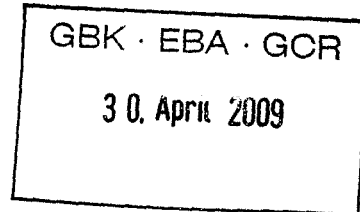


IRISH FREE SOFTWARE ORGANISATION
Promoting and Defending Free Software in Ireland

ifso

EPO - Munich
9
30. April 2009

Enlarged Board of Appeal
European Patent Office
Erhardtstrasse 27
80331 MUNCHEN
Germany



April 23, 2009

Case G 3/08

Dear sirs, madams,

We are writing to respond to the consultation on referral G3/08, addressing the question of patentability of software.

The Irish Free Software Organisation represents the interest of Free Software in Ireland. We believe that there is great societal benefit in such software, which the user has freedom to run, study, adapt, and redistribute in original or improved form. To write software whose users enjoy these freedoms, a programmer must be able to create programs without the fear that holders of unknown patents might emerge and claim rights over the programmer's independently created work. We realise that broader arguments concerning the harm done by software patents are outside the scope of this referral; we outline our position here by way of background.

We have taken a keen interest and an active role in the area of software patents in the past, and welcome the present opportunity to contribute to this important debate.

Our responses to the questions are motivated by the principle that the writers of the EPC specifically and explicitly excluded computer programs from patentability. We must therefore avoid any interpretation which allows this exclusion to become meaningless. The difficulty comes in interpreting the phrase 'as such'. The exclusion loses all force if careful choice of claim wording can escape it, and this cannot be the intent. Further, computer programs are applied by running them on a computer, so to avoid another route whereby the exclusion becomes vacuous, the mere fact that software is claimed as running on a computer cannot exempt it from the exclusion. The further question then arises of what makes up a 'computer'. It will typically have various standard components, including memory, data storage, input/output facilities and so on. The mere use of new software to drive well-understood and non-novel hardware cannot therefore escape exclusion.

We do not argue that a claimed invention should forfeit patentability if it includes software as part of its operation. Any non-software features of the claimed invention, however, must meet the usual tests of novelty, inventive step, and applicability. Novelty in the software cannot contribute in any amount towards the novelty requirement of the claimed invention. In other words, a claimed invention which lacks novelty in its non-software parts is not patentable. In the case of an invention which does display novelty in its non-software parts, no patent infringement can occur if its software part is used in a way which does not infringe those non-software parts. (Although outside the scope of this referral, we note that because software does have protection by copyright, any such separate implementation would have to be created in a way which does not infringe that copyright.)

In terms of the questions of the referral, our position is as follows.

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

No. Under this interpretation, any software could escape exclusion by appropriate wording of the claim to involve a computer. The exclusion would thus become meaningless and this cannot be the intent.

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?*

No. The same reasoning applies as for qn.(1).

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?*

Yes. The scope of 'effects inherent in the use of a computer' must furthermore be understood in a broad sense to mean effects in any well-understood, non-novel hardware controlled by the computer. Any software by necessity causes physical changes to the computer hardware on which it runs (e.g., electrical currents flowing to carry signals) so, for the exclusion to have meaning, such well-understood and non-novel effects cannot be grounds to escape exclusion.

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?*

Yes. Furthermore, the technical effect on the physical entity must be novel in its own right, not merely because of the fact that new software is causing it.

3.(b) *If question 3(a) is answered in the positive, is it sufficient that the physical entity be an unspecified computer?*

No. The physical entity must have technical novelty in its own right.

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?*

Not answered — 3(a) is answered in the positive.

4.(a) *Does the activity of programming a computer necessarily involve technical considerations?*

No. It consists of manipulating abstract and mathematical concepts. Often the end purpose of a particular piece of software will be an application in a technical field, but even then the programming itself remains non-technical.

4.(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?*

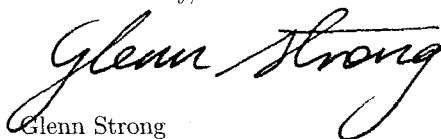
Not answered — 4(a) is answered in the negative.

4.(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?*

Features resulting from programming can never contribute to the technical character of a claim. Any technical character must come from novel, inventive, and applicable effects in the non-software part of the claimed invention.

To summarise, the only reasonable interpretation of the 'as such' clause is that no patent protection can be given to the software part of a claimed invention. Non-software parts of a claimed invention are assessed as to patentability based on the novelty, inventive step, and applicability contained exclusively in those non-software parts.

Yours faithfully,


Glenn Strong
(Chairman) on behalf of IFSO