

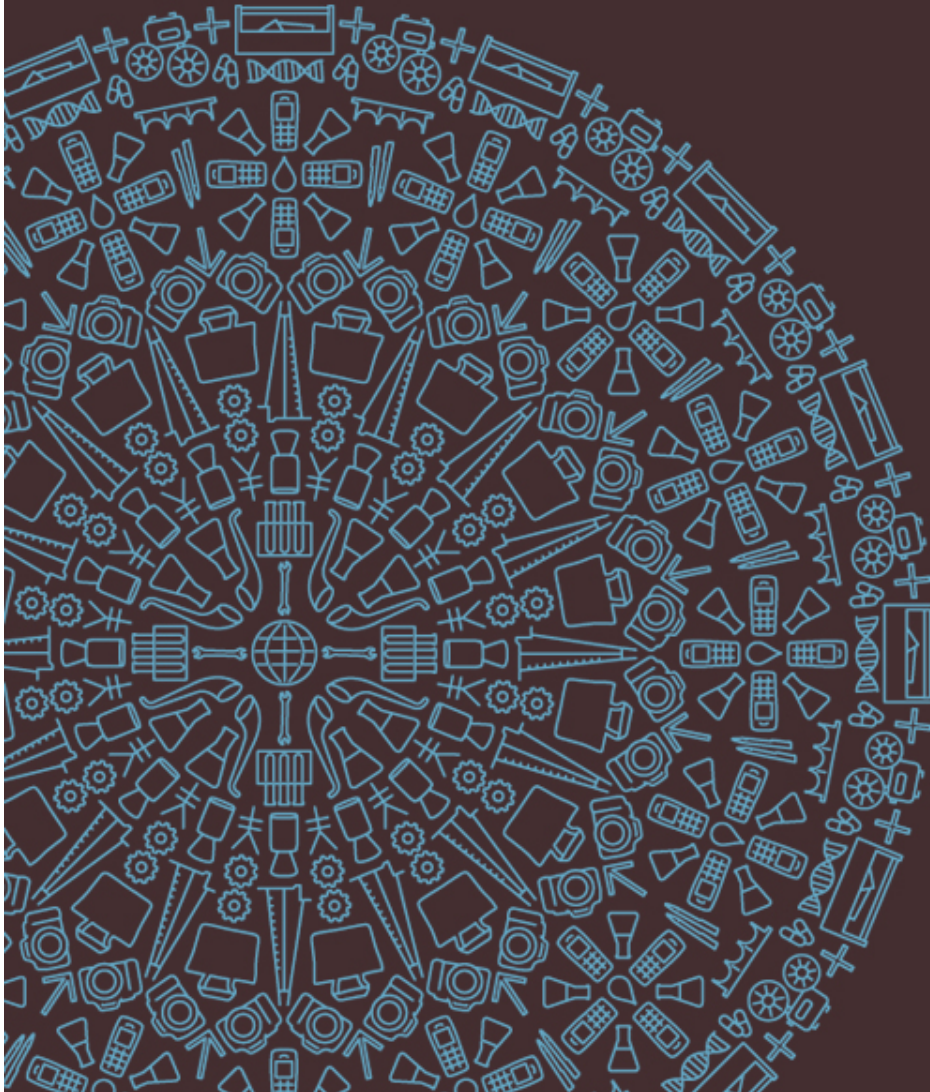
BRISTOWS

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Fordham IP Conference  
2015

Patentability of Software;  
Convergence of EPO, US  
and UK?

Thursday 9<sup>th</sup> April  
Myles Jelf, Partner  
Bristows, London



# Agenda

- Introduction
- UK
- EPO
- US
- Conclusions

# Introduction

- Software patents difficult – what is dividing line between patenting an algorithm and a highly technical invention that happens to use a programmable computer
- Numerous judicial attempts at articulating a bright line test
- But generally difficult to apply in any given case
- Looking at the UK, the EPO and the US shows ostensibly three different definitions
- Q: are they in fact converging in substance, as if so, that multiplies the body of potentially helpful case law for practitioners

# Software patents in the UK

- Exemption from EPC; Art 52
  - Inventions in all fields of technology, if new , inventive step and capable of industrial application
  - Not ‘*discoveries, scientific theories, mathematical methods...programs for computers*’ as such
- UK case law relatively stable since [*Aerotel/Macrossan*] and [*Symbian*]
- Most recently articulated in [*HTC v Apple*] and [*Lantana*]
- 4 stage test:
  - Construe claim
  - Identify contribution to the art
  - Does that fall solely within excluded class?
  - Is contribution technical in nature
- 2<sup>nd</sup> and 3<sup>rd</sup> Qs are the devil to apply– subsequent cases give ‘signposts’ to help answer  
[*AT&T*] [*HTC*]

# Software patents in the EPO

- Prohibition also rooted in Art. 52 EPC
- Patentability per se ‘test’ simple [*Duns Licensing*] - does it involve any (technical) hardware?
- BUT prohibited aspects then resurface where can’t rely on any such aspects to show novelty / inventive step (problem / solution)
- Comparing this with UK
  - UK: to achieve grant, have to identify an inventive ‘contribution to art’ which is not tainted by prohibited aspects + a technical effect;
  - EPO: to achieve grant, have to show an inventive solution which doesn’t contain any of prohibited aspects + some technical nature
- Key signposts the same – is the invention achieving in the real world a technical effect beyond the prohibited categories themselves

# Software patents in the US

- No ‘statutory’ exemptions to patentability BUT judicial exemptions for *‘laws of nature, natural phenomena, and abstract ideas’*
- All inventions *‘abstract idea’* at some level, but still protectable if claim elements alone/in combination *‘transform the nature of the claim’* into patent eligible [*Mayo v Prometheus*]
- A computer program / algorithm in its conceptual sense is an abstract idea and therefore a particular invention has to add something beyond the inherent nature of a computer program if it is to be patentable
- [*Alice Corp v CSL*] gives some definition to what is needed to effect the required transformation:
  - Not just a question of form *‘depending upon the draftsman’s art’*
  - Find an inventive concept outside or beyond exempted area

# Conclusions

- Clear common thread in all three jurisdictions:
  - Is there an inventive contribution once claim shorn of the exempted or prohibited aspects?
  - (UK and EPO both also look for a technical effect or nature, but hard to imagine a US software invention satisfying inventive contribution aspect and not also satisfying this)
- Growing body of specific case law in each jurisdiction is, therefore, going to be helpful instructive to practitioners in all three (and indeed elsewhere!)



Thank you for your attention

Bristows  
100 Victoria Embankment  
London EC4Y 0DH  
T +44(0)20 7400 8000  
F +44(0)20 7400 8050

[myles.jelf@bristows.com](mailto:myles.jelf@bristows.com)  
[www.bristows.com](http://www.bristows.com)  
[www.bristowsupc.com](http://www.bristowsupc.com)