

# Kluwer Patent Blog

## Technicality at EPO After G 1/19

Matthieu Dhenne (Ipsilon) · Wednesday, March 17th, 2021

G 1/19, which admits the patentability of a computer-implemented simulation, was the second opportunity for the Enlarged Board of Appeal to rule on the assessment of the patentability of computer-implemented inventions. Did it take advantage of this [One More Chance](#) or was it only [One More Time](#)?

At any rate, here, I will only briefly comment these statements in relation to my favorite topic: technicality. And we will see that these statements are interesting! Both on the technicality criterion itself, on the one hand, and on the assessment of technicality, on the other hand.

### Technicality criterion

On the technicality criterion, I have some comments on the basis for this criterion and on its definition by the Enlarged Board.

Concerning the basis, the Enlarged Board recalls, as it is now customary inventions must be patentable “in all fields of technology” (Article 27 TRIPS, introduced into article 52 EPC in 2000). Thus, according to the Enlarged Board, this expression would imply a requirement of technicality, which does not appear explicitly in the EPC. I believe this to be wrong for two reasons.

Firstly, the expression “*in all fields of technology*” was introduced into the TRIPS Agreement thanks to the United States in order to widen the field of patentability as much as possible. On the contrary, the technical character criterion limits it. Secondly, technical and technological are two distinct words that are often confused, particularly in English, whereas in reality technology is **knowledge about a technique**. Knowledge about a technique is not the technique: science can provide knowledge about a technique but is not technical knowledge, for example.

Neither the TRIPS nor the European Patent Convention contain an adequate basis for the requirement of technical character, even Article 52 list of exclusions is an imperfect basis (e.g. what are aesthetic creations and computer programs doing in the list when they can be technical?). It seems that EPC should have been revised a long time ago by clearly introducing a condition of technical character.

Concerning the definition of technicality, the Enlarged Board refers to *Rote Taube* case law (i.e. a judgment of the German Supreme Court), but only as a starting point. In *Rote taube* the invention has been defined as “*instruction for planned action to achieve a calculable causal result through the application of controllable natural forces*“. A requirement of mastery of the forces of nature

that has been confused with the requirement of a transformation of Nature.

Then, the Enlarged board states that technicality does not imply an impact on a physical entity. Finally, the Board proposes an open conception of technicality independent of the material world. This proposal is interesting and is the first to our knowledge, although the Enlarged Board insists, wrongly, that a definition of technicality would be too restrictive and not evolutionary. This is wrong because it would not necessarily be the case and a definition would improve legal certainty, which remains a fundamental objective.

### **Technicality assessment**

Concerning technicality assessment, the Enlarged Board applies the further technical effect method to a simulation. But above all it defines this effect, which is unprecedented. The Enlarged Board thus states: *“technical effect going beyond the simulation’s straightforward or unspecified implementation on a standard computer system”*.

Unfortunately, the Board does not shed any light on how the different assessment methods are linked: in particular the further technical effect with any hardware approach (i.e. “Hitachi”). It seems, however, that the further technical effect is made for exclusions claimed as such as a product, such as computer programs, as it appears for AI in EPO guidelines.

If this assumption is retained: does this mean that we could apply both further technical effect approach under article 52 and then Hitachi under article 56, when a product and a process are variations of the same invention?

In any case, eventually, the Enlarged Board adopts a vision which seems to be too imprecise to obtain the desired legal certainty in the field of computer science. Perhaps the European Union could finally take up the topic once again with AI, as it did with biotechnologies in the past? [Who knows?](#)

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