CUOZZO SPEED: A PATENT OFFICE “GLOSSARY” RULE*

Harold C. Wegner**

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*This paper is based upon an ongoing study of Patent Office regulations relating to the patent drafting process. The approach takes a macroscopic view of the rules including their historical roots and purposes as well as a comparative view of practices in Asia and Europe. The project is targeted for completion in 2016 with publication of a treatise, PATENT DRAFTING, that focuses on the impact of drafting techniques on patent scope and validity.

**The author is a Patent Expert Consultant who recently retired from Foley & Lardner LLP where he had practiced for the previous twenty years. His only affiliation with the firm is the honorary position of Partner Emeritus.

contact information:

Harold C. Wegner
8805 Tamiami Trail North PMB-150
Naples, Florida 34108
hwegner@gmail.com.
I. OVERVIEW

It is axiomatic that as part of best practices for patent drafting the very beginning of a patent application should have a *Summary of the Invention* that includes definitions at key terms at the point of novelty. Yet, nothing in Patent Office Rule 73 says a thing about this point, but instead speaks in anachronistic terms that the *Summary* should refer to the invention by “indicating] its *nature* and *substance*”. Instead of suggesting or requiring definitions of terms, Patent Office Rule 73 states that the *Summary* “may include a statement of the object of the invention”, a nonstatutory matter discredited by court decisions.

Matters have gotten out of hand. To its credit, the Agency has recognized the problem through its “Glossary Pilot Program”,* which has met with a relatively cool response from the patent community. What may force the issue of reform is *Cuozzo Speed* that now punishes the patentee who fails to provide a definition of a term at the point of novelty of the invention by imposing a “broadest reasonable interpretation” to such a term in post-grant proceedings at the Patent Trial and Appeal Board. *In re Cuozzo Speed Technologies, LLC, ___F.3d ___* (Fed. Cir. 2015)(Dyk, J.).

This paper commences with a study of current Rule 73, 37 CFR § 1.73, that governs the drafting of a Summary of the Invention that explains the content of this section of a patent application but is silent as to definitions of terms at the point of novelty. See § II, What the Summary Should Contain. Instead of a positive recitation of what should be in a modern Summary, Rule 73 focuses on nonstatutory matters that should not be part of a best practices patent application. See § III, Misguided Guidance, “Nature” and “Object”.

Cuozzo Speed is today perhaps best known as imposing the draconian “broadest reasonable interpretation” of patent claims to Board consideration of patent validity. Implicitly, Cuozzo Speed points to the need to revise Rule 73 to encourage a definitions (or “Glossary”) section in the Summary to cabin the “broadest reasonable interpretation” rule for post-grant proceedings. See § IV, Cabining the “Broaderest Reasonable Interpretation”. Text for a new Rule 73 is proposed. See § V, An Alternative to the “Glossary Pilot”.

II. WHAT THE SUMMARY SHOULD CONTAIN

An overhaul is called for of the Rules of Practice in Patent Cases in many areas, but now most urgently in the rule captioned Summary of the Invention, Rule 73, 37 CFR § 1.73:

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. [emphasis added]
Critical features of the *Summary of the Invention* are not mentioned in Rule 73: The *Summary* should contain a recitation of the claimed invention.

Unlike the *Manual* that is silent as to a recitation of the content of the claimed invention in the *Summary*, the Commissioner has argued that the specification *must* contain a disclosure of the invention of ‘claim 1’ in the specification, an argument the Commissioner made in the *Gardner* case: “While an original claim may be considered as a part of the original disclosure, it should not be considered a part of the ‘written description’—unless the specification contains or is amended to contain the subject matter of the original claim.” *In re Gardner*, 480 F.2d 879, 879 (CCPA 1973)(quoting The Solicitor).

As explained in *Technology Licensing* “a claim in a later application receives the benefit of the filing date of an earlier application so long as the disclosure in the earlier application meets the requirements of 35 U.S.C. § 112, ¶ 1, *including the written description requirement*, with respect to that claim.” *Technology Licensing Corp. v. Videotek, Inc.*, 545 F.3d 1316, 1326 (Fed. Cir. 2008)(citing *Transco Prods. Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 556 (Fed.Cir.1994)). Thus, “a patent must contain a written description of the claimed invention in ‘full, clear, concise, and exact’ terms. 35 U.S.C. § 112, ¶ 1. [Where] a patentee seeks the benefit of the filing date of an earlier filed application, compliance with the written description requirement may turn on whether the disclosure of the earlier application provides ‘adequate support’ for the claims at issue.” *Technology Licensing*, 545 F.3d at 1324 (citing *Vas-Cath Inc. v. Mahurkar*, 935 F. 2d 1555, 1560 (Fed.Cir.1991)).
Fortunately, in terms of whether a claim lacking disclosure in the specification passes statutory muster, it is clear that an original claim is a part of the specification as filed so that if the disclosure of the claim is lacking in the body of the specification, it is procedurally possible to amend the Summary of the Invention to include a recitation of the definitions of the original claims.

