for selecting one or more controlling publicly available technical dictionaries for each TC (or alternatively art unit, class or other desired level of granularity) within the USPTO. The selection process used by the USPTO, as well as the selected dictionaries themselves, would need to be impartial to all applicants in any particular technology area. The USPTO would also need to establish strong revision controls for maintaining and updating such technical dictionaries, including time-stamping all revisions. It would be advantageous for the selected technical dictionary publishers to maintain and update their technical dictionaries according to the USPTO revision controls in order to maintain their status as a preferred source of the USPTO.

More than one technical dictionary could be needed for a particular TC if, for example, one technical dictionary did not fully cover a particular technology. If a TC selected more than one technical dictionary, that TC would designate a ranking, or hierarchy, to resolve any conflicting definitions.

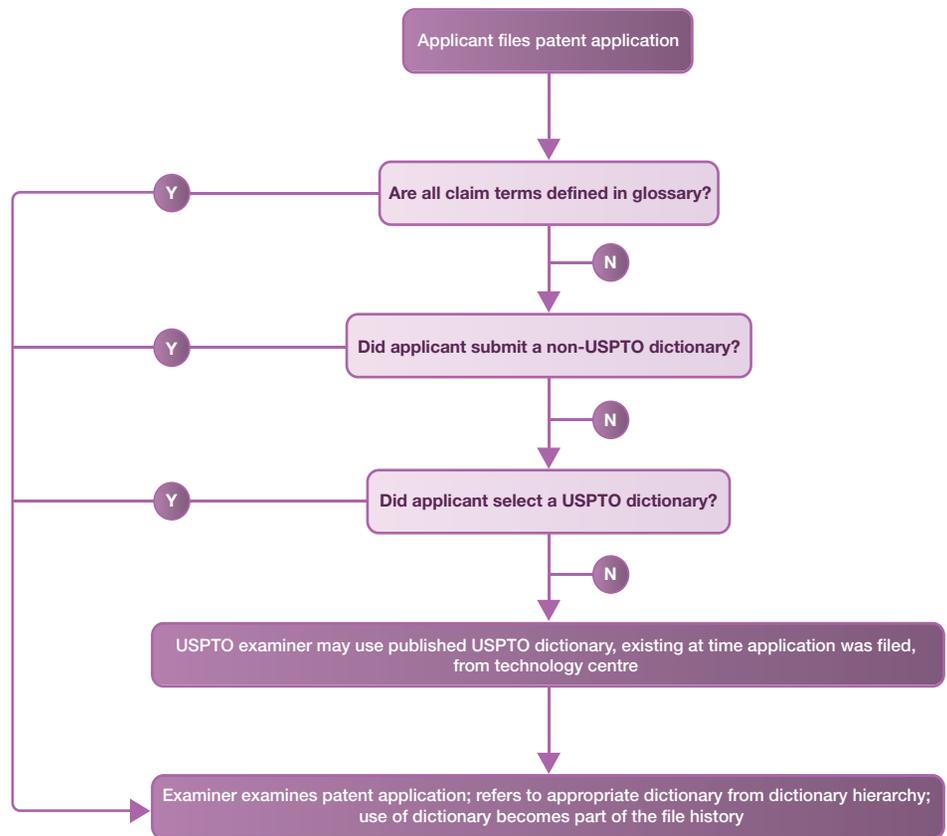
For each TC, the USPTO then would make publicly available all technical dictionary certifications, updates thereto, and their associated hierarchies. This could be done by posting them to the USPTO website. Copies of the dictionaries would be archived at the USPTO so that if the original publisher no longer made them available (eg, they went out of print), the public would be able to access all USPTO certified dictionaries at any time.

Patent application process incorporating a hierarchy of technical dictionaries

Referring to Figure 2, which provides a high-level overview of our proposal, a patent applicant may provide a glossary of claim terms in the written description at the time of filing. This glossary would be the first dictionary in the dictionary hierarchy (described in more detail below). The examiner would use the glossary during the examination process to determine the meaning of any claim terms described in the glossary.

In addition to (or alternatively instead of) supplying a glossary, the applicant would have the option, at the time of filing, of selecting a USPTO certified technical dictionary(ies) from a particular TC that the applicant believed to be most relevant to its invention. If multiple dictionaries were selected, the applicant would have to establish a hierarchy among them. If the

Figure 2. **Proposal: technical dictionary hierarchy**



USPTO assigned the application to a different TC, the applicant's selected USPTO certified technical dictionary(ies), if any, would be regarded as dispositive.

Alternatively, in lieu of a USPTO technical dictionary, the applicant would have the option of designating any publicly available, non-USPTO technical dictionary, so long as the applicant provided the USPTO with access to it. The applicant could accomplish this by supplying a copy of the technical dictionary to the USPTO, or alternatively providing a link to it (although online dictionaries would present an additional issue of change control). In either case, the selected technical dictionary(ies) would become part of the file history to help define the claims terms by informing the public which dictionaries were used during examination. These dictionaries would be used primarily to establish the routine meaning of any claim term not expressly defined in the written description.

Finally, in the event that the applicant failed to select or provide a technical dictionary or adequate glossary (or if a claim

term were not found within one of these resources), the following process would occur:

- First, the examiner would use by default the certified USPTO technical dictionary(ies) designated for his corresponding TC that existed on the effective filing date of the application. Such dictionary(ies) would be used to determine the meaning of any claim term not expressly defined either in the specification or in one of the dictionaries selected by the applicant.
- Second, the examiner would notify the applicant of its use of such USPTO dictionary in the first office action.
- Finally, if a claim term still remained undefined, the examiner would give the undefined claim term the narrowest possible meaning, or if that were simply impossible, hold the claim(s) unpatentable. If the former, the examiner would record such meaning in the first office action.

Advantages

Use of controlling technical dictionaries and glossaries by patent applicants and

examiners would significantly enhance the clarity and predictability of claim meaning and reduce protracted disputes stemming from ambiguous claims. Under the current proposal, the patent applicant retains freedom to be its own lexicographer in two ways. First, the applicant may select or provide a USPTO or publicly available non-USPTO technical dictionary of its own choice at the time of filing. Second, the applicant may include a definition directly in the written description via a technical glossary section.

If the applicant fails to select or provide a technical dictionary or glossary or otherwise leaves a claim term undefined, the examiner uses one or more technical dictionaries assigned to his technology centre, at the time of filing, to determine the meaning of a claim term. Because the use of such dictionary(ies) is part of the prosecution history, the public can readily determine the true meaning of the claims.

If, after all the above resources are exhausted, a claim still has an unclear and

undefined term, such term will be construed against the applicant by being given the narrowest possible meaning by the examiner if possible, or if not possible, held as indefinite.

Because this proposal creates intrinsic evidence in the prosecution history, courts should rely on those same dictionaries for claim construction, thereby enhancing predictability within the entire patent system (see *Phillips v AWH Corp*, No 03-1269 (Fed Cir 2005) (*en banc*)). Implementation of this process would promote certainty and predictability concerning the meaning of claims, and thus provide public notice of the patentee's rights.

Increased claim certainty through the use of glossaries and technical dictionaries will help the public to determine the true meaning of claims and avoid the undesirable effects of ambiguity, including wasting technical and financial resources. By posing the question "may I have the definition, please?" examiners and the public can advance to the next round of improved patent quality. **iam**

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The opinions expressed in this article are those of the authors, and not necessarily those of the IBM Corporation.

This article is dedicated to Herman Rodriguez, whose devotion and contribution to patent excellence inspired its contents

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