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Software as Patentable Subject Matter in Germany - Recent Case Law of the German Federal Supreme Court: In a series of decisions starting in 2009 and culminating in the most recent decision of February 24, 2011, docket no. X ZR 121/09 – *Webseitenanzeige*, the German Federal Supreme Court (*Bundesgerichtshof*, BGH) outlined the requirements for software patents under German patent law. After a decision of the BGH's Xa Senate in 2010 (GRUR 2010, 613 – *Dynamische Dokumentengenerierung*), in which the BGH declared a Siemens' invention for the generation of structured documents with dynamic contents patentable (albeit without addressing its novelty or inventiveness), many commentators believed the BGH had dramatically lowered the barriers to software patentability in Germany. Some feared it would be sufficient to add language referring to a computer to a claim merely to fulfill the patentability requirements. The X Senate clarified the BGH's position later in 2010 under Art. 52 EPC (BGH GRUR 2011, 125 – *Wiedergabe topografischer Informationen*) and in its latest decision on another Siemens patent under the corresponding German rules on patentable subject matter in § 1 paras. 1, 3 and 4 German Patent Code (*Patentgesetz*, PatG).

Under § 1 para. 1 PatG, only technical inventions are patentable subject matter. It is sufficient that only a part of an invention involves a technical aspect (*Wiedergabe topografischer Informationen*, para. 31). It is, for example, sufficient that steps of a method are performed by technical devices connected to each other by a network, like the typical steps of processing, storing, and transmitting data by such devices (BGH GRUR 2009, 479 – *Steuerungseinrichtung für Untersuchungsmodalitäten*), even if such devices are not mentioned in the claims provided that their use is obvious to a person skilled in the art (*Webseitenanzeige*, para. 16).

Section 1 para. 3 no. 3 PatG excludes, among other things, software for data processing equipment from the patentable subject matter. Therefore, while the first requirement is easily met, the BGH further demands that the technical aspect of the invention comprise instructions for solving a specific problem by technical means, e.g., the solution of a technical problem with the help of a programmed computer (*Dynamische Dokumentengenerierung*, para. 22).

The BGH's latest decision provides that the requirement to solve a technical problem is met if (a) components of the devices are modified or are addressed in a fundamentally different way than before, (b) conditions outside the data processing equipment dictate the way the software is used to solve the problem, or (c) the software is designed to take the technical prerequisites of the data-processing equipment into account (*Webseitenanzeige*, paras. 21, 22).

The method claimed in the patent in dispute in *Webseitenanzeige* (display of websites) did not qualify. It comprised the following steps: (a) registering a user upon opening a start page, (b) registering information pages opened by the user directly or indirectly from the start page, and (c) creating a displayable description from which the order of the information pages opened by the user can be discerned. The claim would, for example, read on the use of cookies to track the sites visited by a user of a webpage, like the popular "bread crumb navigation."

The technical aspect of this invention was merely a measure of data processing already known in the art and nothing in the invention went beyond that. Apart from incorporating methods already known in the art (using cookies, generating HTML structures), the patent specification did not disclose any specific method by which the data would be collected. The claimed invention merely relocated the method used from the client to the server. That, too, was known in the art.

In contrast, *Dynamische Dokumentengenerierung*, the BGH had been satisfied that the invention under scrutiny, a method for generating structured documents with dynamic content, was intended to solve a problem faced by servers that lacked the capacity to utilize script languages used in documents to assume sufficient technicality (e.g., because they were too weak to run a Java Virtual Machine). The solution was directed at designers of systems for data processing, not software engineers, thus placing the investigation outside the scope of § 1 para. 3 no. 3 PatG.

Because the patent in *Webseitenanzeige* lacked patentable subject matter, the BGH did not address novelty or inventive steps. However, the test for patentable subject matter in software inventions is not very strict. Its purpose is to filter out patent claims that offer no novel and inventive technical teaching. The effect of an at least partial software implementation on the assessment of the inventive step was addressed in *Wiedergabe topografischer Informationen*.

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There, the technical aspects were limited to calculating the actual position of a car and to displaying topographical information corresponding to the car's direction of travel. Because the technical aspects were part of the prior art, the BGH declared the claim not inventive. Even though the invention permitted the information to be displayed in an improved manner, the BGH concluded that those parts of the claim did not contribute to solving a technical problem and thus could not be considered in evaluating the invention's inventiveness.

These series of decisions thus delineate the minimum requirements for patentable subject matter: there has to be a technical problem solved by technical means beyond what a person skilled in the art would do to implement the invention, such as collecting, processing, storing, or transmitting data. Even though the requirement can be satisfied easily, e.g., by catering to limitations of the data processing equipment used, only the technical aspects of the invention can be used to evaluate whether the invention is inventive. That inquiry will get much closer scrutiny from the courts.