



BL O/361/04

9 December 2004

## PATENTS ACT 1977

APPLICANT                                          Epic Systems Corporation

ISSUE                                                Whether patent application number GB  
0415595.8 complies with section 1(2)

HEARING OFFICER                                G M Rogers

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## REASONS FOR DECISION

### Decision

- 1     At the hearing on 18 November 2004 I refused to allow the application to proceed in the form in which it stood because I held that the claims related to excluded matter under Section 1(2)(c) in that they related to a method of doing business as such or a computer program as such. I promised to provide reasoned grounds for my decision, which I now do. As I did not refuse the application outright, it was open to the applicants to submit amended claims for the examiner to consider. As the period for response to the outstanding examination report expired on the day after the hearing, I agreed an extension of two weeks from that date for a response to be submitted.

### Background

- 2     This application was divided from the parent application GB 0229681.2 following an objection (raised against the parent application) that the claims related to two inventions. The parent application arose from a PCT application (which was published as WO 02/01483) and was effectively filed on 26<sup>th</sup> June 2001, claiming priority from US 60214290 (26<sup>th</sup> June 2000). All of the claims in the parent application were searched by the ISA. The applicant filed the present divisional on the 13<sup>th</sup> July 2004 along with requests for search and examination.
- 3     A first examination report was issued along with the search report on 31 August 2004. In the examination report an objection was made that the subject matter of the claims was considered to be excluded under section 1(2) as being directed to a program for a computer as such or to a method for doing business. It was pointed out that when making an assessment on whether the invention was patentable or not, it was the *substance* of the

invention that was considered and not the form or wording employed. The applicant was directed to *Fujitsu's Application* [1997] RPC 608 to support this reasoning.

- 4 The first examination report also objected that claims 12,13,16,18 and 22 were not novel in light of US 5960406. It was also submitted that US 5960406, US 5692125 and the non-patent literature document "Appointment scheduling on computer" rendered obvious claim 17. The novelty and obviousness objections were waived in the light of arguments put forward by the applicant in a response received on 4 October 2004.
- 5 In that response the applicant's agent submitted a revised claim 1 and also put forward comments on the Section 1(2) objection. It was argued that the invention of claim 1 did not relate to excluded matter as the claims were directed to a "tangible object" being suitable for self-scheduling appointments via an electronic network and that the functions disclosed did not "correspond technically to the steps of a method" referring to the EPO Board of Appeal decision T1002/92 (Peterson) to support this argument. He also argued, quoting from the EPO Board of Appeal decision T931/95 (Pension Benefit), that business methods which were technical or, in other words, have a technical character were not methods as such, adding that the present invention solved a technical problem which distinguished it from Pension Benefit. The agent went on to suggest that the invention of claim 12 did not relate to excluded matter, as defined in Section 1(2)(c) of the Act, as the invention related to "apparatus" and a "physical entity" which is not mentioned in Section 1(2)(c). The agent argued that, essentially, an apparatus cannot be a "method" and therefore cannot be a business method.
- 6 The agent then went on to argue that the invention removed the need of "human influence from the appointment scheduling process" and that this resulted in greater efficiency and reduced the computing resources required (as only one user operable interface need be supplied). It was also argued that the invention provided secure data transfer and that such a secure system should be patentable with regard to "The guidelines for Examination in the EPO" section C-IV, 2.3.6 which states that "a further technical effect...may be found... in the computer's *interfaces* under the influences of the program and could, for example, affect the *efficiency or security* of a process".
- 7 The examiner was not persuaded by these arguments regarding Section 1(2) and issued a further examination report, to which the applicant's agents responded by requesting a hearing. This took place on Thurs 18 November 2004. The applicants were represented by their patent agent, Mr John Lawrence, assisted by Mr Sean Harte and Mr Toby Gosnall. The examiner, Mr Ben Widdows, also attended.

