From: Chao, Bernard
Sent: Monday, April 13, 2015 6:57 PM
To: WorldClassPatentQuality
Subject: Comments to Proposal 3 Clarity of Record

In response to the Patent's Office request for comments, I am copying an April 13, 2014 post from Patently-O that I authored last year (a pdf version is also attached for your convenience). I suggest that recording patent office interviews will clarify file histories and improve the notice function of patents. The post follows:

Patent law seeks to provide the public with notice of a patentee's property rights by requiring that a patent's claims "distinctly point out what the inventor . . . regards as the invention." 35 U.S.C. § 112 (b). However, both the Federal Trade Commission and the White House have noted that far too many patents contain claims that fail to provide adequate notice of what they cover. The Patent Office has recently adopted two initiatives to address these complaints. One program seeks to curb functional claims, a type of claim that is accused of often having uncertain boundaries. A second program encourages patent attorneys to include a glossary in their applications that will define the terms used in the claims. Help may also be coming from the Supreme Court which is reviewing § 112's "insolubly ambiguous" standard in *Nautilus v. Biosig*. To varying degrees, these solutions all show some promise. But they are unlikely to solve the problem of unclear claims by themselves. More is needed. This post proposes another approach that should help clarify claims.

The patent office should bring transparency to patent examiner interviews by recording them. Current patent office rules allow applicants to have face to face interviews with patent examiners. Although these rules also require that the examiner and the applicant summarize the substance of the interview, typically these summaries only identify the prior art discussed, parrot the claim language and provide the most skeletal description of the interview. This problem is well known. I recently attended a patent conference at Stanford Law School where two prominent professors separately complained about how opaque the interview process was. Indeed, patent prosecutors are clearly aware of the minimal record made after patent examiner interviews and view this as an advantage of the procedure.

But concealing the examiner/applicant dialog leads to unclear claims in two ways. First, claim interpretation is more uncertain. Courts rely on the prosecution history as one of the primary sources of evidence to interpret claims. Statements that distinguish an application's claims from the prior art can play a key role in claim interpretation. By explaining how the prior art is different, such statements necessarily say what the claim does not cover. However, when these statements are made verbally during interviews, they do not appear in the prosecution history. Consequently, courts must interpret claims without the benefit of statements that should delineate the boundaries of the claim. Absent this evidence, claim interpretation will inevitably be less accurate and less predictable.

Second, the failure to know what was said during patent examiner interviews renders any doctrine of equivalents analysis less predictable. Under *Festo v. Shoketsu*, 535 U.S. 722 (2002), a narrowing amendment estops a patentee from asserting infringement under the doctrine of equivalents unless the patentee can establish that the amendment was made

for one of three reasons. One of the reasons is that the rationale underlying the amendment bears no more than a tangential relation to the equivalent in question. The examiner interview is the most likely place to discuss the reason for an amendment. Without a record of the interview, anyone is free to speculate about why an amendment *might have* been made. A good example of this phenomenon can be seen in a case I teach in my patent law class, *Unique Concepts v. Brown*, 939 F.2d 1558 (Fed. Cir 1991). In *Unique Concepts*, different Federal Circuit judges could not agree about the reason for amendment because "the record contain[ed] no indication of what transpired in the interview." Making audio recordings of patent examiner interviews would prevent this kind of dispute and clarify what claims cover.

Some patent prosecutors may worry that recording patent examiner interviews will have a chilling effect on the interview process. Patent attorneys may be reluctant to have a frank discussion about what their claims cover. Alternatively, because interviews happen in real time, without time to reflect and choose words, attorneys might refrain from having interviews. All that may be true. But if a patent attorney is unwilling to make a statement on the record, why should the patent office allow the claims? The public is entitled to know why a claim should be allowed before the applicant receives the monopoly rights that come with an issued patent.

The idea of recording patent examiner interviews is hardly revolutionary. In an era, where people post their most trivial thoughts, pictures and videos on Twitter, Instagram and Facebook, it's clearly time for the Patent Office to record some of patent law's most important conversations, examiner interviews.

Very truly yours,
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Making Examiner Interviews Transparent

April 13, 2014 Dennis Crouch

Guest Post By Bernard Chao, Assistant Professor, Sturm College of Law University of Denver

Patent law seeks to provide the public with notice of a patentee's property rights by requiring that a patent's claims "distinctly point out what the inventor . . . regards as the invention." 35 U.S.C. § 112 (b). However, both the Federal Trade Commission and the White House have noted that far too many patents contain claims that fail to provide adequate notice of what they cover. The Patent Office has recently adopted two initiatives to address these complaints. One program seeks to curb functional claims, a type of claim that is accused of often having uncertain boundaries. A second program encourages patent attorneys to include a glossary in their applications that will define the terms used in the claims. Help may also be coming from the Supreme Court which is reviewing § 112's "insolubly ambiguous" standard in *Nautilus v. Biosig*. To varying degrees, these solutions all show some promise. But they are unlikely to solve the problem of unclear claims by themselves. More is needed. This post proposes another approach that should
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Second, the failure to know what was said during patent examiner interviews renders any doctrine of equivalents analysis less predictable. Under *Festo v. Shoketsu*, 535 U.S. 722 (2002), a narrowing amendment estops a patentee from asserting infringement under the doctrine of equivalents unless the patentee can establish that the amendment was made for one of three reasons. One of the reasons is that the rationale underlying the amendment bears no more than a tangential relation to the equivalent in question. The examiner interview is the most likely place to discuss the reason for an amendment. Without a record of the interview, anyone is free to speculate about why an amendment *might have* been made. A good example of this phenomenon can be seen in a case I teach in my patent law class, *Unique Concepts v. Brown*, 939 F.2d 1558 (Fed. Cir 1991). In *Unique Concepts*, different Federal Circuit judges could not agree about the reason for amendment because "the record contain[ed] no indication of what transpired in the interview." Making audio recordings of patent examiner interviews would prevent this kind of dispute and clarify what claims cover.

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About Dennis Crouch

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