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### **Abstract Made Concrete: Software Reverse Engineering – Mike McLean of UBM TechInsights Comments on the Bilski Case**

OTTAWA, June 30, 2010 /PR Newswire/ - For over a decade the fundamental intellectual property rights of an innovation implemented in software have been held ransom as the appeals on the case, “Bilski et al. v. Kappos...” worked their way through the system to the Supreme Court. Prior to the Supreme Court’s recent ruling, software and process patents were on very shaky ground due to the assertion by a lower court that a claimed process is only patent-eligible if it is tied to a particular machine or apparatus, or it transforms a particular article into a different state or thing.

The Supreme Court’s June 28th, 2010, decision on the Bilski case was an affirmation of the viability of patent protection for innovation implemented in software. However, uncertainty still exists as a clear test for patentable subject matter was not established. The Bilski patent was found to claim an abstract idea and as such was determined not to be patentable. Demonstrating the tangible nature of a patented innovation will likely be a key to successfully defending patent rights in the software space.

Similar to Bilski’s business process, one of the fundamental challenges to patenting software has been the rejection of the innovation due to it being an ‘abstract idea’ or an ‘abstract intellectual concept’ which is unpatentable. Unfortunately, as you read through the court documents in the Bilski case they seem to beat around the bush w.r.t. what is an abstract idea and avoid trying to define ‘abstraction’ at all. In the case of software, UBM TechInsights believes that it is becoming easier to concretely establish the evidence of the innovation in the end product, making algorithms (or ‘processes’ as preferred by the courts) implemented in software anything but abstract.

[UBM TechInsights](#) has seen a growing trend towards implementing innovative products in a hybrid of hardware and software. In fact, many clients following a [holistic IP lifecycle management program](#) implement a comprehensive filing strategy whereby software patents, in addition to hardware patents, comprise key elements of their patent portfolios. There are several market advantages for technology products manufactured as a hybrid of software and hardware, not the least of which are time-to-market, enhanced features, flexibility, benefits and key differentiators, as well as the overall product cost. Modern technology-based products would be strongly affected were it to become necessary to implement an innovative algorithm or process in a specific piece of hardware to become ‘patentable’.

A commonly touted issue with software patents is the supposed difficulty and expense of determining if a particular piece of software infringes, but as we will see below, the tools and techniques have evolved and the difficulty of a software infringement analysis is likely substantially less than a typical sophisticated sub-micron integrated circuit project.

UBM TechInsights has seen computing resources improved such that very complex systems can be implemented entirely in software with a bare minimum of ‘interface’ to the real analog world. In the last three years the Software Reverse Engineering and Systems Test capability has grown substantially,

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driven by the necessity to investigate and understand both aspects of a product in order to produce evidence of use for our clients. The [analysis of end products utilizing this technology](#) can provide strong evidence of the tangible nature of the innovation and directly link the technology back to the patent claim. In doing so, the degree of 'abstractness' of the innovation, is mitigated to an extent by directly linking specific algorithms or processes found in the 'code' to functional performance of a system or sub-system. This evidentiary linkage is important in understanding such innovations which ultimately will lead to clarity as to the patentability of innovations and their specific use in the broader market and, of course, the use of those same patents in various licensing campaigns.

No doubt there has been abuse of software and business process patents in the past years due to the broad, wide ranging interpretations given the law in that area, but it would be nice to see the courts tackle trying to resolve the patentability of software directly, rather than relying upon a smattering of example cases and vague opinions (or 'gut feel') on what constitutes an abstract idea in the context of a software-based product. Clarity can be attained through better understanding of the innovation and how it's been applied.

Mike McLean is the Vice President of Intellectual Property Rights and Professional Services at UBM TechInsights. For more information on UBM TechInsights software-related services visit: <http://www.ubmtechinsights.com/markets-served/software/>

### About UBM TechInsights

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For more information contact: Mark Roberts, Director of Marketing  
+1-613-576-0174, <mailto:mroberts@ubmtechinsights.com>