POPA NEWS
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POPA Proposes Much-Needed IFW Changes

USPTO Deputy Director Steve Pinkos welcomed POPA representatives October 21 to discuss the Image File Wrapper system. POPA came to the meeting prepared with resolutions to current IFW problems that waste time and money and cause major headaches for examiners striving for high quality and high production.

POPA's list of solutions included:

■ **Improve Contractor Scanning Services.** Examiners' greatest complaints with IFW, by far, relate to the multitude of scanning errors that create documents improperly entered in the file record, amendments and office actions entered days, weeks, or months late, documents filed under the wrong tabs, and more.

POPA suggested that some of these problems could be fixed with better training for the scanning contractors, while other scanning troubles needed procedural solutions or new hardware and software.

For example, to more quickly turn around problem images, POPA recommended putting scanners at the warehouse so that corrections can be done without waiting for paper files to be located and sent to Crystal City or Carlyle. To more speedily notify examiners of the receipt and scanning of documents—especially time-sensitive documents such as submissions after final rejection or allowance—the agency should program the electronic Desktop Application Navigator (eDAN) to automatically forward applications to examiners and automatically message them when papers have been scanned and entered. The USPTO could program eDAN to do what computers do best—recognize predetermined input codes and automatically notify examiners, much the same as computers send automated "out-of-office" e-mails.

Sometimes examiners need to have papers, e.g., received faxes, scanned and entered in IFW right away. For this USPTO would establish "scan on demand" services in each technology center, allowing examiners to come to a scanning office for imaging that's needed pronto.

■ **Cached Hot-Docket Images and a Hard-Drive Version of eDAN.** The USPTO could avoid significant losses of examining time if it invested in programming eDAN to enable examiners to continue working from their hard drives when the main IFW system is not functioning properly.

The eDAN software lists all of an examiner's cases, from which the examiner can place the ones most important for a biweek in a to-do list known as a "hot docket." When an examiner places an application on his or her hot docket, the improved network version of eDAN would automatically store all the images of each application in each examiner's hot docket on his or her desktop workstation.

With the individualized hot dockets stored on examiners' computers, a local version of eDAN would allow examiners to continue to work even if IFW or the entire network crashed. When a case on the hot docket is finished, i.e., turned in for a count or otherwise removed from the hot docket, eDAN would automatically delete the cached images of that case from the examiner's hard drive to conserve workstation storage space.

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Technology Center 1600 employees indicate their feelings for the so-called "security" measures used at the USPTO's Carlyle campus. They purchased and wore the personalized prison costumes to their end-of-fiscal-year Halloween luncheon.

POPA Proposes IFW Changes

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■ **Improve Handling of Non-Patent Literature (NPL) and Foreign Patents.** The USPTO can improve examiner access to NPL and foreign patents, thereby improving production and quality, by: 1) identifying each NPL by first author; 2) entering each NPL into IFW in the order that the NPL is entered on the applicant's NPL list (USPTO Form 1449), which is part of the application record; 3) identifying each foreign patent by its country/serial number; and 4) increasing the eDAN annotation field to allow more notes.

■ **Allow Display of Multiple Documents in a Readable Size.** This means providing each examiner with a second desktop monitor.

Examiners now have beautiful flat screen monitors to allow large clear images, but because eDAN displays multiple windows, each document appears on the screen so small that most examiners must print all of the documents to read them. If examiners have two monitors—for example, one in portrait mode and one landscape—the USPTO could increase examiner efficiency by reducing time spent printing or switching between windows and significantly reduce paper and toner costs.

Because monitor prices have dropped significantly since IFW was implemented, the advantages and the benefits to other USPTO software programs—such as the Examiner Automated Search Tool (EAST), the Web-based Examiner Search Tool (WEST), and the Office Action Correspondence System (OACS)—make second monitors worth the cost.

■ **Improve IFW Printing Features.** Relatively simple programming solutions would reduce the number of mouse clicks and functions now necessary to print each document. When examiners have to print scores or hundreds of documents, these software fixes would reduce time and repetitive motion injuries. They would also ease document handling.

