

# **Patenting Software Technology Experiences with India & US**

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**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**