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27. April 2009

epi

*Institut der beim Europäischen Patentamt
zugelassenen Vertreter*

*Institute of Professional Representatives
before the European Patent Office*

*Institut des mandataires agréés
près l'Office européen des brevets*

Mr. W. Roepstorff
Registrar
Enlarged Board of Appeal

cc: Vice President Mr. P. Messerli

The President

27.04.2009

Case G 3/08, Referral under Article 112(1)(b) EPC by the President of the EPO

Dear Sirs,

Kindly find enclosed our statement regarding the above case in the form of an Amicus Curiae brief.

Yours sincerely,



Kim Finnälä

Encl: **epi** Amicus Curiae brief, Case G 3/08

cc: Mr. P. Messerli, Vice-President DG 3

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Case G 3/08 (Patentability of programs for computers), Referral under Article 112(1)(b) EPC by the President of the EPO

Amicus Curiae Brief – submission by epi

Patentability of programs for computers

In the view of **epi** the general questions surrounding the patentability of computer programs are important, and it is hoped that the opinion of the Enlarged Board of Appeal could lead to more clarity in this area.

Just like all other inventions, Article 52(1) EPC requires any invention not excluded under Article 52(2) and (3) EPC to lie in a field of technology, to be new, to involve an inventive step and to be susceptible of industrial application. In the view of **epi**, it seems unnecessary to analyse in isolation the patentability under Article 52(2) EPC, when the technical characteristics required in this step are at any rate examined again in comparison with the prior art when assessing novelty and inventive step under Articles 54 and 56 EPC.

epi wishes to emphasise that irrespective of whether patentability is examined separately from or in conjunction with novelty and inventive step, any non-technical subject matter remains non-patentable under the EPC.

It is the opinion of **epi** that for an efficient examination which leads to a valid patent, novelty and inventive step should be assessed in light of Article 52 EPC, with particular consideration of the non-exclusive list of examples of non-inventions given in Article 52(2) and (3) EPC. If, based on the examination of the technical characteristics of the invention, both novelty and inventive step are confirmed, this also means that the invention does not relate to subject matter excluded from patentability under Article 52(2) and (3) EPC.

epi wishes to comment on the four questions referred to the Enlarged Board of Appeal by the President of the EPO as follows:

Question 1

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

Question 2

(A) Can a claim in the area of computer programs avoid exclusion under Article 52(2)(c) and (3) EPC 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?

epi observes the following with respect to both Question 1 and Question 2:

When the patentability test under Article 52(2) EPC is carried out separately, it appears that passing this test may merely depend on the particular wording chosen for the claim. In the opinion of **epi**, however, this is undesirable. In the view of **epi**, it should not depend on the clever wording of its claims whether an invention is considered patentable, but on the actual technical characteristics of its subject matter. It is the opinion of **epi** that the examination of Article 54 and 56 EPC in light of Article 52(1) and (2) EPC concentrates on novelty and inventive step of the technical characteristics of the claim taken as a whole and thus avoids any ambiguity that may be introduced by choosing a particular wording.

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?

It is the opinion of **epi** that when the claim is examined for novelty and inventive step as discussed above, it is ensured that its technical characteristics are identified. In the view of **epi** the requirement of technicality under Article 52(2) EPC is fulfilled for a claim whose technical characteristics are novel and inventive.

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 the programming thus contribute to the technical character of a 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?

The activity of programming a computer does not necessarily involve technical considerations (e.g. when implementing a business method). **epi** wishes to caution, however, that this does not mean that all programming should automatically be considered as being devoid of technical considerations. The examination pursuant to Article 54 and 56 EPC in light of Article 52(1) and (2) EPC concentrates on the novelty and inventive step of the technical characteristics of the claim.

79th **epi** Board meeting, 25.04.2009