

EUROPEAN PARLIAMENT

1999



2004

Committee on Legal Affairs and the Internal Market

11 April 2003

PE 327.249/21-74

AMENDMENTS 21-74

Draft report

(PE 327.249)

Arlene McCarthy

on the proposal for a directive of the European Parliament and of the Council on the patentability of computer-implemented inventions

Proposal for a directive (COM(2002) 92 – C5-0082/2002 – 2002/0047(COD))

Text proposed by the Commission

Amendments by Parliament

Amendment by Toine Manders and Bert Doorn

Amendment 21

Title

Proposal for a **Directive** of the European Parliament and of the Council on the patentability of computer-implemented inventions

Proposal for a **Regulation** of the European Parliament and of the Council on the patentability of computer-implemented inventions

Or. nl

Justification

The directive should be made into a regulation. A directive is not the right legal instrument for achieving the underlying objectives, which can be achieved more effectively by means of a regulation. Directives tend to be transposed late and/or not properly into national legislation, creating 15 different legal systems. Regulations have direct effect and are not required to be

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transposed. This subject matter in particular (patenting of software) demands no change in national legislation and is therefore especially suited to being dealt with in a regulation.

Amendment by Toine Manders

Amendment 22

Recital 1

(1) The realisation of the internal market implies the elimination of restrictions to free circulation and of distortions in competition, while creating an environment which is favourable to innovation and investment. In this context the protection of inventions by means of patents is an essential element for the success of the internal market. *effective* and harmonised protection of computer-implemented inventions throughout the Member States is essential in order to maintain and encourage investment in this field.

(1) The realisation of the internal market implies the elimination of restrictions to free circulation and of distortions in competition, while creating an environment which is favourable to innovation and investment. In this context the protection of inventions by means of patents is an essential element for the success of the internal market. *Effective, transparent* and harmonised protection of computer-implemented inventions throughout the Member States is essential in order to maintain and encourage investment in this field.

Or. nl

Justification

Investment depends not only on effective and harmonised protection, but also on transparency.

Amendment by Evelyne Gebhardt

Amendment 23

Recital 7

(7) Under the Convention on the Grant of European Patents signed in Munich on 5 October 1973 and the patent laws of the Member States, programs for computers together with discoveries, scientific theories, mathematical methods, aesthetic creations, schemes, rules and methods for performing mental acts, playing games or doing business, and presentations of information

(7) Under the Convention on the Grant of European Patents signed in Munich on 5 October 1973 and the patent laws of the Member States, programs for computers together with discoveries, scientific theories, mathematical methods, aesthetic creations, schemes, rules and methods for performing mental acts, playing games or doing business, and presentations of information

are expressly not regarded as inventions and are therefore excluded from patentability. This exception, *however*, applies *and is justified only to the extent that a patent application or patent relates to such subject-matter or activities as such, because the said subject-matter and activities as such do not belong to a field of technology.*

are expressly not regarded as inventions and are therefore excluded from patentability. This exception *also* applies *if the matter referred to is implemented in computer programs which are executed in computers and which do not make a technical contribution. Merely specifying technical means in the patent claims does not constitute a technical contribution.*

Or. de

Justification

The exception contained in the Commission proposal, based on Article 52(2) of the EPC, needs to be defined more precisely. Implementation of excluded matter by means of a computer, or the inclusion of technical means in the patent claims, are not sufficient to make the matter patentable.

Amendment by Luis Berenguer Fuster

Amendment 24
Recital 7 a (new)

(7a) The aim of this Directive is not to amend the European Patent Convention, but to prevent different interpretations of its provisions.

Or. es

Justification

The European Patent Convention is an international instrument which can be amended only by the mechanisms provided for in the convention itself.

Amendment by Evelyne Gebhardt

Amendment 25
Recital 7 a (new)

(7a) A computer program, and in particular the expression of a computer program in source code or object code or in any other form, does not, therefore, constitute a patentable invention. The manufacture, offering for sale or placing on the market of such a computer program, or the importation or possession thereof to those ends, cannot constitute an infringement of patent law.

Or. de

Justification

The mere representation of a patent-protected computer-implemented invention does not in itself constitute an infringement of patent law. This creates the necessary legal certainty in order to avoid criminalising the manufacture or possession of representations of computer programs of patented inventions.

Amendment by Raina A. Mercedes Echerer, Evelyne Gebhardt, Neil MacCormick and Luis Berenguer Fuster

Amendment 26
Recital 8

(8) Patent protection allows innovators to benefit from their creativity. Whereas patent rights protect innovation in the interests of society as a whole; they should not be used in a manner which is anti-competitive.

(8) Patents are temporary monopolies granted by the State to inventors in order to stimulate global technical progress. In order to ensure that the system works as intended, the conditions for granting patents and the modalities for enforcing them must be carefully designed. In particular, in order that inevitable corollaries of the patent system such as restriction of creative freedom, legal insecurity and anti-competitive effects be kept within reasonable limits.

Or. en

Justification

Patents were not created for the benefit of patent holders, but for the benefit of society as a whole. If this overall benefit is not evidenced in some domain, there is no need for patents in this domain. Considering that patents restrict competition, the burden of the proof should belong to the promoters of patents within a new domain. TRIPS requires that patents should be available for all types of inventions, so the legislator must carefully define the limit of what may be considered as an invention, assessing all social and economical consequences.

Amendment by Raina A. Mercedes Echerer, Evelyne Gebhardt, Neil MacCormick, Luis Berenguer Fuster and Ilka Schröder

Amendment 27
Recital 11

(11) Although computer-implemented inventions are considered to belong to a field of technology, in order to involve an inventive step, in common with inventions in general, they should make a technical contribution to the state of the art.

