



BL O/236/06

18 August 2006

PATENTS ACT 1977

APPLICANT Epic Systems Corporation

ISSUE Whether patent application number GB
0428466.7 complies with section 1

HEARING OFFICER A Bartlett

DECISION

Introduction

- 1 Patent application GB 0428466.7, entitled "System and method for a seamless user interface for an integrated electronic health care information system" was filed in the name of Epic Systems Incorporated. It is a divisional application and was afforded the filing date of its parent application GB 0313580.3 under section 15 (4), namely 21 December 2001. Like its parent, the application claims priority from US patent application US 60257970.
- 2 The application was published as GB2406417 on 30 March 2005 having been the subject of combined search and examination. In the initial examination report, the examiner reported that the invention was excluded under section 1(2) (c) and (d) of the Act as a method of doing business, a mental act, a program for a computer and/or the presentation of information. He also reported that the invention defined in the claims as originally filed was not novel and did not involve an inventive step over a number of pieces of prior art cited in the search report. The Applicants responded via their Attorneys, Barker Brettell by filing amendments to the claims and extensive argument as to why the invention was patentable. The examiner was not persuaded by this and after two subsequent rounds of correspondence it was agreed that a hearing should be appointed to allow a hearing officer to decide the matter. The Applicants subsequently opted for that decision to be made on the papers on file.
- 3 During the latter stages of the examination process, the Patent Office adopted a new approach to assessing whether an invention relates to unpatentable subject matter. The new approach was explained in the Practice Notice¹ issued by the Office on 29 July 2005 and reflects the approach adopted by

¹ Patent Office Practice Notice: Patents Act 1977: Examining for Patentability" see <http://www.patent.gov.uk/patent/notices/practice/examforpat.htm>

Peter Prescott QC, sitting as Deputy Judge, in his judgment in *CFPH*². In addition to *CFPH*, the issue of patentability and excluded matter has also been considered in a number of other recent court decisions, namely *Halliburton*³, *Shopalotto*⁴, *Crawford*⁵ and *RIM*⁶. The Applicants were given the opportunity to submit observations regarding the patentability of their invention in light of these judgments which they duly did.

The Law

- 4 In his final examination report, the examiner reported that the application is excluded from patentability under section 1(2)(c) of the Act as relating to a method for doing business and a program for a computer. The relevant parts of this section 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)
- (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)

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.”

- 5 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 that have been issued under this Article in deciding whether the invention is patentable although I am not bound to follow them.

Interpretation

- 6 How these provisions of the Act should be interpreted has been considered in a host of recent court judgments as I have alluded to above.
- 7 In his judgment in *CFPH* Deputy Judge Peter Prescott QC considered at length the reasoning behind the various exclusions and their effect. In addition he considered the difference in approach adopted to decide patentability in the UK and the European Patent Office and, having found there to be shortcomings in both, proposed an alternative test. In doing that the Deputy

2 *CFPH* LLC's Application [2006] RPC 5

3 *Halliburton Energy Services Inc v Smith International (North Sea) Ltd and others* [2006] RPC 25

4 *Shopalotto.com Ltd's Application* [2006] RPC 7

5 *Crawford's Application* [2006] RPC 11

6 *Research in Motion vs Inpro Licensing SARL* [2006] EWHC 70 (Pat)

Judge was seeking to avoid the problem inherent in the old “technical contribution” test that there is no (and is never likely to be) any accepted definition of “technical”. Whilst in his opinion that did not cause a problem for the majority of patent applications he considered it problematic on the borderline of patentability. He therefore proposed an alternative two stage test for assessing such cases which can be summarized as

i) Identify what is the advance in the art that is said to be new and not obvious (and susceptible of industrial application).

ii) Determine whether it is both new and not obvious (and susceptible of industrial application) under the description “an invention” in the sense of Article 52 of the European Patent Convention (EPC) — broadly corresponding to section 1 of the Patents Act 1977.

