
PATENTING COMPUTER IMPLEMENTED INVENTIONS IN THE UK

The United Kingdom Intellectual Property Office (UKIPO) has been obliged to change the guidance to Examiners over the exclusion from patenting of “mental acts”. As a result of decision of the High Court in *Halliburton v Comptroller of Patents* [2011] EWHC 2508, Examiners have been instructed that an “invention implemented by a computer will not be considered to be excluded from patentability as a mental act”. This will have profound effects on UK practice going forward.

Background

The UK Patents Act does not define what constitutes a patentable invention. Instead, it includes a list of exclusions defining those things that are considered not to be inventions. The list includes both computer programs, and methods for performing mental acts. However, something will only fall foul of one of the exclusions if it is considered to relate to that thing “as such”.

Computer Programs

In the *Halliburton* decision the judge confirmed that an invention that is implemented in software can be patentable.

“...The question is decided by considering what task it is that the program (or the programmed computer) actually performs. A computer programmed to perform a task which makes a contribution to the art which is technical in nature, is a patentable invention and may be claimed as such...”

It does not matter how the function is performed or achieved. What matters is that the programmed computer does something technical.

Mental Acts

The central issue raised in the *Halliburton* case was the ambit of the “mental act” exclusion in the UK Patents Act. The invention related to a method of designing drill bits and had been refused by the UKIPO during prosecution as constituting a mental act. Following earlier guidance issued by UKIPO, the Office had used a wide interpretation for the mental act exclusion. Under this interpretation any method which is capable of being performed mentally was excluded regardless of whether, as claimed, it was actually performed mentally. All computers programmed to carry out calculations, therefore, would have been excluded by the wide interpretation of the mental act exclusion because calculations are the kind of thing which are capable of being performed mentally.

“In my judgment the correct scope of the mental act exclusion is a narrow one. Its purpose is to make sure that patent claims cannot be performed by purely mental means and that is all. The exclusion will not apply if there are appropriate non-mental limitations in the claim.”

Two Excluded Areas at Once...

The judge commented, that to fall into the computer software exclusion it is almost always necessary for a claimed invention to fall into *two* of the specific excluded areas. The fact that the invention is implemented in software is not of itself enough to exclude the invention. What matters is what the programmed computer does. However, if the task performed is also excluded, for example, is a business method, or the presentation of information, then the subject-matter is not patentable.

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If you would like to have more detailed advice on the matters arising from this note, please contact us.