

European Patent Office
Enlarged Board of Appeal
- Registry -
Erhardtstraße 27

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27 April 2009

**Case G3/08 – Patentability of Programs for Computers
Referral under Article 112(1)(b) EPC by the President of the EPO
to the Enlarged Board of Appeal.**

Dear Sirs,

This Written Statement is submitted by DIGITALEUROPE under Article 10 of the Rules of Procedure of the Enlarged Board of Appeal in response to the Referral under Article 112(1)(b)EPC by the President of the European Patent Office dated 22 October 2008 ("the President's Referral").

1- 1- Admissibility

The question of patentability of computer programs under the EPC was raised in 2006 when the Rt. Hon. Lord Justice Jacob of the English Court of Appeal suggested that the President of the EPO should refer questions on the patentability of software to the Enlarged Board of Appeal after the Court of Appeal's decision in *Aerotel/Macrossan*.¹

The then President of the EPO, Dr. Alain Pompidou, replied to Jacob LJ in March 2007 that there was:

"...insufficient legal basis for a referral under Article 112(1)(b) EPC. Leaving aside Board of Appeal case law the line of reasoning of which has been abandoned by later case law, I believe there are insufficient differences between current Board of Appeal decisions dealing with Article 52 EPC exclusions on important points of law that would justify a referral at this stage."

¹ [2007] RPC 7.

There has been no significant change in the law since then. Indeed, the Board of Appeal decisions referenced in the President's Referral all predate Dr. Pompidou's reply. Dr. Pompidou's conclusion that there are insufficient differences to justify a referral remains as true now as it was in March 2007.

We would respectfully submit that in the absence of a real conflict between decisions of the Boards of Appeal, the President's Referral is inadmissible and should be rejected.²

1- 2- Programs for Computers

Notwithstanding the inadmissibility of the President's Referral, we would make the following brief observations on the issues raised therein.

Article 52(1) EPC provides that "European 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." While the EPO itself is not a signatory of the TRIPs Agreement, most EPC Contracting States, the European Community and its Member States are. The inclusion of "in all fields of technology" into Article 52(1) EPC shows that the EPC Contracting States do not wish the EPC to deviate from the TRIPs Agreement. Article 27(1) TRIPs Agreement which provides that "... patents shall be available for any inventions, whether products or processes, in all fields of technology, provided that they are new, involve an inventive step and are capable of industrial application" and "... patents shall be available and patent rights enjoyable without discrimination as to ... the field of technology"

Starting from the principle that inventions in all fields of technology are inherently patentable – subject to them having novelty, inventive step and being capable of industrial application as required by Article 52(1) – two further principles logically follow. The first is that it is an implicit requirement of the EPC that patentable inventions have a technical character – i.e. that the claimed invention contains at least one technical feature³. The second is that the exclusions set out in Article 52(2), as exceptions from the general principle that inventions in all fields of technology are patentable, must be construed narrowly⁴. Article 52(3) confirms this need for a narrow construction.

² See also G3/95.

³ See for example T931/95, T 1173/97, T258/03, T619/02.

⁴ See for example T1173/97, cf reasoning in G1/04 in relation to the exclusion patentability under Article 52(4) EPC in respect of diagnostic methods

When these principles are applied to the field of technical inventions implemented by means of programs for computers, what naturally follows is that a claim directed to a technical process or product does not relate to a computer program as such.⁵ As stated in the President's Referral, "in the field of computer technology, innovation frequently lies in the particular method performed by a computer program while executed by conventional hardware."⁶ In view of the last sentence of Article 27(1) TRIPs Agreement, inventions in this technical field may not be treated differently from inventions in other technical fields.

As technology has advanced – in ways that could not possibly have been predicted accurately over 20 years ago – the jurisprudence of the EPC provided by decisions of the Boards of Appeal in relation to the "technicality requirement" has evolved in a way that reflects those advances. This has provided needed flexibility and a common sense approach in the application of the EPC to relatively new fields of technology such as the field of computer programs. Conversely, it can be said that it is because of this flexible, common sense approach that the European patent system has been able to serve its economic purpose of promoting innovation in new technology and new fields of technology in the first place.

