Patents and software

Can you get patents for software, and if so how?

For something to be patentable certain key criteria must be met:

1. It must be new i.e. it must not already be out there (part of the "state of the art");
2. Involve an inventive step i.e. be non-obvious;
3. Be capable of industrial application; and
4. Not fall within an excluded category.

Unfortunately it is this last criteria which often causes the most problems when it comes to patenting software, as a program for a computer "as such" is an excluded category.

Does this mean software / computer programs are not patentable? No – It is these two little words "as such" that are key. In other words if it is *just* a computer program then it cannot be patented, it must be more than that. What takes software beyond just being a computer program is difficult to determine.

"Technical Effect" or "Technical Contribution"

The UK and EU have both grappled with the idea of what takes software beyond being just a computer program as such and have taken slightly different approaches – the crux of their approaches revolve around "Technical Effect" (UK) or a "Technical Contribution" (EPO) – there is no clear guidance on what each means and it is judged on a case by case basis.

However it is thought that whilst the approach taken by the UK and the EU is slightly different, the outcome invariably will be the same.

When comparing the UK and EU stance on software patents to the US approach, the US have generally been more permissive when it comes to granting software patents, however in recent years the granting of US software patents has become much harder.

First steps – Speak to a patent attorney and keep your software confidential

Patents can be valuable assets for innovative software development companies. Therefore, it is important to take advice from a patent attorney who specialises in software patents at an early stage to identify whether the

software product in question meets the relevant criteria and, in particular, provides a technical solution to a technical problem.

Before a patent application is filed, it is vital to avoid non-confidential disclosure of the software. This is because patent law in the UK, EU and much of the rest of the world requires the invention to be both new and not known to the public prior to the patent application being filed. If you make a non-confidential disclosure before filing a patent application, then that disclosure could deprive your software of novelty and render it no longer capable of being patented. For more information on keeping patents confidential, see our infographic on Confidentiality Agreements.

Other thoughts

Even if it does look like your item of software is patentable, before you actually go ahead and file for a patent it is worth bearing in mind that whilst a patent gives you a monopoly right over use of the software it requires full disclosure of how it works. You must therefore think whether this is the right approach to adopt and if someone can design around it.

For further information please contact Philip Bilney on +44(0)1732 224 046 or at philip.bilney@crippspg.co.uk.