Preface

We work at the European Patent Office (EPO). Three of us are patent examiners and one is the director of a group of patent examiners. Patent examiners assess applications for patents which may be granted to inventors. A patent is a legal title giving its holder the right to prevent third parties from commercially using an invention without authorisation. Examiners check in particular that the invention is new and not some mere obvious alteration to something which already exists, by carrying out searches on all sorts of information which existed and could have been looked at by the applicant in the time up to the filing of their first application. Such information is collectively known as the “prior art” by those working in the patent world. Patent examiners work at the forefront of technology and deal every day with the latest and most challenging technical innovations. We will present an overview of the mindset of typical patent examiners. Although we aim to give general advice, a certain bias towards the procedures of the EPO is unavoidable.

The idea underlying this book first came about when two of us participated in writing an article [1] in which we demonstrated, by way of one particular example, how much technical information had to be disclosed in an application in order to describe a technical contribution which would in turn be worthy of detailed examination of inventive step. This article was met with general enthusiasm and numerous remarks encouraging the authors to extend the exercise. Since then we have been repeatedly asked to consider extending the scope to other specific areas of interest. After one of us was approached by the current publishers to present a scheme for a more extensive treatment of such topics, we started to collect information and to discuss, with a view to “doing a proper job” of production of a more complete compilation, snippets of presentations we regularly give.

As befits a European organisation, our countries of origin are spread across Europe. We come from Scotland, Luxemburg, France/Spain and Austria. We are thus truly European. The European Patent Office and its civil servants have created a culture of cultures both as an organisation and within the daily lives of all employees. This even in itself is remarkable – yet only shortly after the European Patent Organisation celebrated its 30th birthday it welcomed “The Former
Yugoslav Republic of Macedonia” as its 35th member state, on 1 January 2009 (Fig. 1). These first few decades have been spectacular. The number of applications filed with the European Patent Office has risen steadily, confounding the humble expectations of its founding fathers, who would never have guessed at the current figures even in their wildest dreams. In the early years of its existence, the EPO was dealing with around 10,000 applications a year; this was already considered a success. In 2007 the EPO received well over 210,000 applications [2].

One basic reason for the success of the European patent system appears to lie in the high economic value which is attributed to patents granted under its auspices. This is a particularly strong motivation for getting patent applications to comply with the European Patent Convention (EPC) right from the beginning. In our daily work we have to deal with a variety of applications, some of which describe truly splendid innovations. A relatively high proportion of them, however, will not be granted a patent because they do not show all the important features

Fig. 1 The member states of the European Patent Organisation (EPO)
necessary to satisfy our patent law. In many cases this sorry situation could have been avoided had some basic considerations been respected. This is particularly true for computer implemented inventions.

Together, the four of us have a total experience of 70 years in the patent business. From our academic background we are physicists, electronic engineers and computer scientists. We are happy to tap our wealth of knowledge for this book. Our present common centre of professional interest lies within the area of Computer Implemented Inventions (CII). This also includes applications which are frequently termed “methods for doing business”, as these are typically implemented on computers.

This book is based on our experience within the EPO and by way of some extension, Europe more generally, patent law in Europe being more or less harmonized. National Courts of Justice, when dealing with cases that had been examined in the light of the EPC and the EPO’s Boards of Appeal, attempt to interpret the law in accordance with the same values, and where differences do exist they tend to be relatively minor matters of emphases rather than fundamental differences.

This book is a guide to examiner thinking. Despite differences in respective patent law, the basic rationale of patent examiners is globally rather similar. The principles developed in this book apply therefore also to other patent systems to a considerable degree, and reference will regularly be made to the USA and Japanese systems.

References

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