Unfortunately, if the original claims (or the remainder of the original specification) lack definitions of the terms of the claims, then the applicant may be out of luck to cure a deficiency in terms of definitions of the invention.

As to the right to amend the specification to include the text from an original claim, this is explained by Judge Lourie in Enzo, “[t]here is no question that an original claim is part of the specification. That was the question answered in the affirmative by In re Gardner, 480 F.2d 879 (CCPA1973), in which the CCPA found compliance with the written description requirement over the objection of the PTO Commissioner, who argued that an original claim should not be considered part of the written description unless the specification was amended to contain the subject matter of the original claim.” Enzo Biochem, Inc. v. Gen-Probe Inc., 323 F.3d 956, 972 (Fed. Cir., 2002)(on pet. for reh’g)(Lourie, J.). This statement echoes what Judge Lane had said shortly after the Gardner case: “Where the claim is an original claim, the underlying concept of insuring disclosure as of the filing date is satisfied, and the description requirement has likewise been held to be satisfied.” In re Smith, 481 F.2d 910, 914 (CCPA 1973)(Lane, J.)(citing In re Gardner, 475 F.2d 1389 (CCPA 1973), supplemental opinion, 480 F.2d 879 (CCPA 1973); In re DiLeone, 436 F.2d 1404 (CCPA 1971)). See also In re Koller, 613 F.2d 819, 823 (CCPA 1980) (“[O]riginal claims constitute their own description.”).
III. MISGUIDED GUIDANCE, “NATURE” AND “OBJECT”

Some key elements of the *Manual of Patent Examining Procedure* have changed little from the original 1949 first edition. There is no better case study than the treatment by the *Manual* of how to draft a *Summary of the Invention*.

The official *Manual* guidance on how to draft a *Summary of the Invention* quotes the *Rules of Practice in Patent Cases*:

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.

MPEP 608.01(d), *Brief Summary of Invention* (quoting 37 C.F.R. 1.73, *Summary of the invention*) (emphasis added)

The *Manual* says absolutely nothing about reciting the invention in the same manner as the claims. It instead puts a focus upon “indicating [the] nature and substance [of the invention], which may include a statement of the object of the invention[.]” MPEP 608.01(d), *Brief Summary of Invention*.

The *Manual* says nothing about a recitation of the scope of the invention in the *Summary of the Invention*.

Nature of the invention?

Substance of the invention?

“Object” of the invention?

Precisely where did such nonstatutory terminology come from? What does it mean?
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).

Precisely where did this information come from?

Certainly not from modern precedent. A study of the history of this section of the Manual of Patent Examining Procedure dating back to prior to the 1952 Patent Act shows that the language is largely taken from an earlier era. 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. ***

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).

IV. CABINING THE “BROADEST REASONABLE INTERPRETATION”

The problem of Cuozzo Speed is that the applicant has the opportunity in drafting his application to offer a specific definition of terms at the point of novelty.

A definition of a specific term within the claims at the point of novelty may be important where a broad interpretation of claim terminology at the point of novelty would mean that the claim reads on subject matter obvious over the prior art, whereas a narrower interpretation would save the claim from an obviousness ruling. Here, a specific definition of this claim terminology in the specification is necessary to mandate claim construction cabined by the specific definition, blocking an otherwise broader interpretation of the terminology under the “broadest reasonable construction” rule applicable to Patent Office proceedings.
Thus, claims in Patent Office proceedings are given their “broadest reasonable interpretation” in contrast to an interpretation to preserve validity at the District Court.

Under *Cuozzo Speed*, a claim is given its “broadest reasonable interpretation” in a Patent Office attack on validity, whether in reexamination, an Inter Partes Review or a Post Grant Review.

In order to avoid an unfettered “broadest reasonable interpretation” claim interpretation at the Patent Office, it is important that there is a *specific definition* of the critical terminology, as explained in *In re Buszard*, 504 F.3d 1364 (Fed. Cir. 2007); *In re Paulsen*, 30 F.3d 1475 (Fed. Cir. 1994)(Lourie, J.); *Markman v. Westview Instruments, Inc.*, 52 F.3d 967 (Fed. Cir. 1995)(en banc)(Archer, C.J.), aff’d, 517 U.S. 370 (1996); and *Saffran v. Johnson & Johnson*, __ F.3d __ (Fed. Cir., 2013)(O’Malley, J., concurring in part).

