



**PATENT OFFICE
OF THE REPUBLIC OF POLAND
PRESIDENT**

Alicja Adamczak

Warsaw, 8 May 2009

S-0811-1/09

**Enlarged Board of Appeal
European Patent Office
c/o W. Roepstorff / Registry
Munich**

Re: Case G3/08 Referral under Art.112(1)b) EPC by President of the EPO (Patentability of programs for computer) to the Enlarged Board of Appeal.

Dear Registrar,

I am pleased to enclose the Polish Patent Office submission on the questions asked by the President of the EPO.

We hadn't planned sending an answer the questions, but we changed our position because one of published amicus curiae briefs directly refers to principles of Polish law and its implementation by the PPO.

Therefore, we feel it is indispensable to the Enlarged Board to know Polish rules as regard patentability of computer programs. The enclosed submission was prepared by the PPO examiners: J.Halbersztadt, A.Kalewski, I.Slomka, W.Witkowska. I would like to ask You to make it public although established by the EBoA deadline has already passed.

We are looking forward with interest to the EBoA decision on patentability of software.

Yours sincerely,

pp A. Adamczak

INTRODUCTION

When giving reason for asking questions, the EPO President has rightly observed that there are certain concerns in member States of the EPO, among both patent institutions as well business and professional circles, about a restrictive interpretation of exclusions from patentability which characterizes the jurisdiction of the EPO's Boards of Appeal. As it is in case of many other national patent offices of the member States, the Patent Office of the Republic of Poland is responsible not only for validation of the patents granted by the EPO but it also has the power to invalidate such patents. That is why the Patent Office of the Republic of Poland is interested in creating mechanisms that would encourage both the discussions and joint decisions on basic principles which patent bodies should follow when interpreting the EPC provisions. The Patent Office of the Republic of Poland perceives the possibility of presenting opinions on the issues mentioned by the EPO President to the Enlarged Board of Appeal as the first step towards a closer cooperation of all interested parties to work out a proper interpretation of binding patent provisions. Only such a method of establishing the interpretation of current provisions and only joint analysis of their drawbacks can constitute the basis for a proposal concerning possible changes in the binding provisions.

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?

When discussing the background of the question the reference was made to the distinction between decisions in the cases T1173/97 and T424/03. However, in both cases, the solutions that had been the subject matter of the disputes were considered as inventions. In the case T1173/97 a rule was established saying that a computer program (a computer program solution) is considered to be an invention when it performs a function regarded as technical one (being of technical nature). In the case T424/03, it has been further extended that the manner of claiming the computer program as a computer implemented method or as a computer program recorded on a carrier is a formal way to overcome the exclusion of programs from patentability.

From the patent law perspective we do not find any need to differentiate between technical and non-technical computer programs. **We think that no program (software solution giving only the new functionality to the old hardware) can be an invention, irrespective of the form or circumstances in which the program was presented. The software can be used as a helping tool for an external technical method, but it is that method that would be patentable. Of course not every software supported method can be a technical one.** The fact that this is not wording but substance of the solution that should decide on patentability was recognized in many court decisions of

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numerous member states. This comes from the general principle of the rule of law. Here the judgement of the German Supreme Court (BGH) in the case *Dispositionprogramm* is of particular importance, because it directly and profoundly refers to the computer program as early as in the year of 1976.

The way of analysis of the application that actually allows to exclude computer programs from patentability was presented by the judgement of the British Court of Appeal in the case *Aerotel/Macrossan* of 2006 mentioned in the reasoning supporting the question. The Patent Office of the Republic of Poland, when examining the applications in which it is not certain whether they contain an invention, has been using the methodology similar to the British one for years. It would be advantageous if the Enlarged Board of Appeal, before making a position to the questions of the EPO President, has had analysed the court practice and jurisdiction of the EPO member states.

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?

According to our opinion, the answer to the question should be negative. Any non-technical subject of an application may not be transformed into an invention through changes in wording. To allow for such attempts would mean that the efforts to define the subject matter of the patent law, as expressed in Article 52 EPC, are rather pointless.

It would be an astonishing inconsistency if on the one hand the computer programs were not found to be the inventions, but on the other hand the same programs recorded on a carrier or installed and run on a computer were granted a status of the invention. Such inconsistency seems to result from the reasoning presented in the grounds for the decision T258/03, according to which the presence of very technical means such as computer is enough to grant the technical character.

