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30 April 2009

Ref: PP 08/09

Dear Sirs,

Written Statement concerning Case G 3/08

This letter provides a written statement in accordance with Article 10 of the Rules of Procedure of the Enlarged Board of Appeal following the referral of points of law concerning the patentability of software to the Enlarged Board of Appeal under Article 112(1)(b) EPC. This written statement forms *amicus curiae* brief on the part of the IP Federation. The IP Federation (formerly TMPDF), represents the views of UK industry in both IPR policy and practice matters within the EU, the UK and internationally. Its membership comprises the innovative and influential companies listed on the final page.

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Yours faithfully,

Sheila Draper
Secretary, IP Federation

GBK · EBA · GOR

- 4. Mai 2009

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Summary

The legislative framework affecting patents for computer software is considered, as is the major case law of the EPO in this area and the position adopted by national courts, particularly in the United Kingdom. It is found that the case law of the EPO Boards of Appeal has developed steadily to a settled state in which the central cases are T 258/03 (Hitachi) and T 641/00 (Comvik), both of which are regularly applied by the Boards of Appeal with predictable and well understood results. The questions referred by the President are found have clear answers well supported by current case law. The divergences identified by the President do not reflect the current case law of the Boards of Appeal, as they compare the evolving position prior to T 258/03 and T 641/00 with the settled position after these decisions. The Enlarged Board of Appeal is requested to affirm the current settled position of the Boards of Appeal. This would be beneficial for stakeholders in the European patent system. Not only would it reduce uncertainty over the patentability of software at the European Patent Office, but it would provide a further incentive to national courts to harmonise their law and practice with the settled practice of the European Patent Office.

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Legislative and Judicial Context

The summary of primary and secondary legislation relevant to the patenting of software under the European Patent Convention provided (as Section 4, entitled "The Legal Framework") in the President's referral accurately reflects the main facts relating to the legislation concerned. It should be noted that this section of the President's referral contains several statements of opinion relating to the uncertainty of the legal position in this area. As indicated below, we contend that the evidence suggests that the legal position in this area is, in fact, relatively well settled.

European Patent Convention

Article 52(1) EPC as originally drafted in 1973 stated that European patents shall be granted for any inventions provided that they are new, involve an inventive step and are susceptible of industrial application. This is qualified by Article 52(2), which identifies a number of items which shall not be regarded as inventions within the meaning of Article 52(1). These include the following: discoveries; scientific theories; mathematical methods; schemes, rules and methods for performing mental acts, playing games, or doing business; presentations of information; and programs for computers. Article 52(2) is itself qualified by Article 52(3), which states that the preceding paragraph "shall exclude the patentability of the subject-matter or activities referred to therein only to the extent to which a ... European patent relates to such subject-matter or activities as such".

Article 54 EPC defines novelty in the context of patentability of inventions. Article 52(1) EPC states that an invention shall be considered to be new if it does not form part of the state of the art. Article 52(2) EPC establishes that the state of the art shall be held to comprise everything made available to the public by means of a written or oral description, by use, or in any other way, before the date of filing of the European patent application.

Article 56 EPC defines inventive step in the context of patentability of inventions. An invention shall be considered as involving an inventive step if, having regard to the state of the art, it is not obvious to a person skilled in the art. The state of the art is as defined in Article 54 EPC, save that for the assessment of inventive step, unpublished European patent applications are not considered to form a part of the state of the art.

Article 57 EPC defines susceptibility of industrial application in the context of the patentability of inventions. An invention shall be considered as susceptible of industrial application if it can be made or used in any kind of industry, including agriculture.



TRIPS (the Agreement on Trade-Related Aspects of Intellectual Property Rights)

The Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS) was made as part of the Uruguay Round of the General Agreement on Tariffs and Trade (GATT) in 1994, coming into effect on 1st January 1995. The Agreement sets common standards for the protection of intellectual property to be observed by GATT signatories. The European Patent Office is not a signatory of GATT - the overwhelming majority of the signatories to the European Patent Convention are also signatories to TRIPS.

