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?**

No

Please Explain

Apart from the provision below, the respective Hungarian law (Hungarian Patent Act: Act No. XXXIII of 1995 on the protection of inventions by patents; Decree of Patent Formalities: Decree No. 20/2002. (XII. 12.) IM on the detailed formalities of patent applications...) does not contain any statutory provisions specifically applicable only to CII.

Programs for computers „as such" are included among the items listed in Art. 1(2) of the Hungarian Patent Act being not regarded as inventions, however, as discussed later, if the claimed subject-matter has a technical character it is not excluded from patentability.

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.**

Art. 1(1) of the Hungarian Patent Act: "Patents shall be granted for any inventions in any field of technology that are new, involve an inventive step and are susceptible of industrial application."

Art. 5 of the Decree of Patent Formalities: "Patent claims are to be drafted by specifying technical features of the invention..."

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

As to administrative practice, the Examination Guidelines of the Hungarian Intellectual Property Office contain divs specifically applicable only to CII:

- div III.2.3.2. stipulates patentability considerations of CII,
- div III.8.2. stipulates disclosure considerations of CII,
- div III.9.4.9. stipulates claim drafting rules of CII, and
- Annex III.1. contains acceptable sample claim wordings for CII.

The case law and the judicial practice do not contain rules specifically applicable only to 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 basic patentability considerations in respect of CII are in principle the same as for other subject-matter. Patents can not be granted for inventions not having a technical character. However, a patent may be granted if the claimed subject-matter of a CII contains a non-obvious technical contribution to the state of the art.

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

Yes

Please Explain

Statutory provisions define the exclusion below.

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

Programs for computers „as such" are not considered to be a technical solution of a problem, do not qualify as an invention, thus are excluded from patentability. This is in line with the general principle that subject matter not having a technical character is excluded from patentability.

The normal physical effects of the execution of a program are not in themselves sufficient to lend a computer program a technical character, and a further technical effect is needed. So, a computer program claimed by itself is excluded from patentability if it is not capable of bringing about, when running on or loaded into a computer, a further technical effect going beyond the "normal" physical interactions between the program (software) and the computer (hardware) on which it is run.

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

Yes

Please Explain

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

Yes

Please Explain

The „other subject matter” has to have a further technical effect to overcome a rejection based on excluded subject matter. To this effect, the „other subject matter” may even be known in the prior art and does not need to be inventive. Of course, only „other subject matter” disclosed in the application as originally filed can be used to this effect.

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

Yes

If yes, please explain

The Examination Guidelines of the Hungarian Intellectual Property Office provides examples of such human endeavours: A further technical effect of the „other subject matter” which lends technical character to a computer program may be found e.g. in the control of an industrial process, in the processing of data representing physical values, in the change of internal functioning of the computer itself, may affect the efficiency or security of a process, may help the management of computer resources required or may increase the rate of data transfer in a communication link.

In summary, human endeavours having an interaction with the physical reality are generally regarded suitable to establish technical character.

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

In order to be patentable, the technical features of the claimed subject-matter of a CII shall contain a non-obvious contribution to the state of the art. The examination to this end is part of the general novelty and inventive step test of examining patentability, however, only the technical features of the claims are taken into account to this respect.

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

Patentability of CII requires a contribution from areas of human endeavour which are deemed to be sources of patentable inventions, i.e. patentability requires a technical contribution. CII with no technical contribution are not patentable.

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

It is required that the relevant contribution the CII makes to the state of the art qualifies as inventive. This test is integrated into the general inventive step examination.

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?**

Yes

Please Explain

Example areas of human endeavour which are accepted as sources of patentable CII are given in the Examination Guidelines of the Hungarian Intellectual Property Office: control of an industrial process, processing of data representing physical values, change of internal functioning of the computer itself, efficiency or security of a process, management of computer resources or rate of data transfer in a communication link.

There exists an implicit consensus in Hungary that human endeavours having an interaction with the physical reality are generally regarded suitable to be accepted as sources of patentable CII.

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.**

Yes

Please Explain

The Examination Guidelines of the Hungarian Intellectual Property Office list acceptable claim-types of CII (div III.9.4.9.): The subject matter of CII can be a method and/or an apparatus, and based on the existence of a method or an apparatus claim, additionally a computer program and/or a data carrier storing the computer program.

