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Patent and Trade Mark Attorneys

What is Patentable? - UK & EPO

- UK Patents Act:

*A patent may be granted only for **an invention** in respect of which the following conditions are satisfied, that is to say -*

- (a) the invention is **new**;*
- (b) it involves an **inventive step**;*
- (c) it is capable of industrial application;*

- The European Patent Convention on Patentable Inventions:

*European patents shall be granted for **any inventions** which are susceptible of industrial application, **which are new and which involve an inventive step**.*

What is Patentable? - US

Title 35 United States Code, section 101:

35 U.S.C. 101 Inventions patentable.

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Novelty

- An invention is new if it is not part of the state of the art
- **“State of the art”**: everything available to the public before filing date



Inventive Step

- Comparison with the state of the art – **was it obvious?**
- Beware of hindsight analysis
- “The skilled person”



What is not Patentable? - UK & EPO

It is hereby declared that the following (among other things) are not inventions for the purposes of this Act, that is to say, anything which consists of –

- (a) a discovery, scientific theory or mathematical method;*
- (b) a literary, dramatic, musical or artistic work or any other aesthetic creation whatsoever;*
- (c) a scheme, rule or method for performing a mental act, playing a game or doing business, or a **program for a computer**;*
- (d) the presentation of information;*

*but the foregoing provision shall prevent anything from being treated as an invention for the purposes of this Act **only to the extent that a patent or application for a patent relates to that thing as such.***

What is not Patentable? - US

US statute says...

... nothing!

UK Practice

- Settling law.
 - Excluded subject matter?
- Four Step Test (Aerotel 2007):
 1. Construe the claim;
 2. Identify the actual contribution;
 3. Ask whether it falls solely within excluded subject matter;
 4. Check whether the actual or alleged contribution is actually technical in nature.

UK Practice

- What is a technical contribution?
- Five Signposts (ATT & Cvon 2009):
 1. Effect on a process external to the computer.
 2. Effect on architecture of the computer (irrespective of the data).
 3. Computer operates in a new way.
 4. Increase in speed or reliability of the computer.
 5. Problem overcome, not just circumvented.

EPO Practice

- Settled law.
 - Excluded subject matter?
- Does the claim involve a technical means?
- If yes then assess inventive step:
 - Only technical elements can contribute to the inventive step.
 - Non technical elements are ignored.

EPO Practice

- Ignoring any non-technical features, does the claim provide an inventive step?
- Very loosely speaking, a non-technical feature does not add a technical function. For example:
 - a credit rating
 - a purchase price
 - colour
 - advertising
 - a discount

EPO Practice

- Consider the following claim:

Apparatus that is arranged to:

- (a) advertise shares for sale on the internet;
- (b) receive bids for shares from the internet; and
- (c) allocate the shares to the highest bidder.

EPO Practice

- Consider the following claim:

Apparatus that is arranged to:

- (a) advertise shares for sale on the internet;
- (b) receive bids for shares from the internet; and
- (c) allocate the shares to the highest bidder.

EPO Practice

- Consider the following claim:

Apparatus that is arranged to:

- (a) put information on the internet;
- (b) receive bids for shares from the internet; and
- (c) allocate the shares to the highest bidder.

EPO Practice

- Consider the following claim:

Apparatus that is arranged to:

(a) put information on the internet;

(b) receive bids for shares from the internet; and

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Obvious!

US Practice

- Very recently in flux (Bilski 2010).
- Is claim directed to abstract idea?
- Factors weighing in favour of patentability:
 - inclusion of a machine or transformation of an article;
 - application of a law of nature;
 - more than a mere statement of a concept.
- 'Machine' includes electronic devices, i.e. computers.
- 'Article' may be physical object or electronic data.
- Novelty & Obviousness tests still apply.

Summary

- EPO settled law.
- UK & US settling after recent change.
- UK - Agonise over technical contribution before inventive step.
- EPO - Any technical means will do but strict on inventive step.
- US - almost anything goes!
- Rest of the World;
 - Japan: Wholly computerised methods OK, usual high standard of inventive step applies.
 - Canada: 'must effect a physical agent & produce a change of character or condition'.

Thank You

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