Study Question

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Patentability of computer implemented inventions

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I. Current law and practice

1 **Does your current law contain any statutory provisions which specifically apply only to CII?**

Yes

Please Explain

Partly.

2 **Please briefly describe the general patentability requirements in the written statute based law of your jurisdiction which are specifically relevant for the examination of the patentability of CII.**

Estonian Patent Act (PA) Art 6
(2) The following, inter alia, are not regarded as the subject of inventions:
…
2) schemes, rules and methods for performing mental acts or doing business;*
5) algorithms for computers and computer programs;
(*There is general prohibition on the patentability of business methods in Estonia)

The formal and substantive requirements for the documents contained in the patent application

§ 31. Example of implementing a device

(4) If the device contains a programmable (configurable) polyfunctional element or instrument (including computer), or if the use of that is required, a data is submitted confirming the possibility to use such element or device in this particular device.

3 **Under the case law or judicial or administrative practice in your jurisdiction, are there rules which specifically apply only to CII? If yes, please explain.**

Yes

Please Explain

According to the directive of the Director General of the Estonian Patent Office, Guidelines for Examination in the European Patent Office (G-II, 3.6; F-IV, 3.9) are used in case of CII.

4 **Please briefly describe the general patentability requirements under the case law or judicial or administrative practice of your jurisdiction which are specifically relevant for the examination of the patentability of CII.**

The CII must:
- be of technical character;
- relate to a technical field;
- concern a technical problem;
- have technical features in terms of which the matter for which protection is sought can be defined in the claim.

Technical character of the computer program should be assessed without regard to the prior art. The computer program, when carried out, has to provide a further **technical effect**.

5.a **Exclusion of non-patentable subject matter per se.**
Do the statutory provisions, case law or judicial or administrative practice (hereinafter collectively referred to as Law / Practice) in your jurisdiction exclude any particular subject matter relating to CII from patentability per se?
In this context, "per se" means that the non-patentable subject matter is identified without any implicit or explicit examination of the contribution to the state of the art the claimed CII makes.

If yes, please answer questions 5.b-5.e, if no, please go to question 6.a

No

Please Explain

5.b **Please describe the subject matter excluded from patentability per se and explain in detail how it is identified in practice**

5.c **If there is any subject matter identified in a patent claim relating to CII that is excluded from patentability per se, is it possible to overcome a rejection of the patent claim by adding other subject matter to the claim?**

If yes, please answer questions 5.d-5.e, if no, please go to question 6.a

5.d **Does the "other subject matter" need to have a certain quality, e.g. does it need to be inventive?**

5.e **Can you describe the areas of human endeavour the "other subject matter" needs to relate to?**

6.a

Requirement of a contribution in a field of technology.

Does the examination of the patentability of CII in your jurisdiction implicitly or explicitly involve an examination of the contribution the claimed CII makes to the state of the art (such examination may be part of a general "patentability" test or part of the novelty and inventive step/non-obviousness test)?

If yes, please answer questions 6.b-6.d, if no, please go to question 7

Yes

Please Explain

6.b

Does this test implicitly or explicitly involve excluding contributions from areas of human endeavour which are not deemed to be sources of patentable inventions? In other words, does patentability of CII implicitly or explicitly require a contribution from areas of human endeavour which are deemed to be sources of patentable inventions (e.g. engineering, natural sciences)? If yes, please explain.

Yes

Please Explain

The CII must have technical character, relate to a technical field and solve a technical problem.

6.c

Does this test also implicitly or explicitly require that the relevant contribution the CII makes to the state of the art qualifies as inventive/non-obvious? This additional test may be integrated into the general inventive step / non-obviousness examination, or may be a stand-alone test. If yes, please explain.

Yes

Please Explain

An inventive step requires a non-obvious technical contribution, i.e. a non-obvious solution to a technical problem defined in terms of technical features. Preferable test, in our opinion, to assess and decide whether an invention involves an inventive step, is so called "problem-and-solution-approach".

6.d

Is there an implicit or explicit consensus in your jurisdiction as to the areas of human endeavour which are accepted as sources of patentable CII? If yes, are these areas of human endeavour defined, and if so how?

No

Please Explain

7

Does the Law / Practice in your jurisdiction contain any specific claim drafting or other formal requirements which are applicable to CII, i.e. which deviate from the Law / Practice applicable to inventions which are not CII? If yes, please explain.

No

Please Explain

8

Does the Law / Practice in your jurisdiction contain any specific requirements as to sufficiency of disclosure and/or enablement which are applicable to CII, i.e. which deviate from the Law / Practice applicable to inventions which are not CII? If yes, please explain.

No

Please Explain

9 **Do courts and administrative bodies in your jurisdiction apply the Law / Practice for patentability of CII in your jurisdiction in a harmonized way? If not, please explain.**

No

Please Explain

There is not enough administrative and court practice in our jurisdiction to answer this question.

II. Policy considerations and proposals for improvements of your current Law/Practice

10 **Is the current Law/Practice in your jurisdiction regarding the patentability of CII considered by users of the patent system and practitioners to be understandable and workable? If not, please explain.**

Yes

Please Explain

11 **Does the current Law/Practice in your jurisdiction regarding patentability of CII provide appropriate outcomes, in particular from an economic perspective? If not, please explain.**

Yes

Please Explain

12 **In your jurisdiction, is copyright protection of CII regarded as sufficient from an economic standpoint? Please state why in either case.**

Yes

Please Explain

According to paragraph 4.3.3 Copyright Act computer programs shall be protected as literary works. Protection applies to the expression in any form of a computer program. This means that copyright protects the programs as well as their appearance (look-and-feel)*. Copyright also protects the source material of computer programs (art 4.4).
If we define software as a series of encoded instructions for a digital computer, copyright is extended to instructions, but only the formal part of them. The decisive part of instructions – idea, algorithm – is left without legal protection. Therefore, copyright does not extend to the content of software, to its logical structure, but only to its form that is perceivable by the software user. Copyright protects the object code and source text from direct copying.