Claim drafting requirements are also specified here in details, which, however, do not deviate from the general practice and are in line with the established practice of the European Patent Office. The Examination Guidelines also recommend acceptable sample claim wordings for CII (Annex III.1.).

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

No, however, the Examination Guidelines of the Hungarian Intellectual Property Office only contain some specific disclosure considerations

with respect to CII (div III.8.2.). It is noted that those are not requirements, but rather advices how to fulfil the general sufficiency/enablement requirement in the case of CII:

- Generally, disclosing only structural features is insufficient and disclosing their functions and/or effects as the technical contribution is also required.
- Listing complete computer programs is not necessary, but short excerpts from programs written in commonly used programming languages can be accepted if they serve to illustrate an embodiment of the invention. Flow-charts and pseudocodes are explicitly preferred means of disclosure.
- The description can be completed with figures representing data processing flow. The description may contain a „data flow plan", in which a time sequence of events relating to data and data storing means can be specified. The description may also contain a „program run plan" specifying all possible run options of the program.

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.**

Yes

Please Explain

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.**

No

Please Explain

Copyright protection of CII is generally regarded as insufficient as it does not protect the abstract technical idea on which the CII is based.

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.**

Yes

Please Explain

There is an implicit consensus that – in addition to copyright protection – patent protection of CII is required, for protecting inventive technical ideas also in this field of technology.

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

There exists an implicit consensus in Hungary that human endeavours having an interaction with the physical reality are generally regarded suitable to be accepted as sources of patentable CII.

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

Yes

Please Explain

Just like in other areas of intellectual achievements.

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.**

Subject matter not having a technical character should be excluded from patentability per se. The Hungarian Group is in favour of identifying of such excluded subject matter in line with the current practice of the EPO.

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

Yes

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.**

Yes

Please Explain

The „other subject matter" should have a further technical effect to overcome a rejection based on excluded subject matter. This particular rejection should be overcome even by „other subject matter" known in the prior art, so it does not need to be inventive. Of course, only „other subject matter" disclosed in the application as originally filed should be used to this effect.

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

Human endeavours having an interaction with the physical reality should be regarded suitable to establish a technical character; "other subject matter" should relate to such areas.

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.

Such examination should be part of the usual novelty and inventive step/non-obviousness test. There is no justified reason to treat this technical field differently.

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

It should be required that the relevant contribution the CII makes to the state of the art qualifies as inventive. This test should be integrated into the general inventive step examination. There is no justified reason to treat this technical field differently.

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

The Hungarian Group is of the opinion that the ultimate purpose of patent law is to protect unforeseen, non-obvious, technical subject matter. The Hungarian Group is in favour of specifying in guidelines a non-exhaustive list of areas of human endeavour which are considered technical. Examples of such list items are as follows:

- control of an industrial process,
- processing of data representing physical values,
- change of internal functioning of the computer itself,
- efficiency or security of a process,
- management of computer resources,
- increasing rate of data transfer in a communication link.

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

The Hungarian Group is of the opinion that every technical field has its characteristic, well established claim-types and claim wording practice. Such practices have been developed so as to establish the most practical ways to fulfil the statutory general claim wording requirements. These general requirements should be applicable for CII as well, so no specific requirements are necessary, but explicit guidance about accepted ways of fulfilling the requirements are 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

The Hungarian Group is of the opinion that every technical field has its characteristic application-drafting practice. Such practices have been developed so as to establish the most practical ways to fulfil the statutory general sufficiency/enablement requirements. These general requirements should be applicable for CII as well, so no specific requirements are necessary, but explicit guidance about accepted ways of fulfilling the requirements are desirable.

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

Without the requirement that the claimed subject-matter of a CII shall contain a non-obvious technical contribution to the state of the art, CII could serve as a basis of abusing the patent system. Namely, it would open the way to patent new scientific theories, mathematical methods, schemes, rules and methods for performing mental acts, playing games or doing business by an easy inclusion of non-technical computer program feature(s), i.e. features without going beyond the "normal" physical interactions between the program (software) and the computer (hardware) on which it is run. This is clearly avoidable. These considerations are reflected by the converging practices of the USPTO and the EPO which are most welcome by the Hungarian Group.

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.
Marcell KERESZTY