

**COMPUTER SOFTWARE PATENTS:
“MEDIA CLAIMS”**

Two recent decisions from the European Patent Office Technical Boards of Appeal (T935/97 and T1173/97) have confirmed that patent claims to a “computer program product” or to a “computer program code” are not excluded from patentability, providing that a technical effect could be realised from execution of the program.

In both decisions, the Boards of Appeal concluded that a computer program claimed by itself is not excluded from patentability if the program, when loaded into a computer, is capable of bringing about a technical effect which goes beyond the normal physical interactions between the program (software) and computer (hardware) on which it is run.

In other words, if a computer, when suitably programmed, provides the necessary “technical effect” for it to be allowable subject matter for a patent claim at the European Patent Office, it is now confirmed that the program claimed by itself, or as a record on a carrier, is also allowable subject matter. What constitutes “technical effect” has, of course, been the subject of much European case law over a number of years.

One of the Boards of Appeal commented that it could see no good reason for distinguishing between a direct technical effect from a suitably programmed computer, and the potential to produce that technical effect by the computer program product.

We conclude that the bar on patenting of computer programs “as such”, provided in EPC Article 52(2)(c) and (3), must now be interpreted as applicable only to a computer program not capable of giving rise to the required technical effect.

Various potentially allowable claim formats, included in the decisions, have been remitted back for re-examination.

Although the Boards of Appeal stressed that the decisions were not in conflict with earlier EPO case law, there are potential conflicts with earlier national decisions. Thus it is by no means certain that all national courts will follow this decision and uphold such claims in validity proceedings.

The information in this Newsletter was correct at the date of release. More up to date information is available by contacting Eric Potter Clarkson. All comments contained here are of a general nature and full professional advice should be sought on any specific problem.

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