

program only be excluded as a computer program as such if it is explicitly claimed as a computer program?"

In Opinion G 3/08 (OJ 2011, 10), the Enlarged Board of Appeal held that a claim utilising a synonym for "computer program", such as "a sequence of computer-executable instructions" or "an executable software module" perhaps, would clearly not avoid exclusion from patentability if the equivalent claim to a computer program did not. It noted that the alleged divergence identified in the referral did not simply relate to the form of words chosen. The discussion also referred to "the function of the computer program (does the claimed program have technical character) rather than the manner in which it is claimed (e.g. as a computer program, a computer program product or a computer-implemented method)".

The Enlarged Board of Appeal noted that in T 424/03 the board had arrived at a conclusion which clearly contradicted the position (or rather one of the positions) taken in T 1173/97 (OJ 1999, 609). T 1173/97 stated, "Furthermore, the board is of the opinion that with regard to the exclusions under Art. 52(2) and (3) EPC, it does not make any difference whether a computer program is claimed by itself or as a record on a carrier ...," (point 13 of the Reasons), whereas T 424/03 stated, "The subject-matter of claim 5 has technical character since it relates to a computer-readable medium, i.e. a technical product involving a carrier" (see decision T 258/03, point 5.3 of the Reasons). Thus there was a difference between the positions taken in T 1173/97 and T 424/03 on this point. It was still however necessary to decide whether this difference constitutes a divergence allowing a question to be referred by the President on the point.

The Enlarged Board of Appeal pointed out that the referral did not identify, and they were not aware of, any decision whatsoever of one of the boards of appeal of the EPO which followed T 1173/97 on this point (although T 1173/97 was evidently considered decisive in its definition of "further technical effect" and abandonment of the contribution approach to exclusion). Secondly, the conclusion arrived at in T 424/03 had not been challenged in any later decisions; nor was it isolated but rather came as the last of a series of decisions, the logic of which was consistent and, at least to the knowledge of the members of the Enlarged Board, had also not been challenged in any later decision of a board of appeal of the EPO (national court decisions were another matter).

The Enlarged Board of Appeal came to the conclusion that the position taken in T 424/03 that a claim to a program on a computer-readable storage medium was necessarily not excluded from patentability by the provisions of Art. 52(2) and (3) EPC 1973 was in fact a consequence of the principles laid out in T 1173/97. It stated that T 424/03 did deviate from a view expressed in T 1173/97, concerning whether a claim to a program on a computer-readable medium necessarily avoided exclusion from patentability under Art. 52(2) EPC 1973. However, this was a legitimate development of the case law. Therefore, the Enlarged Board of Appeal decided that there was no divergence which would make the referral of this point to the Enlarged Board of Appeal by the President admissible (for further legal considerations which were taken into account in that regard, see points 5 to 7 of Opinion G 3/08).