

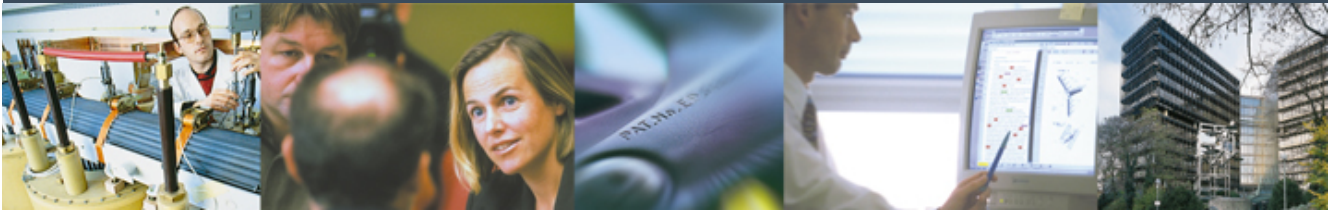


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Examination of CII and Business Methods Applications

Barcelona
November 2005

Dr. Jörg Machek
Director
Directorate 2.2.21



Claim 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.**

- classified in IPC class G06F17/60
- ~ 80000 published applications



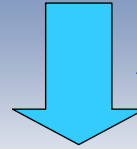
Overview

This Presentation Is Designed to ...

- assist you in dealing with files containing excluded subject matter
- highlight the case of CII
- make you familiar with recent case law of relevance
- ... and its impact on the examination practice at the EPO



Requirements for patentability



Art. 52(1) EPC

European patents shall be granted for **inventions** which

- are **new**,
- involve **an inventive step** and
- are susceptible of **industrial application**.



What is excluded from patentability?

Article 52(2) :

- 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) presentation of information

...as long as
claimed as such
Article 52(3)



What is an invention?

What is an invention?

Interpretation! (Guidelines, Board of Appeal)



What is an invention?

- Having **technical character** is an implicit requirement of the EPC to be met by an invention in order to be an invention within the meaning of Article 52(1) EPC.
T 931/95 - Pension benefit scheme
- A method involving **technical means** is an invention within the meaning of Article 52(1) EPC.
T 0258/03 - HITACHI Headnote I.



What is an invention?

- **Technical character or technical effect** are assessed without the knowledge of prior art.
T 1173/97 - Computer Program Product
- Decisive is **the technical effect** of the invention as defined in the claim **when considered as a whole**.
T26/86 - Koch & Sterzel



What is an invention?

Activities falling within the notion of a **non-invention „as such“** would typically represent purely abstract concepts devoid of any technical implication,

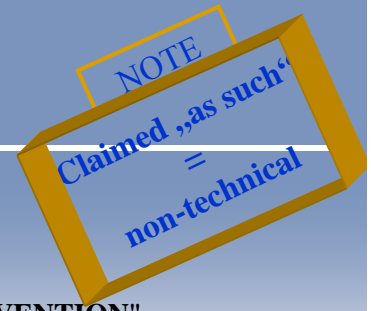
i.e. "as such" may be construed to mean that such subject matter is considered to be a mere abstract creation **lacking technical character**.

T 1173/97 - Computer Program Product

T 258/03 - HITACHI



What is an invention?



Art.52(1) EPC *"there must be an invention"*

(Guidelines C-IV, 1.1(i)) ☆ "hidden" requirement = **"INVENTION"**

Art.52(2) EPC : *non-exhaustive list of "non-inventions"* or
potential EXCLUSIONS

Art.52(3) EPC: The items in the list of Art.52(2) EPC become
exclusions only when they are claimed **AS SUCH**

☆ **IMPORTANT:** assessment of whether the claimed subject-matter represents an INVENTION or an EXCLUSION **without regard to prior art.**

☆ **The claim is considered as a whole**



Technicality

What is technical?

No definition of the word „technical“ is contained in the European Patent Convention (EPC).



Definition of German Federal Court of Justice

„A teaching for a systematic proceeding by application of controllable natural forces to achieve a causal perceivable result, which is the immediate consequence of the controllable natural forces without an intermediate step of the human intellect.“

Antiblockiersystem: GRUR 1980, 802



Definition of German Federal Court of Justice

revisited

„A process that involves – prior to the physical production – an intermediate step performed substantially with the aid of computers cannot be excluded from patentability on the grounds that it refrains from making direct use of controllable forces of nature if the solution seeks to promote the possibility of manufacturing technically workable products in a different manner by technical knowledge.“

Logikverifikation: BGH ref X ZB 11/98



EPO Approach

Rather than attempting a general definition of technical“, the Board’s present approach is to stake out, through a series of individual decisions, the grey area requiring interpretation.