For example, adding a header to each printed document that includes at least the serial number and document-filing date would more easily identify documents. On the print menu, "print current document" would be the default setting, cutting several mouse clicks.

Examiners would select multiple documents for printing if the program allowed using the shift and control keys to highlight the relevant documents. Examiners need additional print options, available in all windows, to allow printing of a specified entire application or only documents new since the last office action.

■ **Program eDAN to Refresh all Dockets as Necessary.** Currently examiners manually refresh each docket, which wastes time when the computer can be programmed to do this work.

■ **Provide File Storage Furniture.** The USPTO offered to provide examiners with printed "working folders," which contain a bare-bones number of documents that examiners can add to. But many examiners have not been supplied any file furniture in which to store them.

■ **Improve Optical Character Recognition (OCR) or Supply a Searchable Text File.** These would allow examiners to readily search the specifications and other documents for relevant terms, and "cut and paste" relevant information from applications into office actions. The enhanced system would enable OCR of an entire document while maintaining reasonable formatting. Using commercial-off-the-shelf OCR software on examiners' desktops would allow exporting of a whole document.

In addition, examiners overwhelmingly express a desire to be able to search text by using keywords, something not readily available with image files.

■ **Better Document Tracking.** By adding a data field to show the date that the contractors actually scanned and entered a document, eDAN would enable the USPTO to actually measure the contractor's performance. Now eDAN only tracks the filing date of the paper document. If a paper document was filed Nov. 3 but scanned on Dec. 3, only the Nov. 3 date shows up on the eDAN file. Because eDAN doesn't track who scanned the paper and when, the USPTO has no way to track the quality, efficiency and cost-effectiveness of the contractor's work.

■ **Establish a Pilot Program for Voice-Activated Software.** When an examiner using IFW was disabled by a repetitive motion injury and filed a workers' compensation claim, the USPTO responded by bringing in software engineers to make eDAN compliant with handicap accessibility regulations and allow use of voice-activated dictation software. With eDAN's capability to support voice-activated software the agency can now offer that ability to other examiners who prefer it to test its benefits with eDAN and OACS. A pilot program could ultimately determine long-term cost savings for the agency.

Illness Prompts Leave Requests

Elizabeth Bolden, an examiner and POPA member in Art Unit 1755, has been in the leave donor program since she was diagnosed with breast cancer in April 2004. While she has finished chemotherapy, she will be unable to work for approximately a month due to cancer surgery in mid-November. She also faces almost weekly doctors' appointments, tests, and additional surgeries in 2005.

To donate leave, contact Veronica Faison, Remsen 9D28, phone 571-272-1366.

Sudhaker B. Patel, an examiner in Art Unit 1624, underwent radical prostate cancer surgery on Sept. 30. His doctor advised a recovery period of 7-8 weeks off from work. At press time he had nearly exhausted all of his available leave and needed annual leave donations to offset the time required for his complete recovery. To donate, fax completed leave donation forms to Stacy Hoffman at 703-746-8495.

Leave donation forms for both employees can be downloaded from http://ptoweb/ptointranet/ohr/library/forms/cd505.pdf.

Court's Defining Moment on Claim Language

A federal court of appeals case, closely followed by much of the patent community, hinges on how the court will decide to define patent claim terms.

The full Court of Appeals for the Federal Circuit is considering *Phillips v. AWH Corp.,* a patent infringement case that revolves around the parties' definition of the noun "baffle" used in the patent's claims. The results of this case will set a precedent that will impact how patent applicants and future courts define and interpret claim terms.

The case concerns the definition of "baffle" in the context of a modular wall in a facility like a prison. In the patent held by Phillips (No. 4,677,798), the wall is comprised of "internal steel baffles extending inwardly from the steel walls." While the portion of the wall module that is labeled as the baffle is only shown extending at an acute angle to the external surface of the wall, the specification does not place any limit on the angular orientation of the baffle. The portions of the wall modules that are shown extending perpendicularly to the exterior surface of the wall are neither labeled as baffles nor described as performing the functions of a baffle.

