

PATENTS ACT 1977

IN THE MATTER OF
Patent Application No GB0301172.3
in the name of Stephen Townsend

DECISION

Background

- 1 Application No GB0301172.3 entitled “Advent calendar” was filed on 17 January 2003 as a divisional application on Application No GB9923624.2 and published on 30 April 2003 as GB2381333. In accordance with the provisions of section 15(4) this application is treated as having, as its date of filing, the date of filing of its parent, *viz* 7 October 1999.
- 2 In an examination report dated 16 February 2003 objection was raised, *inter alia*, that the invention as claimed in claims 1 - 6 was excluded from patentability under the provisions of section 1(2)(d) of the Patents Act 1977. Further correspondence between the applicant, Mr Townsend, and the examiner failed to resolve this matter and consequently it was considered at a hearing on 26 August 2003 at which Mr Townsend, a qualified patent agent, represented himself.

The application

- 3 The parent application relates to an advent calendar where there are two doors for each date, each door when opened revealing a treat. As well as the date, each of the two doors carries further information, for example a.m./ p.m. or %/&. When filed claim 1 of the parent application read as follows:-

“An advent calendar for counting the days from a first date to a second date comprising a plurality of mutually spaced doors, each door being identified as associated with a particular day and adapted to reveal, upon opening, a treat characterised in that at least one door is further identified as associated with a particular time.”
- 4 In the first examination report which issued on the parent application the examiner objected that the invention related to presentation of information and that such things were not considered inventions for the purposes of the Patents Act 1977. Mr Townsend amended the claims in a way which satisfied the examiner. However, before the parent was granted, the present divisional application was filed and claim 1 of this application reads :-

“An advent calendar for counting the days from a first date to a second date comprising a plurality of mutually spaced doors, each door being identified as associated with a particular day and adapted to reveal, upon opening, a respective treat characterised in that at least one door is further identified by an additional indicium.”

The law

5 Exclusions from patentability are listed in section 1 of the Patents Act 1977 and the part relevant to this decision 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)

(b)

(c)

(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 To determine how this section of the Act should be interpreted, section 130 of the Act, sections of the Manual of Patent Practice (MOPP), *Terrell on the Law of Patents* (published by Sweet & Maxwell) and pertinent case law were considered.

7 The relevant part of section 130 is section 130(7) which reads as follows:-

“Whereas by a resolution made on the signature of the Community Patent Convention the governments of the member states of the European Economic Community resolved to adjust their laws relating to patents so as (among other things) to bring those laws into conformity with the corresponding provisions of the European Patent Convention, the Community Patent Convention and the Patent Co-Operation Treaty, it is hereby declared that the following provisions of this Act, that is to say, sections 1(1) to (4), 2 to 6, 14(3), (5) and (6), 37(5), 54, 60, 69, 72(1) and (2), 74(4), 82, 83, 100 and 125, are so framed as to have, as nearly as practicable, the same effects in the United Kingdom as the corresponding provisions of the European Patent Convention, the Community Patent Convention and the Patent Co-operation Treaty have in the territories to which those Conventions apply.”

8 The relevant sections 1.12 and 1.30 of MOPP read as follows :-

1.12 *“.....In general, the question of whether an invention is excluded should be approached by construing the claimed invention as a whole, without regard for its constituent features or integers, and determining whether the whole invention solves a technical problem, or makes a contribution to the art in a non-excluded field, or whether the invention is, in substance, no more than an excluded item or is merely an excluded item in disguise.”*

1.30 *“Any manner, means or method of expressing information which is characterised solely by the content of the information is clearly excluded, no matter whether this be visual, audible or tangible and by words, codes, signals, symbols, diagrams or any other mode of representation. The mere fact that physical apparatus may be involved in the presentation will not suffice to avoid the exclusion. “*

9 To assist in the interpretation of the wording of section 1(2)(d) case law on the interpretation of statutes was considered. In *Farmers Build Ltd v Carrier Bulk Materials Handling Ltd* [1999] RPC 461, Mummery LJ held that :-

“No question of interpretation can be resolved simply by dipping into a

dictionary. It is not the function of lexicographers to construe statutes.”