Technicality

Technical is...

- processing **physical data**
parameters or control values of an industrial process
- processing which **affects the way a computer operates**
 - ✓ saving memory, increasing speed
 - ✓ security of a process, rate of data transfer etc.
- technical character may be implied by the **physical features of an entity**
 - ✓ memory, port etc.



Technicality

- Features relating to non-inventions within the meaning of Art. 52 (2) EPC are **non technical features**.

- selling, trading, insurance
- choosing amongst candidates for a job
- order placement and management



Technicality

...for computer programs and
computer program products...

The computer program, when carried out has to
provide a **"further technical effect"**.

The normal technical effects like flow of electrical
current is not sufficient.

T 1173/97; T 0935/97



Joint Cluster
"Computers"

Requirements
of the EPC

Technicality

EPO Practice

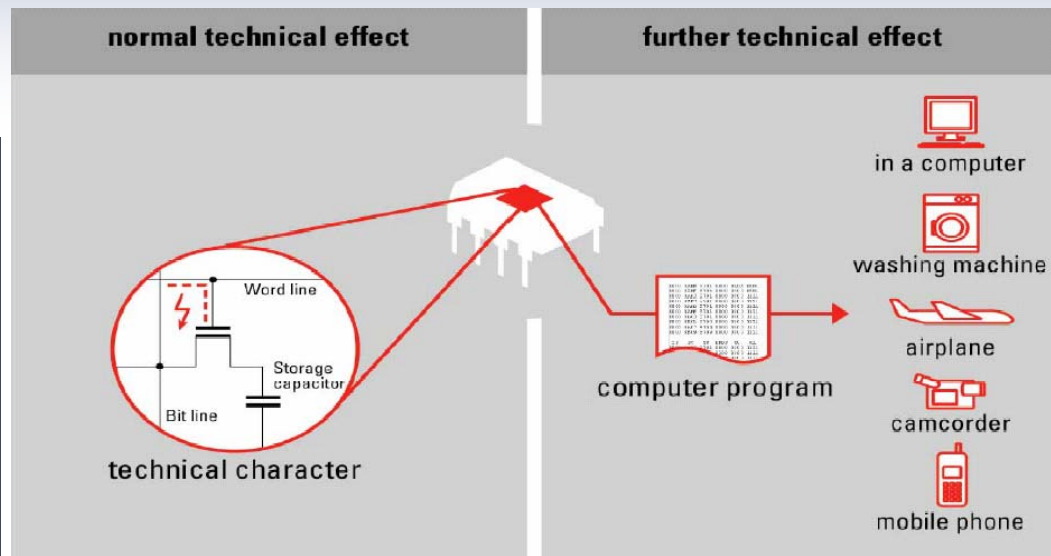
Statistics

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Technicality

Computer Programs: Further Technical Effect



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Technicality

further technical effect	no further technical effect
control of a brake in a car	aesthetical effects of music or of a video
faster communication between mobile phones	new rules of an auction
secure data transmission (encryption of data)	selling and booking sailing cruise packages
resource allocation in an operating system	calculation of a pension



Computer programs "as such"

```
#include <stdio.h>
int main(void)
{
    printf("hello world");
    return 0;
}
```

