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Enlarged Board of Appeal  
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**Subject: *Amicus Curiae* Brief G3/08**

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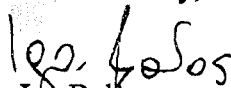
Dear Sirs,

I am a student of law, I will soon graduate. My Master's Theses concerns the application of Article 52 of EPC in the scope of computer programs. Even though I started my research some time ago, it is still in progress thanks to dynamic EPO practice.

Law application is not only limited to executive. Legal regulations are supposed to be applicable by subjects they refer to. That is why inventors' opinion on the subject is truly meaningful. It is important because it constitutes practical aspect of EPC provisions. This aspect is hard to be overrated but for me, as a lawyer, law goes first. Then the practice.

I have examined sufficient amount of EBA decisions to consider myself as a person with strong based opinion on the subject. It does not mean I do have a concept how the submitted questions should be answered. What I do know is that there is a misconception about basic patent law principles. Some of the *amicus curiae* briefs reveal above mentioned as well. I would like to share some remarks as a person with maybe not personal but still great interest in the case.

Yours faithfully,

  
Iga Balos

1. First of all, the arguments of social and economic convenience cannot be used in interpretation and application of EPC provisions. Those could have been used at legislative stage but not when it comes to execution. Besides, it seems impossible to me to find any balance between "YES or NO to software patents" attitude. The point of view depends on interest and should not be decisive in a law making or applying process. What is more important, opinion differs from country to country, depending on their stage of development, which can cause additional ado among members of international organization i.e. EPO.

2. Verifying the fact whether the subject matter constitutes an invention or not, is the first constraint to be met. Novelty, inventive step and industrial application are requirements for **invention**. According to one of amicus curiae briefs, in order to "deal with" computer programs problem, it is admissible to skip the requirement of an invention and go straight to analyzing novelty and the rest. From inventor's point of view, it may look very practical and timesaving since the task is tough. Industrial property protection system protects inventions. If there is no invention, no protection can be granted. Above mentioned approach leads to an inadmissible assumption that each computer program is an invention, the question whether patentable. Even an issue of such a great importance cannot turn upside down basic patent law principles.

3. In my opinion, question no. 2 (a) does not refer to mixed type claims as it is suggested in one of amicus curiae brief. It is more about "any hardware approach" which was strongly developed in PBS<sup>1</sup>, Hitachi<sup>2</sup> and Microsoft Data Transfer<sup>3</sup> cases. It was also applied in Fujitsu case<sup>4</sup> from 2007. It let me assume this approach is still approved by Boards of Appeal. Of course it is admissible to look at claims including any hardware as if they were mixed type claims. In fact they are mixed type. But still, this is not this stage of verification where the problem appears. Invention first, the invention step will follow...or not but as long as the invention is not confirmed, interest in invention step is useless.

<sup>1</sup> T 931/95 – Pension Benefit System.

<sup>2</sup> T 258/03 – Auction method/HITACHI (OJ EPO 12/2004, 575).

<sup>3</sup> T 242/03 – Clipboard formats/MICROSOFT.

<sup>4</sup> T 1351/04 – File search method/FUJITSU.

4. It has been raised many times that requirement of technical character of invention does not derive from EPC. This may be true statement but one cannot forget where the EPC derives from. It combines legal tradition of all contracting states. It is obvious that one contract, European Patent Convention or any other, cannot be taken as a complete version of agreement. Some things are agreed elsewhere, some are not a subject to agreed at all because they are obvious for everyone. I am not trying to present a technical character as a remedy. It lacks of stable content, it is casuistic. It is hard to prove and easy to deny. I cannot think of any substitute for this criterion at the moment. British court said about technical character it was *a useful servant but a dangerous master*<sup>5</sup>. I admit the slogan is quite catchy. It was then suggested to find determinant of invention, especially in case where claims are connected with computer programs, somewhere else. It was not said where. Technical character is not a useful servant. It is just useful since there is no other stable concept. Maybe it is a question of time until inventors, judges and other involved subjects know what a technical character of computer program is?

5. Article 52(2) is like aspirin-applicable to everything, i.e. CII, computer programs, methods implementing by computer program etc. It is really hard, maybe even impossible, to discuss technical character of them all at once. To my mind, applying article 52 underwent evolution. Thanks to it, there is a possibility of looking at a computer program product as a subject matter to protect. At first Article 52 was used in context of any kind of appearance of computer programs in claim. Nowadays, computer program product<sup>6</sup> can be assessed itself. This distinction, between "somehow connected with computer programs applications" and "computer program application", matters when technical character is searched.

6. In my opinion, looking from different points of view, meaning both inventors and consumers, patenting software is not the worst or the best that can happen. The worst is uncertainty of law. On Mondays software is patentable, on Thursdays you never know. EPO judicature tends to grant patents all week long. Its previous reasoning should be taken into consideration as a process of establishing practice. There is something more. I cannot tell the difference between the situation when Boards of Appeal assess patentability, technical character included, of ANY putative invention and when they do the same as to computer

<sup>5</sup> High Court of Justice (Chancery Division/Patent Court), Neutral Citation Number: [2005] EWHC 1589 (Pat), Date: 21/7/2005., *In the matter of Patent Applications GB 0226884.3 and 0419317.3 by CFPH L.L.C.*, point 14.

<sup>6</sup> T 1173/97 – Computer Program Product/IBM.

program or computer program related invention. It is still within the scope of their authorities because Boards of Appeal decide independently, no subject matter distinction. If contracting states have special opinion about computer programs as an exception from the rule, EPC needs to be amended. Boards of Appeal can be called "the executive of the executive". The other executive is European Patent Office in relation to European Patent Organization. Maybe any changes towards binding force of Guidelines or different instructions can make member countries feel more safe about patenting software. But it is up to them not up to BA.