

USPTO Soliciting Comments on Software Patent Issues

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The United States Patent and Trademark Office announced its intent earlier this month to form a “Software Partnership” with the software community in order to enhance the quality of software-related patents (the “Notice”) and, in furtherance of this goal, to host at least two roundtables on February 12 and 27, in Silicon Valley and New York City, respectively.

While the Notice does not specifically address flaws in the patent system, it references public commentary and stakeholder feedback the USPTO has received on software-related patents and “insight based on court cases in which software-related patents have been the subject of litigation.” This is likely a reference to the series of high-profile smartphone lawsuits involving companies such as Apple, Samsung, HTC, Motorola and Nokia.

There will be three initial topics for the roundtable events. The first topic is focused on establishing clear boundaries for claims that use functional language “to effectively ensure that the parameters of a claim are clear so that the public can understand what subject matter is protected by the patent claim and the patent examiner can identify and apply the most relevant prior art.” The second topic requests that the public identify additional topics for future discussion by the Software Partnership. The third topic relates to a forthcoming “Request for Comments on Preparation of Patent Applications.” According to the Notice, these initial topics are intended to be the first of many topics to be explored in a series of roundtables that may ultimately be used for USPTO quality initiatives, public education or examiner training.

The public debate with respect to software patents is highly polarized. In responding to critics of software patents, David Kappos, the outgoing director of the USPTO stated in a recent keynote address that “patent protection is every bit as well-deserved for software-implemented innovation as for [other technological innovations].” However, he also acknowledged that software patent protection must be “properly tailored in scope, so that programmers can write code and engineers can design devices without fear of unfounded accusations of infringement.”

The Software Partnership appears designed to solicit input from a broad spectrum of participants. According to the Notice, while “public attendees will have the opportunity to provide their individual input, group consensus advice will not be sought.” This statement no doubt recognizes the deep division within the software community between those who believe that overly broad software and business methods patents are often asserted frivolously, and companies which seek to protect legitimate patents based on groundbreaking innovation. Given the openness of the forum to diverse opinions, it remains to be seen how productive the roundtables will be over the coming year.

About the Authors

Ms. Bromberg is the head of the firm's Intellectual Property and Licensing Group. She handles all aspects of intellectual property, Internet and technology law, and management of IP litigation (including protection, defense and enforcement of patents, trademarks, domain names, copyrights, and trade secrets). She was named as a New York *Super Lawyer* for Intellectual Property in 2010, 2011, and 2012.

Mr. Hanson is an associate in the firm's Intellectual Property and Licensing Group. He has experience in large-scale, complex patent litigation in a wide variety of areas, including computer architecture, networking and wireless communications, data compression and storage. He graduated, *cum laude*, from Harvard University with a B.S. in Physics, earned a M.S.E. in Computer and Information Science from the University of Pennsylvania, and received a J.D. from Columbia Law School. Mr. Hanson is registered to practice before the United States Patent Bar.

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