



Patent Resources Group

The *Bilski* Impact: Procuring and Enforcing Software, Business Methods and Bioinformatics Patents

Course Syllabus

- I. **INTRODUCTION TO HYPOTHETICAL INVENTIONS USED TO ILLUSTRATE THE PREPARATION AND ENFORCEMENT OF SOFTWARE PATENTS**
 - A. Software Hypothetical No. 1: Voice Validation System for Internet Transactions
 - B. Software Hypothetical No. 2: System of Related Websites
- II. **STATUTORY SUBJECT MATTER: CASES AND GUIDELINES**
 - A. Software Patent Subject Matter
 - B. The Statute and Cases That Control Claim Drafting
 - 1. Statutory Foundation and Overview
 - 2. Intro to *Bilski*
 - 3. Early Cases (*Benson et al.*)
 - 4. *In re Alappat*
 - 5. *In re Warmerdam*
 - 6. *In re Lowry*
 - 7. *In re Beauregard*
 - 8. *State Street Bank*
 - 9. *AT&T*
 - 10. Recent Other Cases - Pre-*Bilski*
 - 11. *In re Bilski*
 - 12. Post-*Bilski* Cases
 - 13. Summary of Cases
 - 14. Post-*Bilski* Strategies
 - C. Examination Guidelines for Computer-Related Inventions
 - 1. 2005 Guidelines Overview
 - 2. Expected Changes After *Bilski*
 - D. Brief Comparative Analysis of Patent, Copyright and Trade Secret Protection for Computer Software
 - 1. Other Available Forms of Protection
 - 2. Summary of Copyright Protection for Software
 - 3. Summary of Trade Secrets Protection for Software
 - 4. Summary of Design Patent Protection for Software
 - 5. Summary of Contract Protection for Software
- III. **LAW RELATING TO SOFTWARE CLAIMS**
 - A. Claim Interpretation
 - 1. Interpretation of Various Terms
 - 2. Chasing an Evolving Standard: The "Written Description" Requirement
 - B. Direct, Contributory and Inducing Infringement
 - C. Doctrines of Equivalents and Prosecution History Estoppel in the CAFC
 - 1. *Warner-Jenkinson v. Hilton Davis*
 - 2. *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.* (CAFC)



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3. *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.* (Supreme Court)
 4. *Johnson & Johnston Associates v. R.E. Service Co.*
 5. Intent Plays No Role
 6. Element-by-Element Basis
 7. Insubstantial Differences vs. Triple Identity Test
 8. Equivalents at Time of Infringement
 - D. Means- and Step-Plus-Function Claims in the CAFC
 1. Concerns With Scope
 2. Legal Effect of Concluding That §112, ¶6 Analysis Must Be Used
 3. Use of "Means" Invokes a Presumption That Means-Plus-Function Analysis Must Be Used
 4. Recitation of Sufficient Structure Precludes §112, ¶6 Analysis
 5. When Does a Term Connote Function as Opposed to Structure?
 6. Recent Decisions Defining "Equivalent" Structure Under §112, ¶6
 7. *Overhead Door Corp. v. Chamberlain Group, Inc.*
 8. Means-Plus-Function Clause Functional Equivalents
 9. USPTO Final Examiner Guidelines for Means-Plus-Function Claims
 10. Step-Plus-Function Elements
 11. Doctrine of Equivalents Applied to Means-Plus-Function Claims
 12. Summary of Means-Plus-Function Law in the Federal Circuit
- IV. SOFTWARE PATENT AND BIOINFORMATICS CLAIMING STRATEGIES**
- A. Optimal Claiming Strategy
 - B. "Point of View" for Each Claim
 - C. Direct Infringement vs. Indirect Infringement
 - D. Optimizing for Direct Infringement and Expansion of Royalty Base
 - E. Jurisdictional Issues and the Extraterritorial Scope of the Patent Infringement Statute
 1. Extraterritorial Infringement Under §271(a): Use Outside the United States
 2. Extraterritorial Infringement Under §271(a): Offers for Sale and Sales Within and Outside the United States
 3. Exporting Components of a Patented Invention: §271(f)
 4. The Process Patent Amendments Act of 1988: §271(g)
 - F. 2005 Examination Guidelines for Computer-Related Inventions
 - G. General Claiming Strategies
 - H. Types of Claims and Examples Thereof
 1. Method and Apparatus Claims
 2. Computer-Readable Media Claims/*Beauregard* Claims
 3. Data Structure/*Lowry* Claims (Data or Memory Structures)
 4. Propagated Signal "Carrier Wave" Claims - No Longer Available



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5. Application Programming Interface (API) Claims
6. Clone Buster Claims
7. User Interface Claims
8. Software-Related Business Technique Claims
9. Bioinformatics Claims
- I. Analyze Claims in Sample Issued Patents; Sample Claims That May Cause Problems With Proving Infringement
- J. Post-*Bilski* Claim (and Specification) Strategies
- V. THE PATENT SPECIFICATION**
 - A. Law Relating to the Software Patent Specification
 1. Enablement
 2. Best Mode
 3. Written Description
 4. Statutory Bars
 5. Real-Life Potential Software Statutory Bar Events
 - B. Disclosure of Software Which Is Proper and Which Is Not Needed for Inclusion in the Specification
 1. For Enablement, Written Description, Best Mode
 2. Description of Hardware
 - C. Illustrative Step-by-Step Preparation of Software Patent Specifications
- VI. PRIOR ART FOR SOFTWARE AND BIOINFORMATIC PATENT CLAIMS**
 - A. Reasons for Finding and Disclosing Prior Art
 - B. Finding Relevant Prior Art
 1. Conventional Patent Collection Searching
 2. On-Line Patent Searching
 3. Finding Non-Patent Prior Art
 4. Include Applicant's Own Prior Versions That Are Prior Art
 - C. Disclosure Statements
 1. Disclosing Non-Patent Prior Art Documents
 2. Disclosing Prior Art Software
- VII. LITIGATION OF SOFTWARE PATENTS**
 - A. Personal Jurisdiction in Software Litigation
 1. General Issues of Personal Jurisdiction
 2. Minimum Contacts and Due Process
 3. Minimum Contacts in Patent Infringement Litigation: *Beverly Hills Fan Company*
 4. Personal Jurisdiction in Software Patent Litigation
 5. Cases Involving Infringement of Software Patents and the Internet
 6. Sample Jurisdiction and Venue Scenarios
 7. Suggestions for Software Patent Claims
 - B. Claim Construction During Litigation



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- 1. Differing Views Presented in *Cybor*
 - 2. Claim Construction After *Markman/Cybor*
 - C. Reexamination
 - D. Relief
 - 1. Damages
 - 2. Injunctions
 - 3. USITC Exclusion Orders
- VIII. ETHICS**
- A. Duty of Disclosure 37 CFR §1.56
 - B. Subject Matter Conflicts of Interest