

*Easy Fix for U.S. Software Patent Problems:  
Comparative Law Perspective*

**Toshiko Takenaka**

Professor of Law, University of Washington School of Law  
Seattle, WA

The leading literatures (Mark Lemley, Software Patents and the Return of Functional Claiming; Colleen Chien, Patent Trolls by the Number) point out activities of non-practicing entities and the overbroad scopes of software patents as major sources of negative impact on innovations and propose a reform. However, NPE's activities are rare outside the United States, although the number of software patents issued by JPO and EPO has substantially increased. This paper compares the patent examination at USPTO, JPO and EPO regarding the software patents examined in the leading literatures. The study revealed that the majority of the examined software patents are issued only in U.S. Many of these patents were not filed at EPO or JPO. Those which were filed were either rejected or withdrawn at JPO and EPO. The scopes of European and Japanese patents were significantly narrower compared with corresponding U.S. patents. At USPTO, the restrictive claim interpretation for functional claims under USC §112(f) made it easier to overcome eligibility, novelty, nonobviousness (inventive step), enablement, written description and claim definiteness rejections. In contrast, JPO and EPO adopt pre-*In re Donaldson* (16 F.3d 1189, Fed. Cir. 1994) claim interpretation to cover any structure, material, acts etc. to perform functions cited in the claim while courts adopt a restrictive claim interpretation for determining infringement of functional claims in light of the specification. This broad claim interpretation during the examination effectively prevents JPO and EPO from issuing overbroad software patents. Accordingly, this paper proposes overruling *In re Donaldson* and bringing USPTO examination for functional claims more in line with EPO and JPO. This harmonization also enhances examination collaboration among patent offices.

**Email:** toshiko@u.washington.edu

Takenaka