

Patenting software

Software is used to implement innovations in a very wide range of fields, from medical scanners to mobile phones, laptop computers to car engines, and even running fast food outlets or operating a pension scheme. In Europe, whether these innovations can be protected by a patent depends on one fundamental question. Is there a contribution to a field of technology?

Technology

The European Patent Convention says that patents can be granted for "any inventions, in all fields of technology". This wording was only enshrined in patent law in December 2007 but for many years before then, the European Patent Office had built up a practice of requiring an invention to provide a technical contribution. Various attempts have been made to define what constitutes a technical contribution but none is completely satisfactory. At one extreme, using a standard spreadsheet package running on a standard computer to carry out a calculation for a financial scheme does not provide a contribution to a field of technology. At the other extreme, an engine management system that controls a car engine so as to improve efficiency and reduce emissions, is a technical improvement even if it is implemented by engine management software. The position of innovations between these extremes is frequently unclear. Each case must be assessed individually.

Excluded fields

Both UK and European law list certain fields for which patents cannot be granted. These include mathematical methods, aesthetic creations, rules for playing games, methods of doing business, the presentation of information, and programs for computers. This list of exclusions is misleading. In practice, the exclusions are not absolute and if there is a technical contribution they do not apply.

Patent claims

It is possible to claim a method, apparatus, and software as such. Software can be claimed as a set of instructions which will configure equipment, such as a computer, to operate in a particular way. Software can be covered whether it is supplied on a physical medium such as a DVD, or is downloaded over the Internet. As regards data processing systems, care has to be taken if some of the data processing can be carried out at one site and some

at another site. To obtain comprehensive protection may require patent claims in a number of different categories, to cover the overall system and what happens at the individual sites. Patent Office examiners frequently object to the presence of multiple categories of claim, and in the European Patent Office there are significant additional fees if the total number of claims exceeds 15. Particular claim structures must be developed to do deal with these problems.

Inventive step

The approach to examining computer implemented inventions differs between the United Kingdom and the European Patent Office. In the UK, inventive step is assessed as it would be for any other type of invention. In the European Patent Office, they examine computer implemented inventions in a particular way and in practice they set a higher standard of inventive step than for other fields of technology. For non-technical cases the outcome is usually the same but if an invention is clearly in a field of technology, in some cases a favourable outcome may be more likely through the UK national route in view of the approach to inventive step.

Business methods

In the implementation of business methods, share trading schemes, online gambling systems and so forth, there may be innovative technology, such as a particular architecture that allows practical benefits to be obtained, or an authentication technique for security purposes. However, the context of these inventions may lead Patent Office examiners to approach the claims with a certain amount of prejudice. It is important to draft the patent specification so as to present the invention in the best possible light. This can be particularly difficult when the original problem was not a technical one. Even though significant technical innovation has been required to implement a solution to a commercial problem, there can be prejudice.

Overseas

A number of countries outside Europe take a more liberal approach to patenting computer implemented inventions. The United States is one example, although the attitudes there have hardened somewhat over the years. Even if the prospects for obtaining a patent in Europe do not look good, an application in any of these other countries may be worthwhile.

Further advice

For further advice please contact us at Dehns using the details below.



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