DIGITALEUROPE believes that the current jurisprudence of the EPC concerning the patentability of inventions involving computer programs achieves the correct balance between, on the one hand, the clarity required to provide legal certainty for patent applicants and the public and, on the other hand, the flexible, common sense approach needed to ensure that the European patent system remains applicable as technology develops.

Referring to the specific questions raised in the President's Referral, DIGITALEUROPE makes the following observations:

Question 1

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

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?

⁵ T208/84 (Vicom).

⁶ Page 6

(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?

Observations on Questions 1 and 2:

When assessing exclusion under Article 52(2)(c) and (3), DIGITALEUROPE believes it is not directly relevant whether or not a claim explicitly recites a computer program, a computer, a computer-readable data storage medium or any other computer-related wording. The question is whether the invention, however the claim is worded, is of technical character.

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?

Observations on Question 3:

A claimed feature lends technical character to the invention if the feature itself has a technical character. Whether this technical character is on a computer, on a physical entity in the real world or independent of any particular hardware that may be used is irrelevant.

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?

Observations on Question 4:

If technical considerations concerning particulars of the solution of the problem the invention solves are required in order to carry out the invention then the claimed invention possesses technical character. While programming a computer does not necessarily involve technical considerations, if technical considerations are required in order to carry out the invention, a claimed invention involving computer programs should not be excluded from patentability under Article 52(2)(c) and (3).

1- 3- Concluding Remarks

As a result of the jurisprudence of the EPC provided by decisions of the Boards of Appeal concerning the patentability of inventions in the field of computer programs, patent applicants and the public can predict with a high degree of certainty whether a claimed invention involving a program for a computer is patentable in view of the exclusions of Article 52(2)(c) and (3).

Technology continues to advance at an astonishing pace. The way in which the technical field of programs for computers will develop in the future is impossible to predict with any degree of accuracy or confidence. Any significant changes to the way in which inventions in this field are treated could have profound, and unforeseen, effects on the whole industry. We would conclude by reminding the Board of the observations made in T935/97. The Technical Board of Appeal, in interpreting the EPC law, as applied to computer programs, stated that the object and purpose of the EPC is the granting of patents for inventions and thus to promote technical progress by providing proper protection for such inventions. With this in mind, the Board arrived at its interpretation in light of developments in information technology. It concluded that this technology tends to penetrate most branches of society and leads to very valuable inventions. DIGITALEUROPE believes that the present level of protection for computer programs is necessary for both hardware and software developers to earn a fair return on their continued investment in R&D activities. Thus, any decision that would narrow such protection would have a negative impact on innovation. On the other hand it should be clear that patents should only be granted for those inventions that meet all EPC requirements, including the requirements that an invention must be new and involve an inventive step for a person skilled in the art as these requirements are currently applied by the Boards of Appeal.⁷

⁷ See e.g. T 641/00, T 154/04, T 306/04, T 365/05, T 368/05 and T 688/05.

Should the Enlarged Board of Appeal be mindful to address the questions raised in the President's referral, we would respectfully suggest that the decision should be directed to affirming the jurisprudence of the EPC as it currently stands. A consistent jurisprudence of the Boards of Appeal is of the utmost importance both for national patent offices and national courts, and any step change departing from current EPO practice would risk losing the convergence and consistency that has been achieved through a careful evolutionary process over the last 25 years or so throughout Europe - both in the EPO and at national level (courts and national patent offices).

Yours faithfully,



Bridget Cosgrave
Director General

ABOUT DIGITALEUROPE

DIGITALEUROPE, the organisation formerly known as EICTA, is the voice of the European digital technology industry, which includes large and small companies in the Information and Communications Technology and Consumer Electronics Industry sectors. It is composed of 61 major multinational companies and 40 national associations from 28 European countries. In all, DIGITALEUROPE represents more than 10,000 companies all over Europe with more than 2 million employees and over EUR 1,000 billion in revenues.

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