

**Registry of the Enlarged Board of Appeal
European Patent Office
80298 Munich
Germany**

Paris, 25 April 2009

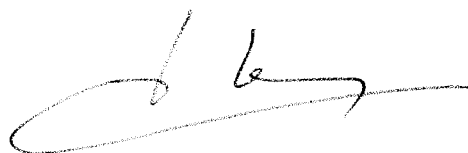
**Subject: Written Statement in Accordance with Art. 10 of the Rules of Procedure of
the Enlarged Board of Appeal**

Re. Case G3/08 – Referral under Art. 112(1)b) EPC by the President of the EPO.

Dear Sirs,

As a European Patent Attorney having been involved in the drafting and prosecution of patent applications, including in the field of computer-implemented inventions, since the entry into force of the EPC and having heavily participated in the debate on the draft EU directive on the subject, I wish to submit the attached statement for consideration by the Enlarged Board of Appeal.

Yours sincerely



Jacques Combeau

18 rue de Naples
F-75008 Paris

Tel. +33 1 4062 5469
e-mail: combeauj@wanadoo.fr

WRITTEN STATEMENT

Introduction

The President of the EPO must be praised for her decision to refer the question of the patentability of computer programs to the Enlarged Board of Appeal. One reason is, of course, the legal uncertainty which has been characterising this area of the business. Technical Boards of Appeal have tried very hard and honestly to develop over the years an appropriate approach for solving problems perceived to be involved with the application of Art. 52 EPC in the relevant area. The fact is that all their efforts have not brought about the level of case law coherence one would wish to obtain. It is when one tries, as a patent professional, to explain the current status of the law to business people that it becomes obvious we are not quite there. It is never a good thing when the law can no longer be understood by those who need to understand it to take the right economic decisions.

But there is another, possibly far more important, reason for wishing a complete and independent review of the situation. It is not excessive to say that the way the EPO has so far dealt with the issue of the patentability of computer programs (and the related issue of the patentability of "business methods") has tarnished the image of the EPO in the eyes of society at large (in Europe) and that this has spilled over onto the European patent system as a whole. Unjust as it may be, the situation is bad for the economy and for the competitiveness of Europe.

I would suggest that the fundamental problem with the sinuous evolution of the decisions of the Boards of Appeal in these matters is the impression many people have that each evolution is leading farther and farther away from the wording of the EPC. It is to some extent as if the EPO had taken the law in its hands. To put the problem in simple terms, it is felt somewhat strange that, while the EPC states clearly and unambiguously that computer programs as such are not patentable, the EPO has managed to grant patents on computer programs claimed as such (after T 1173/97). The bad feeling has not been

alleviated by the ever more subtle line of reasoning that led to such an extraordinary result. The line is basically as follows: a computer program which is technical (makes a technical contribution, is based on technical considerations, has a technical effect, a further technical effect, etc.) is not a computer program as such while a computer program which is not technical (does not make a technical contribution, etc.) is a computer program as such. Try selling that line to R&D and business people whose everyday experience is that computer programs and suitably programmed computers are technical tools at their disposal when they develop new products or processes in their own field of technology.

The fact that, in many cases, the aim of those liberties taken with the EPC was to serve better the perceived needs of the economy (read: the applicants) is considered by many as no real excuse because this aim is way beyond the remit of the EPO.

It is now time to turn to the specific questions put by the President to the Enlarged Board 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?

It is tempting to propose a negative answer, meaning that, of course, if the invention is a computer program as such, it should be excluded in whatever form it is claimed. This, however, would not be a satisfactory answer because the grounds for excluding claims directed to something else than a computer program must still be found in the EPC.

The wording of Art. 52 EPC, does not support all the exclusions that could be required. Strictly speaking, the exclusion of computer programs as such in Art. 52(2) and (3) can only be used to exclude computer programs claimed as such, that is to say to exclude claims directed to computer programs as such. A proper application of the EPC requires

therefore to distinguish between the various types of claims that can be used to define the invention.

a) Computer program claims

If the claim is directed to a computer program without any limitation other than what the program contains, it must be excluded on the basis of Art. 52(2)c) and (3) EPC.

If the claim is directed to a computer program stored on a recording medium or to a recording medium storing a computer program, without any limitation other than what the program contains, it must still be excluded on the basis of Art. 52(2)c) and (3) EPC as the reference to a recording medium does not by itself carry any meaningful limitation.

b) Method claims

Claims directed to a method for doing something to be implemented by the use of a computer program or of a programmed computer cannot be rejected under the exclusion of computer programs as such in Art. 52(2) and (3) EPC. A method for doing something is not a computer program as such. Such claims may, however, come under some other exclusion in Art. 52(2) and (3) EPC, e.g. the exclusion of mathematical methods as such or the exclusion of methods for doing business as such. Other methods may, however, give rise to more difficult questions, for example methods involving the processing of financial data. It is generally agreed that the list of Art. 52(2) is non-exhaustive but the EPC does not provide any clear indication as to which other exclusions could be considered and on what basis. One possibility would be to apply (with care!) the new wording of Art. 52(1) *a contrario* and to exclude inventions claimed as methods that do not belong to a field of technology. What must be clear, however, is that the inclusion of a computer program or the use of a suitably programmed computer as a step in a method can neither justify by itself that the method must be excluded nor suffice to conclude that the method belongs to a field of technology.

