Mr Peter Messerli
Chairman of the Enlarged Board of Appeal
European Patent Office
Erhardtstrasse 27
D80298
Munich

30 April 2009

Re: Case G3/08
Referral of the President of the EPO under Art.112(1) (b) of October 22nd 2008.
Statement according to Article 10 Rules of Procedure of the Enlarged Board of Appeal

Dear Mr Messerli,
With reference to the Decision of the Enlarged Board of Appeal of 11 November 2008, I submit the following statement on the points of law referred by the President of the European Patent Office.

Question 1.

This question has been submitted based on an alleged divergence between T1173/97 (Technical Board of Appeal 3.5.1) and T424/03 (Technical Board of Appeal 3.5.1). However, not only are the two decisions those of a single Board of Appeal, but also there is clearly no divergence in their findings.

In T1173/97 the appeal was from a decision of the Examining Division who objected to two independent claims directed to 'A computer program product' on the basis that their subject matter was excluded from protection under Art. 52 (2) and (3). The Examining Division had found allowable claims directed to "A method for resource recovery in a computer system running an application which requests a work operation involving a resource, …."; and to "A computer system…." albeit that these were respectively directed to the method resulting from the running of the novel program in an otherwise conventional computer system, and to a conventional computer system modified simply by programming with the new computer program.

In T424/03 the application had been refused by the Examining Division for lack of novelty and inventive step, a new set of claims them being submitted before the Board of Appeal. The new set of claims contained an independent claim directed to 'A method in a computer system having a clipboard for performing data transfer of data in a clipboard format, …." – a method implemented by using an otherwise conventional computer programmed with a novel program; and an independent claim directed to 'a computer readable medium having computer – executable instructions adapted to cause the computer system to perform the method of one of claims 1 to 4."

In both decisions Board 3.5.1. found all the claims (and hence their formats) to be allowable – none falling foul of Art 52 (2). In T1173/97 the Board did not

find reason to comment substantively on claims to the method for resource recovery and for a computer system for carrying out the method – since these had not been objected to by the Examining Division and were clearly allowable. At issue were the computer program product claims which the Board reasoned to be allowable. Similarly in T424/03 the computer program product claim was deemed to be allowable through direct analogy (and reference to) T1173/97. In T424/03 The Board explained how the form of the claim to 'A method in a computer system...” could <u>not</u> be equated with a claim to a computer program as such – and hence could not be objected to on the basis of A52 (2).

Against this background it cannot be seen that T1173/97 and T424/03 are in any way divergent. Moreover, the two decisions emanate from one Board of Appeal rather than two and hence the requirement of Art 112 (1) (b) would not seem to be met.

Question 2.

This question is posed based on an alleged divergence between T1173/97 (TBA 3.5.1.) and T258/03 (TBA 3.5.1.).

In particular it is suggested that in T1173/97 "The Board considered ' programs for computers' to be a type of method – claim” This odd premise is based on consideration of section 9.6 of the Reasons for the Decision which is concerned with the claims for a computer program product. The relevant part of the section reads as follows: "A computer program product which (implicitly) comprises all the features of a patented method (for operating a computer, for instance) is therefore in principle considered as not being excluded from patentability under Art. 52 (2) and (3) EPC.

It is self-evident that a claim to such a computer program product must comprise all the features which assure the patentability of the method it is intended to carry out when being run on a computer. When this computer program product is loaded into a computer, the programmed computer constitutes an apparatus which in turn is able to carry out the said method.”

It is clear that this passage does not support the contention that the Board considered claims to computer program products actually to be method claims. A claim to an apparatus which, in use, performs a novel and inventive method may be claimed as an apparatus which is configured to behave in accordance with that method – such a claim to an apparatus does not thereby become a method claim. Likewise a claim to a conventional computer programmed to perform a particular novel and inventive technical method does not constitute a claim <u>to</u> the method albeit that all the features on the method are somehow expressed in the definition of the programmed computer.

Thus, the alleged basis for alleged divergence is not actually present. In addition the two decisions are in fact those of a single Board of Appeal, so that the requirements of Art. 112. (1) would not seem to be met.

