

EPO answers to Kauppi questions available

<http://swpat.ffii.org/lisri/04/kober0114/index.en.html>

Workgroup

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A spokesman of the European Patent Office has provided official answers of the EPO to questions which MEP Piiia-Noora Kauppi submitted to president Kober before his visit to the European Parliament on November 27. The answers are evasive and it is unclear whether Kober himself stands by them.

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1 The Text

Questions to EPO president, Mr. Ingo Kober 27/11/03

Answers by David Sant, EPO Brussels Office 17/12/03

- 1. We welcome the EPO's new mission statement of "strengthening innovation and economic growth in the interest of European citizens". In the European Parliament we have decided by large majority that certain*

*<http://www.ffii.org/~phm>

classes of patents which are currently granted by the EPO do not serve innovation and economic growth. Is this reason enough for the EPO to consider stopping to grant such patents?

REPLY: NO. In examining patent applications and granting European patents, the EPO is only bound by the European Patent Convention (EPC). The European Patent Organisation is an independent intergovernmental organisation, which is not subject to Community law or decisions taken by institutions of the Community. However, where Community legislation affects the European Patent Convention, it is up to the European Patent Organisation and its member states to examine and decide whether and how the EPC needs to be brought in line with Community law, such as a directive or regulation.

- 2. Vice president Desantos said in Paris at OECD that indeed this might be a reason for the EPO to reconsider the whole policy on software. Desantos and his colleagues showed a remarkable spirit of political leadership, very much contrasting with that of the USPTO's officials at that conference. And it's not the only time that this has been remarked. You have said something similar to a Belgian newspaper last November. Art 52 seems to give you a legitimate basis for refusing to grant software and business method patents. In case you do consider this option, what obstacle is there to overcome? Who will be the resisting forces, who might be the supporting ones?*

REPLY: In examining European patent applications the responsible departments of the EPO examining and opposition divisions as well as the boards of appeal are bound by the provisions of the European patent Convention and nothing else. Where an application does not meet the requirements of the Convention, including Art. 52 EPC, the grant of a patent has to be, and will be refused. Applications involving computer programs or business methods are treated in exactly the same way as applications in any other field of technology.

- 3. The current EPO practice on software appears to be based on a series of decisions taken by very few people at the Technical Boards of Appeal, from Vicom (1986) to IBM I & II (1998) and Pension Benefit Systems (2000). Did the TBA arrive at these decisions independently or do they reflect an underlying decision by the EPO (President or the Administrative Council)?*

REPLY: The EPO boards of appeal (albeit part of the EPO so far) and their members enjoy full judicial independence. In their decisions the members of the boards are not bound by any instructions (issued by the President of the EPO, the Administrative Council or anybody else) and shall comply only with the provisions of the EPC, Article 23(3).

- 4. Some say that not the TBA but only the Enlarged Board of Appeal (EBA) could possibly have been legitimated to take decisions on fun-*

damental legal matters. To what degree are these decisions binding for the EPO today?

REPLY: The decisions of the boards of appeal are binding on the EPO only in the individual case in question. Some decisions which are of a general importance to the practice of the EPO in grant or opposition proceedings are reflected in the EPO Guidelines for Examination which have to be applied by the examining and opposition divisions in normal cases. Decisions of the Enlarged Board of Appeal usually are of such a general importance to EPO practice and therefore incorporated into the Guidelines so as to ensure that they are respected by the other EPO departments.

5. Can the EPO not decide to adopt a different administrative practise, based on the political will that has been expressed by the Parliament, which is the only elected legislative body in the EU?

REPLY: NO. Again, the EPO is bound only by the EPC and secondary legislation enacted in accordance with the EPC.

6. What about taking the matter to the Enlarged Board of Appeal and asking them to overrule the TBA?

REPLY: Under the EPC the President of the EPO has only limited powers to bring a case or point of law before the Enlarged Board of Appeal. Under Article 112(1)(b) EPC the President may refer a point of law to the Enlarged Board of Appeal only where two boards of appeal have given different decisions on that point. In the field of computerimplemented inventions such has not been the case so far. However, any board of appeal shall refer any question to the Enlarged Board if it considers that a decision is required to ensure uniform applications of the EPC or if an important point of law arises. Again, in the field of computerimplemented inventions no board of appeal considered this to be necessary up to now.

7. CEC has suggested establishing a quality control division in EPO. Do you believe that such a quality control division would be a useful addition to the EPO structure?

REPLY: NO: There are sufficient and effective quality control mechanisms in place both inside and outside the office. Any patent granted by the EPO may be opposed by any person within 9 months after publication of the patent and decisions of the opposition divisions may be appealed to a board of appeal. Furthermore, even after the opposition period has expired any European patent may be revoked by the national courts of the contracting states for which the patent has been granted.

8. Do you believe there are systematic problems of quality in any areas of the EPO's work?

REPLY: NO.