source code

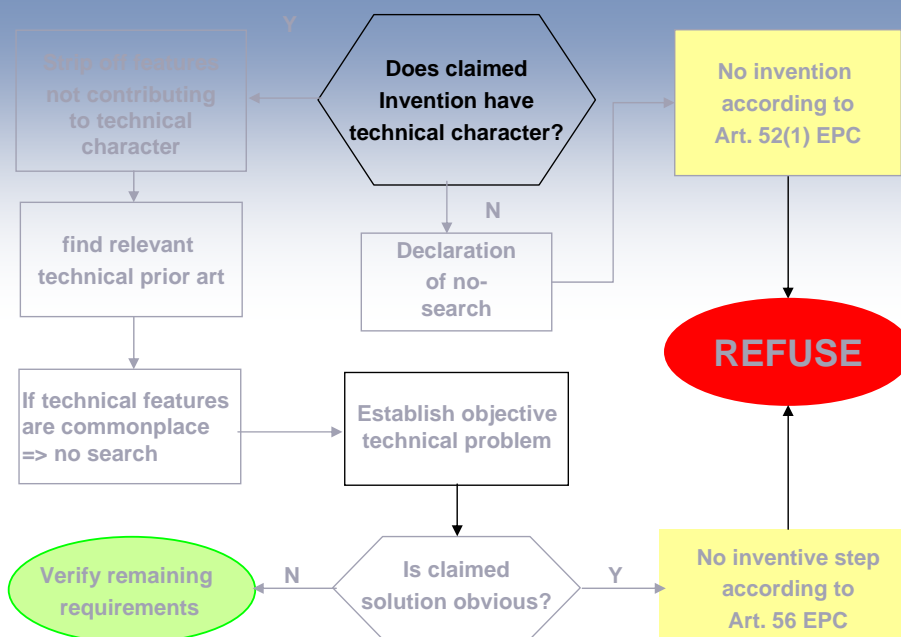
```
05 23 48 00 0A 1E 35 01 0F 19 35 01 19 1E 36 01
19 1E 36 01 04 00 00 00 60 80 3A 08 05 0A 81 00
05 0A 48 00 0A 1E 81 00 0A 1E 48 00 0A 1E 39 01
19 1E 39 01 1E 23 39 01 14 19 39 01 23 28 39 01
28 2D 39 01 1E 00 00 00 7C 80 3A 08 14 14 1B 00
14 14 4C 01 15 15 1B 00 15 15 4C 01 13 13 58 01
15 15 58 01 13 13 1B 00 13 13 4C 01 14 14 3E 01
14 14 3E 01 16 16 3E 01 16 16 3E 01 0A 00 00 00
AC 80 3A 08 14 1E B7 00 0A 14 B7 00 1E 23 B7 00
05 0A B7 00 14 1E 37 01 04 00 00 00 E4 80 3A 08
0A 0F 4A 00 05 0A 4A 00 0F 14 4A 00 0F 14 4A 00
0F 14 4A 00 14 00 00 00 00 81 3A 08 05 0A 81 00
05 0A 76 00 0A 1E 81 00 0A 1E 76 00 0A 1E 43 01
19 1E 43 01 1E 23 43 01 14 19 43 01 23 28 43 01
28 2D 43 01 1E 00 00 00 1C 81 3A 08 0F 0F 53 01
0F 0F 53 01 0F 0F 42 00 0E 0E 53 01 0E 0E 53 01
0E 0E 42 00 10 10 53 01 10 10 42 00 10 10 53 01
10 10 53 01 10 10 53 01 10 10 53 01 14 00 00 00
4C 81 3A 08 0F 0F 34 01 0F 0F 34 01 0F 0F 1B 00
0E 0E 34 01 0E 0E 34 01 0E 0E 1B 00 10 10 34 01
10 10 1B 00 10 10 34 01 10 10 E3 00 10 10 34 01
10 10 E3 00 14 00 00 00 84 81 3A 08 10 10 66 01
10 10 2A 01 11 11 66 01 0F 0F 66 01 0F 0F 2A 01
10 10 7C 01 10 10 2B 01 12 12 2B 01 11 11 7C 01
```

object code

=>

EXCLUDED (≠ invention)

EPO Practice





EPO Practice

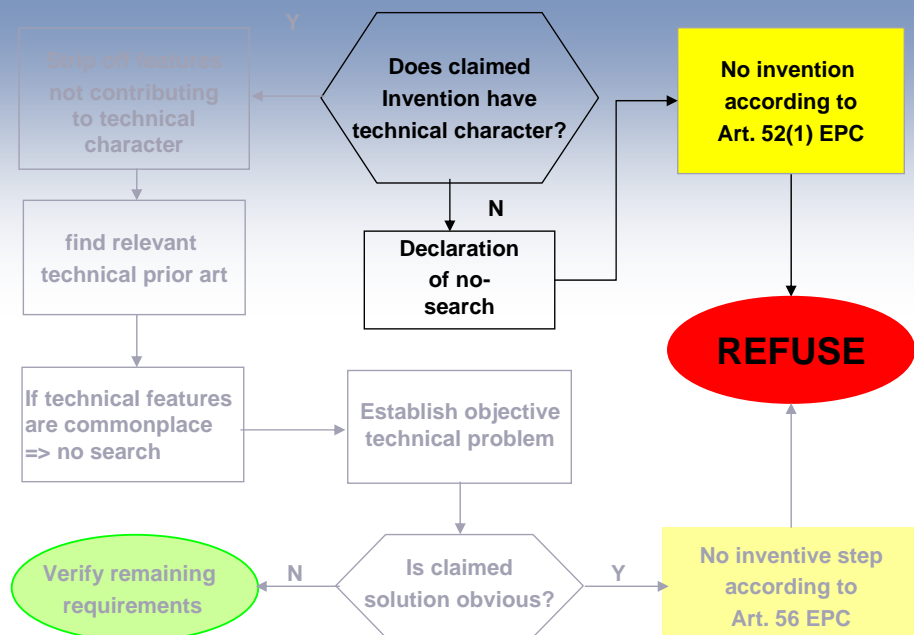
Example:

