

Enabling Requirements in Software Patents

Patrick Lloyd
Reddie & Grose
London & Cambridge
Patrick.lloyd@reddie.co.uk

September 28-29, 2004

Contents

- Best Mode/Sufficiency
- Dealing with Inventors & Obtaining Disclosure
- Problems specific to the software industry
- Questionnaires for inventors
- Finding Existing Documentation
- Who else should be involved?

Best Mode/Sufficiency

- United States requires that you disclose the best mode you know of putting the invention into effect.
- Must be sufficient description that the invention can be put into effect by one skilled in the art.
- But it is the Patent Office Examiner who has to make the judgement

Best Mode/Sufficiency

- Ultimately the Courts will decide whether there is sufficient description
- Judges may not be technically trained in the field.
- It is sensible to err on the side of caution

What Goes into the Specification

- Most countries do not allow new matter to be added after filing.
- In some countries such as EPO/Japan broadening existing terminology counts as new matter.
- It is most important to file a full disclosure in the first application. Time and money spent at the beginning is worth it.

Dealing with Inventors

- Inventors in the software field can pose particular difficulties:
 - They don't write anything down
 - They are brilliant at what they do, but
 - They are not very good at describing it to others

The Patent Proposal Form

- Asks Inventors key questions to help them describe their inventions
 - Background – what have others done before
 - What problems are addressed by the invention
 - What is the inventive idea
 - Give a specific example
 - How else could it be done
 - What else could it be used for

What have others done

- This is important as it helps the patent attorney decide how to claim the invention
 - Do you know of any third party patents
 - Third party products
 - Third party literature
 - Third party websites
- You will have to pass this information to the US Patent Office

Specific Example

- Interviewing Inventors
- Are there drawings, flow charts, state charts or any other illustrations
- Would screen shots aid understanding
 - The inventor must understand that we have to describe HOW the invention works as well as WHAT it does.

What Documentation Already Exists

- What processes does the company have for documenting procedure?
- Conceptual presentations to management
- Business Requirements
- Technical Requirements
- Implementation Documents

Alternative Implementations

- Why is this important?
 - Supports broad claims
 - Useful to catch infringers trying to design around
 - Supports means + function language

Who else should be involved

- The inventor may not be the only person to talk to.
 - Business managers – they will know about alternative applications
 - Technical managers – they may have a better understanding of the overall picture than the inventor
 - Line managers and colleagues – they may be better at explaining the inventor's ideas than the inventor

Who else should be involved

- The company should consider a Patent manager responsible for working on disclosures before the patent attorney is involved

How do you disclose software?

- Do not include actual code.
- In some cases pseudo code is useful
- The purpose is to describe what is happening: a functional description is ideal.
 - The more illustrations the better.

Remember Technical Contribution

- Not a problem in the USA
- If drafting for India, Europe or Japan, have you shown what the technical is that you are addressing
- Have you shown how you solve it
- This is the difference between success and failure.