9. *Are there any areas of patentability which should be particularly investigated to determine whether the current*

REPLY: NO. The EPO attaches the greatest importance to high and homogeneous quality of its products and services in all fields of technology. The mission of the EPO is to set patent protection standards responding to the needs of the users and setting a benchmark for best patent practice. An internal EPO working group was set up this year to review the issue of strategic quality at the EPO. The results of this ambitious project are expected in spring next year.

10. *Could you give an orderofmagnitude estimate of the number of*

REPLY: NO. This is a hypothetical question which cannot of course be answered.

11. *Would you be the right person to choose the members of such a division, or would it be better for them to be independently nominated by the legislatures of the EPC member states (including the EU)?*

REPLY: Hypothetical question as before.

12. *What is the real reason mathematical formula aren't patentable and why doesn't that apply to computer programs?*

REPLY: Mathematical methods as such are not regarded as patentable inventions, Article 52(2) (a) EPC, as are computer programs per se, Article 52(2)(c). These rules do not automatically apply to a computerimplemented invention which meets the requirements of the EPC i.e. has a technical character, is new and inventive.

13. *It has been argued that proposed Art. 3a (which says data processing is not a field of technology) would preclude patenting computers or data processing devices. Yet, music is not a field of technology but musical instruments (and CDplayers &c) can be patented. What is the difference?*

REPLY: The comparison between music and musical instruments is beside the point. There is a clear difference if proposed Article 3a of the Directive would indeed mean that patent protection for computers or data processing devices was no longer available.

14. *How exactly do you determine whether something 'advances the state of the Art' or 'makes a technical contribution'? Or, when do you ever decide it doesn't?*

REPLY: The question whether a claimed invention makes a technical contribution to the art is assessed in accordance with the approach outlined in the EPO Guidelines for Examination (Part CIV, 2) which is based on the case law of the boards of appeal.

15. *What is EPO's position on the effect of competition in encouraging innovation, and in particular when (if ever) patents might actually hinder innovation by stifling competition?*

REPLY: We share the general view that patents are indeed an important tool to promote innovation and competition. Once again, the mission of the EPO is to support innovation, competitiveness and economic growth for the benefit of the citizens of Europe.

16. *Does EPO see any problems in the potential conflict between patents and citizens' rights of fair use?*

REPLY: It's difficult to see where potential conflict between patents and citizens' rights of fair use may arise. Fair use is a copyright concept which has no equivalent in patent law. However, the rights conferred by a patent are subject to some limitations such as private or experimental use as provided for by the national laws.

17. *Assuming the office had plenty of resources to do examination in a perfect way, how much income in fees would it lose with each rejected patent as compared to what would it get if granted? Is additional expenditure on examination sustainable in case some applicant drowns the office in invalid patent applications and appeals? What mechanism is there to respond to such a kind of service attack by applicants, besides degrading examination standards and hoping for judges to invalidate granted patents?*

REPLY: Hypothetical questions. All applications are examined carefully and rejected if they do not meet the requirements of the EPC. Financial considerations have no impact at all on the manner in which applications are processed by the EPO.

18. *How do you reconcile your behaviour in granting such patents as, e.g., the Amazon gift order patent with the examination guidelines of 1978 and with article 52 of the European Patent Convention? (<http://swpat.ffii.org/patents/samples/ep927945/index.en.html>)*

REPLY: No comment! It is not for the President of the EPO to comment on individual cases which have been settled by the responsible departments of the EPO. Any person may oppose a patent where she/he thinks that the patent shouldn't have been granted. By the way the recent version of the EPO Guidelines for Examinations has been issued in 2001.

19. *Would it really be acceptable to grant a patent to the use of nonEnglish languages in Internet addresses?*

REPLY: At first glance, no. But every case has to be looked into and decided on its own merits.

20. *How would the directive in various forms affect the sample "inventions" in <http://swpat.ffii.org/analysis/testsuite/>?*

REPLY: No comment.

21. *What is currently the average time for an ICT patent to be granted in the EPO? And how long does it take to receive the preliminary research*

report of the second phase of the PCT process? Do you think these timelines are reasonable and what are you planning to do to change this?

REPLY: The question apparently concerns the average time it takes for granting a European patent based on a PCT application. Here it should be borne in mind that under the PCT there is a period of 31 months from the priority date which the applicant has to decide whether he wants to enter the European phase, either after only the international search or, as the case may be, an international preliminary examination. Only after that period has expired and the applicant enters the European phase substantive examination on the EPO can start. Our aim is to complete the examination within three years after entry into the European phase.

22. *Is it true, what companies say, that at the moment it is possible to patent business models if you are able to*

REPLY: NO. It is not the manner in which an invention is presented and claimed but rather the substance which is decisive to the assessment whether or not there is a patentable invention which meets the requirements of the EPC.

2 Annotated Links

- **EPO President to speak before European Parliament¹**

On 27 November 2003 the European Parliament's Committees for Industry and Legal Affairs will hold a joint meeting to hear a presentation by Ingo KOBER, President of the European Patent Office, on the mission and functions of EPO.

¹<http://localhost/swpat/lisri/03/kober1106/index.en.html>