Article 27 of TRIPS defines what constitutes patentable subject matter. Article 27(1) states that patents shall be "available for any inventions, whether products or processes, in all fields of technology". Article 27 of TRIPS also contains a list of elements which may be excluded from patentability, and this list does not include programs for computers. This list does not include a number of the other elements of excluded subject matter identified in Article 52(2) EPC.

EPC 2000

A diplomatic conference was held in 2000 as part of a process to effect a revision to the European Patent Convention. The revised EPC which resulted has now been in effect since 2007. The only revision made to Article 52 EPC has been the introduction of the statement that European patents shall be granted "in all fields of technology", bringing this Article more closely into alignment with Article 27 of TRIPS. As noted in the President's referral, amendment of Article 52(2) EPC was discussed, but not carried out.

Decisions

The practice of the Boards of Appeal of the European Patent Office in the area of patentability of software-related inventions has seen steady development since the inception of the EPO. The following four cases appear particularly significant in that they have been heavily cited by subsequent Boards of Appeal over an extended period of time.

T208/84 (Vicom) – 15th July 1986

This case related to a method and apparatus for digitally processing an image by a process of repeated scanning with an operator matrix to produce a filtered image. This had been rejected by the Examining Division as directed to excluded subject matter, either as a mathematical method or a computer program as such. The Board disagreed. The board held that "even if the idea underlying an



invention may be considered to reside in a mathematical method a claim directed to a technical process in which the method is used does not seek protection for the mathematical method as such." In the case of a method for digitally filtering data, it was necessary to specify what physical entity is represented by the data for the method to be the subject of a technical process susceptible of industrial application. The Board further stated that "a claim directed to a technical process which process is carried out under the control of a program... cannot be regarded as relating to a computer program as such within the meaning of Article 52(3) EPC, as it is the application of the program for determining the sequence of steps in the process for which in effect protection is sought." The Board also held that a computer of known type set up to operate according to a new program cannot be considered as forming part of the state of the art as defined by Article 54(2) EPC. The Board also considered it to be inappropriate to distinguish between embodiments of the same invention carried out in hardware and software. "Generally speaking, an invention which would be patentable in accordance with conventional patentability criteria should not be excluded from protection by the mere fact that for its implementation modern technical means in the form of a computer program are used." The Board in *Vicom* indicated that the technical contribution made to the known art was significant.

T1173/97 (IBM) – 1st July 1998

This case related to resource recovery in a computer system – the Examining Division had accepted as patentable claims to a method for resource recovery and a computer system adapted to use such an approach to resource recovery, but had objected to claims to a computer program product as being excluded under Article 52(2) EPC. The Board addressed the application of the TRIPS treaty, and assessed that it could not be applied directly to the EPC but that it was appropriate to take it into consideration – the Board found that there was no clearly apparent intention not to exclude programs for computers from patentability. The Board went on to consider the meaning of "as such" in Article 52(3) EPC and construed "programs for computers as such" to mean "that such programs are considered to be mere abstract creations, lacking in technical character". The Board went on to determine the meaning of technical character in the context of programs for computers. The Board found that to provide technical character, further effects deriving from the execution of the program were required, the further effects having a technical character or causing the software to solve a technical problem. The Board stated that "on condition that they are able to produce a technical effect in the above sense, all computer programs must be considered as inventions within the meaning of Article 52(1) EPC". The Board considered this approach to be consistent with the line of cases following *T208/84*, and made it clear that the "further" technical effect may itself be known in the prior art. The Board stated 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)". The Board found that on this basis, claims for a computer program product were capable of being patentable, as the computer program product has the potential to cause a predetermined further technical effect. The Board again referred to T208/84 – by the same reasoning used in T208/84 to argue that a computer set up to execute control of a technical process should be as protectable as the technical process controlled by a suitably programmed computer, a computer program product comprising all the features enabling the implementation of the method should be protectable.

