

It all depends on the facts

The UK Court of Appeal recently issued a judgment in Lantana Ltd's application which provides a useful summary of tests for excluded subject matter in the UK set out in previous cases. However, the judgment does little to clarify what continues to be a rather opaque and fact-specific area of the law.

The Court of Appeal upheld the High Court's decision that the invention claimed in Lantana's application was excluded from patentability as relating to a computer program, as such. The full judgment can be viewed [here](#).

The claim in Lantana's application was directed to a method of transferring data between two computers over the internet, whereby the first computer sends an email specifying a file to the second computer and the second computer automatically responds by sending an email response with the file attached. Lantana asserted that the advantage of the claimed method was that it saves the need for continuous connection to the computer storing the files.

The novelty and inventiveness of Lantana's claim was never at issue. The application was rejected by the UKIPO solely on the basis of the invention constituting unpatentable subject matter under Section 1 of the Patents Act 1977 which excludes computer programs "as such" from patentability.

The judgment refers to the four-stage approach from the Court's previous 2006 judgments in *Aerotel Ltd v Telco Holdings Ltd*; *Macrossan's Application*. As laid out in *Aerotel*, the four steps comprise:

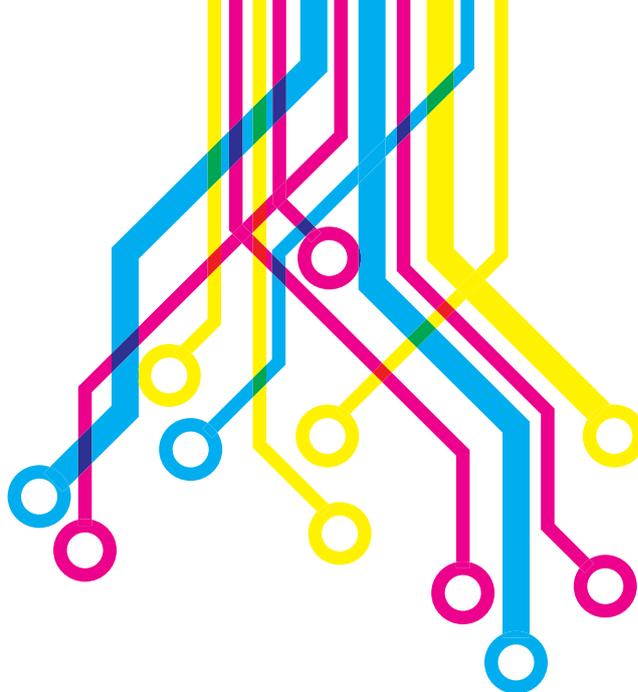
1. properly construing the claim;
2. identifying the actual contribution;
3. asking whether it falls solely within the excluded subject matter; and
4. checking whether the actual or alleged contribution is actually technical in nature.

Despite the use of the word "alleged" in the fourth step of the *Aerotel* test, but in line with further excerpts from *Aerotel*, Lord Justice Kitchen emphasised in Lantana's appeal that "it is the actual contribution to the art which the invention has made which must be considered". Therefore, the critical issue in question was whether the invention made an actual technical contribution.

It was also accepted that there is no comprehensive test for determining technical contribution. However, paragraphs 45 to 49 of the Court of Appeal's 2013 judgment in *HTC Europe Co Ltd v Apple Inc* were highlighted as providing a helpful starting point: these upheld the High Court's application of the five "signposts" for assessing technical contributions which originated in 2009 from *AT&T Knowledge Ventures' Application*.

For Lantana's case, the *AT&T* signposts were considered by both the Hearing Officer at the UK Intellectual Property Office and Justice Birss in the High Court, but in both cases it was concluded that none of the signposts assisted Lantana.

Lord Justice Kitchen agreed with Lantana that "it is the claim as a whole which must be considered when assessing the contribution which an invention has made, and that it is not permissible simply to cut the claim into pieces and then consider those pieces separately and without any regard to the way they interact with each other" (paragraph



64). However, despite this, the Court of Appeal found that Justice Birss had not erred in breaking the invention down into its constituent parts to determine whether there was a relevant technical step outside the computer program, especially since he subsequently considered the claim as a whole.

The Court also stressed that, although they should arrive at the same result, the EPO and the English courts adopt a different methodology when assessing the patentability of computer programs. Accordingly, decisions of the EPO provide only limited assistance to the English courts.

In assessing technical contribution, the Court was dismissive of the relevance of prior patentability decisions: "It cannot be right [...] that simply because at one point in history a process constitutes a technical contribution that the same or similar process, even if novel, will constitute a technical contribution for all time" (paragraph 43). Therefore, any similarity between the method of Lantana's claim and that considered to be patentable in a previous *IBM* decision before the UK Patent Office did not assist Lantana in establishing patentability.

On the facts of this case it was found that the invention of Lantana's application did not provide a technical contribution outside the computer program and was, therefore, not patentable.

Conclusion

The judgment in *Lantana* does not deviate from the general guidelines for the assessment of excluded subject matter and technical contribution in the UK as

laid out in previous case law. However, the judgment does emphasise that, in the very fact-sensitive area of the patentability of computer programs, technical contribution is not a static test; the bar for establishing a technical contribution will continue to rise as the technical field progresses. Accordingly, one cannot rely on a previous finding of patentability for similar subject matter as evidence of a technical contribution. According to the Court: "It all depends on the facts".

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