CIPA

The Chartered Institute of Patent Attorneys

Enlarged Board of Appeal
European Patent Office
Erhardtstrasse 27,
80469 Munich,
Germany

29th April, 2009

Dear Sirs,

Case G3/08 - Comments of the Chartered Institute of Patent Attorneys, UK

I am pleased to send you the comments of the Chartered Institute of Patent Attorneys on this case.

CIPA is the professional and examining body representing Patent Attorneys practising in the UK. It was founded in 1882 and was incorporated by Royal Charter in 1891. CIPA represents virtually all of the 1,750 registered patent attorneys in the United Kingdom, whether they work in industry or in private practice. Total membership is over 3,000, and includes trainee patent attorneys and other professionals with an interest in intellectual property matters. Its members include 1,497 European Patent Attorneys. CIPA maintains the UK Register of Patent Attorneys under statutory authority on behalf of the Department of Innovation, Universities and Skills.

CIPA members have extensive first hand experience of patents for computer-implemented inventions and work both in-house and in private practice to prosecute applications before the EPO and other patent offices. They are involved in legal and commercial activities relating to such patents, including defence against third party rights.

Yours faithfully,

Michael Ralph

M.C. Ralph
Secretary & Registrar

Amicus Brief: G3/08

The Chartered Institute of Patent Attorneys

Executive Summary

According to the EPC, computer programs *as such* are not inventions. However, this does not necessarily exclude protection for an inventive product or process which is implemented by a computer program. Over many years, the EPO Boards of Appeal have developed a carefully formulated approach in which patents are granted for a **technical solution to a technical problem**. This has now become well-established practice before the EPO in general.

In CIPA's view, there are many reasons for the Enlarged Board of Appeal to confirm this approach (and no compelling reasons not to). It provides a consistent framework for handling all areas of excluded subject matter, including business methods, etc., and also sits well with the reference to "technology" now included in Article 52(1) EPC. Furthermore, the approach offers continuity and legal certainty in terms of what is and what is not patentable, which is of great value to inventors and the public alike.

In summary, the current approach provides a sensibly balanced and legally coherent treatment of excluded subject matter that benefits both applicants and third parties. This approach should continue, and our detailed answers to the questions below reflect this position.

Introduction

The EPO Boards of Appeal have considered the patentability of computer-implemented inventions for over twenty years, from the seminal decision of T208/84 (Vicom) through to more recent decisions such as T154/04 (Duns Licensing). The case law has developed (rather than diverged) over this period to place increased focus on Article 56 EPC compared with Article 52(2) EPC. Nevertheless, the EPO Boards of Appeal have managed throughout to maintain a broadly consistent line as to what is or is not patentable, allowing for the combination of Article 52(2) EPC and Article 56 EPC. This represents a very significant and impressive achievement that provides certainty and predictability for applicants and the public at large.

The situation at the EPO is to be contrasted with difficulties elsewhere. For example, the State Street Bank decision from the US Court of Appeals for the Federal Circuit caused a significant increase in the range of subject matter for which a patent could be obtained, while the recent Bilski decision from the same court represents a potentially significant contraction. These two decisions have left US patent law in a state of great uncertainty. There have also been problems in the UK, where the IPO has issued four different Practice Notices relating to computer-implemented inventions in just the last five years. Such rapid changes are clearly undesirable given a patent lifetime of up to twenty years.

The current EPO approach does not discriminate between hardware and software, but rather focuses on technicality and, in particular, the provision of a technical solution to a technical problem. This clearly matches the philosophy of TRIPS (and the corresponding amendment to Article 52(1) EPC) that patents should be available for inventions in all fields of technology.

We therefore urge the Enlarged Board to confirm the current approach of the EPO Boards of Appeal as set out, for example, in T154/04. This approach is now established practice at the EPO and is also reflected in the Guidelines. This will provide welcome consistency, not only with EPO case law, but also across the various jurisdictions within Europe. Previous decisions from the Enlarged Board (e.g. G01/05 and G01/06) have likewise followed established practice absent compelling reasons to hold otherwise.

We have certain reservations about the Referral itself. Many of the legal conflicts identified in the Referral are based on an artificial (or incorrect) interpretation of the relevant decisions. They do not substantiate the presence of a divergence between the Boards of Appeal, but represent at most the natural evolution of case law. Other problems with the Referral include:
a) it is well-known that recent decisions, such as T258/03 (Hitachi), place great emphasis on the application of Article 56 EPC. However, the Referral makes virtually no reference to inventive step. This produces a distorted view of the case law.
b) although the Referral is concerned with computer programs (as indicated in the covering letter from the President), Article 52(2) EPC covers a much broader range of exclusions. Rather confusingly, some of the decisions relied upon in the Referral do not actually relate to (or consider) the computer program exclusion itself. There is great concern that any opinion of the Enlarged Board resulting from the Referral will have unexpected and perhaps unwelcome consequences for other categories of excluded subject matter, given this mismatch between the scope of the Referral and its potential effects.
c) the Referral adopts a very broad definition of "computer" that would easily encompass most video recorders, heating systems, dishwashers, etc.. This definition does not seem to have any basis in the EPC.

