JOINT ELECTRONIC AND COMPUTER LAW, IP PRACTICE IN THE FAR EAST, AND IP PRACTICE IN JAPAN COMMITTEE SESSION

SCHWEGMAN ■ LUNDBERG ■ WOESSNER

Intellectual Property Attorneys

PATENT PROTECTION FOR HIGH TECHNOLOGY

PATENTABILITY OF COMPUTER IMPLEMENTED INVENTIONS DOMESTICALLY AND INTERNATIONALLY

©2009 Schwegman, Lundberg & Woessner P.A.

Welcome

Thank you to the following people and their respective committees for their help in organizing this joint session:

Manny Schecter – Chair of the Electronic and Computer Law Committee

William "Skip" Fischer – Chair of the IP Practice in the Far East Committee

Mark Guetlich & David Schnapf – Co-Chairs of the IP Practice in Japan Committee

©2009 Schwegman, Lundberg & Woessner P.A.

2008 – From Wall Street to State Street

Since the last Mid-Winter Institute, we have experienced a year of change.

- **35 U.S.C. § 101 rejections became quite common**
- **Signal claiming practice was turned on its head in view of *In re Nuitjen***
- **Particular machines, systems, and apparatus or a transformation of matter in method claims according *In re Bilski***
- ***State Street* is no longer dispositive**
- **Tax strategy patents under review by the IRS**
- **Human intelligence may be novel, but it is non-statutory subject matter under § 101 according to *In re Comiskey***

©2009 Schwegman, Lundberg & Woessner P.A.

Computer Implemented Inventions in the US

Prof. Ann McCrackin, Esq.

Professor of Law; Shareholder, Schwegman, Lundberg, & Woessner, P.A.

Ann is a shareholder with Schwegman, Lundberg, & Woessner and a Professor of Law at the Franklin Pierce Law Center. At Franklin Pierce, Ann is the Director of the Patent Practice and Procedure Program. Her law practice focuses on computer architecture, software, and business methods. She is a co-editor and contributing author to *Electronic and Software Patents: Law and Practice (*BNA Books) and co-author of the *Association of University Technology Managers Technology Transfer Practice Manual*. She lectures throughout the US on various patent prosecution topics.

©2009 Schwegman, Lundberg & Woessner P.A.

Computer Implemented Inventions in Europe

John Collins, Esq.

BSc, PhD, Cphys, MInstP, CPA, EPA, MITMA, ETMA

Mr. Collins has considerable experience of proceedings before the European Patent Office, including oppositions and appeals, as well as in litigation both in the UK and the US. He focuses his practice toward software, Internet and business method patents. Mr. Collins is a member of the Chartered Institute of Patent Attorneys (CIPA) Technology Committee and the CIPA Parliamentary Committee, he is involved in advising CIPA and members of the UK and EU parliament on developments in patent law. He lectures widely, notably to US attorneys on the differences in practice in this field between the US and Europe. He is also a contributing author to *Electronic and Software Patents: Law and Practice (*BNA Books).

©2009 Schwegman, Lundberg & Woessner P.A.

Computer Implemented Inventions in Japan

Kazunori Kurusu, Esq.

Owner, Kurusu Patent Law Office founded in 2000

Mr. Kurusu is a Japanese Registered Patent Attorney. His experience extends to patent protection for software, numerical analyses, communications networks, mechanic and optical engineering; and business methods, as well as patent litigation and licensing. His experience also extends to international patent protection. Also, prior to entering the patent profession, Mr. Kurusu worked as an automobile engineer.

©2009 Schwegman, Lundberg & Woessner P.A.

Computer Implemented Inventions in China

Robin R. Zhao, Esq.

Founding and managing partner of Jeekai & Partners, Beijing, a leading private Chinese intellectual property firm in Mainland China

Mr. Zhao is a Chinese patent and trademark attorney, and U.S. patent agent. He has practiced IP law for 25 years since the establishment of the Chinese IP laws. He graduated from the Physics Department of Beijing (Peking) University, a Chinese law school, and the Franklin Pierce Law Center (MIP). Mr. Zhao worked with the CCPIT Patent and Trademark Law Office as group chief for five years in China, and was previously a research engineer. He also worked with the Irell & Manella firm in the US for four years, and trained with Baker & McKenzie and at Banner & Witcoff. Mr. Zhao has extensive experience in prosecution, litigation and transactional matters of Chinese intellectual property. He is a board member of China Intellectual Property Society, former board member of All-China Patent Agent Association, and a frequent speaker on Chinese IP protection issues.

©2009 Schwegman, Lundberg & Woessner P.A.

CLAIMS FOR CONSIDERATION FROM RECENT BPAI DECISIONS

©2009 Schwegman, Lundberg & Woessner P.A.

Question – Ex parte Wasynczuk et al.

From *Ex parte* Wasynczuk et al. (Appeal 2008-1496; US App. Serial No. 09/884,528)

June 2, 2008

According to Appellants, the invention relates to computer programs that simulate systems. More specifically, the invention relates to simulation systems using a distributed computer network, wherein subsystems can be simulated independently, the subsystem simulations communicating the values of input/output variables to simulate subsystem interaction. (Spec., ¶ [0003].)

Claim 1 found to be non-statutory subject matter under 35 U.S.C. § 101.

Claim 9 found to be statutory subject matter under 35 U.S.C. § 101.

©2009 Schwegman, Lundberg & Woessner P.A.

Question – Ex parte Wasynczuk et al.

