

A wooden gavel with a polished, dark brown finish is positioned diagonally across the frame. The head of the gavel, featuring a cylindrical top and a tiered base, is the central focus. The handle extends towards the upper left. The background is a vibrant blue fabric with several large, bright yellow stars, reminiscent of the European Union flag. The lighting is soft, highlighting the texture of the wood and the fabric.

Bringing  
together  
software-  
related  
inventions  
in European  
courts

## In earlier versions of European IP Update, the recent Case Law and the possibilities and pitfalls of software-related inventions were discussed.

### For the granting procedure of European patent applications, the Case Law is reasonably settled, especially after the Enlarged Board of Appeal decision G3/08.

The EPO President (at that time Ms. Brimelow) had referred a number of questions to the Enlarged Board of Appeal, which in essence confirmed the existing Case Law as valid and not contradictory.

Thus at the EPO application phase of a patent, it is quite clear where boundaries are set for clearing the Art. 52(2) EPC hurdle: once a computer or other hardware unit is explicitly involved, the invention relates to technical subject matter.

Of course – and this has proven to be common practice today in software-related applications – the next hurdle is arguing inventive step. For this the claim features are separated into technical features and non-technical features, and for assessing inventive step, the non-technical features are simply ignored.

In actual patent applications, it may then prove quite hard to argue inventive step for the remaining technical features, as computer (or signal processing) hardware is, of course, widely known.

After the granting of a European patent, a bundle of national patent rights is established.

For the various national courts of the States Party to the EPC, the EPO Case Law does not apply directly, and therefore some differences may exist in national Case Law.

The Bundesgerichtshof (BGH) in Munich, Germany, recently published a decision where previous Case Law in Germany is set aside and replaced with the interpretation by the EPO of software-related inventions.

The conflict related to the German part of European patent EP-B-0 378 271, which protects an invention involving reproduction of topographic information, for instance on a navigation device for use in a car.

In its decision X ZR 47/07, the BGH decided that the subject matter of a method related to the reproduction of topographic information using a technical device is not excluded from patent protection according to Art. 52(2) EPC if at least one aspect of the claimed teaching solves a technical problem.

Upon assessing inventive step, only those instructions that determine or at least influence the solution of the problem by technical means are to be considered.

The selection of a (central perspective) representation of topographic information that is appropriate for navigating a vehicle should be disregarded for the assessment of inventive step as non-technical information for a person skilled in the art.

In the end, the BGH upheld the revocation of the German part of EP-B-0 378 271. In contrast to the lower court decision, the BGH argued that the subject matter of the invention does indeed lie in a technical area and is thus not excluded from patentability. It was found that the independent

claim as granted meets the requirements of Art. 52(2) EPC. However, the next hurdle was too high: the BGH held that the subject matter was lacking an inventive step in view of the prior art.

Of course, a coordinated approach towards software-related patents can work either for or against your company, depending on which side of a dispute you are on.

The increasingly coordinated approach at least provides a clearer insight into the possible outcome of conflicts across countries in matters relating to software-related patents.

This area of technology remains complicated territory for IP matters, for which the Nederlandsch Octrooibureau specialists can apply their knowledge and skills to your best advantage.



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