

# Patenting Computer Related Inventions

Presentation at


**The CII**

---

January 23, 2003

# Patentability of Computer Software

 Computer related inventions are patentable in the US

 The recent amendment to the Patents Act makes software patentable, however with limitations

## The new Indian law

In the new proposed clause (k) in Section 3 of the Patents Act, the words "per se" have been inserted. This change has been proposed because sometimes the computer programme may include certain other things, ancillary thereto or developed thereon. The intention here is not to reject them for grant of patent if they are inventions. **However, the computer programmes as such are not intended to be granted patent.** This amendment has been proposed to clarify the purpose.

## What does this provision mean?

- How do you determine what is not a statutory subject matter in the context of computer related inventions
- Is business method patentable - Are you going to review the complete specification and examine whether the invention achieves a “*useful, concrete and tangible result*” [State Street Bank & Trust v. Signature Financial Corp. Inc [Fed. Cir.1998]]
- If the invention provides a useful, concrete and tangible result, is that patentable as per the new law.
- Is the Examiner going to look at the claims to see whether an algorithm is recited

# US Patent Number 5,796,395

## 1. A system comprising:

a server having a memory, and a database defined in the memory; and

a client in communication with the server, the server in operation communicating to the client a plurality of selectable graphics respectively having the appearance of a house, requesting a selection by a user of the client, receiving a selection from the client, and adding the selection to the database, the server in operation further communicating to the client a request for information identifying the user, receiving the information from the client adding the information to the database, and associating in the database the user with the house selected by the user.

## United States Patent No. 5,796,395

### 3. A server comprising:

a memory;

a database defined in the memory, the database including data about a plurality of users including interests of the users, the database further including fields representing possible interests of the users; and

communication hardware providing for communication between the server and clients that connect to the server;

the server communicating to a client that connects to the server a request for data by providing a plurality of selectable differing graphics icons respectively having the appearance of a house, and the server receiving a selection from the client and adding the selection to the database and associating the selection with the user of the client, the server further communicating to the client a list of possible interests of the user, requesting a selection of interests of the user of the client, receiving a selection from the client, adding the selected interests to the database and associating the selected interests with the house icon selected by the user of the client;

the server communicating to a client which connects to the server a form for use in requesting a search of the database, and the server generating graphics having the general appearance of a plurality of houses after the search is performed, wherein the houses are respectively selectable using the client and wherein the server communicates to the client the interests of the user associated with a house if that house is selected.

## A US Examiner would

Determine what the programmed computer does when it performs the processes dictated by the software. *[Functionality of the programmed computer]*

Determine how the computer is to be configured to provide that functionality. *[What elements constitute the programmed computer and how those elements are configured to provide the specific functionality]*

If applicable determine the relationship of the programmed computer to other subject matter outside the computer that constitutes the invention *[machines, devices, materials external to the programmed computer or even processes other than those performed by the programmed computer]*

# Specification

Claims	Drawing Figures	Text description of the preferred embodimen ts	Title	Technical Field
Background	Related Art	Summary	Detailed Description	Abstract

## Drafting a Spec

Draw out two drawing figures. Figure 1 illustrating all interfacing components of the invention

Figure 2 is the core component illustrating all elements of the core component

Using figure numerals draft out a written description describing the functional interface between all elements of the system. This is the base for the principal method claim

You could then

- draw out a series of flow charts or drawing figures illustrating the invention,






- augment the specification with written disclosures on all aspect of the invention

- provide antecedence for claims in the specification

- recite alternatives &

- ensure that the claims find adequate support

# Claims


-  Review the claims to ensure that the examining attorney will not raise substantive objections.
-  What an examining attorney will do in analyzing a computer software claim:
  -  Identify and evaluate each claim limitation
  -  The examining attorney will read each claim limitation based on the written description.
  -  In interpreting a specific term the examining attorney will look for explanations provided in the text description. What is the limiting effect of the language in a claim.


# What is statutory subject matter in the context of computer related inventions

- 📄 General Exceptions from the scope of patentability – natural phenomenon – abstract ideas – laws of nature which constitute descriptive materials.
- 📄 Descriptive materials can be functional and non-functional.
- 📄 Functional descriptive materials are computer programs and data structures. [Data structure means physical or logical relationship among data elements, designed to support specific data manipulation functions.]
- 📄 Non functional descriptive materials include mere compilation of data.
- 📄 When a functional descriptive material is recorded on some computer readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases. In re Lowry 32 USPQ2d1031 data structure that increases computers functional efficiency held statutory. In Warmerdam 31 USPQ2d at 1760 claim to computer having specific memory held statutory.

## Therefore the 5796395 Patent

is addressed at Statutory Subject Matter in the US

 The Indian legal position on patentability of computer software integrally coupled to means providing “useful, concrete and tangible results” is yet to evolve

 Except computer programme per se all computer related inventions are patentable in India as per the new act

 Thank you