

# EPO 1990: T 0022/85

<http://swpat.ffii.org/papri/epo-t850022/index.en.html>

Workgroup

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A Technical Board of Appeal of the European Patent Office (EPO) rejects a patent application which is directed to a program for computers. In 1984, the EPO's examiners had rejected the patents based on the original Examination Guidelines of 1978, saying that the claims referred to a "program for computers". The appellant argued on the basis of newer Guidelines and caselaw that his claims are directed to technical effects and not a program as such. The Board of Appeal rejects the appeal by arguing indirectly that the use of general-purpose computer hardware does not confer technicity on an abstract method: "Abstracting a document, storing the abstract, and retrieving it in response to a query falls as such within the category of schemes, rules and methods for performing mental acts and constitutes therefore non-patentable subject-matter under Article 52 EPC" and "The mere setting out of the sequence of steps necessary to perform an activity, excluded as such from patentability under Article 52 EPC, in terms of functions or functional means to be realised with the aid of conventional computer hardware elements does not import any technical considerations and cannot, therefore, lend a technical character to that activity and thereby overcome the exclusion from patentability."

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

**title:** EPO 1990: T 0022/85

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## 1 introduction

The EPO rejects a patent application which is directed to a program for computers.

In 1984, the EPO's examiners had rejected the patents based on the original Examination Guidelines of 1978<sup>1</sup>, saying that the claims referred to a program for computers in verbal clothing.

The appellant argued on the basis of newer Guidelines and caselaw that his claims are directed to further technical effects and not a program as such. This time, in 1988, the Board of Appeal evades the question of what "programs for computer" are in the EPC context and instead rejects the appeal by arguing indirectly that the use of general-purpose computer hardware does not confer technicity on an abstract method:

*Abstracting a document, storing the abstract, and retrieving it in response to a query falls as such within the category of schemes, rules and methods for performing mental acts and constitutes therefore non-patentable subject-matter under Article 52 EPC*

*The mere setting out of the sequence of steps necessary to perform an activity, excluded as such from patentability under Article 52 EPC, in terms of functions or functional means to be realised with the aid of conventional computer hardware elements does not import any technical considerations and cannot, therefore, lend a technical character to that activity and thereby overcome the exclusion from patentability.*

The EPO's judges, still in 1990, pronounce remarkable insights such as:

*3. The requirement that an invention must have a technical character or in other words, must provide a technical contribution to the art is at the basis of a long-standing legal practice in at least the majority of Contracting States of the EPO. Neither from the terms of Article 52 EPC, nor from the legislative history of that Article as appearing from the preparatory documents can it be deduced that these Contracting States would have intended to deviate from their national laws and jurisprudence in this respect. On the contrary, it seems to be borne out by the list of exceptions in Article 52(2)(a) to (d) EPC that they did not wish to do so.*

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<sup>1</sup><http://localhost/swpat/papri/epo-g178/index.en.html>

[...]

7. *The claims effectively seek protection for systems and methods in which conventional computer means are controlled by a program so as to carry out abstracting, storing or retrieving of documents in accordance with the said set of rules. The new contribution to the art made in the present case, however, lies clearly essentially in the provision of this set of rules. Insofar the claims have to be regarded as being related to subject-matter which is excluded under Article 52(2) and (3) EPC as such.*

[...]

10. *In the opinion of the Board it cannot have been intended by the Contracting States to the EPC that express exclusions from patentability could be circumvented simply by the manner in which the invention is expressed in a claim.*

[...]

The Examining Division had in 1984 taken an even more straightforward view of Art 52(2)(c), based on the then used Examination Guidelines:

*II. The reason given for the refusal was that the contribution to the art resided solely in a computer program as such within the meaning of Article 52 EPC, paragraphs 2(c) and*

*3. Consequently, this subject-matter was not a patentable invention within the meaning of Article 52(1) EPC, in whatever form it was claimed.*

*III. In arriving at this conclusion the Examining Division argued on the basis that Claims 1 and 2 related to a method for automatically abstracting and storing an input document in an information storage and retrieval system and Claims 3-6 to a corresponding method for retrieving a document from the system. The claims specifically referred to a dictionary memory, input means, a main memory and a processor. These hardware elements were classical elements of an information and retrieval system (as described e.g. in: Hillman, Proceedings Spring Joint Computer Conference, 1969, pp. 447-455) and objectionable under Article 54(2) EPC as lacking novelty. According to the present description (see page 4, line 26 to page 5, line 4 and lines 22 to 28 and page 6, line 15 to page 8, line 19) the method steps were implemented by programming such a classical system. The claimed combination of steps did not imply an unusual use of the individual hardware elements involved. The claims merely defined a collocation of known hardware and new software concerned with document information to be stored but not with an unexpected or unconventional way of operating the known hardware. The differences between the prior art and the subject-matter of the present application were defined by functions to be realised by a computer program which was used to implement a particular algorithm, or mathematical method, for analysing a*

*document. In other words the steps of the method defined operations which were based on the content of the information and were independent of the particular hardware used.*

## 2 Annotated Links

- **Art 52 EPC: Interpretation and Revision<sup>2</sup>**

The limits of what is patentable which were laid down in the European Patent Convention of 1973 have been eroded over the years. Influential patent courts have interpreted Art 52 in a way that renders it obscure and meaningless. Not all courts have followed this interpretation, and numerous law scholars have shown why it is not permissible. The EPO had accepted the inconsistencies in anticipation of an expected change of law. However this expectation was frustrated in 2000 by the governments and in 2003 by the European Parliament. The Parliament voted for a clarification which gives Art 52 back its meaning. Meanwhile, proponents from all sides have proposed to modify Art 52(3) EPC in one or the other way, of course while claiming that this merely serves to “clarify the status quo” or to implement a directive which serves this purpose, and, since the European Commission and the Council have not signalled support for the Parliament’s approach, there is still no common understanding of which “status quo” we are talking about.

- **Patentjurisprudenz auf Schlitterkurs – der Preis fr die Demontage des Technikbegriffs<sup>3</sup>**

So far computer programs and other *rules of organisation and calculation* are not *patentable inventions* according to European law. This doesn’t mean that a patentable manufacturing process may not be controlled by software. However the European Patent Office and some national courts have gradually blurred the formerly sharp boundary between material and immaterial innovation, thus risking to break the whole system and plunge it into a quagmire of arbitrariness, legal insecurity and dysfunctionality. This article offers an introduction and an overview of relevant research literature.

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<sup>2</sup><http://localhost/swpat/stidi/epc52/index.en.html>

<sup>3</sup><http://localhost/swpat/stidi/korcu/index.en.html>