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Tom: Hello everyone and welcome to WIPR Patents Live, I'm Tom Phillips, group editor of WIPR, and today we're going to speak with two lawyers about an interesting patent dispute case that patent owners should take note of, especially in the software industry.

Now let me introduce our experts – they are BSKB partner David Bilodeau, and associate Brad Fritz, also at BSKB, hi guys,

Brad: Hello.

David: Hello.

Tom: Thanks very much for joining us today.

David: Thank you.

Tom: Now I'm going to do a bit of a hand fisted intro to the case before I hand it over to David and Brad – basically, we're talking about Rain Computing V Samsung. Now this involved a patent directed to delivery software applications to a terminal in a network based on user demands, and I'll let our experts explain a bit more about what that is.

It was heard at a Massachusetts District Court, where Rain Computing prevailed, but on appeal the Federal Circuit overturned the lower court's decision and Samsung walked away. Now what marks this case out is the lessons patent owners can draw regarding tricky means-plus-function interpretations in patent claims.

The Federal Circuit held that a claim in Rain's patent was indefinite for lack of adequate description. Now that's my basic overview, and I'm going to turn to our experts here for a little bit more detail. First of all, putting it to you Brad, can you describe it in a little bit more detail about what the case involved, and what the patent was related to please?

Brad: Yes, so this case involved a small inventor, and just to provide some context, this inventor had a few patents but he's also a patent attorney, and he's a partner in his own practise. And the way he described it is his invention was directed to Raining down applications to the client to distinguish from cloud computing.

So, he got a patent, and the independent claim was rather broad, and then he went after Samsung and sued them for infringement, and he targeted some of their app store services. And this whole case hinged on means-

plus-function language and the use of a user authentication module. And I like to think of it as a type of sword and shield type of situation, so here – sometimes people like to claim or use means-plus-function language to be more broad, so he had a user authentication module, but he didn't want to explain exactly how it worked in the claim to keep it broad.

But then, the court looked at that and they said, "OK, we don't know exactly how it works, and you don't have support for exactly how it works, there's no algorithm or steps" and then they said, "There's lack of written description under 1.12A which leads into a cascade." And then, "If you don't know how it works then that makes it indefinite under 1.12B" and they invalidated it for that reason.

Tom: OK, so going back a little bit there, what did the US District Court of Massachusetts rule, and then we can follow on with what the Court of Appeal said?

Brad: The District Court of Massachusetts had a similar outcome, they held the claim invalid but for a different reason, but as to the user authentication module they disagreed with the Federal Circuit – well they didn't – there was no Federal Circuit decision yet, but they found that it was acceptable and that there was enough support in the specification because there was one paragraph that did show some hardware, such as the SIM card, or CD-ROM that related to the user authentication module.

Tom: I see, OK – now can we get into the means-plus-function disclosure that was sort of at the heart of this case, why was that important?

Brad: The means-plus-function was very important because, like I said before, you can use the means-plus-function language in a claim to keep it broad because you claim the user identification module for controlling access to software packages, and there can be a lot of different ways for how that access is controlled.

So rather than specify an exact algorithm or steps, he left it broad and utilised the means-plus-function language. And using the word module is a red flag that tips off examiners or judges that, "Hey, this could potentially be interpreted on a 1.12f, and we need to look to the specification for what type of structure is linked to the means-plus-function language."

Tom: I see, so this wasn't your kind of average plaintiff in the sense that this was someone who had knowledge of the way you construct the language around this?

Brad: Correct, and the fact that he was a small inventor, he's a patent attorney himself, and given that it appeared that he's maybe a non-practised entity, or at least viewed as one, and then you're suing Samsung – I think all of those things taken together also weighed into the court's decision.

Tom: Right, I see – OK brilliant, I think we covered quite a lot of that bit, so

turning to you David.

David: Sure.

Tom: Let's talk about the prosecuting strategies that you can get from this case.

David: OK, first the interesting thing with day-to-day practise, as most patent attorneys are finding out now, is the means-plus-function rejection is becoming very common in [office actions]. It's the new big thing that's happening in patent law, and what's happening is examiners are – if they see module or unit, or any controller, they claim means-plus-function and then when they do that they go to the specification and look for the support.

So the specification must have the algorithm, which is a flowchart, or some type of steps – without that algorithm the controller is held to be indefinite for lack of written description. So it's very important in electronics patent law, particularly with electronic devices, we always have a controller, which is really just a chip, it's a processor.

But there's really no way to avoid means-plus-function when you claim a processor configured to control and AC generated to output a wave form. I had a recent case where I got a rejection 1.12f, and then they go in to look in the specification and they said I didn't have written support. So I go to the specification, and I explain to the examiner where the written support is in order to avoid that lack of written description.

So it's become – the number one issue right now in examination is this 1.12f means-plus-function interpretation, and then the examiner goes to the specification to show the written support. The interesting thing is now the examiners actually go to the specification – before they would claim means-plus-function and leave it like that.

Now they actually go to the specification and point where the support is, they believe the support is, or where the support is not. So you always – it seems like every case I get now has a 1.12f rejection because of the use of the term controller. To me the controller is just a general-purpose computer but when you input the algorithm, that's the structure.