(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?

In our opinion, it would be an even bigger inconsistency than the one resulting from the affirmative answer to the question 2A. The same program could avoid exclusion or not, depending on the purpose for which it was applied.

In an earlier decision T1173/97 a technical effect going beyond the usual physical functioning of a computer is required. That decision has been referred to in the reasoning to the questions as entirely different from the decision T258/03. The reasoning presented in T1173/97 would be right provided that the decision (together with other decisions that refer to it) did not regard the "further technical effect" as a "decisive feature". It is not a technical effect in common meaning because the only change introduced to the system is a change in the computer program. For example, in apparatus category, it merely means that non-technical idea was realised by means of technical devices without making any changes to technical functioning or construction of these devices. That is why in our opinion the decisions referring to a "further technical effect" are wrong.

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?

In the discussion of the question background the point was made on differences between the decisions T163/85 and T190/94 in which physical aspects were necessary to recognize the technical character of the claim, and the decisions T424/03 and T125/01 in which reference to functional instead of purely cognitive information is sufficient to recognize technical character.

We definitely opt for the first interpretation, though we find it to be insufficient. We agree that, not only technical aspects in the application are important, as it is rightly established in the EPO's approach. However, according to that approach in practice, a technical character need not manifest itself in the solution. It may as well arise from the problem which lies at the source of the solution, or the results gained through the solution. (*T833/91 and Case Law of the Boards of Appeal of the EPO, 5th Ed., 2006, p.12*). We think that it is not right to search for shades of technicality as far and wide. We can not find either clear grounds for the interpretation assumed by the EPO in the actual provisions.

From the rules of practice of the EPO, where it is stated what the layout of the invention specification should be like (*rule 42 (c) of the Implementing Regulation*), that is where it is stated that the specification should disclose the invention in such a way that it is possible to understand the technical problem which was solved and the favourable results that occurred compared to the state of art, it does not follow that merely the technical problem or effect is enough for the solution to have a technical character. **We are of an opinion that in order for the application to contain an invention the very solution has to be of technical character.**

It is also important what one means by technology. We consider as a right thing to accept a reference, used in German jurisdiction (as well as in Polish and other Member States' jurisdiction) to "controllable natural forces" or referring technology to natural sciences. Such a formula is included in the Polish implementing regulations to the patent law (paragraph 32 (1) of the regulation on filing and examining patent applications) as well as in the guidelines of the German Patent Office (item 3.3.3.2.1. of the guidelines of DPMA of 2004). In 2004-2005, in the process of the works over the European directive on patentability of software related inventions, many governments (including the Polish government, in the resolution of 17 November 2004) demanded including this wording in the directive. Similar wording is used in the guidelines for the government in the resolution 15/4403 of the German Parliament of 1 December 2004, and the Legal Commission of the European Parliament passed on 20 July 2005 an amendment in which the field of technology was defined as an application domain requiring the use of controllable forces of nature to achieve predictable results in the physical world.

The requirement of the technical character should not be regarded as a formal requirement that is easy to circumvent as a result of some semantic changes. The use of technical means has to be the main part of a solution. **That is why a claimed subject matter, which consists only of instructions performed by conventional hardware for data processing, also called a computer program or a computer implemented solution, is not an invention in the sense of the patent law, irrespective of the form in which it has been claimed.** A subject matter, introduced as a device made of modules

described as functions will not cease to be a program that in fact consists of a set of instructions.

A claimed subject matter can be an invention in sense of the patent law only if it contributes knowledge to the state of the art in a field of applied natural sciences. There is no technical contribution in case when an element that matters in a claimed solution does not require a new hardware or a new combination of previous hardware, does not remove any noticeable drawbacks and is connected merely with correction of a non-technical part. If a technical contribution (that consists in enhancing practical knowledge in the material sphere) cannot be identified, it also means that there is no invention included in the subject matter of an application.

A modified at the end of the 90s EPO's methodology of determining the technical character of the application has ceased to require an assessment of the technical contribution. Instead to answer whether a hybrid solution, where technical and non-technical features are combined, includes an invention a special method of assessing an inventive step was developed (*T931/95, T1173/97 and Case Law of the Boards of Appeal of the EPO, 5th Ed., 2006, p.1-2*). The modification is considered very controversial, it is partly regarded as entirely unacceptable.