Deleted

Or. en

Justification

The technical nature of assumed "computer-implemented inventions" has to be proved, and not taken for granted.

This amendment is the same as Am 14 Itr, Am 15 Itr and Am. 16 Itr.

Amendment by Evelyne Gebhardt

Amendment 28
Recital 11 a (new)

(11a) Computer-implemented inventions are only patentable if they may be considered to belong to a field of technology and, in addition, are new, involve an inventive step and are susceptible of industrial application.

Justification

In order to create legal certainty, the patent law principles of novelty, inventive step and industrial application (Articles 54, 56 and 57 of the EPC) should be incorporated in the recitals.

Amendment by Toine Manders

Amendment 29

Recital 12

(12) Accordingly, where an invention does not make a technical contribution to the state of the art, as would be the case, for example, where its specific contribution lacks a technical character, the invention will lack an inventive step and thus will not be patentable. ***Deleted***

Justification

The question of patentable matter is being linked to the question of inventive step. These questions must be considered separately from each other, as is the case with patents in general. Recital 11 is sufficient for purposes of clarification.

Amendment by Bert Doorn

Amendment 30

Recital 12

(12) Accordingly, where an invention does not make a technical contribution to the state of the art, as would be the case, for example, where its specific contribution lacks a technical character, the invention will lack an inventive step and thus will not ***Deleted***

be patentable.

Or. nl

Justification

Recital 11 is sufficient.

Amendment by Evelyne Gebhardt

Amendment 31

Recital 12

(12) Accordingly, *where an invention does not make a technical contribution to the state of the art, as would be the case, for example, where its specific contribution lacks a technical character, the invention will lack an inventive step and thus will not be patentable.*

(12) Accordingly, *a patentable computer-implemented invention should make a technical contribution to the state of the art, which is only the case if the contribution meets the criterion of having a technical character, i.e. teaches in one or more ways about cause-effect relationships when using controllable forces of nature. The extent of the protection provided by patent claims granted may, irrespective of further non-technical contributions and effects, only include this technical contribution. Patent claims should, in addition, be granted only if sufficient disclosure has been made of the computer-implemented invention.*

Or. de

Justification

The technical contribution to be made by a computer-implemented invention and the related concept of technical character are not defined precisely in the Commission proposal. It is, however, essential to do so in order to ensure legal clarity and legal certainty with regard to the patentability of a computer-implemented invention.

The disclosure requirement in respect of computer-implemented inventions enables technical

progress from the point of view of society as a whole to be made comprehensible. As regards computer programs forming part of computer-implemented inventions, the source code, including comments, should, for example, be made available.

Amendment by Raina A. Mercedes Echerer, Evelyne Gebhardt, Neil MacCormick, Luis Berenguer Fuster and Ilka Schröder

Amendment 32
Recital 13

(13) A defined procedure or sequence of actions when performed *in the context* of an apparatus such as a computer may *make a technical contribution to the state of the art* and thereby constitute a patentable invention. However, an algorithm *which is defined without reference to a physical environment* is inherently non-technical and cannot therefore constitute a patentable invention.

(13) A defined procedure or sequence of actions, when performed *with the help* of an apparatus such as a computer, may *contribute to our knowledge about the cause-effect relations of controllable forces of nature* and thereby constitute a patentable invention. However, an algorithm *or a computer program, regardless of whether the symbolic entities of which it is composed can be interpreted as referring to a physical environment or not*, is inherently non-technical, and cannot therefore constitute a patentable invention.

Or. en

Justification

The first sentence was unclear and could be interpreted such that otherwise non-patentable "sequences of actions" could receive patent protection when performed by a computer. The technicity of an assumed "computer-implemented invention" should not reside in the mere fact that a computer is used, but in the fact that it involves the use of controllable forces of nature to achieve a technical effect distinct from the ones involved in the processing of information by the computer program. The directive deals with computer-implemented inventions, that is, inventions the realisation of which involves computer programs, but computer programs are not inventions themselves since they do not belong to the physical realm and are protected by copyright. The computer equipment and software used to implement the invention should not be covered by the patent.

This amendment is equivalent to Am. 17 Itr and Am. 18 Itr.

Amendment by Evelyne Gebhardt

Amendment 33
Recital 13 a (new)

(13a) Computer-implemented rules of organisation and calculation (mathematical methods, algorithms, schemes, rules and methods for performing mental acts or doing business and programs for computers, etc) do not, pursuant to this directive, belong to the field of technology and are therefore not patentable. A method involving the use of rules of organisation or calculation may only be patentable subject to the additional condition that it makes a technical contribution to the state of the art.

Or. de

Justification

Paragraphs 2(a) and (c) of Article 52 of the EPC exclude, inter alia, patentability of rules of organisation and calculation and programs for computers. As these constitute an abstract contribution to knowledge of relations within non-material mathematical constructs (rules of calculation) or between material phenomena which are not determined by controllable natural forces (rules of organisation), both should also be excluded from patentability when implemented in the form of computer programs.

Amendment by Luis Berenguer Fuster

Amendment 34
Recital 16

(16) The competitive position of European industry in relation to its major trading partners would be improved if the current differences in the legal protection of computer-implemented inventions were eliminated and the legal situation was transparent.

(16) The competitive position of European industry in relation to its major trading partners would be improved if the current differences in the legal protection of computer-implemented inventions were eliminated and the legal situation was transparent.

However, the removal of these barriers may not entail the abandonment of basic

principles of European patent law, such as the principle that only technical inventions and inventions with industrial application are patentable.

