

Guidelines2day

Computer-implemented inventions and artificial intelligence
Live session on 23 March 2022 (PL93-2022)

Questions and answers

Preamble

This is a collection of questions which were asked during the Q&A part of the presentation but which could **not** be answered during the live session anymore.

That is currently the opinion of the CNIPA (China National Intellectual Property Administration) on inventions invented by AI?

In addition to what the experts answered in the live session:

We are not aware that CNIPA published any opinion on the applications indicating an AI system as inventor. However, it is recommended to contact CNIPA to answer this kind of questions.

How would you recommend dealing with cases where the Examining Division is stretching?

Normally when the examiner substantiates an objection, they cite passages from prior art and explain their interpretation of the features of the claim and the prior art. If the applicant does not agree with this interpretation, they should counterargue and bring forward their interpretation. Ultimately the examining division will come to a conclusion taking into account the arguments of the applicant. Applicants wishing their applications to be processed rapidly may request accelerated prosecution of their application ("PACE", see OJ EPO 2015, A93).

Can software embedded in specialised hardware be protected without fully disclosing details of hardware?

Only if enough of the hardware is given to have the software fully enabled (Art.83 EPC).

If a claim implies a technical and a non-technical use, could you please comment on using undisclosed or disclosed disclaimers to disclose non-technical use?

There would be a case by case analysis of whether the disclosed and undisclosed disclaimer would be allowable with respect to the requirements of Art. 84 and 123(2) EPC. These are explained in the Guidelines, F-IV, 4.19 and H-V, 4 and sub-sections. It would need to be decided whether expressly stating a disclaimer of specific non-technical use would be sufficient to guarantee acknowledging a technical effect over the whole scope. We have not spotted any example in case law yet but the Guidelines H-V, 4.2.1, first bullet (iii) hints at such a possibility.

How do you recommend dealing with A84 objections in those cases?

The claims should define the technical features which achieve the technical effects allowing the solution of the technical problem. The effects as such, or information in support of their presence may appear in the description. Sections F-IV, 4.5.2 and 4.5.5 about essential features might be relevant for this question.

I think the EPO considers "the cloud" a technical object, such as any other storage.

"Computer cloud" would be interpreted as a system, presumably with storage and processing resources. The Guidelines F-IV, 3.9.3 discusses CII implemented in a distributed computing environment.

Is it patentable to apply rules to data in the cloud, if for example, same rules are known in the prior art? Is there any basis/reference to the approach of the EPO for "cloud" computing claims? For some cases at the USPTO, the mere fact that the computation is done in the cloud makes the invention patentable, how does EPO see that? Any reference that I can read?

An invention relating to computer clouds would be treated as any other invention. There should be a technical solution to a technical problem which is a novel and inventive over prior art. Each individual feature, e.g. data rules, would be assessed if they make a technical contribution in the context of the claim, and if so, will be taken into account when assessing

inventive step and compared with prior art. The Guidelines F-IV, 3.9.3 has information relevant for cloud computing.

I could imagine that allocating public in a stadium comprises a technical step though. It avoids the stadium of being damaged and person from being hurt. So avoiding such a concrete/technical effect could be regarded as technical.

But that claim seemed to lack the technical means. The technical means (e.g. a computer) must be disclosed in the claim.
