



BLO/347 /04

23<sup>rd</sup> November 2004

## PATENTS ACT 1977

APPLICANT                Sony Communication Network Corporation

ISSUE                     Whether patent application number GB  
0224087.7 is excluded under section 1(2)

HEARING OFFICER                     A Bartlett

---

## DECISION

### Introduction

1. International patent application number PCT/JP2001/003426 entitled, "Marketing support method and device using electronic message", was filed on 20 April 2001 in the name of "Sony Communication Network Corporation" claiming priority from a Japanese application with an earliest date of 21 April 2000. The international application was published as WO 01/82156 on 1 November 2001.
2. In his first examination report, the substantive examiner raised an objection that the application was excluded from patentability under section 1(2)(c) as a business method and/or a computer program. A number of other objections raised in that and subsequent reports have now been disposed of. However, a number of rounds of amendment failed to satisfy the examiner that the invention was patentable and he offered the applicant the opportunity to be heard on this matter. The applicant declined his invitation and requested instead that the issue be decided on the papers.

### The Application

3. The application concerns a method for facilitating the exchange of messages between parties such that a recipient can specify who (s)he receives messages from. In other words a message sender has to be given permission by a potential client in order to send a message to that client. Whilst the claims as presently drafted do not specify the nature of the information transmitted, in the embodiments described this is promotional information regarding products and services offered by pharmaceutical companies to healthcare professionals. In line with the terminology used in that field I shall refer to this as electronic permission marketing.
4. To describe the system in a little more detail, the client and message sender initially enter personal data into a central data repository. When a client identifies a message sender that he/she is willing to receive a message from, the client is registered with the message sender. The message sender is then able to send a message to the client, the message being prepared

via an interface on the sender's terminal.

5. The method of this invention is intended to be implemented through the use of computers linked by a network such as the internet via an intermediary server. The messages sent could be email, but in the embodiment described the messages are contained in web pages or portals browsed by the client. The various functions of the invention are controlled by software running on the computers.
6. The latest amendments to the claims were filed on 21 September 2004 and include three independent claims. Independent claims 27 and 30 define computer program storage means and apparatus claims which correspond to method claim 1 which reads as follows:

1. A method of sending and receiving messages to and from people comprising the steps of:

- receiving an input of personal data of a message receiving person so as to be stored in a client table;

- receiving an input of personal data of a message sending person so as to be stored in a salesperson table;

- receiving identifying data of a message sending person from a terminal of a message receiving person in order for the message receiving person to approve the message sending person;

- generating a selective registration table which, based on the identifying data that the message receiving person has inputted, associates the client table of said message receiving person with the salesperson table of an approved message sending person;

- registering entry of the message receiving person into a client list file of the approved message sending person, on the occasion of said generating the selective registration table, and

- providing a salesperson-side message interface which supports preparation of a message addressed to the message receiving person from the message sending person so as to enable preparation of a message to said message receiving person which has been registered in the client list file.

## **The Law**

7. The examiner has maintained 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 as such. 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 purposes of this Act only to the extent that a patent or application for a patent relates to that thing as such.*

8. 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 (EPO) that have been issued under this Article in deciding whether the present invention is patentable.

### **Interpretation**

9. The principles to be applied under UK law in deciding whether an invention is excluded from patentability have been rehearsed repeatedly in various decisions of the Comptroller's hearing officers in recent times. These can all be found on the Patent Office website at <http://www.patent.gov.uk/patent/legal/decisions/index.htm> and for the purposes of this decision I consider it necessary only to restate the principles I have applied, not their origin.
10. First, it is the substance of the invention which is important rather than the form of claims adopted. Second, the effect of the final part of section 1(2) is that an invention is only excluded from being patentable if it amounts to one of the excluded areas "as such" and that following decisions of the UK courts and the EPO Boards of Appeal, an invention is not considered to amount to one of those thing "as such" if it makes a technical contribution. Third, whether an invention makes a technical contribution is an issue to be decided on the facts of the individual case. Fourth, it is desirable that there should be consistency between the Patent Office's and EPO's interpretation of the exclusion in the Patents Act and the EPC. Finally, any doubt over the patentability of the invention should be resolved in favour of the applicants.
11. In deciding whether the present invention is excluded from patentability I shall consider two specific questions:
  - a. Does the *substance* of the invention relate to a business method and/or a computer program? If the answer to that question is "yes"
  - b. Does the *substance* of the invention make a technical contribution such that it cannot be said to amount to the excluded item *as such*?
12. If the answer to the second question is "no" the invention is not patentable.

