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Patent examination guidelines amended for computer software-related inventions

[Formosa Transnational - Taiwan](#)

[Yulan Kuo, Charles Chen](#)

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The protection of computer software under Taiwanese patent legislation has been an ongoing issue. Chapter 12 of the Patent Examination Guidelines specifically addresses computer software-related inventions and was first announced in October 1998 to improve the protection of IP rights related to computer software. In the 1998 version, computer software itself was not eligible subject matter for protection and a claim for computer software had to be drafted in the form of a method claim or an article claim (eg, a computer-readable medium or a system) in order to comply with the Patent Law. In 2008 an amendment dealt with the issue of whether computer software alone was patentable subject matter under the Patent Law; it expanded the scope of protection to computer software-related inventions and further defined the claim language for 'means plus function'. After these guidelines had been applied for several years, a number of issues arose due to certain ambiguities. Following public hearings and consultation, the most recent amendment to the guidelines was finalised and took effect on January 1 2014.



Yulan Kuo



Charles Chen

Inconsistency

The amendment first deals with the problems of inconsistency and redundancy. Several duplicated sentences and paragraphs have been deleted and all paragraphs and contents have been reorganised or redrafted, resulting in a much better structure. Most of the examples of what is and is not patentable are now in the last section, which provides easy reference. In addition, the amendment addressed the issue of eligible subject matter and further clarifies the definition of a patentable 'computer software-related invention'.

Clarification of 'non-technical'

The guidelines basically adopt the principle (stated in the proposed EU directive) that a software-related invention must possess technical character.



The 2008 amendment stated that claims drafted for computer software-related inventions must sufficiently disclose how to perform the algorithms with the technical means to achieve specific functions. However, this explanation was still abstract and resulted in much debate over office actions. In order to resolve this issue, the Taiwan IP Office (TIPO) has redrafted the related paragraphs, which now set out two tests to explain how TIPO examines for technical character: simple presentation of information and simple utilisation of a computer.

Simple presentation of information

A patent application that simply indicates the presentation of information is not a patentable computer software-related invention. However, it can become patentable if it has a technical effect. The amendment provides several examples to explain and identify what is non-technical in terms of the presentation of information. For instance, a design for a graphic user interface in which the arrangement of the icons is made to attract consumers usually involves no technological art, and the content of a short message displayed on a device contains no technological art, even if such message makes the user execute actions on the device. However, if a technical effect occurs as a result of the interaction between the presentation of information and algorithms, the patent application will likely be deemed to contain technical character. For example, a presentation of information may be deemed to have a technical effect if it can increase the accuracy or reduce the effort exerted by a user of an input device.

Simple utilisation of computer

If computer software or a computer is merely used to replace human work and to provide only faster speed and accuracy, this utilisation will be deemed to be non-technical, as such an improvement is derived merely from the inherent ability of software or computers. However, if such utilisation generates a technical effect because it overcomes a technical difficulty or solves questions by technical means, it may contain the requisite technical character. For example, the utilisation of a computer that improves the security of a data system, increases a system's execution efficiency or increases the stability of a system may be deemed to contain a technical character. In sum, how the "technical effect" is created is the essential point in determining whether technical character exists in a computer software-related invention. According to the amendment, not only must claims related to computer software have described sufficient technical features to show how the software program is conducted, but also the specifications and drawings should explain how the technical effect was generated to show the existence of technical character, rather than simply indicating that the process is performed by a general purpose computer or microprocessor.

Guidance on 'means plus function' claims

'Means plus function' claim language is often applied in claims for computer software, as most of the technical features derive from the function outcome based on the algorithm, rather than from the tangible device in which the software is stored. Although the previous 2008 amendment provided the definition of 'means plus function' in view of the claim words for computer software patents, there were no clear rules as to how to determine what claim language belongs to the category of means plus function or the scope of the claims drafted by means plus function. Now, TIPO has merely provided examples of means plus function or steps plus function for computer software-related inventions, rather than directly providing a definition of these with examples of claim wording.

Also, the amendment emphasises the requirement for clear and sufficient disclosure. A claim must allow a person ordinarily skilled in the art to know the corresponding structure, material, actions, software or hardware that may perform such functions. Thus, the amendment makes the guidelines more concise and facilitates understanding, but there are still no clear rules indicating how to determine which claims are considered to be means plus function claims. As such, the amendment provides room for applicants to create claims for computer software-related inventions and needs more precedents to clarify the rules.

Comment

The amendment achieves its objective of further clarifying the standards and improving consistency, and provides further guidance as to the meaning of 'non-technical'. Thus, it should help applicants and examiners to understand and determine whether a patent application for a computer software-related invention has the requisite technical character. As a result of the amendment, the guidelines more clearly indicate that a computer software solution for presentation of information or a business method may be patentable if it has a technical effect. The amendment can thus be viewed as a positive development for software companies working on mobile applications or engaged in the online games industry. Although the explanations are still somewhat abstract, further details and rules are expected to be established by practice in the near future.

For further information please contact:

Yulan Kuo
Formosa Transnational
www.taiwanlaw.com
Email: yulan.kuo@taiwanlaw.com
Tel: +886 2 2755 7366

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