### **The application**

- 8 The application generally relates to a method and system for allowing a patient to "self-schedule" an appointment with a medical provider/department via an electronic network. A patient's appointment request is subject to various rules and the patient may also have a stored "ticket" which contains information to limit the patient's ability to schedule appointments. Claim 1 as presently on file (including the amendments filed on 4 October 2004) reads:

A method of self-scheduling appointments between service recipients and service providers via a secure electronic network, the method comprising the steps of: receiving via the electronic network an appointment scheduling request from a service recipient at a self-scheduling server; determining an authorization of the service recipient to submit the appointment scheduling request at a processor of the self-scheduling server; identifying a pre-authorized scheduling ticket for the service recipient, the preauthorized scheduling ticket including appointment scheduling information at a server; providing to the service recipient an appointment proposal in accordance with the appointment scheduling information via the electronic network; and applying a set of rules to the appointment request at the processor to determine if the requested appointment is allowed.

9 There is also an independent claim (claim 12) to a system which reads:

A system to allow self-scheduling of appointments via an electronic network, the electronic network configured to permit secure access thereto by a service recipient, the system comprising:

a self-scheduling server coupled to the electronic network for secure communications therewith, the self-scheduling server adapted to receive appointment scheduling requests from the service recipient securely via the electronic network;

a self-scheduling service including a processor, the processor being coupled to a rule base, to a scheduling database, and capable of receiving an appointment scheduling request; and

wherein the processor is operable upon the receipt of the appointment scheduling request to authorize the appointment scheduling request, to send appointment schedule information to the scheduling database for inclusion therein and to send an appointment acknowledgment to the service recipient securely via the electronic network.

10 The method and system allow a service recipient, for example a patient, to make an appointment with a service provider, eg a doctor, over a network such as the internet, without the need for any human intervention at the service provider. Rules or a 'scheduling ticket' determine whether the patient is authorized to make the requested appointment, and so provide some manner of regulation of the use of the system.

### **The law**

Objection has been raised that the invention relates to a business method and a computer program contravening Section 1(2)(c) of the Patents Act 1977. The relevant parts of Section 1 of the Act read as follows:

*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.

11 This particular section of the Act corresponds to articles 52(2) & (3) of the European Patent Convention. As section 130(7) of the Act confirms, these respective provisions are so framed as to have, as nearly as practicable, the same effect. It is also well established that whilst I am bound by the decisions of courts in the UK, as prescribed by Section 91 of the Act, I must also have regard to the decisions of the European Patent Office Boards of Appeal, at least insofar as they relate to these particular articles of the Convention.

12 Some of the exclusions from patentability in section 1(2) of the Patents Act 1977, and the case law surrounding it, were considered by the Court of Appeal in *Fujitsu Limited's Application* [1997] RPC 608. In his judgment in that case, Aldous LJ stated at page 614, lines 40-46:

"However, 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 technical contribution are. Thus the concept that what is needed to make an excluded thing patentable is a technical contribution is not surprising. This was the basis for the decision of the Board in *Vicom*. It has been accepted by this court and by the EPO and has been applied since 1987. It is a concept at the heart of patent law."

13 This means, for example, that inventions **which involve a technical contribution** will not be refused a patent merely because they relate to business methods, mental acts, or computer programs and aligns UK practice more nearly with practice under the corresponding provisions of the European Patent Convention. This was set out in a Practice Notice published on 24 April 2002.

14 In reaching a decision in this case there are, therefore, two questions I have to answer. The first is: does the invention relate to a scheme, rule or method for doing business, or to a computer program? Secondly, if the answer to the first question is yes, is there a technical contribution or technical effect? The presence of such a technical contribution or effect would allow me to find that the invention does not relate to a mental act or a computer program **as such**, in which case it would not contravene Section 1(2)(c) or the corresponding Article 52(2)(c) of the EPC.

