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Enlarged Board of Appeal
European Patent Office
Erhardtstrasse 27
D-80331 Münchien
Germany

Warszawa, April 30, 2009

Case ref: G3/08
Our ref: G2172PL00/FM

Re: Referral under Art. 112(1)b) EPC by the President of the EPO
to Enlarged Board of Appeal

Dear Sirs,

I hereby present my *amicus curiae* brief to the questions asked by Mrs. Alison Brimelow, President of the European Patent Office.

I will present my – Polish - perspective to the problems behind the questions raised by Mrs. Brimelow. Polish perspective might be in this case of particular relevance due to the fact that National Law and Polish Patent Office applies extremely restrictive approach to the computer implemented inventions, thus problems related to the substantive issues of the patent law can be seen best in the extreme (in this case Polish) environment. Further I would like to present suggested answers to the questions, if the questions are deemed to be admissible, followed by a short summary that can be found at the end.

Case study - Poland

Poland as a member state to the EPC and a party of the TRIPS Agreement has amended Industrial Property Law of 2000 (IPL) in respect of requirements for

patentability with intention to bring it in line with both the Convention and the Agreement. However amendments of the Polish IPL have not resulted in a full compliance with the international regulations. Delimiter of the exclusions from the patentability under art. 52(3) EPC i.e. “*as such*” clause was not adopted to IPL. Then IPL does not exclude from patentability computer programs *as such* but in general computer programs.

The consequence of the above is simple - computer program cannot constitute patentable invention. Therefore computer program cannot be a subject of the claims neither product claims nor method claims. It is irrelevant whether an effect obtained by computer program is technical or not. Since the subject matter of the application is a computer program (excluded subject matter) patent cannot be granted. When applying these provisions of IPL Polish Patent Office is seeking for computer programs in any forms, understanding *computer program* as broadly as possible (*to exclude computer programs from patent protection effectively*). This approach results in exclusion from patentability of technical invention due to computer program applied to work the invention.

Under Polish IP Law it is a full exclusion from patentability of the computer programs does not comply with a goal of the patent system – which is to protect technical solutions. Objections raised by the Polish Patent Office in the application proceedings under the IPL reveal a system that brings the meaning of “a technical solution” to material aspect of the solution – i.e. controllable forces of nature need to be involved in the solution of the problem. It is not enough to use forces of nature to work invention – application of the forces of nature must solve the problem. From that point of view computer programs are perceived as pure abstract concepts that happened to be present in the material environment of a computer.

Contrary to the above presented approach legal definition of a technical invention as a patentable subject matter (delimited by the exclusions) or understanding of this term should have dynamic and descriptive character. I mean understating the legal terms should follow technology development and not the other way round – law shall not diverge from reality. Patent law cannot create an equivalent of

technology that is used to define a patentable solutions – fundamental rule expressed in art. 27 of TRIPS clearly shows the way – patent should be available to inventions, as they are, without a discrimination in every field of technology.

According to the latin rule *exceptiones non sunt extentendae*, exclusions from patentability should be clear and univocal to avoid situation when technical invention is left without the possibility to obtain patent protection.

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?

No. Any technical invention should be patentable. The scope of exclusion should be understood as not relating to the subject matter being a technical invention. If a subject matter of the application is a technical invention worked out by the computer program which invention is claimed in a form a computer program claim. The form of a claim may not decide about exclusion of such subject matter from patentability.

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?

Yes. The presence of a computer program on a record carrier and use of the computer program in a computer indicates that the computer programs are of technical character.

When assessing the inventive step of invention a combination of the claimed features should be considered, and the invention has an inventive step when the contribution to the state of the art of a technical character is present.

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?

Notwithstanding the answer to Q2(a) the further technical effect is only relevant for patentability if it contributes to novelty and inventive step.

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?

The concept of a physical entity in the real world seems to not be a quite precise and useful for assessing the technical character of the invention.

First of all computer programs are present in a real world in the same way as the screwdriver is.

Technology and technical inventions are consisted of both physical entities and logic rules that are expressed in abstract (logical) way. Invention can be found in both aspects of the solution. Therefore limiting technical effect to a physical effect is a limitation in respect to understanding the term *technical effect* with a common sense.

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

There is no reason to distinguish computer from any other device / apparatus.

Question 4

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

YES. Each program is an instruction set for a machine. Technical consideration are involved in writing a software since they are necessary to properly formulate the code.

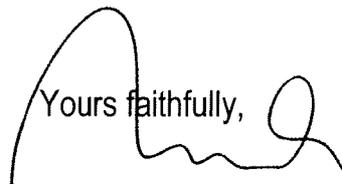
(b) If question 4 (a) is answered in the positive, do all features resulting from programming thus contribute to the technical character of a claim?

YES. All features resulting from programming should be considered as having technical character and should be a subject of further examination to establish novelty and inventive step.

Summary

I believe the all referred decisions of the Board of Appeal do not lead to divergence in practice of the European Patent Office. Modified problem-solution approach applied to establish whether the subject matter is a patentable subject matter represents a balanced and correct approach that is suitable for examination of the state of the art inventions in XXI century.

Nowadays computer programs are tools to achieve technical effects, pretty much the same way as a steel construction was in XIX century and semiconductors ware in XX century.

Yours faithfully,

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