Such circumstances make it very difficult for the Enlarged Board to provide legal certainty other than by following existing practice, which provides a well-understood and trusted framework for handling computer-implemented inventions. It is therefore of great importance for the Enlarged Board to confirm the current approach of the Boards of Appeal.

Question 1

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

Response

The Background section for Question 1 recognises that computer-implemented inventions are claimed, inter alia, as "methods" and as "computer-implemented methods". The implication is that some method claims do not specifically recite a computer. Such a method claim may have no technical features and hence may fall into the exclusion of Article 52(2) EPC. (This follows the reasoning of T258/03 and other similar decisions).

Accordingly, the answer to Question 1 is "No".

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?

Response

2a) A claim that explicitly recites a computer or a computer-readable data storage medium necessarily has technical character since it involves a physical apparatus. Therefore such a claim does not fall within the scope of the exclusion of Article 52(2) EPC. (This follows the reasoning of T258/03 and other similar decisions).

Accordingly, the answer to Question 2a is "Yes".

However, it must be emphasised that such a claim does not necessarily represent patentable subject matter. In particular, features that do not contribute to the technical character are not taken into consideration in relation to inventive step under Article 56 EPC. This might be the case for example if the claim relates to a business method implemented on a conventional computer in which any innovation lies entirely in the field of economics. (This again follows the reasoning of T258/03 and other similar decisions).

2b) Given the positive answer to Question 2a, then an answer to Question 2b is not required.

Nevertheless, we note that according to earlier case law (especially T1173/97), the answer to Question 2a would be "no" and the answer to Question 2b would be "yes". However, this development in case-law from T1173/97 to T258/03 has not led to an overall change in the boundaries of patentable subject matter when considering the combined effect of Article 52(2) EPC **and** Article 56 EPC.

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?

Response

3a) A feature contributes to the technical character of the claim if it helps to provide a technical solution to a technical problem. The Question proposes an alternative condition for a feature to contribute to technical character, namely that there is "a technical effect on a physical entity in the real world". However, this alternative condition has no legal basis and its meaning is unclear. For example, image processing has long been recognised as a

technical process following T208/84 (Vicom), but an image may or may not be considered as a "physical entity in the real world".

Accordingly, the answer to Question 3a is "No".

This conclusion is consistent not only with T125/01 and T424/03, but also with T163/85 and T190/94, which only imply that a technical effect on a physical entity in the real world represents a **sufficient** condition for technical character, not a **necessary** condition.

3b) Given the negative answer to Question 3a, then an answer to Question 3b is not required.

Nevertheless, we believe there is no legal basis to discriminate between computers (which clearly lie in a field of technology) and other physical entities. Hence, the answer to Question 3b, if addressed, is "Yes".

3c) It was established in T208/84 (Vicom) that a technical process may be implemented using new hardware or new software running on a conventional computer. A claim to this technical process fell outside the exclusion of Article 52(2) EPC.

The technical effect in Vicom (faster image processing) was achieved irrespective of whether the implementation involved special purpose hardware or conventional hardware with special purpose software. The effects of the claim features were therefore independent of the particular hardware used. Indeed, this represents a common situation, where a technical process may be implemented on various hardware, and hence is independent of the particular hardware used.

Accordingly, the answer to Question 3c is "Yes".

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 a 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?

Response

4a) We assume that involving "technical considerations" represents having technical character. We further assume that "programming a computer" represents inputting instructions into a computer in order to control the operation of the computer. Since this activity necessarily involves an interaction with a machine (the computer), it has technical character (following T258/03).

Accordingly, the answer to Question 4a is "Yes".

Merely thinking about a possible program, rather than actually programming a computer itself, would be excluded under Article 52(2)(c) as a mental act (in the same way as thinking about any other potential invention).

4b) The "features resulting from programming" are assumed to represent the program code itself. Whether or not such features contribute to the technical character of the claim depends on the function of the program code, and in particular, whether or not the program code helps to provide a technical solution to a technical problem. For example, program code for calculating pension benefits would not contribute to the technical character of a claim. On the other hand, program code for matching genetic sequences or performing image compression would contribute to the technical character of a claim.

Accordingly, the answer to Question 4b is "No", since it depends on the function of the program code in question.

(The computer into which the program code is programmed would always contribute to the technical character of the claim).

4c) Given the positive answer to Question 4a, then an answer to Question 4c is not required.

Nevertheless, the same reasoning given above for Question 4b also applies to Question 4c. In particular, whether or not program code contributes to the technical character of the claim depends on the function of the program code and whether it provides a technical solution to a technical problem.

Information about CIPA

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