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Examination of CII and Business Methods Applications

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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
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?

- 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

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.
- 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

...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
Computer Programs: Further Technical Effect

- Normal technical effect
  - control of a brake in a car
  - faster communication between mobile phones
  - secure data transmission (encryption of data)
  - resource allocation in an operating system

- Further technical effect
  - aesthetical effects of music or of a video
  - new rules of an auction
  - selling and booking sailing cruise packages
  - calculation of a pension
Computer programs “as such”

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

source code

=> EXCLUDED (≠ invention)

EPO Practice

Step 1: Features not contributing to technical character

- find relevant technical prior art
  - If technical features are commonplace => no search

Step 2: Does claimed invention have technical character?

- Declaration of no-search

Step 3: Establish objective technical problem

- Is claimed solution obvious?

No invention according to Art. 52(1) EPC

No inventive step according to Art. 56 EPC

REFUSE
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.
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.

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

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*
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.
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?

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:

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.

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!
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.
Statistics

**Total and CII Applications at EPO**

- **Total no. of applications**
- **Applications in CII**

Data over years from 1990 to 2001:
- Applications in CII show a steady increase.
- Total applications show a more erratic pattern but also an overall increase.

**Joint Cluster Computers**

- **Filed appl.**
- **Searches**

Data over years from 1990 to 2004:
- Filed applications and searches show significant growth over time.
- The trend indicates a rising demand or interest in computer-related applications.
The number of applications to be searched at the EPO increased dramatically in the field of business methods.

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

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

Rate [%]

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Guide for applicants

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Dir. 2.2.21