### **Argument**

### **The excluded categories**

13. As outlined above, the present invention relates to a permission-based messaging system whose purpose is to allow a user to avoid being bombarded with unsolicited messages. I consider administering a process defining “who is allowed to contact whom” to be just the kind of activity encompassed by the business method exclusion and thus that prima facie the invention is caught by that exclusion.
14. As for whether the invention also potentially falls foul of the computer program exclusion, I am in no doubt whatsoever that the most convenient means for implementing the invention is via a computer program irrespective of the form of wording employed in the individual claims. That this is a software implemented invention is confirmed by the existence of claim 27 (the claim to a medium carrying the program causing a computer to implement the invention). Thus I consider that prima facie the invention also falls within the computer program exclusion.

### **Technical contribution**

15. I have found that the invention potentially falls within the “business method” and “computer program” exclusions. That is not the end of the matter however. I must now decide whether the invention amounts to those things “as such” by applying the technical contribution test. What constitutes a “technical contribution” has been the subject of a good deal of argument before the UK courts, the Comptroller’s hearing officers and the Boards of Appeal of the EPO. The decisions of those bodies provide a bountiful source of guidance to help me decide whether an individual invention makes a technical contribution.
16. I have considered the entire specification and all the arguments put forward in the correspondence in detail in an attempt to identify the required technical contribution. However, I have been unable to satisfy myself that the present invention provides one.
17. There is no suggestion anywhere in the specification that the hardware used to implement the invention is anything other than conventional. Thus the hardware itself cannot, it seems to me, provide the technical contribution.
18. The specification refers to a number of problems that the invention seeks to overcome. Conventional mail shot techniques are said to be impersonal and it is difficult to assess when they have been successful. Face-to-face marketing is stated to be extremely labour intensive and expensive and the timing of visits may be inconvenient for customers. Whilst I agree that there are clear advantages in adopting electronic distribution techniques, the Comptroller’s hearing officers have made it clear on many occasions<sup>1</sup> that these are precisely the sort of advantages to be expected from using a computer network and using a computer or computer system to achieve them is not sufficient for an invention to be said to make a technical contribution. Moreover, I do not consider any of the problems identified to be

---

<sup>1</sup> See for example the decision in Fujitsu Limited’s application GB9604003. 5 BL O/317/00 at <http://www.patent.gov.uk/patent/legal/decisions/2000/031700.pdf>

technical problems. Rather I consider the problems to be business or administrative ones. Solving them does not in itself provide the required technical contribution. Any efficiency savings follow on naturally and directly from this automation.

19. Another potential source of the required technical contribution is in the way the underlying problem is solved. As I have said above, the hardware seems to be conventional. However, the applicant has argued that the “separation” between the message receiver and the message sender (in particular the fact that the message sender has no access to the message receiver’s address details) provides the necessary technical contribution. I am not convinced by this argument. It would appear that this functionality is intimately bound up with the business method which underlies the invention and is not concerned with addressing any technical issues. The feature of “separation” or “confidentiality” is common place amongst internet based systems (for example in internet dating systems) and cannot it seems to me provide the required technical contribution.
20. I can see nothing in the particular way the invention is implemented that could be said to amount to a technical contribution.

### **Summary**

21. I have been unable to identify a technical contribution resulting from this invention either through the problems it aims to solve or through the effects achieved in solving these problems. There is nothing in the specification to suggest that anything other than conventional hardware, programmed in a conventional way, is used in realizing the invention. Consequently, I must conclude that the claimed invention fails to provide the necessary technical contribution.

### **Decision**

22. I have found that the invention as claimed in this application is no more than the application of known technology to solve a business problem, and that it fails to provide any technical contribution. I therefore find that it is excluded from patentability as a method of doing business and a program for a computer as such. Although consideration has been focused on the independent claims, I can find nothing in the other dependent claims, or indeed the rest of the specification, that would provide support for any patentable claim. Accordingly I refuse the application under Section 18(3) on the grounds that the invention is excluded by Section 1(2)(c).

### **Appeal**

23. Under the Practice Direction to Part 52 of the Civil Procedure Rules, any appeal against this decision must be lodged within 28 days.

**A Bartlett**

Deputy Director acting for the Comptroller