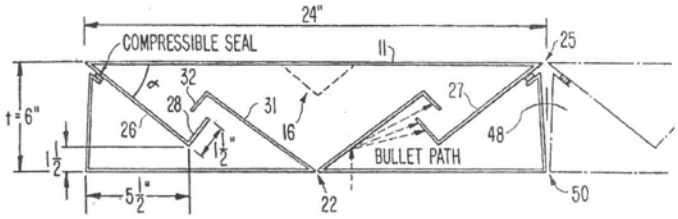

Figure 6 from Phillips' Patent No. 4,677,798 shows a cross section through an assembled wall module indicating the three triangular pieces comprising the wall. Elements 26, 27, and 31 are the disputed "baffles" in the claimed modular wall.

The alleged patent infringer, AWH Corp., created a wall panel having a reinforcing support at a 90-degree angle to the exterior surface of the panel. In defending against the infringement charge, AWH Corp. maintains that Phillips' invention was limited to having the baffles oriented at an acute angle because that was all that was taught by the patent, and thus the angular orientation of the baffle became part of the meaning of "baffle" as used by the patentee. However, Phillips' broadest claim did not specify that the baffle had to be placed at an acute angle to the exterior surface of the module.

The federal district court and the initial appeals court panel ruled in favor of AWH Corp. In the initial decision, the court did what examiners are repeatedly cautioned not to do: they read limitations from the specification into the claims. That initial decision has been withdrawn and the case is now awaiting an *en banc* decision from the full appeals court.

The court is seeking to determine a standard procedure for claim interpretation and the degree to which definitions from dictionaries, expert opinions and treatises—which the court calls "extrinsic" evidence—will be applied *during litigation,* as opposed to the USPTO's interpretation of claims *during prosecution.* "Intrinsic" evidence includes art cited in prosecution, specifications and the entire file wrapper history.

The USPTO's position, as stated in its *amicus* brief filed in this case, is that "primary reliance on intrinsic evidence, rather than later-determined dictionaries that were not part of the record, generates the greatest likelihood that the claim construction will be consistent with the USPTO's interpretation of the claims in issuing the patent."

"During prosecution, claims are given their broadest reasonable interpretation consistent with the specification," the USPTO brief continued. The policy underlying USPTO's approach "stems from the applicant's opportunity during patent prosecution to amend the claims."

The USPTO's Mandate to Examiners

This USPTO position dictates the rules and methods that examiners must use in prosecution. Patent law requires that the definition of a claim term must reflect the perspective of a person of ordinary skill in the art. Examiners are trained to interpret the claims as broadly as possible unless the applicant has explicitly provided a definition to the contrary in the specification or if the specification provides an explicit disclaimer. Examiners are permitted to use dictionaries and other extrinsic evidence to determine the broadest reasonable interpretation.

The philosophies on defining claim terms fall into two broad camps. The "proceduralists" rely on extrinsic definitions to delineate the boundaries of a claim term's possible meanings. The "holistics" look to the rest of the patent application to determine the term's meaning in the context of the application's subject matter.

Dictionary meanings play a role in understanding claim terms, but must be used as supporting tools in studying the context of the application. "The courts may turn to extrinsic evidence to aid in finding the level of ordinary skill in the art," stated the USPTO, "in understanding the intrinsic evidence, and in discerning the meaning that one skilled in the art would give claim terms when read in the context of the entire specification."

The upcoming *en banc* decision has attracted great patent community interest and a huge number of *amicus* briefs. For example, the American Intellectual Property Law Association (AIPLA) stated in its brief filed in this case, "A court should also inquire into the ordinary meaning (or meanings) because these are the *background meanings* that a person of ordinary skill would employ in studying the intrinsic record."

While a "proceduralist" may defend using solely dictionary meanings because of their inherent objectivity, a dictionary definition—even one from a technical dictionary—"may or may not reflect the ordinary meaning in the relevant art and it may not reflect the ordinary meaning at the relevant time," as the AIPLA stated in its brief.

"Litigants have converted claim construction disputes into a 'battle of the dictionaries,'" wrote the USPTO in its brief.

