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# Examination of CII and Business Methods Applications, Exclusions from Patentability

Lisbon, 20 March 2007



# Outline

- what are computer implemented inventions and business methods
- legal context
- common practice at the EPO
- examples

# Requirements for patentability

## Art. 52 (1) EPC

- European patents shall be granted for any inventions
  - which are susceptible of industrial application
  - which are new and
  - which involve an inventive step

## Art. 52(1) EPC Requirements

- **industrial applicability**
  - rarely used in CII, Art. 52(4) EPC
- **novelty**
  - Article 54 EPC
- **inventive step**
  - Article 56 EPC
- **Invention**
  - no positive definition; definition by exclusion (Art. 52(2) EPC)

## Exclusions Art.52(2)(a)-(d) EPC

- a) discoveries, scientific theories and mathematical methods
- b) aesthetic creations
- c) schemes, rules and methods for performing mental acts, playing games or doing business, and programs for computers;
- d) presentations of information

...only excluded if application or patent relates to such subject matter or activities **as such (Article 52(3))**

# Ambiguities Art. 52(2)&(3) EPC

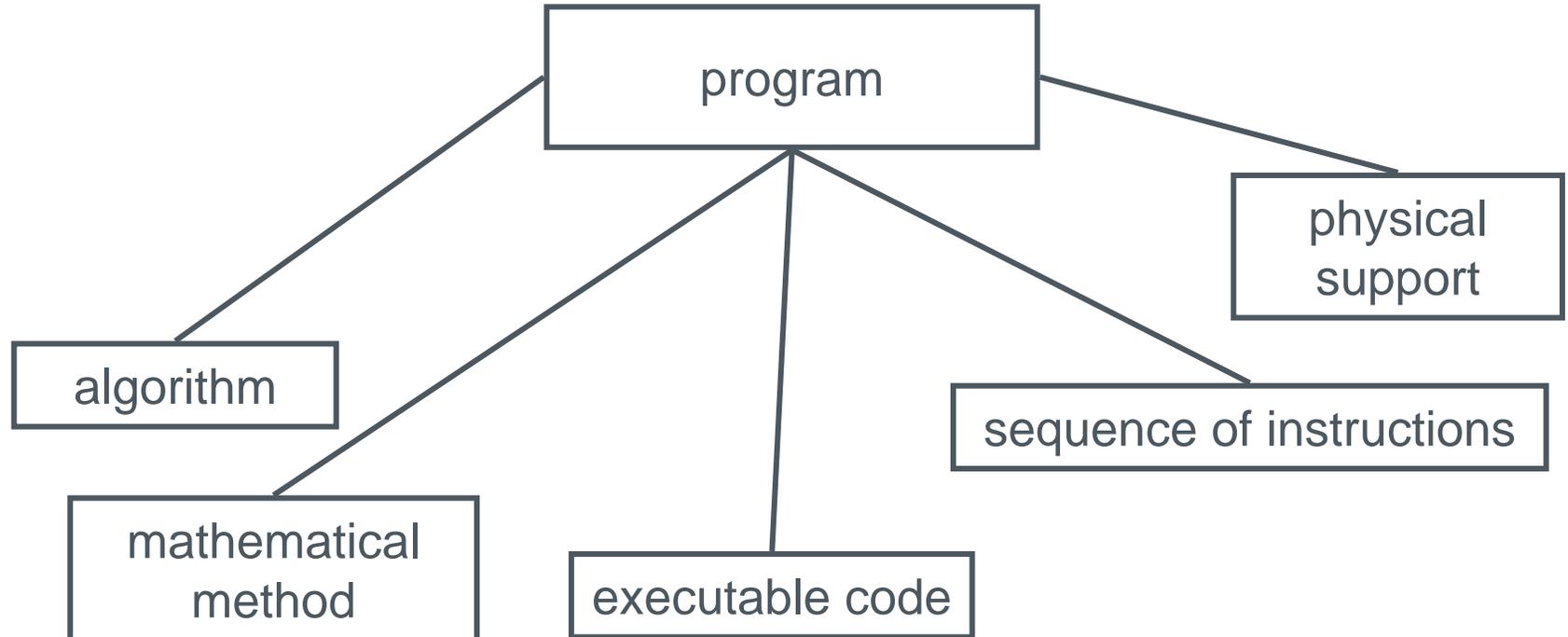
- what is the meaning of "as such"
  - what is a computer program as such?
  - what is a business method as such?