Or. es

Justification

Eliminating differences between European and United States legislation cannot entail complete adoption of US criteria and the abandonment of everything that represents the essence of European law on the subject.

Amendment by Evelyne Gebhardt

Amendment 35
Recital 16 a (new)

(16a) At the international level, Europe is ahead in the area of open, alternative development and licensing approaches to computer programs, e.g. open source projects under the “General Public License”. Particularly in the light of increasing requirements for stability, interoperability and IT security of computer programs, open source computer programs developed on a common, ongoing and transparent basis are gaining in importance. In order to turn this European lead in terms of development into a real competitive advantage, the legal framework conditions for such alternative development and licensing approaches must continue to be able to be relied upon.

Or. de

Justification

Europe has the biggest community of developers and users of open source software (e.g. Linux and Apache). Thanks to the transparent conditions under which it is developed and its significantly lower costs in comparison with proprietary solutions, such software is growing in

importance, in particular in sensitive fields of application (security, secrecy protection, etc) or in areas subject to growing cost pressures (e.g. public administration). This directive should not make the already complicated legal framework for such project approaches even more complex.

Amendment by Luis Berenguer Fuster

Amendment 36
Recital 16 a (new)

(16a) For an invention to have industrial character, it is necessary not only for the means used in its implementation to be predominantly industrial, but also for the result it produces to be industrial in character.

The industrial character of an invention also implies that it contains no indication of human intellectual activity. In any case, as far as this Directive is concerned, when mention is made of the technical contribution, it should be understood that this refers to industrial technology.

Or. es

Justification

In a directive regulating the patentability of computer-implemented programmes, emphasis should be on basic principles, such as industrial character, which is used to distinguish inventions which are patentable from those which are not.

Amendment by Piia-Noora Kauppi

Amendment 37
Recital 18

(18) ***Acts permitted under*** Directive 91/250/EEC on the legal protection of computer programs by copyright, in particular provisions thereof ***relating to*** decompilation and interoperability, ***or the***

(18) ***The rights conferred by patents granted for inventions within the scope of this Directive shall not affect acts permitted under Articles 5 and 6 of*** Directive 91/250/EEC on the legal protection of

provisions concerning semiconductor topographies or trade marks, shall not be affected through the protection granted by patents for inventions within the scope of this Directive.

computer programs by copyright, in particular *under the* provisions thereof *in respect of* decompilation and interoperability. *In particular, acts which, under Articles 5 and 6 of Directive 91/250/EEC, do not require authorisation of the rightholder with respect to the rightholder's copyrights in or pertaining to a computer program, and which, but for Articles 5 or 6 of Directive 91/250/EEC, would require such authorisation, shall not require authorisation of the rightholder with respect to the rightholder's patent rights in or pertaining to the computer program.*

Or. en

Justification

Unlimited patent protection for software could make it illegal under patent law to engage in reverse engineering practices employed by software developers to achieve interoperability as currently permitted under the exceptions in the Software Copyright Directive. Therefore future EU legislation related to software patents must include an explicit exception to patent rights in order to ensure that developers of software can continue to engage in the same acts to achieve interoperability under patent law as they are allowed to today within the limits of copyright law.

The Council's common approach of 8 November 2002 is supported and clarified by a reference to Articles 5 and 6 of Directive 91/250/EEC.

Amendment by Arlene McCarthy

Amendment 38

Recital 18

(18) *Acts permitted under* Directive 91/250/EEC on the legal protection of computer programs by copyright, in particular provisions thereof *relating to decompilation and interoperability, or the provisions concerning semiconductor topographies or trade marks, shall not be affected through the protection granted by patents for inventions within the scope of this Directive.*

(18) *The rights conferred by patents granted for inventions within the scope of this Directive shall not affect acts permitted under Articles 5 and 6 of Directive 91/250/EEC on the legal protection of computer programs by copyright, in particular under the provisions thereof in respect of decompilation and interoperability. In particular, acts which, under Articles 5 and 6 of Directive 91/250/EEC, do not require authorisation*

of the rightholder with respect to the rightholder's copyrights in or pertaining to a computer program, and which, but for Articles 5 or 6 of Directive 91/250/EEC, would require such authorisation, shall not require authorisation of the rightholder with respect to the rightholder's patent rights in or pertaining to the computer program.

Or. en

Justification

Unlimited patent protection for software could make it illegal under patent law to engage in reverse engineering practices employed by software developers to achieve interoperability as currently permitted under the exceptions in the Software Copyright Directive. Therefore future EU legislation related to software patents must include an explicit exception to patent rights in order to ensure that developers of software can continue to engage in the same acts to achieve interoperability under patent law as they are allowed to today within the limits of copyright law.

The Council's common approach of 8 November 2002 is supported and clarified by a reference to Articles 5 and 6 of Directive 91/250/EEC.

Amendment by Luis Berenguer Fuster

Amendment 39

Recital 18

(18) Acts permitted under Directive 91/250/EEC on the legal protection of computer programs by copyright, in particular provisions thereof relating to decompilation and interoperability, or the provisions concerning semiconductor topographies or trade marks, shall not be affected through the protection granted by patents for inventions within the scope of this Directive.

(18) Acts permitted under Directive 91/250/EEC on the legal protection of computer programs by copyright, in particular provisions thereof relating to decompilation and interoperability, or the provisions concerning semiconductor topographies or trade marks, shall not be affected through the protection granted by patents for inventions within the scope of this Directive.

Under no circumstances should patent protection and copyright protection overlap.