8 Whilst the Judges in *Halliburton*, *Shopalotto*, *Crawford* and *RIM* all used slightly different wording to elucidate the test, I have no doubt that the test adopted in all these cases is fundamentally the same as the one the Deputy Judge applied in *CFPH*. Thus I shall apply the *CFPH* test in the present case, subject to one qualification which is that in applying the test it is the substance of the invention that is important rather than the form of claim adopted. This is a long established principle of UK law (see *Merrill Lynch*⁷ and *Fujitsu*⁸ for example) and was incorporated into his version of the *CFPH* test by Pumfrey J. in his judgment in *RIM* where he said at paragraph 86:

“It is now settled, at least at this level, that the right approach to the exclusions can be stated as follows. Taking the claims correctly construed, what does the claimed invention contribute to the art outside excluded subject matter?”

9 One other thing that those other judgments have made clear is that the *CFPH* type test is not inconsistent with the “technical contribution” approach first introduced by the EPO Board of Appeal in *Vicom*⁹ and endorsed by the Court of Appeal in *Merrill Lynch* and *Fujitsu*. Thus in applying the *CFPH* test to the present case I will also consider whether the invention makes a “technical contribution”. If I can identify a contribution to the art that is technical, I will take that as indicating that the contribution probably lies outside the excluded area and that the invention is patentable.

10 The “properly construed” qualification of the *CFPH* test is particularly relevant to the present application as the Applicants have argued at length that the invention defined in claim 1 cannot be said to relate to a computer program as such by virtue of it being directed to a computer system having specific features. I shall therefore begin with the issue of construing the claim before moving on to identifying and characterizing any advance made by the invention.

7 Merrill Lynch’s Application [1989] RPC 561

8 Fujitsu Limited’s Application [1997] RPC 608

9 Vicom/Computer related invention T208/04

- 11 Rather than it being a claim to a computer program as such, the Applicants have argued that the invention is a “technically better computer and memory machine with a (sic) interface to the user that is dynamically controlled so as to give similar dynamic components that a user is used to using from other functional modules.” Furthermore they say, better computers or better computer database systems are not excluded explicitly by Article 52 of the EPC (or section 1 of the Act).
- 12 In furthering their argument on this point, the Applicants drew my attention to the comments of Pumfrey J in *RIM* where he warns against interpreting the computer program exclusion too broadly. Furthermore they correctly emphasized that section 1(2) includes the qualifier that an invention is only excluded if the patent or application relates to excluded matter “as such”.
- 13 In deciding the present case I am mindful of all these points. However the UK courts have consistently made it clear¹⁰ that it is the substance of the invention rather than the form of wording used in the claims that is important when assessing excluded matter. This point comes from *Merrill Lynch*, and relates to the question of whether you can make an unpatentable claim patentable by dressing it up differently. In that case the Court of Appeal decided that the fact that the invention was claimed as a computer system made no difference to the patentability of the invention - the hardware being conventional. In my opinion that is directly analogous to the present situation – there is no suggestion that the hardware used to implement the present invention ie the processors, servers, display units etc is anything other than conventional. Any novelty resides in how the system is programmed to operate and the mere presence of conventional hardware in the claim does not mean the exclusions are avoided under UK law.
- 14 The Applicants also drew my attention to two EPO Board of appeal cases¹¹ and the subsequent practice notice issued by the Patent Office¹² and suggested the practice of granting claims to a carrier if they carried a program that performed a patentable invention (or indeed to the actual program) was not consistent with Peter Prescott QC’s comments in *CFPH* that the purpose of the computer program exclusion was to prevent the foreclosing of computer programs to the public. Moreover they said that if claims in the form described in that practice notice did not amount to a program for a computer as such, then neither did a computer system as specified in the present claims. They said that Pumfrey J’s comments in *RIM* reinforced this point and that it would be wrong for the Office to give more weight to the guidance given in *CFPH* than to that given in *RIM*.
- 15 In deciding the present case I have given due regard to all the precedent case law available including both *CFPH* and *RIM*. In doing that I do not consider *CFPH* to be as incompatible with the other cases as the Applicants suggest – in *CFPH* Peter Prescott QC clearly envisages that not all computer programs are unpatentable, citing autopilots and canned soup manufacturing plants as

10 see Fox LJ’s comments in *Merrill Lynch* and endorsed by Aldous LJ in *Fujitsu*

11 T0935/97 and T1173/97 both in the name of International Business Machines Corporation

12 “Claims to programs for computers” 19 April 1999

examples of potentially patentable computer implemented inventions. These are clearly only examples ie they form a non-exhaustive list of the sort of applications of programs that can be patentable. The fact remains though that to be patentable a computer program must make an advance in a non – excluded field. In *Vicom* the technical advance was the generation of an enhanced image by using a new algorithm. The end result of performing the invention was a technically improved image. Likewise in *Halliburton* the form of claim that Pumfrey J suggested would be patentable was constrained to the manufacture of a tangible, technical item – a drill bit. Neither was considered to then relate to a computer program as such.

