



A Short Guide

Patenting Computer-implemented & Business Inventions

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Are new ideas involving computers or new methods of doing business patentable?

The answer is yes in many cases, but not in all. It depends on your idea and where you want to obtain protection for this idea. Many thousands of patents have been granted in these fields. Often the existence of a patent, or even only a patent application, can provide a vital head start over competitors.

Can I rely on copyright protection to protect my software?

Copyright does provide a degree of protection for computer software, but the protection is not as strong as patent protection. This is because copyright is only infringed by direct copying (rather than independent creation) which can be difficult to prove, and because copyright also cannot generally protect the fundamental new ideas and concepts that may lie behind a new piece of software. The purpose of patent protection, on the other hand, is to protect ideas and concepts, and not just the expression or implementation of those ideas.

What makes computer-implemented inventions patentable in Europe?

The test applied by the European Patent Office (EPO) requires inventions to involve technical means and to provide a technical solution to a technical problem in order to be eligible for patent protection. This test is not usually a problem for inventions relating to improvements to computer hardware or computer-controlled devices and machines. However, where an invention lies in new software, the patent examiner must decide whether the improvement is sufficiently “technical”.

Is the law the same in all countries in Europe?

Yes and no. Although the laws of individual countries in Europe should be aligned with the law of the EPO, there are subtle differences and this area of law is in flux. However, as a general rule applying the principles of the EPO gives a fair indication of patentability.

What sort of software can be patented in Europe?

Generally speaking, the EPO allows patent protection in the following areas:

- Software for controlling an apparatus or machinery.
- Software which processes data representing images or data representing other physical entities.
- Software which improves the operation of hardware, for example improved operating systems or software achieving an increase in effective memory or speed.
- Software for implementing business inventions where a “technical” problem is overcome in order to implement the invention and the invention directly solves the technical problem.
- Any other software where there are sufficient “technical” considerations involved in the production of the software, or which produces a new technical effect.

Is it easier to obtain patent protection for computer-related inventions in the USA?

Yes. In the USA there is no requirement that computer-related inventions have a “technical character” or solve a technical problem.

What is the test for computer-related inventions in the USA?

In the USA, the basic test is essentially that the invention must be tied to a particular machine or apparatus, or alternatively must transform a particular article into a different state or thing.

What sort of software can be patented in the USA?

Patent protection is available for a wider range of software than is the case in Europe. In addition to software of a technical nature, it is often possible to obtain patent protection for software for carrying out new business methods on the Internet, controlling financial processes, analysing financial data, and processing language or speech, to name but a few examples.

Can I obtain patent protection in Europe for a new method of doing business?

The EPO does grant patents relating to business methods, but only if the invention meets the “technical” criteria mentioned above. This means that the business method must be implemented using technical means, such as a computer system, and the implementation of the invention must provide a technical solution to a technical problem. The EPO does not grant patent protection for new business methods in isolation, where no technical means are involved in implementing the method.

Can I obtain patent protection in the USA for a new method of doing business?

The answer is typically yes, but the US position is in something of a state of flux. In the USA, patent protection is not limited to inventions meeting the “technical” criterion mentioned above and is generally more widely available for new methods of doing business

using computers and the Internet. In fact, the invention does not even have to lie in a technical field. Many patents have already been granted in the USA for new business methods, and some of these have made headline news.

Where should I file my first patent application?

A patent application filed in the UK establishes a priority date, which is effective in other countries, such as the USA, provided that a patent application is filed in the foreign country within 1 year of the UK filing date. It is also possible to file an application in another country without first having filed an application in the UK, provided that the subject matter of the application does not fall within certain sensitive categories. Indeed there are advantages to filing first in some countries such as in the USA due to their law providing certain favourable conditions to USA first filings. (For basic information on the procedure for obtaining patent protection internationally, see the Marks & Clerk short guide to European and international patents).

If I patent my software, when will my ideas be published?

In most countries, including the UK, patent specifications are published 18 months after the priority date (being the first date on which a patent application is filed). However, if you decided not to continue with patent protection beyond the first year, it is possible to request that publication of the application does not take place.

If I patent my software do I have to publish my source code?

No, there is no requirement for the patent specification to include the source code. In some cases, however, we will recommend that some be included in the patent specification in order to ensure that the specification contains sufficient information to allow the invention to be performed.

How can Marks & Clerk help?

Marks & Clerk advises on all aspects of intellectual property. For more information and to find out how we can help you with the patenting and protecting of computer-implemented and business inventions and managing your patent portfolio, contact your usual Marks & Clerk attorney or a member of our patent team at your nearest Marks & Clerk office. Full details are on our website www.marks-clerk.com

The information within this guide is intended to provide a summary of the subject matter. Readers should not act or rely on information contained in this guide without first obtaining specialist professional advice.