# What is a computer program?

- Definitions
  - “combination of instructions and data that allow the hardware to perform some function”
  - “set of instructions that can be interpreted by a computer in order to process some data”
  - “set of instructions used by a computer with the aim of obtaining a certain result”

# What is a program?

- Interpretations



## Computer Program related example

*A method of processing electronic mail in a computer system, the method comprising the steps of:*

- 1. searching the text of the e-mail for an indication that the user intends to include a file attachment*
  - 2. if such indication is found, determining whether the e-mail in fact includes a file attachment*
  - 3. if the e-mail does not include a file attachment, notifying the user to attach the file to the e-mail*
- transmitting the e-mail.*

# What is a business method?

- no clear definition
- can denote
  - economical activities
    - buying/selling, auctions
  - marketing
  - financial strategies
  - betting (games, sports)

## Business method example

*A method of promoting toy sales, comprising the step of placing the toys on the lower shelves of the store, where they are easily accessible for children.*

## Program or business method?

*Method for ordering a product characterized by:*  
client

- ❖ *display* of information identifying the product
- ❖ upon *reception of the request*, retrieval of data about buyer previously stored in a *database*
- ❖ as a result of a single user action, *sending a request* including information identifying the buyer

server

- ❖ *complete the sale*

## Program or business method?

*"A method of encouraging customers to be loyal buyers by giving a discount on future purchases"*

*"A **computer** with a **database** of customers who have previously purchased and applying a discount to any subsequent purchase"*

## Program or business method?

- Exclusion list Art. 52(2) EPC applies for pure cases
- In general, mixture of excluded and non-excluded matter, presence of excluded matter does not result in whole claim being excluded
  - other requirements EPC need to be considered

## In practice

- legal context
  - EPC
  - decisions of the Boards of Appeal
  - guidelines for examination
  - national laws

## Article 52 (2)&(3) EPC

- list of exclusions is not exhaustive
- exclusion is relative
  - circumstances or interpretations which rule out exclusion
- from the BOA decisions and guidelines

need of technical character

## Why require "technical character"?

- Rule 27(1) EPC requires the description to specify technical field of the invention and disclose it in such terms that the technical problem solved and its solution are understood
- Rule 29(1) EPC requires that claims define the subject-matter in terms of the technical features of the invention
- implicit requirement of the EPC (T1173/97, T935/97, T931/95, T641/00, T258/03)

# Technical character assessment

- *when*
  - at the search stage (if possible, otherwise examination)
- *without using prior art*
  - T1173/97, T931/95, T258/03
- *claim considered as a whole*
  - T26/86, T208/84
- *each feature or their combination needs to be considered*
  - T258/03 even trivial features can lend technical character
- *claim category relevant?*
  - Yes in T931/95
  - No in T769/92, T1173/97, T258/03, Guidelines C.IV.2.2

# Technical character assessment

- no technical character found?
  - Rule 45 EPC declaration, Guidelines part B, VIII
    - *if the Examining Division considers that the application does not comply with the provisions of the Convention to such an extent that a meaningful search on the basis of all or some of the claims is not possible, it shall declare such impossibility or perform a partial search;*
    - *this declaration is for further prosecution the European search report*

# Rule 45 EPC

- *no loss of rights for the applicant*
  - examination can proceed without prior art documents,
  - the division may perform a search if it judges it necessary at a later stage

# Technical character assessment

- technical character found?

