



6 In a letter confirming his intention to attend the hearing, Mr Geary identified what he saw to be the issue I should address. This, he said, was:

“whether the applicant is entitled to be notified of the Patent Office’s opinion on the relationship between the claimed invention and the prior art when an application is objected to on Section 1(2) grounds”.

7 I do not consider that to be quite right. As I see it, it is not for me to make pronouncements about general points of law or practice. On the contrary, what I must do is consider the facts pertaining to a particular application with a view to deciding whether that application complies with the 1977 Patents Act. For the present dispute, as part of the process of deciding whether the present application relates to patentable subject matter, I need to ensure that the principles of natural justice have been applied. Specifically, for the present dispute, that means ensuring that the applicant knows, in detail, the case he has to answer. At least before the hearing, Mr Geary felt that the examiner had not fulfilled the Office’s obligation to set out its case fully.

### **Argument**

8 The crux of Mr Geary’s argument is focussed on the word “contribution” in the technical contribution doctrine. In his opinion, “contribution” implies some sort of an advance over what has been done before. Thus, according to Mr Geary, an assessment of whether an invention falls within the excluded categories of section 1(2) requires the examiner to make a comparison of the claimed invention with the prior art. Only once that has been done, he said, can the claimed invention be properly assessed to determine the presence or otherwise of a technical contribution.

9 In advancing his argument Mr Geary sought to rely on a number of previous decisions of the Comptroller’s Hearing Officers and of the Courts. In each of those decisions, Mr Geary said, the starting point for the assessment of technical contribution was an analysis of the prior art followed by the identification of differences between that prior art and the claimed invention.

10 In particular, Mr Geary said that in *Sporting Exchange Ltd’s Application* BL O/280/02 and *Hutchins’s Application* BL O/209/01, the decision that the claimed invention did not make a technical contribution was predicated on the determination that the hardware employed in carrying out the invention was conventional. Similarly, he said, in *Wills’s Application* BL O/089/99, the starting point for the decision is that laminated identity cards were known. In *Genentech Inc’s Patent* [1989] RPC 147, the starting point is that the invention was based on a discovery which by definition is new. Finally in *Fujitsu Limited’s Application* [1997] RPC 608 the starting point is that the invention provided a new tool for modelling crystal structures.

11 In all these cases, said Mr Geary, the approach had been to compare the invention with the prior art before going on to determine whether the invention made a technical contribution. In his view, the Patent Office should always follow that approach when determining whether an application is excluded from patentability. Thus, he said, the applicant was entitled to have the nearest prior art identified by the Office and an assessment given of any differences that exist between the invention claimed and that prior art. Only when provided with that information could the applicant fully set out his

case that the differences constituted a technical contribution. I do not agree.

- 12 In the prior cases quoted by Mr Geary the approach used to assess patentability does indeed seem to have been to use the current prior art as the starting point for assessing whether the inventions claimed in the applications concerned did make the required technical contribution. I have read all those decisions carefully but I can see nothing in any of them to suggest that that approach should be adopted universally; the approach adopted was the one seen as being appropriate in the case in question.
- 13 Furthermore, I have reservations as to whether a general approach to assessing patentability should be inferred from these prior cases. In *Fujitsu*, the Court of Appeal decided that the required technical contribution was not present, irrespective of the fact that the invention provided a new tool (for modelling crystal structures). To my mind the step of deciding that the tool is new is rendered somewhat superfluous if the ultimate decision on patentability is taken irrespective of the findings on that point.
- 14 In *Genentech* the issue is whether the practical application of a discovery can provide a technical contribution. As acknowledged by Mr Geary, discoveries are by their very definition “new” and I am not convinced that I can infer a standard approach to assessing technical contribution relative to the prior art from this decision.
- 15 Nor am I convinced that the *Sporting Exchange* decision supports Mr Geary’s arguments. In his decision on that application, the Hearing Officer did rely on the fact that the hardware implementing the invention was conventional, as Mr Geary said. However, he went on to accept the applicant’s assertion that the resulting betting system was innovative and moreover made a point of saying that he did so without testing that assertion. His justification for doing so was that in line with the decision of Fox LJ in *Merrill Lynch Inc’s Application* [1989] RPC 561, the key thing to do when deciding upon the patentability of an invention was to determine the substance of the invention and that the technical contribution must be found in it. In the *Sporting Exchange* case, the Hearing Officer found that there was no technical contribution. Thus in determining whether the invention was patentable, the novelty or otherwise of the programmed computer seems to have been of no bearing.
- 16 I am also not persuaded that the decision in *Wills’s Application* supports Mr Geary’s argument on the approach to be adopted when assessing patentability. That decision does undoubtedly include discussion of which elements of the claimed invention are new and which are conventional. However, the Hearing Officer did not in my view suggest that such an assessment should always be conducted. Rather, he went out of his way to emphasise the issues he considered to be essential in determining whether an invention is excluded from being patentable when he said in the final paragraph on page 9:

“..I am clear that in reaching my decision, I must have regard to a number of important principles. I must bear in mind that matter is not prevented from being treated as a patentable invention merely because some of its integers fall into an excluded category. I must consider what technical contribution the invention, as defined in the claims when considered as a whole, makes to the known art. Thus, it is not the nature of an embodiment which is important but the nature of the central idea or invention which is embodied. To determine this, I must assess and construe the invention claimed as a whole to see whether the contribution it makes goes beyond an excluded category.”

- 17 I do not consider that this decision supports any argument on general approach to be adopted beyond these clear principles.
- 18 When deciding whether a particular invention is excluded from patentability each application has to be considered on merit. The ultimate decision and the approach required to reach that decision will depend upon the facts of an individual case. In my opinion this is not an area that lends itself to hard and fast rules which Mr Geary would have me impose.
- 19 This leads me to conclude that there is no “one-size-fits-all” approach which must be adopted when deciding whether an individual application relates to patentable subject matter. However, I still need to consider whether the applicant’s right to know the case against him in detail has been met in the present application.
- 20 I have a certain amount of sympathy with Mr Geary on this point but only in so far as the the last letter issued by the examiner is concerned. That letter does indeed make reference to there being some differences between the invention claimed and the prior art and that in the examiner’s opinion those differences do not constitute a technical contribution. With hindsight, it would have been beneficial if that letter had been more expansive. It is my feeling however that the omission of additional explanation of the objection is explained by the underlying intention behind that letter. The examiner and applicant had already undertaken numerous written and telephone exchanges relating to the patentability of the application before that letter was issued. It is my view that the examiner considered that all the arguments on patentability had been aired sufficiently and the purpose of the letter was to set in motion arrangements for the substantive hearing, not to restate the objections.
- 21 From reviewing all the correspondence I find it inconceivable that there could be any misunderstanding as to what prior art the examiner was referring. The applicant has identified the Microsoft Outlook/Exchange product as being the nearest piece of prior art to the present system known to them. In addition, in his letter of 1 May 2003, the examiner identified 8 internet citations which he considered provided evidence that the invention did not make a technical contribution. To my mind this is the prior art the examiner was referring to.
- 22 Moreover, when the invention is considered against that prior art it is relatively straight forward to identify the differences that exist between those various systems. In his letters of 11 April 2002 and 3 July 2002, Mr Geary himself identified the difference between the present invention and the Microsoft system as being in the particular messaging regime employed. In particular, the present invention allows for a single electronic communication to correspond to more than one event in the reminder system where as in the Microsoft Exchange system each communication corresponds to a separate event. In his letter of 12 May 2003, Mr Geary identified this same difference to exist between the present invention and the systems disclosed in the web pages cited by the examiner. When all the correspondence is taken into account I consider the differences between the prior art and the present system to be easily derivable.
- 23 I conclude that the correspondence, when viewed in the round, is such that the applicant knows in detail the case he has to answer, consistent with the principles of human justice.

24 Moreover, even if that were not the case before the preliminary hearing, the discussions that took place during the course of it served to highlight agreement between the examiner and Mr Geary on the differences between the identified prior art and the present invention. I am thus in no doubt that Mr Geary knows the case he will have to answer in relation to the patentability of the present invention when that comes to be considered at the substantive hearing both he and I agree is necessary to decide whether the invention is patentable.

### **Decision**

25 I have found that the applicant knows in detail the case he has to answer on the issue of patentability of the present invention consistent with the principles of natural justice.

26 I have asked that the substantive hearing be arranged to take place as soon as practicable whilst allowing at least fourteen days notice for the applicant after the end of the appeal period. That further hearing will of course be delayed should any appeal against this decision be lodged.

### **Appeal**

27 Any appeal from this decision must be lodged within twenty eight days of the date of this decision.

### **Other Issues**

28 During the course of the hearing, I discussed with Mr Geary whether the independent claims were actually limited to a system where each electronic communication corresponds to more than one event. Mr Geary thought it was but I advised him to consider this further in advance of the substantive hearing given this is likely to be fundamental to his case on patentability.

29 I have asked the examiner to confirm the difference between the identified prior art and the present invention as discussed at the hearing in writing.

Dated this    th day of April 2004.

**A BARTLETT**

Deputy Director acting for the Comptroller