9. A computer-implemented method for simulating operation of a physical system having a plurality of physical subsystems, comprising:

simulating a first physical subsystem with a first continuous-time simulation on a first physical computing device;

accepting a request for export of information relating to a number *n* of state-related variables that characterize the state of the first physical subsystem in said simulating;

sending a first series of state-related messages, each message containing information relating to the value of at least one of the *n* state-related variables;

simulating a second physical subsystem with a second continuous-time simulation on a second physical computing device;

receiving in said second continuous-time simulation said first series of state-related messages from said first continuous-time simulation without said first series of state-related messages passing through a central communication process; and

outputting data representative of a state of the second continuous-time simulation;

wherein:

the first physical subsystem interacts with the second physical subsystem; and

the at least one state-related variable characterizes at least a portion of the interaction between the first physical subsystem and the second physical subsystem.

©2009 Schwegman, Lundberg & Woessner P.A.

Question – Ex parte Wasynczuk et al.

1. A computer-implemented system, comprising:

a first executing process that:

implements a first continuous-time model to simulate a first physical subsystem, the first model being programmed in a first language and having a first state variable; and

sends a first series of state-related numerical values, each numerical value reflecting information relating to the value of the first state variable at a different point t_m in simulation time in the first model; and

a second executing process that:

receives said first series of state-related numerical values from said first executing process without said first series of state-related numerical values passing through a central communication process;

implements a second continuous-time model to simulate a second physical subsystem, the second model being programmed in a second language and taking as an input values from said first series of state-related numerical values; and

outputs data representative of a state of the second continuous-time model.

©2009 Schwegman, Lundberg & Woessner P.A.

Question – Ex parte BO LI

From *Ex parte* BO LI (Appeal 2008-1213; US App. Serial No. 10/463,287)

November 6, 2008

Appellant's invention relates to a method and system for generating a report using software modules adapted for easy modification and updating (Spec, p. 1, bottom). In the words of the Appellant:

Custom business reports for a WEB application are generated by parsing a configuration file, processing data logic, and organizing data. The result of the parsed configuration file is further processed by the data logic processing. The data logic processing prepares the data to generated languages suitable for a data query from a database or for locating files. The data is then organized into a form suitable for display. (Spec, p. 28)

Claim 42 found to be statutory subject matter under 35 U.S.C. § 101.

©2009 Schwegman, Lundberg & Woessner P.A.

Question – Ex parte BO LI

42. A computer program product, comprising a computer usable medium having a computer readable program code embodied therein, said computer readable program code adapted to be executed to implement a method for generating a report, said method comprising:

providing a system, wherein the system comprises distinct software modules, and wherein the distinct software modules comprise a logic processing module, a configuration file processing module, a data organization module, and a data display organization module;

parsing a configuration file into definition data that specifies: a data organization of the report, a display organization of the report, and at least one data source comprising report data to be used for generating the report, and wherein said parsing is performed by the configuration file processing module in response to being called by the logic processing module;

extracting the report data from the at least one data source, wherein said extracting is performed by the data organization module in response to being called by the logic processing module;

receiving, by the logic processing module, the definition data from the configuration file processing module and the extracted report data from the data organization module; and

organizing, by the data display organization module in respone to being called by the logic processing module, a data display organization of the report, wherein said organizing comprises utilizing the definition data received by the logic processing module and the extracted report data received by the logic processing module.

©2009 Schwegman, Lundberg & Woessner P.A.

Question – Ex parte Cornea-Hasegan

From *Ex parte* Cornea-Hasegan (Appeal 2008-4742; US App. Serial No. 10/328,572)

January 13, 2009

Appellant invented a method for predicting results of floating point mathematical operations and calculating the results. Preferably, the results are calculated using software rather than hardware (floating-point hardware) when the results are tiny (too small to be accurately calculated using hardware). (Spec. ¶¶ [0003], [0004], [0012].)

Both claims 1 and 18 found to be non-statutory subject matter under 35 U.S.C. § 101.

©2009 Schwegman, Lundberg & Woessner P.A.

Question – Ex parte Cornea-Hasegan

1. A method, comprising:

normalizing by a processor operands a, b, and c for a floating point operation;

predicting by the processor whether result d of said floating point operation on said a, b, c might be tiny;

if so, then scaling by the processor said a, b, c to form a', b', c';

calculating by the processor result d' of said floating-point operation on said a', b', c';

determining by the processor whether said d is tiny based upon said result d';

if so, then calculating by the processor said d using software; and

if not, then calculating by the processor said d using floating point hardware.

©2009 Schwegman, Lundberg & Woessner P.A.

Question – Ex parte Cornea-Hasegan

18. A *computer readable media* including program instructions which when executed by a processor cause the processor to perform the following:

normalizing operands a, b, and c for a floating-point operation;

utilizing the results of a hardware prediction unit predicting whether result d of said floating-point operation on said a, b, c might be tiny;

if so, then scaling said a, b, c to form a', b', c';

calculating result d' of said floating-point operation on said a', b', c';

determining whether said d is tiny based upon said result d';

if so, then calculating said d using software; and

if not, then calculating said d using floating-point hardware.

©2009 Schwegman, Lundberg & Woessner P.A.

Thank You

Prof. Ann McCrackin, Esq.
amccrackin@slwip.com

Mr. John Collins, Esq.
jcollins@marks-clerk.com

Mr. Kazunori Kurusu, Esq.
GZG03606@nifty.ne.jp

Mr. Robin Zhao, Esq.
robinzhao@jeekai.com

©2009 Schwegman, Lundberg & Woessner P.A.