

EIP

Computer Programs and Excluded Subject Matter: An Examiner's View

On a rather warm 27 June 2012, a motley group of practitioners, including this reporter, gathered at CIPA Hall. Our task was to learn how to examine computer programs and excluded subject matter as a UK patent examiner. Our able teachers were Nigel Hanley and Stephen Richardson of the UK IPO. Both Nigel and Stephen train UK examiners in Newport and are highly-experienced examiners themselves. Gwylim Roberts was on hand as chair to control any trouble-makers at the back.

In the session the tables were turned: attorneys accustomed to receiving objections from UK examiners were now asked to raise their own objections on excluded subject matter. This change of perspective was illuminating.

Nigel started with a quick rundown of the exclusions of s.1(2) of the UK Patent Act. Even though these are (overly) familiar to practitioners in this area, it was useful to hear them explained from the IPO's point of view. For example, it was useful to hear from the IPO that the 'business method' exclusion includes so-called 'administrative methods'. There then followed a 'greatest hits' listing of related EPO case law: VICOM (T208/84), Pension Benefits (T931/95), COMVIK (T641/00), Hitachi (T258/03) and Microsoft Data Transfer ('Clipboard' – T424/03). It was agreed that everyone liked VICOM.

The parallel development of UK case law was also set out: Fujitsu ([1997] RPC 608), CFPH ([2005] EWHC 1589 (Pat)), Aerotel ([2007] RPC 1), Symbian ([2008] EWCA 1066) and AT&T and Cvon ([2009] EWHC Civ 1371). UK development is characterised by rapid step-inflation. Fujitsu introduced a one-step test: the presence of a technical contribution. CFPH developed this into a two-step test: 1) What is the contribution? 2) Is the contribution patentable? Aerotel then presented a four-step test, which effectively spilt

each of the steps from CFPH. AT&T then presented five signposts to help determine whether a contribution is technical in nature.

Current UKIPO examination is based on this UK case law. It applies the Aerotel four-step test and then, if necessary, uses the five signposts of AT&T as guidance. Hence, a UK examiner will first construe the claim. They will then determine the contribution. A determination will then be made as to whether the contribution lies solely in excluded subject matter, for example as set out in the exclusions of s.1(2). If the contribution relates to a computer program, the AT&T signposts may be used to determine if it is a computer program 'as such', i.e. lies solely in excluded subject matter, or whether there is in fact a technical contribution. If the contribution does not lie solely in excluded subject matter a check is made to see if the contribution is 'technical' in nature.

As all freely admitted, the heart of examination is the third step. Nigel explained how the fourth step was barely used; at the IPO only two examples could be found to invoke the final check: 1) a method of training a sheep dog (that would not be excluded per se but would not be technical) and 2) the Quest International Board of Appeal case at the EPO (T619/02) that considered the patentability of odours. In practice, UK examiners were taught to apply the third step by cross-checking the 'actual contribution' of the second step with the excluded categories of s.1(2). For practitioners this suggests that a correct framing of the 'actual contribution' in the second step is vital, remembering that the 'actual contribution' need not be the same as the novel features of the claim. For example, if the contribution is determined to be solely a 'business method' or 'presentation of information', then the claim fails the third step and an objection is raised. The fourth step is not invoked. If the contribution is determined to be a 'computer program' the UK examiner turns to the five signposts. If any of the five signposts suggest a technical contribution on the balance of probabilities, no objection is raised; if the contribution does not resemble any of the five signposts, the claim is objected to for being a 'computer program' as such. Again, typically the fourth step is not invoked.

Nigel presented a handy checklist of tried-and-tested ways to invoke the ire of a UK examiner (which your reporter kindly suggests should not be used in vain). These include: 1) making reference to EPO practice; 2) citing Symbian without clear relevance to the case in question; 3) arguing that the contribution is a new arrangement without evidence; and 4) ignoring the five signposts on the ground that they are simply guidance. Stephen stressed that although the signposts were not appropriate for all cases, practitioners could at least attempt to apply them and, if they were not applicable, provide a suitable explanation as to why. Practitioners could also help by: avoiding 'means for' type claim formulations; explicitly claiming a 'computer-implemented method' if relevant; clearly setting out the technical contribution of the claim; and making use of, or at least

acknowledging, the UKIPO's preferred approach as described above. Examiners were also open to telephone conversations; often issues could be resolved much more efficiently over the phone.

The seminar ended with practitioners being let loose on three fictional claims. Here there was variation amongst practitioners and for each case there were valid points on each side of the excluded subject-matter debate. This made it easier to understand the variability in examiner position - while unpredictable for an applicant it was the natural result of a human application of the guidance of the courts.

While your reporter would not necessarily agree with all of the legal interpretation of the UK IPO, they found the seminar useful and would use the guidance in their daily practice. They wish to thank Nigel and Stephen for their trek eastward (and Gwylim for his somewhat shorter trek southward) and applaud the current efforts of the UKIPO to increase understanding between examiners and practitioners.

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By Ben Hoyle