USPTO's Scrutiny Of Software Patents Paying Off

Law360, New York (July 22, 2014, 7:16 PM ET) -- Though recent U.S. Supreme Court rulings have not provided much help, the U.S. Patent and Trademark Office's efforts to more closely scrutinize software patents is reducing the incentive for patent applicants to seek vague, broad claims, experts told USPTO officials at a forum Tuesday.

At a meeting of the USPTO's Software Partnership, a group created to work with the software community on patent issues, attorneys and representatives of several technology companies praised the office's increased training for examiners aimed at bringing more clarity to software patents, which they said have too often been overbroad in the past.

The new training is helping examiners identify patents that are too vague and is starting to change the landscape of patent prosecution, said Christopher Bullard of Oblon Spivak McClelland Maier & Neustadt LLP.

Prior to the office's increased focus on clarity in software patents, many patent applicants strove to write claims as broadly as possible to obtain greater coverage, but the USPTO's efforts have made clear that doing so may no longer be beneficial to clients, said Bullard, speaking as a representative of the American Bar Association's Section of IP Law.

"The idea of creating this amorphous blob that can be molded and shaped as competitors emerge is simply not useful in any respect when it can be challenged so readily at the office," he said.

The patent office has helpfully taken on the issue of software patent clarity, even though recent Supreme Court rulings on patent issues, like its **June decision** in Alice Corp. v. CLS Bank on abstract ideas implemented using a computer, have provided little real guidance beyond the facts of specific cases, Bullard said.

"If the Supreme Court were to come out with an opinion that was in the form a flowchart, with a litany of examples, I sincerely believe the office would readily adopt it," he said. "But the office does not have that luxury because unfortunately, the recent jurisprudence has not been clear."

The USPTO's training is directed at ensuring that examiners can identify and reject patent applications that describe a claimed function without specifying a means for performing it.

The incentive for applicants to overreach and use vague claim terms is large because they want to obtain the broadest patent coverage they can, said former Federal Circuit Chief Judge Paul Michel. However, USPTO examiners can improve patent clarity by requiring applicants to make amendments to make to clear up ambiguity, he said.

"Examiners have a lot more power than they think they do, in my opinion, because they can say no. They can say, 'I am not allowing this claim,'" Judge Michel said.

In the long run, increased patent clarity is in everyone's interest since a patent that is later invalidated is a waste of time and money, he said. With the USPTO's increased focus on rooting out patents with elastic or indefinite words, "I hope the more extreme examples will decrease," he said.

The training is "an excellent first step towards improving patent quality," a critical issue for many technology companies, said Laura Sheridan, patent counsel at Google Inc.

Broad, low-quality software patents that do not have clear boundaries and can cover any way of performing a given function are "a drag on innovation and contribute little to technological progress," Sheridan said, yet are common in the technology space.

Such patents "reward an easy first step on the path to innovation, receiving the desired result," she said. "But they allow patent owners to tax and deter the hard part of innovation, which is the creative and detailed work to bring new and better products to consumers."

Sheridan said the USPTO could be doing even more to improve software patent quality, such as giving examiners more time to look at each patent or requiring all patent applications to include a glossary of key terms, not just those that wish to do so under a **new pilot program**.

The examiner training to date is "simply a start and not an end point," said Deputy Commissioner for Patent Examination Policy Drew Hirshfeld, and the office plans more training aimed at boosting patent quality.

"It is our view that quality is something that should always be improved, and I anticipated that we will have a never-ending focus on quality," he said.

--Editing by Christine Chun.