- *Technical contribution* of the features of the claim having technical character
- *non-technical features do not contribute to an inventive step*
- *look for a technical solution, not mere circumvention via non-technical features*
- *Rule 45 not excluded*

## Mix technical & non-technical subject-matter

mix of **non-technical** and **technical** features:

"requirement  
specification"

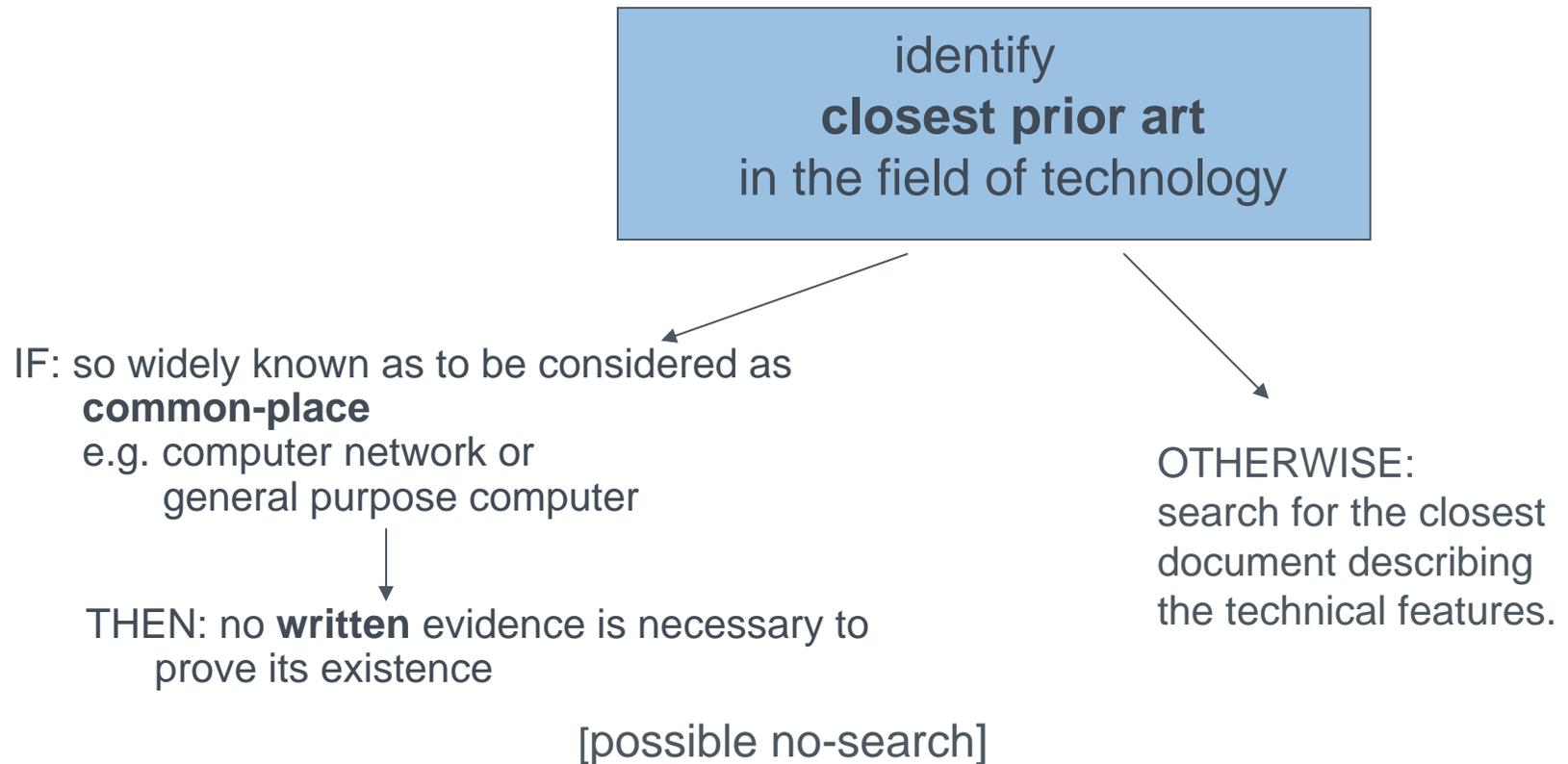
prior art in a  
field of  
technology

= instructions given to the programmer summarising the requirements of the customer  
*e.g. a business or administrative process to be automated*

