



UNITED STATES PATENT AND TRADEMARK OFFICE

UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND
DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE

February 11, 2005

Mr. Neil Wilson
Director and Chief Information Officer, IT Division
World Intellectual Property Organization
34, chemin des Colombettes
1211 Geneva 20
SWITZERLAND

Re: SCIT 2605

Dear Mr. Wilson:

Attached is the USPTO response to the Questionnaire on the Harmonization and Identification of the Parts of Patent Specifications (SDWG Task No. 36). Should you have any questions, please contact me at cherie.kazenske@uspto.gov or Ed Rishell at ed.rishell@uspto.gov.

/Signed by/

Cheryl E. Kazenske
International Intellectual Property Program Manager
Office of International Relations

Questionnaire on the Harmonization and Identification
of the Parts of Patent Specifications

*approved by the SCIT Standards and Documentation Working Group
at its fifth session on November 11, 2004*

Task No. 36: Prepare a questionnaire and carry out a survey in order to clarify the different practices by industrial property offices regarding difficulties in citing specific parts of the description of the invention text in a patent document. Prepare a proposal regarding this matter for consideration by the SDWG.

Please provide the following contact information in order for us to contact the person responsible for the Questionnaire in case of need:

<u>Contact details of the Reporting Office:</u>	
Name of the Reporting Office	<u>US</u> (ST.3 two-letter country/organization code)
Person to contact	Name: <u>Ed Rishell</u>
	Tel. number: <u>1-571-272-7824</u>
	E-mail: <u>ed.rishell@uspto.gov</u>

Q U E S T I O N N A I R E

1. Does your Office use any practices to make citing of specific parts of patent documents possible independent of the media and formats on which the document is stored or published?

YES NO

2. In the light of new developments in media and formats, is your Office planning to introduce new practices regarding citing of specific parts of patent documents?

YES NO

3. If your Office is planning to introduce those practices, when will they be introduced?

4. In WIPO Standard ST.36 paragraph numbering in patent document is foreseen. If your Office is using or planning to use practices for unambiguous citing of the text, which practices are or will be used?

- Paragraph numbering
 Sentence counting
 Word Counting
 Other – Please specify:

For patent application publications, paragraph numbering is used for both images (Yellow Book 2 based on ST.33) and full text (Red Book ICE based on ST.36). For patent grants, columns and line numbers are used in the image data only.

5. If paragraph numbering is done or foreseen by your Office, who defines or will define the paragraphs to be numbered?

- (a) Basically the applicants
 (b) The Office, e.g. the examiners
 (c) Other –Please specify:

For patent application publications, the publication contractor numbers paragraphs in their logical order at the time of publication for most applications (paper or electronic), ignoring any paragraph numbers applied by the applicant (since they might no longer be in ascending numerical order by time of publication).

For patent grants, the publication contractor ignores paragraph numbers applied by the applicant and provides paragraph numbers for Grant Red Book ICE (based on ST.36) and numbers and columns in Grant Yellow Book 2 (based on ST.33).

6. If according to 5 (a) the applicants define or will define the paragraphs, does or will your Office give guidance as to, e.g., how long a paragraph should ideally be?

YES NO

Comments, if necessary:

7. If your Office is using or planning to use practices for unambiguous citing of the text, how are the claims treated (or how will they be treated)?

Claims for patent application publications are numbered by the applicant. Claims for patent grants are numbered using consecutive Arabic numerals starting with the number 1. Claim step numbering within a claim normally reproduces whatever the applicant submitted in terms of outline style.

8. Does your Office count or intend to count other parts of the specification apart from textual parts, e.g., embedded images, tables, etc.? Please specify:

Some embedded images are already counted; for example, chemical structures and mathematical equations. Applicants may provide numbering for tables, formulas, etc. that will appear in the image of the document and may be cited by a user. For published patent applications, the paragraph number near an imbedded image or table may be included in a citation, necessary or desired. For granted patents, the column and line number near the imbedded image or table may be cited.

9. Do you plan to create within the user interface of your electronic patent information products or services an option to suppress the display of the numbers allotted to paragraphs, sentences, etc.? Please specify the products or services and the methods used:

No

10. If your Office has introduced or is planning to introduce e-filing, does it intend to implement or change its practices concerning the citing of specific parts of patent documents with regard to e-filing?

YES NO

Please elaborate: *When citing published US patent application publications, the examiner will continue to cite the relevant paragraph numbers. When citing granted US patents the examiner will continue to cite the relevant column and line number.*

11. What are, according to the position of your Office, aspects which seem to be difficult?

Long paragraphs – Comments, if necessary: *Paragraphs that extend over more than one page are most often broken into multiple "sub" paragraphs that read very much like a claim with a large number of claim steps. We now treat these as unordered lists (list without bullets) and give them paragraph numbers as if they were separate paragraphs.*

Other –Please specify: *We currently do not include tables, equations, formulas, in the sequence of paragraph numbering. It is not clear whether we should we have only one sequence for numbering all objects throughout the document, or if we should maintain separate numbering for different object types. Examiners and other users will need to be consulted about their experiences.*

12. Do you intend to introduce additional measures to solve the problem of unambiguous citing?

Instructions to the applicant

Other –Please specify: *Not at this time.*