UNICE
Union of Industrial and Employers' Confederations of Europe
Union des Confédérations de l'Industrie et des Employeurs d'Europe

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PATENTABILITY OF COMPUTER PROGRAMS

UNICE COMMENTS

I. GENERAL COMMENTS

Before answering the questions put forward by the Commission, UNICE would like to recall some of the background information which is needed to have a full picture of the topic under discussion.

- Article 52(2) of the European patent Convention (EPC) excludes "programs for computers" from the concept of invention as defined in Article 52(1). In addition, Article 52(3) limits that exclusion to programs for computers "as such".

  Inspired by Rules 27(1)(c) and 29(1) EPC, the Boards of Appeal of the European Patent Office (EPO) have interpreted the combination of paragraphs (1), (2) and (3) of Article 52 EPC as prescribing that European patents shall be granted to invention involving a solution to any technical problem that meets the common criteria of novelty, inventive step and industrial applicability. Thus, an invention within the meaning of Article 52 EPC is defined as a technical solution to a technical problem. In other words, an invention must have a technical character, represent a technical development or at least be based on technical considerations.

- Article 27(1) TRIPs Agreement prescribes that patents shall be available for any inventions, whether products or processes, in all fields of technology, provided that they are new, involve an inventive step and are capable of industrial application. Hence, the TRIPs Agreement defines in a positive manner (inventions in all fields of technology) what already by and large corresponds to the present practice of the EPO Boards of Appeal. This means that the present wording of the EPC is already broadly TRIPs-compliant.

  Nevertheless, the most important problem with the present wording of the EPC is that those who have little experience with European patent practice might be misled by the negative formulation

of Article 52(2) EPC, and conclude that they cannot obtain a patent for their invention involving a computer program.

- To ensure full TRIPs-compliance in a clear manner, it is necessary to align the wording of Article 52(1) EPC to that of Article 27(1) TRIPs , and to delete paragraphs (2,3) of Article 52 EPC. The result will be the following wording for a revised paragraph (1) of Article 52 EPC:

  "(1) European patents shall be granted for any inventions, whether products or processes, in all fields of technology, provided that they are new, involve an inventive step, and are susceptible of industrial application."

- Although only few amendments are needed, it is important that these modifications enter into force in the short term in order to put the patentability of software-related inventions beyond all doubt.

  Since TRIPs already contains the requirement to adapt existing patent a new EC directive does not need to impose new requirements for patent legislation to be changed. In UNICE's opinion, a far easier and faster way for the Commission to encourage Member States to make the desirable adjustments in their national patent law, is to issue a recommendation.

- Irrespective of the instrument (directive or recommendation) actually chosen, it suffices to include in the body of the instrument the above-mentioned simple amendment of Article 52 EPC and the requirement that national patent laws be amended accordingly.

  Anything else should not be mentioned in the body but in the part listing the recitals of the instrument. These considerations should make clear that in Article 27(1) TRIPs and thus also in the proposed amended wording of Article 52(1) EPC, the notion "invention" only means a solution to a problem whereby the technical character requirement is represented by the words "in all fields of technology". This change in the definition of the notion "invention" and the introduction of the new requirement "in all fields of technology" should, of course, also be properly explained.

II. QUESTIONNAIRE FROM THE COMMISSION

Since the Commission has put forward specific questions to industry, UNICE would like to make the additional following comments/

1. How should the concept of computer program be defined in the context of the planned directive ?

If EPC and the national patent laws are amended as set out above, there is no need for a definition of the concept of a computer program. Moreover, defining 'concept of computer program' is not useful: 'computer program' is an ambiguous term which can refer to means for the implementation/reduction to practice of an invention or to a 'work' directed to communicating its meaning to humans.

2. The tendency is generally to define an invention as a technical solution to a technical problem. Do you therefore think that the Commission's planned proposal should place particular emphasis on this point, and why?

UNICE does not believe so. If the Commission's planned proposal for an instrument contains wording which deviates from the TRIPs Agreement, it might be argued that the EC violates

TRIPs. Moreover, if any wording derived from the present case law of the EPO Boards of Appeal is put into an EC directive, future legal developments to cope with new technical developments might be blocked.

It is therefore desirable that any proposal is limited to adapting the text of the present patent laws to that of the TRIPs Agreement without making any more detailed provisions in the body of the instrument chosen.

However, as regards the recitals of the instrument, it is desirable to stress that solving a technical problem by technical means, including software, falls within the ambit of patent law. This could help to remove 'software' from the pedestal on which it is placed in some patent circles. A formulation could be found in e.g Rules 27(1)(a,c) and 29(1) EPC.

3. If the answer to the previous question is affirmative, how do you think that this "technical solution to a technical problem" approach should be formulated?

On this, please refer to our comments in point 2 above.

4. In connection with the answer to the previous question, do you think that it might be useful for the planned Commission proposal to contain some "guidelines for interpretation" on how to view compliance with patentability requirements concerning computer programs, and more specifically the aspect of industrial application?

In UNICE's opinion, the answer is no. As regards the body of the instrument it can safely be left to case law to interpret Article 27(1) TRIPs in the light of new technical developments. There seems to be no urgent need to define further the concept of industrial applicability. The definition of Article 57 EPC suffices.

5. If the "technical solution to a technical problem" approach is selected, do you think that there needs to be a distinction between various categories of computer program, in order to eliminate those that might not intrinsically be regarded as technical solutions to a technical problem: e.g. computer programs for games or those relating to economic and financial operations?

The very question shows that trying to develop wording exceeding the simple language of Article 27(1) TRIPs can result in serious problems.

6. Do you think that it might be necessary to stipulate that certain elements involved in devising programs - e.g. routines, algorithms or object code - cannot be patented as such? Do you have any suggestions, and why?

In light of the above there is no need to do so.

7. In relation to the answer given to the previous question, do you think that there should be a distinction between the patentability of a computer program taken as a whole and the fact that the extent of the protection provided by the patent does not extend to certain elements as such involved in devising the program? How could this be expressed?

As set out above, the adjustments to be made to Article 52 EPC should be limited to adapting the wording of Article 52(1) EPC to that of Article 27(1) TRIPs, while paragraphs (2,3) of Article 52

EPC are simply deleted. There is no need for any further definitions that might only cause problems when new technical developments arise.

8. Do you think that it might be necessary to stipulate limits on the extent of protection, particularly with regard to backup copies, as laid down in Article 5(2) of Council directive 91/250/EEC on the legal protection [for literary works in accordance with the Bern Convention] of computer programs?

UNICE believes not. The present wording of Article 5(2) of Council Directive 91/250 EEC suffices. Nevertheless, since the above directive deals with copyright, when a program product is covered by both copyright and patent right, the program supplier would have to make sure that his ownership to or his license under the patent includes the right to have back-up copies made by his customers.

9. Do you think that it might be useful to incorporate a kind of "infringement threshold" indicating from when and with regard to what the extent of protection provided by a patent on a computer program is valid? Is it possible to have a criterion concerning "essential parts" in this context? Why, and/or do you have other suggestions in this regard?

UNICE is of the opinion that there is no need to go beyond Articles 25 and 26 CPC 1989 as regards the body of the instrument.

III. CONCLUSION

UNICE welcomes the Commission's initiative to bring an end to the ambiguity which exists regarding patentability of computer programs. Patent protection should be made available for computers programs, whether they are claimed as systems, processes or program products.

In this context, the proposed instrument should have two main objectives:

-it should recognise that there is no legitimate policy or practical reason why computer program inventions should be treated differently from those in any other technology;

-it should focus on eliminating the ambiguity which surrounds the current legal situation.

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