Justification

The substance of this Directive cannot be seen as offering additional protection to that provided for in Directive 91/250/EC.

Amendment by Raina A. Mercedes Echerer, Evelyne Gebhardt, Neil MacCormick, Luis Berenguer Fuster and Ilka Schröder

Amendment 40
Article 1

This Directive lays down rules *for the patentability of computer-implemented inventions.*

This Directive lays down rules *concerning the limits of patentability and patent enforcability with respect to computer programs.*

Or. en

Justification

The term "computer-implemented inventions" is unclear, and obliges the legislator to deal with patentable and non-patentable inventions, while TRIPs requires that all inventions be patentable.

The directive deals with non-inventions just as much as with inventions, since it defines the limit of patentability between the world of technical, patentable inventions and the world of ideas and data processing, which is inherently non-technical and therefore not subject to patentability. This distinction will achieve the claimed legal certainty, since the rules of patentability for computerised inventions will be the same as the ones for inventions that do not make use of software for their operation.

Amendment by Raina A. Mercedes Echerer, Evelyne Gebhardt, Neil MacCormick, Luis Berenguer Fuster and Ilka Schröder

Amendment 41
Article 2, point (a)

(a) "computer-implemented invention" means any *invention the performance* of which involves the use of a computer, computer network or other programmable apparatus and having one or more prima

(a) "computer-implemented invention" means any *technical solution the implementation* of which involves the use of a computer, computer network or other programmable apparatus and having one or

facie novel features which are realised wholly or partly by means of a computer program or computer programs;

more prima facie novel or non-novel implementation features which are realised wholly or partly by means of a computer program or computer programs, *whereas the prima facie novel solution features depend wholly or partly on the presence of peripheral hardware which uses forces of nature in an inventive way;*

Or. en

Justification

The initial definition of patentability is too broad. In particular, a computer-implemented invention should not be considered patentable on the mere fact that a computer is used, or that software which runs on a non-novel programmable apparatus is novel. A technical contribution should be assessed.

This amendment improves Am. 15 Cult, Am. 19 Itr and Am. 21 Itr.

Amendment by Willi Rothley

Amendment 42 Article 2, point (a)

(a) "computer-implemented invention" means any invention the performance of which involves the use of a computer, computer network or other programmable apparatus and *having one or more prima facie novel features* which *are* realised wholly or partly by means of a computer program or computer programs;

(a) "computer-implemented invention" means any invention the performance of which involves the use of a computer, computer network or other programmable apparatus and which *is* realised wholly or partly by means of a computer program or computer programs;

Or. de

Justification

Self-explanatory.

Amendment by Raina A. Mercedes Echerer, Evelyne Gebhardt, Neil MacCormick, Luis

Berenguer Fuster and Ilka Schröder

Amendment 43
Article 2, point (b)

(b) "technical contribution" means a contribution to the state of the art in a technical field which is not obvious to a person skilled in the art.

(b) "technical contribution" means a contribution to the state of the art in a technical field which is not obvious to a person skilled in the art, *that is, a new teaching on cause-effect relations in the use of controllable forces of nature.*

Or. en

Justification

Innovations in non-technical domains are not inventions.

This amendment synthesises Am. 17 Cult, AM. 18 Cult, and Am. 22 Itr.

Amendment by Willi Rothley

Amendment 44
Article 2, point (b)

(b) "technical contribution" means a contribution to the state of the art in a technical field *which is not obvious to a person skilled in the art.*

(b) "technical contribution" means a contribution to the state of the art in a technical field.

Or. de

Justification

Self-explanatory.

Amendment by Raina A. Mercedes Echerer, Evelyne Gebhardt, Neil MacCormick, Luis Berenguer Fuster and Ilka Schröder

Amendment 45
Article 2, point (ba) (new)

(ba) "technical field" means an industrial application domain requiring the use of controllable forces of nature to achieve predictable results. "Technical" means "belonging to a technical field". The use of forces of nature to control physical effects beyond the numerical representation of information belongs to a technical domain. The production, handling, processing, distribution and presentation of information do not belong to a technical field, even when technical devices are employed for such purposes.

Or. en

Justification

The term "technical field", although referred to in several places of the Directive, was not defined.

The fact that a programmable apparatus, such as a generic computer, makes use of physical effects in order to process information should not be used to allow patent protection to the program running on such an apparatus.

This amendment synthesises Am. 16 Cult, Am. 19 Cult, Am. 23 Itr, Am. 24 Itr. and Am. 25 Itr.

Amendment by Raina A. Mercedes Echerer, Evelyne Gebhardt, Neil MacCormick, Luis Berenguer Fuster and Ilka Schröder

Amendment 46

Article 3

Member States shall ensure that ***a computer-implemented invention is considered to belong to a field of technology.***

Member States shall ensure that ***data processing is not considered to be a field of technology in the sense of patent law, and that innovations in the field of data processing are not inventions in the sense of patent law, regardless of whether they are executed in the human mind or by means of technical devices.***

Or. en

Justification

In order to achieve the goals of fostering innovation, competitiveness and growth in the European software sector, the patent system should apply only to areas where it has some economical soundness, that is, in the material realm, while no global economical benefit of patents have been evidenced for immaterial goods, as reported in report Juri-107, for instance.

Moreover, this amendment provides legal certainty, by defining clear limits between the domains of patentable inventions and of non-patentable immaterial innovations.

Amendment by Bert Doorn

Amendment 47

Article 4

1. Member States shall ensure that a computer-implemented invention is patentable on the condition that it is susceptible of industrial application, is new, and involves an inventive step.

