

26 February 2013

PATENTS ACT 1977

APPLICANT Intuit Inc

ISSUE Whether patent application number GB 0813340.7
complies with section 1(2)

HEARING OFFICER Mrs S E Chalmers

DECISION**Introduction**

- 1 The patent application relates to a computer program for providing user access to modules of a software product based on the product features purchased. The application was filed on 21 July 2008 and published as GB 2451555 on 4 February 2009.
- 2 The examiner argues that the invention is excluded from patentability under section 1(2) of the Act as a computer program and a business method. The applicant requested a hearing to decide the matter – this took place on 21 February 2013 and was attended by Mr Simon Davies in his capacity as attorney for the applicant. Mr Jim Calvert (examiner) and Miss Gabrielle Cowcill (observer) were also present.

The invention

- 3 The invention is a method for dynamically configuring a subset of modules of a software product based on the features purchased. The user receives an identifier corresponding to the purchase and this purchase information is stored on a server. The user then makes an access request for the software using the identifier and the server provides configuration instructions to enable the purchased software. In response to another access request made at a later date, a newer version of the configuration instructions will be provided. For example, the updated configuration instructions might allow access to modules not enabled in the software as purchased or might result in an updated version of a given module that was already enabled by the original configuration instructions.
- 4 The most recent set of claims was filed on 26 November 2012 and has three independent claims: independent claim 1 is to a method for providing access to a software product; and independent claims 18 and 19 are respectively to a computer program product and a computer system for carrying out the method of claim 1. All claims relate to the same inventive concept, so I need only consider one of these claims for the purposes of this decision.

5 Claim 1 reads as follows:

A method for providing access to at least a portion of a software product, comprising:

receiving purchase information from a first location, wherein the purchase information includes information about purchased software features to which a user purchased access, and wherein the purchased software features are provided by a first subset of modules in the software product;

receiving an access request from a second location from which the software product can be accessed, wherein the access request includes an identifier provided to the user when the user purchased access to the purchased software features; and

providing configuration instructions to the second location, wherein the configuration instructions dynamically enable the first subset of the modules;

and wherein the operations of receiving the access request and providing the configuration instructions are repeated after a time interval, whereby a newer version of the configuration instructions allows synchronization of software features that are enabled in the software product.

The law

6 The section of the Act concerning inventions that are excluded from patentability is section 1(2), which reads:

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; 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.

7 In order to decide whether an invention relates to subject matter excluded by section 1(2), the Court of Appeal has said that the issue must be decided by answering the question of whether the invention reveals a technical contribution to the state of the art (cf *Aerotel*¹ and *Symbian*²). The Court of Appeal in *Aerotel* set out the following four-step test to help decide the issue:

1) construe the claim;

2) identify the actual (or alleged) contribution;

3) ask whether it falls solely within the excluded subject matter;

¹ *Aerotel Ltd v Telco Holdings Ltd and Macrossan's Application* [2006] EWCA Civ 1371

² *Symbian Ltd v Comptroller-General of Patents* [2008] EWCA Civ 1066

4) check whether the actual or alleged contribution is actually technical in nature.

8 Mr Davies agreed this was the correct approach.

Arguments and analysis

- 9 There is no particular difficulty in construing the meaning of claim 1 or in identifying the contribution allegedly made by the invention. *Aerotel* suggests that the contribution can be assessed from the point of view of the problem to be solved, how the invention works and what the advantages are. In applying this guidance to the present invention, the contribution can be seen to be the provision of a subset of modules of a software product according to purchase information and repeating the configuration instructions after a time interval to allow synchronization (ie updating) of the purchased software features.
- 10 In accordance with the *Symbian* approach for deciding whether the invention is excluded under section 1(2), the next step is to assess whether this contribution can be regarded as technical. The courts have consistently found that the mere fact that the contribution is made in the field of computing is not enough for it to be regarded as technical. Something more is needed.
- 11 In *Halliburton*³, which relates to a computer implemented method of designing a drill bit, HHJ Birss QC said that the question is to be decided by considering what task it is that the program (or the programmed computer) actually performs. A computer programmed to perform a task which makes a contribution to the art which is technical in nature, is a patentable invention and may be claimed as such. If the task the computer performs itself falls within the excluded matter, and there is no more to it, then the invention is not patentable. When the task carried out by the computer program is not itself something within the excluded categories then it is likely that the technical contribution has been revealed and thus is patentable. (The caveat here being the words "is likely": HHJ Birss says that there are no doubt cases in which the task carried out is not within the excluded areas but nevertheless there is no technical contribution at all).
- 12 What I take from this is that I need to take account of the task performed by the computer program and determine whether the task is technical. If the task performed by the computer is a business method, a presentation of information, a mathematical method or a method of playing a game then the computer program is not patentable. If the task performed by the computer program falls outside these categories then the program will be patentable if it can be shown to make a technical contribution. HHJ Birss gives two specific examples where overlap with other excluded categories does not exist: i) when the task performed does not represent something specific and external to the computer, i.e. there is nothing else going on other than the running of a computer program, then the computer program can be patentable if it solves a technical problem (e.g. making computers work better is patentable); ii) when the task performed by the computer represents something specific and external to the computer then the computer program is likely to be patentable because it is likely that a technical contribution exists (e.g. a method of designing drill

