Kluwer Patent Blog

Bilski Galore: Federal Court's take on "Patent Eligibility" for Computer Programs

Korbinian Kopf (Maiwald Patentanwalts GmbH) · Thursday, July 1st, 2010

On 22 April 2010 the German Federal Court of Justice issued its Decision in a case on appeal from the German Patent Court. The later rejected on the ground of excluded subject matter a claim to a method for dynamic generation of documents. In essence the method carries into effect an interface that translates commands of a first, "has-it-all" computer language into commands of a simpler computer language. This allows a no-frills server [devoid of an environment for the first language] to still generate the document by executing only the simple language commands.

The German Federal Court reversed and remanded the case back to the Patent Court for further proceedings.

From the Headnotes:

a) A method that relates to the immediate interplay between elements of a computer (in this case the interplay between a server and client for dynamic generation of structured documents) is never excluded subject matter. It does not matter whether the to-be patented embodiment is characterized by technical teachings.
b) Such a method is not excluded subject matter for relating to a computer program if the method solves a concrete technical problem by technical means. For there to be a solution by way of technical means it is not necessary to modify system components or to address them in a new manner. Rather, it is sufficient if (i) technical conditions outside the computer are determinative of the problem-solving program's execution or if (ii) the very solution resides in configuring the program so that the program accounts for the technical conditions of the computer.
It appears that (i) is akin to a reverse-"further technical effect" test for computer programs set out in one of the IBM cases (T1173/97) of the EPO's Board of Appeals: The EPO likes to see a further technical effect of the program executing computer whereas the Federal Court is happier with an effect of the outside world on the computer. See G03/08 where the EPO's Enlarged Board of Appeals (EBA) reviewed the case law on excluded subject matter for computer programs.

Although on a somewhat weaker scale, (ii) echoes G3/08's parting shot at the referred questions. See the bottom of the penultimate page in the EBA decision: "… it would appear that the fact that fundamentally the formulation of every computer program requires technical considerations in the sense that the programmer has to construct a procedure that a machine can carry out, is not enough to guarantee that the program has a technical character (or that it constitutes "technical means"). By analogy one would say that this is only guaranteed if writing the program requires "further

technical considerations“. Emphasis added.

On a comparative note, it appears that the majority opinion in the recent US Supreme Court case of Bilski v Kappos sides more with the EPO’s “further technical effect” test. There, the Supreme Court cited its previous case of Diamond v Diehr. In Diehr, the claim related to a computer programmed to pop open just at the right time a mold press for curing rubber. It was held good, so a “further technical effect”, as it were, helped the claims stay within the language of patent eligibility defining Section 101 of the US Patent Act. However, The majority in Bilski also held that those effects (“transforming or reducing an article to a different state or thing”) are merely sufficient for the claim not to run afoul of Section 101, whereas, before the EPO, having a ““further technical effect” appears also necessary.

To make sure you do not miss out on regular updates from the Kluwer Patent Blog, please subscribe here.

This entry was posted on Thursday, July 1st, 2010 at 2:33 pm and is filed under Germany
You can follow any responses to this entry through the Comments (RSS) feed. Both comments and pings are currently closed.