As explained by Chief Judge Prost, “if an applicant wants a claim term [in reexamination] to have a specific meaning, the applicant can ***provide an express definition for the claim term in the specification. See [In re Yamamoto, 740 F.2d 1569, 1571-72 (Fed.Cir.1984)](noting that an applicant can overcome a rejection by amending the claim language); [In re Morris, 127 F.3d 1048, 1054 (Fed.Cir.1997)] (noting that the PTO must take into account definitions contained in the specification when interpreting claim language).” *Buszard*, 504 F.3d at 1358(Prost, J., dissenting)(emphasis added).
“If the patentee wishes to rely upon a particular definition for interpretation of his patent, it is important that a specific definition be provided in the specification: “Although an inventor is indeed free to define the specific terms used to describe his or her invention, this must be done with reasonable clarity, deliberateness, and precision. ‘Where an inventor chooses to be his own lexicographer and to give terms uncommon meanings, he must set out his uncommon definition in some manner within the patent disclosure’ so as to give one of ordinary skill in the art notice of the change. See *Intellicall, Inc., v. Phonometrics, Inc.*, 952 F.2d 1384, 1387-88 (Fed.Cir.1992).” *Paulsen*, 30 F.3d at 1480.

As explained by Chief Judge Archer:

“[Federal Circuit] cases recognize that the specification may reveal a special definition given to a claim term by the patentee that differs from the meaning it would otherwise possess. In such cases, the inventor's lexicography governs. See *CCS Fitness, Inc. v. Brunswick Corp.*, 288 F.3d 1359, 1366 (Fed. Cir.2002).” *Phillips v. AWH Corp.*, 415 F.3d 1303, 1316 (Fed. Cir. 2005)(en banc)(Bryson, J.). Thus, a patentee is free to be his own lexicographer. *Autogiro [Co. of America v. United States*, 384 F.2d 391, 397 (1967)]. The caveat is that any special definition given to a word must be clearly defined in the specification. *Intellicall, Inc. v. Phonometrics, Inc.*, 952 F.2d 1384, 1388, 21 USPQ2d 1383, 1386 (Fed. Cir.1992).”

*Markman*, 52 F.3d at 980.
Circuit Judge O’Malley stresses the point that there should be a specific definition if the applicant’s definition is to trump the otherwise broadest reasonable interpretation:

To find a special definition mandated by the written description, a term must be ‘clearly’ redefined, and an ‘express intent’ to do so must be evident from the patent. See Elekta Instrument S.A. v. O.U.R. Scientific Int'l, Inc., 214 F.3d 1302, 1307 (Fed. Cir. 2000) (‘While we have held many times that a patentee can act as his own lexicographer to specifically define terms of a claim contrary to their ordinary meaning, the written description in such a case must clearly redefine a claim term so as to put a reasonable competitor or one reasonably skilled in the art on notice that the patentee intended to so redefine that claim term. Absent an express intent to impart a novel meaning, claim terms take on their ordinary meaning.’)(citations and internal quotation marks omitted); see also Edwards Lifesciences LLC v. Cook Inc., 582 F.3d 1322, 1329 (Fed. Cir. 2009) (‘Similarly, we will adopt a definition that is different from the ordinary meaning when the patentee acted as his own lexicographer and clearly set forth a definition of the disputed claim term in either the specification or prosecution history.’) (internal quotation marks omitted); Cannon Rubber Ltd. v. The First Years, Inc., 163 F. App’x 870, 875 (Fed. Cir. 2005) (‘These two cited instances, however, do not clearly indicate that the patentee intended to assign a more narrow definition to the phrase 'in the body' than it would otherwise possess.’).

Saffran v. Johnson & Johnson , __ F.3d at ___(O’Malley, J., concurring in part).
V. AN ALTERNATIVE TO THE “GLOSSARY PILOT”

It is proposed that Rule 73 be superseded by a completely rewritten rule* that would provide for definitions at the point of novelty as new Rule 73(b), 37 CFR § 1.73(b): “[I]mmmediately after the first usage of a term at the point of novelty, a definition of such term [should be included] which shall preclude a broader interpretation of that term in proceedings at the Office[.]”

Proposed Rule 73(b) differs from the Glossary Pilot because there is no requirement that a definition (or “glossary”) be included in the specification. But, if the applicant fails to provide a definition for a term at the point of novelty, he does so at his own peril:

Without a definition, the Patent Office under Cuozzo Speed will give the “broadest reasonable interpretation” to any undefined term so that if the term is at the point of novelty of the invention, this moves the scope of the claim for purposes of a validity analysis closer to the prior art, and thus closer to a conclusion of obviousness under 35 USC § 103.

* Proposed 37 CFR § 1.73. “Summary of the Invention. A brief summary of the invention should precede the detailed description which should include:

“(a) a verbatim description of the invention using the wording of the claims;

“(b) immediately after the first usage of a term at the point of novelty, a definition of such term which shall preclude a broader interpretation of that term in proceedings at the Office; and

“(c) where appropriate in the case of a novel chemical or biotechnology entity, a statement of utility for such entity.”
VI. CONCLUSION

In a first-to-file world speed to gain the earliest filing date is important. Current Rule 73 discourages prompt filing by suggesting that elements should be drafted for a new patent application that beyond taking valuable time that delays a filing date are counterproductive. More importantly, the absence of positive suggestions for what should be in Rule 73 creates technical traps for the unwary.

Cuozzo Speed now offers the challenge to revise Rule 73 that will encourage applicants to provide a better definition to their inventions without the cudgel of mandatory glossary rule.