³ Halliburton's Application [2011] EWHC 2508 (Pat)

bits is technical because it involves consideration of physical parameters such as wear, dimensions and the ability to cut).

- 13 In *AT&T/CVON*⁴, Lewison J reviews the relevant authorities and sets out a number of signposts to a relevant technical effect. These are set out at paragraph 40 of the judgment:
- i) *whether the claimed technical effect has a technical effect on a process which is carried on outside the computer;*
 - ii) *whether the claimed technical effect operates at the level of the architecture of the computer; that is to say whether the effect is produced irrespective of the data being processed or the applications being run;*
 - iii) *whether the claimed technical effect results in the computer being made to operate in a new way;*
 - iv) *whether there is an increase in the speed or reliability of the computer;*
 - v) *whether the perceived problem is overcome by the claimed invention as opposed to merely being circumvented.*
- 14 So what then is the task performed by the present computer program? The examiner argues that task performed is a business method because the method claimed is dependent on the purchase of the software modules irrespective of whether the purchase has happened before or during what happens in the claim. I put it to Mr Davies that the method could be viewed as an “after sales service”. Mr Davies disagrees and argues that the task performed by the computer ie the configuration of the modules, does not depend on the purchase. He stresses that the purchase happened before the method claimed although he agrees that the purchase defines what software features the user has access to. In his view, the task is not a business method and refers me to paragraph 9 of *Aerotel* which says: “... A patent is after all to a legal monopoly over some commercial activity [emphasis added] carried out by human beings such a making or dealing in goods or carrying out a process...”. (This is to be contrasted with scientific theory which is not an activity.) I therefore understand Mr Davies as saying that the task performed by the computer relates to a process outside the computer and is not a business method. Therefore, according to *Halliburton*, the invention claimed is likely to be patentable.
- 15 In my view, the task carried out by the computer program is two-fold: firstly to enable the software features purchased on receipt of the identifier provided to the user; and secondly, in response to an access request at a later time, to update those features using a newer version of the configuration instructions. As stated in paragraph [0029] of the description:

“By dynamically enabling subsets of modules and/or subsets of features ... these techniques allow software features to be customised to the needs of a given user. In turn, this capability allows retail establishments to carry and

⁴ AT&T/CVON [2009] EWHC 343 (Pat)

display fewer software products, thereby simplifying operations, reducing expenses, and/or reducing shortfalls or excesses in inventory. Moreover, such software products are generally less complex, and easier to test and distribute. For example, by allowing the user to only purchase those features that are of interest, the user interface can be simplified and overall user experience can be improved.”

In the light of this and similar statements in the description, it seems to me that the task carried out by the computer does amount to a business method.

- 16 In the event that I am wrong on this, I shall go on to consider whether the contribution – in accordance with *Aerotel* and *Symbian* – is technical. Mr Davies argues that the invention results in a “better computer” (cf paragraph 54 of *Symbian*) since the effect of the invention is not merely within the computer programmed with the relevant instructions. The result of these instructions results in a better product for the user as it allows the computer to configure the program to give him the features he wants and overcomes the problem of a complicated interface. He also argues that the invention fulfils the *AT&T* signposts since the configuration step installs the programs for the modules at the architectural level and is independent of the functionality of the system in that the configuration step works with any software.
- 17 I disagree. In my view, the effect of the method is to enable features of the software and that is clearly carried out inside the computer. Although no particular software is specified in the claims, it is clear that the invention relates to enabling a particular software product which will not be at the architectural level of the computer on which it runs. I do not think the computer will itself operate in a new way, rather the software modules will enable the software itself rather than the computer to operate in a new way. Although bug fixes, enhanced performance or improved compatibility may result, these will be features of the program which is running, not the computer itself. Finally, perceived problems with these are not apparently solved directly but are circumvented by providing updates or new versions. The invention therefore does not involve a technical contribution nor does it match any of the *AT&T* signposts.

Conclusion

- 18 I find that the invention set out above is excluded under section 1(2)(c) as a computer program and a business method. I can find no possible amendment in the specification that will render the claims patentable. I therefore refuse the application under section 18(3).

Appeal

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

MRS S E CHALMERS
Deputy Director, acting for the Comptroller