In order to be patentable, a computer-implemented invention **must be** susceptible of industrial application, **be** new, **involve** an inventive step **and make a technical contribution.**

2. Member States shall ensure that it is a condition of involving an inventive step that a computer-implemented invention must make a technical contribution.

3. The technical contribution shall be assessed by consideration of the difference between the scope of the patent claim considered as a whole, elements of which may comprise both technical and non-technical features, and the state of the art.

Or. nl

Justification

This revised wording brings the definition of patentability of a computer-implemented invention into line with the general bases for patentability.

Amendment by Raina A. Mercedes Echerer, Evelyne Gebhardt, Neil MacCormick, Luis Berenguier Fuster and Ilka Schröder

Amendment 48
Article 4, Paragraph 1

1. Member States shall ensure that *a computer-implemented invention is patentable on the condition that it is susceptible of industrial application, is new and involves an inventive step.*

1. Member States shall ensure that *patents are granted only for technical inventions which are new, non-obvious and susceptible of industrial application.*

Or. en

Justification

Article 4(1) should be coherent with the amended version of Article 2. There must not be distinctions between patentable and non-patentable inventions.

This amendment synthesises Am. 11 Cult, Am. 20 Cult, Am. 28 Ire, and Am. 29 Ire.

Amendment by Luis Berenguier Fuster
Amendment 49
Artículo 4, apartado 1

1. Member States shall ensure that a computer-implemented invention is patentable on the condition that it is susceptible of industrial application, is new, and involves an inventive step.

1. Member States shall ensure that a computer-implemented invention is *not* patentable '*per se*', *but only insofar as* it is susceptible of industrial application, is new, and involves an inventive step *and a technical contribution.*

Or. es

Justification

It should be made clear that computer programmes cannot be patentable 'per se'.

Amendment by Willi Rothley

Amendment 50
Article 4, paragraph 2

2. Member States shall ensure that it is a

(Does not affect English version.)

condition of involving an inventive step that a computer-implemented invention must make a technical contribution.

Or. de

Justification

(Does not affect English version.)

Amendment by Raina A. Mercedes Echerer, Evelyne Gebhardt, Neil MacCormick, Luis Berenguer Fuster and Ilka Schröder

Amendment 51
Article 4, paragraph 2

2. Member States shall ensure that it is a condition of involving an inventive step that a computer-implemented invention must make a technical contribution.

2. Member States shall ensure that it is a condition of involving an inventive step that a computer-implemented invention must make a technical contribution, ***that is, provide new problem solutions consisting in teachings about new cause-effect relations in the use of controllable forces of nature, which are not obvious to a person skilled in the art.***

Or. en

Justification

Data processing should not be considered a field of technology.

This amendment synthesises Am. 21 Cult and Am. 22 Cult.

Amendment by Raina A. Mercedes Echerer, Evelyne Gebhardt, Neil MacCormick, Luis Berenguer Fuster and Ilka Schröder

Amendment 52
Article 4, paragraph 3

3. The technical contribution shall be

3. The technical contribution shall be

assessed by consideration of the difference between *the scope of the patent claim considered as a whole, elements of which may comprise both technical and non-technical features*, and the state of the art.

assessed by consideration of the difference between *all of the the technical features of the patent claim* and the state of the art.

Or. de

Justification

The wording of this article is self-contradictory, as it seems to state that a technical contribution may consist of non-technical features.

One should ensure that the conditions of novelty and inventive step regard the technical contribution, otherwise any novel software running on a non-novel technical device could be patentable.

This amendment synthesises Am. 32 Itr and Am. 33 Itr.

Amendment by Willi Rothley

Amendment 53
Article 4, paragraph 3

3. The technical contribution shall be assessed *by consideration of the difference between* the scope of the patent claim considered as a whole, elements of which may comprise both technical and non-technical features, *and the state of the art*.

3. The technical contribution shall be assessed *on the basis of* the scope of the patent claim considered as a whole, elements of which may comprise both technical and non-technical features.

Or. de

Justification

Self-explanatory.

Amendment by Evelyne Gebhardt

Amendment 54
Article 4, paragraph 3 a (new)

3a. Member States shall ensure that patent claims to a computer-implemented invention are granted only if there is full disclosure of the invention. Full disclosure includes the publication of the computer programs used for the purpose of implementation in source code, including comments.

Or. de

Justification

In order to create legal certainty, the patent law principles of novelty, inventive step and industrial application (Articles 54, 56 and 57 of the EPC) should be incorporated in the recitals.

The technical contribution to be made by a computer-implemented invention and the related concept of technical character are not defined precisely in the Commission proposal. It is, however, essential to do so in order to ensure legal clarity and legal certainty with regard to the patentability of a computer-implemented invention.

The disclosure requirement in respect of computer-implemented inventions enables technical progress from the point of view of society as a whole to be made comprehensible. As regards computer programs forming part of computer-implemented inventions, the source code, including comments, should, for example, be made available.

Amendment by Evelyne Gebhardt

Amendment 55
Article 4 a (new)

Exclusions from patentability

1. The fact that a computer or other programmable apparatus is used cannot in itself be regarded as constituting a technical contribution by a computer-implemented invention. Accordingly, inventions which involve computer programs and which, beyond the normal physical interaction between a program and the computer, computer network or other apparatus on which the program is

run, do not make any technical contribution, shall not be patentable.

2. Computer-implemented inventions which, in one or more ways, implement rules of organisation and calculation, such as business, mathematical or other methods, and which, beyond the normal physical interaction between a program and the computer, computer network or other apparatus on which the program is run, do not make any technical contribution, shall not be patentable.