Dictionaries also don't create their definitions with the context of the patent in mind. Therefore, even if claim term definitions are right-on in their dictionary meanings, "the extrinsic evidence, including dictionaries, should always be considered for the purpose of elucidating the intrinsic evidence and not for the purpose of establishing a presumptive meaning of claim terms without reference to the intrinsic evidence," concluded the USPTO in its court brief.

To read the variety of opinions about *Phillips v. AWH Corp.,* including the full USPTO amicus brief, go to www.patentlyobviousblog.com.

POPA 2004 Election Nov. 17–18

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Philippe Derakshani 3700
Kimberly Wood 3600
Vinh Luong* 3600

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Melanie H. Tung* 2900
Caron D. Veynar* 2900

* Incumbent

POPA 2004 Election Guidelines

Election of Officers and Area Delegates will be from 9 a.m. to 4 p.m. on Wednesday, Nov. 17 and Thursday, Nov. 18, 2004, at voting stations located:

At Carlyle: Copy Center room on the Concourse level of the Jefferson Building near the elevators.
At Crystal City:
On Nov. 17: Crystal Park 1, Suite 601, Room D (6th floor)
On Nov. 18: Crystal Park 1, Suite 601, Room C

1. Only members in good standing may vote. This means you must have paid your FY2005 dues or currently be on the payroll deduction program. (Non-dues-paid members see Note 3 below.)
2. Voting procedures will be as follows:
a. Members are to proceed to the voting stations.
b. The voting stations will be managed by contracted temporary workers and election committee members.
c. Members should:
I. Present I.D. card (building pass); tell attendant name and voting area.
II. The attendant will then verify member's I.D. and voting area by comparing to a members' listing by voting area, check off the name from the list and give the member a ballot. The attendant will also check the mailing address for accuracy, and make note of any corrections to be made.
III. The ballot will then be marked at a voting table, folded, and placed in a ballot box. The ballot will not be signed or otherwise identified by the voting member.
IV. Ballots cannot be removed from the voting area (except by election committee members for the purpose of collecting and counting ballots).
d. All dues-paid members may vote for Officers.
e. Members may vote for Area Delegates only in their area of representation, e.g. Chemical members vote for Chemical Area Delegates, etc. Member may submit a blank ballot, vote for only one Area Delegate, or vote for as many Area Delegates as desired up to a maximum of 9 Chemical Area Delegates; 13 Electrical Area Delegates; 7 Mechanical & Business Area Delegates; 2 Design & Other Areas.
f. Write-in candidates are permitted; however, a write-in candidate for an Officer must receive at least 15 votes to be elected while a write-in for an Area Delegate must receive at least 5 votes to be elected.
g. Ballots marked with more than the maximum number of votes permitted will not be counted.
h. No person including candidates will be permitted to interfere with the voting process at the voting station.
3. Persons who cannot produce their official I.D. card should check with Election Co-Chairs Bob Ramseur (Carlyle) at 202-635-7122 or Maria Fernandez (Crystal City) at 410-703-8594. Persons who are not dues-paid POPA members may join, pay their dues, and vote in this election, provided they submit their dues deduction form personally to one of the above election officials.
4. Members are permitted to run both as an Area Delegate and as an Officer; however, they may be elected to only one position. If elected as an Officer, the member's name will automatically be removed from the list of Area Delegates.
5. In the event of a tie vote in any race, a run-off election will be held under the following guidelines:
a. The membership list will be closed, i.e., no new members will be permitted to join and vote in the run-off.
b. Ballots will be prepared and distributed to the affected area, the election will be held and the ballots counted.
c. In the event of another tie vote, the candidates will be notified of same. Candidates will be asked if any wish to withdraw to resolve the contest. Failing this, the run-off will be decided by a coin flip.
6. The candidates for Officers and Area Delegates will appear on the ballots in the order listed on this page (asterisk denotes an incumbent).
7. No campaigning or campaign literature will be permitted within 50 feet of any polling room.
8. The Association shall only give out the name, address and area designation of members to candidates who have submitted valid nominating petitions.
9. No absentee ballots are permitted.

Patent Office Professional Association

Letters from readers are welcome. Address to:

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