SIMULATION IS REAL COMPUTER SIMULATION IS PATENTABLE

HOGARTH CHAMBERS

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Claims to computer simulation held patentable in the UK

In a further development in the law on inherently patentable subject matter, the High Court yesterday handed down its decision in *Halliburton Energy Inc's Patent.* This was an *appeal* from UKIPO's refusal of Halliburton's patent applications to methods of simulating drill bit performance. The appeal concerned the mental act, program for a computer and mathematical method exclusions.

HH Judge Birss QC sitting as a Deputy High Court Judge considered the various claims to methods of simulating drill bit performance, noting that those claims did not include any step of manufacturing a drill bit to any optimised design.

The court considered the ambit of the *mental act* exclusion in some detail deciding between two conflicting views. The first is a broad construction that excludes anything capable of being performed mentally, regardless of whether it is so claimed. This broad construction was that favoured by Aldous LJ in *Fujitsu* and was applied by the Hearing Officer at first instance (following the UKIPO's Practice Note of 8 December 2008). The alternative narrower construction is that favoured by Jacob LJ in *Aerotel* and only excludes acts carried out mentally.

The judge held that *"the balance of authority in England is in favour of the narrow approach"*. He was fortified by the decision of the EPO in *T1227/05 Infineon* which makes clear that any computer implemented embodiment would avoid the exclusion. He also noted the judgment of Floyd J in *Kapur* to a similar effect.

The judge gave the remaining objections short shrift. The computer program exclusion did not apply stating *"Is it more than a computer program as such. The answer is plainly yes. It is a method of designing a drill bit."* As to mathematical method, whilst mathematics was

involved, *"the data on which the mathematics is performed….represent[s] something concrete (a drill bit design)."* This distinguished the case from *Gale's Application* and rendered the claim patentable.

Allowing the appeal, the judge's observations on the wider question of possible divergence between the EPO and the UKIPO are of interest, concluding with the statement that *"as a matter of law computer implemented inventions are just as patentable in the UK as in the EPO".*

Richard Davis of **Hogarth Chambers** instructed by **Hoffmann Eitle** appeared for the appellant Halliburton.

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