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Patentability of Computer Implemented Inventions in Europe

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Computer Implemented Inventions in Europe

- EPO law
- The Law in Germany, France and the UK
- Harmonization?
- Allowable claim formats
- Bilski

The Landscape in Europe

The European Patent Office is a transnational body. The member states includes the member states of the EU as well as other states such as Eastern European states and Switzerland. The law of the EPO has been drafted so as to have the same effect as the national law of the member states. However, the law of the EPO is not binding on the member states and vice versa.

A recipe for divergence!

The Law of the EPO

- The European Patent Convention (EPC) is interpreted by the Technical Boards of Appeal. If decisions diverge only legal questions can be referred to the Enlarged Board of Appeal.

- No definition of an invention except that Art 52(1) EPC2000 states that patents must be allowed for inventions in “all fields of technology”

The Law of the EPO

- Art 52(2) – non-exhaustive list of things not an inventions, including
  - discoveries, scientific theories and mathematical methods
  - aesthetic creations
  - schemes, rules and methods for performing mental acts, playing games or doing business, and programs for computers
  - presentations of information

- Art 52(3) qualifies that Art 52(2) only applies to those things <u>as such</u>

- Technical Boards of Appeal have decided that the exclusions have in common that they relate to non-technical subject matter

EPO Law on CIIs

- Comvik (T641/00) is the current EPO test.
- Any technical means, even a pen and paper, in the claim will get past Art 52(2) and (3)
- The test is now an inventiveness test (Art 56)– a technical solution to a technical problem
- Non technical features (eg business methods, aesthetic features and mental processes) are ignored
    - cannot contribute to the technical solution
    - even considered as provided to the skilled person in the determination the solution of the technical problem

The Approach to Identify a 'Technical Contribution'

1. Identify the closest prior art

2. What are the differences between the invention and the prior art and the problem addressed by these differences/the invention that is not addressed in the prior art?

3. Is the problem technical? The field of the person who would be concerned with the problem should be identified. Is the field a technical field? Non-technical features cannot form part of the technical solution and have to be disregarded.

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The Law in the Member States

German Law on CIIs

- Decision of the Federal Court of Justice - May 2000 (OJ EPO 8-9/2002, 454)
- German patent application for a dialogue analysis device for natural language
- Patent refused by the Patent Office and the Federal Patent Court for no technical contribution (contribution in linguistics)
- Overturned on appeal
- Inadmissible mixing of arguments relating to inventive step with arguments relating to technicality
- An apparatus (computer) which is programmed in a specific way has technical character even if texts are edited on the computer
- This diverges from the EPO Comvik decision (T641/00)

French Law on CIIs

- Since there is no examination of inventive step if you pass the "invention" test you will get a patent
- It is then up to the courts to decide if it is obvious. There is no unified doctrine or case law – a lottery

  Infomil v Catalina – Method and Apparatus for Dispensing Discount Coupons

  - technical apparatus determined to be known
  - Patent was upheld – the claims cover a device permitting the delivery of coupons and not a method as such in the field of economics

  Sagem v INPI - Method for electronically ordering products at a sales outlet

  - Patent was refused – reasons not clear. Possibly because the claims were to a method

UK Law on CIIs

- ‘Technical’ does not appear in the UK law – judges have been reluctant to rely on it.
- Aerotel and Macrossan ([2006] EWCA Civ 1371) as modified by Symbian ([2008] EWCA Civ 1066) is the current binding authority
- New 4 step approach adopted

The Four Step Test

1. Properly construe the claim
2. Identify the actual contribution
3. Ask whether it falls within the excluded subject matter
4. Check whether the actual or alleged contribution is actually technical in nature

Note that following Symbian step 4 can be ‘conflated’ with step 4 – must ask whether the invention is technical in nature

Application by the UK IPO

- Identification of the contribution often requires the identification of the inventive step prior to determining if the invention is excluded
- The test is whether the contribution is technical. Non-technical features may be considered and may contribute to the inventive step
- Possibility for UK be more lenient than EPO
- In practice UK IPO takes a harder line on what they think is a ‘technical’ contribution
- But Symbian is a recent decision – only 2 decisions of UK IPO

The 'Confrontation' Between the UK and the EPO

- In the Aerotel and Macrossan decision a senior UK Appeal Court Judge LJ Jacob criticised the EPO approach specifically in Hitachi
  - not intellectually honest
- Mr Steinbrener was the Chairman of the TBA in Hitachi and has since written a treatise explaining the history of the EPO approach, why it is correct and consistent and why the the judge had missed the point! (Duns T154/04 Nov 2006)

- For a good read I recommend Aerotel and Macrossan followed by Duns.