* - In software design, look-and-feel is a term used in respect of a graphical user interface and comprises aspects of its design. The term can also refer to aspects of an API, mostly to parts that are not related to its functional properties.

13 **Alternatively, is there an explicit or implicit consensus that patent protection of CII is required to ensure sufficient reward on investments made into the development of CII? If yes, please explain.**

No

Please Explain

14 **In your jurisdiction, is there an implicit or explicit consensus that availability of patent protection should be limited to contributions from certain areas of human endeavour, excluding contributions from all other areas of human endeavour, no matter how advanced these contributions?**

Yes

Please Explain

Availability of patent protection should be limited with only fields of technology.
Availability of patent protection in any field of technology should not be limited.
CII must have technical character.

III. Proposals for harmonisation

15 **Do you consider that harmonisation regarding patentability of CII is desirable?**
If yes, please respond to the following questions without regard to your Group's current Law/Practice.
Even if no, please address the following questions to the extent your Group considers your Group's current Law/Practice could be improved.

Yes

Please Explain

16.a **Exclusion of non-patentable subject matter per se.**
Should there be any exclusion from patentability per se of subject matter relating to CII?
In this context, "per se" means that the non-patentable subject matter has to be identified without any implicit or explicit examination of the contribution to the state of the art the claimed CII makes.

If yes, please answer questions 16.b-16.e, if no, please go to question 17.a

No

Please Explain

No, except computer programs per se, which do not have technical character .

16.b **Please describe the subject matter that should be excluded from patentability per se and explain in detail how it should be identified in practice.**

16.c **If there is subject matter identified in a patent claim related to CII you consider should be excluded from patentability per se, should it possible to overcome a rejection of the patent claim by adding other subject matter to the claim?**

If yes, please answer questions 16.d-16.e, if no, please go to question 17.a

16.d **Should such "other subject matter" be required to have a certain quality, e.g. should it need to be inventive? Please state why in either case.**

16.e **If yes to question 16.d above, please describe the areas of human endeavour to which such "other subject matter" should relate.**

17.a **Requirement of a contribution in a field of technology.**
Should the examination of subject matter eligibility of CII involve an examination of the contribution the claimed CII makes to the state of the art? If not, please explain.

If yes, please answer questions 17.b-17.e, if no, please go to question 18

Yes

Please Explain

17.b **Should such examination be made under a test specific to CII, or should it be part of the usual novelty and inventive step/non-obviousness test? Please state why in either case.**

Yes

Please state why.

It should be part of the usual novelty and inventive step / non-obviousness test. It is desirable to use universal problem-and-solution-approach.

17.c **Under this test, should patentability of CII require a contribution from areas of human endeavour which are deemed to be sources of patentable inventions (e.g. engineering, natural sciences)? In other words, should contributions from areas of human endeavour which are not deemed to be sources of patentable inventions be disregarded? If not, please explain.**

If yes, please answer questions 17.d-17.e, if no, please go to question 18

Yes

Please Explain

17.d **Should this test also require that the relevant contribution the CII makes to the state of the art qualifies as inventive/non-obvious? This additional test may be integrated into the general inventive step / non-obviousness examination, or may be a stand-alone test. Please state why in either case.**

Yes

Please Explain

To involve an inventive step, CII must make a technical contribution. Technical contribution means a new and non-obvious contribution to the prior art in a field of technology.

17.e **Should there be a non-exhaustive list of areas of human endeavour which are accepted as sources of patentable CII, taking into account the ultimate purpose of patent law (protecting unforeseen, non-obvious subject matter)? If yes, please provide such a list. If not, why?**

Yes

Please Explain

If yes, then such a list should contain all fields of technology.

18 **Should there be any specific claim drafting or other formal requirements which are applicable to CII, i.e. which deviate from the rules or practice applicable to inventions which are not CII? Please explain why in either case.**

No

Please Explain

No, but publication by the patent offices of non-binding claim drafting examples and guidelines is desirable.

19 **Should there be any specific requirements as to sufficiency of disclosure and/or enablement which are applicable to CII, i.e. which deviate from the rules or practice applicable to inventions which are not CII? Please explain why in either case.**

No

Please Explain

No any specific provisions of law concerning sufficiency of disclosure applicable only to CII necessary. Publication of specific rules and guidelines by the patent offices is desirable.

20 **Please comment on any additional issues concerning patent protection of CII your Group considers relevant to this Study Question.**

In our opinion the expression "computer implemented invention - CII" is too narrow, considering the innovation today. Steps of manipulating or interacting with technical physical entities by using computer control come into mind with this term. However, there are many more new technologies that require the use of different types of data processing, not only computer control. Therefore we find that the expression "computer implemented invention - CII" should be replaced with the expression "computer technology invention - CTI".

Please indicate which industry sector views are included in part "III. Proposals of harmonization" on this form:

Please enter the name of your nominee for Study Committee representative for this Question (see Rule 12.8, Regulations of AIPPI). Study Committee leadership is chosen from amongst the nominated Study Committee representatives. Thus, persons not nominated as a Study Committee representative cannot be in the Study Committee leadership.
Raul KARTUS