A methodology used in the 90s by the EPO, based on an assessment of technical contribution, is one of the basic ideas behind a well-known judgment *Aerotel/Macrossan*, in which the judge Jacob presented the first version of questions to the Enlarged Board of Appeal (*[2006] EWCA Civ 1371, para 76*). We would consider it relevant if the Enlarged Board of Appeal referred to these questions as well.

We think that it would be advisable to return to the methodology of assessing for technical contribution, which has been carried on by some of the national patent offices in Europe and accepted by courts of these Member States. With the exception of rare German cases we do not know a single judgment case when a Member State court uses a new approach developed during the last decade by the Technical Board of Appeal 3.5.01.

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

We think that an unspecified computer is an exclusively abstract device for data processing. Any set of abstract instructions for physically unspecified computer never leads to a solution of a technical character.

(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?

Our answer to the question 3A is affirmative.

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

Discussing the grounds for the question, it was pointed out that previous decisions used to emphasize an abstract nature of programming which does not involve technical considerations. However, it is said in the recent decisions: *T1177/97* and *T172/03* that

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implementation in the computer system of non-technical functions (e.g. a method of translating from one natural language to another) involves at least indirect reference to technical aspects.

It seems that the above approach results from a wrong understanding of the term "technology". In the grounds for the decisions: T1177/97 and T172/03 by the words "technical considerations" they mean "practical and useful considerations". However, rightly understood technical considerations refer solely to "controllable natural forces" (discussed in the answer to question 3A) in the context of the essence of the solution and not a connection with the solution. **Programming, excluding perhaps programming of some basic functions of operational system of a processor, is just about defining relations among abstract objects.** Thus, it is a human activity beyond "controllable natural forces". One may say that programming is related to technology in the same way as work over patent application is related to technology. The first and the second are about presenting technical solutions in the right language. The first in a language acceptable by a computer, the second in a language acceptable by patent professionals. Paradoxically, only very few people think that the work over patent application can be patented, whereas surprisingly big number of patent professionals think that after some semantic changes computer programs become patentable.

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

Our answer to question 4A is in the negative.

(C): IF (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?

We are of an opinion that no features resulting from programming can contribute to the technical character of a claim. The fact that non-technical idea was implemented by means of a technical device does not mean that the idea become a technical one and an invention.

ADDITIONAL REMARKS

The remarks below go beyond legal questions put forward by the EPO President. However, in our opinion, they are of importance for the proper estimation of the discussed issues.

Out of some unclear reasons, in the grounds for questions to the Enlarged Board of Appeal it was stated that there exists a consensus about a methodology of a technical contribution identification having no grounds in the EPC (p. 14). However, it is a single view of the Technical Board of Appeal 3.5.01, which is considered, for example in the British jurisdiction, as entirely wrong. It is clearly expressed in the model grounds for the judgment *Aerotel/Macrossan* ([2006] EWCA Civ 1371) that due to lack of consistency of the EPO's jurisdiction, the methodology of identifying technical contribution is the only applicable one.

The Polish Patent Office, similar to the British or German Patent Offices, continues to treat identification of an invention as an independent decisional procedure that precedes examination of fulfilling the three patentability criteria. For the purpose of this analysis a methodology of identifying the technical contribution is used. An obligation of a search for a technical contribution was also included in the version of the European directive accepted in July of 2005 by a coalition of all political party members of the European Parliament.

As the judge Jacob rightly observed in the grounds for the judgment *Aerotel/Macrossan*, the two methods (rejected and applied by the EPO) can often produce the same result, that is granting or refusal to grant a patent. However, the practice suggest that the Polish Patent Office (UPRP) refuses to grant a patent more often than the EPO when referring to applications with the same priority. The PPO, annually takes a few dozens of negative decisions on refusing to grant a patent due to lack of a technical character in the solution described in the application, whereas the EPO regards parallel applications as including inventions. None of the four options of claimed scope of protection from those discussed in the model decision T154/04 would be considered by the PPO as including an invention. (compare to *D.Closa, P.Corcoran, J.Machek, C.Neppel, EPO examination practice in relation to Computer-Implemented Inventions, in particular, Computer-Implemented Business Methods. EPI Information 02-2007, p.65-69*)

Justine Pila of Oxford University analysed the jurisdiction of the EPO from the whole time of its functioning (*Dispute over the Meaning of 'Invention' in Article 52(2) EPC - The Patentability of computer-implemented Inventions in Europe. International Review of Industrial Property & Copyright Law, Vol. 36, 2005, p.173-191*), which led her to a conclusion that in the EPO's approach to the idea of "invention" one can distinguish three periods. Each of them lasted about 10 years. The first one till the year 1988, the second in the 90s, and the third lasts since 1999.