- 16 However, the facts on the present case are different. The practical application of the program in the present case identified by the Applicants results as a direct consequence of it being run on a computer: when it is run you have the computer system of claim 1. However they might argue it, the hardware remains unchanged when the program is run. It is not a new “computer system or a new computer and memory machine”. It is a conventional computer system programmed to have a specific functionality. If their argument on this point were correct, then any computer running a novel program would be a new machine and would be patentable. That cannot be right and is the very reason that the courts have told us that it is the substance of the invention that must be considered not the form of claim. *Halliburton* does not change that. What it serves to do is emphasise that an excluded item can form the basis of a patentable invention if it is properly constrained to a technical field. What I need to do in the present case is identify the actual or alleged advance made by the present invention and decide if that is in a non-excluded field. If it is, then the invention is patentable. Merely running the program on a computer system does not, however, provide the required advance.

The advance

- 17 With one exception which I will come back to later, the claims I am required to consider were filed with the Agent’s letter dated 4 August 2005. There are 17 claims altogether of which I feel I need only reproduce claim 1 – the only independent claim - for the purposes of this decision. Claim 1 reads as follows:

1. A computer system having a processor, a database structure held in memory, and a graphical use interface, wherein:

the database structure has a plurality of patient records;

the database structure contains an activities database containing information defining a plurality of activities available within the computer system, each activity of the plurality of activities being associated with providing an aspect of patient care;

the processor is adapted to determine context data and changed context data associated with use of the system, the context data identifying

a user and an activity of the user, and the changed context data identifying a change in the user, a change in the activity of the user or a change in the user and the activity of the user;

the database structure comprises a modular framework coupled to the activities database and the graphical user interface, the modular framework including a plurality of common visual elements;

the processor is adapted to utilize at least one of the common visual elements to construct display data for depicting information and menu structures in the graphical user interface associated with each activity of the plurality of activities; and

the processor is further adapted to construct the display data responsive to the context data and to automatically and dynamically change the display data responsive to the changed context data.

- 18 To assist interpretation of that claim I think it would be beneficial for me to explain the background to the invention. The invention concerns what I shall call an integrated healthcare data management system. As explained at some length in the description it seeks to overcome the problems associated with having different record systems used by different practitioners in the healthcare system. Those problems are multifold. Many existing healthcare systems rely on paper records, an arrangement which clearly does not lend itself to rapid and efficient access to information by general practitioners, consultants, pharmacists or administrative staff. Even where automated systems are employed, the description suggests that different software packages are employed for different functions. That causes further problems. A particular software package may require data to be input in a format that is not compatible with other packages thus causing data transfer problems or the need for separate databases. Furthermore, the different appearance of the various packages increases the training burden as staff performing or switching between multiple roles need to be trained in how to use the different packages.
- 19 The invention seeks to overcome these problems by providing a common backend database structure accessed via one of a series of Graphical User Interfaces (GUIs). The database structure includes records for multiple patients including such things as their previous medical history, their address and insurance provisions. It also contains an activities database which contains information related to each aspect (or activity) of patient care. For example, the activities could be primary care functions delivered by a general practitioner, triage nursing functions in an accident or emergency department or appointment scheduling functions available to a receptionist. Each activity is performed via the relevant GUI associated with that role, each of the GUIs sharing common visual elements such that they have a common appearance or "feel" in the way data or menu functions are presented. Furthermore the database is said to be modular such that additional activities (ie new roles) can be added to the system without losing any of the above benefits, for example if the system were extended to incorporate a 24 hour emergency call centre

operation. Finally the system is said to automatically respond to changes in the context by constructing the appropriate display for the changed context using one or more of the common visual elements.

