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-advice 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?