The second period is characterized by formation of the two competing lines of jurisdiction. The first of them is a far departure from the widely used jurisdiction of Member States, mainly German. It is associated with big increase of patents for software related solutions and is called whole contents analysis approach. According to that approach, a connection with computer hardware decides that an software related solution is an invention (*for example decisions T42/87, T164/92, T59/93, T6/83, T110/90, T236/91, T769/92*). The second, alternative approach, was about adaptation of the pre-EPO methodologies to computer related solutions. It was referred to as an approach based on the analysis of a contribution. The methodology based on the analysis of a contribution leads to a test according to which the technical character of a contribution decides on an invention, which excludes the solutions where the difference concerns computer programs (*for example decisions T22/85, T38/86, T158/88, T833/91, T204/93, T52/85, T65/86*).

According to J.Pila after the year 1999, the two competing methodologies of application analysis were merged in one methodology. In fact, the preferred one is the approach based on the whole contents theory. Moreover, this option should be the only right one, and any deviation from it should mean disobeying the EPC convention. The use of a methodology based on the analysis of a contribution was dismissed by the Technical Board of Appeal 3.5.1. However, its language is used for the purposes of the whole contents approach. At the end of the travel according to EPO requirement of the technical character is a requirement entirely of form, that exists independent of the requirement of

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an inventive contribution, and that does not depend on the production of any material or physical object.

Documents of the European Commission and EPO of the years 1997-1999 (*Promoting Innovation Through Patents. Green Paper on the Community Patent and the Patent System in Europe. COM (97) 314 final, 24 June 1997, p.16-17; Promoting Innovation through Patents. The Follow-up to the Green Paper on the Community Patent and the Patent System in Europe. COM (99) 42 final, 5 February 1999 p.12-13; Trilateral Project, Examination of "business method" applications. Appendix 6: EPO position paper, 19 May 2000*) had carried arguments and conclusions that changes resulting in de facto patentability of computer programs should be done from political and economical reasons: because of developments in this field by the main European trading partners (the United States and Japan) and because of obligations imposed by the WTO/TRIPS agreement.

The presuppositions and the other arguments for patentability of software were not accepted. To the proper understanding of patentability provisions should be taken into account that plans to abolish computer programs from the list of non-inventions were abandoned and proposed directive on the patentability of computer programs related invention was rejected. Addressing of the 6 July 2005 the European Parliament the rapporteur of the directive Michel Rocard said: "rejection is a message directed at the European Patent Office. The European Parliament has refused to ratify the recent judicial errors by extending the scope of patentability to certain software programs".

We find it reasonable to abandon false direction accepted after 1999. Instead, only the line of jurisdiction based on the analysis of a contribution should be continued. It is our understanding of obeying the EPC.

SUMMARY

The most important principles of a correct understanding of the issues discussed by the EPO President are as follows

1. A claimed subject matter, which consists only of instructions performed by conventional hardware for data processing, also called a computer program or a computer implemented solution, is not an invention in the sense of the patent law, irrespective of the form in which it has been claimed. The technical character is not a formal requirement, in order to fulfill it, it is not enough to use a technical form or describe an abstract subject of an application by means of technical terms. This requirement is essential and decides on the limits of patentability.
2. A claimed subject matter can be an invention in sense of the patent law only if it contributes knowledge to the state of the art in a field of applied natural sciences (relating to "controllable forces of nature"). There is no technical contribution in case when an element that matters in a claimed solution does not require a new hardware or a new combination of previous hardware, does not remove any noticeable drawbacks and is connected merely with correction of a non-technical part. The technical character has to be present in the solution, it is not enough if it is in the problem or the results.
3. Identification of an invention is an independent decisional procedure that precedes the check of fulfilling the patentability criteria.

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