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# EPO ENLARGED BOARD REFERRAL ON SOFTWARE PATENTS

The President of the European Patent Office (EPO), Alison Brimelow, has recently referred[1] to the Enlarged Board of Appeal a number of questions relating to the application of the exclusion of computer programs under Article 52(2)&(3) of the European Patent Convention. These questions may be of key importance to the patentability of computer-implemented inventions (CIIs), and in particular to whether claims directed to software are allowable in Europe.

### *Background*

Under current EPO case law, patent claims to inventions that would be carried out by means of software are in principle allowable, provided that a "further technical effect" can be demonstrated, generally interpreted as meaning an effect that goes beyond the conventional interactions between computer software and hardware[2]. EPO case law has shown that claims to computer programs themselves can also be allowable, provided these are specifically directed to an allowable method. For example, since a novel and inventive (i.e. non-obvious) method of transforming digital images (e.g. for compression or an improvement in picture quality) can in principle be patentable, a claim to a computer program for carrying out the identified method would not be objected to.

### *UK & EPO approaches*

Over the past few years, there has been a degree of discrepancy between how CIIs are treated at the EPO as compared with the UK Intellectual Property Office (UK-IPO). In 2006 this resulted in a number of questions being proposed to the EPO by the UK Court of Appeal (in *Aerotel/Macrossan*[3]) for consideration by the Enlarged Board. These questions were subsequently rejected by the then EPO president and by an EPO Technical Board of Appeal[4]. Since then, the UK courts have looked again at questions relating to patentability of CIIs. A recent Court of Appeal decision (*Symbian*[5]) has emphasised that the UK approach should be substantially in line with that of the EPO.

### *The Referral*

According to the President, diverging decisions of the EPO Boards of Appeal have created uncertainty, and the referral is necessary to enable the "harmonious development of case law in this field". The referral seeks guidance on how the exclusions under Article 52(2) and (3) EPC are to be applied, with a hope that this will lead to greater clarity concerning the limits of patentability. The questions[6] address four different aspects of patentability in this field, in particular: i) whether explicit claims to computer programs are allowable; ii) whether exclusion can be avoided by the mere mention of a computer or a computer-readable storage medium; iii) whether a technical effect on a physical entity in the real world is required; and iv) whether the field of computer programming is inherently technical. In general terms, the questions appear to be an attempt to seek a definition for the word "technical", which is used by the EPO to define the boundaries of patentability.

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[1] http://www.epo.org/topics/news/2008/20081024.html
[2] See for example the Technical Board of Appeal decision of T 1173/97
[3] *Aerotel Ltd. v Telco Holdings Ltd & Ors Rev 1* [2006] EWCA Civ 1371 (27 October 2006)
[4] *Duns Licensing*, T 154/04.
[5] *Symbian Ltd v Comptroller General of Patents* [2008] EWCA Civ 1066 (08 October 2008)
[6] http://www.epo.org/patents/appeals/pending.html

### *Implications*

Since the referral raises key questions that may potentially affect a large number of patent applications, it is possible that prosecution of CII applications before the EPO will need to be suspended pending the outcome of the Enlarged Board's decision (which may take some time to issue). The EPO has, as yet, given no indication of whether or when the suspension would occur. At present, the referral itself does not change EPO practice, and it is not even certain whether the referral will be judged to be admissible by the Enlarged Board, since the Enlarged Board has first to decide whether there is a divergence of decisions by the Technical Boards of Appeal.

The information in this Newsletter was correct at the date of release. More up to date information is available by contacting Potter Clarkson LLP. All comments contained here are of a general nature and full professional advice should be sought on any specific problem. Please note that all our Newsletters can be found on our website at www.potterclarkson.com.
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