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**STANDING ADVISORY COMMITTEE  
BEFORE THE EUROPEAN PATENT OFFICE**

33<sup>rd</sup> meeting

Munich, 27 - 28 June 2002

**Subject** : Proposal for an EC Directive on the patentability of computer-implemented inventions

**Drawn up by** : European Patent Office

**Addressees** : Members of SACEPO (for comment)

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**SUMMARY**

This document contains a succinct analysis of the proposed directive and a first provisional assessment.

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**Background:** *Proposal* for a Directive on the patentability of computer-implemented inventions of 20 February 2002 . The full text of the proposal is attached as *Annex1*.

### **Contents of the proposal**

The proposed directive aims at creating uniform standards for patenting computer-implemented inventions featuring new software, e.g. a computer program, on the basis of patent law in Europe as it stands, i.e. without affecting Article 52 (2) and (3) EPC excluding computer programs from patent protection, where claimed as such.

The proposal is largely based on current EPO practice and case law (Boards of Appeal), especially relying on the "technical contribution approach". Computer-implemented business methods would not be patentable *per se*.

Main difference from current EPO practice: Claims for computer programs as such, when stored on a carrier or in the form of a "program product"(as admitted by the IBM decision T1173/97) should not be allowable.

### **Provisional assessment**

The proposal is broadly in line with the current practice of the EPO and some EPC contracting states and will help clarify the legal situation in Europe, if properly drafted. A provisional assessment of the proposed rules and some suggestions for drafting them are given below.

A strong "fundamentalist" lobby (open source community, Eurolinux) opposing patent protection of software-related inventions would like to see this opposition reflected in the directive, while the patent community, in principle, welcomes the initiative but not without criticism as to the contents of the proposal, particularly the envisaged ban on computer program claims.

Discussion on the proposal in the EC Council (Working Party on Intellectual Property) and European Parliament (Committee on Legal Affairs) has commenced only recently. The EPO will be involved in the deliberations of the Council Working Party as an expert of the EU Commission.

## Key elements of the proposal compared to EPC and EPO practice

- **Computer-implemented invention“ (CII)**

Art. 2(a) = based on EPO Guidelines C-IV, 2.3

Suggested wording:

*„computer-implemented invention“ means any invention ~~[the performance of which]~~ involving the use of a computer, computer network or other programmable apparatus ~~[and having one or more prima facie novel features]~~ which is realised wholly or partly by means of a computer program or computer programs“*

- **„Technical contribution“** - Art. 2(b)

= based on EPO practice

Suggested wording:

*„technical contribution“ means a contribution to the state of the art in a ~~[technical]~~ field ~~[which is not obvious to a person skilled in the art]~~ of technology.“*

- **CII belongs to a field of technology** - Art. 3

= EPO practice, Art. 52(1) rev. EPC

- **CII patentable** if new, inventive and industrially applicable

Art. 3(1) = Art. 52(1) EPC

- **CII may involve an inventive step, only if it makes a**

**„technical contribution“** – Art. 4(2)

= EPO practice and case law

- **Assessing the technical contribution** – Art. 4(3)

consider difference between scope of the claim as a whole (technical and non-technical features) and the prior art

= basis and contents not entirely clear

Suggested wording:

*„The technical contribution shall be ~~[assessed by consideration of the difference between the scope of the patent claim]~~ determined on the basis of the subject-matter claimed, considered as a whole, ~~[elements of]~~ which may comprise both technical and non-technical features. ~~[and the state of the art.]~~*

- **Form of claims for CII – Art. 5**  
**Claims allowable for**

**product**, i.e. programmed computer etc.

**process**, i.e. process carried out by a computer  
etc. through the execution of software  
= *EPO practice*

**Claims unallowable (?) for**

**Computer program per se, as record on a carrier or program product**  
≠ *EPO practice!*

Implications for enforcement of CII

- **Open questions to be addressed in Directive**

**How to assess whether or not there is a „technical contribution“?**

EPO approach (Guidelines C-IV,2.3 Programs for computers *in fine*)

*„In assessing whether there is an inventive step, the examiner must establish an **objective technical problem** which has been overcome. The solution of that problem constitutes the invention's technical contribution to the art. The presence of such a technical contribution establishes that the claimed subject-matter has a technical character and therefore is indeed an invention ... If **no such objective technical problem** is found, the claimed subject-matter does **not satisfy at least the requirement for an inventive step** because there can be **no technical contribution to the art ...**“*

**Make clear that mere computer implementation of a *per se* non-technical method** such as business method **does not** involve a „technical contribution“

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