

- 5 However on 27 October 2006, before I had issued my decision, the Court of Appeal handed down its judgment in the matters of *Aerotel Ltd v Telco Holdings Ltd* and *Macrossan's Application (Aerotel/Macrossan)* which approved a new test for assessing patentability under Section 1(2). In response, the attorney, Mr Dallimore filed additional written submissions on 17 January 2007.

The Invention

- 6 The invention concerns an arrangement for accessing over a computer network such as the Internet, secure sites which contain personal or financial information, for example bank accounts. To gain access to an online bank account, for example, a user is usually required to input a username and password. Users often have a number of bank accounts and hence are required to remember many different passwords. To simplify the access process users may employ a remote third party aggregator to store their many passwords and to access their accounts on their behalf. There are a number of problems associated with using account aggregators, (i) they are prime targets for hackers and (ii) many financial institutions require their customers not to disclose their passwords to a third party.
- 7 The present invention seeks to overcome these problems by employing an *active content agent (ACA)*, which in the disclosed embodiment is a piece of software which when downloaded from the Internet runs on the user's personal computer and accesses, for example, their bank account(s) on their behalf using passwords which are stored locally on their computer in an encrypted form. The advantages of this are there is no need for the user to remember their password(s), to engage an aggregator nor is there any disclosure of the user's password(s) to a third party.
- 8 There are currently two sets of claims for me to consider which were filed on 30 August 2005. Claim set 1 (the applicants preferred set of claims) includes a total of 38 claims. Independent claims 1 and 18 relate to a system and a method for facilitating access to a secure network using a active agent and read as follows:
- 1. A system for facilitating access by a user to a secure network site, the system including an active agent arranged to access the network site on behalf of the user, the active agent being arranged, in response to a user query from a user computing system, to obtain access means for enabling access to the secure site, and to utilise the access means to obtain content information from the secure network site.*
- 18. A method of facilitating access to secure network sites, comprising the steps of utilising an active agent to obtain user access means and utilising the secure access means to obtain content from the secure network access site and provide the content to a user computing system.*
- 9 Claims 24-27 relate to associated methods of authorizing access to secure

network sites, a registration system, an agent provider site and a user system therefor whilst Claims 28-31 relate to “computer programs”. In addition, there are seven omnibus claims.

- 10 The second set of claims, (claim set 2) includes a total of 35 claims. Here independent claims 1 and 16 relate to a system and a method for facilitating access to a secure network using an active agent with the addition of the wording underlined below to emphasise that the user access means is only accessible via the user computing system. Claims 1 and 16 of claim set 2 therefore read as follows:

1. A system for facilitating access by a user to a secure network site, the system including an active agent arranged to access the network site on behalf of the user, the active agent being arranged, in response to a user query from a user computing system, to obtain access means for enabling access to the secure site, and to utilise the access means to obtain content information from the secure network site, wherein the user access means is only accessible via the user computing system, and wherein control of the access to the secure network site is via the user computing system.

16. A method of facilitating access to secure network sites, comprising the steps of utilising an active agent to obtain user access means and utilising the secure access means to obtain content from the secure network site and provide the content to a user computing system, wherein the step of utilising the active agent to obtain content from the secure network site is controlled via the user computing system.

- 11 Again there are a number of additional independent claims, computer program and omnibus claims, which are broadly equivalent to those in claim set 1.

The Law

- 12 The examiner has reported that the application is excluded from patentability under section 1(2) of the Act, as relating to a scheme a program for a computer as such. The relevant parts of section 1(2) read:

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) a discovery, scientific theory or mathematical method;

(b) a literary, dramatic, musical or artistic work or any other aesthetic creation whatsoever;

(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;

- 13 As regards the interpretation of section 1(2), my approach will be governed by the judgment of the Court of Appeal in *Aerotel Ltd v Telco Holdings Ltd and Macrossan's Application* [2006] EWCA Civ 1371 (*Aerotel/Macrossan*) and the Practice Notice issued by the Patent Office on 2 November 2006. In *Aerotel/Macrossan* the court reviewed the case law on the interpretation of section 1(2) and approved a new four-step test for the assessment of patentability, namely:
- 1) Properly construe the claim
 - 2) Identify the actual contribution
 - 3) Ask whether it falls solely within the excluded matter
 - 4) Check whether the actual contribution is technical in nature.
- 14 However, the fourth step of checking whether the contribution is technical in nature may not be necessary because the third step – asking whether the contribution is solely of excluded matter – should have covered that point (see paragraphs 45 – 47 of the judgment).
- 15 Finally, I note that 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.

Arguments and analysis

- 16 Much of the agent's argument at the hearing was directed to establishing that the invention made a technical contribution. On the basis of the law as it then stood, I would agree that if I had been able to identify a contribution to the art which was technical in nature, then that would have been a pointer to it lying outside the excluded area as such. However, that is not the approach adopted in *Aerotel/Macrossan* where the presence or otherwise of a technical effect need only be considered where the invention passes the first three steps. Accordingly, the applicant in his letter dated 17 January 2007 kindly reframed his arguments in light of the judgment in *Aerotel/Macrossan* addressing the four steps in turn and it is on the basis of that letter that I will base my decision.
- 17 The first step in the *Aerotel/Macrossan* test requires me to construe the claims. I do not think this presents any real difficulties. However, I think it worth saying from the outset what I consider is meant by the term "active agent". There is no doubt in my mind that a person skilled in the art would regard this to mean a software application which acts on behalf of the user to retrieve their access means, for example, their password, and to subsequently gain access to information from a secure network site such as details of their bank account. Whilst I acknowledge that an active agent, like all other software applications can in principle be implemented in hardware, the embodiment disclosed clearly

relates to a software implementation and there is no real evidence of how this would be achieved in corresponding hardware.

