

## Appeals over patentability of software continue to fail in UK

1.1 As regular readers will know, we have, over the past three years or so, reported extensively<sup>1,2,3,4,5,6</sup> the problems associated with whether or not certain inventions are excluded from patentability.

2.1 In recent weeks, an English High Court judge has dismissed two appeals<sup>7</sup> by telecommunications service provider AT&T Knowledge Ventures LP (**AT&T**) and innovation company CVON Innovations Ltd (**CVON**) that their claimed inventions were excluded subject matter.

2.2 The appeals once again raise questions regarding the scope of exclusions from patentability, as governed by section 1(2) of the Patents Act 1977 ([UKPA](#)) and Article 52 of the European Patent Convention ([EPC](#)).

2.3 The scope of these exclusions has been considered by the court of Appeal in the UK in recent years: a first time in 2007 (“*Aerotel*”)<sup>8</sup>, and a second time in 2009 (“*Symbian*”)<sup>9</sup>.

2.4 A *four-part* test, which helps to determine whether or not a claimed invention is patentable, was set by the Court of Appeal in *Aerotel*. The test has the following four parts:

- i) properly construe the claim;
- ii) identify the actual contribution;
- iii) ask whether the identified contribution falls solely within the excluded subject matter;
- iv) check whether the actual or alleged contribution is actually technical in nature.

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<sup>1</sup> [Review of Law on Exclusions to Patentability](#)

<sup>2</sup> [Exclusions to Patentability – an update](#)

<sup>3</sup> [Exclusions to Patentability in the UK and EPO - the continuing saga](#)

<sup>4</sup> [Exclusion from Patentability of Mental Acts](#)

<sup>5</sup> [Exclusions to Patentability in the UK and EPO - moving on](#)

<sup>6</sup> [Software Exclusions - referral to Enlarged Board of Appeal at the EPO](#)

<sup>7</sup> [\[2009\] EWHC 343 \(Pat\)](#)

<sup>8</sup> [\[2006\] EWCA Civ 1371](#)

<sup>9</sup> [\[2008\] EWCA Civ 1066](#)

3.1 While those with an interest in obtaining software patents in the UK had hoped that the recent *Symbian* decision would see a change in the way in which the UKIPO examined software patents, this judgment, in addition to a recent practice note<sup>10</sup> issued by the UKIPO, would now suggest that this is unlikely to be the case.

3.2 In *Symbian*, the four-part *Aerotel* test was enforced and it was deemed that a technical effect did subsist and that it related to the reality that the result (i.e. achieved *technical effect*) was a faster and more reliable computer.

4.1 In this recent judgment<sup>7</sup>, Mr Justice Lewison merely attempts to reconcile part (iv) of the test by giving some further guidance as to what a *technical effect* might be.

4.2 Briefly, the **AT&T** invention concerned a broker hosting service system which provided a means to store information about the functionality and capability of a device held by a user; and the **CVON** invention concerned a mobile telecommunications system which modified messages sent between users over a communications network.

4.3 The judge, therefore, considered the following:

- i) whether the claimed technical effect had a technical effect on a process which was carried on outside the computer;
- ii) whether the claimed technical effect operated at the level of the architecture of the computer; that is to say whether the effect was produced irrespective of the data being processed or the application being run;
- iii) whether the claimed technical effect resulted in the computer being made to operate in a new way;
- iv) whether there was an increase in the speed or reliability of the computer (as in *Symbian*);
- v) whether the perceived problem was overcome by the claimed invention as opposed to merely being circumvented.

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<sup>10</sup> [Patents Act 1977: Patentability of computer programs](#)

5.1 It is worth noting here that the guidance of *Aerotel* still remains the law. Therefore, it remains essential to consider whether the claimed *technical effect*, which may be assessed by looking to one of the five suggestions listed above, lies solely within excluded subject matter. However, while the judge stressed that a question as to whether the contribution is technical or not must be answered it does not matter whether it is answered at stage (iii) or stage (iv) of the *Aerotel* test.

5.2 It would appear to us that the five points to consider do not add anything dramatic to the way in which the law should be interpreted, however they do provide an illustration of how the Court of Appeal judgment is being interpreted by the lower courts in the UK. Clearly, the five suggestions themselves are given only to provide guidance towards distinguishing what a relevant *technical effect* might be. While their meanings are open to dispute, this judgment will certainly be useful when trying to deduce what amounts to *technical in nature* in the future.

6.1 In summary, the judge dismissed **AT&T's** appeal that the claimed invention was patentable by stating that it did not overcome the perceived problem, but rather supplied some information which circumvented the problem (i.e. looking to his fifth suggestion).

6.2 And similarly, **CVON's** claim was dismissed by the judge because, *inter alia*, the claimed invention did not make the invention work in a new or different way (i.e. looking to his third suggestion) nor did it provide a technical solution to any alleged incompatibility formats. Rather, he said, all that the claimed invention did was avoid the problem by changing the direction of the flow of information (i.e. looking to his fifth suggestion).

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