

Patent law briefing

Symbian Limited and Comptroller General of Patents: are the UK and Europe aligned again?

by Richard Lawrence

Since the *Aerotel/Macrossan* judgement in 2006, the UK Intellectual Property Office and the English courts have taken a very different view to the European Patent Office as to what kinds of software-implemented invention can be protected by patent.

The judgement of the English Court of Appeal in *Symbian* brings UK law and practice much more closely into line with that of the EPO. In this case, the Court of Appeal accepted that a claim to a software invention which improves the operation of a computer running the new software is potentially patentable, and is not to be rejected as being directed to "a computer program as such".

The consequences for prosecuting software patent applications in the UK are not yet clear, but the judgement provides reassurance about the validity in the UK of granted European patents for software inventions.

For many years, the leading judgement in the UK on the patentability of software and business methods has been the judgement of the Court of Appeal in *Merrill Lynch's Application*. This essentially affirmed the then-current EPO approach in *Vicom* in determining that for there to be a patentable invention, there had to be a technical contribution to the known art. The presence of a technical contribution did not itself mean that there was a patentable invention - it just established that one may be present if there was also novelty and inventive step over the prior art.

While this judgement is binding on the Court of Appeal and all lower courts and was clearly followed in subsequent Court of Appeal decisions such as *Fujitsu's Application* and *Gale's Application*, recent UK decisions had started to show a divergence from EPO practice. The EPO tests have remained focussed on technical contribution, but new tests have developed in the UK. The High Court in *CFPH's Application* proposed the "little man" test, by which action of a computer program was compared to that of a hypothetical "little man" with a control panel, and this was adopted, controversially, by the UKIPO as a practical test consistent with the judgement in *Merrill Lynch*.

A new test was adopted by the Court of Appeal in *Aerotel/Macrossan*. The Court of Appeal is bound by its earlier judgements, so this was proposed to

be an alternative expression of the rule in *Merrill Lynch* rather than an entirely new test. The *Aerotel/Macrossan* test is as follows:

1. properly construe the claim;
2. identify the actual contribution;
3. ask whether it falls solely within the excluded subject matter; and
4. check whether the actual or alleged contribution is actually technical in nature.

The judgement in *Aerotel/Macrossan* provided relatively little guidance on how to apply this test, but it was dismissive of EPO jurisprudence, which it indicated to be wrong in certain respects and inconsistent in others. The UKIPO, which had proposed aspects of the test to the Court, immediately provided a practice note, which contained the following provisions:

- Step 4 of the test would rarely be material, and could never "rescue" an invention that had failed on step 3.
- Claims directed to a computer program stored on a storage medium would not be allowed (this provision has since been changed following the 2007 judgement in *Astron Clinica*, which established that this form of claim is allowable in the UK).
- Applications with claims clearly failing the test would not be searched by the UKIPO.

The UKIPO argued that the resulting position was broadly consistent in practice with that taken by the EPO. This view was not widely held outside the UKIPO. In addition to difficulties in prosecuting software-related inventions at the UKIPO, concern arose over the status of software-related invention patents granted by the EPO. If the UK courts were to apply the *Aerotel/Macrossan* test in the manner adopted by the UKIPO, the issue of primary concern was that a significant number of these patents would be invalid in the UK.

Symbian tests this issue directly. *Symbian* prosecuted a UK case and an EP case in the same family. These cases related to developments to a dynamic link library (DLL) structure containing functions called by executable programs. There

are two basic approaches for an application to call a function from a DLL file - by name (which requires the name to be interpreted), which is slow but robust, or by ordinal (file position), which is fast but vulnerable to error when a system has been updated. The invention proposes an extension which allows for the benefits of linking by name while retaining most of the speed of linking by ordinal.

Claims in the EP case were accepted for grant, whereas all claims in the UK application were rejected after a hearing on the grounds that they all failed the *Aerotel/Macrossan* test. The UKIPO Hearing Officer stated that:

"The actual role of the DLL has not been changed by the claimed invention - it still provides exactly the same functionality as it had before. What has changed is the manner in which the DLL has been accessed - it is now done by an additional piece of software in the form of the interface. I therefore find that the contribution made by the claims on file, the main claims and the first auxiliary claims boils down to nothing more than a computer program and hence is excluded from patentability."

This was appealed to the High Court, where Patten J. upheld the appeal and expressed concern about the way the *Aerotel/Macrossan* test had been applied. He stated that a technical contribution was present, as: *"without an effective operating system a computer is nothing. It is simply inaccurate to label all programs within the computer as software and on that basis to regard them as of equal importance in relation to its functionality. The end result of the invention (as claimed) is that it does (to use the test in Gale) solve a technical problem lying within the computer."*

The UKIPO appealed this verdict. Another relevant case was heard before this appeal. In *Actavis UK Ltd v Merck & Co Inc*, it was held that the Court of Appeal was free to depart (but not bound to depart) from one of its previous decisions on a point in the field of patent law if satisfied that the EPO Boards of Appeal have formed a settled view on that point, which differs from that arrived at in that previous decision. This offered another line of argument for *Symbian* - that the Court of Appeal could abandon the *Aerotel/Macrossan* test on the grounds that the EPO Board of Appeal view was settled.

The Court of Appeal in *Symbian* did not agree that the *Aerotel/Macrossan* test had to be abandoned for inconsistency with the settled view of the EPO Boards of Appeal. The judgement did, however, go to great lengths to argue that the *Aerotel/Macrossan* test could be applied consistently with both the judgement in *Merrill Lynch* and Board of Appeal caselaw. In the present case, the Court accepted that there was a technical contribution present, and that the claims in the application passed step 3 of the *Aerotel/Macrossan* test even though they were effected by a software application - the actual contribution was not solely excluded subject matter *"because it has the knock-on effect of the computer working better as a matter of practical reality."*

***Symbian* will not be appealed to the House of Lords, so will remain the position of the English courts in this area for some months at least. The judgement should go far to reassure patent owners that patents for software-implemented inventions granted by the EPO are unlikely to be held invalid in the UK merely on the ground that they are excluded from patent protection.**

It is not clear at present what changes the UKIPO will make to its examination practice. The UKIPO has issued a notice stating that it "will continue to use the *Aerotel/Macrossan* test but in doing so it will take account of the Court of Appeal's judgment in the *Symbian* case whenever appropriate." It also said that one of the reasons that the case was not appealed to the House of Lords was the recent reference to the EPO's Enlarged Board of Appeal of a series of questions relating to the patentability of computer software. The outcome of that reference will of course have a bearing on developments in the UK and elsewhere within Europe.

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