The advance

- 20 During the examination process, the examiner relied upon various documents to support his view that the invention claimed was not novel and/or not inventive. In deciding the present case I shall refer to two of those. The first is a journal paper written by Van de Velde¹³ which sets out at a relatively high level, the requirements for an improved healthcare data management system. That document discusses the desirability of providing such a system through a framework that provides a consistent execution environment for a number of different user activities each being made up of a series of reusable components and each accessed via one of a series of GUIs. The various user interfaces are said to be consistent and homogeneous and compliant with user needs and privileges thus reducing learning curves. The ability to customize the interface to reflect a different role is seen as essential and it must be extendable to cover new aspects of the healthcare domain as the system is growing. Finally it must provide access to healthcare data and functions depending on the users' profile.
- 21 The Applicants have played down the relevance of this reference drawing attention to the lack of discussion of the specific architecture through which the system would be provided. Whilst I agree that Van der Velde doesn't include much by way of a specific form of implementation, much the same can be said of the present application. I am satisfied that Van der Velde discloses a healthcare management system having the following essential features required in present claim 1:
- a database containing multiple patient records and information defining a plurality of patient care activities;
 - the use of user specific GUIs that have a common appearance developed from common (reusable) visual elements;
 - automatically presenting a user with the appropriate GUI for their role and
 - a modular framework allowing the system to be extended to cover new roles with each user function being generated from reusable components.
- 22 On this basis I take Van der Velde to be the closest prior art. However I also note that a further paper cited by the examiner (Fabretti¹⁴) reinforces the fact that at the priority date of the application integrated healthcare databases using a modular structure to allow extension of the system to new activities had been disclosed.

13 "Framework for a clinical information system" R Van de Velde published in the International Journal of Medical Informatics 57 (2000)

14 Applying the object paradigm to a centralised database for a cariology division; Internal journal of Bio-Medical Computing 42 (1996) pp129-134 by Fabretti, Dorsaz, Doriot & Rutishauser.

- 23 Thus it seems to me that the advance made by the present invention over the prior art (Van der Velde) is in the way that the GUI in the present system is “automatically and dynamically” changed in response to changes in the context data. Indeed that is entirely consistent with the degree of emphasis the Applicants have put on this feature in seeking to demonstrate that their invention makes a patentable advance. What I must now do is decide whether that is both new and not obvious (and susceptible of industrial application) under the description “an invention” in the sense of Article 52 of the European Patent Convention (EPC).
- 24 I note that the examiner has not pursued the novelty and inventive step objections raised initially. Van der Velde discusses the reduced training load resulting from the system envisaged therein. That users could perform multiple roles at any point in time seems to me to be the main way in which that reduced training benefit would be achieved. I can see however that a reduced training benefit could also be provided where a member of staff moves department to take up a new role. On that basis I accept that that Van der Velde does not explicitly disclose changing the display data automatically in response to a change in context data. However, according to the description and claim 17 as presently on file, the change in context in the present invention can be determined from user input such as a mouse click on an appropriate icon or menu. I have no doubt that it was commonplace in networked computer systems at the priority date of the application for users to be presented with a user interface appropriate to them and their role and that by an action such as clicking a mouse they could access the interface of another role. Thus I have some reservations as to whether this difference provides an inventive step. However, for the purpose of deciding whether the invention is excluded I will assume that that advance is indeed non-obvious. But is it an advance in a non-excluded field?
- 25 The Applicants have provided copious arguments as to how their invention provides a non-excluded, technical advance. For example, they say that the “claims set out a technical advance in terms of how data can be transferred within a data structure”. Drawing a distinction between the present case and the EPO Board of Appeal’s decision in *Hitachi*¹⁵, they say that the present invention seeks to overcome a technical problem by technical means – the technical means being the new and non-obvious data structure - whereas *Hitachi* was rejected because the technical problem was overcome by implementing a new business method.
- 26 Their support for that argument is I think best summarized in their letter dated 4 August 2005 where they say:

“For many years databases have been used to hold information on patients. Also different “activities” that relate to client care and management have been implemented on different systems using different databases. Such prior art patient systems have real problems. These problems have been set out at length in the introductory part of the current application. The invention overcomes these problems by having a database structure that comprises a modular framework

15 *Hitachi/Auction method T 0258/03*

including a plurality of common visual requirements. When there is a change in the user of the system or a change in the activity of the user then the same common visual elements can be used and be populated with data responsive to the new user or new activity. The user is not going about his business in a different way by using the invention, rather that he is being provided with a new technological tool that allows him to do his business in a more efficient way.”

