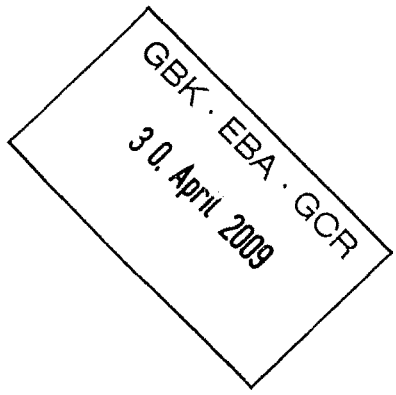
Institut zum Schutze geistigen Eigentums | Institute for protection of intellectual property



IZSGE
Institut zum Schutze
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4020 Linz

Abs: IZSGE, Hauptplatz 4, A 4020 Linz

Enlarged Board of Appeal
European Patent Office
Erhardtstrasse 27

D-80331 München

Linz am 22.4.2009

Regarding: Case G-03/08: Referral to the Enlarged Board of Appeal

Dear Sirs,

hereby we submit an amicus curiare brief on case G-03/08 (patentability of programs for computers), which is also submitted for publication.

We understand that the EPO is under pressure from political groups and other groups in our society, that do not understand the importance of protection of intellectual property rights. It is one of the greatest challenges of the future to overcome the mistrust and educate those groups, mainly those who produce software or other goods just protected by the Berne convention, on the advantages of patent protection.

As it was stated by the Austrian delegation on the EPC in 2000, we think that it is of first priority not to give up on the progress made on the extension of patentability on computer programs. The computer industry has emerged to a noticeable scale without patent protection. Such a process can not be allowed to continue without patent protection. This could lead into unjustified questioning on the benefits of patent protection in other fields of technology at the political level.

What is actually addressed by some as problems, has to be seen in the light of successful expansion. This expansion of patentable subject matter is leading to new challenges in patent examination, but this challenges can be met by a progress in the procedures of the offices. This progress will result in additional benefits to all other applicants.

We are concerned, that the status quo is used to argue against patent protection being too slow, too expensive and unrelated to the state of the art in all modern technologies. It is often argued that copyright protection is much more adequate to this fields. This argument hides, that for software, copyright also needed to be adjusted. We think that this revisionism has to be answered by very clear patenting rules and by predictable and standardized examination. We see this also as a preliminary stage to make further progress on patenting cost.

We are also concerned about a future scenario, in which the misunderstanding of current concepts is leading to low quality of applications and unpredictable examination results and thus to more pressure to question patent protection as such.

Summary:
We think that the concept of the further technical effect is the preferred concept to maintain the expansion of patentability of computer programs. The concept has some limitations in practice, which we think can be overcome by clear communication. If applied as intended, the concept has important advantages over others.

QUESTION 1: CAN A COMPUTER PROGRAM ONLY BE EXCLUDED AS A COMPUTER PROGRAM AS SUCH IF IT IS EXPLICITLY CLAIMED AS A COMPUTER PROGRAM?

Answer 1: No
Reasoning: As long as Art 52(2)(c) and (3) EPC are not deleted, there has to be a theoretical exclusion. An exclusion of a computer program if explicitly claimed as a computer program is easy to overcome by the applicant, but has the drawback that the applicant has to use a special wording. This special wording is reducing the quality of the disclosure and gives argument to the critics of the expansion of the patent system. Overcoming this exclusion by wording in the application is the least preferable method.

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?

Answer 2(a): No
Reasoning: This would extend patentability not only to computer programs but also to data structures and programs without a practical meaning. Of course there is no legal argument why data structures and algorithms should be less valuable and not benefit from protection. But in the context of computer implemented inventions, there is a limited use of such patents. There is no need to disclose an algorithm or data structure to obtain patent protection for the related product.
Mentioning a storage medium or a computer as a condition leads the applicant into a wording that is degrading the quality of the disclosure and gives argument to the critics of the expansion of patenting.
As long as Art 52(2)(c) and (3) EPC are not deleted, there has to be a theoretical exclusion. But the mentioning of the computer or the storage medium is a circumvention that is very hard to justify.

