



BL O/059/07

23 February 2007

## PATENTS ACT 1977

APPLICANT MIB Partners Plc

ISSUE Whether patent application number GB  
0308992.7 complies with section 1(2)

HEARING OFFICER R C Kennell

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### DECISION

#### Introduction

- 1 Application no GB 0308992.7 was filed on 17 April 2003 and published under serial no. GB 2400693 A on 20 October 2004. The examiner has reported that search would serve no useful purpose and has objected that the invention is excluded from patentability under section 1(2) of the Act. The applicant has not been able to overcome this objection despite amendment of the specification: however it does not wish to attend a hearing and is content for me to decide the matter on the basis of the papers on file.
- 2 Following the review of case law under section 1(2) by the Court of Appeal in its judgment of 27 October 2006 in the matters of *Aerotel Ltd v Telco Holdings Ltd* and *Macrossan's Application* [2006] EWCA Civ 1371 (hereinafter "*Aerotel/Macrossan*"), the examiner has re-formulated his objections but the applicant does not wish to make any further submissions.

#### The invention

- 3 Following amendment (italicized), the invention is now defined in claim 1 as follows:

"A system for providing an analysis of data, comprising means to assimilate static data, means to provide mapping of and a normalized structure of said data as a summary report, *the means providing mapping comprising a means to map static data into the system*, whereby to provide an enhanced analysis of said data."
- 4 The invention is said in the specification to provide a technical solution to the problem of handling data concerning all aspects of a business or technology. It particularly seeks to mitigate the disadvantages of previous survey-based attempts at benchmarking business performance which require participants to complete questionnaires for subsequent analysis for trends. These are

expensive, time-consuming and prone to error. In contrast, the present invention can be implemented by computer so as to provide a one-page summary report for direct use by business management.

### The law and its interpretation

5 The relevant parts of section 1(2) read (emphasis added):

“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) a discovery, scientific theory or **mathematical method**;
- (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 purposes of this Act **only to the extent that a patent or application for a patent relates to that thing as such.**”

6 Objection has been raised under all the highlighted provisions at various times, but in the light of *Aerotel/Macrossan* the examiner is maintaining objection principally under the computer program and mental act exclusions.

7 In *Aerotel/Macrossan* the Court of Appeal approved a new four-step test for the assessment of patentability under section 1(2), namely:

- 1) Properly construe the claim
- 2) Identify the actual contribution (although at the application stage this might have to be the alleged contribution)
- 3) Ask whether it falls solely within the excluded matter
- 4) Check whether the actual or alleged contribution is actually technical in nature.

8 In a notice published on 2 November 2006<sup>1</sup>, the Patent Office stated that this test would be applied by examiners with immediate effect. It did not expect that this would fundamentally change the boundary between what was and was not patentable in the UK, except possibly for the odd borderline case.

9 By virtue of section 130(7) of the Act section 1(2) is so framed as to have, as nearly as practicable, the same effects as the corresponding provisions of the European Patent Convention. However, the reliance that I can place on decisions of the Boards of Appeal of the European Patent Office under the corresponding Article 52 of the EPC must now be limited in view of the contradictions in these noted by the Court of Appeal in *Aerotel/Macrossan* and its express refusal to follow EPO practice.

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<sup>1</sup> <http://www.patent.gov.uk/patent/p-decisionmaking/p-law/p-law-notice/p-law-notice-subjectmatter.htm>

## **Arguments and analysis**

- 10 The applicant's case would seem to rest on its letter of 26 June 2006 asserting without explanation that the mapping means provides an advance of a technical nature. However I must consider this in the light of the four-step test in *Aerotel/Macrossan*, on which the applicant has declined to comment.

### ***Steps 1 and 2 of the test***

- 11 I do not think the construction of the claims in the first step presents any problems. For the second step of identifying the contribution, paragraph 43 of the judgment suggests that I need to identify what the inventor has added as a matter of substance to human knowledge. In the absence of any search of prior art I can only go by what is alleged in the specification. On this basis I consider the contribution to be the enhancement of data analysis for business purposes by means of a system for assimilating, mapping and normalizing data in order to provide a summary report.