Method of doing business

- 27 Mann J addressed the breadth of the business method exclusion in his judgment in *Macrossan*¹⁶. At paragraph 30 of that judgment he concluded that the business method exclusion “is aimed more at the underlying abstraction of business method” rather than a tool or activity which might be used in a business activity. In light of that judgment I agree with the Applicants that the present invention is more akin to a tool for use in a business activity rather than a business method as such and thus I do not consider it to fall within that particular exclusion as interpreted by Mann J.

Program for a computer

- 28 As I have said earlier, there is no suggestion anywhere in the specification that any of the hardware employed in the present invention is anything other than conventional. In my opinion the present invention comprises the computer program through which the functionality specified in claim 1 is provided. However much the Applicants might argue to the contrary, I do not view the data structure in the present invention to be a technical means. It is a computer program. To be patentable that program must make an advance in a non-excluded field.
- 29 The advance I have identified as being made by the invention is the way that the GUI is automatically and dynamically changed in response to changes in the context data. The use in the final clause of claim one of the words “dynamically” and “automatically” affords a degree of complexity to the claim which might on first sight suggest it defines a patentable invention. However on closer inspection that appearance is not sustained. As I have already indicated, there is no more to this than the system responding to the identity of the user logging in and providing them with the access to the functions relevant to them, or, once logged in, providing the user with different functions by for example clicking on a different icon on the screen. Changing the information displayed in this way does not in my view provide the advance or contribution required to make the invention patentable. It is just a feature of the program.
- 30 In seeking to convince me to that GUIs are patentable, the Applicants referred me to a number of patents granted by the EPO. In their latest letter they suggest that the EPO would grant this case and implied that I should take account of that to avoid a divergence as to what is patentable between the two Offices. Whilst any divergence in practice as to what is and is not patentable is of course highly undesirable, the Comptroller’s hearing officers have said on many occasions that the fact that a particular invention was found on the basis

of the facts pertaining to that case to be patentable has no bearing on the decision in subsequent cases. Pumfrey J reinforced this view in para 184 of the *RIM* Judgment I referred to above when he stated:

“The test (as to whether an invention is excluded) is a case-by-case test, and little or no benefit is to be gained by drawing analogies with other cases decided on different facts in relation to different inventions.”

31 Thus the fact that the EPO may have granted some applications relating to GUIs has no bearing on whether the present invention is patentable.

32 In arguing this point the Applicants raised another point which I feel I need to address. In asking me to consider whether the EPO would allow the patent, they put it to me that:

“*CFPH* says we should construe that the excluded subject matter section as if it were Article 54(2) (sic). The EPO would, we submit, not think twice about allowing the present claims – they would find them clear of E54(2).”

33 I agree that under the *Hitachi* approach it seems likely that the EPO would consider the present claims to escape the Article 52 exclusions by virtue of the presence of hardware elements in the claims. That does not however mean that they would be found to be patentable. Under the *Hitachi* approach, having made that initial assessment the examiner would then go on to consider whether the invention was novel and inventive and in determining inventiveness would disregard any excluded subject matter. Thus escaping the Article 52 exclusions would not necessarily mean the invention was patentable under the *Hitachi* approach.

Technical effect

34 The Applicants have identified a whole range of benefits provided by the invention which they say demonstrate it provides a technical effect and thus is patentable. In addition to those already mentioned above, the Agent’s letter of 4 August 2005 identified the invention as providing such things as a reduction (if not elimination) of duplication of records in the system, lower staff training requirements, easier switching between functions, simplified updating when, for example, a care provider’s details change and more information being available to users in a particular role.

35 That, the Applicants assert, makes the system far less onerous for practitioners to use and reduces the risk of errors being introduced or duplicate records being created. At the same time patients benefit from being relieved of the burden of providing the same information over and over again to different healthcare workers.

36 That may be so, but to my mind these arguments merely serve to demonstrate the usefulness of the invention. That though is not at issue. My experience of existing healthcare data systems is that they are subject to precisely the problems outlined in the specification. A system of the sort claimed in the application would be a major improvement over the systems I have

experienced. However, the Court of Appeal in *Fujitsu* made it abundantly clear that usefulness is not the test to be employed when deciding whether an invention is patentable.