If the claim is directed to a computer program (product) for the implementation of a non-excluded method, which is the subject of another claim, it should be rejected on the basis of Art. 52(2)c) and (3) EPC, as a computer program capable of being used in the implementation of a method is still a computer program as such. In **T 1173/97** the Board was clearly trying to compensate for insufficiencies in the substantive patent laws of some countries regarding contributory infringement. Laudable as the aim may be, it is totally inappropriate for a Board of Appeal, indeed for the EPO as a whole, to do so.

c) Product (other than computer program product) claims

Claims directed to a computer or a computer system or any other kind of product with data processing capabilities cannot be rejected on the basis of Art. 52(2) and (3) EPC as these provisions do not give any support for such a rejection. A computer system is not a computer program as such and none of the other exclusions mentioned in these provisions appear to support the rejection of such claims. Such claims therefore must be passed to the next phase of examination, namely the novelty/inventive step determination.

Although this is not properly part of the answer to the question, it may be useful to deal briefly with the issue of novelty/inventive step in such a case. It is commonly agreed that it is permissible to mix product features and method steps in a claim, for example to mix product parts of a computer and features relating to how to use those product parts to produce a useful result. Sometimes, this form of claim leads to a better and more concise definition of the invention. But the fact that it is permissible to claim an invention in such a way does not mean that this form of claim can be used to escape an otherwise deserved rejection. If the product elements of the claim are not novel, the claim as a product claim is not novel. Method steps such as storing specific data in the memory of the computer or running a specific computer program to achieve a specific processing of the data do not and cannot serve to define a novel computer. They do not impart novelty to the product itself. The Board of Appeal in **T 154/04** was faced with such a situation. After properly rejecting the method claim as a method of doing business under Art. 52(2) and (3), it was confronted with a "product" claim, which was nothing else than the very same method

claim disguised as a product claim by addition of traditional computer features. The Board arrived at the right conclusion but felt obliged to base its rejection on dubious considerations regarding technical features. I believe that it would have been enough to say that, from a pure product viewpoint, the product claim lacked novelty.

Question 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?

As already mentioned with respect to Question 1, it seems unnecessary to make any difference between a computer program, a computer program stored on a computer-readable data storage medium or a computer-readable data storage medium storing a computer program. From both a technical viewpoint and a business viewpoint they all are computer programs as such.

The other part of the question is not totally clear as there are many ways to mention a computer or the use of one in the area of computer programs and they cannot be handled all in the same fashion. As already said about Question 1, a claim directed to a computer storing and running a computer program cannot be directly excluded on the basis of Art. 52. On the other hand, a claim directed to a computer program for use with a computer can and should be excluded under Art. 52(2)(c) and (3).

Question 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?

On the basis of the answers to Question 1 and 2(A) given above, there is no need to deal with this Question 2(B). It is enough to say that the question is based on one specific expression of the unfortunate "technical/non technical" dichotomy which is at the root of the present difficulties. The sooner it is abandoned, the more chances we have to arrive at a straightforward application of Art. 52 EPC as outlined above in response to Question 1.

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?

Question 3(B)

If Question 3(A) is answered in the positive, is it sufficient that the physical entity be an unspecified computer?

Question 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?

More of the same, really. The questions use a number of expressions found in various Board of Appeal decisions (technical effect, physical entity, real world, technical character) which, not only are not defined, but are not even used in the EPC. There is no better way to confirm the feeling that the case law has progressively moved away from a straight implementation of the EPC.

Question 4(A)

Does the activity of programming a computer necessarily involve technical considerations?

Question 4(B)

If the answer to Question 4(A) is answered in the positive, do all features resulting from programming thus contribute to the technical character of the claim?

Question 4(C)

If the answer to 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, more of the same with further undefined expressions foreign to the EPC: technical considerations, further technical effect.

The activity of programming a computer can most probably be termed a technical activity because it is usually performed in a technical environment by persons having a technical background. But whether or not one considers programming a technical activity is irrelevant to the exclusion from patentability of computer programs as such. In the EPC, computer programs as such are not excluded because they result from a non-technical activity but because the EPC expressly says they are excluded from patentability.

It may be the right place to say a few words about the TRIPS Agreement and the question of whether the EPC, as currently written, complies with it. Many of those who support the technical/non-technical dichotomy do so because they see the application of this dichotomy as the only possible way of reconciling their interpretation of the EPC with their interpretation of Art. 29(1) TRIPS. While it is fine for scholars to study this issue of TRIPS-compliance, it is certainly not for the EPO to enter into the debate. The EPO at all levels is in charge of applying the EPC as it is. The EPO is not in charge of interpreting, even less of applying TRIPS. This is the job of WTO if and when the question is put to this organisation or of the EPC Member States if they feel that their obligations under TRIPS compel them to change the EPC. It is comforting to see that this is the official line within the EPO but one may wonder if, beyond the official line, some of the issue of

TRIPS-compliance has not found its way into the birth and growth of the ill-advised dichotomy-based approach within the Boards of Appeal.

Jacques Combeau
24 April 2009