

Software Disclosures

How does a software disclosure differ from other IDs?

- New software technology disclosures require more information than conventional technology IDs because the patentability of software is often more difficult to prove novelty and non-obviousness than conventional technologies that qualify for a utility patent.
- Disclosure of a new software technology requires more stringent evaluation of whether the software is patentable or whether a copyright or keeping the software as a trade secret would bring more value for commercialization.
- Information needed: functional description of the software, whether the software was developed from open-source software or pre-existing software, and what the future development of the software entails (i.e. whether the final product has been developed and if there are any additional versions/updates expected).

Key additional information for a software disclosure

1. Functional description of the software

- a. Describe the computer or device on which the program will run
- b. What was the programming language and operating system used to develop the software?
- c. What type of medium will the software be supplied on?
- d. Were any other software programs required to develop and/or run the software being disclosed?

TIPS:

- The inventors/researchers need to be able to describe the process using logic in sequential steps in layman's terms.
 - This includes the system architecture.
 - For each step of the process, what are the data that are going in, the process that is being performed for that step, and what are the outputted data?
 - Flow charts and diagrams (i.e. "front-loaded" information) are incredibly helpful.
 - Any type of front-loaded information that is applicable to a patent and can describe the program de novo would be helpful for the disclosure.
- The written description of the invention needs to be thorough enough that the patent drafters can accurately enable the technology in the patent – called the patent enablement requirement.
- Disclose all open-sourced software packages that were used in the development of the disclosed software.
 - Provide all sources, their licenses, and the links to those licenses so the counsel can review them to accurately draft the patent and describe the novelty.
 - For any patents, especially software patents, detailing the technical problem of existing [related] software and the technical benefit of a novel software is important.

2. Commercialization potential

- a. Are there any companies interested in the software?
- b. What would be the accessibility intentions of the software (i.e. who are the end users of the software)?
- c. Are there competing programs or programs that serve the same purpose as the one being disclosed? How much do those programs cost?

TIPS:

- Is there a target company that can be used as an inspiration for drafting the patent application (i.e. tailoring a patent to enhance the probability of that company licensing the patent)?
- It's important that the researchers/innovators do not self-edit or self-advise the patentability of a technology or software because the strategy could easily change based on a variety of different factors:
 - E.g., Prior art, having a licensee lined up, knowing a particular claim may not be allowed, etc.

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3. Cost of development

- a. How much did the software cost to develop, what were the sources of funding used to develop the software, and how were those costs distributed?

4. On-going development

- a. What stage of development is the software in at the time of submission of the software disclosure?
- b. Are updates and/or version of the software expected?
- c. Are there entities who are interested in beta testing the software?