

Patenting Software Technology Experiences with India & US

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**Naren Thappeta
US Patent Attorney/India Patent Agent
www.iphorizons.com
nt@iphorizons.com**

DISCLAIMER! NOT LEGAL ADVISE!!

Overview of Presentation

- **Differences in Law**
- **Differences in Practice**
 - **Procedure**
 - **Substantive**
- **Drafting Software Applications**

The Statutes

- **US: 35 USC 101**
 - **Any new and useful ...**
 - **Lot of case law**
 - **“Everything under the Sun”**
- **India: Section 3 (Effective Jan 1, 2005)**
 - **Not patentable: Computer programs per se other than its technical application to industry or a combination with hardware**
 - **Not patentable: A mathematical method or a business method or algorithm**

Procedure Differences

- **Means to file**
 - **India: Paper copy to IPO (facsimile permitted)**
 - **US: Electronic or paper copy (no facsimile)**
- **Filing date**
 - **India: date of receipt at IPO**
 - **US: (a) time of start of successful transmission (efiling)**
(b) Date of dropping the packet at post office
 - **holiday filing dates:US (Yes); India (no)**
- **Filing of correspondence**
 - **US: except new application, most documents by facsimile (including assignments, declarations and communication with examiners)**
 - **India: Original requirement (stamp act applicable)**

Procedure Differences (Cont..)

(Filing Abroad)

- **India: Section 39**
 - **Restored sub-sections 1 and 3 from pre-1999**
 - **Indian applicants: File in India first, wait for 42 days**
 - Or obtain written permit from IPO**
 - **Up to 3 months for grant of written permit**
 - **Different rules for “persons” resident in India vs abroad**
 - = Person include non-Indian assignee? See sub-section (3)**
 - **Even for technologies that are not patentable**
 - **Filing PCT application with India as RO – Automatic authorization?**
- **US**
 - **Aligned with export control restrictions**
 - **Time to grant license: 1 day with payment of fees (3 days without)**
 - **Facsimile communication acceptable**

Substantive Practice

- **Substantial commonality in drafting software vs. non-software**
 - **Fitting the facts into ‘objectives’**
 - **Differences mostly in details of content for enablement**
- **Case law**
 - **In India very little**
 - **US: LOT!**

Claims

. Approach

- Identify the central idea that differentiates minimally from the prior art
- Introduce detail ‘gradually’
- Property/function/operation/structure at every level of description
- What done vs. how done
- Words/terms needed to capture the ideas/detail
- Use the specification to control the definition of the words/terms

. Common Claim Types Under US Laws

- Method
- Computer readable medium
- Computer implemented method
- User interface (I.e., screens interaction)
- Uncommon: data structures, medium carrying specific signals
- Multiple sets in each category

Claims ... (Cont.)

. Objectives

- **Direct infringement**
- **Possibly many forms (same in substance)**
- **Barriers in Channels of trades**
- **Licensing Support**
- **Claim sets to help PTO understand the technology**
- **Jurisdiction**
- **Intermediate scope claim sets (to avoid Festo application)**
- **Alternative claim sets to avoid 'means for' construction**

. Claim forms

- **Method and computer readable medium forms in software**
- **Convert method claims to means for format?**

Specification

➤ Title

- Set the problem as close as possible without giving out the novelty
- Ideally preamble to the broadest claim

➤ Field of invention

- Specific field repeats the title

Specification --- (Cont...)

➤ **Related Art**

- **Define each word used in the title**
- **Each paragraph: statement and supporting example**
- **Set the context**
- **Only as much prior art as needed to appreciate the point of novelty**
- **Other known prior art: in detailed description and/or IDS**
- **No drawings**
- **Presumptive prior art (including the motivation)**

➤ **Summary**

- **Generally avoiding**
- **See overview below**

Specification --- (Cont...)

➤ Detailed Description

- **Overview section (one paragraph statement of feature/benefit)**
- **Enablement requirement**
- **‘Work-in’ the inventors description (best mode)**
- **Ensure support for ALL intended claim sets**
- **Separate concept from enabling disclosure and environment**
- **Typically, a flow chart that parallels the broadest claim**
- **Each step of flow-chart used to attain desired interpretation**
 - = **inherently ambiguous words (on, connected, adjacent)**
- **Disclose alternative embodiments but look for a covering concept**
- **No objective statements, but only benefits**
- **Mix ‘can’, ‘may’, ‘embodiment’, ‘aspect of the invention’**
- **Avoid strong words**