ARE Patent Law Alert:
The Enlarged Board of Appeal of the European Patent Office Declines to Provide Further Guidance on the Patentability of Computer-Implemented Inventions Under the European Patent Convention

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(May 18, 2010) On May 12, 2010, the Enlarged Board of Appeal (EBoA) of the European Patent Office (EPO) issued an Opinion addressing a set of questions concerning the patentability of computer-implemented inventions under the European Patent Convention (EPC). *Opinion of the Enlarged Board of Appeal*, EPC No. G 3/08 (Slip op. 12 May 2010). The questions were referred to the EBoA by the EPO President under Article 112(1)(b) EPC. In its Opinion, rather than answering the questions, the EBoA dismissed the referral as inadmissible for failing to meet the requirements of the EPC. In doing so, the EBoA passed up an opportunity to provide further guidance and clarity as to the limits of patentability in this important field.

Article 52 EPC

The language of the EPC does not define the limits of the patentability of computer-implemented inventions. On one hand, under Article 52(1) EPC, "European patents shall be granted for any inventions, *in all fields of technology...*" (emphasis added). On the other hand, Article 52(2)(c) EPC provides that "programs for computer" shall not be regarded as "inventions" within the meaning of Article 52(1) EPC. The scope of this exclusion is limited by Article 52(3) EPC, which provides that the patentability of "programs for computer" shall be excluded "only to the extent to which a European patent application or European patent relates to such subject-matter or activities as such." (emphasis added). However, the language of Article 52(3) EPC does not provide clear guidance as to when "programs for computer" can be regarded as patentable inventions.

EPO Case Law

The case law of the EPO's Boards of Appeal has not provided definitive and uniform guidance on this issue, either. For example, the Board in *T 1173/97 Computer Program Product/IBM* (OJ EPO 10/1999, 609) held that programs for computers are patentable when they have "technical character," focusing on the function of the computer program as the determining factor for the patentability. However, the Board in *T 424/03 Clipboard Formats/Microsoft* instead focused on the manner in which the computer program is claimed, distinguishing a method implemented in a computer system from a computer program.

Referral Under Article 112(1)(b) EPC

Under Article 112(1)(b) EPC, "[i]n order to ensure uniform application of the law, or if a point of law of fundamental importance arises: . . . the President of the European Patent Office may refer a point of law to the Enlarged Board of Appeal where two Boards of Appeal have given different decisions on that question." Accordingly, on October 22, 2008, the President of the EPO referred the following set of questions to the EBoA in an attempt to obtain further clarity in this area:

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

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?

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?

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?

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

3(C). If Question 3(B) 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?

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

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?

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?

EBoA Dismissal

In an Opinion issued on May 12, 2010, the EBoA dismissed the EPO President's referral as inadmissible under Article 112(1)(b) EPC since the EBoA could not identify any "different decisions" in the case law supporting the referral, as required by the EPC. "A referral is justified only if at least two Board of Appeal decisions come into conflict with the principle of legal uniformity." (7.3.1). While the EBoA recognized a divergence between the two

decisions by the Technical Boards of Appeal, *T 1173/97, IBM* and *T 424/03, Microsoft*, the EBoA concluded that "this is a legitimate development of the case law and . . . there is no divergence which would make the referral of this point to the Enlarged Board of Appeal by the President admissible." (10.12).

Conclusion

By dismissing the EPO President's referral as inadmissible based on a procedural defect, the EBoA missed an opportunity to provide much-needed guidance and clarity to the limits of patent eligibility of computer-implemented inventions under the EPC.

We continue to monitor the development of the law on the patentability of computer-implemented inventions in Europe. Please check our website for additional reports on this issue. For further information on how this issue could impact your business in Europe, please contact one of our attorneys.

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Mr. Macedo was principal attorney, along with Amster Rothstein & Ebenstein partner Anthony Lo Cicero and associate Jung S. Hahm on an amicus curiae submission to the Federal Circuit in *In re Bilski* and was principal attorney, along with Amster Rothstein & Ebenstein LLP partner Anthony Lo Cicero and associate Norajean McCaffrey on an amicus curiae submission to the U.S. Supreme Court in *Bilski v. Kappos*.