ENLARGED BOARD OF APPEAL
EUROPEAN PATENT OFFICE
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DEUTSCHLAND

CASE G3/08: REFERRAL UNDER ART. 1 12(1)B) EPC BY THE PRESIDENT OF THE EPO (PATENTABILITY OF PROGRAMS FOR COMPUTERS) TO THE ENLARGED BOARD OFAPPEAL.

BRIEF OF ASSOCIATION HISPALINUX AND JOSE MARIA LANCHO RODRÍGUEZ AS *AMICUS CURIAE* IN SUPPORT OF THE QUESTIONS POSED BY THE PRESIDENT OF THE EPO IN THE REFERENCED CASE

By José María Lancho Rodríguez Attorney Admitted in Madrid.

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(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?

I- INTEREST OF THE *AMICUS CURIAE*

The Association HISPALINUX is a non-profit Spanish association with more than 7,000 software users and developers as members in the Kingdom of Spain. HISPALINUX collaborates in many technological fields with the Spanish authorities.

HISPALINUX was founded in 1997 to promote research in the field of free and open source software, interoperability, advance knowledge of the new technologies among civil law practitioners, and encourage the Public Administration to promote integrity, independence, and expertise on its digital services under technological neutrality basis. A*micus* affirms that no counsel for a party of this case authored this brief in whole or in part and that no person other than *amicus* and its counsel assume any contribution -even monetary- to its preparation or submission.

II- REFERRAL ANSWERS:

A. Question 1:

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

Article 52 of the EPC contains the exclusion of programmes for computers as things that shall not be regarded as inventions. Article 52 (3) EPC qualifies that article 52(2) EPC only applies to those subjects as such.

An applicant's explicit claim over a computer program pre-empt a computer program in the EPC sense and it excludes its patentability. Computer programs are not statutory, EPC must be the first test used to determine subject matter patentability and be read in excluding interpretations ways with inherent semantic ambiguities.

If EPO should not read into article 52 EPC exceptions to patentable subject matter or if article 52 should be construed broadly to determine patentable subject matter must be assume by the Contracting States of the Convention.

There are added risks on limiting the definition of a computer program to embrace it within the statutory terms of the EPC: we think that it can affect -and should do so- the copyright protection of the work (program).

An expansive analysis of the sense of computer program in a patent claim, even considered as whole, to avoid the article 52 effects is necessarily sophisticated and arbitrary. Maybe in the classic Chinese philosophy **a white horse is not a horse,** a famous paradox resulted of a dialectic analysis of the question *Can it be that a white horse is not a horse? But here, any broader analysis to make a computer program being statutory is purely adjective.* This

approach would bring us to a legal paradox which is arbitrarily imposed.

B. 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?

(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?

(a) NO. Not even in United States, where its Board of Appeals and Interferences decided issues related to Section 101 determinations under the technological arts test (exparte Bowman 61 USPQ2D 1669 Pat. Off. Bd. App. & Inter. 2001). In this case the Board agreed with the rejection of the Examiner because there were absolutely no indication in the claimed invention that it were connected to a computer in any manner.

(b) 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. Computer code is a creative expression of instructions for a language always in the context of a language and dependant of it. The majority of software related inventions involve functions or methods rather than new structures, these patents grants monopoly over functions of the language and only indirectly over machines.

That is the reason why computer code is only copyrightable work. Article 10 paragraph 1 of TRIPs provides that a computer program is a type of work which is eligible for protection under copyright law: "Computer programs, whether in source or object code, shall be protected as literary works under the Berne Convention".

Copyright (in the sense of intellectual property) and patent law have different scopes of protection. The special nature of a computer program and its legal treatment makes copyright and patent protection mutually exclusive.

C. 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?

(a) Yes. Technical effect is necessary but not sufficient condition to attribute technical character to a claim. In the case of computer programs can not be identified an autonomous technical contribution to the art because the computer programs are not autonomous from a machine (process), they are tied to a pre defined technological art and basically describe operations that virtually do not produce technical change at all.

(b) If the question poses that the technical effect has no postcomputer process activity and no physical transformation of an object and it is reduced only to a data manipulation carried out solely in the computer: the answer is NO.

D. 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?

(a) Yes. The activity of programming a computer involves technical considerations. But there are also technical considerations and technical solutions in the work of civil engineers and architects who are used to working with new materials and new necessities on a constant technical contribution considered as an inventive and technical solution to a technical problem.

(b) This criterion would turn any solution into a technical solution by merely programming some source code. The activity of programming does not define a technical solution to a technical problem.

II- SUMMARY OF ARGUMENT:

Article 52 of the EPC contains a non-exhaustive list of subject matters that shall not be regarded as inventions including programs for computers. Article 52 (3) EPC qualifies that article 52(2) EPC only applies to those subjects as such. Mainly from 1986 (Vicom case) , the EPO has been granting patents for inventions involving these excluded fields as software related inventions.

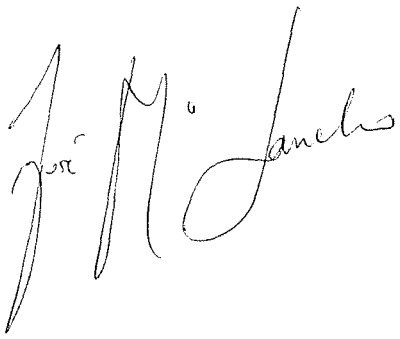
The evolution of the EPO approach to the patentability of computer implemented inventions can only be explained under ideological basis rather than on solid legal bases. The evolution is obvious, in the Comvik (T641/00) and Systran (T1177/97) cases the "technological contribution" test was broken down into a mere inventiveness test (there was no legal reason for it).

The recent decisions from the Technical Board of Appeals have widely consolidated that EPO will allow claims to computer programs on a carrier medium.

Now the Board of Appeals subjects to debate the most stringent requirement by EPO to grant a patent: the requirement of "technical solution to a technical problem".

The possibility of a new reduction of the "technical result" criterion for patentability for the sole purpose of weakening article 52 of the EPC will increase legal uncertainty, reduce patent effectiveness at Courts and Tribunals, extend the patent exceptional protection to activities of an abstract and intellectual character and increase the risk of possible arbitrariness in the EPO patent grants.

Respectfully submitted



José María Lancho Rodríguez
Attorney
C/Pintor Juan Gris, nº 5, 3º A
28020 Madrid
+34 915980710
jmcamelot@gmail.com

Counsel for Amicus Curiae

ASOCIACIÓN HISPALINUX