

acknowledges that lottery games played over the internet are well known, and cites the Freelotto website as an example of a lottery game where revenue is generated by directing a player to click on website advertising banners. It is suggested that a disadvantage of prior art lottery games is that the articles selected by a player, for example numbers, have no commercial significance whatsoever. The invention seeks to overcome this disadvantage by replacing commercially neutral articles such as numbers with brand representations of commercial products or services, thereby allowing products or services to be advertised to players playing the game and for the lottery operator to charge the brand owner for the privilege.

- 4 The original set of claims had one independent claim, claim 1, directed to a lottery played over the Internet:

“1. A lottery played over the Internet, the lottery comprising a Web site arranged to present a player with a set of brands, and arranged to allow a player to select a subset of the set of brands, the Web site recording the selected subset of brands together with information identifying the player, a subset of brands subsequently being selected at random from the set of brands, the player being awarded a prize if the player's selected subset of brands corresponds to the randomly selected subset of brands.”

- 5 The claims were subsequently amended to relate to a computer apparatus configured to provide a lottery playable over the internet, with claim 1, which remains the only independent claim, now reading:

“1. A computer apparatus configured to provide a lottery playable via the Internet, the apparatus comprising:

a web server configured to provide each of a plurality of players with a web page over the Internet, the web page displaying a set of brands;

receiving means configured to receive over the Internet data representing player selection of a subset of the set of brands;

storage means configured to record the selected subset of brands together with information identifying the player;

selecting means configured to select a subset of brands at random from the set of brands; and

reward means for awarding a prize to a player if that player's selected subset of brands corresponds to the randomly selected subset of brands.

The law

- 6 The examiner has maintained that the claimed invention relates to subject matter excluded from patentability under section 1(2) of the Act, in particular to a method for playing a game or doing business under section 1(2)(c), and/or the presentation of information under section 1(2)(d). The relevant parts of section 1(2) read as follows:

1(2) It is hereby declared that the following (among other things) are not inventions for the purposes of this Act, that is to say, anything which consists of-

(a)

(b)

(c) a scheme, rule or method for performing a mental act, playing a game or doing business, or a program for a computer;

(d) the presentation of information;

but the foregoing provision shall prevent anything from being treated as an invention for the purpose of this Act only to the extent that a patent or application for a patent relates to that thing as such.

- 7 These provisions are designated in section 130(7) as being so framed as to have, as nearly as practicable, the same effect as Article 52 of the European Patent Convention (EPC), to which they correspond. I must therefore also have regard to the decisions of the Boards of Appeal of the European Patent Office (EPO) that have been issued under this Article in deciding whether the present invention is patentable.

Interpretation

- 8 The principles to be applied when considering inventions relating to an excluded field are set out in *Fujitsu Limited's Application* [1997] RPC 608, wherein at page 614 Aldous LJ said:

"...it is and always has been a principle of patent law that mere discoveries or ideas are not patentable, but those discoveries and ideas which have a technical aspect or make a technical contribution are. Thus the concept that what is needed to make an excluded thing patentable is a technical contribution is not surprising. That was the basis for the decision of the Board in *Vicom*. It has been accepted by this Court and the EPO and has been applied since 1987. It is a concept at the heart of patent law."

- 9 In other words, inventions relating to an excluded field which involve a technical contribution will not be considered to relate to excluded matter as such. The practice of the Patent Office in this regard is set out in the practice notice issued on 24 April 2002 and entitled "Patents Act 1977: interpreting section 1(2)".

- 10 In assessing any alleged technical contribution it is clear that it is the substance of the claim rather than its particular form that is important. Accordingly, it is not possible to render patentable an inherently unpatentable method merely through the specification of technical means. Thus, when the Court of Appeal came to consider *Merrill Lynch's Application* [1989] RPC 561, Fox LJ said at page 569:

"..... it seems to me to be clear, for the reasons indicated by Dillon LJ, that it cannot be permissible to patent an item excluded by Section 1(2) under the guise of an article which contains that item - that is to say, in the case of a computer program, the patenting of a conventional computer containing that program. Something further is

necessary. The nature of that addition is, I think, to be found in the Vicom case where it is stated: "Decisive is what technical contribution the invention makes to the known art". There must, I think, be some technical advance on the prior art in the form of a new result (eg, a substantial increase in processing speed as in Vicom)."

Argument

- 11 At the hearing, Mr Kenrick sought to convince me that the substance of the invention in this application is an apparatus for playing a game, where the novelty resides in the fact that users select a sub-set of brands from a provided set of brands, a sub-set of brands is then selected at random, and a prize is awarded if the user-selected sub-set of brands in some way corresponds to the randomly selected sub-set of brands. Mr Kenrick then argued that apparatus for playing games are not caught by the exclusions set out under section 1(2), and that it is only the rules associated with playing games that are intended to be excluded from patentability. To support this line of argument, Mr Kenrick referred me to the Official Ruling 1926(A) annexed as an appendix to 43 RPC, which reads:

"Counter and board games considered in relation to the definition of an invention contained in Section 89 of the Patents and Designs Acts, 1907 and 1919.