Or. de

Justification

In line with recitals 7, 7a (new) and 13a (new).

Amendment by Luis Berenguer Fuster

Amendment 56
Article 4 a (new)

For the purposes of the previous article, the following conditions must be met in order for computer-implemented inventions to be patentable:

- 1. Both the means employed and the result must be industrial,*
- 2. They must involve novelty and an inventive step, to ensure that inventions already in the public domain cannot be appropriated by the mere fact of running a computer program;*
- 3. The description that must be made public should include the source code;*
- 4. Research into the object of the patent must be allowed, and therefore its decompilation;*

In any event, the patent holder must keep

the market adequately supplied with the result of the patented invention.

Or. es

Justification

The patentability of computer-implemented inventions must comply with the principles of patent law.

Amendment by Willi Rothley

Amendment 57
Article 5

Member States shall ensure that a computer-implemented invention may be claimed as a product, that is as a programmed computer, a programmed computer network or other programmed apparatus, or as a process carried out by such a computer, computer network or apparatus through the execution of software.

Deleted

Or. de

Justification

Self-explanatory.

Amendment by Maria Berger

Amendment 58
Article 5

Member States shall ensure that a computer-implemented invention may be claimed as a product, *that is* as a programmed computer, a programmed computer network *or* other programmed apparatus, or as a process

Member States shall ensure that a computer-implemented invention may be claimed as a product, *such* as a programmed computer, a programmed computer network, other programmed apparatus, *or a computer*

carried out by such a computer, computer network or apparatus through the execution of software.

program, or as a process carried out by such a computer, computer network or apparatus through the execution of software.

2. A patent claim to a computer program, either on its own or stored on a carrier, shall be allowed if that program would, when loaded and executed in a computer, programmed computer network or other programmed apparatus, put into force a product or process.

Or. de

Justification

This proposed amendment to Article 5 is in accordance with the common approach agreed by the Council in November 2002.

In accordance with that approach and with the wording proposed by the Commission, the second paragraph of the proposed version of Article 5 seeks to include claims relating to computer programs and thereby to make the provisions clearer. The proposed amendment reflects the current situation, as the European Patent Office and also national courts (for example, in Germany the judgment by the Federal Court in case X ZB 16/00, published in GRUR Int, 2002, volume 4, p. 323) have recognised claims relating to computer programs as products. It is important to use a positive form of words ('shall be allowed'), as it should be drawn to the attention of companies of all sizes and types that it is possible for claims of this kind to lead to a patent application. One of the objectives of the proposal is to convey a positive signal to the whole of the industry that computer-implemented inventions may be patented. The proposed amendment is also in accordance with the common approach agreed within the Council. However, the negative form of words used in the Council compromise ('shall not be allowed') does not contribute to clarity of the text, and a positive form of words ('should be allowed') should be used. This will enable difficulties of interpretation to be avoided in connection with the transposition of the provisions by the Member States.

Amendment by Raina A. Mercedes Echerer, Evelyne Gebhardt, Neil MacCormick, Luis Berenguer Fuster and Ilka Schröder

Amendment 59 Article 5

Member States shall ensure that a computer-implemented invention may be claimed as a product, that is as a **programmed computer**,

Member States shall ensure that a computer-implemented invention may be claimed **only** as a product, that is a **set of equipment**

a programmed computer network or other programmed apparatus, or as a process carried out by such a computer, computer network or apparatus through the execution of software.

comprising both programmable apparatus and devices which use forces of nature in an inventive way, or as a technical production process operated by such a computer, computer network or apparatus through the execution of software.

Or. en

Justification

The original wording of this article is confusing, since allowing to patent programmed generic computers would be equivalent to allowing to patent their software as such. Also, one must make sure that the production of information cannot be considered as an industrial production process.

This amendment synthesises Am. 24 Cult, Am. 25 Cult, Am. 37 Itr and Am. 38 Itr.

Amendment by Werner Langen

Amendment 60 Article 5

Member States shall ensure that a computer-implemented invention may be claimed as a product, that is as a programmed computer, a programmed computer network or other programmed apparatus, or as a process carried out by such a computer, computer network or apparatus through the execution of software.

Member States shall ensure that a computer-implemented invention may be claimed as a product, that is as a programmed computer, a programmed computer network or other programmed apparatus ***or a computer program stored on a carrier or delivered by means of a signal***, or as a process carried out by such a computer, computer network or apparatus through the execution of software.

Or. de

Justification

The European Patent Office and national courts already allow patents on program products. The proposal for a directive would restrict this practice and give rise to further problems. A claim to a computer-implemented invention as a product would only be granted where an infringing party combines the computer program invention with hardware in order to form a programmed computer, programmed computer network or other programmed apparatus. End

users would directly infringe the patent by installing the invention in a computer, computer network or other apparatus, whilst manufacturers or distributors would not be committing a direct infringement by manufacturing or distributing carriers containing such computer-implemented inventions. Such an effect cannot be desirable.

Amendment by Malcolm Harbour, Janelly Fourtou and Anne-Marie Schaffner

Amendment 61

Article 5, paragraph 1 and paragraph 2 (new)

Member States shall ensure that a computer-implemented invention may be claimed as a product, ***that is*** as a programmed computer, a programmed computer network or other programmed apparatus, or as a process carried out by such a computer, computer network or apparatus through the execution of software.

1. Member States shall ensure that a computer-implemented invention may be claimed as a product, ***such*** as a programmed computer, a programmed computer network or other programmed apparatus, or as a process carried out by such a computer, computer network or apparatus through the execution of software.

