

From: Carmichael, James T.
Sent: Friday, January 04, 2013 3:38 PM
To: SoftwareRoundtable2013
Subject: Software Roundtable

I would like to register for the New York City event on February 27 and make an oral presentation on the topics listed below. Here is the required information:

1. The proposed speaker

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2. Which roundtable event I wish to attend

New York City.

3. Topic and approximate desired length of oral presentation

I would like to give an oral presentation on the following issues related to use of means-plus-function claims in software patents, as identified in the 3 January 2013 Request for Comments and Notice of Roundtable Events for Partnership for Enhancement of Quality of Software-Related Patents. Fifteen minutes or less would be sufficient.

As an Associate Solicitor, I represented the PTO in *In re Donaldson*, 16 F.3d 1189 (Fed. Cir. 1994)(en banc). In that case, the PTO argued to the Federal Circuit that the PTO was ill-equipped to apply 35 U.S.C. 112 (f) (then sixth paragraph) and should not be made to do so. The Federal Circuit disagreed. The *Donaldson* case led to issuance of PTO guidelines, still in use today, for determining when 112(f) would be invoked and whether sufficient structure is disclosed. Using the *Donaldson* case as a starting point, I would suggest the PTO is doing a good job applying 112(b) and (f) in software patents. Software patent quality could be improved by better searching, not by changing procedures relating to 112(b) and (f).

The question of whether 112(f) is invoked is well handled by current PTO guidelines. For example, claims lacking the traditional “means for” or “step for” language are presumed not to invoke 112(f). Proposals are currently being floated by anti-software groups to interpret all software and business method patents as invoking 112(f), partly as a way to narrow the claims in view of Supreme Court jurisprudence applying 35 U.S.C. 101. These proposals are misguided. Large numbers of patents have been examined and issued under the current PTO guidelines. The PTO is to be commended for issuing such clear and flexible guidelines for determining whether 112(f) is invoked. The PTO guidelines should not be changed, and Courts should defer to them when evaluating whether 112(f) is invoked.

A requirement that every applicant expressly identify clauses within particular claim limitations for which the inventor intends to invoke 35 USC 112(f) and point out where in the specification the corresponding

structures, materials, or acts are disclosed that are linked to the identified 35 U.S.C. 112(f) claim limitations is too strict a requirement to impose on every applicant. Existing PTO guidelines addressing both those issues are working well. Examiners appropriately ask applicants to point out the corresponding structures, materials, or acts in cases where it is needed. Both applicants and examiners would be unnecessarily burdened by imposing such a requirement in all cases. Further, imposing a blanket requirement could lead to a decrease in patent quality if patent drafters responded by pointing to a boilerplate listing in the specification mentioning every imaginable structure, material, or act.

Currently, the requirements of 35 U.S.C. 112(b) are typically being complied with by applicants and properly applied during examination. It usually takes very little disclosure to convey to one of skill in the art what structure would perform an identified function executed in software. Those skilled in computers generally know what hardware is needed to run software, and what software is needed to implement algorithms. The level of detail required for disclosure of an algorithm depends on the particular invention. Applicants usually provide sufficient detail to enable practicing the invention, and that is generally enough for the sufficient structure requirement.

An instructive example is found in *Touchcom v. Bereskin & Parr*, 574 F.3d 1403 (Fed. Circ. 2009). I served as an expert witness in that case. In *Touchcom*, the specification included source code for most of the functional claim limitations but accidentally omitted the support for one of them. The court held the patent invalid for indefiniteness. I would present the argued support for the invalidated claim as an example of what has been determined to be insufficient disclosure for a software invention.