In *Unilever Limited (Davis’s) Application* [1983] RPC 219, it was held, quoting Maxwell on the Interpretation of Statutes, that :-

“In dealing with matters relating to the general public, statutes are presumed to use words in their popular, rather than their narrowly legal or technical sense; ...”

- 10 General consideration of what is necessary to make an excluded item patentable are given in *Fujitsu’s Application* [1997] RPC 608 where 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.”

- 11 In an Office decision, O/069/03, an application in which the invention related to a vehicle number plate where the background colour indicates e.g. the sex of the driver was refused under section 1(2)(d) on the grounds that the invention related to nothing more than the display of information to road users and that such a display served no technical purpose. In a decision of the EPO board of appeal, T0603/89 *Beattie*, an application was refused because the contribution of the invention resided only in the content of the displayed information and not in the apparatus itself which belonged to the state of the art.

- 12 In respect of section 1(2)(d) of the Patents Act 1977, *Terrell* reads (at section 2.28) :-
“Subsection 1(2)(d) excludes from the class of inventions anything which consists of the presentation of information. This may go further than the old law, which distinguished between novelty in the information itself, which was unpatentable as being a mere discovery, and novel methods of presenting information, which were patentable. It is submitted that the wording of the subsection is capable of covering both these categories. However, where the presentation serves a technical purpose the claim amounts to more than presentation as such, and should be allowed.”

Since this section indicates that exclusions under the 1977 Act might go further than exclusions under the previous Act, some earlier precedents were drawn to Mr Townsend’s attention. In *Dixon’s Application* [1978] RPC 687 a printed sheet carrying print instruction means providing information on how to pronounce words was considered to disclose nothing which could properly be protected. In *Nelson’s Application* [1980] RPC 173 a paper sheet with a three part instructional message was refused since the invention consisted solely of matter having intellectual, literary or artistic connotation.

- 13 Subsequent to the hearing Mr Townsend drew attention to two further precedent cases. In *TDK Electronics Co Ltd’s Application* O/97/83 a claim to a tape cassette of conventional construction but with differentially coloured poles to facilitate assembly was refused under section 1(2)(d). In *Pepper v Hart* [1992] 3 WLR 1032 it was held that it was legitimate to consider the intention behind legislation in construing a statute where the legislation was ambiguous.

The issues

- 14 The examiner argued that the characterising feature of the present application was an additional indicium on the door of an advent calendar and hence the invention related to the presentation of information. Since the additional indicium had a purely decorative or informative purpose it had no effect on the functioning of the advent calendar. Its effect was solely on the psychology of the person using the calendar. Therefore the invention of claim 1, when viewed as a whole, had no technical effect, nor did it solve a technical problem. Hence, following the guidance given in the passages of MOPP quoted above, it related to presentation of information *per se* and was excluded from patentability by the provisions of section 1(2)(d).
- 15 In response Mr Townsend argued that the term “presentation of information” should be interpreted by consideration of the terms used in the French and German versions of the European Patent Convention since section 1 is one of the sections referred to in section 130(7). The word used for “presentation” in the German version is “Wiedergabe” which Mr Townsend defined, quoting the Oxford Duden German Dictionary, as “Darstellung” meaning “representation or portrayal” and “Schilderung” meaning “account”. He asserted that this suggested how particular information is expressed and not the provision of information *per se*. Similarly, in the French version the word used is “présentations” which, quoting the Oxford Hachette French Dictionary, meant “arrangement, layout” again suggesting how information is expressed. He maintained that, since “presentation of information” could mean either “provision of information” - that is providing information where it had not been provided before or “expression of information” - that is the manner (typeface, ink) in which the information is conveyed, its proper meaning was ambiguous. Therefore, since it is an exclusion, in accordance with the Vienna Convention, the term should be construed narrowly unless there is a public interest reason not to. Hence, he argued, in the light of the terms used in the other languages of the EPC, the exclusion should be interpreted as covering the mere expression of information and not the provision of information.
- 16 In respect of the case law considered he argued that, whilst he did not dispute that in O/069/03 an application was refused in which the invention lay in the provision of information, the distinction he was making between provision and expression of information was not argued before the Hearing Officer. In T0603/89 Mr Townsend asserted that the information being provided was information that had already been provided before.
- 17 In respect of the passage from *Terrell* he argued that this was just a bland assertion on the meaning of the section of 1(2)(d) with no reasoning provided. In his view precedents under the previous Act carried no weight, following the judgement in *Unilever* where it was held that:-
“...the long title of the Patents Act 1977 makes it clear that the old law of patents was being swept away.”
- 18 Mr Townsend asserted that the advent calendar of the present application is a technical solution to what is essentially a non-technical problem. The indicium is not merely decorative but it enables the calendar to be shared between two people, i.e. used in a new way. He maintained that a product which can be used by a human in a new way is

