

Patent law: patentability of computer-implemented inventions

2002/0047(COD) - 07/03/2005 - Council position

The Council, acting by qualified majority, has adopted a common position which incorporates the substance of some 25 of Parliament's amendments at first reading. The Council has amended or merged a number of recitals appearing in the Commission's proposal and has adopted a few additional ones.

Throughout the common position, the Council has sought to strike a reasonable and workable balance between the interests of rightholders and those of other parties concerned.

The Council's main amendments are as follows:

- it has partly followed the European Parliament's amendments on definitions by deleting the words "one or more *prima facie* novel" from the definition of computer implemented invention, on the grounds that these are redundant and risk creating confusion as regards their relationship with the novelty test, which applies at the stage of the examination of the patentability of any invention. In addition, the Council replaced "technical field" with "field of technology", which is the term commonly used in international agreements on patent law, such as the TRIPS Agreement; inserted the words "new and", in order to clarify the criteria for "technical contribution"; added a second sentence, which is basically the provision of Article 4(3) of the Commission proposal slightly amended in order to clarify that even if non-technical features may be taken into consideration when assessing the technical contribution of a given computer implemented invention, it is indispensable that any patent claim comprises technical features as well;

- it includes an Article which obliges Member States to ensure in their national law that computer-implemented inventions are considered to belong to a field of technology. In accordance with Parliament's amendment, the Council has decided to delete the Article which considers that a general obligation of this nature would be difficult to transpose into national law;

- in order to avoid any misunderstanding, the Council has included a paragraph which comprises a clear statement to the effect that a computer program as such cannot constitute a patentable invention;

- it includes a paragraph was added in order to clarify that in certain circumstances and under strict conditions a patent can cover a claim to a computer program, be it on its own or on a carrier. The Council considers that this would align the Directive on standard current practice both at the European Patent Office and in Member States;

- the Council has taken on board European Parliament's amendment as regards the relationship with Directive 91/250/EC, considering that this is clearer than the text of the Commission's proposal. It has removed references to provisions concerning semiconductor topographies or trade marks as these were considered as irrelevant in this context;

- Council has maintained the text of the Commission proposal concerning the report on the effects of the Directive. In addition, it also added a reference to the Community's international obligations. This is understood as primarily a reference to the TRIPS Agreement. The reference to the Community Patent was deleted as this is beyond the scope of the current Directive;

- the Council stipulated a transposition period of twenty four months (not defined in the Commission's proposal). Parliament envisaged eighteen months.