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REVISED DRAFT PCT INTERNATIONAL SEARCH AND
PRELIMINARY EXAMINATION GUIDELINES:
PROPOSALS BY THE EUROPEAN PATENT OFFICE
CONCERNING PROGRAMS FOR COMPUTERS

Document prepared by the International Bureau

1. Document PCT/MIA/9/2 contains a revised draft set of combined Guidelines for International Search and Preliminary Examination under the PCT submitted by the United States Patent and Trademark Office.
2. Noting that practice varies between Authorities in respect of the search and preliminary examination of international applications relating to programs for computers, the Annex to this document contains a proposal by the European Patent Office (EPO) for an annex to paragraph 20.04(f) of the Guidelines, describing the practice by some Authorities, including the EPO, in this field.
3. *The Meeting of International Authorities is invited to take note of the contents of the Annex to this document in conjunction with the relevant parts of the draft Guidelines in the Annex to document PCT/MIA/9/2.*

[Annex follows]

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ANNEX

PROPOSAL BY THE EUROPEAN PATENT OFFICE
FOR AN ANNEX TO PARAGRAPH 20.04(F) OF THE GUIDELINES,
RELATING TO PRACTICE IN CERTAIN AUTHORITIES
CONCERNING PROGRAMS FOR COMPUTERS

Programs for computers, to the extent that the Authority is not equipped to carry out search or preliminary examination on such programs. It should be noted at the outset that programs for computers can be expressed in many forms. To the extent that a natural language description of any computer-executable program, or a self-documented code, is included in the disclosure and the claims, the Authority should be considered “equipped” to carry out a search and preliminary examination based on such a description as long as a meaningful search can be carried out and subject to the following guidelines regarding the conditions as to exclusion. The basic considerations here are exactly the same as for the other exclusions listed in Rule 67, that is, whether the program claimed has technical character. A program producing only an expression of an idea (such as a mathematical theory) would fall within this exclusion. On the other hand, a data-processing operation can be implemented either by means of a computer program or by means of special circuits, and the choice may have nothing to do with the inventive concept but be determined purely by factors of economy or practicality. The technology involved in executing the data-processing operation should not be the determining factor for exclusion. With this point in mind, search and preliminary examination in this area may be performed on any computer program having technical character. Search and preliminary examination should not be denied merely on the grounds that a program is involved in the implementation. This means, for example, that program-controlled machines and program-controlled manufacturing and control processes should normally be regarded as subject matter on which an international search and preliminary examination can be carried out. It follows also that where the claimed subject matter is concerned only with the program-controlled internal working of a known computer, the subject matter could be searched and examined if it provides a technical effect which goes beyond the normal interaction between a program and a computer. As an example, consider the case of a known data-processing system with a small, fast-working memory and a larger, but slower, further memory. Suppose that the two memories are organized under program control in such a way that a process which needs more address space than the capacity of the fast-working memory can be executed at substantially the same speed as if the process data were loaded entirely in that fast memory. The effect of the program in virtually extending the working memory provides a technical character and would, therefore, require search and preliminary examination of a claim relating to the program involved whatever is the form in which it is presented, e.g. product, computer program product, process and use claims. See, however, in this context, paragraphs III-3.2 and III-4.1 [paragraphs 13.12 and 13.32] [XR].

[End of Annex and of document]