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On the fence of Article 27(k) of the UPC: The software interoperability “limitation”

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Software interoperability seems to be at the heart of any discussion to how to protect computer programs lately. Recent cases such as [Oracle v. Google](#) before the US Supreme Court, and [SAS v. WPLtd](#) before the Court of Justice of the European Union (CJEU) have probably something to do with it. The truth is that software interoperability has always been a matter of concern in the ICT sector. Especially since the international community agreed upon protecting computer programs as *literary works* – by means of copyright – and accepting both source code and object code as valid forms of expression ([Article 10\(1\) of the TRIPS Agreement](#)). But this is matter for another debate. Interoperability constitutes one of the pillars of the [Digital Agenda for Europe 2010-2020](#); it has been declared a key factor for the ICT sector and a matter of public interest in the EU. In a sector where innovation is driven by competition, as is the case in ICT, the ability to communicate and interact with other systems is a pivotal factor. This reflects the significance of software interoperability, and according to the European Commission’s latest studies, the European ICT sector has an [interoperability problem](#).

Although it is clear that computer programs are protected by means of copyright, the [Software Directive](#) does not ban other types of protection of computer programs, such as trade secrets or patents. Yet under the [EPC](#) a computer program claimed “as such” is not a patentable invention. However, a computer-implemented invention (CII) is one, which involves the use of a computer, computer network or other programmable apparatus, where one or more features are realized wholly or partly by means of a computer program. Among these features one can find parts of a computer program containing interoperable information. These are its interfaces and its interface specifications: data formats, application program interfaces (API), user interfaces and communication or protocol interfaces. Some examples of CII relating to computer program interfaces can be found in EPO Dec. T 2217/08 (Executable code/Microsoft) and T 1415/07 (Converting graphical programs/National Instruments).

Following the previous reasoning, it makes sense that the Unitary Patent Package gave attention to this matter and tried to provide a solution. (Or maybe not).

The Unified Patent Court Agreement solution is contained within Article 27(k). Article 27 regulates the “*Limitations of the effects of a patent*” and its letter (k) states that “*The rights*

conferred by a patent shall not extend to any of the following: (k) the acts and the use of the obtained information as allowed under Articles 5 and 6 of Directive 2009/24/EC, in particular, by its provisions on decompilation and interoperability". Curiously, the wording of this Article is almost identical to the text of [Article 8](#) of the 2002 Proposal for a Directive of the European Parliament and of the Council on the patentability of computer-implemented inventions.

First to be noted is that as far as interoperability is concerned, only paragraph 3 of Article 5 matters. Paragraphs 1 and 2 refer namely to the right to perform acts necessary for the use of the computer program and to the right to make a back-up copy.

As of the wording, it appears the limitation could be understood in two ways:

1. As an equivalent (but independent) limitation to those of the Software Directive, allowing certain acts and uses in the context of patent law;
2. As a limitation on top of the copyright limitation (more restrictive) that provides that insofar as the acts, which are alleged to constitute infringement, satisfy the conditions of the Software Directive, the party conducting those acts will not be liable for patent infringement.

On the first possibility, the use of the term "as allowed" brings us to the field of copyright.

The main problem here is that none of the limitations contained in Articles 5.3 and 6 have proven to be effective, as some scholars have been declaring over the last years. It is worth pointing, although it may look anecdotal at first glance, that since the approval of the Software Directive in 1991 there are almost zero decisions of the CJEU determining the interpretive criteria or the scope of these limitations. (There is only one case brought before the CJEU and it refers to Article 5, C-406/10 SAS v. WPLtd. – mentioned above-, but not a single one about Article 6). If compared with the existing case law on the copyright limitations established by "The InfoSoc Directive" of 2001 (more than twenty), the result does not speak much in favour of them: If the limitations have been working fine and no Court interpretation has been necessary over the last twenty years, why are we still talking about a "software interoperability problem"? Thus, how might the same exception in the field of patent law be more efficient or effective?

On the second approach, a more restrictive interpretation of the limitation in the field of patent law than in the field of copyright, two main problems could be predicted. First, the acts and the use of the information obtained through reverse engineering techniques such as a black box analysis (Article 5.3) or decompilation (Article 6) are only regulated in the later case: decompilation. The reason is obvious. Copyright protects the expression of the program, the code. Reproduction of the code is essential for the program to run and work as expected in the machine. But the underlying principles of the program, the ideas, are not protected by means of the Software Directive. For this reason, observation, studying and testing the functioning of the program was made clear to be allowed to the legitimate user. However, if patent law needs to provide a limitation over the same acts and the provision is understood more strictly than the copyright one: would this not mean that functions contained in the code of the program are given patent protection? Would this not be a tacit admission that computer programs "as such" could be within the scope of the patent? There is no need to provide a limitation over something that falls outside the scope of the patent.

Second, what happens with the acts and the use of information obtained through Article 6, decompilation, under this more restrictive interpretation? The copyright provision states in a complicated paragraph 2 what shall not be done. Despite the lack of interpretative criteria coming from the CJEU to shed some light, many scholars have agreed upon the following: the information can only be used for the creation of an independent program, which interoperates with the one decompiled. How this Article 6 can be applied in the field of patent law is uncertain. What should be clear is that the act of decompilation itself constitutes an infringement of the exclusive rights of reproduction and adaptation of the computer program (thus the copyright limitation), but in any case, decompilation of a computer program as such could constitute patent infringement.

All in all, how Article 27(k) will apply to patent cases is extremely difficult to say. If it were merely meant to preserve and shelter the existing copyright limitations, it would seem redundant. If not, it gives more reasons for concern as it would constitute a limitation which scope is decidedly unclear. On top of that, both possibilities bring a field of more potential national law fragmentation, decreasing the level of legal certainty. In a nutshell: Article 27(k) spells trouble.

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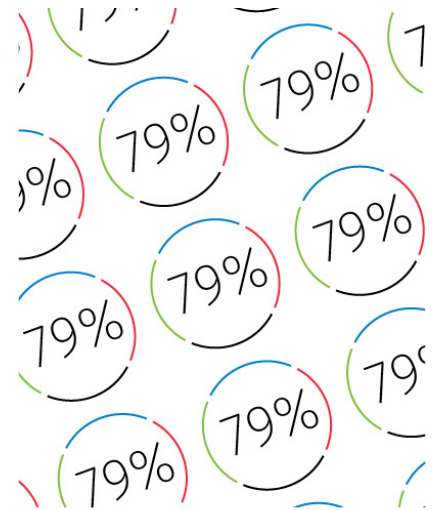
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