

PC Dynamics, Inc.
31332 Via Colinas #102
Westlake Village, CA 91362
T. 818/889-1741
F. 818/889-1014

Commissioner orders re-examination of "Energizer Bunny" software patent

WESTLAKE VILLAGE, CALIF., -- The commissioner of the U.S. Patent and Trademark Office has ordered the agency to re-examine a broad software patent that might demand royalties from the Energizer Bunny screen savers published by PC Dynamics Inc.

Representing a possible first step toward reversing the patent, the decision to review by Commissioner Bruce Lehman follows a request by Arizona Senator Dennis DeConcini, chairman of the Subcommittee on Patents, Copyrights and Trademarks, and protests by the Software Publishers Association and others alerted by PC Dynamics.

"The PTO is clearly responsive to public officials and the computer industry, who are helping to fight a patent that wrongly targets PC Dynamics," said Peter Avritch, president of PC Dynamics.

Software Advertising Corp. of La Costa, Calif., alleges that the PC Dynamics screen savers infringe 1992 patent No. 5, 105, 184, which covers any "system which integrates an advertisement into a computer software program without altering the function of the program."

PC Dynamics legally licenses the Energizer Bunny and pays the Eveready Battery Company a royalty for use of the character.

Software Advertising owns neither the bunny nor the screen saver software, but demands royalties on sales of the screen saver on the grounds that it owns the idea of using advertising within software.

"The shortcomings of this claim create the possibility that it could apply to any display of products, services, and trademarks affected by computer software, a very broad scope of protection," said Ken Wasch, executive director of the SPA, the principal trade association of the personal computer software industry, with more than 1,100 members, writing to Lehman.

In his letter to Lehman, DeConcini said: "I am concerned that this patent could have a tremendous impact on numerous software uses and could also affect the next generation of computer software...If in fact it encompasses all logos and advertisements generated by computer software, then I believe a reexamination may be in order."

Lehman's decision, written by Stephen G. Kunin, deputy assistant commissioner for patents, cites prior art that "raises a substantial new question of patentability."

The decision specifically cites a review of SuperPaint from Silicon Beach

Software published by the New York Times on April 28, 1987, five years before the Software Advertising patent was issued. The review rails against the integration into SuperPaint of advertising for "Silicon Beach Software's latest arcade game Dark Castle," complete with scenes from the program, and a second "advertisement for a game called Airborne."

This is the second time in recent months that Lehman has ordered a software patent review. The agency recently reconsidered and rejected all 41 of Compton New Media's claims on multimedia.