Description for Preliminary Programme – Study Questions for Sydney 2017

Patentability of computer implemented inventions

Patents for computer implemented inventions have been a contentious topic since the dawn of the computing age. In 2014, in the case of *Alice Corp v CLS Bank International*, the US Supreme Court issued a keenly awaited judgment, reversing the trend of relative leniency towards the granting of patents for computer software and business methods. Core to the *Alice* doctrine is the requirement that a patentable (computer-related) invention must comprise "significantly more" than an abstract idea.

European practice in this field has been reasonably clear and consistent since the early 2000s, albeit relatively strict in terms of what can be patented. Although differences exist between the EPO and national practices, and between individual European countries, the approach summarised in the EPO Enlarged Board of Appeal decision G 03/08 (Programs for computers) of 12 May 2010 is broadly followed. Core to current EPO doctrine is the requirement that a patentable (computer-related) invention must make a non-obvious contribution to the state of the art in the field of "technology", whereas contributions to non-technical fields (no matter how inventive) are not sufficient to fulfil the inventive step requirement (modified inventive step test).

Practice in countries such as Japan and Australia has traditionally been less strict. Patents for business methods are often allowed, although debate about the patentability of software and business methods has recently taken a harder line in Australia.

US patent practice has been significantly affected by the USPTO examination guidelines which were revised after *Alice*, with previously-patentable subject matter now routinely being rejected by examiners and on appeal. In the meantime, the number of patent applications relating to computer-implemented subject matter continues to grow. There will also likely be further developments in Europe based on the jurisprudence of the anticipated Unified Patent Court.

This topic is of huge significance to some of the world's largest industries. Article 27 of TRIPs stipulates that patents shall be available for any inventions, whether products or processes, in all fields of technology. However, differences in the rules and practice between individual countries and regions often mean that computer implemented subject matter is viewed differently across different jurisdictions, making it difficult to develop effective global patenting strategies.

It is therefore highly desirable for AIPPI to seek to develop a Resolution on this topic.