28 April 2009


Registry
Enlarged Board of Appeal
European Patent Office
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Dear Sirs

**Case G3/08: Referral under Art. 112(1)b) EPC by the President of the EPO (Patentability of programs for computers) to the Enlarged Board of Appeal**

This Written Statement is submitted by Intellect under Article 10 of the Rules of Procedure of the Enlarged Board of Appeal in response to the Referral under Article 112(1)(b)EPC by the President of the European Patent Office dated 22 October 2008 ("the President's Referral").

Intellect is the UK trade association for the IT, telecoms and electronics industries including the consumer electronics industry and the fixed, mobile and satellite telecommunications industries. Its members account for over 80 per cent of these markets and include blue-chip multinationals as well as early stage technology companies. These industries together generate around 10 per cent of UK GDP and 15 per cent of UK trade.

On 27 April 2009, DIGITALEUROPE (formerly EICTA) submitted a Written Statement to the Enlarged Board of Appeal submitting that the above Referral was inadmissible and adducing the argument that the current jurisprudence of the European Patent Convention (EPC) achieves the necessary certainty concerning the patentability of computer programs whilst preserving enough flexibility to cope with advancements in technology.

Specifically, DIGITALEUROPE pointed out that the question of patentability of computer programs under the EPC was raised in 2006 when the Rt. Hon. Lord Justice Jacob of the English Court of Appeal suggested that the President of the EPO should refer questions on the patentability of software to the Enlarged Board of Appeal after the Court of Appeal's 2006 decision in Aerotel/Macrossan.[1]

The then President of the EPO, Dr. Alain Pompidou, replied to Jacob LJ in March 2007 that there was:
> "…insufficient legal basis for a referral under Article 112(1)(b) EPC. Leaving aside Board of Appeal case law the line of reasoning of which has been abandoned by later case law, I believe there are insufficient differences between current Board of Appeal decisions dealing

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[1] [2007] RPC 7.

with Article 52 EPC exclusions on important points of law that would justify a referral at this stage."

There has been no significant change in the law since then. Indeed, the Board of Appeal decisions referenced in the President's Referral all predate Dr. Pompidou's reply.  Dr. Pompidou's conclusion that there are insufficient differences to justify a referral remains as true now as it was in March 2007.

Intellect would respectfully submit, therefore, that as there is an absence of a real conflict between decisions of the Boards of Appeal the President's Referral is inadmissible and should be rejected, following the precedent set in G3/95.

In addition, Intellect submits that the Referral could have the effect of upsetting the trend, set over many years, of national case law and practice converging with EPO jurisprudence on this issue, thereby lending greater certainty to patenting practice in Europe, both at the European Patent Office and in national patent offices, and hence encouraging invention, enhancing legal certainty, and reducing the cost of protection and enforcement.

Although, since the Aerotel/Macrossan decision in 2006, UK national case law and more especially the practice in the UK-IPO has seemed somewhat at odds with that of the EPO and indeed with other European national jurisprudence, in October 2008 the UK Court of Appeal handed down an important decision in the Symbian case[2] which has had the effect that UK case law is once again tending to converge with the jurisprudence of the EPO Board of Appeals.  Importantly, this should have the practical effect of aligning UK-IPO practice more closely with EPO practice once again.

In conclusion, Intellect submits that, as there is no real conflict between decisions of the Boards of Appeal, and taking a holistic view of the trends in jurisprudence and in patenting practice in this area throughout Europe, **the Referral should be rejected on the basis that it is inadmissible**.

That said, in the event that the Referral nevertheless progresses, then Intellect makes the following observations regarding the four questions raised:

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

Intellect's observation here is that the answer to this question ought to be "no", a computer program cannot only be excluded as a computer program as such if it is claimed as a computer program. This is because any computer related invention that does not possess a technical character is excluded, irrespective of the manner in which it is claimed.

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[2] [2008] EWCA Civ 1066

**Question 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?*

Intellect's observation here is that the answer to this question ought to be "yes", a claim in the area of computer programs avoids exclusion under Art. 52(2)(c) and (3) merely by explicitly mentioning the use of a computer or a computer-readable data storage medium.
This is because, with the addition of a computer or computer storage, the invention now possesses a technical character and is therefore not excluded.

*(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?*

In the event that an answer of "no" is contemplated for Question 2(a), then Intellect's observation is that the answer to Question 2(b) ought also to be "no", a further technical effect is not necessary to avoid exclusion [under Art. 52(2)(c) and (3)]. Any such technical effect should then be factored into judgment of the invention under Articles 54 and 56 in relation to the relevant state of the art.

**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?*

Intellect's observation here is that the answer to this question ought to be "no", a claimed feature need not cause a technical effect on a physical entity in the real world in order to contribute to the technical character. The entity affected need not be in itself physical, but could simply be data.

*(a) If question 3(a) is answered in the positive, is it sufficient that the physical entity be an unspecified computer?*

In the event that an answer of "yes" is contemplated for Question 3(a), then Intellect's observation is that the answer to Question 3(b) ought also to be "yes", it is sufficient that the physical entity be an unspecified computer.

*(b) 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?*

In the event that an answer of "no" is contemplated for Question 3(a), then Intellect's observation here is that the answer to Question 3(c) ought to be "yes", features can contribute to the technical character of the claim if the only effects to which they contribute are independent of any particular hardware. A technical contribution can for example be made in the organization of data or in the form of a transmission signal, independent of hardware used to process the signal or data.

**Question 4**

*(a) Does the activity of programming a computer necessarily involve technical considerations?*

Intellect's observation here is that the answer to this question ought to be "no", the activity of programming a computer does not necessarily involve technical considerations. Some user interfaces are such that a computer can be instructed to perform a task without any technical insight.

*(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?*

In the event that an answer of "yes" is contemplated for Question 4(a), then Intellect's observation here is that the answer to Question 4(b) ought to be "no", all features resulting from programming do not thus contribute to the technical character of a claim. For example, features resulting from programming that amount to no more than excluded subject matter make no contribution to technical character.

*(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?*

In the event that an answer of "no" is contemplated for Question 4(c), then Intellect's observation here is that the answer to Question 4(c) ought to be "no", any features resulting from programming that contribute to the technical character of a claim can render the claim patentable. What is important, in Intellect's view, is that the features resulting from programming that contribute to the technical character should be factored into judgment of the invention under Articles 54 and 56 in relation to the relevant state of the art.

Yours faithfully

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