



Bulletin

EPO Enlarged Board Asked to Clarify Law on Patents for Computer Programs

For several years, the UK Intellectual Property Office (UKIPO) and European Patent Office (EPO) have been applying divergent interpretations of essentially identical patent legislation. UK patent law and the European Patent Convention (EPC) both state that certain things are not to be regarded as inventions for which a patent can be granted and that one of those things is “programs for computers”. However, patentability is excluded only to the extent to which the patent application or patent relates to a program for a computer “as such”.

In 2006, the UK Court of Appeal openly criticised the way a number of recent decisions of the EPO had interpreted these provisions.ⁱ The court suggested that the decisions were “mutually contradictory” and used an approach that was “not intellectually honest”, and recommended that the president of the EPO refer some questions on the issue to the Enlarged Board of Appeal, the highest law-making authority within the EPO. Subsequent decisions of the EPO were equally scathing of the approach taken in the UK, saying that it was “irreconcilable” with the EPC and “not consistent with a good-faith interpretation” of it.ⁱⁱ Alain Pompidou, then president of the EPO, also rejected the call from the UK courts to refer the matter to the Enlarged Board.

More recently, however, the EPO and the UK courts have mellowed in their attitude towards one another. A Court of Appeal judgment issued on 8 October 2008,ⁱⁱⁱ while refusing to adopt the EPO approach nevertheless highlighted the similarities rather than the differences between the two interpretations. The judgment called for two-way dialogue and mutual compromise between national courts and Patent Offices and the EPO in order to ensure that the differences in outcomes were minimised even if the differences in approach could not. Shortly after this, on 22 October 2008, the new EPO president and former Chief Executive of the UKIPO, Alison Brimelow, put a number of questions to the Enlarged Board,^{iv} citing the fundamental importance of the point of law in question and expressing the desire for improved clarity concerning the limits of patentability in the field of computing

The questions that have been put to the Enlarged Board are 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) merely by explicitly mentioning the use of a computer or a computer-readable data storage medium?

Question 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?

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?

Question 3(B): If question 3(A) is answered in the positive, is it sufficient that the physical entity be an unspecified computer?

Question 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?

Question 4(A): Does the activity of programming a computer necessarily involve technical considerations?

Question 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?

Question 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?

This referral is pending as G3/08, but there has so far been no official response to it from the Enlarged Board. It is possible that they will refuse to answer the questions if they decide that there is no clear divergence between decisions of the Boards of Appeal. Even if they do consider the questions, it is likely to be at least a year and quite possibly longer before any answers are provided.

In the meantime, while the different interpretations and approaches do result in an ongoing lack of clarity at the boundary between patentable and unpatentable subject matter, it is encouraging to hear the UK Court of Appeal highlighting that, in general terms, the extent of the computer program exclusion is quite well settled.

Boult Wade Tennant

ⁱ *Aerotel Ltd v Telco Holdings Ltd & Ors and Neal William Macrossan's Application* [2006] EWCA 1371 (Civ)

ⁱⁱ *Estimating sales activity / Duns Licensing Associates*, T 0154/04

ⁱⁱⁱ *Symbian Ltd v Comptroller General Of Patents* [2008] EWCA 1066 (Civ)

^{iv} Referral to the Enlarged Board of Appeal under Article 112(1)(b) EPC, pending as G3/08

This information has been prepared by Boult Wade Tennant.

For further information please contact Geoff Dallimore or your usual adviser.

Verulam Gardens
70 Gray's Inn Road
London WC1X 8BT
United Kingdom

tel +44 (0)20 7430 7500
fax +44 (0)20 7430 7600
email boult@boult.com

www.boult.com