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Jeffri A. Kaminski

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Software Patents Put to the Test – a Bad Sign for Trolls?

One of the challenges presented by software patents, which are commonly asserted by so-called patent assertion entities (aka, patent trolls), is determining what the patent covers. Often the invention is described in vague terms that are difficult to decipher. A recent Federal Circuit decision involving online advertising patents may force patent applicants to describe their invention with particularity and assist in invalidating unduly vague patents.

In *Function Media, L.L.C. v. Google Inc.*, a patent assertion entity sued Google for allegedly infringing three advertising patents. The patents describe a method and system to facilitate online advertising on multiple advertising outlets, such as newspapers and websites. According to the patents, in the past, advertisers had to manually ensure that their ads conform to the differing requirements of each advertising venue. For example, if one website required square ads with red borders, while another required rectangular ads with blue borders, the prior art systems required the advertiser to manually create both ads. The alleged invention eliminates this inefficiency by automatically formatting the ads to fit each publisher's requirements and sending them out for publication. Google's AdSense for Content and AdSense for Mobile products, when used in conjunction with Google's AdWords interface, were accused of infringement.

The meaning of the italicized language in claim 1 of one of the patents was at issue:

- . A method of using a network of computers to contract for, facilitate and control the creating and publishing of presentations, by a seller, to a plurality of media venues owned or controlled by other than the seller, comprising:
 - providing a media database having a list of available media venues;
 - providing means for applying corresponding guidelines of the media venues;
 - providing *means for transmitting said presentations to a selected media venue of the media venues*;
 - providing means for a seller to select the media venues; and
 - providing means for the seller to input information; whereby the seller may select one or more of the media venues, create a presentation that complies with said guidelines of the media venues selected, and transmit the presentation to the selected media venues for publication.

The lower court determined that the patent claim is indefinite, and the Federal Circuit affirmed. According to the appellate court, the patent "does not describe the means or steps taken to accomplish the end result," and "is merely a black box that accomplishes the claimed function." "Simply disclosing software ... 'without providing some detail about the means to accomplish the function[,] is not enough.'" The algorithm for performing the transmitting function must be disclosed. In this case, the court found no specific algorithm disclosed in any form, *i.e.*, no explanation of how the software performs the function is provided, rendering the claim invalid for indefiniteness.

As courts and legislators consider the implications of the rise in patent troll suits, this case could signal the start of a trend of the courts taking a harder look at software patents asserted by such entities.