

FINNEGAN



The Uneasy Future of Software and Business-Method Patents

SD Times March 24, 2010

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Protecting and enforcing IP rights in a high-speed world

The world has become more connected than ever. Talking on the phone while at the beach, watching videos in the car, connecting online with friends across continents, Internet shopping and banking, and downloading a favorite song—these are just a few advancements in the electrical and computer technology industries over the past decade.

The overlap between technology innovations and their application to products and services has created new markets and opportunities for collaboration. Highly prized intellectual property assets typically drive these advances, and Finnegan has worked with many of the industry leaders in electronics, the Internet, computer hardware and software, semiconductors, and telecommunications to help protect and enforce their IP rights. We have advised clients on patent issues that address standards; counseled financial services companies on business method patents; litigated cases at the ITC for semiconductor manufacturers; and advised online businesses on unique issues that arise in the Internet arena, such as licensing open source software.

A comprehensive scope of work

Finnegan provides a full range of IP services to electrical and computer technology companies:

- Developing IP portfolio and filing strategies.
- Drafting and prosecuting patents for high-value products and technologies.
- Providing formal opinions and counseling.
- Determining the appropriate vehicle to use for patent correction with the U.S. Patent and Trademark Office: a Request for Certificate of Correction, a Reissue Application, or a Reexamination Application (ex parte and inter partes).
- Counseling and representing clients in patent interferences—a unique type of PTO administrative proceeding requiring a specialized set of skills in litigation and prosecution.
- Asserting and defending IP assets in federal district courts and other dispute forums as well as various domestic and international arbitration tribunals.
- Representing clients at the U.S. International Trade Commission—more than a third of Finnegan’s lawyers been involved in ITC litigations, and six formerly worked at the ITC as either staff trial attorneys or advisors to the administrative law judges.
- Conducting due diligence for mergers, acquisitions, and other partnering opportunities—from assessing the strength of a single licensed patent to a thorough review of an entire portfolio.
- Analyzing opportunities to generate revenue from technology and IP assets, including formulating and executing licensing programs.
- Negotiating and enforcing complex license and technology transfer agreements.
- Advising on and assisting with trademark rights, including trademarks, service marks, trade dress, product configurations, trade names, and domain names.
- Guiding and protecting the rights of clients that have developed and use digital rights management technology to securely distribute key information and content.

- Tracking and assessing case law trends to best position our clients' business-method inventions to receive the broadest patent protection available.

Understanding the technology is critical to success

The depth of our legal and technical knowledge and our understanding of our clients' businesses enable us to identify opportunities, anticipate problems, and provide practical solutions. More than 80 of our lawyers have at least one degree in electrical engineering, computer science, or another form of technology relevant to electrical and computer technology. Some have worked in the electronics and computer industries and bring an insider's perspective to the problems our clients face. Several of our lawyers have written their masters and doctoral theses in nanotech fields, including semiconductor fabrication for use in MEMS, nanoscale thin film deposition, and nanoscale printing. Whatever the electrical technology—LEDs, DSL, circuits, watermarking, digital signatures, microchips, flash memory, SSL, networking, digital video, MPEG, data compression, HD-WDM, or GPS—we have a professional with experience in that field.

Far-reaching experience

We have handled matters for clients in virtually every sector of the electrical and computer technology industries:

- Computer hardware and software
- Semiconductor devices and processing equipment
- Telecommunications
- Consumer electronics
- Internet applications
- Medical devices
- Optics
- Bioinformatics

- Alternative energy technologies

Computer software

Some of the most rapid changes in intellectual property law have involved computer software. Once thought unpatentable, computer software now accounts for an estimated 20,000 new patents each year. When evaluating our clients' software for protection, we consider and balance many unique issues, such as development speed, ease of market entry, market fluidity, changing alliances, and ease of copying. We also evaluate current industry trends, potential product and industry developments, and the effect of those developments on our clients' software protection. We then advise our clients on how to best protect their software through patents, copyrights, and trade secrets and we guide them around the intellectual property barriers created by others. In addition, to increase our clients' return on investment, we assist them with licensing and technology transfer, and negotiating and drafting those agreements.

Semiconductor processing

We have extensive experience litigating, licensing, and prosecuting patents in the semiconductor industry. Our experience includes both semiconductor manufacturing and semiconductor devices, and it extends from single devices, such as light-emitting diodes and analog circuits, to complex VLSI and ULSI circuitry. We have also litigated, licensed and prosecuted patents that involve firmware, ASICs, and FPGAs. In addition, we have experience in obtaining protection under the Semiconductor Chip Protection Act and in litigating under that Act.

Telecommunications and consumer electronics

Decades of working with telecommunications and consumer electronics clients have given us a deep understanding of how those industries have evolved and where they are heading. We have been on the cutting edge of IP issues that arise out of the standard-settings processes prevalent in the telecommunications and consumer electronics industries. To capture economies of scale and customer conveniences that standards provide, many of our clients have

developed, patented, and licensed their technologies. Some work with other companies to pool patents to make licensing more efficient. We help negotiate and enforce agreements to help our clients get the most from their assets, collect royalties, and ensure the protection of their rights. When contracts are violated, patents infringed, or invalidity challenges issued, we have a seasoned team that stands ready to take on our clients' opponents.

A diverse client base

- AOL
- Axis Communications
- D-Link
- InterDigital Communications Corp.
- Intertrust Technologies
- LG Electronics
- Marvell Semiconductor
- Philips
- PNY Technologies
- SAP AG
- Seoul Semiconductor
- Sony
- Starent Networks
- Toshiba
- TSMC
- Winbond Electronics Corp.