

### A Global Patent Application?

- Patent applications are accepted/examined in every industrialized country
- Depending on the country of origin, a patent application may have issues in other countries
- The “Big 3” - U.S., Europe, and Japan - have already taken steps to harmonize applications
- China and Korea are moving towards it too



## Need for a Uniform Format

- Patent applications are currently formatted differently under USPTO, EPO, and JPO rules
- General format differences include:
  - Organization of the Patent Application
  - Section Headings Used
  - Claim Format
  - Manner of describing an invention
  - Treatment of prior art



## Need for a Uniform Format

- USPTO, EPO, and JPO all recommend a specific order for the parts of an application as well as specific content
- An example of differences in order:
  - Placement of Claims in Specification
    - USPTO: At the end of the specification
    - EPO: Not mandatory, but before preferred
    - JPO: Before the specification



## Need for a Uniform Format

- An example of differences in content:
  - Reference Numbers in Claims
    - USPTO: Not required and not advisable for litigation reasons
    - EPO: Preferable and EPC Rule 26(7) prohibits use of numbers to limit claims
    - JPO: No apparent effect on claim construction



## Need for a Uniform Format

- Such format differences result in:
  - Examination Delay
  - Increased Expense
  - Limitations on Scope
  - Difficulty with Electronic Filing and Processing
  - Decreased Ability to Share Efforts among Patent Offices



## Patent Office Efforts

- USPTO, EPO, and JPO are promoting harmonization of patent systems
  - Electronic Priority Document Exchange Program
    - Allows for automatic delivery of certified copies of priority documents among the patent offices
    - Korea Intellectual Property Office recently joined
  - Patent Prosecution Highway Program
    - Allows for accelerated examination based on prior allowance of same claims by another patent office



## Patent Office Efforts

- USPTO, EPO, and JPO are promoting harmonization of patent systems
  - New Route/Triway Proposal
    - Similar to PCT without WIPO, one of the three patent offices performs search
  - Uniform Patent Application Format Proposal
    - Trilateral commission working to create a format that is acceptable in every patent office
    - Many issues still exist



## Unification of Format

- Format issues
  - Sub-headings to be used / not used
    - Problems to be solved
    - Means for solving the problems
    - Effect of the invention
    - Industrial applicability
    - Mode for carrying out invention
    - Cross-reference to related applications
  - Claims to start on new page



## Unification of Format

- Substantive issues
  - Extent of requirement to discuss prior art in background
    - Whether specific reference to art is required
    - Affirmative duty to discuss closest art
  - Level of detail in summary of invention
    - Problems to be solved
    - Construction of the invention
    - Effect of the invention



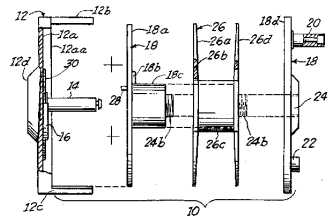
## Unification of Format

- Stylistic issues
  - Even unified format proposals may leave room for problems in the U.S.
    - Detail in summary and abstract may limit claims
      - Many cases illustrate this
    - Problem/solution approach may limit claims
      - Broadest claim may not be limited to arrangement that solves all recited problems
  - Use of definite article
    - « the invention is »



## Specific Examples

- *Cortland v. Orvis* - Fed. Cir. (Feb. 2000)
- Fly fishing reel
- Reel includes:
  - first end plate
  - first spool axle
  - second end plate
  - connecting means





## Specific Examples

- ***Cortland v. Orvis* - Summary:**
  - Claimed invention was an interchangeable cartridge spool that allowed fishing line types to be rapidly changed
  - The Orvis device used a single end plate and was attached to the housing using a rubber grommet and plastic insert
  - District Court granted Summary Judgment on both literal infringement and doctrine of equivalents



## Specific Examples

- ***Cortland v. Orvis* - Primary issue on appeal:**
  - Meaning of the term “plate”
    - Court referred to the Brief Description of the Drawings to determine meaning:
      - “Moreover, in the ‘003 patent’s “Brief Description of the Drawings,” the patentee states that ‘FIG. 1 shows a side elevational view ... in accordance with the present invention.’ (Emphasis added by the court).
      - “Indeed, figure 1 illustrates the only embodiment of the invention.... Thus the specification supports the conventional meaning of the word “plate” as a broad, flat disc.”



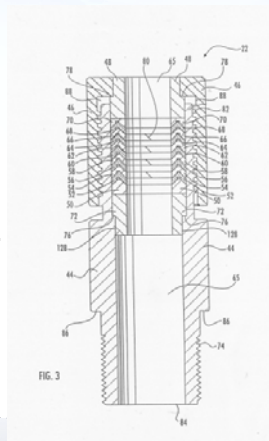
## Unification of Format

- Potential problems
  - Lack of alternative examples/embodiments
    - Sole embodiment invites narrow claim construction
  - Claims to only method or apparatus/product
    - May limit recovery
  - Narrative / Functional claim format
    - Often indefinite and difficult to examine/construe



## Specific Examples

Example claims for a “Stuffing Box”





## Specific Examples

- Stuffing box - overview:
  - Used at the wellhead in oilfield operations
  - Outer casing housing a plurality of seal rings
  - Seals against a reciprocating and/or rotating polished rod so as to allow motion of the rod while maintaining fluid pressure downhole
  - Two part construction allows for replacement of seal rings without disconnecting drill string



## Narrative Claim

A sealing apparatus for a reciprocating polished rod comprising a seal having a plurality of seal rings disposed between a first bushing and a second bushing, the seal and the two bushings being placed within a channel in a body to which a cap is releasably attached, such that upon connection of the cap to the body opposing mating surfaces on the body and the cap compress the seal against the reciprocating polished rod.



## Functional Apparatus Claim

A sealing apparatus for a reciprocating polished rod, comprising:

a body for receiving the polished rod; and

a seal for preventing leakage of a fluid alongside the polished rod by radial pressure of a plurality of seal rings that are compressed between a first bushing and a second bushing within the body when a cap is threaded onto one end of the body.



## Outline Form Claim

A sealing apparatus for a reciprocating polished rod, comprising:

a body having a first end, a second end, a channel for receiving the polished rod, and a first mating surface formed on an interior surface of the body, wherein the first end is adapted for engagement with a well;

a first bushing disposed within the channel and engaging the first mating surface;



## Outline Form Claim (cont.)

- a plurality of seals disposed within the channel adjacent the first bushing;
- a second bushing disposed adjacent the plurality of seals; and
- a cap having an aperture for receiving the polished rod and defining a second mating surface, the cap being removably engaged with the second end of the body such that the second mating surface engages the second bushing.



## A Global Patent Application

- Draft original application taking into account the known format differences
- Take advantage of fresh knowledge of an invention when originally drafting application
- For given countries, draft alternates up front:
  - claim sets, abstracts, summaries, and even detailed descriptions in the preferred form



## A Global Patent Application

- Request local counsel review and revise application **before** filing in a given country
- Perform pre-filing review for in-coming U.S. filings
  - File original language version and revise translation, or
  - File together with preliminary amendment, or
  - Make substantive revisions at first office action



Thank You.  
Any Questions?