T931/95 (PBS Partnership) – 8th September 2000

This case relates to a method and apparatus for controlling a pension benefits program. The Board affirmed existing case law in finding that the requirement of "technical character" to be fulfilled by patentable inventions – the Board also confirmed that "technical character" determined whether an invention was patentable under Article 52, and not the "technical contribution" that it provided. The Board found that the method claim did "not go beyond a method of business as such" as "all the features ... are steps of processing and producing information having purely administrative, actuarial and/or financial character." This was the case even though data processing and computing means were defined in the claims and performed method steps, as the individual steps "amount to no more than the general teaching to use data processing means for processing or providing information", "the purpose of each single step and of the method as a whole being a purely economic one – the Board held that "using technical means for a purely non-technical purpose ... does not necessarily confer technical character". The Board however held that a claim to a computer system programmed to bring the method into effect had technical character and could be an invention within the meaning of Article 52(1) EPC. In this case, the claim to a computer system lacked inventive step over the prior art – although this had not been considered in detail at first instance, the decision could in practice be made from the Examining Division's assessment of the technical contribution made by the invention.

T641/00 (Comvik) – 26th September 2002

This case relates to the assessment of inventive step in determining patentability of inventions with a mixture of technical and non-technical features. It follows a line of cases starting with T26/86 (Koch & Sterzel) and including T931/95 (PBS Partnership) which develop a determination of how non-technical features of the claim should be used in the test for inventive step.

The case relates to a subscriber identity module (SIM) for mobile telephony which is allocated at least two identities. The user may selectively activate the identity to be used. The Board considered the relevant claims to have a mix of technical and non-technical features. The Board considered how the



problem and solution approach should be implemented for such claims, and found that while the technical problem should not be formulated to refer to matters of which the skilled person would only have become aware by knowledge of the solution now claimed, this applied only to technical features and not to non-technical features. Moreover, "where the claim refers to an aim to be achieved in a non-technical field, this aim may legitimately appear in the formulation of the problem as part of the framework of the technical problem that is to be solved, in particular as a constraint that has to be met". In this case, the Board found that the selection between two identities to distribute costs was a non-technical feature rather than a technical one, and that the technical problem to be solved by the invention should be formulated to incorporate some of these novel non-technical features.

T258/03 (Hitachi) – 21st April 2004

This case related to an auction method executed in a server computer. The Board again considered the "contribution" approach to determining whether a patentable invention could exist and held that it was settled case law that "any comparison with the prior art was found to be inappropriate for examining the presence of an invention". The Board considered the presence of technical and non-technical features in a claim, and stated that "it is often difficult to separate a claim into technical and non-technical features, and an invention may have technical aspects which are hidden in a largely non-technical context. Such technical aspects may be easier to identify within the framework of the examination as to inventive step, which, in accordance with the jurisprudence of the boards of appeal, is concerned with the technical aspects of the invention." The Board stated that "there should be no need to further qualify the relevance of technical aspects of the method in order to determine the technical character of the method" – T 931/95 was in error in finding that the presence of conventional technical means was not enough to provide a claim with technical character. The Board stated that "activities falling within the notion of a non-invention "as such" would typically represent purely abstract concepts devoid of any technical implications. The Board made it clear that this did not imply that "all methods involving the use of technical means are patentable. They still have to be new, represent a non-obvious technical solution to a technical problem, and be susceptible of industrial application." The invention of T258/03 failed on inventive step, as the solution to the technical problem involved was an obvious one.

National Law

National law throughout the EPC contracting states has generally been broadly consistent with the developing case law of the Boards of Appeal of the European Patent Office. A significant exception to this trend has been the United Kingdom. The most relevant case law of the United Kingdom Court of Appeal - the most senior court to consider questions of patentability of computer programs under the Patents Act 1977, which is drafted to bring the national patent law of the United Kingdom into



conformity with the European Patent Convention - is discussed below. The relevant provision of the Patents Act 1977, section 1(2), essentially mirrors Articles 52(2) and 52(3) EPC.

