Patenting Software Methods
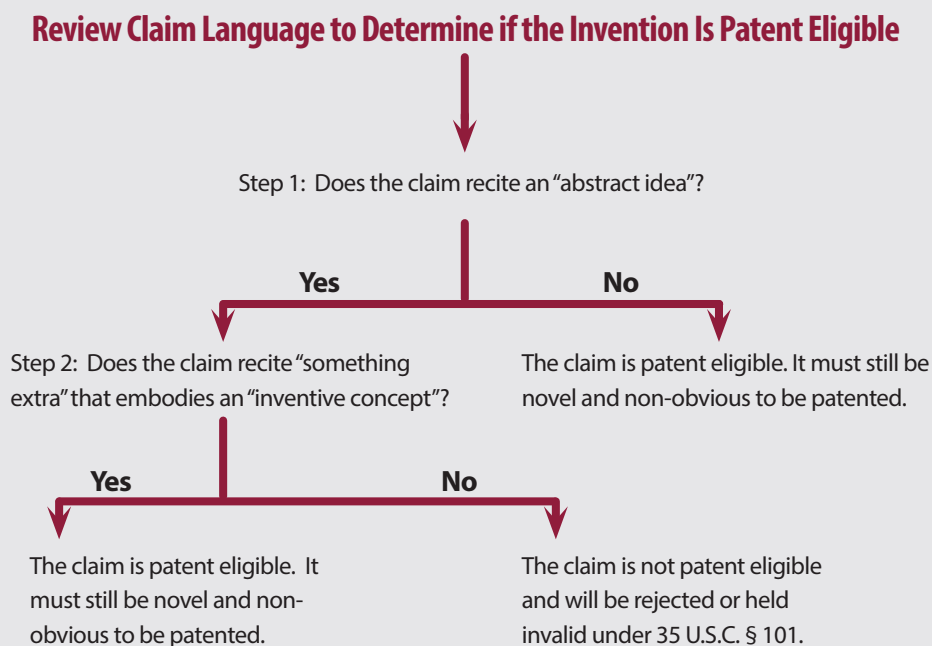
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by David E. Rogers

Software methods can be patented in the United States if the application is prepared to describe and claim subject matter legally defined as being patentable.

Under *Alice Corp. v. CLS Bank International*, 134 S. Ct. 2347 (2014) analyzing a claimed software method involves two steps. In step one, the claim language is interpreted to find if it is directed to an "abstract idea," such as an algorithm, method of computation, or other general principle. If the answer is "no," then the claim is patent eligible and you do not go to step two. If the answer is "yes," go to step two. In step two the claim is interpreted to find if it recites "something extra" that embodies an "inventive concept."

The analysis is represented in the following chart:

Review Claim Language to Determine if the Invention Is Patent Eligible

Step 1: Does the claim recite an "abstract idea"?

Yes   **No**

Step 2: Does the claim recite "something extra" that embodies an "inventive concept"?   The claim is patent eligible. It must still be novel and non-obvious to be patented.

Yes   **No**

The claim is patent eligible. It must still be novel and non-obvious to be patented.   The claim is not patent eligible and will be rejected or held invalid under 35 U.S.C. § 101.

The "something extra" could be a new and non-obvious method step (such as one that transforms data in a unique way), an improvement to the functionality of software or hardware, a different type of hardware, or a unique software/hardware interface.

So How Should Software Patent Applications Be Drafted?

Applications should be drafted to describe and claim subject matter that falls into one or more (and preferably as many as possible) categories that the courts have held to constitute patentable subject matter. The devil is in the details. Broad method steps, even if reciting standard computer operations, will likely not suffice. Following are among the things a careful drafter would thoroughly describe:

(1) The physical devices/systems on which the software operates, the user interface, and improved operation(s) of the physical devices/systems due to the software operation (e.g., it lowers energy consumption, enables a memory to store more information without an increase in RAM, or otherwise enhances device performance, such as to enable improved facial recognition).

(2) Any new data structure (e.g., data comprised of a unique combination of temperature, vibration, time, and location), or a different manner of inputting data via a physical device.

(3) How data is organized to permit faster searching and/or retrieval.

(4) Any new data encryption technique.

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