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***“Intellectual Property lies at the centre of the modern company's economic success or failure”***

Lester Thurow : Economist

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## Patentability of Computer Programs – What is the Law?

by Virtuoso Legal 15/04/2008

In the UK it has long been established that computer programs are not classed as inventions and lack the inventive step to become patentable.

The European Patent Convention (EPC) supports this idea. However, in recent years there has been a clear conflict between the UK Intellectual Property Office (UK IPO) and the European Patent Office (EPO) on the application of the EPC. The EPO have adopted a more lenient approach when it comes to computer programs, whereas the UK has adopted a strict approach. This has resulted in confusion in this area of law.

In 2006 a joint Judgement was issued in the matters of *Aerotel* and *Macrossan* and a new 4 step test was laid down by the Court to help determine whether inventions involving computer software could be patented.

Although the 4 step test caused controversy as it was incompatible with the EPO's approach, it gave some stability and guidance for the assessment of the patentability of computer programs here in the UK. The test comprises the following four steps:

- » To construe the claim properly;
- » To identify the actual contribution
- » To ask whether it falls solely within the excluded subject matter;
- » To check whether the actual or alleged contribution is actually technical in nature.

The test was used to determine the patentability of computer programs, until recently. An appeal against the UK IPO by 5 patent applicants for their computer programs (*Astron Clinica's* Application) resulted in Mr Justice Kitchin commenting on how undesirable it is to have the EPC construed differently in the UK IPO and the EPO. In this case the applications involved image quality and a semi conductor chip design; although the IPO ascertained that the methods which were used were patentable they concluded that the programs were not and on those grounds refused the patent applications. Mr Justice Kitchin decided that there are in fact cases where it will be possible to

interpret the 4 step test to bring the UK more into line with the rest of Europe.

However, as soon as there appeared to be light at the end of the tunnel there was again more confusion. In the case of *Autonomy*, a Judgement less than two weeks after the decision in *Astron Clinica*, the High Court ruled that in fact, if there is no technical effect outside the software then the software will not be patentable. In this case the application was for a system for searching for files on a computer

It seems that the lack of clarity remains. To cloud matters even further the Judgment of *Symbian's* Patent Application on March 18 2008 has overturned the *Autonomy* decision by allowing the program in this case to be patented. The application was for indexing of library functions to ensure operating stability.

The divide between the EPO and the UK IPO was again noted by Judge Patten. The EPO has granted *Symbian* a patent for its invention. In the meantime, according to a press release from the UK IPO on 18 March 2008, the UK IPO are appealing against the Judgment to seek clarity on the law in this area and in the meantime they will be 'continuing to follow the practice, set out in its practice notices issued in November 2006 and February 2008 which are founded on the established *Aerotel/Macrossan* test.' However, they will also take account of the *Symbian* Judgement in appropriate cases.

It appears for the moment that the safest option albeit the most expensive option for inventors whose invention includes any software is to file directly with the EPO.

The decision of the appeal by the UK IPO will hopefully make clear this murky area of law once and for all and assist inventors and practitioners alike when dealing with inventions containing any software content.

S.1(2)(c) Patents Act 1977

Article 52 (2) (3)

Video Game - KONAMI T928/03

*Aerotel Ltd v Telco Holdings Ltd (and Others)* and *Macrossan's* Application [2006] EWCA Civ 137 (27 October 2006)

*Astron Clinica's* Application and Others Applications [2008] EWHC 85 (Pat) (25 January 2008)

*Autonomy Corporation's* Application [2008] EWHC 146 (Pat) (6 February 2008).

*Symbian Limited's* Application [2008] EWHC 518 (Pat) (18 March 2008)