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## Is It Full Circle for Patentability of Computer Programs In The UK?

### Summary

On 8 October 2008 the UK Court of Appeal handed down a judgment dismissing an appeal by the UK IPO against a decision of the UK High Court to allow Symbian Ltd's patent application (GB 325145.1). We expect that this judgment will have far-reaching consequences for the patentability of computer-software-implemented inventions in the UK. In particular, it should be easier to obtain granted patents for inventions that have a technical effect or technical character before the UK IPO, regardless of whether they are implemented in software or hardware. It is suggested that this will have the effect of bringing into line the practice of the UK IPO with that of the EPO.

### Background

In 2006, the UK Court of Appeal issued a joint judgment in the matters of Aerotel and Macrossan ("Aerotel"). This judgment concerned the interpretation of s. 1(2) of the UK Patents Act which excludes "computer software as such" from being susceptible to patent protection. The Court approved a new four-step test to considering the patentability of inventions involving computer software. Key steps of this test are to consider the "actual contribution" of the invention and whether this relates to excluded subject matter i.e. computer software as such.

The UK IPO interpreted the Aerotel four-step test in an overly restrictive way, such that it became very difficult to obtain patent protection for any invention which may be implemented in software, or may include a software element if the invention did not produce an effect outside of a computer. This resulted in a divergence of UK IPO practice from that of the EPO, which regularly grants patents for software-implemented inventions.

In 2007, the UK IPO refused Symbian's application concerning a method of operating a computer to access data held in a dynamic link library (DLL). In the view of the UK IPO Hearing Officer, the invention amounted to "nothing more than a computer program" and was therefore excluded from patentability. However, Symbian appealed the refusal of the application to the UK High Court. The High Court overturned the UK IPO's decision on the grounds that the "end result of the invention is that it does solve a technical problem lying within the computer". The Court concluded that "the question of whether the invention makes a relevant technical contribution has to be asked" and that the technical contribution of the invention was "improved reliability of the machine".

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The UK IPO appealed the allowance of Symbian's application to the UK Court of Appeal which dismissed the appeal on 8 October 2008. In its judgment, the Court of Appeal concluded that "upholding the conclusion of the Comptroller in this case, would involve the English courts departing from all the decisions of the Board [EPO Boards of Appeal]". In the Court's reasoning "a technical innovation, whether within...or outside the computer will normally suffice to ensure patentability", consistent with the EPO's decision in *Vicom* (T0208/84) and earlier decisions of the UK Courts such as *Merrill Lynch's Application* and that of *Gale*.

### Going Forward

It is suggested that applicants and their representatives review UK patent applications that have been objected to by the UK IPO on the ground of being a computer program because it is expected that many of these may now be patentable following the Court of Appeal's recent decision in *Symbian*.

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