

Patently better

UK software patentability is moving closer to the European position following a judgment by the English Court of Appeal. RENZO MARCHINI predicts the ruling will provide welcome increased certainty for businesses

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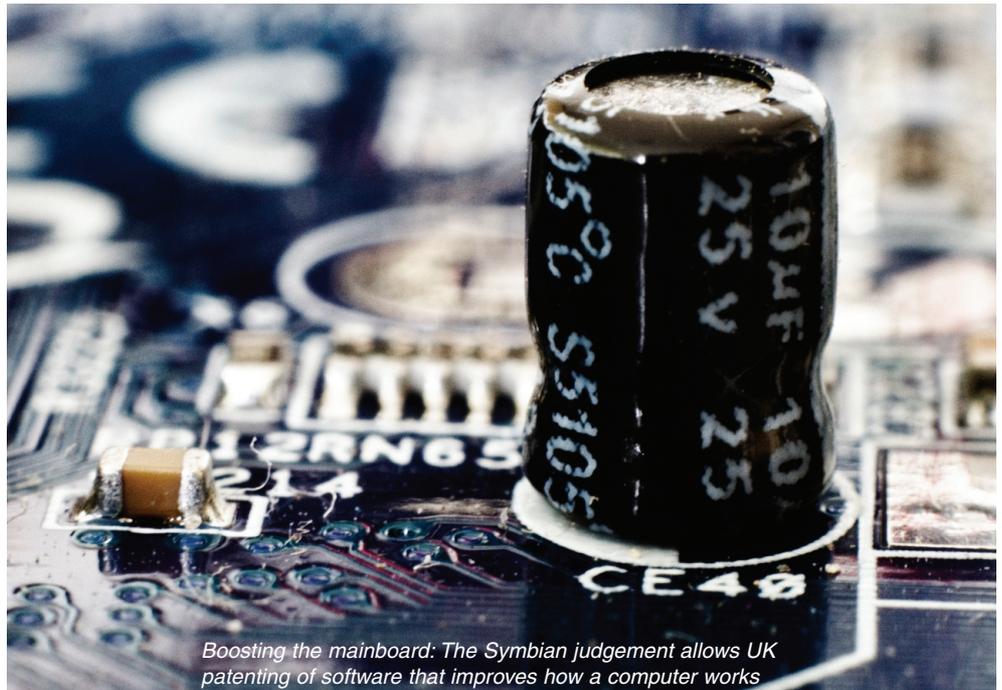
The long-awaited judgment by the UK Court of Appeal in *Symbian Ltd v Comptroller General of Patents* has finally been delivered, providing guidance on the thorny issue of precisely when software can be patented.

It is only two years since the Court of Appeal last considered the issue, having done so in the *Aerotel/Macrossan* case (*Aerotel Limited v Telco Limited*; *Macrossan's Application* [2007] 1 All ER 225), which was widely viewed by experts as putting a stop to momentum for greater availability.

But in the recent decision, the court has given fresh hope to software designers that this, the strongest of intellectual property protections, may well be available to their innovations – at least when the improvement makes the computer work faster or better, as opposed to making simply a better computing application in its own right.

Converging paths

In doing so, the court is clearly drawing closer to the stance of the European Patent Office (EPO). The two tribunals – the EPO and the UK courts – have in recent years been moving away from each other. Now, that divergence seems to be reversing, with the UK court calling for – and in this judgment demonstrating – a desire for ‘mutual compromise’.



Boosting the mainboard: The Symbian judgement allows UK patenting of software that improves how a computer works

What has changed since the 2006 *Aerotel* case? Sharp words had been exchanged by the rival tribunals – namely the UK court, which is the guardian of the UK Patents Act 1977, and the EPO Technical Board of Appeal, which is the guardian of the European Patent Convention (EPC) from which the UK Act derives. In particular, the UK court had accused the technical board of making ‘mutually contradictory’ decisions and ‘intellectual dishonesty’.

In turn, the latter claimed that the UK court was not being ‘consistent with a good-faith interpretation of the European Patent Convention’. Perhaps conscious of its earlier, somewhat deprecatory tone, the UK court is now

taking a much more conciliatory approach, promoting the idea that the two points of view are in fact reconcilable.

