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To: Enlarged Board of Appeal
European Patent Office

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Opinions on the Patentability of Computer Programs

The Japan Intellectual Property Association (JIPA) is a non-profit, non-governmental intellectual property organization established in 1938, which counts about 900 major Japanese companies as its members. We submit our opinions and comments to the relevant authorities and organizations with a view to support the improvement of the intellectual property systems implemented throughout the world and the operations thereof. Taking this opportunity to file a written statement concerning the "limits of the patentability of computer programs," we would like to hereby put forward our opinions as follows. We would appreciate it if you could take them into consideration.

Computer programs satisfy the patentability requirement defined in Article 27 of the TRIPS Agreement, "patents shall be available for any inventions, whether products or processes, in all fields of technology, provided that they are new, involve an inventive step and are capable of industrial application." In fact, inventions relating to computer programs are treated as patentable subject matter in Japan and the United States. From the perspective of trilateral harmonization, we would like to request that the EPO clearly stipulates in its Guidelines for Examination and other provisions that inventions in the area of computer programs are patentable and that the patentability of computer programs does not depend on the claim forms.

In the actual patent examination process, it is often the case that the patentability of an invention is determined based not only on whether or not the invention has a technical aspect but also on whether or not it has "a further technical effect." However, in our view, a "further technical effect" in an invention is a factor that is examined in the phase to assess whether or not the invention involves an inventive step. In conclusion, we consider that whether or not an invention is patentable should be determined based on "whether or not it is explicitly mentioned in a claim that the invention as a whole uses a computer" and "whether or not the invention has any technical aspect, e.g. contributing to solving a technical problem."

Attachment: Detailed comments on the questions

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3 (B)	If question 3(a) is answered in the positive, is it sufficient that the physical entity be an unspecified computer?	–	–
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?	Features can contribute to the technical character of a claim.	[Same as 3(A)]
4 (A)	Does the activity of programming a computer necessarily involve technical considerations?	Yes, the involvement is necessary.	Designing and manufacturing computer programs involve technical considerations, based on the constraints of the computer hardware as well as viewpoints from software engineering.
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 all features contribute to the technical character of a claim.	Not all features resulting from programming contribute to the technical character of a claim because some features reflect constraints in terms of the applicable fields or business purposes. The patentability of the invention in the area of computer program should be determined based on whether the technical character resulting from programming have recited in the claim or not.
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?	–	–

[Attachment] Detailed comments on the questions

No	Questions	Opinions	Comments
1	Can a computer program only be excluded as a computer program as such if it is explicity claimed as a computer program?	A computer program should not be excluded.	The patentability of an invention should not be determined only on the basis of the claim form, but it should be determined by examining whether or not the invention has a technical aspect.
2 (A)	Can a claim in the area of computer programs avoid exclusion under Art. 52(2)(c) and (3) merely by explicity mentioning the use of a computer or a computer-readable data storage medium?	Such claim should not avoid exclusion.	In the area of computer programs, the patentability of an invention should be determined based on whether or not it is explicitly mentioned in a claim that the invention as a whole uses a computer. For instance, in the case of an invention wherein all data processing steps are manually handled and a computer is used only for the storage of output data, it cannot be said that the invention as a whole uses a computer, thus such invention should be excluded from the scope of patentable inventions.
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?	The patentability of an invention should not be determined on the basis of the existence of a further technical effect, but it should be determined by assessing whether or not the invention as a whole uses a computer.	The "existence or absence of a further technical effect" in an invention should be examined in the phase to assess whether the invention involves an inventive step, and such issue should not be taken into consideration when determining whether or not the invention can avoid exclusion from patent.
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?	Such an effect on a physical entity is not necessarily required.	For example, when considering the invention for improving accuracy of data processing, though it would not have an effect on a physical entity (e.g. computer hardware architecture), it should be treated as the patentable invention because it solves a technical problem.