

Uncertainty for computer program patents after the Astron Clinica and Symbian judgments of 2008

Introduction

The decision of the High Court in *Astron Clinica Limited and others v The Comptroller General of Patents, Designs and Trade Marks*¹ in January 2008 by the Honourable Mr. Justice Kitchin aligns the United Kingdom patent office with the European patent office², by overturning the practice of rejecting computer programs patents. The importance of this case was confirmed by the practice note released on the 7th of February 2008 by the UK patent office which indicated that the decision would not be appealed. However, the area is by no means settled with the decision in *Symbian* in March 2008 casting uncertainty on the *Astron Clinica* decision and the *Aerotel/Macrossan* four step test.

What is a patent?

A patent is an official document that confers proprietorship of an invention on the recipient. A grant of a patent is preceded by examination of applications by the patenting authority (the patent office in the UK) but the final responsibility for validating or invalidating a patent lies with the courts under challenge.

The fundamental principle behind patents is that the crown awards exclusive control over an invention for a fixed number of years, to the individual who first discloses the invention within its territory. In most systems a patent is granted to whichever applicant is first to submit a detailed description of the invention, provided the applicant can satisfy the patent authority and the courts through litigation regarding certain conditions laid down by patent law. In instances where strong public policies outweigh the policies behind granting patent exclusivity, the scope of a patent may be limited.

Patents are granted in regard to inventions arising from new technology, the rights they imbibe on the inventor includes the right to exclude others³ from utilising the patented invention for a specified amount of time, which is usually 20 years. In return for obtaining this grant, an inventor must describe the invention in detail to give

notice to the public to enable one of ordinary skill in the art to which the invention pertains to make and use the invention⁴.

The UK patent system is brought into being by the Patent Act of 1977⁵, related legislation includes the Copyright, Designs and Patents Act of 1988 (CDPA); however these devices are influenced by various pieces of European legislation. The Patent Act also contains provisions that attempt to harmonise the UK with the European Patent Convention, the Community Patent Convention and the Patent Cooperation Treaty⁶.

Many inventions have the capability to fulfill the four main requirements for patent grant under UK patent law. The Patent Act 1977, Part 1, Section 1 (1) outlines the four main patent fulfillment criteria:

1.-(1) A patent may be granted only for an invention⁷ in respect of which the following conditions are satisfied, that is to say –

- (a) the invention is **new**;
- (b) it involves an **inventive step**;
- (c) it is capable **of industrial application**;
- (d) the grant of a patent for it is **not excluded by subsections (2) and (3) or section 4A below**;

Alongside the new (or novelty), inventive step and industrial application criteria stands a fourth criteria in subsection (d) that indicates that certain application will fail due to being specifically excluded by the Patent Act. Both the UK and European patent systems specify a non exhaustive list of areas that will not be regarded as inventions; these exceptions can be found in subsection (2) of section 1 The Patent Act 1977:

(2) It is hereby declared that the following (among other things) are not inventions for the purposes of this Act, that is to say, anything which consists of:

- (a) a discovery, scientific theory or mathematical method;
- (b) a literary, dramatic, musical or artistic work or any other aesthetic creation whatsoever;
- (c) a scheme, rule or method for performing a mental act, playing a game or doing business, **or a program for a computer**⁸;
- (d) the presentation of information;

but the foregoing provision shall prevent anything from being treated as an invention for the purposes of this Act only to the extent that a patent or application for a patent relates to that thing as such.

Sections 1 (2) (c) and (d) are important in relation to the patentability of computer programs debate. From what seems a straightforward exclusion arises a complex line of case law and fluctuating international divergence between the European Patent Office and the United Kingdom patent office. This divergence is potentially problematic due to provisions in Section 130 of the Patent Act 1977 which states that section 1(2) is “so framed as to have, as nearly as practicable, the same effects in the United Kingdom as the corresponding provisions of the European Patent Convention”⁹.

Patents and copyright

One distinction that needs to be made here is the use of copyright and patents to protect computer programs. The European Patent office decision in T 0424/03 which concerned an application from the Microsoft Corporation can be used to clarify the distinction: The decision released on the 23rd of February 2006 outlined that software is patentable if it can be defined as a technical method which can be carried out on a computer¹⁰. This can, in turn be distinguished from the program itself, which is an expression of the method and this expression can be protected through copyright.

Definitions and wider debate

The definition of a software patent is difficult to fully realise, as there are different options concerning how the term computer software should be defined. Running parallel to this debate is the question concerning whether software patents should be granted in any form due to the contention over the issue of whether they actually encourage or discourage innovation.