So it's a little counterintuitive, the software that the controller performs is the structure, is the sufficient structure, so what I've been doing is – I take the algorithm steps or instructions and put it into the claim, and that's one way to avoid – once you have the algorithm in the claim, the controller is no longer a means-plus-function element.

So, Brad, I think you've been having a lot of those cases as well with the 1.12f rejection.

Brad: Yes correct, I see it very often now, but like David said, now if they make a 1.12f interpretation, examiners will often say that there is support and

they'll point to the examples instructions specification for how they're interpreting that type of module or union to be.

David: So, Tom, the one thing that's important is that – so we talked about the algorithm, which is really a flowchart that you use in order to programme. So a programmer would get a flowchart and they would write the code necessary for performing those functions. You don't have to put the code into the specification, but you absolute have to have the flowchart, many flowcharts, describing how the controller performs that function.

           You can't just say a controller for outputting a sign wave, you almost have to describe how it's done – that's a little bit different than in the past, before we could say a controller configured to control a generator to output a sign wave, that would be sufficient. But now, you actually have to do a little bit more detail and put those instructions in.

           And this is a good point because foreign companies filing US patent applications should have the attorney perform – we call it a revision, so we revise the case before it's filed, we check for these type of things, and then you can make sure that there's sufficient written description.

Tom: What I was going to ask was why is this happening, what's driving it?

David: Rain versus Computing, is one of the cases that's driving it, there's Team Worldwide which is a recent case, a similar case where the same thing happened, it's just one of those things like I guess it was maybe eight years ago it was 101, and –

Tom: I see, it's changed –

David: About every 10 years something comes up new and it's –

Tom: Yeah, keeps you on your toes.

David: Yeah, keeps you on your toes. Now Brad, even looking at Rain, you know Rain versus Computing had a SIM which is – a SIM card, which is a Subscriber Identity Module, so one could argue that the specification did provide sufficient written description. Now you can argue that one skilled in the art would understand based on that description how to make or use the invention.

           But the problem with that is – you can get into a little bit of trouble, so it's much better to not have to argue that, that's the last thing you want to do is argue that the specification doesn't include the support, but one skilled in the art would know how – would know how this works.

Tom: Brad, any final thoughts?

Brad: Yeah, I just want to follow up on what David said about how important it is to have support in the specification for algorithms or steps, for how the

module or unit carries out the means-plus-function language because this is what the Federal Circuit hinged their opinion on – is they looked at the examples given in the specification, like a SIM card, and IC card, memory card or CD-ROM.

But then they said, "Well it doesn't say how those work to control access" and they said, "Those are all generic computer readable media or storage" and then they said, "They just amount to a general-purpose computer." And the way I like to think about it is – you can take a general-purpose computer, but if you disclose a specific algorithm in your specification that's carried out by that computer, then that transforms that general-purpose computer into a specific special purpose computer.

So, without the disclosed algorithm you can't say you have a special purpose computer, so Rain did not have a good argument against the Federal Circuit's analysis saying that the limited examples merely amount to generic or general-purpose computer.

David: There's also another interesting point following up with Brad is that – a lot of these cases, for instance, Rain versus Computing, Team Worldwide, these type of cases, the element that's being held as indefinite for not having proper written description is not the patentable feature, it's just a regular feature that's not even relied on for the novel feature.

And the other thing is it's happening after the case is granted, so these cases go through prosecution, get a Notice of Allowance, and then in litigation this issue comes up. So it's very important that the attorney makes sure there's proper written description, which when you talk about a controller, or a processor, it's an algorithm.

Brad: Yeah, but to follow what David said – or if the feature is not important for novelty, don't claim it, because you're opening the door to further issues. Here Rain said that the user identification module was well-known to one skilled in the art, and that code for implementing it was readily available online, so if it's well-known maybe you have no business claiming in the first place.

Tom: OK.

Brad: You can protect yourself that way.

Tom: Thank you, I want just a final thought on which industries need to take note of this, which sectors in particular?

David: I can start with it's mostly what I work in, and I do a lot of wireless communication electronics, and every electronic claim has a controller, and in the old days it would be a controller for doing this, we would change for to configure to, we put hardware dash embedded processor – these type of changes are not working anymore.

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So, if you put a hardware embedded processor instead of a controller, it's still not going to transform that processor into a special purpose computer, so you have to put the algorithm into the controller part of the claim. So it's software and any electronics, even the TV, cell phones, these type of things, where you can claim a controller result in this problem.

Tom: Brad, anything else to add?

Brad: Right, just like David said, the best practise would be to include the algorithm or steps in the claim for performing the means-plus-function language, or at the very least, if you want to keep it broad, at the very least, make sure there is support in the specification for an algorithm specifying the steps that a special purpose computer would carry out to perform the claims functions.

And here it would be how – explaining how Rain controlled access to the software.

Tom: OK, thank you very much – thank you so much for that, for explaining that and what's going on on the ground right now, I'm sure a lot of people are going to find it very useful, especially in those industries you work in David and Brad.

For those watching at home, if you want more on this fascinating case, we have David and Brad's article in WIPR issue three, so I really recommend you go and check that out. But for now, that's goodbye from David and Brad, thank you guys.

David: Thank you Tom.

Brad: Thank you Tom.

Tom: I've been Tom Phillips, and you've been watching WIPR Patents Live, please do join us again soon, goodbye.

David: Goodbye.

Brad: Goodbye.

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