inherently technical because it concerns a real world interface between a product and a human.

Consideration of the arguments

- 19 It is not disputed that, in the light of section 130(7), section 1(2)(d) should be construed in conformity with article 52 of the European Patent Convention and Mr Townsend asserted an interpretation of the meaning of the term “presentation of information” by quoting various dictionary definitions of the word “presentation” and the equivalent words used in other language versions of the EPC. Whilst I accept that the term “presentation of information” might be defined as covering both “provision of information” and “expression of information” I do not accept his arguments that the word used in other languages in the EPC implies that the exclusion is only intended to cover “expression of information”. To my mind the word “présentations” in the French version is on all fours with the word used in the English version. The word “Wiedergabe” in Collins German Dictionary is defined, in addition to the “account” and “representation” meanings given by Mr Townsend, as “Darbietung” - rendering, rendition, “Übersetzung” - translation and “Reproduktion” - reproduction. I think this shows that the words used in the various authorised versions of the EPC are capable of wider interpretation than that given by Mr Townsend. However, I do not consider that agonising over dictionary definitions is helpful in interpreting the meaning of statutes. Following the decision in *Farmers Build*, it is clear that attempts to “prove” the meaning of everyday words in this way should be treated with caution. Words or phrases in a UK statute should be interpreted on their natural and ordinary meaning.
- 20 I accept that the Manual of Office Practice is not authoritative, being a guide to the working practices of the Patent Office, but an analysis of authorities and case law indicates how the current practice in respect of excluded matter in the passages quoted by the examiner is derived.
- 21 T0603/89 is an example of an application which was refused when the invention lay in the presentation of information on a keyboard instrument. The information, which was provided to the user to facilitate learning, was not, of itself new - it comprised a dodecatonic numeric scale but the context in which it was provided, i.e. on a keyboard, was new. The way, e.g. typeface, in which the scale is expressed is not important and I note that this bears resemblance to the present application in which the information provided on the door is not new - the symbols and letters are known but it is the context that is new, i.e. on an advent calendar. In O/069/03 it is agreed that information, the sex of the driver, is provided to the user. Similar considerations apply in *TDK Electronics* to which Mr Townsend drew my attention subsequent to the hearing - information, in the form of colour coding, is provided to the user to facilitate assembly.
- 22 These cases seem to me to reinforce the situation that existed under the 1949 Act. Mr Townsend dismissed the passage quoted above from *Terrell* which indicated that the present Act may go further than the old law but I do not consider that such an authority can be so lightly discarded. Some of the changes introduced by the new law were clearly radical but others were less so. Mr Townsend drew my attention to *Pepper v Hart* but did not indicate which parts of the preparatory documents produced before the introduction of the EPC would facilitate determination of the draughtsmen’s intentions. However,

before the 1977 Act came into force the Banks Report in the chapter on patentable inventions listed examples of matter which had never been considered to be an invention and these included :-

Designs or arrangements which serve only to convey information and in which the novelty resides solely in the information conveyed, e.g. normally printed sheets and mere presentations of information.”

and, in my view, the 1977 Act did not intend to make patentable things which had never been considered to be inventions. The view of *Terrell* is that section 1(2)(d) may go even further than the old law and, in the light of this authority, I do not consider that presentations of information which would have been excluded under the old law are allowable under the new.