- skilled person is aware of it T641/00
- normally found in description & in claims

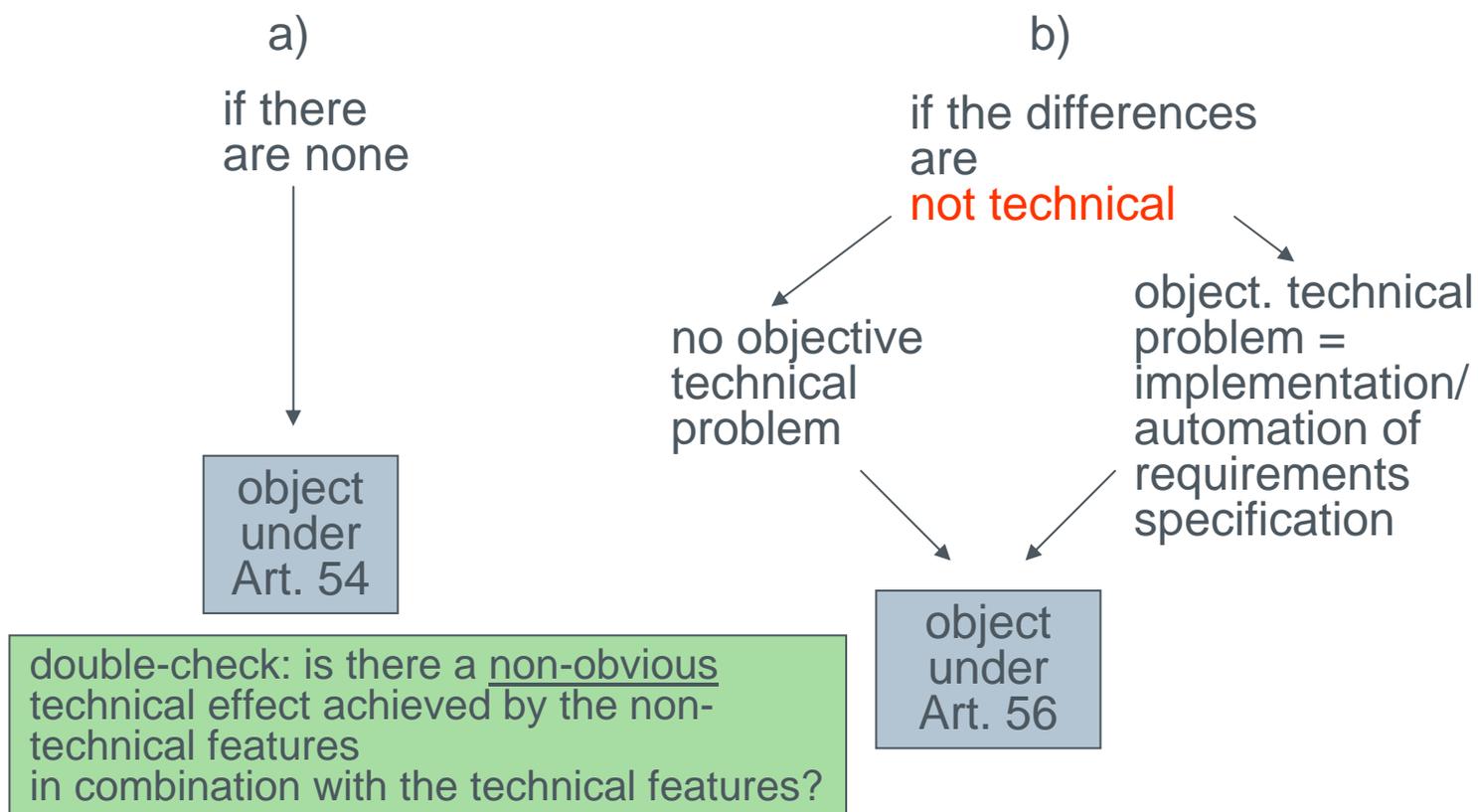
# Mixed subject-matter

based on the **technical** implementation set out in the claims and description:



# Mixed subject-matter

Identify **all the differences** between the subject matter of the claim and the closest prior art



# Mixed subject-matter

Identify **all the differences** between the subject matter of the claim and the closest prior art

c)

if differences =  
mix of **non-technical** & **technical**  
features

i) formulate the objective technical problem taking into account the requirements specification e.g. *"how to adapt system of CPA in order to implement the business concept"*

## Solution:

solution of the objective technical problem must require the technical features of the above identified differences.

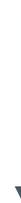
ii) if the solution of the technical problem is obvious

→ object under Art. 56

double-check: Is there a non-obvious technical effect achieved by the non-technical features in combination with the technical features?

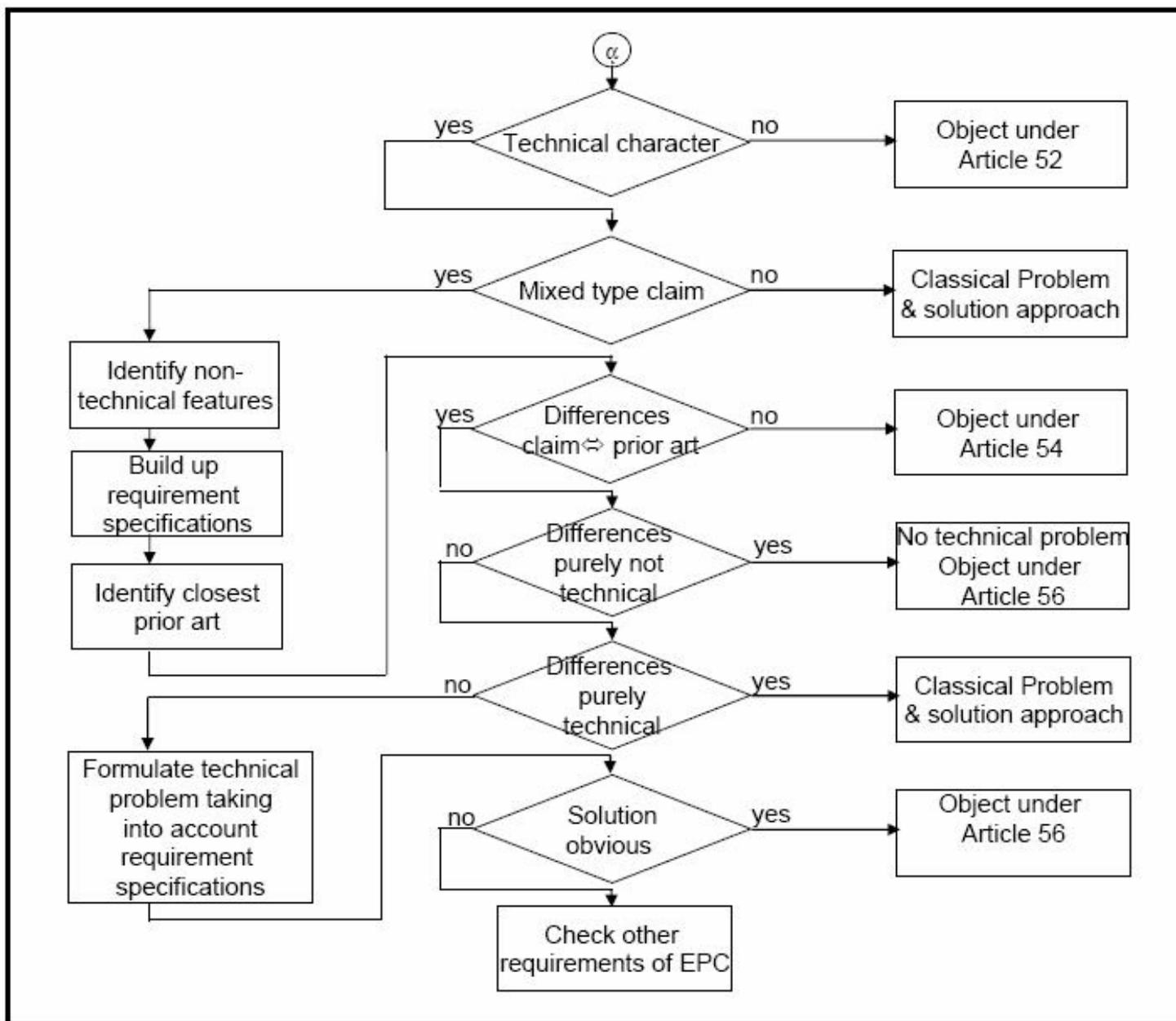
d)