Question 3

This question is based on alleged divergence between four decisions of the single Technical Board of Appeal 3.5.1. The referral seeks to draw a distinction between T163/85 and T190/94 on the one hand and T424/03 and T125/01 on the other.

In T163/85 the claimed subject-matter was a television signal, and the Board found that the signal claimed was a physical reality which could be detected directly by technological means.

In T190/94 the claimed subject-matter was a (computerised) system for rotating an image (for example on the display of a workstation or personal computer), where the Board said that the difference between the claimed subject-matter and the prior art manifested itself in the real world in a technical effect on a physical entity in the sense of T208/84 (Vicom) − albeit that the physical entity was merely an image on a visual display of a computer system.

In T424/03 the invention concerned a method performed in a computer system using a clipboard to effect data transfer, selected data being converted into a file contents clipboard format and stored as a data object, etc.

In T125/01 it is not clear that there was any substantive consideration of the relevance or application of Article 52 (2) to the claimed subject-matter − the application being refused on a conventional application of Article 56.

Consideration of the three decisions that concern Article 52(2) reveals that there is no significant divergence between them: the conversion and storage of the data in the invention of T424/03 concerns a physical reality which can be detected directly by technological means, just as the television signal could be in T163/85. Similarly, there is nothing to distinguish the 'reality' of the computerised image processing of T190/94 from the computerised data processing in T424/03 - they are equally 'real' and can readily be discerned by studying the behaviour of the two systems.

The conjecture which concludes the discussion of question 3 does not seem to find any basis in any actual divergence between the identified decisions.

Question 4
This question is based on the alleged divergence between 5 Decisions of TBA 3.5.1 - T1177/97 and T172/03 on the one hand and T833/91, T204/93 and T769/92 on the other.

The divergence is said to consist of Decisions T1177/97 and T172/03 accepting that technical considerations are involved in implementing a function of a computer system or that providing a software implementation of even a non-technical method constitutes a technical problem, whereas the other decisions are said to show that a programmer's activity, that is the writing of computer programs, falls within the exclusions set out in Article 52(2) (c) – that is that these decisions consider that the activity of programming constitutes a mental act.

But this confuses the process of programming with the considerations which must be taken into account during the process. There are innumerable technical activities that require technical considerations – the process of designing almost anything in any engineering sector for example, or of solving any kind of technical problem, and the solution or arrangement of those technical considerations may give rise to eminently patentable inventions – but that does not make the process or act of designing or of solving problems patentable. Generally the very same objection under Art.52(2) (c) will apply – that the process of designing or of problem solving is merely a mental act (albeit that patentable inventions *might* arise in an automated system for designing something or of problem solving).

Thus it does not seem that any significant divergence exists between the *ratio* of the cited cases.

Although it is believed that it would be quite appropriate to consider the referral in this case to be inadmissible, it may nevertheless be helpful to comment on the questions and possible answers thereto.

Question 1
Can a computer program only be excluded as a computer program as such if it is explicitly claimed as a computer program?

The European Patent Convention is a convention for the granting of patents and Article 52(1) "is of fundamental importance for the whole of substantive patent law. It lays down the fundamental principle of a general entitlement to patent protection: as a matter of principle a European patent is to be granted for an invention. Any exceptions to this are to be construed narrowly (see G1/83, G5/83. G6/83, point 22, with reference to the ultimately identical view of the German Federal Court of Justice)." [Singer/Stauder – The European Patent Convention]

While Art.52(2) does provide a list of things which are not to be regarded as inventions, these exclusions are tempered by Art.52(3) – so that the exclusion only applies to the extent to which a European patent application relates to such subject-matter or activities as such.

Of equal if not greater practical significance is the fact that to be patentable an invention must be new and involve an inventive step. The developed caselaw of the Boards of Appeal has rightly placed much emphasis on the importance

of assessing inventive step. A great many patent applications relating to what are known as computer implemented inventions are rightly refused for lack of inventive step even though their claims are so worded as to avoid exclusion under Art.52(2).

By focussing only on exclusion under Art.52(2), the question may unintentionally mislead those unfamiliar with the patenting process.