The nature of judicial precedent in the United Kingdom is first briefly discussed. The legal system of the United Kingdom is rooted in common law, which means that it has a greater reliance on case law precedent than civil law based systems. The highest court is the House of Lords, and the decisions of the House of Lords are binding on all lower courts (but not upon the House of Lords itself). The next highest court is the Court of Appeal. Decisions of the Court of Appeal are binding on all lower courts and on the Court of Appeal itself. Below the Court of Appeal, the lower level courts handling patent matters are the High Court and the Patents County Court. These courts handle patent actions at first instance and the High Court also hears appeals from matters decided by the United Kingdom Intellectual Property Office (UKIPO). Leading case law in the area of exclusion from patentability is mainly from decisions of the UKIPO appealed to the High Court and further to the Court of Appeal. None of these cases has been appealed to the House of Lords since the Patents Act 1977 came into force. The relevant case law in the United Kingdom thus consists of a series of decisions of the Court of Appeal, all of which are binding on lower courts and the UKIPO.

The first case to reach the Court of Appeal on this issues was *Merrill Lynch's Application*, which was decided after *Vicom* but before the other Board of Appeal decisions discussed above. *Merrill Lynch* affirmed the technical contribution approach commended in *Vicom* - Fox LJ stating that "there must ... be some technical advance on the prior art in the form of a new result" - with the result that the technical contribution approach is still good law in the United Kingdom. It has been applied in subsequent Court of Appeal cases (*Gale's Application*, *Fujitsu's Application*) leading up to *Aerotel v. Telco*; *Macrossan's Application* and *Symbian Ltd v Comptroller-General of Patents*.

In *Aerotel*, the Court of Appeal was obliged to follow *Merrill Lynch*, but approved a new four-part test for determining whether a claimed invention is patentable. The steps of the test are to:

- i) properly construe the claim;
- ii) identify the actual contribution;
- iii) ask whether the identified contribution falls solely within the excluded subject matter; and
- iv) check whether the actual or alleged contribution is actually technical in nature.

This was accepted by the Court as an alternative construction of the "technical contribution" test. EPO Board of Appeal case law, including *Hitachi*, was expressly not followed. Following regular rejection of cases on section 1(2) grounds, the *Symbian* case was taken to the Court of Appeal. The *Aerotel* test was approved as good law, though it was held that the invention in *Symbian*, which related entirely to software interactions within a computer, passed the *Aerotel* test as it led to a faster and more reliable computer.



Between *Aerotel* and *Symbian*, the further Court of Appeal case of *Actavis UK Ltd v. Merck & Co Inc* included an important finding concerning precedent in the Court of Appeal. The Court held that the Court of Appeal was “free to depart (but not bound to depart) from one of its previous decisions on a point in the field of patent law if satisfied that the Board have formed a settled view on that point, which differs from that arrived at in the previous decision”. The Court in *Symbian* considered this point but did not consider that the view of the Board was sufficiently well settled.

The United Kingdom test for whether an invention is excluded from patentability under section 1(2) of the Patents Act 1977 is thus still the four part test established in *Aerotel*. This is a form of the contribution test explicitly rejected in the line of decisions leading up to *Hitachi*, and the UK is thus clearly divergent from the current practice of the Boards of Appeal of the European Patent Office.



Analysis

As noted in the referral, it is apparent from the *travaux préparatoires* to the European Patent Convention that the intention behind Article 52(2) EPC was to provide an indication of principles that would be applied to give practical effect by the EPO Boards of Appeal and the relevant courts. It should also be noted that some of the exclusions can only be given a narrow interpretation without leading to absurd results, most particularly that of "a discovery". Any new invention may be considered, in a broad sense, as a discovery - it brings something new to the world.

