

SRI International



How Can Examination Add Maximum Value?

US Patent and Trademark Office Software Partnership Roundtable

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SRI International

SRI- Who We Are

A world-leading independent R&D organization



SRI headquarters, Menlo Park, CA



Sarnoff, Princeton, NJ

- Founded by Stanford in 1946
 - Based in Silicon Valley
 - Non-profit corporation
 - Independent in 1970
 - Sarnoff Corp (formerly RCA Labs) now integrated into SRI
- 2,200 staff members
 - 800 with advanced degrees
 - More than 20 locations worldwide
- Consolidated 2011 revenue ~\$570M



SRI Harrisonburg, Virginia



SRI State College, Pennsylvania



SRI Tokyo, Japan



SRI Washington, D.C.



SRI St. Petersburg, Florida

“SRI is the best R&D organization in the world at converting its technology into commercial value” David Ladd, Partner at Mayfield Ventures



\$20B

Minimally invasive virtual surgery



NUANCE

\$6.5B

Computer speech recognition

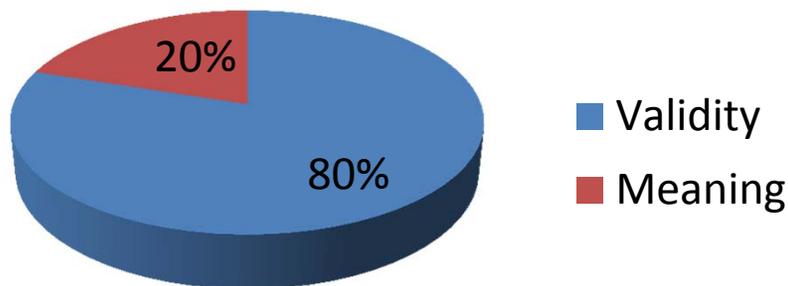


World's first virtual computer assistant

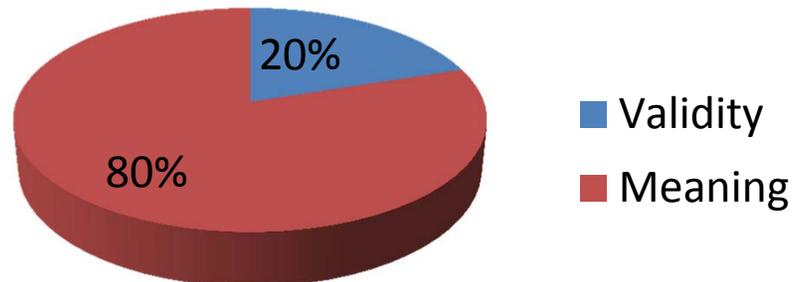
What is the purpose of examination?

- **Validity:** screening out unpatentable subject matter
- **Meaning:** clarifying what the claim language means

**S/W patent examination
focuses on:**



**Use of examination records
post-issuance focuses on:**





Licensing and enforcement of software patents revolves around this: *What do the claims mean?*

- “Claim interpretation is the logical starting point in any claim analysis for the purpose of patentability determination or infringement analysis.”
 - 85 J. Pat. & Trademark Off. Society 693 (September, 2003)
- Standard patent litigation begins with each party proposing what they believe each salient claim term means



So, why not focus s/w patent examination more explicitly on *meaning*?

- For efficiency, be selective: applicant or examiner can each flag selected terms they think are important to clarify, and propose a definition. The other side either proposes a different definition, or else the examination proceeds on this basis
- Courts and parties will find an explicit exchange persuasive, under virtually any approach to claim construction
- Helps resolve validity questions during examination too
 - Examiner may be comforted by clarity of definition
 - Applicants may better understand the examiner's concerns and how to address them

Thank you for your time

Questions and discussion

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