

Beauregard U-Turn (again!)

1. Introduction

1.1 In a recent decision (*Astron Clinica Limited and Ors v. The Comptroller General of Patents, Designs and Trade Marks*), the UK High Court has stated that so-called Beauregard (computer program product) type claims are in principle allowable.

1.2 For the uninitiated, Beauregard claims are claims that cover computer programs stored on suitable storage media as opposed to claims directed to a device or apparatus operating under the control of a program or a method performed by running a suitably programmed computer.

1.3 Why is this decision so important in the UK? Computer program product claims allow patent owners to protect their software-related inventions without having to rely upon the contributory infringement provisions (a form of indirect infringement) of the UK Patents Act. This is especially important, because the contributory infringement provisions do not protect against the production and sale of computer programs in the UK when they are intended for use abroad.



2. Background

2.1 Under the UK statute, certain parts of the UK Patents Act are meant to be framed so as to have, as nearly as practicable, the same effect in the UK as the corresponding provisions of the European Patent Convention (EPC).

2.2 However, in relation to software-related inventions, UK jurisprudence is only partially consistent with European Patent Office jurisprudence. As a result of a relatively recent UK Court of Appeal decision, UK case law is not consistent with some of the more recent EPO Technical Board of Appeal decisions.

2.3 The relatively recent (2006) Court of Appeal judgement mentioned above is known as the *Aerotel/Macrossan* case. In this case, the UK Court of Appeal extensively reviewed both UK and EPO jurisprudence before arriving at a reformulated test for determining whether or not a claim relates to excluded subject matter, for example purely to a computer program, a game, a business method or a process of the human mind.

2.3 As a result of this judgement, the UK Intellectual Property Office (UK IPO) concluded that they were no longer empowered to allow Beauregard type claims contained in a UK patent application.

3. The Decision

3.1 The judge, Mr Justice Kitchin, reviewed the various EPO decisions and UK judgements. The judgment spent some time pondering the definition of a computer program and whether it could be construed narrowly or broadly.



- 3.2 Kitchin J., concluded that Beauregard type claims were, in fact, in principle allowable because [for amongst other reasons] consideration of the claims was a matter of substance rather than form.
- 3.3 The finding that claims of this type were allowable was with the proviso that the claims must be “drawn to reflect the features of the invention which would ensure the patentability of the method which the program is intended to carry out when it is run”.
- 3.4 In reaching this decision, Mr Justice Kitchin had to try to side-step another recent UK High Court judgement. Consequently, Kitchin J., diplomatically tried to suggest that an otherwise unhelpful [from the perspective of a patentee] comment made in the other High Court judgement related to something quite specific. He therefore suggested that his view was nevertheless consistent with the comment made in the other judgement, even though the ultimate result of that judgement was refusal of the Beauregard type claims. Kitchin J., also stated that if he was incorrect about his interpretation of the view expressed in the other judgement, then he must respectfully disagree with it.
- 3.5 Our view is that this judgement is inconsistent with the other previous judgement. However, the UK IPO have not appealed the judgement, but instead issued a revised practice notice.
- 3.6 Consequently, the practice of the UK IPO, for now, will revert to granting Beauregard style claims drafted along the lines mentioned above even though the case law is arguably inconsistent. The only likely opportunity for settling the inconsistency one way or the other is therefore if another case is heard by the Court of Appeal and it decides that it needs to consider this matter of Beauregard type claims.

The above information is intended to be of a general nature and should not be taken as legal advice. If you have any specific questions, please do feel free to contact one of our advisors at mail@laudens.com for further information.

