



Court Of Appeal Upholds UK Approach To Software

Earlier this month a Judgment^[1] was issued by the Court of Appeal which reiterated the UK Courts' approach to the exclusion of an invention relating to computer programs (as such). The Court of Appeal rejected the Lantana application, upholding the Judgment issued by the Patents Court last year.

The Lantana claim includes two computers and a data retrieval system which allows a user at a first, local computer to obtain a file from a second, remote computer. On request of the file, the local computer sends an email via the Internet to the remote computer, the email containing machine-readable instructions and an identification of the requested file. On receiving the email, the remote computer executes the instructions in the email by retrieving the file identified and sending the file to the local computer via email.

The UKIPO rejected the application under Section 1(2) of the Patents Act 1977 which implements Article 52 of the EPC. An invention is excluded from patentability if it lies wholly within one of the exclusions defined in Article 52 EPC, e.g. if the invention is a computer program. However, if the contribution of an invention is held to be "technical", the invention is not excluded as a computer program as such. The law in relation to this issue was reviewed in *HTC v Apple*^[2] last year.

In *HTC v Apple*, the approach adopted in *Aerotel*^[3] was used to determine whether or not the invention made a technical contribution, keeping in mind that novel and inventive subject matter which is purely excluded does not count as having a technical contribution. The UK Courts have developed "signposts" to help determine whether or not there is a relevant technical effect, which originated from *AT&T*^[4], and were refined on appeal in *HTC v Apple*. In the present case, the signposts have been used in the original decision by the UKIPO, by the Patents Court and now by the Court of Appeal.

The development of the case law in the UK is determinedly different from the approach taken by the EPO. The Court of Appeal specifically discussed precedence of EPO decisions because Lantana had argued, and relied on, many EPO decisions. The Court of Appeal noted that the EPO decisions mentioned, although also concerned with the exclusion of computer programs from patentability, apply a different methodology when assessing the exclusion of subject matter from patentability. Therefore, the Court concluded that the EPO decisions only provide

limited assistance in helping to determine whether or not the exclusion applies.

In the UK approach, it is held that novelty and inventive step are assessed separately from whether or not the invention is patentable. This differs from the EPO approach in which the technical and non-technical features are identified, and the inventiveness of the application is then determined, depending only on the technical features. In the UK approach, in order to determine whether or not an invention is patentable, the technical contribution of the invention must be determined. Although the UK approach tries to separate patentability from novelty and inventive step, in order to assess the technical contribution, the prior art must be considered.

The Lantana claim seems to be a mere automation of an entirely conventional exchange between two people, and the Court of Appeal agreed that the process was in fact disclosed in the prior art in a manual form. Thus the application might have been more simply rejected as lacking inventive step, as it appears was the fate of the corresponding US application^[5].

The Lantana case can be contrasted with another November Judgment of the Court of Appeal in *Adaptive Spectrum v BT*^[6]. Again the inventions at issue could have been implemented in software. However, as the invention related to asymmetric digital subscriber line technology, which is used to send data over telephone lines, there was no question of the inventions being excluded for patentability.

The Lantana case reinforces the slightly clumsy approach to excluded subject matter in the UK Courts and illustrates the UK Courts' resolve to apply this approach, even in view of an invention that could be considered as a mere automation that could have been more easily rejected as lacking inventive step.

The full Lantana Judgment is at <http://www.bailii.org/ew/cases/EWCA/Civ/2014/1463.html>.

^[1] *Lantana Ltd v The Comptroller General of Patents, Design And Trade Marks* [2014] EWCA Civ 1463

^[2] *HTC Europe Co Ltd v Apple Inc (Rev 1)* [2013] EWCA Civ 451

^[3] *Aerotel Ltd. v Telco Holdings Ltd & Ors Rev 1* [2006] EWCA Civ 1371

^[4] *AT&T Knowledge Ventures LP, Re* [2009] EWHC 343

^[5] US 2011-0145345 A1

^[6] *Adaptive Spectrum And Signal Alignment Inc v British Telecommunications Plc* [2014] EWCA Civ 1462

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