Decoding Software Patents: Best Strategies for Drafting, Prosecution & Litigation

Course Syllabus

I. INTRODUCTION TO HYPOTHETICAL INVENTION USED TO ILLUSTRATE THE PREPARATION AND ENFORCEMENT OF SOFTWARE PATENTS
   A. Software Hypothetical: Voice Validation System for Internet Transactions

II. STATUTORY SUBJECT MATTER §101: TROUBLED AND IN FLUX
   A. Software Patent Subject Matter – Where We Are, Where We Are Headed
      2. “Abstract Idea” Undefined
      3. “Conventional, Routine and Well-Understood” - Analysis Involves Fact Issues
      4. Berkheimer Case – Not Resolvable on 12(b)(6)
      5. Latest USPTO Memos
   B. The Statute, Cases and Guidelines That Control Software Claim Drafting
      1. Statutory Foundation and Overview
      2. Summary of Pre-Bilski cases
      3. In re Bilski, Mayo v. Prometheus
      4. Alice v. CLS Bank
      5. Summary of Key CAFC Cases in Which Patent Eligibility Was Found:
      6. Drafting Strategies With Respect to the Specification and Claims in Reaction to Decisions
   C. Examination Guidelines for Computer-Related Inventions
      1. (Post-Alice) Guidelines Overview
      2. January 2019 Guidance
   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
      5. Summary of Contract Protection for Software

III. LAW RELATING TO SOFTWARE CLAIMS AND ENFORCEMENT
   A. Claim Interpretation
      1. Interpretation of Various Terms
      2. Chasing an Evolving Standard: The "Written Description" Requirement
   B. Direct, Contributory and Inducing Infringement
      1. BMC Resources v. Paymentech; Muniauction v. Thomson; Akami v. Limelight
      2. Centillion Data v. Qwest; Global-Tech v. SEB
   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 & Supreme Court)
4. Intent Plays No Role
5. Element-by-Element Basis
6. Insubstantial Differences vs. Triple Identity Test
7. Equivalents at Time of Infringement

D. Value and Appropriate Use of Means- and Step-Plus-Function Claims to Maximize Protection
   1. Concerns with Scope
   2. Legal Effect of Concluding That §112(f) 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(f) Analysis
   5. When Does a Term Connote Function as Opposed to Structure?
   6. Recent Decisions Defining "Equivalent" Structure Under §112(f)
   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

IV. SOFTWARE PATENT 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)
   F. 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. Application Programming Interface (API) Claims
      5. Clone Buster Claims
      6. User Interface Claims
      7. Software-Related Business Technique Claims
   I. Analyze Claims in Sample Issued Patents; Sample Claims That May Cause Problems With Proving Infringement
   J. Post-Mayo/Alice Claim (and Specification) Strategies in View of Recent Cases

V. THE PATENT SPECIFICATION
   A. Law Relating to the Software Patent Specification
      1. New Cases on Drafting the Specification to Help with 101: Thales Visionix & Visual Memory
2. New Cases on Indefiniteness: Sonix Technology, One-EWayu & Tunnus Enterprises
3. Enablement and 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

VI. LITIGATION OF SOFTWARE PATENTS
   A. Latest Cases TC Heartland, Cuozzo, Oil States, SAS
   B. Personal Jurisdiction in Software Litigation
      1. General Issues of Personal Jurisdiction, Minimum Contacts and Due Process
      3. Personal Jurisdiction in Software Patent Litigation
      4. Cases Involving Infringement of Software Patents and the Internet – Divided Infringement/Joint Infringement
      5. Sample Jurisdiction and Venue Scenarios
   C. IPR and Covered Business Method Patent Review
   D. Money Damages
      1. Damages Theories
      2. Damages for Activities Outside the U.S.

VII. ETHICS
   A. Duty of Disclosure 37 CFR §1.56 with a Focus on Software Patents
   B. Subject Matter Conflicts of Interest with a Focus on Software Patents

VIII. OPEN SOURCE LICENSES
   A. Overview of Open Source Software (OSS)
   B. Introduction to GNU GPL and Lesser GPL, “Copyleft”
   C. Modifications, Derivatives and Linked Works (“MDLW”) under GPL
   D. Rise of More Permissive (OSS) Licenses
   E. Patent License Grant Clauses in OSS Licenses
      1. Apache
      2. Mozilla
      3. IBM Public License
   F. Open Source Patent Pool
   G. Managing OSS Use
      1. Collecting Use Data Sufficient for Compliance
      2. Compliance Analysis
      3. Compliance Provisions in Commercial Licenses
      4. Enforcement Risks