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Gary A. Clark and Darren M. Franklin
Sheppard Mullin

Implications of Aristocrat v. IGT for Software Patents

The law governing U.S. software patents sometimes shifts like the ground here in California – a point illustrated by the recent decision of the Court of Appeals for the Federal Circuit (CAFC) in *Aristocrat Technologies Australia PTY Ltd. v. International Game Technology*, 521 F.3d 1328, 1333 (Fed. Cir. 2008).

The Aristocrat case involved a patent relating to an electronic slot machine that let users define the winning symbol combination before commencing the game. The invention used a computer processor to control how the game functioned. The sole independent claim of the patent recited a "game control means" using means-plus-function language – the claim recited a means for performing a specified function without reciting the structure for performing the function. The patent specification stated it was within the capability of a worker in the art "to introduce the methodology on any standard microprocessor base[d] gaming machine by means of appropriate programming."

The CAFC held that the independent claim – and hence all other claims – was invalid because it was not "definite" as required by the US Patent Act, 35 USC section 112, paragraph 2. As the claim used means-plus-function language, the court reviewed the patent specification to determine whether Aristocrat sufficiently disclosed the structure of the "game control means." Aristocrat contended its disclosure of a "standard microprocessor" with "appropriate programming" sufficed.

The CAFC rejected Aristocrat's arguments. First, it "has consistently required that the structure disclosed in the specification be more than simply a general purpose computer or microprocessor." 521 F.3d at 1333. The forgoing requirement recognizes that "simply disclosing a computer as the structure designated to perform a particular function does not limit the scope of the claim to 'the corresponding structure, material, or acts' that perform the function, as required by section 112 paragraph 6." Id. Patents must disclose the particular algorithm that a computer uses to execute a function – thereby avoiding "pure functional claiming." Id.

Second, the court rejected Aristocrat's view that disclosure of "a microprocessor with 'appropriate programming'" sufficed because a skilled person could devise an appropriate algorithm. According to the CAFC, "the pertinent question… is whether Aristocrat's patent discloses structure that is used to perform the claimed function." Id. at 1336. While the sufficiency of such disclosures should be judged from the viewpoint of a person skilled in the art, at a minimum, an algorithm must be disclosed.

For software patent drafters, the issue is whether the patent specification itself discloses a software algorithm. If so, then a means-plus-function element is limited to software programs using such an algorithm. If not, such claims are invalid for indefiniteness – even if a person of ordinary skill could write appropriate software.

Importantly, the patent applicant need not disclose source code or even a "highly detailed description of the algorithm." Aristocrat, 521 F.3d at 1338. But to employ means-plus-function language, the applicant must "at least disclose the algorithm that transforms the general purpose microprocessor to a special purpose computer programmed to perform the disclosed algorithm." Id. This is typically done by using detailed flowcharts and written descriptions of the algorithm.

The lesson: Claiming a software-related invention as part of a system or apparatus, and using means-plus-function language to define a software element, requires describing (in the patent specification) an algorithm for performing the specified function. The only alternatives are: 1) Omitting that element to avoid triggering the requirement for describing an algorithm; or 2) using method claims to define an invention, since only in the most unusual cases would section 112, paragraph 6 be applied to method claims.

Sheppard Mullin Richter & Hampton LLP
Tel – G Clark: +1 213 617 4197
Tel – D Franklin: +1 213 617 5498
Email: gclark@sheppardmullin.com
dfranklin@sheppardmullin.com
Website: www.sheppardmullin.com