HOFFMANN · EITLE

MÜNCHEN LONDON

UK PATENTS COURT HOLDS THAT COMPUTER PROGRAM CLAIMS ARE ALLOWABLE

NEWSLETTER 03/2008

On 25 January 2008, the UK Patents Court issued a decision in Astron Clinica and Others[1], which has changed the way in which the UK Intellectual Property Office treats the allowability of claims to a computer program. More particularly, claims to a computer program are, once again, allowable in the UK. This article sets out the background to the new court decision, and explains its findings and implications for patents in the UK.

by David Sproston

BACKGROUND

The European Patent Office (EPO) allows claims to a computer program in cases where the method which is performed by the computer program provides a technical solution to a technical problem[2]. These claims typically have the form:

A computer program comprising computer program instructions to program a programmable processing apparatus to become operable to perform a method as set out in Claim X.

Or

A storage medium storing computer program instructions to program a programmable processing apparatus to become operable to perform a method as set out in Claim X.

The UK Intellectual Property Office (UK-IPO) allowed such claims until the UK Court of Appeal issued a decision in Aerotel/Macrossan[3] setting out a new four-step test to determine whether an invention is unpatentable because it comprises non-statutory subject matter.

Following this decision, the UK-IPO stopped allowing computer program claims (although apparatus claims and method claims were still permitted if the invention passed the new four-step test).

The absence of computer program claims in a granted UK patent can cause problems when the patent proprietor tries to enforce the patent. More particularly, if a competitor is selling computer programs stored on a storage medium or Internet downloads, the patent proprietor can only stop the competitor by relying upon the contributory infringement provisions of UK law[4] (the competitor is selling an essential element for putting the invention of the apparatus and method claims into effect). However, the contributory infringement provisions of UK law provide protection only if the essential element is for putting the invention into effect **in the UK**. Accordingly, if the competitor is exporting the computer programs, there is no infringement, with the result that the patent proprietor cannot stop the sales.

THE NEW COURT DECISION

The new court decision[1] concerns six patent applications belonging to five different applicants (Astron Clinica, Cyan Technology, Inrotis, Software 2000 and SurfKitchen).

In each case, the UK-IPO had found that the apparatus and method claims were allowable, but refused to allow the corresponding computer program claims. This refusal was therefore appealed to the UK Patents Court.

The judge (Mr Justice Kitchin) reviewed the relevant case law of the UK courts, and held that there was nothing to preclude the grant of computer program claims in cases where the invention relates to statutory subject matter.

In addition, the judge reviewed the relevant case law of the EPO, and commented that "it is highly undesirable that provisions of the EPC are construed differently in the EPO from the way they are construed in the national courts of a Contracting state".

In view of these findings, the judge held that:

"(C)laims to computer programs are not necessarily excluded by Article 52. In a case where claims to a method performed by running a suitably programmed computer or to a computer programmed to carry out the method are allowable, then, in principle, a claim to the program itself should also be allowable"

[1] Astron Clinica and Others and The Comptroller General of Patents, Designs and Trade Marks [2008] EWHC 85 (Pat)

[2] See, for example, T 935/97 and T 1173/97

[3] Aerotel v Telco, Macrossan's Application [2006] EWCA Civ 1371

[4] UK Patents Act 1977: Section 60(2)

CONSEQUENCES FOR CLAIM DRAFTING

As a result of this decision, applicants are advised to include computer program claims in UK applications as well as European applications.

Hoffmann · Eitle will continue to take into account new developments in national law across Europe concerning computer-implemented inventions and provide advice to secure the best protection in light of those developments.

HOFFMANN · EITLE
MÜNCHEN LONDON

MÜNCHEN
Arabellastrasse 4 · D-81925 München
pm@hoffmanneitle.com
Telefon +49 (0)89 – 92 409-0
Telefax +49 (0)89 – 91 83 56

LONDON
Sardinia House · 52 Lincoln's Inn Fields
London WC2A 3LZ
Phone +44 (0)207 – 404 01 16
Fax +44 (0)207 – 404 02 18

©Hoffmann · Eitle 03/2008. This newsletter provides information and comments on legal issues and developments of interest to our clients and friends. The foregoing is not a comprehensive treatment of the subject matter covered, involves simplifications and is not intended as professional legal advice. Intellectual property laws and systems are multi-faceted and intricate, and regarding any problem which involves intellectual property matters, we urge you to obtain professional advice before taking any action with respect to the matters discussed in this newsletter. All correspondence regarding the contents of this publication should be addressed to David Sproston in our London Office. He can be reached via e-mail at DSproston@HoffmannEitle.com