Issues of politeness and European camaraderie aside, the decision is good news for software developers. The UK approach – in applying the same rules to particular inventions – now seems to be moving towards that of the EPC. Prior to this case, the position in the UK was that computer programmes could in principle be patented if they made something (not a computer itself) work better – and when all other requirements, such as novelty and innovation, were being met. However, *Symbian* allows a patent where the something that works better is in fact the computer itself.

The case is all about the well-known exclusion in European patent law (see article 52(2) of the EPC) of computer programmes from patentability. However, this exclusion is complicated by article 52(3), which states that it only applies to the extent to which an application is for computer programmes ‘as such’.

Symbian's application concerned a method of accessing data in a dynamic link library (DLL) within a computer. DLLs were an existing means of storing functions common to a number of different applications, so that they were only required to be stored once. *Symbian's* alleged invention sought to provide an interface that was faster and more reliable than existing state-of-the-art systems.

The invention itself was already subject to a successful application at the EPO, and so failure in the UK would have led to the undesirable position of protection elsewhere in Europe but not in the UK. The UK Intellectual Property Office, following the guidance on how the issue should be approached in light of *Aerotel* (the 'four-stage approach'), initially refused the application. It did this on the basis that the invention was excluded from patentability on the grounds of only being a computer programme 'as such'. Mr Justice Patten allowed an initial appeal by Symbian and the office appealed that decision to the Court of Appeal.

Treading carefully

As a result of the technical board's recent criticism of the four-stage approach in the *Duns Licensing Associates* case, there has been a lot of tension between the EPO and the UK courts. The judgment in *Symbian* is a masterpiece in diplomacy as it tip-toes around this tricky area of law. The approach is conciliatory, but the court has still repeated an invitation to a more authoritative tribunal, and specifically an enlarged board of appeal, to provide clear guidance. This invitation was originally made during the *Aerotel* case.

In the spirit of 'mutual compromise', the court in *Symbian* recognised it was necessary to follow the

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technical board's approach in *Duns*. It found that the test of whether the claimed contribution to state-of-the-art technology can be said to be the excluded subject matter itself, is the same as determining whether or not a claim fails at the third and fourth stages of *Aerotel*.

Given that the application sought to register a computer programme, the issue should be resolved by answering the question of whether it reveals a 'technical contribution' to the state-of-the-art technology.

In deciding whether the alleged invention provided a technical contribution, the court followed the approach of the technical board of appeal in three earlier pre-*Aerotel* decisions:

- *Vicom/computer*: The fact that a new method and apparatus for digitally processing and manipulating images was implemented in the form of a computer programme was considered not to be decisive. Rather, the technical contribution to the known art, when considered as a whole, meant the method was capable of patent protection.
- *IBM Corp/data processor*

network: This case covered a new method of communicating between programmes and data files within the computer. It was held by the board to be properly 'regarded as solving a problem which is essentially technical' and therefore it was capable of patent registration.

■ *IBM Corp/computer-related invention*: Here, the claim related to a new data structure system embodied in an algorithm, which was faster and required less data storage than the state-of-the-art technology. The board again held the claim was technical in character.

Making a difference

Applying these principles, and some of its earlier decisions on this topic, the UK court found in *Symbian* that the claimed invention does make a technical contribution and is not therefore precluded from registration by article 52(2)(c). It emphasised that a computer containing the alleged invention will be a better computer and that the alleged invention solves a technical problem with the computer itself.

Furthermore, the court stated that 'the fact that the improvement may be software programmed into the computer rather than hardware forming part of

the computer cannot make a difference'. Moreover, the fact that the invention gave no improvement external to the computer 'gives no credit to the practical reality of what is achieved by the programme'.

As a matter of reality, the alleged invention was more than just a 'better programme', as it made a computer faster and more reliable. The invention was in fact 'technical'. The distinction between an improvement within or outside the computer is, in the end, irrelevant.

This judgment may come as a surprise to many who considered *Aerotel* to be more restrictive. However, many will welcome the development. First, the approaches of the UK and the EPO are closer now than they were before, and that provides the greater certainty that business requires.

Secondly, as a result it gives greater hope to those innovating in the software area that they will receive the same protection that others receive in different areas. ■ See the IP sector feature on p29

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