

The Enlarged Board of Appeal  
European Patent Office  
D-80298 München  
Germany

date 30 April 2009  
your ref G3/08  
our ref 406.Amicus

Dear Sirs

## Case G3/08 - Amicus Brief

I am a partner in a firm of Patent Attorneys but these comments are not presented on behalf of any particular client nor in relation to any particular case. Nor can they be assumed to reflect the views of the firm as a whole.

On 13 December 2007 a revised European Patent Convention came into effect. Article 52 (1) now reads:

*Patents shall be granted for any inventions, in all fields of technology, provided that they are new, involve an inventive step and are susceptible of industrial application.*

The Travaux Préparatoires (MR/2/00) for EPC 2000 explain the reasons for the change.

*Article 52(1) EPC has been brought into line with Article 27(1), first sentence, of the TRIPS Agreement with a view to enshrining "technology" in the basic provision of substantive European patent law, clearly defining the scope of the EPC, and making it plain that patent protection is available to technical inventions of all kinds.*

The Travaux Préparatoires (MR/2/00) for EPC 2000 also included the following.

*In light of the new wording of Article 52(1) EPC, it may be queried whether the provisions of Article 52(2) and (3) EPC, which enumerate subject-matter or activities not to be regarded as inventions, are still needed.*

Ultimately, nothing was done in respect of Article 52(2), for fear of sending out an encouraging message about patents in respect of business methods. However, Article 52 (2) has always been

### Partners

Christopher P. Pett MA ♦♦  
Kerry J. Tomlinson MA ♦  
Michael J. Butler MA ♦♦  
Julian Cockbain MA DPhil ♦♦  
Christopher R. Davies BSc ♦♦  
Alexander J. Piésold BSc ♦♦  
Derek P. Matthews BSc PhD ♦  
Hanna Dzięglewska BSc PhD ♦♦

### Roberto Calamita MA ♦♦

David Leckey BSc ♦♦  
Alison J. Hague MA ♦♦  
Philip D. Towler MA ♦♦  
Andrea M. Hughes BEng LL.M ♦♦  
John P. Tothill MA ♦  
Robert P. Jackson BSc LL.M ♦  
Elizabeth Jones MSc PhD ♦  
Louise A. Golding MA ♦

### Rebecca Gardner BSc ♦

Philip M. Jeffrey BSc PhD ♦  
Annabel R. Beacham MA DPhil ♦  
Adrian Samuels MA ♦  
Neil Campbell BA ♦  
Philip M. Webber MA PhD ♦  
Matthew Hall BA MSc ♦  
Elaine P. Deyes BSc ♦

### Associates

Jason Stevens BA ♦  
Joseph M. Letang LL.B ♦  
Deborah J. Owen MA PhD ♦  
Katherine F. Mabey MA ♦  
Christopher R. Goddard MA PhD ♦  
Clare L. Stoneman BA ♦  
Anna Leathley MBiochem PhD ♦  
Andrew Chiva MSc ♦

### Jodie Rutherford BSc PhD ♦

Stephen Gardiner MPhys ♦  
Sara Kidd BSc PhD ♦  
Daniel Rowe BSc PhD ♦  
Barbara N. Rigby MA PhD ♦  
Richard Goddard BSc MSc ♦  
Adam Taylor MEng ♦

an unsatisfactory way of defining subject matter that can be patented. Its provisions are not exhaustive, are not absolute, and before EPC 2000 came into force had been reduced to a trivial matter, as made clear in *File Search Method / Fujitsu* T1351/04, for example. If a claim includes a reference to something technical, that is enough. The recent *Bilski* judgement in the United States makes it clear that, even there, it is necessary to do more than just refer to a machine.

The failure of the original Article 52 (1) or Article 52 (2) to provide a clear basis for determining what type of subject matter could be patented, has led the Examining Division to develop some examining practices in respect of computer implemented inventions that are difficult to understand and exhibit serious prejudice against such fields of technology. A claim which specifies functions carried out by apparatus will be examined in a completely different manner if the specific embodiment described and illustrated is computer equipment configured by a program, than would be the case if the specific embodiment was a machine with a collection of gears, springs and levers. There is a significantly lower chance of success.

The change made to Article 52 (1) by EPC 2000 introduces a clear, substantive requirement for an invention to be in a field of technology. The EPO should adapt its practices accordingly and should bear in mind that an invention may be in any field of technology and that Article 52 (1) is worded such that there can be no discrimination against any field, and in particular against fields of technology that are implemented by computer.

Considering the specific questions before the Enlarged Board.

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

Amicus Submission 1:

If there is claimed an invention in a field of technology, determined as a matter of substance, it is irrelevant whether, as a matter of form, the claim is expressed as apparatus, a method, or a computer program. No such claim should be excluded.

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

Amicus Submission 2 (a):

The requirement for an invention to be in a field of technology is a matter of substance under Article 52(1) and simply referring to a computer or to a storage medium makes no difference.

2 (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?*

Amicus Submission 2 (b):

Whether there is an invention in a field of technology is a matter of substance to be determined on a case by case basis.

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?*

Amicus Submission 3 (a)

There is nothing in Article 52 (1) or anywhere else in the EPC that requires an invention in a field of technology to cause a technical effect on a physical entity.

3 (b). *If question 3 (a) is answered in the positive, is it sufficient that the physical entity be an unspecified computer?*

Amicus Submission 3 (b):

N/A

3 (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?*

Amicus Submission 3 (c)

Any features in a claim that contribute to the claimed invention being in a field of technology are relevant, regardless of hardware dependence or independence.

4 (a). *Does the activity of programming a computer necessarily involve technical considerations?*

Amicus Submission 4 (a)

Whether it does or does not, has no effect on whether a claimed invention is in a field of technology. It is necessary to look at what is claimed. Programming may be a technical art and may involve technical considerations but the qualifications and the activities of the inventor are not relevant when looking at a patent claim.

4 (b). *If question 4 (a) is answered in the positive, do all features resulting from programming thus contribute to the technical character of a claim?*

Amicus Submission 4 (b)

The answer must be negative. A programmer may modify a computer game program to produce a more attractive story line, prettier colours, or better music. Those may be contributions to the game but they are not contributions to computer game technology. On the other hand, writing new code to control the graphics processor of a computer so that fast moving objects in the game travel more smoothly across the screen, would be a contribution to the technology.

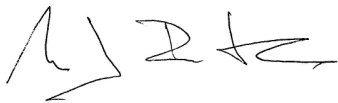
4 (c). *If question 4 (a) is answered in the negative, can features resulting from programming contribute to the technical character of a claim only when they contribute to a further technical effect when the program is executed?*

Amicus Submission 4 (c)

Again, it is necessary to determine whether what is claimed is an invention in a field of technology, on a case by case basis.

How the EPO will determine whether a claimed invention is in a field of technology, will vary from cases to case. In some cases it will be clear that the claimed invention cannot possibly be in a field of technology. An example is a pure business method, or such a business method where there is a trivial reference to a calculation being made using an electronic calculator. In other cases it may be easier to deal with the requirements of Article 52 (1) together and to determine whether there is an inventive step in a field of technology. Whatever practices the EPO adopts, it should not be seen to favour traditional technology over modern, computer implemented technology. Article 52 (1) EPC, as amended, does not allow it to do so.

Yours faithfully

A handwritten signature in black ink, appearing to read 'Michael J. Butler', with a stylized, cursive script.

Michael J. Butler