

Computer-Implemented Inventions Latest Developments in Germany

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JÜRGEN BETTEN

- Studies in electrical engineering and data processing at the Technical University of Stuttgart
- 1972 -- 1974 Program Developer in Computer Division of Siemens AG
- 1978 -- Partner with Betten & Resch, Patent Attorneys, Munich
- 1990 -- President of the Computer Software Committee of UNION
- 1982 -- 1995 Chairman of the Computer Software Committee of the German Patent Attorneys' Institute
- member of AIPPI Committees Q132 (Computer Software etc.) and Q133 (Patenting of Computer Software)
- member of the FICPI CET Trademark Group
- member of the Trademark and Unfair Competition Commission of GRUR (German AIPPI)
- member of the Advisory Board of the German journal "COMPUTER UND RECHT" ("Computer and Law")
- main activities: patents (data processing, electronics), protection of software, trademarks

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§ 1 German Patent Act

- (1) Patents shall be granted for **inventions** which are susceptible of **industrial application**, which are **new** and which involve an **inventive step**.
- (2) The following **in particular** shall **not** be regarded as inventions within the meaning of paragraph 1:
 - (a) discoveries, scientific theories and mathematical methods;
 - (b) aesthetic creations;
 - (c) schemes, rules and **methods for performing mental acts, playing games or doing business**, and **programs for computers**;
 - (d) presentations of information.
- (3) The provisions of paragraph 2 shall exclude patentability only to the extent to which protection is sought for the above-mentioned subject-matters or activities **as such**.

Limits to patentability

German Federal Supreme Court (FSC)

„The term „Technik“ defines the marked line between patentable achievements and e.g. copyrightable achievements.“

Art. 27 TRIPS

„Patents shall be available for any inventions in all fields of technology, provided that they are new, involve an inventive step (are non-obvious) and are capable of industrial application (are useful).“

„Red Dove“ - German FSC

„The main object of the patent law is to include those results that are worth patenting according to the **latest state** of science and research.“

Need for global approach?

- US: „Anything under the sun made by man“ (Supreme Court)
„Useful, concrete and tangible results“ (CAFC)
„Practical application in the technological arts“ (USPTO)
- JP: „Law of nature“
- EU: „Technical character“
- DE: „Technik“
- AIPPI: „Technical Content“

Important decisions of the German Federal Supreme Court (FSC) (1)

„Logic Verification“ (1999)

- The technical character of the invention must be determined on basis of the subject matter as a whole (including **all** features of a claim).
- Modification of the long established term „Technik“¹: the feature „without intervention of human intelligence“ no longer plays an essential role.
- Technical character can be present if technical considerations are necessary to solve the problem.
- **Result:** no patent

1) „Technical“ is a teaching of a systematic activity to use controllable natural forces, to achieve a causally predictable result, without intervention of human intelligence

Important decisions of the German Federal Supreme Court (FSC) (2)

„Speech Analysis Apparatus“ (2000)

- An apparatus (computer) programmed in a specific way has technical character.
- **Result:** no patent

Important decisions of the German Federal Supreme Court (FSC) (3)

„Search for faulty character strings“ (2001)

- Computer programs are patentable if they have a particularity that goes beyond the mere use of a computer.
- Such a particularity is present e.g. if the computer program solves a concrete technical problem or has technical character.
- Computer program claims are acceptable.
- Claims proposing the processing of method steps by means of a computer in order to solve a problem existing in a conventional field of technology, i.e. engineering, physics, chemistry, or biology, are basically patentable.
- **Result:** Remanded; Patents Court: no patent

Important decisions of the German Federal Supreme Court (FSC) (4)

„Electronic Monetary Transaction“ (2004)

- A „secure data transmission“ is a technical feature.
- A concrete technical problem can be the **secure transmission** of data from one computer to another.
- A problem originating from a business activity is not a technical problem.
- The mere use of a computer as technical means does not contribute to inventive step.
- There must be further features (instructions) which solve a technical problem with technical means.
- Only an inventive solution of a problem in a technical field is patentable („enrichment of the field of technology“).
- It is not necessary to stick to a certain order as to statutory patent requirements and patentability exclusions.
- **Result:** Remanded for further examination.

Important decisions of the German Federal Supreme Court (FSC) (5)

„Offering Interactive Help“ (2004)

- The technical problem has to be determined objectively.
- It is not a technical problem to supply to the offerer the information on time, so that he may offer the customer interactive help at his computer in case he is not likely to place an order.
- **Result:** no patent.

Important decisions of the German Federal Supreme Court (FSC) (6)

„Profitability Determination“ (2004)

- It is not a technical problem to determine the profitability of a medical apparatus.
- It is not a technical problem to automatically determine and transmit data relevant to a desired business result.
- **Result:** no patent.

Decisions of the German Federal Supreme Court

- „Chinese Characters“ (1991) OJ EPO 1992, 789
- „Page Buffer“ (1991) OJ EPO 1993, 241
- „Diver’s Computer“ (1991) OJ EPO 1993, 250
- „Logic Verification“ (1999) 33 IIC 2002, 231
- „Speech Analysis Apparatus“ (2000) 33 IIC 2002, 343
- „Search for Faulty Character Strings“ (2001) 33 IIC 2002, 753
- „Electronic Payment System“ (2004) 36 IIC 2005, 242
- „Offering Interactive Help“ (2004) GRUR 2005, 141
- „Profitability Determination“ (2004) GRUR 2005, 143

**Some interesting decisions in English of the
German Patents Court (Bundespatentgericht)**

- „Viterbi Algorithm“ (1996) 31 IIC 2000, 443
- „Automatic Sales Control“ (1999) 32 IIC 2001, 328
- „Cheapest Telephone Connection“ (2004) OJ EPO 2005, 268