

UK Intellectual Property Office approves software patent June 2009

Software that allows programmers to program a mobile phone system remotely from a computer can be patented because it is more than just a software program, the Intellectual Property Office (IPO) has decided. The decision related to whether UK patent application number GB0424655.9 in the name of Nokia Corporation (Nokia) was excluded from being patented under s.1(2) of the Patents Act 1977 (the Patents Act)¹.

The Patents Act says that something cannot be patented if it consists only of a program for a computer. The IPO has historically been quite strict in denying patents for “pure” software. In contrast, the US allows software to be patented.

This means that UK software developers have been left to rely on copyright to protect their work. Copyright only offers protection against being copied. Patents, on the other hand, are an absolute right against unauthorised use of the patent holder’s invention, and can protect the underlying ideas or processes. So with a patent, it does not matter whether a competitor has copied the program or developed an identical program – or indeed a different program which uses the same ideas or process steps – on their own, it still breaches the patent and the patent holder can claim damages and/or an injunction to enforce their rights.

The patent application, for programming mobile phones remotely, was first applied for by Intuwave, then passed to Symbian and finally to Nokia, which appealed an initial IPO decision to refuse it.

The invention allows a computer to control a mobile phone while software was being developed, which Nokia said was an improvement over using the mobile phone’s controls to develop software and using a computer emulator of the phone, which were the methods used until now for development.

Mills & Reeve LLP is a limited liability partnership regulated by the Solicitors Regulation Authority and registered in England and Wales with registered number OC326165. Its registered office is at Fountain House, 130 Fenchurch Street, London, EC3M 5DJ, which is the London office of Mills & Reeve LLP. A list of members may be inspected at any of the LLP’s offices. The term “partner” is used to refer to a member of Mills & Reeve LLP.

Andrew Bartlett, deputy director of the IPO, upheld Nokia's appeal and allowed the patent to be registered because the invention made a "technical contribution" when compared with current technology in the field (the so called "prior art").

Mr Bartlett's decision comes in the light of two recent landmark Court of Appeal decisions on software patentability. In a case involving Aerotel and Macrossan, the court set out a four-step test to assess whether something fell outside the scope of patentability¹.

The test consists of: (i) interpreting the invention claim properly; (ii) identifying the actual contribution the invention makes; (iii) considering whether that contribution falls solely within matters that can not be patented by law (the so-called "excluded categories" of which inventions which are simply computer programs are one); and (iv) checking whether that contribution is technical in nature.

The court in this case then applied that four-step test to medical ordering software developed by mobile phone software company Symbian. The court reversed the IPO's refusal of a patent because the technology was found to have made a technical contribution. The court decided that the invention was not just a better computer program but it also turned the machine it ran into "a better and faster computer". It therefore made a technical contribution.

In his Nokia decision, Mr Bartlett said "In my view, the particular way that [this] invention overcomes the technical problems inherent in the prior art provides a technical contribution. Thus whilst the invention may be implemented in software it provides a technical contribution such that it is more than a program for a computer as such."

This latest whittling down of the general rule against patenting of software is important for software developers to bear in mind. If they can demonstrate that their software is more than just a clever bit of programming but that it also produces a technical effect, then applications for a patent will receive a more favourable response than before.

¹Useful links:

- The IPO's decision on the patentability of the invention applied for by Nokia: <http://www.ipa.gov.uk/o10709.pdf>
- The IPO's practice notice on the patentability of computer programmes: <http://www.ipa.gov.uk/pro-types/pro-patent/p-law/p-pn/p-pn-computer.htm>
- The IPO's submissions (on behalf of the United Kingdom) to the European Patent Office's (EPO) Enlarged Board of Appeal relating to the patentability of computer

programmes under the European Patent Convention can be found on the EPO's website: <http://www.epo.org/patents/appeals/eba-decisions/referrals/pending/briefs.html>. Page 3 and 4 of the submission illustrates the United Kingdom's proposed approach to the issue, and probably still reflects the narrowest set of principles for permitting computer software to be patentable. This perhaps reflects an increasingly widely promoted view that there is no economic evidence to show that patent protection for computer software has any benefit in innovation.

- The Court of Appeal decision in *Aerotel Limited v Telco Holdings Limited and Ors* (2006) in the matter of patent application GB 0314464.9 (Aerotel/Macrossan): <http://www.bailii.org/ew/cases/EWCA/Civ/2006/1371.html>
- *Astron Clinica Ltd & Ors v The Comptroller General of Patents, Designs and Trade Marks* (2008) was a test case which successfully challenged the practices of the IPO which included refusing claims in patents for computer-implemented inventions. Mr Justice Kitchin's decision can be read here: <http://www.bailii.org/ew/cases/EWHC/Patents/2008/85.html>

About the Author

Simon Elsegood is a member of the Technology and Commerce Team at Mills & Reeve LLP. After obtaining his PhD in Organic Chemistry, Simon worked as a research scientist at British Sugar Technical Centre before being promoted to a facilities management role. Using his previous scientific research experience, Simon has advised clients on all aspects of patents, particularly from the point of view of investors in patented technology. Simon works with Alasdair Poore, a partner in the Technology and Commerce Team, who is also a Chartered Patent Attorney and regularly advises on issues about protection and enforcement of computer related inventions and Dr Tasmina Goraya, another scientist working in the Technology and Commerce Team and specialising in intellectual property protection. For further information, please contact Simon.

Simon Elsegood
Senior Solicitor
for Mills & Reeve LLP

+44(0)1603 693449

simon.elsegood@mills-reeve.com

The contents of this document are copyright © Mills & Reeve LLP. All rights reserved. This document contains general advice and comments only and therefore specific legal advice should be taken before reliance is placed upon it in any particular circumstances. Where hyperlinks are provided to third party websites, Mills & Reeve LLP is not responsible for the content of such sites.