Dust settles on software and other excluded inventions following G3/08 and Bilski Decisions

1. Following on from our *PageView* of June 2010 (Enlarged Board of Appeal are happy with current EPO case law on Computer implemented inventions), it seems appropriate to try to come to some conclusions on the current state of the law, or at least how it is interpreted in practice, and how best to deal with it.

2. The very short answer for European Patent Office practice, UK practice and the US is: **NO CHANGE**.

3. As mentioned in the *PageView* referred to above, the Enlarged Board of Appeal decision G3/08 essentially stated that the way the Boards of Appeal have been dealing with the issues of computer implemented inventions (and excluded subject matter more generally), are fine, that they are part of the evolution of the law in this area, and the Enlarged Board saw no need to get involved.

4. Similarly, in the Bilski decision in the USA, the Supreme Court appeared to approve the Machine-or-Transformation test for patentability, but said this was not (necessarily) the *only* test, and also confirmed that business methods were not *necessarily* unpatentable.

5. Finally, in the UK, although they have a different, and arguably tougher, test for patentability of excluded subject matter from that used by the EPO, the present precedent set by the Court of Appeal means that the UK Patent Office practice cannot be changed (for example to be more consistent with that of the EPO) until the Court of Appeal (at least) overturns its current view of the matter.

6. Therefore, in order to maximize the chances of getting patents granted in the EPO (and also in the UK), the following inexhaustive suggestions are made for drafting descriptions and claims for inventions that are close to the edge of patentability for being at least partly within the excluded categories, such as computer software, business methods, mental acts, etc.

Thus, some recommendations are:

i. Omit or at least minimize all references to the particularly excluded subject matter, e.g. “software”, “business”, “mental act”, “presentation of information”, “mathematical method”, or similar words, e.g. “computer program”, algorithm, “financial” etc;

ii. “Convert” as much functionality from method steps or program steps to functional modules of hardware (i.e. functional black boxes);

iii. Include as much real hardware as possible, especially making sure to include, at the very least, the constituents of a computer, i.e. a processor, a display, a memory and some user interface;

iv. Include as much context as possible for the invention, especially in the use that the “output” of the method/apparatus is put to. The use of such an output “for controlling” something is especially useful. If the context is itself excluded subject matter, however, e.g. a business method, or presentation of information, then do not include this;

v. Any hardware (even paper and pen) is better than none;

vi. The key concept to include is “technical”. The invention must be technically different to the prior art. In some cases, considering the invention independently of any adjectives limiting “data” is useful, e,g, financial data, mathematical data, in order to see whether the basic technique is technically inventive without relying on the specific adjective for novelty, especially if that adjective is within the excluded fields. Nevertheless, other adjectives that limit the particular environment can provide the patentability. For example, image processing is usually OK, where word processing, is not. Cryptographic techniques for coding are usually OK, where mathematical techniques for coding may not be.

8. As can be seen there is no clear reason behind the situation we are now in. The overriding aim is to provide a description and claims to an Examiner that he/she will assume are patentable, without considering excluded subject matter. Once an excluded subject matter is raised, it becomes very, very difficult to overcome. It is also worth bearing in mind that a narrower claim that does not raise this objection is far preferable to a broader one that does.

9. In this case, in particular, it should be pointed out, of course, that each invention is different and using any or all of the above recommendations does not in any way guarantee that a patent will be granted. The recommendations are merely based on our experience of how to maximise the chances of success.

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