



Protection of Software-related Inventions under European Laws & Practice

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Principles of Eligibility/Patentability of Inventions under European Patent Convention (EPC) and German Patent Act (GPA)

- Patent for inventions on all fields of technology (only)?
 - ◆ Technicality required (Art. 1 EPC and GPA)
- Novelty and inventiveness depending on technical contribution
 - ◆ „Technical“ not restricted to „hardware“
- Software as such not eligible

Patentability of Computer Implemented Inventions at EPO - I -

- Since decision „Auction method/Hitachi“ (T258/03) of April 21, 2004, practice of EPO rather liberal, namely:
 - ◆ Invention not related to merely computer software „as such“, if in patent claim at least one technical element (like „computer“)
 - ◆ When determining novelty/inventiveness, only such features of patent claim giving technical contribution are to be taken into consideration
 - ◆ Example: CD carrying new business software not novel
 - ◆ Example: Laptop with new operation software, increasing e.g. processing speed, patentable

Patentability of Computer Implemented Inventions at EPO - II -

- President of EPO had presented Hitachi case law to Enlarged Board of Appeal on October 23, 2008, case handled under „G03/08“ at Enlarged Board of Appeal
 - ◆ Allegation of President of EPO that non-uniform case law has been created by TBAs of EPO
 - ◆ Opinion of President of EPO controversially discussed in EPO and by scholars, as well as public
 - ◆ Opinion/decision of Enlarged Board of Appeal of May 12, 2010: No non-uniform case law by TBAs exists. Therefore, EBA has refused to handle the case
- Opinion/decision of EBA of May 12, 2010, means that liberal practice according to „Hitachi“ remains in force at EPO

Patentability of Computer-Implemented Inventions in Germany

- On April 22, 2010, decision Xa ZB 20/08 „Dynamic Generation of Documents“ of German Federal Court of Justice (GFCJ) issued.
 - ◆ Decision Xa ZB 20/08 has stated that presence of at least one technical (hardware) feature in a patent claim, otherwise directed to software features, makes subject matter eligible for patenting.
 - ◆ If comparing combination of features of a claim with technical/hardware and software features is compared with prior art (for determining novelty and inventiveness), only such features can create novelty/inventiveness which contribute to overall technical effect.
 - ◆ Decision Xa ZB 20/08 has brought German Computer Implemented Invention (CII) case law into conformity with the continuing liberal practice of EPO in accordance with T 258/08 „Hitachi“.
 - ◆ Decision Xa ZB 20/08 confirmed by X ZR 47/07 „Representation of Topographic Information“ of GFCJ of October 28, 2010

Recommendations for EP/DE related Drafting

- Interaction between computer and software features of inventions should be described in specification
- Technical solution to technical problem, achieved by hardware and/or software features, should be described in specification
- Interaction between hardware and software features should be described as going beyond „normal“ interaction between computer and software

Novelty and Inventiveness under EPC

- Step 1: Determination of technical contribution/effect achieved by claimed subject matter
- Step 2: Determination of such set of elements of patent claim that contribute to the solution according to Step 1
- Step 3: Compare set of (hardware and/software) features found by Step 2 with state of the art, using usual problem-solution-approach of EPO