A method for evaluating leadership effectiveness, comprising the steps of:

- **gathering target information quantifying at least one domain selected from the group consisting of having personal convictions, being visionary, building emotional bonds, being inspirational, being team oriented, being a risk taker and having a drive to excel;**
- **comparing the target information with a standard, the standard including standard values of the domain; and**
- **identifying non-standard responses of the target.**



EPO Practice





EPO Practice

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.**



EPO Practice

Example:

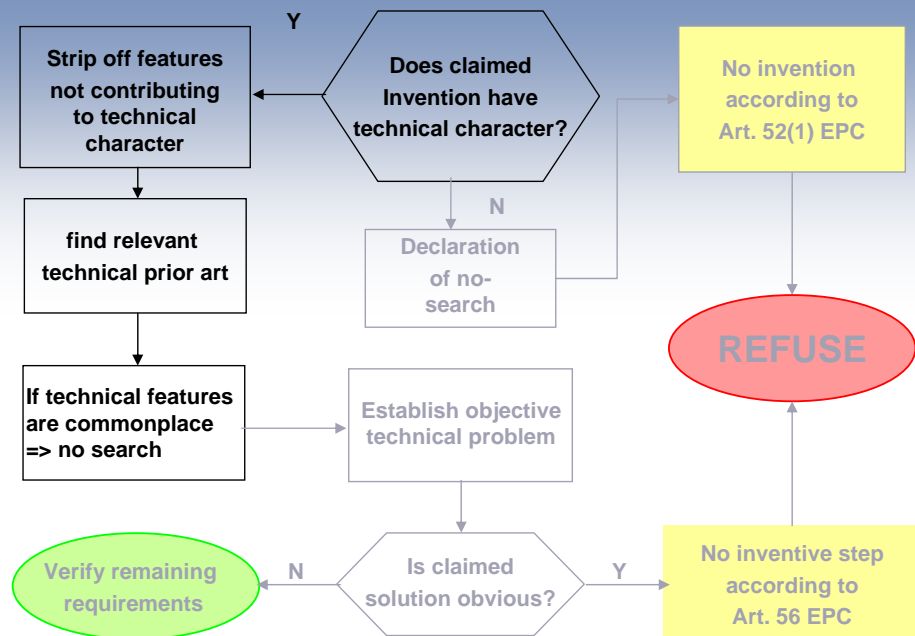
**A method for grouping a plurality of exams for a patient
comprising the following steps:**

- **Selecting a first exam;**
- **Selecting at least one other exam, related to said first exam;**

**Characterised in that the method further comprises the step of
defining a time relation between said first exam and said other
exam.**



EPO Practice



EPO Practice

Mix of technical and non-technical features - What is “prior art”?

- **Separate the features** which contribute to a technical character from those that do not.

T 258/03 - HITACHI; section 5.3

- The term **“state of the art”** ... should ... be understood as **“state of technology”**, which in the context of the EPC does not include the state of the art in commerce and business methods.

