



# Software patents – do the ends justify the means?

**The requirements for the patentability of computer-implemented inventions in Europe are notoriously difficult to pin down. Two recent judgments offer an opportunity to consider the English approach and compare it with that of the European Patent Office**

## Is software patentable?

In Europe, the law in relation to the patentability of software is notionally harmonised under the European Patent Convention (EPC). Article 52 of the EPC provides that computer programs “as such” are not patentable.

The European Patent Office (EPO) has developed a practice in which a patent application’s claims are split into technical and non-technical features. The non-technical features (eg, software) are stripped out when considering whether the contribution over the prior art is obvious.

Despite the English courts recognising that they must follow EPO case law, in this area they have refused to do so, stating that the EPO’s position is insufficiently settled. They have instead focused on whether the contribution of the invention is excluded subject matter. In *Aerotel* the UK Court of Appeal developed the following test:

- Properly construe the claim.
- Identify the actual contribution.
- Ask whether that contribution falls solely within excluded subject matter.
- Check whether the contribution is actually ‘technical’ in nature.

The courts have proposed a number of signposts which indicate technical contribution:

- Whether the claimed technical effect has a technical effect on a process which is carried on outside the computer.
- Whether the claimed technical effect operates at the level of the architecture of the computer – that is, whether the effect is produced irrespective of the data being processed or the applications being run.
- Whether the claimed technical effect results in the computer being made to

operate in a new way.

- Whether there is an increase in the speed or reliability of the computer.
- Whether the perceived problem is overcome by the claimed invention as opposed to merely being circumvented.

## Apple’s patent – excluded subject matter?

In *HTC v Apple*, one of the three patents which HTC succeeded in revoking at first instance taught a method of developing software for devices which allow multiple touches to be made on different areas of the screen simultaneously.

At first instance, Justice Floyd applied *Aerotel* and the signposts, and concluded that the relevant contribution was in easing the writing of software for such multi-touch devices. It had no real-world effect on the way that the device performed – it was impossible to tell whether the device had been programmed using the invention. He concluded it was not patentable, being software as such.

However, the Court of Appeal reversed that finding, stating that the problem of dealing with multiple touches was a technical problem. The solution, while implemented in software, caused the devices to operate in a new and improved way and provided an improved interface for application programmers.

The fourth signpost was broadened to “whether a program makes the computer a better computer in the sense of running more efficiently and effectively as a computer”. The court held that the invention did result in a better device, as it was easier to program.

## Further guidance – Lantana’s patent

In *Lantana* the High Court considered the UK Intellectual Property Office’s (UKIPO) decision that Lantana’s patent application was invalid, being software as such. Lantana’s invention enabled a first computer to control and request data from a second remote computer via email. The invention sought to overcome the problem that access of a second computer by a first would otherwise require a continuous connection.

Lantana’s argument that the claims had been considered to be novel and inventive by the UKIPO, and that this confirmed there was a technical contribution, was rejected. Applying *Aerotel* and the signposts, the judge concluded there was no technical contribution:

- The invention took place solely inside the computers – it had no technical effect outside.
- The computers’ architectures were conventional.
- The computers were not operating in a new way – at the priority date it was well known to transmit code between two remote computers by email.
- There was no evidence that the computers were intrinsically more reliable, effective or efficient.
- The proposed solution circumvented the problem of maintaining a continuous connection.

## No straightforward test

In *HTC*, experienced patent judges at first instance and appeal considered the same facts and subjected them to the same legal tests, yet came to different conclusions. This shows the inherent difficulty in assessing whether, for any particular invention, a ‘technical’ contribution exists.

As seen in *Lantana*, the requirement that each invention be judged on its own contribution to the state of the art at the priority date shows that past decisions are often of little assistance in assessing whether there is a technical contribution. Whether a technical contribution exists is intrinsically linked to the state of the art at the priority date.

Ultimately, *HTC* and *Lantana* show that there is a fine line between software which the courts consider worthy of patent protection and that which is not. These latest cases demonstrate that the English courts remain committed to taking a different route from the EPO even though it remains far from straightforward to apply.

**Alex Wilson** is a partner and **Tom Oliver** an associate at Powell Gilbert LLP