



FÉDÉRATION INTERNATIONALE DES CONSEILS EN PROPRIÉTÉ INDUSTRIELLE
COMMISSION D'ÉTUDES ET DE TRAVAIL (CET)

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PURPOSE:	DISTRIBUTION:	All attendees
AUTHOR:		David Merrylees, Workshop Reporter

WORKSHOP 3 – November 05, 2007

“Patenting of non-technical Subject Matter”

Present:

Chair – Alexander Esslinger (DE)
Reporter – David Merrylees (BR)

Peter Puchberg (AT)	Philippe Overath (BE)
Philippe Baechtold (CH)	François Curchod (CH)
Arturo Alessandri (CL)	Josef Plicka (CZ)
Dieter Laufthütte (DE)	Stephan Frieschem (DE)
Marcelino Curell Suñol (ES)	Jean Pierre Colas (FR)
Simon Rees (GB)	Constantinos Kilimiris (GR)
Donal O'Connor (IE)	Ena Pugatsch (IL)
Yoshio Inoue (JP)	Young-Wook Ha (KR)
Mariano Soni (MX)	Henrik Jan Brookhuis (NL)
Leo Jessen (NL)	Jon Heggstad (NO)
Julie Ballance (NZ)	Jan Modin (SE)
Max Waldbaum (US)	At Van Rooy (ZA)

Alexander Esslinger opened the workshop by introducing the development in the US from the 1980 Supreme Court decision *Diamond v. Chakrabarty* (“Everything under the sun made by man” is patentable) to the first business method patents sparked off by the 1998 CACF State Street decision which brought within the domain of patentability those “inventions” that produce a “useful, concrete and tangible result” (even if it be a dollar amount at the bottom line) without any requirement for technical means or content.

He also drew attention to the FICPI Vancouver resolution F that called for “adequate protection for commercially valuable innovations in information technology as applied in any area of business” and for the harmonisation of “patent protection in this”.

The members of the workshop had their attention also drawn to the results of the questionnaire on “Patent protection of software, computer-related inventions and business methods” (EXCO/ES07/CET/1701) as a starting point for the discussion. Three general approaches by different patent authorities could be identified:

- (i) The “anything under the sun” approach pioneered by the US granting patents for new and useful inventions in technical as well as non-technical fields;
- (ii) The “technical means” approach followed e.g. by JP, KR, CA, AU, or NZ requiring the use of technical devices, in particular a computer;
- (iii) The “technical contribution” approach formulated by the EPO, followed more or less by the European countries, Southern American countries (AR and CO) and China, requiring an invention, in order to be patentable, to provide a contribution to the solution of a technical problem.

It immediately became clear from the answers in the questionnaire as to the patentability of specific types of inventions involving software (see question 10), that there is a lack of clear consistency in the answers from different members of the EPC. This showed that the interpretation of the EPC is also different in different countries. Only the US respondent was able to answer that a non-computer based training method could be considered patentable.

The lack of unanimity between the members of the workshop became clear from the start. Moreover, it also showed that few members had preformed opinions as to what should in fact be protected which made the preparation of a resolution at this time inadvisable.

Within reason, the individual contributions were given looking at what would be desirable and not how local law should be interpreted. The US member present reported that uncontained grant of patents for any type of innovation, be it technical or not in nature, is under discussion in the US as well. Attention was drawn to the tendency in the US to redefine what is patentable by revisiting the § 101 definition of invention in addition to the novelty and non-obviousness requirements. In other words, the door is being opened to questioning whether certain innovations are inventions or not, even if new and not obvious.

The workshop discussed at length whether the simple inclusion of a computer in a claim according to the “technical means approach” should be determining as to patentability or not. The fairness was questioned of a good “inventive” idea not being patentable just because of its steps not being operated through a computer. The further discussion related to the lack of a proper definition of an “invention” and the problem of sufficient description to carry it out.

The standard questioning was made regarding the practical difficulties of searching non-technical solutions and the dangers of granting non-valid patents due to ineffective searches. In Korea, the workshop was told, that notwithstanding the need to have

software involved for a business method to be patentable, the majority of patents granted in the field have been found invalid for lack of novelty or inventive step. In reply it was pointed out that badly granted patents due to search limitations are not a sufficient ground to classify a whole area of innovations to the status of non-inventions.

The question was raised as to what other types of protection would be available for innovations without a technical character and the answer was in the negative.

Equally, the workshop was confronted with the question of industrial use. Others upheld the fact that methods of manufacture or industrial use could be outmoded definitions and require re-thinking. Why is an invention in the field of agriculture industrial but a business method not? Is business by definition not an industry ("service industry") if the same flexibility of interpretation is given as has been to agriculture?

Certain members of the workshop supported the grant of patents for all innovations that are novel and non-obvious, independently of their having a technical character or using technical means in their execution.

Since the workshop could not form an even marginally majority opinion, it was agreed that this is not the moment to prepare and adopt a resolution. In addition, the potential adverse political effects of a FICPI resolution supporting a broadening of the patent system were mentioned. However, it was unanimously considered that the question is of great importance, that the moment is one of change and that further study must be given to this question and that FICPI, through the CET, should continue its work.

Votes, however, were taken in an effort to direct future studies, as follows:

- a) 10 votes indicated that all innovations that are novel and non-obvious, independently of their having a technical character or using technical means in their execution, should be patentable;
- b) 8 votes indicated that some form of hardware or other technical means should be involved in order for patent protection be maintained; and
- c) 4 votes were in favour of the requirement of technical contribution to the art.

In spite of the above result, it has to be emphasised that the votes were "non-binding" in view of the recognition by all that this question is of sufficient importance to have further and deeper study.