

Introduction to IP

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Kilburn & Strode LLP

- Founded in 1906
- Currently 17 partners
- 64 fee earners
- 150+ total workforce
- Electrical and Information Technology Group (26 fee earners)
- Chemistry Group
- General Engineering Group
- Biotech and pharmaceutical Group
- Trade Marks and Designs Group
- Top ranked by main surveys:

Types of IP

- Unregistered rights
 - Copyright/unregistered designs
 - Form, not substance
 - Know-how
 - Confidential information
- Registered rights
 - Trade marks
 - Brand
 - Registered Designs
 - Aesthetic, non-functional
 - Patents

Patents

- Substance not form
 - Underlying principles or process
- Right to exclude
 - Limited Duration (20 years)
- Disclosure
 - Quid pro quo of monopoly rights
- Territorial
 - National rights, although harmonised European system

Requirements for patentability

- Novelty
 - Claimed invention must be new over anything disclosed to the public by anyone anywhere.
 - This includes your own disclosures
- Inventive step/obviousness
 - Mere novelty not sufficient, must show that the difference is inventive
- Patentable subject matter
 - More on this later

The patent application process

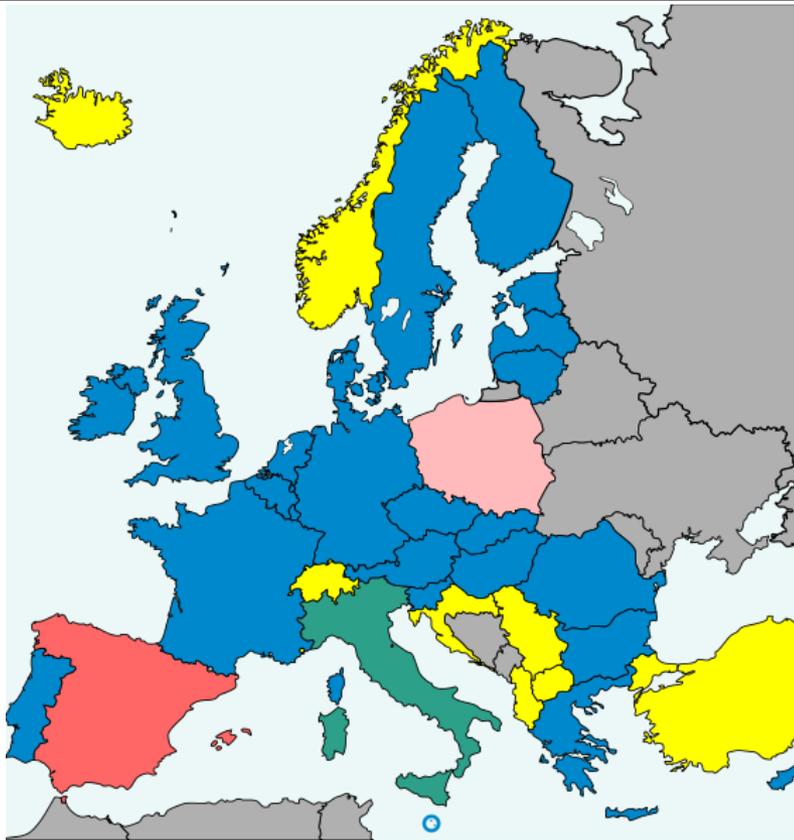
- Drafting and filing the application
 - Often the most time consuming single step. The application must contain everything needed to get through the process to grant, as room for later changes is severely limited.
- Search and Examination
 - Patent office will attempt to find prior art that can be used to show the invention is either not novel or not inventive. Arguments and possible amendments will ensue, until hopefully...
- Grant
 - Patent officially granted. Only at this point can any enforcement action take place

The patent application itself

- Background
 - What's the problem?
- Summary
 - How is the problem solved? Here, in general terms
- Detailed description
 - A particular example (your best one) of the invention
- Claims
 - Define the scope of protection. In a single, tortuous sentence
 - These are what are examined during the application process and what are used to judge later infringement

International Protection

- Broad filing strategy costs money
- Priority
 - 1 year from first filing
- Patent cooperation treaty (PCT)
 - 148 contracting states
- European patent convention
 - Unified procedure up to grant
 - National patents thereafter
- Unitary patent



- EU members participating in enhanced patent cooperation and the Unified Patent Court
- EU country only participating in Unified Court
- EU country only participating in enhanced patent cooperation
- EU countries not participating
- Other European Patent Convention parties (no participation possible)



- EPO member states & London Agreement
- = no translation
 - = claim translation
- (English specification)

Patentable subject matter

- or can I patent a computer program?