T 0172/03 - RICOH Headnote I



EPO Practice

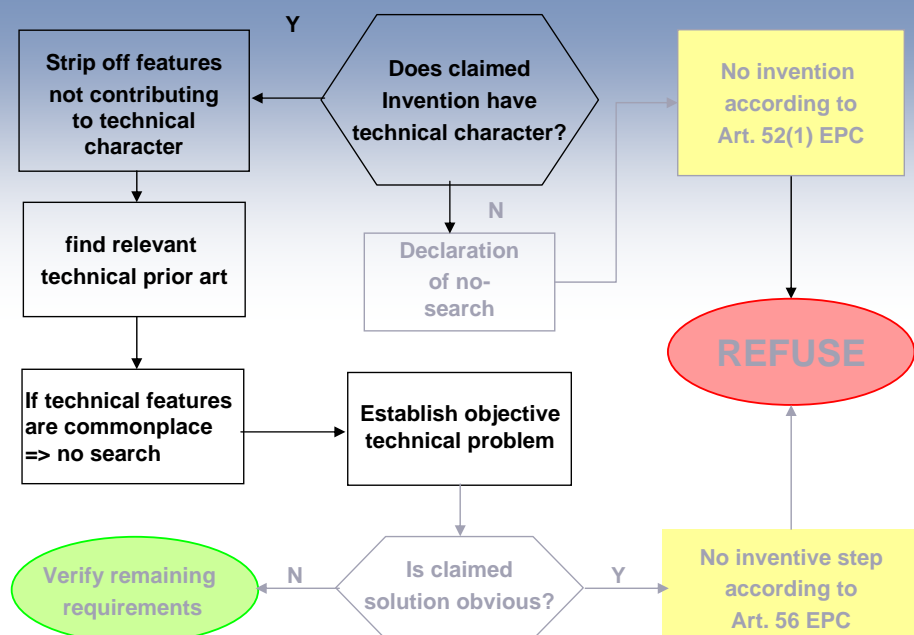
Example:

A computerised method for evaluating leadership effectiveness,
comprising the steps of:

- receiving on a computer target information quantifying at least one domain selected from the group consisting of having personal convictions, being visionary, building emotional bonds, being inspirational, being team oriented, being a risk taker and having a drive to excel;
- comparing the target information with a standard, the standard including standard values of the domain; and
- identifying non-standard responses of the target;
- outputting the non-standard responses on a display screen.



EPO Practice





EPO Practice

*Are the distinguishing features between the subject matter of the claim and the closest state of the art of a technical character,
i.e. is the contribution over the state of the art technical?*

*Is the objective problem technical?
Is it possible to formulate a technical problem?*

Is the objective (technical) problem solved by the (technical) distinguishing features?



EPO Practice

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.**



EPO Practice

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.**



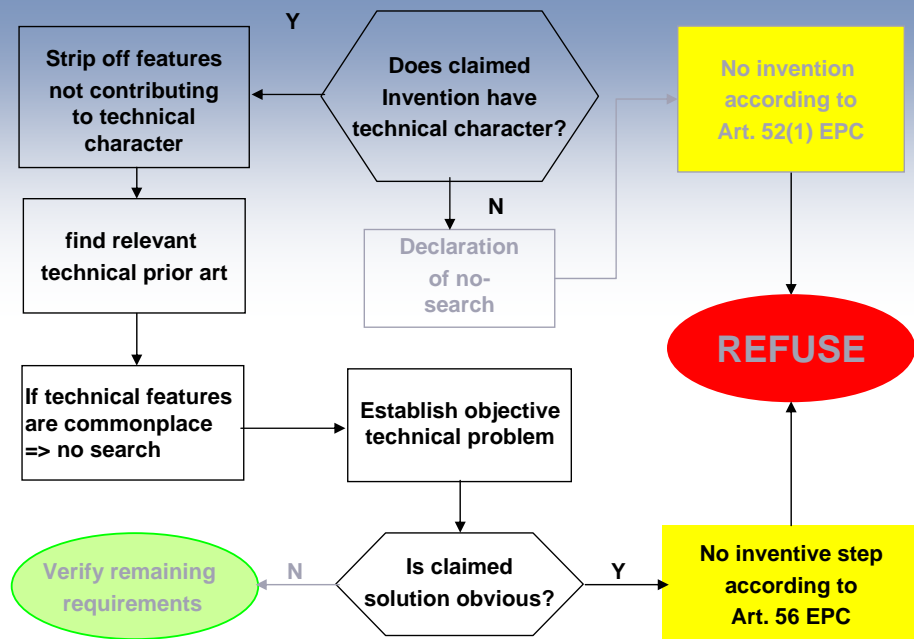
EPO Practice

Stage 2:

- **Closest prior art:**
"downloading data (e.g. music) from the Internet"
- **Distinguishing features:**
"debiting a mobile telephone account of the customer"
- **Effect of distinguishing features:**
"efficient settlement for purchased goods"
- **Objective problem:**
not technical!



EPO Practice



EPO Practice

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
- the audio and/or video data files are at least partly arranged to be encrypted by means of a password.