- 37 Further benefits provided by the system were identified in the Agent's letter dated 3 June 2005. In particular it was argued that:

"The use of common visual components greatly increases the overall efficiency of the system and reduces the development costs associated with developing the one or more activities by eliminating the need to design and develop separate visual components for each of the one or more activities displayed on the user interface. It also makes it a faster development process - it can be made faster".

- 38 Once again I have no reason to doubt the benefits that this provides. However, the fact that a particular system is easier to program than another does not mean it makes a technical advance – it remains a program for a computer. It may very well be a better program but that is irrelevant in terms of the exclusions. Furthermore I fail to see how drawing upon common visual components when creating different user interfaces provides the required technical advance. That is just a characteristic of the program and does not in my view result in a technical, non-excluded advance.

- 39 In seeking to highlight the technical benefits provided by the invention, the Applicants have again pursued multiple strands of argument. They say that

"The invention resides in part at least in the technical interaction between the data structure and the activities processing – acquiring data from different places, calling up different menus dependent upon data entered by the user (reducing time taken by the user) and how the GUI of different activities have the same look and feel and are intuitively easier to use for a user because they are built from common components, and how that reduces the burden on the person who queries the database/system, and how it makes life easier for the system administrator who has to maintain data integrity and update the data as things change. Developing a new activity from the common components results in another GUI with the same look and feel."

- 40 They say that the invention results in reduced data traffic across the network which they consider to be a field of technology, in this instance achieved by technical means - the information management system. Furthermore they argue that the invention enhances the speed of accessing databases which is patentable.

- 41 I am not convinced by any of these arguments. Aldous LJ made it clear in *Fujitsu* that avoiding labour or error are just the sort of advantages that are expected to result from the use of computer programs and such advantages are not sufficient for the computer program exclusion to be avoided. Similarly Nicholls LJ made it clear in his judgment in *Gale*¹⁷ that a new programming

17 *Gale's Application* [1991] RPC 305

method producing an increase in speed through the more efficient use of resources does not necessarily involve a patentable technical effect. That application concerned a computer program for calculating square roots but in deciding that it was no more than a program for a computer as such, Nicholls LJ said at page 327 line 46:

“The attraction of Mr Gale’s case lies in the simple approach that, as claimed, he has found an improved means of carrying out an everyday function of computers. To that extent, and in that respect, his program makes a more efficient use of a computer’s resources. A computer, including a pocket calculator with a square root function, will be a better computer when programmed with Mr Gale’s instructions. But the instructions do not embody a technical process which exists outside the computer. Nor as I understand the case presented to us, do the instructions solve a “technical” problem lying within the computer as happened with patent applications such as *IBM Corp./Computer related invention (T115/85)* and *IBM Corp/Data processor network (T06/83)*.....But, as I understand it, in the present case Mr Gale has devised an improvement in programming. What his instructions do, but it is all they do, is to prescribe for a cpu in a conventional computer a different set of calculations from those normally prescribed when the user wants a square root. I do not think that makes a claim to those instructions other than a claim to the instructions as such. The instructions do not define a new way of operating the computer in a technical sense, to adopt the expression used in *IBM Corp/Document abstracting and receiving (T22/085)*”.

42 On the face of it the comments of Pumfrey J at para 186 of his judgment in *RIM* could be viewed as inconsistent with these aspects of *Gale* and *Fujitsu*. Thus even though the Applicants did not rely on the *RIM* judgment to support their argument that the increase in processing efficiency and reduced network traffic rendered their invention patentable, I feel I ought to address that point.

43 More particularly, Pumfrey J said:

“*RIM* says that the point does not require elaboration. It contends that all that is claimed, as a matter of substance, is a collection of programs for computers. I think this is wrong. What the claims give is a technical effect: computers running faster and transmitting information more efficiently, albeit ultimately for the purpose of displaying part of that information.”

44 In my opinion, the comments of Pumfrey J need to be considered in the context within which they were made. The system under consideration in *RIM* was one where internet pages had their information content reduced to make them suitable for transmission over a limited bandwidth channel for display on devices with small screens. The benefit provided by that invention – that information could be transmitted rapidly and displayed on small screens –

resulted from the reduction in content. It was not a result of the computer running more quickly or of the transmission being more efficient. Thus I would not consider *RIM* to support a proposition that a program which makes a computer run faster or transmit data more efficiently necessarily provides the technical effect required for it to be patentable even if the Applicants had made such a proposition. In the present case, any increase in speed or reduction in data transmission does not in my view result from any technical effect produced.

