

In G. 3/08 (OJ 2011, 10) (Question 2 of the referral), the Enlarged Board of Appeal stated that a claim in the area of computer programs can avoid exclusion under Art. 52(2)(c) and (3) EPC merely by explicitly mentioning the use of a computer or a computer-readable storage medium. It noted however that no exposition of this position would be complete without the remark that it is also quite clear from the case law of the boards of appeal since T. 1173/97 that if a claim to program X falls under the exclusion of Art. 52(2) and (3) EPC, a claim which specifies no more than "Program X on a computer-readable storage medium," or "A method of operating a computer according to program X," will always still fail to be patentable for lack of an inventive step under Art. 52(1) and 56 EPC.

The Enlarged Board of Appeal also noted that in T. 424/03 (extending the reasoning applied in T. 258/03) the board held that claim to a program ("computer executable instructions" in the claim in question) on a computer-readable medium also necessarily avoided exclusion from patentability under Art. 52(2) EPC. The decision in T. 424/03 went on to note that the particular program involved had the potential of achieving a **further technical effect** when run and thus also contributed to the technical character of the claimed subject-matter. The Enlarged Board of Appeal stated that this fact was, however, not necessary to the conclusion that the claimed subject-matter avoided exclusion, since according to the reasoning of T. 258/03 **any technical means** claimed was **sufficient** to overcome the exclusion of Art. 52(2) EPC.

#### 2.4.5 Patentability of computer programs: technical character

Whereas the view had been taken on a number of occasions in the boards' earlier case law (T. 26/86, OJ 1988, 19, T. 110/90, OJ 1994, 557, T. 164/92, OJ 1995, 305, and T. 204/93) that the exclusion from patentability under Art. 52(2)(c) and (3) EPC 1973 applied to all computer programs, independently of their contents, that is, independently of what the program could do or perform when loaded into an appropriate computer, the board in T. 1173/97 (OJ 1999, 609) held that, in the context of applying the EPC, the technical character of an invention was generally accepted as an essential requirement for its patentability, as was illustrated, for instance, by R. 27 and 29 EPC 1973. The exclusion from patentability of computer programs as such (Art. 52(2) and (3) EPC 1973) could be construed to mean that such programs were considered to be mere abstract creations, lacking in technical character. The use of the expression "shall not be regarded as inventions" seemed to confirm this interpretation. This meant that computer programs had to be considered patentable inventions **when they had a technical character**.

Further, Art. 27(1) TRIPS provides that "patents shall be available for any inventions, whether **products or processes**, in all fields of technology". The board went on to state that it was the clear intention of TRIPS not to exclude from patentability any inventions, whatever field of technology they belong to, and therefore, in particular, not to exclude programs for computers as mentioned in and excluded under Art. 52(2)(c) EPC 1973. The board held that a computer program product is not excluded from patentability under Art. 52(2) and (3) EPC 1973 if the program, when running on a computer or loaded into a computer, brings about, or is capable of bringing about, a **technical effect** which goes beyond the "normal" physical interactions between the program (software) and the computer (hardware) on which it is run.