Joint Cluster
"Computers"

Requirements
of the EPC

Technicality

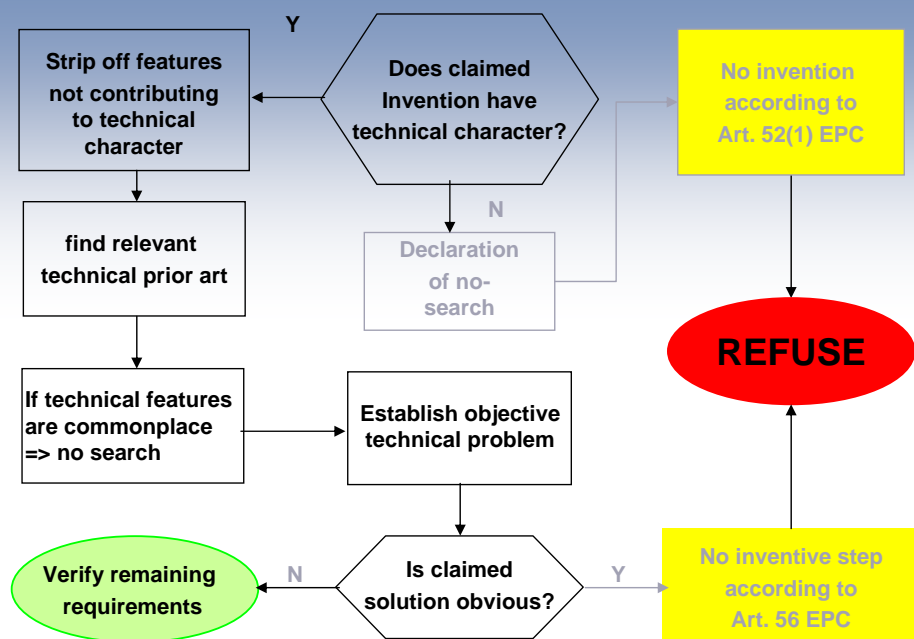
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Statistics

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EPO Practice



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Requirements
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Technicality

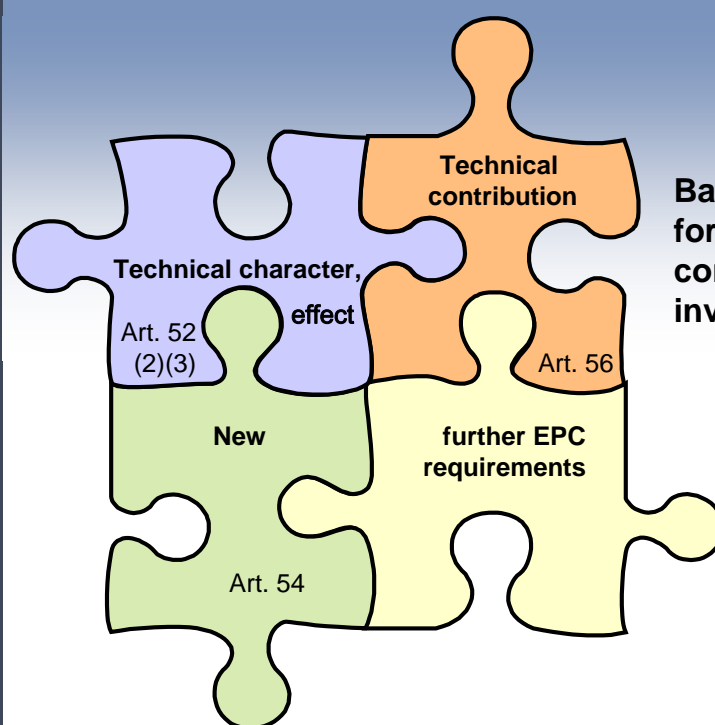
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EPO Practice