The question having arisen upon an Examiner's Report, whether a patent for a game of the above character should be refused where the only novel feature (apart from the rules of the game) lies in the particular character of the markings upon the board, the following Ruling was given:

It may be stated generally, that where the claim made in cases such as this is to apparatus for playing a game, comprising one or more playing pieces and a board marked in a particular manner substantially as shown in drawings accompanying the Specification, the playing piece or pieces being moved in accordance with directions furnished in the Specification as to the manner in which the game is to be played, the requirements involved by the definition of an "invention" contained in Section 93 of the Acts will be held to be complied with, and the application will be subject only to such objection as may arise under Section 7 or otherwise in the normal procedure of examination."

- 12 Although Mr Kenrick accepted that the 1926 Ruling was primarily concerned with board games, he referred me to paragraph 1.22 of the Patent Office's Manual of Patent Practice which suggests that section 1(2)(c) "is not construed as extending to inventions relating to apparatus for playing a game which are patentable if the other requirements of the Act are satisfied." He also referred me to decisions of the Patent Office and the Patents Appeal Tribunal which support a broader interpretation of the 1926A Ruling as allowing patents for games apparatus in general. In *Cobianchi's Application* [1953] 70 RPC 199 considered under the 1949 Act, it was found that a special pack of cards designed for playing a known game (Canasta) did involve a manner of new manufacture. In *Tucker's Application* (BL O/100/99), the Hearing Officer concluded that claims to a three-dimensional chess apparatus comprising a number of conventional chess boards and standard sets of chess pieces were

inherently patentable.

- 13 In deciding whether an invention is excluded from patentability, Mr Kenrick agreed that the questions to be answered are:
- a) does the invention have as its basis one of the categories of excluded matter mentioned in section 1(2) ? If so,
 - b) does the invention makes a technical contribution such that it cannot be said to amount to excluded matter as such?

Mr Kenrick argued that since the substance of the invention is an apparatus for playing a game then the first question must be answered in the negative. If there is any doubt as to whether the invention relates to an apparatus for playing a game, that doubt must be exercised in the applicant's favour.

- 14 On the face of it, Mr Kenrick's argument seems reasonably persuasive. However, even were I to accept that the substance of the present invention is an apparatus for playing a game, I consider that the weight of more recent authority compared to the Official Ruling 1926(A) demands that inventions in the field of games be subject to the same requirement for technical contribution as in any other field of creative endeavour. This is consistent with the conclusion drawn by the Hearing Officer in *EventsMarket Pty Ltd* (BL O/087/04), where it was also noted that the Ruling has not been tested in the courts under the 1977 Act.

- 15 Turning to the substance of the invention, Mr Kenrick would have me believe that this is clearly an apparatus for playing a game. I do not agree. Whilst the application relates in general terms to a lottery game and to a method for implementing such a game over the Internet, the invention itself is concerned with increasing the commercial significance of known lottery games by replacing numbers with brands. In my view, the substance of the invention is not an apparatus for playing a game, but the mere presentation of brand information in a lottery game. The rules for playing the game are exactly the same as in known lotteries, and the apparatus is identical in all regards apart from the information presented to the player. I therefore consider that the substance of the invention is the presentation of brand information, which falls within the exclusion of section 1(2)(d).

- 16 I must now consider whether the invention makes a technical contribution such that it cannot be said to amount to excluded matter as such. In addressing this question at the hearing, Mr Kenrick pointed to the technical nature of the apparatus and to the graphic user interface employed for selecting brands as providing the required level of technical contribution. As to the former, it was accepted that the apparatus employed was entirely conventional and, indeed, it is acknowledged as such in the specification. As such, I cannot find that the invention makes any technical contribution in this regard. As to the second area, i.e. in respect of the user interface for selecting the brands, there is nothing in the specification that suggests that this is anything other than a conventional input and acknowledge procedure in entering data into a computer. Equally there is nothing in the specification that points to this providing a technical solution to a technical problem, which is often used by the courts, the Patent Office

and the European Patent Office to identify potential sources of technical contribution. As such, I do not consider that the invention makes any technical contribution whatsoever.

Conclusion

- 17 I have found that the claimed invention is excluded from patentability under section 1(2)(d). I have reviewed the application fully and have been unable to find any basis for a claim incorporating a technical contribution. I therefore refuse the application under section 18(3).

Appeal

- 18 Under the Practice Direction to Part 52 of the Civil Procedure Rules, any appeal must be lodged within 28 days. It should be noted that the hearing was held some time after the deadline specified under rule 34 for putting the application in order, but before the extended deadline available as of right under rule 110(3). At the time of the hearing, a request to extend the rule 34 period under rule 110(3) had not been filed, but this can be done retrospectively up to 20th March 2005.

H JONES

Deputy Director acting for the Comptroller