- Practical issues
 - The code per se is protected by copyright, patents are for the underlying principles
- Cultural issues
 - Open source movement
- Legal issues
 - Art 52(1) EPC: European patents shall be granted for any inventions, in all fields of technology...
 - Art 52(2) EPC: The following in particular shall not be regarded as inventions ... programs for computers ...
 - Art 52(3) EPC: Paragraph 2 shall exclude ... only to the extent to which [an invention] relates to such subject-matter or activities as *such*

What does that actually mean?

- You can't patent a computer program as such...
 - ...but you can patent a computer implemented invention
- How do you know the difference?
 - A patentable invention is *technical*
 - It solves a *technical* problem
- But this is just another question
 - What does technical mean?

Computer programs are not the only exclusion to patentability

- Others include
 - discoveries
 - mathematical methods
 - methods for performing mental acts
 - methods for doing business
 - presentations of information
- Can consider this a non-exclusive list of things considered non-technical
 - all only excluded as such
- Can be informative to consider how these are treated:
 - You can't patent a discovery - but you can patent the application of that discovery
 - You can't patent a computer program - but you can patent an invention which uses a computer program to do something more

How does this work in practice?

- During search and examination, the patent office will assess whether your invention is technical
 - In the UK if not technical the application will be refused as relating to unpatentable subject matter. Judged by whether the invention makes a technical contribution to the art
 - At the European patent office, the application will be refused for lacking an inventive step - because it doesn't solve a *technical problem*
 - Different approaches, but (should be) the same practical outcome
- At the outset, you must prepare the application with the idea of a technical contribution or technical problem solved

Some historical examples

- Vicom
 - Image processing method on known computer equipment
 - Only contribution is in the processing of electrical signals representing the image, but this still felt to offer a technical outcome. The image is considered to have some element of physical reality.
 - Application allowed

- Gale
 - Method of calculating square roots
 - Used in a calculator - benefits are increased accuracy/speed
 - Application denied - invention considered a computer program (non-technical) implementation of a mathematical method (non-technical)

Symbian

- Improved method of handling Dynamic Link Libraries (DLLs)
- A software solution to a software problem, so not technical right?
- Wrong -"A computer with this program operates better than a similar prior art . To say 'oh but that is only because it is a better program – the computer itself is unchanged' gives no credit to the practical reality of what is achieved by the program. As a matter of such reality there is more than just a 'better program', there is a faster and more reliable computer."
- But don't all computer programs result in a better computer, if only for the particular purpose of that program? We can perhaps distinguish this case as being at the OS rather than the application level, but we can see the type of arguments needed

Apple - Slide to unlock

- Patent granted at EPO, and later litigated in UK and German courts
- “Unlocking a device by performing gestures on an unlock image”
- Claim required “moving an unlock image along a predefined displayed path”
- At the EPO, Apple argued the problem this solved was to “provide more efficient, user-friendly procedures for unlocking portable electronic devices”
- In court, the case was invalidated for lack of inventive step.
 - Always need to know what the prior art is

US and European differences

- Historically, US approach much more favourable than European approach
 - No statutory bar on any particular subject matter
 - “Anything under the sun made by man”
- However, recently more limited approach has been adopted.
- “Machine or transformation”
- Abstract/non-abstract
- Pre-emption
- Design application for Europe, and it will be strong in the US

Spider.io

- UK start up
- Filed first patent applications approx 3 years ago
 - US filings accelerated given potential market/investment
- Technology relates to online ad fraud - has an advert been viewed as often as it appears to have been, how many people have seen it?
- Search and examination ongoing
- Acquired by Google - press release last Friday
- Google saw the value: patent applications, know-how, expertise

Thank you

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