Differing jurisdictions have heterogeneous policies in regard to the positioning of the boundary line between what is patentable and non patentable software. This argument was outlined in Europe during the lengthy de-

bate concerning the Directive on the patentability of computer implemented inventions. Suggestions for hurdles that software must clear to be patentable included: “computer program that utilises “controllable forces of nature to achieve predictable results” and “A computer program which provides a “technical effect””, however the variety of definitions suggested did not succeed in satisfying all members.

Aerotel v Telco and Macrossan's application

[2006] EWCA Civ 1371

Aerotel/Macrossan case dealt with section 1(2) of the Patents Act 1977 and Article 52 its equivalent in the European Patent Convention (EPC). The UK court did not feel that the decisions of the contracting states to the European Patent Convention and European Patent Office were sufficiently robust or stabilised to follow, in place of slavishly following the European Patent Office, the court outlined that the decision would be a definitive statement of law concerning patentable subject matter in the UK and it would rarely be necessary to refer back to previous UK or EPO case law. The Court approved a four step test proposed by the UK patent office:

- properly construe the claim, which analyses the scope of the potential monopoly before moving on to deciding whether the area is excluded.
- identify the actual contribution, this step looks at whether the patent application adds to human knowledge, the court outlined that it is the substance rather than the form of the claim that is important.
- ask whether it falls solely within the excluded subject matter, this deals with the Article 52(3) question, the wording of the step indicates that if it falls partially within one or more of the excluded areas it will pass the third step.
- check whether the actual or alleged contribution is actually technical in nature.

A further area of note arose from the case, the Court outlined that Article 52(2) is not a full list of exceptions, rather a categorisation of the things that should not be regarded as inventions¹¹.

Neil Macrossan sought leave to appeal the refusal of his patent to the House of Lords, due to the difference between approaches taken between the European and

United Kingdom patent office. This was refused by the House of Lords under the rationale that the case “does not raise an arguable point of law of great public importance.”

Aerotel v Telco and Macrossan's application prompted a practice note from the UK patent office outlining a change in the way in which patent examiners consider what fulfils the criteria for patentable subject matter. This was considered by many to be a restrictive interpretation, which **restricted computer programs from being permitted** as a patent claim even if the underlying method was found to be patentable. This left the UK patent office providing an alternative approach to that used by the European Patent Office with regard to the issues of software patents.

Astron Clinica and Others v The Comptroller General of Patents, Designs and Trade Marks

January 2008

Patents provide a broad area of study; the Astron Clinica case, which was heard in the UK court, illustrated this by combining a diverse range of technologies¹² within a single case, due to the exhibition of common feature: The provision of a technical advance being facilitated by a computer program. This technical advance is commercially valuable in each case and monopoly protection is sought through the use of the patent system.

The decision in Astron Clinica analysed the previous decisions in Merrill Lynch's Application¹³; Gale's Application¹⁴; and Fujitsu Limited's Application¹⁵ finally moving to the decision voiced in the Aerotel v Telco and Macrossan's application case in the Court of Appeal.

Kitchin, J outlined that it was unhelpful to have the provisions of the European Patent Convention used in different fashions at the European Patent Office and at its counterpart in the United Kingdom. This leaves the current position that computer program claims in the UK will be granted by the UK patent office, with the Aerotel/Macrossan criteria of a four step test being used. This is different to the test of technical character (or technical method) used at the European Patent office¹⁶.

The importance of this case was confirmed by the practice note released on the 7th of February 2008 by the UK patent office which indicated that the decision would not be appealed and stated that:

“In his judgment, Kitchin J has now clarified the law in this area, and decided that patents should, as a result of applying the test formulated in Aerotel/Macrossan, be allowed to protect a computer program if, but only if, the program implements a patentable invention. This ruling is a narrow one which places a greater emphasis on the substance of what has been invented than the words used in the claim. It does not have the effect of making computer programs generally patentable in the UK but it does allow innovators to enforce all aspects of their patentable inventions directly.”

The UK patent office has now affirmed that the consideration of the actual substance of the invention rather than the particular way the invention had been claimed, thus aligning the United Kingdom patent office with the European patent office. Despite assurances that the two tests will not lead to vastly different results, these affirmations do not fully deal with the question of how the two separate tests used at the UK and European Patent Offices can be fully reconciled.

Symbian's patent application

March 2008

The differing tests were again highlighted by Mr Justice Patten in the judgment in Symbian which concerned a patent for how a DLL (dynamic link library) is accessed with reliable changes being made to the architecture of the DLL. The UK-IPO had initially refused Symbian's patent application, despite the EPO granting the patent. The High court overturned the decision of the UK-IPO who refused the application because it related to nothing more than a computer program. There is thus still uncertainty over the correct usage of the Aerotel/Macrossan test, therefore the UK-IPO has stated that it will appeal this decision.

As further appeals are made over the issue of computer patents, it seems that there is currently no end in sight to the diversity of opinion found between the UK-IPO, the EPO and the judiciary.

