

EPO patentability of Computer Related Inventions, an Update

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The Enlarged Board of Appeals of the EPO issued a decision today relating to patentability of computer related inventions. See "Case Number: G 0003/08 "OPINION of the Enlarged Board of Appeal of 12 May 2010 in relation to a point of law referred by the President of the European Patent Office pursuant to Article 112(1)(b) EPC".

Unfortunately, the Enlarged Board failed to define "technical", which is a word used in its analysis whether a claimed invention is patentable. In this respect, it stated:

9.2 The term "technical"

We do not attempt to define the term "technical". Apart from using this term in citing the case law, in what follows the Enlarged Board only makes the assertions that "a computer-readable data storage medium" and a cup have technical character and that designing a bicycle involves technical considerations, in order to be able to explore the consequences of that case law. It is to be hoped that readers will accept these assertions without requiring a definition of exactly what falls within the boundaries of "technical". This question is discussed in some more detail for the particular case of programs for computers in the section relating to Question 4 (see point 13 below).

The Enlarged Board considered 4 questions, but it found its case law on questions 2-4 not divergent and therefore only rendered a decision on question 1. I present below Question 1 and the Enlarged Boards' answer to that question.

10. Question 1

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

The Enlarged Board's answer is:

10.13 The present position of the case law is thus that (phrasing the conclusion to match Question 2 of the referral) a claim in the area of computer programs can avoid exclusion under Articles 52(2)(c) and (3) EPC merely by explicitly mentioning the use of a computer or a computer-readable storage medium. But no exposition of this position would be complete without the remark that it is also quite clear from the case law of the Boards of Appeal since T 1173/97 that if a claim to program X falls under the exclusion of Articles 52(2) and (3) EPC, a claim which specifies no more than "Program X on a computer-readable storage medium," or "A method of operating a computer according to program X," will always still fail to be patentable for lack of an inventive step under Articles 52(1) and 56 EPC. Merely the EPC article applied

is different. While the Enlarged Board is aware that this rejection for lack of an inventive step rather than exclusion under Article 52(2) EPC is in some way distasteful to many people, it is the approach which has been consistently developed since T 1173/97 and since no divergences from that development have been identified in the referral we consider it not to be the function of the Enlarged Board in this Opinion to overturn it, for the reasons given above (see point 7.3.8).

Thus, the Enlarged Board slightly relaxed the limitations on patentability of computer related inventions.

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