if differences are purely **technical**



apply  
classical  
PSA

# Overview



# Example

Method for purchasing and payment of goods and services, preferably audio and/or video data provided on a provider's **platform in a computer network**, like the Internet, comprising the steps:

- taking a customer's order for goods and services, preferably an order for **audio and/or video data files**;
- providing a **download** of ordered goods and services, preferably of audio and/or video data files, for the customer; and
- debiting a mobile telephone account of the customer.

## Example

<b>Technical</b>	<b>Yes</b>
<b>Mixed type claim</b>	<b>Yes</b>
<b>Requirement specs</b>	<b><u>Ordering and paying for goods</u></b>
<b>Closest prior art</b> 	<b>Platform for downloading audio files from the Internet</b>
<b>Differences</b>	<b><u>Debiting mobile phone account</u></b>
<b>Technical problem</b>	<b><u>none</u></b>
<b>Solution obvious</b>	<b>n.a.</b>

## Example (cont.)

### Requirement Specifications

**Method for selling/purchasing audio and/or video data provided on the Internet,  
where**

- a customer's order is taken,
- ordered audio and/or video data files are delivered;  
and
- a mobile telephone account of the customer is debited.

## Example (cont.)

### Differences

Method for purchasing and payment of goods and services, preferably audio and/or video data provided on a provider's **platform in a computer network**, like the Internet, comprising the steps:

- taking a customer's order for goods and services, preferably an order for **audio and/or video data files**;
- providing a **download** of ordered goods and services, preferably of audio and/or video data files, for the customer; and
- debiting a mobile telephone account of the customer.

## Example (cont.)

...return

### Objective technical problem

**No objective technical problem can be identified**

**There is no inventive step involved.**

## Example modified

Method for purchasing and payment of goods and services, preferably audio and/or video data provided on a provider's **platform in a computer network**, like the Internet, comprising the steps:

- taking a customer's order for goods and services, preferably an order for **audio and/or video data files**;
- providing a **download** of ordered goods and services, preferably of audio and/or video data files, for the customer; and
- debiting a mobile telephone account of the customer,

whereby the purchase data sent to the telephone company are at least **partially encrypted** by a password.

# Example modified

<b>Technical</b>	<b>Yes</b>
<b>Mixed type claim</b>	<b>Yes</b>
<b>Requirement specs</b>	<b>Ordering and paying for goods</b>
<b>Closest prior art</b> 	<b>Platform for downloading audio files from the Internet</b>
<b>Differences</b> 	<b>Debiting mobile phone account and encrypting purchase data</b>
<b>Technical problem</b>	<b>Enhance data security</b>
<b>Solution obvious</b>	<b>Was encryption known?</b>

*Thank you for your attention*

More information:

[www.epo.org](http://www.epo.org)