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Harmonization?

The Failed EU Directive

- After a long consultation period the European Commission published a Proposed EU Directive on the Patentability of CIIs in Feb 2002
- The proposal generally endorsed the EPO approach
- A large response from the Open Source community and FFII
- Far reaching amendments were fought over – it became ugly
- At the vote of the EU Parliament in the Summer of 2005 the Proposed Directive was rejected – rather no Directive than a bad one!

So What are the Problems?

- The European Commission has no appetite to revisit this
- The EPO and UK (and others) diverge
- The UK House of Lords rejected the opportunity to review this issue of law in Aerotel and Macrossan
- The UK Court of Appeal asked the EPO President to refer the issue to the EBA and this was refused
- The EPO believes it has it right but it does not bind the member states
- The UK is bound by the Aerotel and Macrossan and Symbian cases until this issue goes to the House of Lords

The Solution?

- The President of the EPO has, of her own volition, referred the issue of the computer programs exclusion to the Enlarged Board of Appeal (G 3/08)
- The referral takes the form of questions
- Third party submissions (Amicus Briefs) can be submitted by end of April 2009

The Questions

- Are they only excluded is claimed as programs?
- Is it sufficient to mention use of a computer or medium?
- If not, is a further technical effect necessary – beyond inherent effect?
- Must a claimed feature cause a technical effect on a physical entity to contribute to the technical character?
- If so, can it be an unspecified computer?
- If not, can the effect be independent of any hardware
- Does programming necessarily involve technical considerations?
- If so, do all programming features contribute to the technical character?
- If not, can programming features contribute to the technical character only when they contribute to the further technical effect?

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Allowable Claim Formats

Carrier Medium Claims

- If computer implemented method and/or apparatus claims allowed, claims are allowed to:

  a computer program per se

  a storage medium storing a computer program

  a signal carrying a computer program
- (following IBM T935/97 and T1173/97 and BBC T163/85)

- Practical tips
  - claim a carrier medium carrying computer readable code (infringement effect of a claim to a computer program unsure)
  - Use a dependent claim: A carrier medium carrying computer readable code for controlling a computer to carry out the method of any one of claims X to Y – saves claims fees

Other Claims

- Means-plus-function broadest apparatus claim – no 35 USC §112 equivalent

- Article 84 requires there to be a minimum number of independent claims – usually one method claim and one apparatus claim but there are exceptions. eg

  A secure communication system – claims allowable for:

  The system as a whole and the method of operation of the system

  A transmission apparatus and a method performed by the transmission apparatus

  A receiving apparatus and a method performed by the receiving apparatus

  A signal securely encoded as transmitted

  A computer program for operating the transmission apparatus

  A computer program for operating the receiving apparatus

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Bilski

Would the Bilski Invention be Patentable in Europe?

A method for managing the consumption risk costs of a commodity sold by a commodity provider at a fixed price comprising the steps of:

(a) initiating a series of transactions between said commodity provider and consumers of said commodity wherein said consumers purchase said commodity at a fixed rate based upon historical averages, said fixed rate corresponding to a risk position of said consumer;

(b) identifying market participants for said commodity having a counter-risk position to said consumers; and

(c) initiating a series of transactions between said commodity provider and said market participants at a second fixed rate such that said series of market participant transactions balances the risk position of said series of consumer transactions

Would the Bilski Invention be Patentable in Europe?

- EPO – The claim is not limited to any technical means. Fails Art 52(1) not in a field of technology.
- UK – The contribution clearly relates solely to a business method. Excluded under Section 1(2).
- France – following Sagem, method claims with no technical means likely to be excluded.
- Germany – no technical means and hence no technical character - excluded

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