- 18 For the second step, it is necessary to identify the contribution made by the invention. Paragraph 43 of *Aerotel/Macrossan* explains that this is to be determined by asking what it is - as a matter of substance not form - that the invention has really added to human knowledge having regard to the problem to be solved, how the invention works and what its advantages are.
- 19 Mr Dallimore in this letter dated 17 January 2007 regards the contribution to lie in a new system and an associated method of managing secure access to computing systems, by using agent technology to fetch and carry passwords, to obtain access to secure network sites and retrieve content on behalf of the user. In his opinion, the contribution does not lie in the agent (or computer program) as such. He considers the advantages to be that there is no need for the user to remember their password(s), no need to engage an aggregator which would require additional network components or hardware, nor is there any disclosure of the user's password(s) to a third party thus providing improved security.
- 20 It is clear to me, that the system is made up of entirely conventional components. In contrast to the system which was found patentable in *Aerotel*, there is no new physical combination of hardware and therefore the contribution cannot reside in a new system as such. In my view, the contribution must lie in the use of a program or an active agent and the function that agent has been programmed to carry-out, in this case, to retrieve a user's password and to gain access to information from a secure site on their behalf.
- 21 What I must now do is decide whether that contribution resides solely within excluded subject matter.
- 22 Mr Dallimore, again in his letter of 17 January 2007, argues that the system and method claims 1 and 18 are not to software per se, but to a process and system which utilises an agent to fetch and carry access means and obtain information from a secure site. They are to a process and system involving an agent interacting with computing devices to perform certain actions, not to an agent as such. He goes on to say that just because a claim may involve the use of a computer program does not mean that it should be excluded drawing my attention to paragraph 22 of *Aerotel/Macrossan*. Whilst I agree with the broad thrust of this argument, I would emphasise that, as paragraph 43 makes clear, I must look at what the invention contributes as a matter of substance rather than at the particular form in which the invention is claimed even if the claim is to system or a process.
- 23 Mr Dallimore, whilst acknowledging that software agents are well known and that they can be used for many operations in computing systems, points out that no-one has ever before utilised an agent for implementing security in computer networks in this way. It is the utilisation of an agent for implementing security by fetching and carrying passwords which he regards as the inventive contribution and in his view does not constitute excluded matter, even if the

agent per se is excluded.

- 24 Having considered the arguments at some length, irrespective of the form in which the invention is claimed, I think the contribution lies not in a new system for accessing secure network sites but in the provision of an active agent suitably programmed to carry-out a specific sequence of operations to retrieve the user's password and to gain access to information on a secure site without the user having to enter it themselves. This amounts to nothing more than instructing a computer to store, read and transmit data without user intervention and the contribution lies in the specific instructions per se, in my view, this is nothing more than a computer program as such and is therefore excluded.
- 25 In my view independent claims 24-27, are merely claims to other aspects of the invention, the contribution of which, as a matter of substance, is still to be regarded as excluded as relating to a program for a computer. Furthermore, I do not consider that the exclusion can be avoided by incorporating any of the features of the dependant claims.
- 26 Having found the contribution to reside solely in excluded matter, I do not need to consider step 4 of the test.

Claim set 2

- 27 The additional set of claims (claims set 2) filed on 1 September 2005, are substantially the same as those of claim set 1 but with the added limitation that the user access means is only accessible via the user computing system and that access to the secure network site is controlled via the user computing system, this feature is clearly reflected in independent claims 1 and 16. However, this does nothing to alter the fact that the contribution resides in a program for a computer as such and is therefore excluded.

Computer program claims

- 28 In the Practice Notice² issued, following the judgement in *Aerotel/Macrossan*, the Office announced a change in practice in relation to claims to a computer program or a program on a carrier, namely that such claims appeared to be excluded even when claims in a different form would be allowable. There are a number of such claims in this case. The applicant, whilst acknowledging that the Rule 34 period has long since expired and that no further amendments may be filed at this stage, has asked for discretion to be granted in order to delete any such claims which might otherwise render the application to be granted. However, as I have found that the application, irrespective of the way in which it has been claimed, is excluded as a program for a computer as such, the presence or absence of these claims has no bearing on whether or not to the invention is excluded. I am therefore not required to decide this issue.

Conclusion

² Patents Act 1977: Patentable subject matter [2007] RPC 8

- 29 I therefore conclude that the invention is excluded under section 1(2) as it relates to a program for a computer as such.
- 30 Having read the specification in its entirety, I cannot identify anything that could form the basis of a patentable invention. I therefore refuse the application under section 18(3)

Appeal

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

P R SLATER

Deputy Director acting for the Comptroller