It would clearly be possible to claim a computer program as such without using either the words computer or program – such as by referring to a set of instructions for controlling a machine so it is clearly not appropriate simply to answer the question with an unqualified "Yes" - but it is equally important to give due weight to Art.52(3). Moreover, the reasoning in T1173/97 on this point is believed to be sound and consistently applied by the EPO without much problem.

Question 2
(a)   Can a claim in the area of computer programs avoid exclusion under Article 52(2)(c) and (3) merely by explicitly mentioning the use of a computer or a computer-readable data storage medium?

(b)   If Question 2(a) is answered in the negative, is a further technical effect necessary to avoid exclusion, said effect going beyond those effects inherent in the use of a computer or data storage medium to respectively execute or store a computer program?

The established case law answers question (a) in the affirmative. The established case law rightly applies Article 56 in such a way as to make life extremely difficult for those who seek to patent business methods etc. It is believed that this approach is the correct one.

Question 3
(a)   Must a claimed feature cause a technical effect on a physical entity in the real world in order to contribute to the technical character of the claim?
(b)   If Question 3(a) is answered in the positive, is it sufficient that the physical entity be an unspecified computer?
(c)   If Question 3(a) is answered in the negative, can features contribute to the technical character of the claim if the only effects to which they contribute are independent of any particular hardware that may be used?

This question seems to assume that use of the discredited "contribution" approach is appropriate: it is not and has not been for many years.

The concept of the "real world" suggests a lack of understanding of this area of technology and is in any case without any basis in the EPC.

In so far as the question has meaning, the answer must be no – on the assumption that the inner workings of a programmed machine are not considered to be "real world".

In so far as question 3(c) has relevance, the answer must be yes. The inventive solution of a technical problem does not imply or require the use of something other than general purpose or generic hardware.

Question 4
(a)   Does the activity of programming a computer necessarily involve technical considerations?
(b)   If Question 4(a) is answered in the positive, do all features resulting from programming thus contribute to the technical character of the claim?
(c)   If Question 4(a) is answered in the negative, can features resulting from programming contribute to the technical character of a claim only when they contribute to a further technical effect when the program is executed?

Again, these questions seem to be based on the mistaken assumption that a contribution approach should be used in the assessment of patentability under Art.52(2). The currently applicable case law – Hitachi T258/03 makes it clear that claims directed to the result of programming will if appropriately drafted not be excluded under Art.52(2) since they will have technical character. The subject matter of such claims would then need to be further assessed for the existence of an inventive step.

Conclusion

It is unfortunate that patent law has become something of a political football – and that the application of Article 52(2) has attracted a disproportionate amount of ill-informed comment. Processors controlled by stored programs are utterly ubiquitous – from the engine management systems of our vehicles, their anti-lock brake systems, our mobile phones, washing machines, pacemakers, CAT scanners, MRI scanners, televisions, manufacturing machinery – the list is endless.
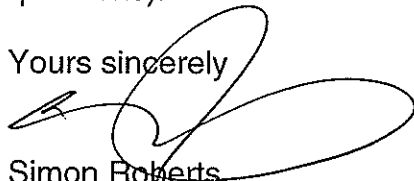
Often the performance of any one of these devices may be substantially enhanced simply by loading enhanced software – so that last year's CAT scanner now has higher resolution because of new algorithms implemented in the new software; the fuel economy of an internal combustion engine is improved by a cleverer method of using the data available from the existing engine management sensors.

Where historically performance enhancements would often come from improved design of hardware now much of the progress in the performance of machines comes in large part from enhancements of the code that controls the machinery. If such improvements were to become unpatentable there

would be dire consequences for the European economy with no compensating benefit.

It is clear that it was never the intention of those responsible for creating the European Patent Convention that such inventions should not be patentable. Through the developed and now established caselaw of the Boards of Appeal the EPO has happily managed to throw out the business method "bathwater" while safeguarding the "baby" of meritorious and inventive technical solutions to real-world problems. All those with an interest in the future of the EPO and the continued commercial success of the industrial and computer-related industries of Europe look to the Enlarged Board to come up with the right answers (should it be deemed appropriate to answer any of the referred questions).

Yours sincerely

Simon Roberts
European Patent Attorney
Head of Patents
Intellectual Property Department
British Telecommunications plc