International and comparative law of patents, trade secrets and related rights

Section D: Current issues in international patent law and policy

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Contents

> 3. The provisions of paragraph 2 shall exclude patentability of the subject-matter or activities referred to in that provision only to the extent to which a European patent application or European patent relates to such subject-matter or activities as such.

The exclusion of computer programs as such is not the only restriction on

- A technical invention does not lose its technical character simply because it is used for a non-technical purpose such as a business method.
- A method claim is patentable so long as it is technical.
- An apparatus (or product) claim, even if it is a computer as programmed, cannot be an example of excluded matter since such things are not mentioned in Article 52(2) of the EPC.

There are now three versions of the hardware approach:

- . If the claim relates to a method which consists of excluded subject matter, it is excluded even if hardware is used to carry out the method. A claim relating to the apparatus (such as a computer as programmed) is not excluded, but is bad for lack of inventive step because the notional skilled person must be taken to know about the improved, excluded method.
- T258/03 [2005] EPOR 55. A claim to hardware is necessarily not caught by Article 52(2). A claim to a method using that hardware is also not within the excluded matter. But either type of claim is bad for lack of inventive step for the reason described above.
- T424/03 [2006]. It is proper to ask whether the claim is for something concrete (like hardware/apparatus). If it is then Article 52(2) does not apply, but inventive step, novelty and so forth should be applied in the normal way.

These cases demonstrate the desire of the EPO to bypass the exclusions under Article 52 and to consider only inventive step and novelty. The correct approach, it has recently been suggested,[2] is that something which is technical falls outside the exclusion, and so what is necessary is to identify a technical problem.

[1] *In* DUNS Licensing *Z1//5\ NI DON 35-*

5.2 Approach in the United Kingdom

In the United Kingdom, the law is presently in a state of some flux. In v [2006] EWCA Civ 1371 it was believed that some clarity had been brought the field and the correct approach to computer programs had been identified. In v [2008] EWCA Civ 1066 the Court of Appeal endorsed .

does not represent a departure from previous UK practice; rather, it is a return to the earlier decision of the Court of Appeal in [1989] RPC 561. This decision endorsed the EPO's decision in and introduced the technical contribution requirement to British law. This technical contribution approach was applied in [1991] RPC 305, an application for a method of calculating a square root where the court held that this was simply a method of doing a mental act. Similarly, in [1997] RPC 608 a claim for a method and apparatus for modelling synthetic crystal structures of inorganic materials was rejected on the basis that the program was merely a method of displaying an image faster than could be done with a physical model. leaves these decisions in place and provides a four-step approach to the exclusion:

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

In , 545 F 3d 943 (Fed Cir 2008) the liberal approach of was criticised and the court reiterated the machine or transformation test. This means that the invention must be either tied to a particular machine or apparatus, or transform a particular article into a different state or thing. The case has now been appealed to the Supreme Court and has attracted many amicus briefs from those interested in the issue. The decision of the Supreme Court will be significant for patenting within the United States, but it may also have implications beyond.

Activity 5.2

Do you think the US approach to the patenting of computer software would be well received in Europe?

No feedback available.

Reminder of learning outcomes

Now that you have studied this chapter and the related readings, you should be able to:

- explain the problems under the European Patent Convention
- discuss the developments in the practice of patenting computer software in:
  - the European Patent Office
  - the United States
  - the United Kingdom
- outline the history of patenting software from the 1960s until today
- discuss the issues surrounding the debates over the patenting of computer software.

Self-assessment questions

- Which exclusions under Article 52 of the EPC might be relevant to computer-implemented inventions?
- How should a claim for a computer-implemented invention be interpreted according to *@dqnsdk*?
- In practice do you think the approach of the EPO and the USPTO are the same?

Feedback to activities

Activity 5.1 *Xnt rgntkc hcdmshex sgd entq `ooqn`bgdr rds nts hm sgd @oodmchw sn the* Aerotel *cdbhrhnm-Xnt rgntkc `krn I dmshnm sg`s sgd TJ rshkk `ookhdr sgd sdbgmhb`k bnmsqhatshnm sdrs+ ats sgd DON fdmdq`kkx `ookhdr ` I nqd khadq`k sdrs a`rdc nm k`sdq b`rdr such as* PBS+ Hitachi *and* Microsoft.

Activity 5.2 *No feedback provided.*