Notes and References

¹[2008] EWHC 85 (Pat).

²The UK Patent Office is now known as the UK Intellectual Property Office (UK-IPO), but is still referred to as the Patent Office in legislation.

³Imitators and “independent devisors.”

⁴Chisum et al 2001.

⁵The Patent Act of 1977 succeeded the Patent Act of 1949 (and has been recently amended by the Patent Act 2004). The Patent Act of 1977 in section 60(1) sets out those acts which are deemed to infringe a patent. Infringement is detailed within the UK Patent Act of 1977

in section 60(1). The act will only infringe if it falls within the scope of the patent claim, the courts will have to determine whether an act infringes and this is achieved by analysing extent of the monopoly. Statutory provisions under the Patent Act 1977 the extent of an invention is taken to be that specified in the actual claim (section 125(1)). The construction of a patent claim must be in accordance with the Protocol on the interpretation of article 69 of the EPC section 125(3)). The Protocol states that Article 69 (of which s125(1) is the equivalent) should be interpreted to mean that the extent of protection occupies the middle ground between the two extremes of a strictly literal meaning of the wording of the claim or seeing the claim only as guideline.

⁶ Part One of this Act sets out the domestic law of the UK and concerns itself with concepts such as patentability and infringement. Part two covers the internal aspects of UK patent law. Part three contains general provisions relating to the workings of the Act. The European dimension is further discussed in the Appendix section.

⁷ It is interesting to note that what actually constitutes an invention is not specifically defined anywhere in the Patent Act 1977, however the Act does provide a list of things that are not classed as inventions for the purposes of the Act.

⁸ Article 52(2) of the European Patent convention also contains a "programs for computers" exception and a similar provision to the Patent Act section (2)(d) in Article 52(3): "only to the extent to which a European patent application or European Patent relates to such subject matter or activities as such". Therefore any invention that makes a non obvious technical contribution or solves a technical problem in a non obvious way is patentable despite being facilitated by a computer program.

⁹ Section 130 (7) Whereas by a resolution made on the signature of the Community Patent Convention the governments of the member states of the European Economic Community resolved to adjust their laws relating to patents so as (among other things) to bring those laws into conformity with the corresponding provisions of the European Patent Convention, the Community Patent Convention and the Patent Co-operation Treaty, it is hereby declared that the following provisions of this Act, that is to say, sections 1(1) to (4), 2 to 6, 14(3), (5) and (6), 37(5), 54, 60, 69, 72(1) and (2), 74(4), 82, 83, 100 and 125, are so framed as to have, as nearly as practicable, the same effects in the United Kingdom as the corresponding provisions of the European Patent Convention, the Community Patent Convention and the Patent Co-operation Treaty have in the territories to which those Conventions apply.

¹⁰ 1. The claim category of a computer-implemented method is distinguished from that of a computer program. Even though a method, in particular a method of operating a computer, may be put into practice with the help of a computer program, a claim relating to such a method does not claim a computer program in the category of a computer program (point 5.1 of the reasons). 2. A computer-readable medium is a technical product and, thus, has technical character (point 5.3 of the reasons).

About the Author

Dr Mark Van Hoorebeek is a lecturer at the Bradford University Law School. His teaching interests encompass a wide variety of areas, they include Intellectual Property and the Law of the Internet, Public law, and comparative Sharia Law. His research at present is focused on two main projects; one concerning the Eco patent commons and the second revolves around the topic of this short research outline: the controversy surrounding the issue of computer patents.

¹¹ It seems from this statement that the general principle of statutory interpretation that exceptions should be construed narrowly does not apply within the UK and European jurisdictions.

¹² (1) A method of generating bit masks for use with laser printers which results in higher quality images, (2) skin imaging techniques developed at the University of Birmingham which enable images of the skin to be processed to identify the distribution and concentration of underlying skin chromophores, (3) methods of identifying groups of target proteins for drug therapy by processing proteome data defining proteins and protein interactions, (4) an invention which improves the ability of mobile telephones to access services on the Internet and finally (5) a method of generating data for configuring micro-controllers which greatly simplifies chip design and programming.

¹³ [1989] RPC 561.

¹⁴ [1991] RPC 305.

¹⁵ [1997] RPC 608.

¹⁶ For an in depth account of these differences see Pearce, D. (2008) Computers and Law, forthcoming, available online: <http://ukpatents.wikispaces.com/space/showimage/AstronClinica.pdf>. Accessed 29th February 2008.

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Publisher: Bradford University Law School, School of Management, Emm Lane, Bradford, BD9 4JL.

Editorial team: Jessica Guth (Head), Tel: 01274 236799; Fax: 01274 236786; email:

j.guth@bradford.ac.uk; William Onzivu and Tim Connor.

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