- 23 The precedents under the 1949 Act quoted above are further examples where applications were refused where the invention was characterised by information being, to use Mr Townsend's word "provided" - in both *Dixon's Application* and *Nelson's Application*, instructions were provided or conveyed to the user.
- 24 Mr Townsend provided no case law to justify his narrow interpretation of the meaning of "presentation of information" other than an assertion that, because it was capable of more than one meaning it was ambiguous and should therefore be interpreted narrowly. I do not accept that the term is ambiguous. As Mr Townsend states the term, in its normal usage, covers both the provision and expression of information and, in the light of the above authorities and precedents, I consider that the term, as used in section 1(2)(d), is intended to cover its everyday usage - the process of offering, or to use Mr Townsend's word, providing, information for consideration or display. I am reinforced in this view by the fact that, if Mr Townsend's analysis were correct, books and newspapers which, in accordance with his definition, both provide and express information, would not be excluded. He tried to distinguish his invention from such items by arguing that, in the case of a newspaper, it is merely reporting information which is already known but I am unimpressed by the argument that newspapers never provide new information.
- 25 Mr Townsend acknowledges that his invention lies in the provision of information and I have held that, for the purposes of section 1(2)(d), the term "presentation of information" encompasses this within its meaning. Accordingly I find that the invention of the present application lies in an excluded field.
- 26 I consider that, following the decision in *Fujitsu's Application*, it is a requirement for patentability that inventions which lie in excluded fields should have a technical effect, i.e. serve a technical purpose or include a technical advance. Since I have found that the present invention lies in an excluded field I need to consider whether it fulfils this requirement since Mr Townsend has asserted that it does.
- 27 All the constructional features of the calendar are well known. As described the characterising feature is a known indicium comprising letters or symbols, for example of the form a.m./ p.m. or %/&, and this is intellectual information not a technical feature. Therefore I do not accept the argument that the features which distinguish the product over the prior art are described in precise, technical terms.

- 28 Mr Townsend has argued that a product which can be used by a human in a new way is inherently technical but, in my opinion, such use does not necessarily result in the technical advance or improvement necessary to render the product patentable. For example, every time a user operates a PC it is probably operated differently from any previous use and the operation concerns a “real world interface between a product and a human” but it is well established that such normal usage of a PC is not patentable. However, in this instance, I do not accept his argument that the product is being used in a new way. It is the invention of the parent application, which is an advent calendar with more than one door for each day of advent, that enables sharing of the calendar by two people. The provision of an additional indicium merely provides information to the user. When and which doors are opened is then a matter for the individual user but the calendar itself is used in the conventional way - a door is opened to reveal a treat.
- 29 I therefore consider that the invention of claim 1, an advent calendar which has an additional indicium on each door, serves no technical purpose and includes no technical advance, providing merely intellectual information to the user and as such it relates to the presentation of information *per se*. It is therefore excluded from patentability by section 1(2)(d) of the Patents Act 1977. The remaining claims introduce no new technical features and hence are also excluded from patentability.

Conclusions

- 30 I have found that all the claims are excluded from patentability by the exclusion of section 1(2)(d). Having read the application in its entirety, and taking into account the invention claimed on the parent application, I can find no technical feature which could be claimed in order to meet the patentability requirements. Accordingly I refuse the application under section 18(3) on the grounds that the application does not comply with section 1.

Appeal

- 31 Under rule 52.4 of the Civil Procedure Rules the period for appeal to the Patents Court is 28 days unless I direct a different period. I see no reason to do so, and so the appeal period is 28 days from the date below.

Dated this 1st day of September 2003

MRS JACKIE WILSON

Deputy Director acting for the Comptroller

THE PATENT OFFICE