Answer 2(b) Yes
Reasoning: The "further technical effect" is the preferred circumvention to Art 52(2)(c) and (3) EPC. While it still maintains a theoretical exclusion it is, together with the ability to claim the computer program, resolving all practical limitations. The concept is easy to handle as it is working only on the legal preconditions and has neither to be reflected in the patent application nor evaluation.
It also offers the ability to be applied to other fields of technology, that do not have patent protection now. An invention, which is relaxing muscles by sound waves, would now be discriminated from patent protection because it is seen to be excluded as a music creation. The concept of "further technical effect" lends a reasonable basis for such inventions to be the technical inventions, they are.
For this ease of application, the concept of the "further technical

effect" is to be preferred until a deletion of Art.52(2) and (3) can be get trough on political level.

Note: We want to mention, that there are practical problems with the "further technical effect" when the concept is misunderstood. As explained by the EPO in 2000 this concept should not be used at all in the examination but only as a "de-facto" deletion of the exclusions under Art.52(2) and (3). But we think that these problems can be solved by communicating the concept to examiners and local patent offices.

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 (A) IS ANSWERED IN THE POSITIVE, IS IT SUFFICIENT THAT THE PHYSICAL ENTITY BE AN UNSPECIFIED COMPUTER?

(C) IF (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?

Answer 3(a): No
Reason: Depending on the further clarification, such a ruling would be either understood as a retreat from the status already reached on the patenting of software programs or as an obscure circumvention of Art 53(2) and (3). It is sufficient if a claimed feature has a further technical effect.

Answer 3(b): No
Reasoning: Every computer program can be shown to have such an effect. This would extend patentability not only to computer programs but also to data structures and programs without a practical meaning. As pointed out in Answer 2(a) such obvious steps are not necessary as the finer instrument of the further technical effect is easier to use and justify.

Answer 3(c): Yes
Using the construct of the further technical effect, features of a software program can always contribute to the technical character of a claim whether there is hardware involved at all, as such a further technical effect can also be archieved on "virtual" entities.

Note: This is important as there is another evident gap in the protection. In the 80s the distribution of programs on paper was common practice. These programs have been printed in magazines and have been typed into computers by the readers. Patent applications are, by now, just seen as protected by copyright. This is sufficient now, as patents on computer programs do not have reached a quality level that, allows the reproduction of a person skilled in the art. Now an applicant can make use of a patent to file his own application, without having a license. It is important to close this hole before it becomes evident.
The ability to claim the program on any storage medium makes sure, that there is no reason to deny that protection on the patent application itself. So an applicant has to license the rights on prior art. This is not only to the advantage of the applicants but to the development itself as the holder of a prior art patent is then aware of the usage.

QUESTION 4 (A) DOES THE ACTIVITY OF PROGRAMMING A COMPUTER NECESSARILY INVOLVE TECHNICAL CONSIDERATIONS?

(B) IF (A) IF ANSWERED IN THE POSITIVE, DO ALL FEATURES RESULTING FROM PROGRAMMING THUS CONTRIBUTE TO THE TECHNICAL CHARACTER OF A CLAIM?

(C) IF (A) IF 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?

Answer 4(a): No
Reasoning: This concept is not of the quality reached with the concept of the further technical effect for the reasons already displayed in this text. Against the background of the criticism on the EPO, such a concept could lead into a broader discussion about the term "technical" itself.

This is to be avoided as there will be many participants in that discussion without enough knowledge.

Answer 4(c): Yes

Any feature that contributes to a further technical effect is contributing to the technical character of the claim.

Yours faithfully

Institut zum Schutze geistigen Eigentums

DDr. Herbert Grauskop