The questions of law in interpretation of Article 52(2) relate to how broadly the individual exclusions should be interpreted, particularly in the light of Article 52(3), to how claims should be interpreted to which multiple exclusions may apply, and also to how Articles 54 and 56 should be interpreted and applied for claims to which Article 52(2) is relevant. All these considerations need to be addressed, and have been addressed, in determining the extent to which inventions relating to software can be patented under the European Patent Convention. The referral errs in implying that the only relevant consideration is the interpretation of Article 52(2). This is apparent from the developing case law of the Boards of Appeal of the EPO, which also reflect the legislative changes affecting this area since the EPC came into force.

A logical starting point may be found in *Vicom*, which established the patentability of inventions which provided a new and non-obvious technical effect even if implemented by software. *Vicom* promoted the technical contribution approach to determining whether exclusion from patentability applied - this (and none of the developing case law which followed it) was adopted by the UK Court of Appeal. Case law before the Boards of Appeal, however, developed. T1173/97 (IBM) questioned the "technical contribution" approach and affirmed the possibility of protection for program product claims provided that these provided a "further technical effect", which need not in itself be new. This was followed by *PBS Partnership*, which explicitly rejected the contribution approach but led to different criteria to be met by method and apparatus claims. These cases followed the adoption of TRIPS, and discussed the extent to which TRIPS should affect interpretation of the EPC.

At this point, a good case could be made for arguing that the position of the Boards of Appeal needed clarification by the Enlarged Board, as the practice following *PBS Partnership* appeared less than fully coherent. The Boards of Appeal however resolved the issues remaining from *PBS Partnership* in the subsequent *Comvik* and *Hitachi* decisions. *Comvik* established a practice for determining inventive step in cases containing a mix of technical and non-technical elements. The result of this practice is predictable, in that it leads to a test which can be applied objectively, and is stringent, as it results in a more difficult test for partly technical inventions than for fully technical inventions, in



that novel non-technical features may be used in the formulation of the technical problem to be solved (thus placing the “skilled person” in a position closer to the solution of the invention than they would be for a purely technical invention). *Hitachi* follows the finding of the Board in *IBM* that technical considerations are most logically evaluated when considering inventive step, by establishing that the presence of technical means is sufficient to satisfy the Article 52(2) EPC test. Since *Hitachi*, substantive consideration of software patent claims which are novel over the prior art has been under the *Comvik* test for inventive step. This has been clearly and consistently used by the Boards of Appeal, and the application of *Hitachi* and *Comvik* together is well understood and a significant body of practical jurisprudence has been built upon it in the years since *Hitachi*.

Unless the Enlarged Board essentially affirms the current position following *Hitachi* and *Comvik*, the current clear and predictable position under European Patent Office case law and practice will be thrown into confusion. This is particularly true if the Enlarged Board feels constrained to adhere strictly to the questions raised in the referral. . The case law of the Boards of Appeal shows a transition from the “technical contribution” approach used in *Vicom* to the “technical character” test of the cases leading to *Hitachi* and the inventive step assessment approach of *Comvik*. This transition has been the logical development of a large number of carefully reasoned decisions and has come about for logical and practical reasons. It is imperative therefore that the Enlarged Board of Appeal gives due acknowledgement to this development in the law in reaching its final decision.

Moreover, as a result of this failure of recognition the discussion of “divergence” provided for each question is seriously deficient. In each case, the comparison is essentially between decisions taken before the practice had been settled under *Hitachi* and *Comvik* with *Hitachi* or decisions taken subsequent to it. There is, in such cases, no true divergence. The evolved law is the settled practice of the Boards of Appeal - the evolving law is not.

