## COMMENTS ON THE REFERRAL G 3/08
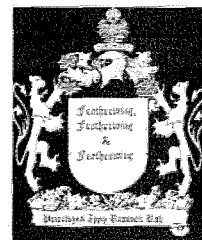
The referral to the Enlarged Board of Appeal is *inadmissible* since the decisions cited by the President of the EPO are not diverging in respect of the questions referred.

## REASONS

Usage:

*Technical computer program* = a computer program which "when running on a computer or loaded into a computer, brings about, or is capable of bringing about, a technical effect which goes beyond the "normal" physical interactions between the program (software) and the computer (hardware) on which it is run" (cf T 1173/97, point 13).

*Article* = Article of the EPC.

The *italics* are added.

## I.

## QUESTION 1

If the answer to Q1 were "no", computer-implemented methods and computer systems could be excluded under Article 52(2) as "computer programs as such". The president states that according to decision T 424/03 "the exclusion of programs for computers would become a formality, merely requiring formulation of the claim as a computer implemented method or as a computer program product". Supposing there is a divergence between this decision and T 1173/97, as argued, the latter decision must hold that computer-implemented methods and computer systems may be excluded under Article 52(2).

But decision T 1173/97 states nothing of the kind. On the contrary: in section 8 it is said that:

"Determining the technical contribution an invention achieves with respect to the prior art is therefore more appropriate for the purpose of examining novelty and inventive step than for deciding on possible exclusion under Article 52(2) and (3)".

This statement ended a long discussion whether or not the criteria of Articles 52(2) and 54/56 should be treated separately or not. According to the previously prevalent "contribution approach", subject-matter was excluded under Article 52(2) unless it made a contribution in a technical area. It could thus happen that computer systems were held excluded under Article 52(2). In case T 1173/97 the deciding board instead found that the technical contribution subject-matter achieved with respect to the prior art - and in particular whether any hardware mentioned it is new or not - was irrelevant for deciding whether or not it was excluded. That means that no technical subject-matter can be deemed excluded merely because it is not new. This is in agreement with T 424/03, which decision (not surprisingly) cites T 1173/97.

The final paragraph of T 1173/97 reads:

"Furthermore, the Board is of the opinion that with regard to the exclusions under Article 52(2) and (3) EPC, it does not make any difference whether a computer program is claimed by itself or as a record on a carrier... ".

Read out of context this passage could be taken to mean either of two things: 1) a technical program is not excluded even if claimed by itself, or 2) a non-technical program is excluded even if claimed as a record on a carrier. However, at this point of the reasons the board had already decided to remit the case to permit the examining division to carry out an examination of the wording of the claims. Seen in this context, the above quotation was a hint to the examining division that the *particular technical program under consideration* did not have to be claimed together with a carrier. (Both the appellant and the examining division took the hint, as demonstrated by the appellant's letter dated 26.5.1999 and granted claim 20.) There is no reason to assume that the board wanted to conclude its decision with speculations about *non-technical* programs with which the appeal was not concerned, especially if such speculations contradicted what the board had said before.

CONCLUSION: There is no divergence between the decisions mentioned, which both clearly indicate that the answer to Q1 should be "yes".


II.

QUESTION 2(A)

The President again cites decision T 1197/97. For the reasons outlined above there is no divergence between this decision and T 258/03. Both decisions indicate that the answer to Q2(A) should be "yes".

QUESTION 2(B)

This question (which incidentally appears not to permit an answer in the negative) thus need not be considered.

CONCLUSION: There is no divergence between the decisions mentioned, which both clearly indicate that the answer to Q2(A) should be "yes".

## III.

## QUESTION 3(A)

There is surely universal agreement that any invention has to provide some kind of technical effect, and a technical effect is by definition on a physical entity (not on the human mind). T 424/03 and T 125/01 say nothing else:

"the computer-executable instructions have the potential of achieving the above-mentioned further *technical effect* of enhancing the internal operation of the computer" (T 424/03, section 5.3);

"Außerdem liefert nach Auffassung der Kammer die geeignete Umstrukturierung eines Steuerungsprogramms im Hinblick auf die Möglichkeit, weitere technische Gerätefunktionen aufzunehmen und/oder die Bedienbarkeit des Geräts zu verbessern, in Analogie zur Umkonstruktion einer Hardware-Steuerungseinrichtung zu diesem Zweck auch *einen technischen Beitrag zur Erfindung*" (T 125/01, section 4.2).

In practice the problem is rather whether there is a technical effect in each particular case, which is not a point of law. Critics of the two decisions cited may naturally argue, rightly or wrongly, that the invention in each case did not give rise to any technical effect. But even so it would be wrong to conclude that the deciding board thought that none was required.

The President's explanations given in the section headed "The divergence" are strangely remote from the question as it is actually formulated. The impression is that the President in reality wanted a clear ruling that "elementary programming constructs" are excluded from patentability, but, since this would not be a question of law, tried to wrap it up in legal terms to suggest an aura of admissibility, and in the process lost sight of the initial aim.

## QUESTIONS 3(B) AND 3(C)

These questions thus need not be considered.

CONCLUSION: There is no divergence between the decisions mentioned, which all clearly indicate that the answer to Q3(A) should be "yes".

## IV.

## QUESTION 4(A)

T 1177/97 mentions in section 3 that implementing a function on a computer always involves, at least implicitly, technical considerations. But the stress is on the implementation and a distinction is made with the field of linguistics. What the board says here is that linguistics requires no technical considerations at all whereas implementing (linguistic) functions on a computer does, *at least implicitly*. And clearly it does. For example, somebody (not necessarily the programmer of the linguistic function) would have to select a suitable processor, compute the necessary memory requirements etc. The board thus does not hold that any activity of programming a computer

necessarily involves technical considerations, but that any implementation of a function does. Naturally, such considerations may be well known and would often not even appear in a claim.

Similarly, T 172/03 merely confirms that the activity of programming a computer might involve technical considerations: "The Board thus considers appropriate to define, *in the present case*, the relevant 'person skilled in the art' within the meaning of Article 56 EPC as such a software project team" (section 16).

Thus neither decision holds that an activity of programming a computer *necessarily* involves technical considerations. This is not really surprising, considering the very different activities commonly referred to as "programming" (as correctly pointed out by the President in the section "The divergence").

It may be added that that the boards' view of the programmer has in fact changed over time, but not in the way indicated in the referral. T 833/91, T 204/93 and T 769/92, which decisions arguably contain statements to the effect that programming is generally non-technical, all preceded the landmark case T 1173/97. Since T 1173/97 broke with the earlier jurisprudence with regard to the patentability of technical programs, it was inevitable that the status of a programmer would undergo a corresponding shift. But this is not indicative of a "divergence" between individual decisions. T 1173/97 significantly developed the jurisprudence, as implicitly acknowledged in the referral by its lack of any attempt to establish a divergence between T 1173/97 and earlier decisions.

## QUESTIONS 4(B) AND 4(C)

These questions thus need not be considered.

CONCLUSION: There is no divergence between the decisions mentioned, which all clearly indicate that the answer to Q4(A) should be "no".

Yours truly

B. S. Featherwing