**Basic components
for the grant of a
computer-implemented
invention**



Statistics

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Technicality

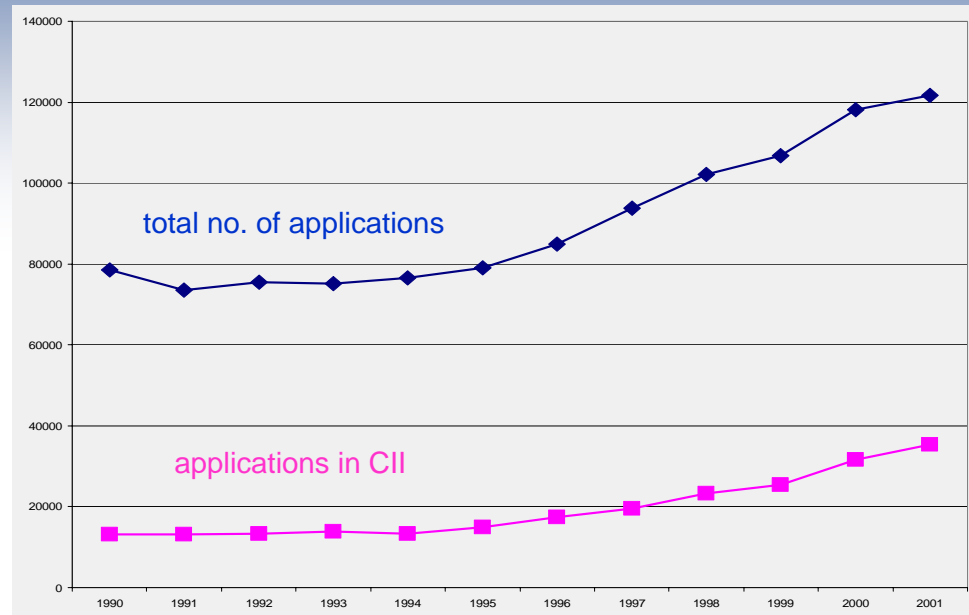
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Total and CII Applications at EPO



40



Statistics

Joint Cluster
"Computers"

Requirements
of the EPC

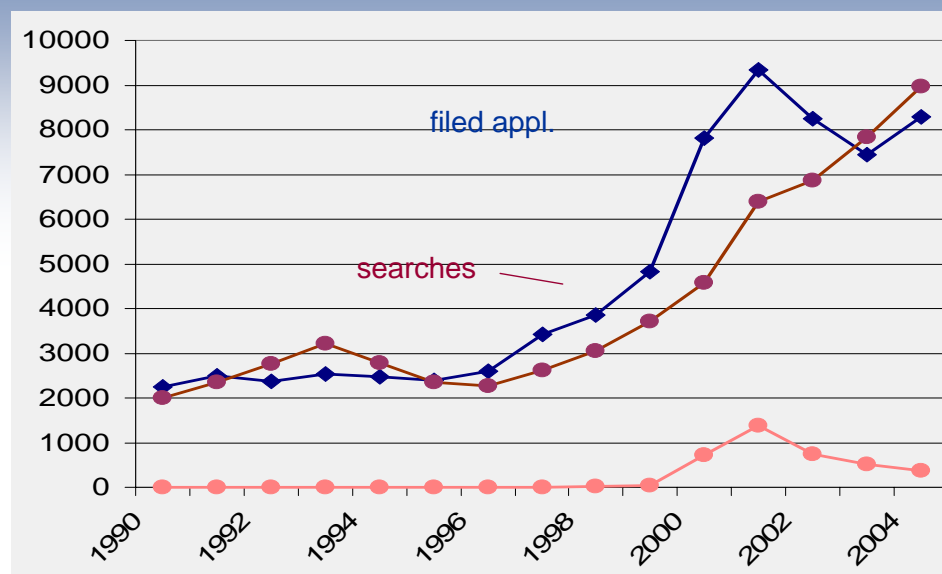
Technicality

EPO Practice

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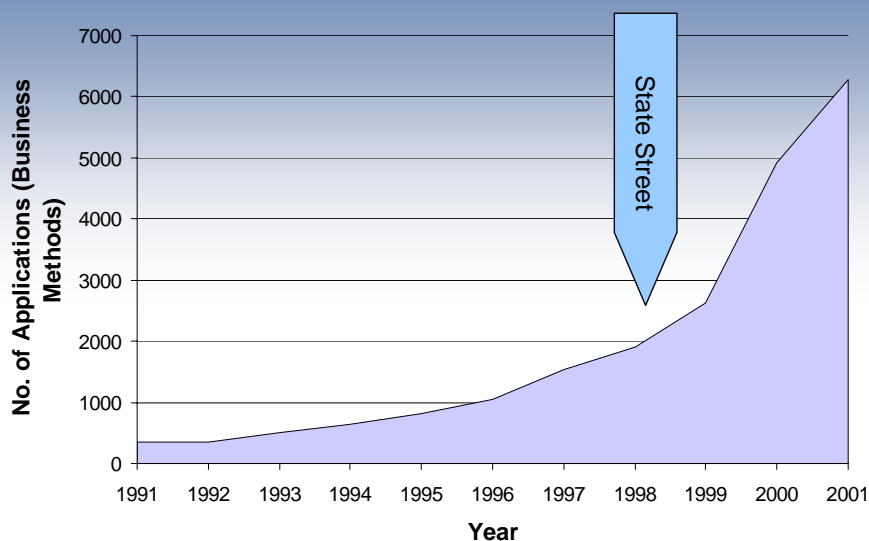
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Joint Cluster Computers