It is therefore important for the Enlarged Board to affirm the current practice under *Hitachi* and *Comvik*. This may have further benefits in resolving divergences in case law in EPC member states. In particular, this may allow the UK Court of Appeal to revisit its application of the divergent “technical contribution” test, following its own decision in *Merck v. Actavis*. A judgement which does anything other than affirm the current practice of the Boards of Appeal is most unlikely to have any such beneficial result. It will in addition throw the application of the developed case law of the Boards of Appeal since *Comvik* and *Hitachi* into uncertainty.



Response to Questions

General Comments

The following approach will be taken in commenting upon the questions raised. Current EPO practice, considering both the role of Article 52 and the role of Article 56, will be summarised. We will then indicate whether we consider the case law to exhibit any true divergence. If so, we will indicate which approach should be followed, and why.

Question 1

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

The President found divergence between T1173/97 as discussed above and T424/03 (Microsoft), finding that under T424/03 the exclusion would be limited to claims directed explicitly to computer programs (rather than computer program products), whereas T1173/97 required a more extensive technical character.

We do not consider there to be a true divergence. The law of the Boards of Appeal was still evolving at the time of T1173/97, as is discussed above, but has been settled in *Hitachi*. For good legal and practical reasons, the computer program exclusion is to be interpreted narrowly, as indicated in *Hitachi* and T424/03. This does not mean that inventions related to computer software are easier to patent than inventions in other areas of technology - they are harder to patent, following the practice set out in *Comvik* for assessing inventive step. The primary reason for this narrow scope of exclusion is that questions of technicality cannot be fairly assessed until the examination for inventive step, as is indicated in *Hitachi*. Question 1 should be answered in the positive. This is perfectly consistent with applicable case law and legislation, including TRIPS. The suggestion in the “Consequences” section of the part of the referral relating to question 1 is thus potentially misleading, and it is not clear that any significant negative consequences result from answering Question 1 in this way.

Question 2

(A) Can a claim in the area of computer programs avoid exclusion under Article 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?

The President found divergence between the *IBM* and *Hitachi* decisions discussed above, on the grounds that *Hitachi* merely required the presence of technical means whereas *IBM* required the presence of a further technical effect.

There is no true divergence, as the *IBM* decision is merely a waypoint to the settling of this question in *Hitachi* - this is clear from the case law of the Boards of Appeal, which have consistently followed *Hitachi* on this point thereafter. For the reasons set out in *Hitachi* - in particular, that questions of technical contribution cannot be effectively assessed until inventive step is considered - the position is now well established, and Question 2(A) should be answered in the positive. This is again clearly consistent with case law and applicable legislation, including TRIPS. It should be noted that the even though the answer is clear, the divergence is exaggerated in the referral. The *IBM* decision makes it clear that any "further technical effect" may itself be known in the prior art.

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?

The President found divergence between T163/85 (BBC) and T190/94 on the one hand, and T424/03 as discussed above and T125/01 (Henze) on the other hand. In the first two decisions, claims were held to be acceptable under Article 52(2) EPC because, respectively, they related to a television signal, held to be a physical reality which could be directly detected by technological means, and to a difference from the prior art which led to a technical effect on a physical entity. In the latter two decisions, claims directed to functional data structures independently of cognitive content were allowed as they facilitated data exchange, and claims in which the novelty was found in the use of a single table rather than a plurality of tables were also found to be acceptable under Article 52(2) EPC. The referral considers these decisions to be divergent, and that the result is that it is difficult,



if the latter cases are followed, to contemplate which aspects or effects of a computer program could fall within the exclusion.

We consider that this set of questions gives insufficient recognition to what is the settled case law of the Boards of Appeal. The questions are all directed to the contribution to be made to the technical character of a claim by specific features, and are only relevant to questions of exclusion from patentability under Article 52(2) EPC if the technical contribution approach is followed. It is not. This is very clearly the settled case law of the Boards of Appeal. This may also explain why of the four cases identified in the referral, three are relatively old and two at least have been scarcely considered by Boards of Appeal within the last ten years. This is because it has been settled for approximately ten years that the “technical contribution” approach is not followed by the Boards of Appeal.

