

# Michigan Telecommunications and Technology Law Review

---

Volume 7 | Issue 1

---

2001

## E-Commerce and Equivalence: Defining the Proper Scope of Internet Patents--Foreword

Sanjay Prasad  
*Oracle Corporation*

James T. Carmichael

Follow this and additional works at: <http://repository.law.umich.edu/mttlr>

 Part of the [Commercial Law Commons](#), and the [Internet Law Commons](#)

---

### Recommended Citation

Sanjay Prasad & James T. Carmichael, *E-Commerce and Equivalence: Defining the Proper Scope of Internet Patents--Foreword*, 7 MICH. TELECOMM. & TECH. L. REV. 251 (2001).

Available at: <http://repository.law.umich.edu/mttlr/vol7/iss1/6>

This Symposium Foreword is brought to you for free and open access by the Journals at University of Michigan Law School Scholarship Repository. It has been accepted for inclusion in Michigan Telecommunications and Technology Law Review by an authorized editor of University of Michigan Law School Scholarship Repository. For more information, please contact [mLaw.repository@umich.edu](mailto:mLaw.repository@umich.edu).

# E-COMMERCE AND EQUIVALENCE: DEFINING THE PROPER SCOPE OF INTERNET PATENTS

A SYMPOSIUM SPONSORED  
BY  
ORACLE CORPORATION  
AND LYON & LYON LLP

## FOREWORD

*Sanjay Prasad\**  
*James T. Carmichael\*\**

Can a patent really be construed to cover an entire method of doing business? Internet or e-commerce type patents have generated a great deal of controversy due, in no small part, to the perceived scope of many of these patents. The enormous commercial significance of certain Internet technologies means that the precise scope of a patent can have dramatic impact, not only on the directly affected parties but on the pace of innovation in e-business. Given these considerations, what is or should be the exact legal scope of Internet-type patents?

Patenting of business processes and enforcement of such patents has rapidly accelerated following the Federal Circuit Court of Appeals decision in *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* While *State Street* resolved longstanding questions of subject matter patentability, it left unanswered the important question of patent scope. Traditional patent law doctrines such as the doctrine of equivalents and prosecution history estoppel continue to play a direct and important role in such a consideration, as supplemented by recent judicial pronouncements on the scope of functionally defined elements. What are the legal and economic implications for Internet-type patents of these and other doctrines that determine claim scope?

On October 27, 2000, Oracle Corporation, Lyon & Lyon LLP and the George Washington University School of Law co-sponsored a Symposium to encourage reasoned and thoughtful public discourse on these important issues. Academics, government officials, private practitioners and industry representatives were invited to discuss and debate the doctrines that govern the scope of Internet-type patents. To focus and

---

\* Chief, Patent Counsel, Oracle Corporation.

\*\* Partner, Lyon & Lyon LLP.

stimulate thinking, Oracle and Lyon & Lyon offered a writing grant providing law professors full academic freedom to express their views on substantive patent or copyright law principles or policy considerations pertaining to the scope of Internet-type patents. Three grants were awarded and the views of three additional professors were solicited to provide critiques of the selected papers. In addition, Oracle and Lyon & Lyon encouraged representatives from government, industry and the Bar to contribute their own insights at the Symposium.

The diverse expression of views provided in the following papers provides a rich foundation for consideration of the issues surrounding the scope of Internet-type patents. On behalf of the Symposium writers and sponsors we invite you to continue consideration of the legal rules and policy implications surrounding this interesting and important subject.