2. ***A claim to a computer program either on its own or on a carrier shall be allowed if that program would, when loaded and executed in a computer, programmed computer network or other programmable apparatus, put into full effect a product or process.***

Or. en

Justification

Makes it clear that computer programs can be patented provided that they put into force a product or process that meets the criteria for a computer-implemented invention. This formulation removes any legal uncertainty about the linkage between the programmed apparatus and the process concerned. The requirement to put into "full effect" means that the program must be completely linked to the patentable product or process outcome.

Amendment by Ward Beysen

Amendment 62

Article 5, paragraph 2 (new)

2. ***A claim to a computer program, either on its own or on a carrier, shall be allowed if that program would, when loaded and***

executed in a computer, programmed computer network or other programmable apparatus, put into force a product or process claimed in the same patent application in accordance with paragraph 1.

Or. deJustification

The European Patent Office presently permits a computer-implemented invention that meets the normal tests to be claimed as a computer program. The Commission's proposal diverges from current EPO practice and would forbid such claims. The result would be to introduce a disconformity with current EPO practice and create doubt about the status of granted patents including such claims. Enforcement of patents will become more difficult, particularly against infringing distributors of computer programs. In cases where such distributors are located in one EU Member State and the users of the computer program are situated in another Member State, enforcement of valid patents against distributors may well be impossible. Users will be put in the untenable situation of purchasing computer programs in good faith, but unwittingly infringing valid patents when executing the computer program.

Amendment by Raina A. Mercedes Echerer, Evelyne Gebhardt, Neil MacCormick, Luis Berenguer Fuster and Ilka Schröder

Amendment 63
Article 5 a (new)

Member States shall ensure that the production, handling, processing, diffusion and presentation of information in whatever form can never constitute a direct or indirect patent infringement, even when technical devices are used for that purpose.

Or. en

Justification

The purpose of this amendment is to prevent the patenting of so-called "business methods" (that is, in fact, information processing) patents that exist in the United States and should not exist in the EU.

Also, one has to make sure that the execution on any programmable apparatus of software that does not contribute to any technical process should not be patentable. Else, any generic software running on some programmable apparatus having novel features could be patentable, which is explicitly prohibited by the European Patent Convention of 1973, as stated in Recital 7.

This amendment synthesises Am. 27 Cult, Am. 28 Cult, Am. 39 Itr and Am. 40 Itr.

Amendment by Willy C.E.H. De Clercq

Amendment 64
Article 5, paragraph 2 (new)

2. A claim to a computer program, either on its own or on a carrier, shall not be allowed unless that program would, when loaded and executed in a computer, programmed computer network or other programmable apparatus, implement a product or process claimed in the same patent in accordance with paragraph 1.

Or. en

Justification

Paragraph 2, as proposed, corresponding to the orientation of the Council, draws the normal and important consequence for the program of its being a decisive part of the computer-implemented invention. Deciding differently would deprive the patentability of computer-implemented inventions of any practical meaning, since the program is the core of it and, above all, the part which is under attack through patent infringement. The most energetic defence must be applied to the program.

Amendment by Evelyne Gebhardt

Amendment 65
Article 5, paragraph 2 (new)

2. Member States shall ensure that patent claims granted in respect of computer-implemented inventions include only the technical contribution which justifies the patent claim. A patent claim to a computer program, either on its own or on a carrier, shall not be allowed.

Or. de

Justification

A patent claim to a computer program as such used in connection with patent-protected computer-implemented inventions, or to its recording on a carrier, is not permissible. A 'text claim' to computer programs in source or binary code would increase legal uncertainty, as simply possessing an expression or a carrier with a protected program would mean infringing patent law. The availability of a program in text form may be seen as a contribution to the disclosure requirement in respect of functionalities of computer programs for which patent claims are granted.

Amendment by Arlene McCarthy

Amendment 66
Article 6

“Acts permitted under Directive 91/250/EEC on the legal protection of computer programs by copyright, in particular provisions thereof relating to decompilation and interoperability, or the provisions concerning semiconductor topographies or trademarks, shall not be affected through the protection granted by patents for inventions within the scope of this Directive.”

The rights conferred by patents granted for inventions within the scope of this Directive shall not affect acts permitted under Articles 5 and 6 of Directive 91/250/EEC on the legal protection of computer programs by copyright, in particular under the provisions thereof in respect of decompilation and interoperability.

Or. en

Justification

Unlimited patent protection for software could make it illegal under patent law to engage in reverse engineering practices employed by software developers to achieve interoperability as currently permitted under the exceptions in the Software Copyright Directive. Therefore future EU-legislation related to software patents must include an explicit exception to patent rights in order to ensure that developers of software can continue to engage in the same acts to achieve interoperability under patent law as they are allowed to today within the limits of copyright law.

The Council's common approach of 8 November 2002 is supported and clarified by a reference to Articles 5 and 6 of Directive 91/250/EEC.

Amendment 67

Article 6

“Acts permitted under Directive 91/250/EEC on the legal protection of computer programs by copyright, in particular provisions thereof relating to decompilation and interoperability, or the provisions concerning semiconductor topographies or trademarks, shall not be affected through the protection granted by patents for inventions within the scope of this Directive.”

The rights conferred by patents granted for inventions within the scope of this Directive shall not affect acts permitted under Articles 5 and 6 of Directive 91/250/EEC on the legal protection of computer programs by copyright, in particular under the provisions thereof in respect of decompilation and interoperability.

