

software developer knows about A and B, and upon looking at A, and then looking at B, would a POSITA consider A and B together to already be known? If the answer is yes, then A plus B is obvious. If the answer is no, A plus B is not obvious.

## Section 1

### “US Patents: Definitions & Patentability”

## Chapter 7

### Patent Claims and the Tangibility of Digital Products

**I've developed a new software app. How does software fit in to the world of patent eligibility?**

This is a very good question, and something I get a lot lately. Software developers and, say, groups of engineers collaborate, and oftentimes co-create new software apps. New software apps are coming out thousands, if not tens, or hundreds of thousands at a time. What type of protections should these innovators be seeking? There are two. We'll talk about them each in turn.

- **Patent Protection.** We should talk first about how the scope of patent eligibility for software has become the subject of numerous court decisions just as recently as over [www.boldip.com](http://www.boldip.com) | Bold IP, PLLC | 1-800-849-1913

the past eighteen months. 2014's Alice Corp vs CLS Bank decision by the Supreme Court has since spurred between 15 and 20 federal court decisions on the subject. These decisions are all over the map, as far as how to try to interpret the Supreme Court's holding, but there has been a basic line of reasoning that the courts have held.

The reason why software recently got this kind of airtime in the courts is because it is a little tricky when it comes to eligibility.

We've discussed the four different types of inventions that qualify for patent rights. The ones easier to define seem to be those things that one can touch and feel: the airplane fuselage that starts out as sheet metal, or as composite material, for example. As it moves through the manufacturing line and goes through additional processes and starts to re-form; as each sheet gets riveted to one another and attached to the frames, soon what was simply a sheet of metal has now become a well-formed position fuselage.

It's not that simple with software, and as one might imagine, there's no big, honking metal parts to see. But if those digital processes

have some tangible result and function, they may very well be qualified for exclusivity rights.

As of this writing, it stands in the courts that as long as the claims tie the process steps to a specific machine, the claims could be considered by the USPTO. However, if the "process" is simply a recitation of steps; if an applicant's claim states that "if one were to perform steps A, B, C, and D, using software on a computer and that these steps should be considered patentable functions performed on the personal computer," there process is too generic.

Unfortunately, that was the case for CLS Bank, as the Supreme Court ultimately said that their financial software application is not patent eligible.

However, this does not mean that there isn't software that IS eligible for protection. As long as the patent claim:

- cites specific problems that the software attempts to solve, and the
- functions can be proven and shown through novel hardware, specific user interface, or specific electrons moving, traveling along a physical line, cable or air-wave, and
- are received by another signal.

THEN you're talking about something that is certainly patent protectable.

Something else to think about in regards to software that many people might not understand is that software is simply a process. The coding belongs more in the domain of copyright.

- **Copyright Protection.** This protection is for the code that developers and/or engineers have produced. Registration for a copyright can be granted through the Library of Congress. Although I would highly recommend registering software code for a copyright, it is a process that is separate from the patent law, and the USPTO.