45 Finally, the Applicants also referred me to the “little man test” used by Peter Prescott QC in *CFPH* in support of their argument that the invention was not excluded as a program for a computer as such. The essence of the little man test is that if the computer program can be replaced by a little man sitting at a console issuing decisions, then the program is merely a tool for implementing the invention rather than the invention being a computer program as such. He then illustrated the test with reference to the manufacture of canned soup or control of an autopilot.

46 Applying this to the present case, the Applicants argued that a little man could implement all the steps required to perform the present invention. This they said demonstrates that the program is just a tool for implementing the invention and that the invention was not about programming at all.

47 I do not find that argument persuasive. At paragraph 105 of his judgment, Peter Prescott QC went on to say:

“Of course if it (the invention) were about better rules for running a business the idea would not be patentable.”

48 This I think provides a crucial qualification of the “little man” test – a computer implemented invention does not become patentable merely because the commands could be issued by a human operator; there must still be a patentable advance which can be provided by what the computer program is used to control. It is a question to be answered on the individual facts of the case and as outlined above, I have been unable to identify one made by the present invention.

Conclusion

49 In my opinion the invention defined in claim 1 is a program for a computer and having failed to identify any advance or contribution in a non-excluded, technical field, I find it to be excluded as a program for a computer as such.

50 What is more I can see nothing in any of dependent claims 2 -17 or the rest of the specification that could form the basis of a patentable claim. For example, the security management features of claim 10 appear entirely conventional as illustrated by Van der Velde which discloses the allocation of different user access rights.

Benefit of the Doubt

51 The Applicants argued that the benefit of the doubt should be exercised in their favor given that the courts have recognized that this is a difficult area of law to apply. As support for this argument, the Applicants questioned why the Office did not of its own volition seek revocation of patents that should have been refused in the past if it was so sure of itself. Their point on this issue is misconceived. Under section 73, the Comptroller only has the power to revoke patents of his own volition under a very limited number of circumstances and that the patent relates to excluded matter is not one of them.

52 Notwithstanding that, whilst I agree that determining whether an invention is excluded is often not an easy thing to do, I am entirely satisfied that the present invention does not make an advance in a non-excluded field and is not patentable. Thus I find there is no doubt to be exercised. Whilst I have not relied upon it, I am reassured in reaching that conclusion by the findings of Mann J in *Macrossan* on the appropriate level of benefit of doubt to be given to Applicants and in particular that he found that the Applicant only benefits from genuine doubt.

Disclaimer

53 I said earlier that I would come back to one further claim that I was asked to consider by the Applicants. That claim which was filed with the Agent's letter of 6 December 2005 and is identical to claim 1 above but for the inclusion of a disclaimer in the following terms:

“wherein the computer system does not solely comprise a scheme, rule or method for performing a mental act, or doing business, or a program for a computer, or a mathematical method or the presentation of information as such.”

54 The Applicants argue that such a claim cannot possibly fall foul of section 1(2). What is more they say that if section 1(2) is sufficiently clear in meaning that decisions can be made that inventions fall within the exclusions listed in it, then it cannot be argued that the disclaimer is not clear. Furthermore, they say, once the disclaimer is applied you have physical entities left which are not excluded. Thus, in their view, that claim is not excluded.

55 I am not persuaded by the Applicants' argument as to the patentability of that claim. I have found above that the substance of the invention defined in claim 1 is excluded, that is the invention of claim 1 makes no advance in a non-excluded field. Disclaiming the excluded matter does not affect that position – the invention still makes no advance in a non-excluded field. Moreover, the affect of the disclaimer is to remove the specific functionality the hardware is programmed to provide. Thus once the disclaimer is applied, the means that remain are entirely conventional and thus cannot provide any advance, let alone one in a non-excluded area.

Decision

56 I have found that the invention defined in claim 1 is excluded as a program for a computer as such. I have carefully considered the remaining claims and the

entire specification and have been unable to identify anything which could form the basis of a patentable claim. I therefore refuse the application as not complying with section 1(2) of the Act.

Appeal

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

A BARTLETT

Deputy Director acting for the Comptroller