Or. en

Justification

Unlimited patent protection for software could make it illegal under patent law to engage in reverse engineering practices employed by software developers to achieve interoperability as currently permitted under the exceptions in the Software Copyright Directive. Therefore future EU-legislation related to software patents must include an explicit exception to patent rights in order to ensure that developers of software can continue to engage in the same acts to achieve interoperability under patent law as they are allowed to today within the limits of copyright law.

The Council's common approach of 8 November 2002 is supported and clarified by a reference to Articles 5 and 6 of Directive 91/250/EEC.

Amendment by Raina A. Mercedes Echerer, Evelyne Gebhardt, Neil MacCormick, Luis Berenguer Fuster and Ilka Schröder

Amendment 68

Article 6

Acts permitted under Directive 91/250/EEC on the legal protection of computer programs by copyright, in particular provisions thereof relating to decompilation and interoperability, or the provisions concerning semiconductor topographies or trade marks, shall not be affected **through the protection granted by patents for inventions within the scope of this Directive.**

Member States should ensure that the domains of copyright and patent protection do not overlap. Property in computer programs is acquired and regulated through copyright. Property in technical inventions is acquired and regulated through patents. Aspects of a computer program that cannot be appropriated through copyright cannot be appropriated through patents, utility certificates nor any

other property regime. Consequently, acts permitted under Directive 91/250/EEC on the legal protection of computer programs by copyright, in particular provisions thereof relating to decompilation and interoperability, or the provisions concerning semiconductor topographies or trade marks, shall not be affected ***by*** this Directive.

Or. en

Justification

Patents can pose a serious threat not only to interoperability but also to competition in general, especially in the case of information technologies. Referring to the copyright directive to only ensure interoperability is not relevant, because while these provisions can help a second implementor to achieve interoperability with existing software, software patents also harm the first player to implement a patented algorithm, when the patent holder did not make the true effort to turn a cheap patented idea into software and prefers to collect taxes on really innovative players.

In order to avoid this anti-competitive behaviour, the owner of a copyrighted software must not be deterred by patents, nor should he be able to deter innovative competitors from entering the market and challenging him; first-mover advantage is enough to guarantee him return on his investments (as evidenced in report Juri-107). Consequently, the spheres of copyright and of patents should be kept separate.

Amendment by Luis Berenguer Fuster

Amendment 69

Article 6, second paragraph (new)

The Member States shall ensure that computer-implemented inventions that meet the conditions laid down in this Directive do not benefit from protection by both patent and copyright.

Or. es

Justification

The substance of this directive should not entail protection additional to that provided under Directive 91/250/EC.

Amendment by Raina A. Mercedes Echerer, Evelyne Gebhardt, Neil MacCormick, Luis Berenguer Fuster and Ilka Schröder

Amendment 70
Article 7 a (new)

The European Parliament shall form a permanent committee on the criteria of patentability. This investigation committee shall be empowered to take appropriate means to obtain any needed information from the European Patent Office, the European Commission and important industry players. The European Community retains the freedom to adopt a stricter interpretation of concepts such as "invention", "technical character", "inventivity" and "industrial application" any time later and to apply this stricter interpretation retroactively to patents which were granted under looser interpretations when this is found to be in the public interest.

Or. en

Justification

Since the criteria for patentability may have a tremendous impact on entire business fields and therefore impact the economy and society as a whole, it is of utmost importance to have them defined under parliamentary control.

The legality of this amendment has to be checked with respect to the roles of the different European institutions.

Amendment by Raina A. Mercedes Echerer, Evelyne Gebhardt, Neil MacCormick, Luis Berenguer Fuster and Ilka Schröder

Amendment 71
Article 8 c bis (new)

Whether the powers delegated to the EPO are compatible with requirements for harmonisation of the EU legislation, together with the principles of transparency

and accountability.

Or. en

Justification

Since the criteria for patentability may have a tremendous impact on entire business fields and therefore impact the economy and society as a whole, it is of utmost importance to have them defined under parliamentary control.

This amendment synthesises Am. 35 Cult and Am. 44 Itr.

Amendment by Toine Manders

Amendment 72

Motion for a legislative resolution, paragraph 1

1. Calls on the Commission to withdraw the directive. For reasons of legal certainty, calls on Member States which are contracting states to the European Patent Convention to examine the possibility of including the patentability of computer-implemented inventions in Article 52 of the European Patent Convention.

Or. nl

Justification

Withdrawing the directive and amending Article 52(3) of the EPC will provide the harmonisation and legal certainty desired. The fact that the European Patent Convention and Community legislation exist alongside each other makes the current legal rules concerning the granting of patents unnecessarily confusing. Amending Article 52 of the EPC in accordance with the spirit of, and the criteria proposed in, this directive will enhance legal certainty.

Amendment by Toine Manders

Amendment 73

Motion for a legislative resolution, paragraph 1 a

1a. For reasons of legal certainty, calls on

Member States which are also contracting states to the European Patent Convention to ensure that practice with regard to the granting of patents pursuant to the European Patent Convention is brought into conformity with the provisions of this directive.

Or. nl

Justification

The Member States should ensure that the examination guidelines of the European Patent Office are in accordance with the provisions of this directive.

Amendment by Toine Manders

Amendment 74

Motion for a legislative resolution, paragraph 1 b

1b. Calls on the Commission to put forward, within two years, concrete proposals for establishing a Community patent. Calls on the Member States to withdraw from the European Patent Convention following the introduction of such Community legislation.

Or. nl

Justification

Legislation forming part of Community law, in respect of which the Court of Justice has jurisdiction and over which the democratically elected Parliament has control, is to be preferred. In view of the consequences of patents for the economy and society, it is important that such matters fall within the competence, and are subject to the control, of a democratically elected Parliament.