

**THIRD PARTY STATEMENT FOR CASE G03/08 BEFORE
THE ENLARGED BOARD OF APPEAL**

“CUTTING THE GORDIAN KNOT”

General comments

1. The referral of questions relating to the patentability of computer programs to the Enlarged Board of Appeal is welcome and it is long overdue. The situation in this field is still not resolved and uncertainty remains, making decisions in specific cases unpredictable. Given the influence and particular responsibility of the EPO in the fragmented European patent system, such uncertainty is harmful since it propagates to the case law of national courts. In addition, the line of reasoning used in leading decisions is, to say the least, difficult to understand. It seems decisions are written in such a way that they can only be understood by other Boards of Appeal.

2. The major reason for the uncertainty is that leading Board of Appeal decisions, instead of applying Article 52(2) and 52(3) EPC pursuant to their normal meaning, have actually rewritten these provisions by substituting a condition of lack of “technical content” or “technical character” for the “as such” condition. The more Board of Appeal decisions distance away from the normal meaning of the EPC, the greater the uncertainty and the greater the potential for inconsistency with past and future decisions. This is particularly the case within the EPO since unlike common law courts, the Boards of Appeal are not bound by precedents. The EPC should not be treated by Boards of Appeal like a nose of wax which may be turned and twisted in any direction.

3. The entry into effect of the EPC 2000 raises two observations we consider highly relevant to the issue. First, while it was proposed during the discussion of EPC 2000 to remove the exclusion of computer programs as such, the final decision was to maintain it, without any change to the original language of Articles 52(2) and 52(3). This signals that these provisions should be given effect and should not be interpreted so as to be made ineffective. Second, Article 52(1) defining inventions was amended by the insertion of “in all fields of technology”. With this explicit reference to a “field of technology” now present in Article 52, it would be obviously contrary to any logic to interpret the “as such” condition of Article 52(3) as involving a lack of technical content or technical character. This emphasises the requirement that Articles 52(2) and 52(3), since they define exceptions to the definition of inventions of Article 52(1), cannot rely for their application on any condition included in Article 52(1).

4. We conclude from the observations above that the entry into effect of EPC 2000 has given the EPO a *mandate* to interpret Article 52 EPC in line with its internal logic and its normal meaning. Since Articles 52(2) and 52(3) define exceptions from the definition of invention of Article 52, and the latter now explicitly refers to a field of technology, Articles 52(2) and 52(3) should be applied irrespective of whether a “technical content” or “technical character” (or “technical contribution”) is present. Simply stated, the excluded categories should be those defined by the words of Article 52(2) and 52(3), nothing more, nothing less, without reference to any of the conditions to be fulfilled under Article 52(1). We believe such a simple approach of the application of Article 52(2) and 52(3) would be effective to *cut the Gordian knot*, in other words, put an end to the intricacies and inconsistency of the current EPO case law.

5. Another general observation relates to the significance of the wording of claims. It is frequent to find in decisions of Boards of Appeal, or of national courts, references to “substance” as opposed to “form”, in such statements as “form must not be allowed to prevail over substance”. When in fact, “form” refers to the wording of a patent claim, the opposition between “form” and “substance” is a mistake : the reason being that the wording of a patent claim *is a critical element of substance*. This is clear when considering the fact that patentability and validity issues are decided for each individual claim. This is consistent with the principle of Article 69 EPC that the scope of a claim is defined by its terms. The wording of the questions referred to the Enlarged Board of Appeal must thus be fully approved in that they refer to the *claims* or *the claimed subject matter*. A claim to a “method” or an “apparatus” is not a claim to a “computer program” and it should not be interpreted as a claim to a “computer program” on the basis of “substance”.

6. Under Article 52(2) and 52(3), computer programs as such are excluded. What is a computer program ? A sequence of instructions for the operation of a computer. A computer program has always a support (physical, electronic), and a computer program remains a computer program whether or not its support is mentioned. What is sometimes called a “software product” is a computer program. Therefore, computer programs should be excluded, irrespective of the support.

In contrast, a method of doing things using a computer program, or an apparatus including a computer program, are not computer programs as such, they do not fall within the definition of Articles 52(2) and 52(3) and have no reason to be excluded. They qualify as inventions in accordance with Article 52(1) and their patentability must be reviewed on the basis of the conditions of Article 52(1).

The same principle should apply to the other categories excluded under Article 52(2) and 52(3) (mathematical methods, methods for doing business, etc).

Answers to the questions**Question 1**

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

A computer program should be excluded if the claim relates to a computer program, or to a program stored on a support ("software product"). Claims relating to methods other than those excluded by Article 52(2) should not be excluded for the reason that they use a computer program. Claims to apparatus or systems including, or controlled by, a computer program should not be excluded either. The applicable conditions are those of Article 52(1).

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?

We do not see the difference between the question concerning a "computer-readable data storage medium" and Question 1, so the answer is the same as for Question 1. As to the use of a computer, if the computer is recited as an element in the claim, the claim does not relate to a computer program as such. But if the claim only states that the program is "for use with a computer", it does not appear that the computer is an element of the claim in accordance with the rules of claim interpretation of the EPO. If so, the claim relates to a program as such and should be excluded.

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?

In our introductory comments, we have concluded that Articles 52(2) and (3) must be applied on the basis of their ordinary meaning, without adding the requirement of a technical content. On this basis, a requirement for a "further technical effect" has no justification.

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?

In the application of Articles 52(2) and 52(3) as proposed in the foregoing, the “technical character” of the claim is irrelevant. Therefore no answer needs to be given to these questions.

Question 4(A)

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

Question 4(B)

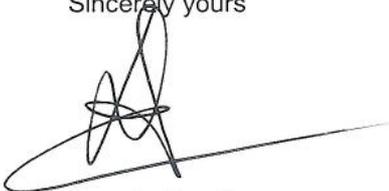
If the answer to Question 4(A) is answered in the positive, do all features resulting from programming thus contribute to the technical character of the claim?

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?

The answer is the same as for Questions 3. Since in the application of Articles 52(2) and 52(3) as proposed above, the “technical character” of the claim is irrelevant, no answer needs be given to Questions 4.

Sincerely yours

A handwritten signature in black ink, consisting of several loops and a long horizontal stroke extending to the right.

Francis Hagel
European Patent Attorney
May 12, 2009