### ***Steps 3 and 4 of the test***

- 12 The third step requires me to consider whether the contribution lies solely in excluded matter. As stated at paragraphs 45 – 47 of *Aerotel/Macrossan*, reconciling the new test with the earlier judgments of the Court of Appeal in *Merrill Lynch* [1989] RPC 561 and *Fujitsu* [1997] RPC 608, the fourth step of checking whether the contribution is technical may not be necessary because the third step – asking whether the contribution is solely of excluded matter – should have covered the point. The Court makes the important point that a contribution which consists solely of excluded matter will not count as a technical contribution. The presence or otherwise of a technical effect is now therefore a subsidiary factor, to be considered only where the invention passes the first three *Aerotel/Macrossan* steps. Accordingly, if the contribution made by the invention consists solely of excluded matter, then the invention will not be saved by reference to a possible technical effect.

### **Computer program**

- 13 The claims are not restricted to computer implementation of the invention, but there is no disclosure of any other method and it is difficult to see how else the suggested benefits of the invention might be achieved. The hardware components of the system and the use of a database and graphical user interface, insofar as they are described, appear to be wholly conventional. It seems to me that the contribution lies solely in a set of procedures and instructions which enable a computer to replace a manual process for analysing data, and that the resultant improvements, including the possibility of producing a single-screen report, are no more than would be expected from computerising a manual process. In my view these procedures and instructions constitute a computer program and the invention therefore relates to a computer program as such.

### Mental act

- 14 Insofar as the invention is not implemented on a computer it seems to me that the contribution amounts to nothing more than a series of mental operations to be performed in analysing data in order to provide a report, and that the invention is excluded as a scheme or method, if not a rule, for performing a mental act.
- 15 As paragraph 13 of the Office notice explains, it is now doubtful whether the mental act exclusion extends to computerised means of doing what could otherwise have been done mentally given the divergence between the judgments of the Court of Appeal in *Aerotel/Macrossan* and *Fujitsu* on this point. However, I do not think that I need to decide this point, given my finding above that in such a case the invention is excluded as a computer program.

### Business method

- 16 There seems to me an arguable case that the contribution of the invention is nothing more than a scheme or method for doing business in the light of *Aerotel/Macrossan*, where (see paragraphs 63 – 71) the Court of Appeal rejected the narrow interpretation of this category by Mann J in *Macrossan's Application* [2006] EWHC 705 (Ch) and held that the exclusion was not limited to abstract concepts or completed transactions. However the examiner is not now pressing this head of exclusion and I do not think it is necessary for me to make a finding on it.

### Mathematical method; presentation of information

- 17 Although, as the examiner acknowledges, some aspects of the invention involve the use of mathematical methods and the presentation of information, I do not think that the contribution of the invention lies solely in these areas.

### Technical effect

- 18 It follows from the above that the contribution of the invention lies solely in areas excluded under section 1(2). I therefore do not think it is necessary for me to go on to step 4 and consider whether the contribution is technical in nature. However, if I am wrong on that, I do not consider that there is anything of a technical nature in the contribution, despite the statement at page 4 of the specification that the single screen report shown in Figure 9 “provides a technical solution to the problem of handling data concerning all aspects of a business or technology, for example investment banking or utilization of nanotechnology”. This would seem to me to be in line with the earlier decisions of the comptroller in *Knowledge Support Systems Limited* (BL O/202/06) and *Bloomberg LP* (BL O/151/06) to which the examiner had referred pre-*Aerotel/Macrossan*.

### **Conclusion**

- 19 I therefore conclude that the invention now claimed is excluded from patentability under section 1(2)(c) on the grounds that it relates to a computer program as such and/or to a scheme or method for performing a mental act as such. Having considered the application carefully, I agree with the examiner that nothing in it provides any advance of outside of an excluded area. I therefore refuse the application under section 18(3).

**Appeal**

- 20 Under the Practice Direction to Part 52 of the Civil Procedure Rules, any appeal must be lodged within 28 days.

**R C KENNEL**

Deputy Director acting for the Comptroller