

Update on patentability of software: the most recent case law and doctrine

Luciano Bosotti
Buzzi, Notaro & Antonielli d'Oulx

Statutory patentability

* BoA decisions published May-June 2016 - Approximately 25 cover
A63F-H01P-H04B-H04N-H04Q-G01N-G01S- G06F-G08B-H03K-
H04L (i.e. software-related cases)

* Points at issue:

Novelty (N) – Inventive step (IS) – Arts. 54 and 56 EPC

Clarity - Art. 84 EPC

Sufficiency – Art. 83 EPC

New matter added – extent of protection broadened – Art. 123(2) and
(3) EPC

Various formal issues

(T1145/10 – technical/non technical features)

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- * Patentability/Enforceability in Litigation **and** Licensing. Apparently minor practical points should not be overlooked.

 - * The finger points at the moon: **look at the moon and at the finger**
- 1. No grace period under the EPC** (and national laws harmonized with the EPC)
- standards and standard preparatory documents (*Guidelines G-IV, 7.6*) the burden of proof >>>> rests on you
 - conference communication on day X may go public on day X – n (e.g. at welcome reception and/or online: tick the box for on-going patenting process if available).

2. Communication 71(3) EPC (Notice of Allowance)

- portions of claims excised as redundant - Word/phrase changed for clarity (Art. 84) has no literal basis in original application
- embodiment labelled as “*not in accordance with the invention*” - Portions of description excised since no longer consistent with claimed invention: portion excised may include the only description of a claimed feature
- Review **carefully** claims and description for last minute EPO amendments - refuse approval and ask for new 71(3) - You can waiver *your* right to have a new one but EPO is not barred from issuing a new one.

3. Issues for SW-related inventions

- * “Network claims” - (e.g. User Equipment./ Base Station) - contributory infringement may help, but may backfire e.g. if network operator is licensed and UE is “branded” by operator
- * Application-of-Chip” claims - may help in leveraging increased damages/royalties - chip may be licensed or manufactured in country where no patent exists
- * Patent covers standard >>> standard compliant equipment infringes (easily disproved) - claiming “essentiality” may lead to curtailed rights (e.g. no urgency relief) and royalties (e.g. FRAND)
- * Claims to SW for 3D printing - Computer Program Product (CPP) when run, does NOT perform all the steps of a claimed 3D printing method (certain steps involve physical steps e.g. fusing, injecting) – Use modified IBM type claims

THANK YOU!

**Luciano Bosotti
Buzzi, Notaro & Antonielli d'Oulx**

via Maria Vittoria, 18 – 10123

TORINO - TURIN

l.bosotti@bnaturin.com