Following *IBM*, *PBS* and *Hitachi*, it is clear that in so far as the question can be considered meaningful as the “technical contribution” approach is not good law, the answer to question 3(A) is “No”. Technical character can be found without any such technical effect. It would be misleading even to answer Question 3(B), as the question is not meaningful if the “technical contribution” approach is not good law. However, it is clear from the settled case law of the Boards of Appeal - in a large number of decisions applying the *Hitachi* and *Comvik* approach - that technical character may be found without hardware-dependent technical features. This approach is fully consistent with the applicable legislation, including TRIPS. Moreover, absolutely nothing in this legislation supports the requirement of “an effect on the real world” postulated in this referral.

As before, the discussion of the divergence seriously overestimates the consequences as it does not consider the effect of *Comvik*. Claims passing the Article 52(2) hurdle will still need to be assessed under Article 56, and this assessment is difficult to pass for claims containing a mixture of technical and non-technical features for the reasons discussed above.

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 the 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?

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The President found divergence between T 1177/97 and T172/03 (Ricoh) on the one hand and T833/91, T204/93 and T769/92 (Sohei). T 1177/97 found that “implementing a function on a computer system always involves, at least implicitly, technical considerations” and in T172/03 the relevant “skilled person” was defined as a software project team. The three latter decisions all considered that a programmer’s activity fell within the Article 52(2)(c) exclusions - the decisions, according to the referral, all holding “programming to be a mental act of the programmer”.

As for Question 3, this set of questions is also not well-founded, as it is underpinned by the “technical contribution” approach to assessing whether inventions are excluded from patentability under Article 52. This issue is settled by the line of cases culminating in *Hitachi*, again unfortunately omitted from the cases identified in the referral. Again, most of the cases actually discussed are essentially obsolete in that they relate to the practical application of the “technical contribution” test.

The specific questions in the referral cannot be readily answered, as they assume the “technical contribution” approach in their wording. A clear answer to the handling of the issues raised in Question 4 is however found in the settled case law of the Boards of Appeal. This answer is summarised in *Hitachi*, and is that claims relating to the result of the activity of programming will, if properly formulated, not be excluded under Article 52(2) EPC as they will have technical character. Such claims will then need to be assessed for inventive step using the principles set out in *Comvik*. As indicated above and further considered in numerous cases following *Comvik*, it is then necessary to formulate a technical problem to be solved by the person skilled in the art - who may, in appropriate cases, be a computer programmer or programming team as in *Ricoh* - and this technical problem may be formulated in the light of novel but non-technical features of the claim. This approach is again clearly consistent with the applicable legislation, including TRIPS, and provides an objective test with predictable results. The discussion of the divergence is not easy to understand, as it does not at any point address the fundamental issue of inventive step.



Conclusion

It is clear from the consideration of the legislation and prior art above that the questions raised in the referral should be answered consistently with the well-established case law of the Boards of Appeal, and in particular with the stable position following *Hitachi* and *Comvik*. It is particularly clear that issues relating to the patentability of software need to be considered as a whole, and that questions of inherent patentability under Article 52 cannot be trivially distinguished from questions of inventive step under Article 56. The Boards of Appeal have, after much case law, developed a stable and generally well-understood approach. This approach is not well represented by the referral, which is informed by a belief in the continued applicability of the “technical contribution” approach to assessing patentability under Article 52 which has been, very clearly, long abandoned by the Boards of Appeal. The Enlarged Board is requested to affirm the approach to assessment of patentability under Articles 52 and 56 taught in *Comvik* and *Hitachi*, as this provides a fair and objective framework for assessing inventions containing a mixture of technical and non-technical features. To do otherwise will result in an extended period of confusion and a reduced likelihood of harmonisation in the national law of the signatory states to the EPC.

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