

Wsthoff 2001: Strategic Advice to Banks on Business Method Patents in Europe

<http://swpat.ffii.org/papri/wuesthoff-bm01/index.en.html>

Workgroup

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A prestigious german patent law firm explains that US business method patents can in most cases be europeanised without much difficulty, because the “technical contribution” requirement does not present a real obstacle. They estimate the costs of researching which business method patents a bank may be infringing to around 2 manyears of work by professionals in the fields of patent law and data processing, plus costs for licensing negotiations and buildup of a defensive patent portfolio.

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[...]

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*<http://lists.ffii.org/mailman/listinfo/traduk>

see <http://www.wuesthoff.de/en/topic/index.php> (currently not available there due to a redesign but you can obtain it from Alexander Maron by mail to wuesthoff at wuesthoff de.)

The statement above originates from the acclaimed German IP law firm “Wuesthoff & Wuesthoff”:

According to a survey of the British Journal Managing Intellectual Property, the firm has been consistently rated, in recent years, by lawyers and corporate counsels world-wide, amongst the top five firms in Germany, out of several hundred IP firms.

see <http://www.wuesthoff.de/en/portrait/index.php>

In the last section before the Annex, they say:

V. Strategic Considerations

Recently my firm had to explore the patent situation world-wide for one the major banks. All existing U.S. patents and all published European patent documents have been searched regarding any potential risk for the banking business. The search was performed on the basis of a profile combining both the leading banks, service providers in that field and also key-terms relevant in the field of banking. The search revealed more than 5000 patent documents which could possibly have an impact on the activities of the bank. The next step will be to evaluate those patents regarding scope of protection and the possible relevancy. The task being a list of patents which might be infringed by the bank’s business. Possible counter-measures are envisaged in a next step (oppositions, negotiations etc.).

It is assumed that the evaluation of all patents will need two or three patent experts, combined with two or three IT-experts from the bank itself and a time period of three to six months. This is the “defensive” measure. As an “offensive” measure it is advisable that banks start filing patent applications wherever possible and promising. Of course, the liberal practice in the U.S. requires to file almost any business method for patent. These business methods are always implemented by a computer (I have not seen any other example). This computer implementation in most cases gives the opportunity to look for some sort of a “technical effect” or “technical consideration” or “technical problem” etc. which might help to obtain a European patent, in the long run. When studying a business method computer software program it turns out that in most cases that program includes at least one aspect (feature) which might qualify under the European standards as “technical”. It is an advisable measure for any bank these days to try to develop a patent portfolio in order to have at least some arguments in hand when approached by others for patent infringement.