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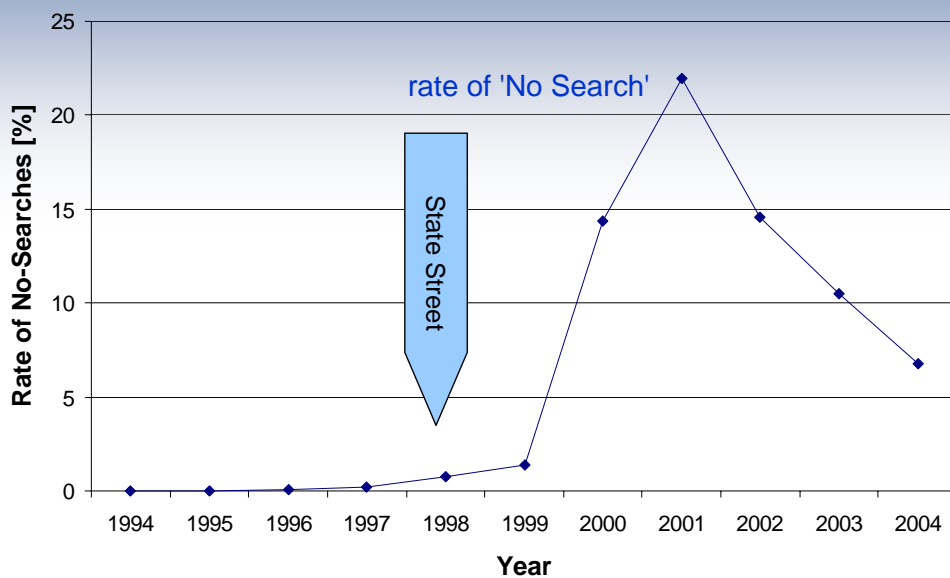


The number of applications to be searched at the EPO increased dramatically in the field of business methods.



Statistics

Rate = number of 'No Search' / the total number of applications
(in the field of business methods)





Joint Cluster
"Computers"

Requirements
of the EPC

Technicality

EPO Practice

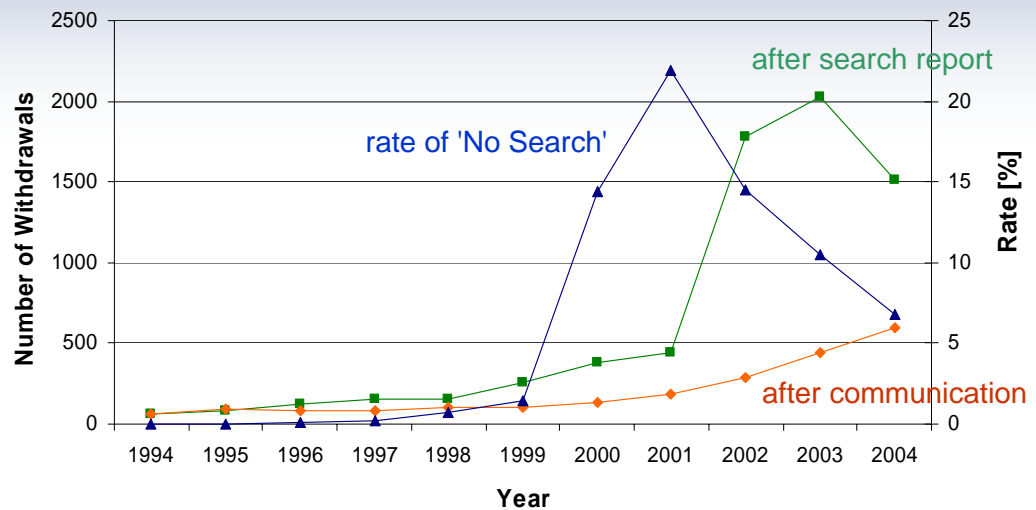
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Statistics

Number of withdrawals after 'No Search' and after written communication
(in the field of business methods)



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Guide for applicants

Dr. Jörg Machek
Director,
Dir. 2.2.21