### **Argument**

15 Mr Lawrence began by reminding me that in *ex parte* proceedings any benefit of the doubt should be resolved in favour of the applicant and he hoped to show me that there was some doubt in this case. In referring to the judgment in the *Fujitsu* case he warned against trying to read behind the words of the claim to determine the essence of the invention. This, he

said, required one to pre-judge what the invention was, and conflicted with the advice of Lord Hoffmann in *Biogen Inc v Medeva plc* [1997] RPC 1, who, in declining to define the meaning of invention warned that judges “would be well-advised to put to one side their intuitive sense of what constitutes an invention until they have considered the questions of novelty, inventiveness and so forth”. He did concede, however, that there was a considerable body of precedent cases where judges had looked behind the wording of the claims to decide what was the invention.

- 16 This prefaced Mr Lawrence’s first argument which was that the invention was not excluded because the wording used in the claims took the invention outside a business method or a computer program, observing that because an invention related to a business or commercial activity, it did not follow that the invention was excluded. He suggested that the invention was a new IT network allowing patients to self-schedule medical appointments but included a new functionality which was provided in a way which reduced technical problems. He explained that the system put restrictions on the ability to self-schedule, for example it only allowed appointments to be made if it was safe to do so, and he argued that safety was usually a technical feature. He added that restricting self-scheduling also meant less network traffic requiring less bandwidth and reduced the processing capacity requirement and these were clearly technical features. He went on to point out that the claims contained features such as a scheduling ticket which has certain attributes and a set of rules, and argued that these gave the invention a technical ‘feeling’.
- 17 Mr Lawrence pointed out that in operation the system ends up with an appointment ‘document’ and whether this document was merely displayed on a screen or printed out, it was a product arising from a method of manufacture, which is normally regarded as patentable, and not a business method.
- 18 In relation to claim 12, he argued that this claim was directed to items of computer hardware so could not be regarded as a method of doing business nor as a computer program.
- 19 Before coming to a decision on this first issue, ie whether the claims relate to a business method or a computer program *per se*, I will address Mr Lawrence’s point that I should have regard to the words used in the claims and not ‘look behind the wording’ as Mr Lawrence expressed it. However, as Mr Lawrence conceded, there is a substantial body of case law guiding me to do just that. This was expressed most clearly in *Merrill Lynch's Application* [1989] RPC 561, where Fox LJ said at page 569:
- “It cannot be permissible to patent an item excluded by Section 1(2) under the guise of an article which contains that item – that is to say, in the case of a computer program, the patenting of a conventional computer containing that program. Something further is necessary.”
- 20 Thus claiming a business method or a computer program in the guise of a computer or computer system embodying the business method or containing the program does not circumvent the prohibition embodied in Section 1(2)(c).
- 21 Considering claim 1, this is directed to a method of self-scheduling appointments, and

comprises a number of steps relating to the fixing of an appointment. These steps include receiving a request for an appointment, checking whether the person requesting the appointment is authorised to do so having regard to a set of rules, and if the rules are met, making the appointment. All these steps are related to the orderly management of an appointments system and so in my view claim 1 clearly is directed to a business method. I cannot see how Mr Lawrence's argument that I should not look beyond the wording of the claim can help him here. Turning to claim 12, the system comprises essentially a network, a server, a processor and databases which inter-relate, to provide a self-scheduling appointment system. There is nothing in the claim to suggest that the components are anything other than conventional components. Any novelty must therefore reside in the way in which the system operates. In this case it operates to provide a self-scheduling appointment system. A claim to system comprising an assembly of hardware, if it is entirely conventional hardware, and is programmed to carry out a business method cannot be used as a means to claim an excluded business method or computer program. So the answer to the first question is, yes, the claims do relate to a business method or a program for a computer.

- 22 Considering Mr Lawrence's argument that the method results in an appointment document and that this is a product whether or not it was printed out, I cannot see that this has any bearing on the nature of the invention. I do not accept the argument that if there is a product then there is a manner of manufacture and that must be patentable. The invention in claim 1 relates to the management of an appointments system and comprises various steps in operating that system. Whether the system includes the printing of an appointment document (and the present claim 1 doesn't) is of no consequence. The claim is still directed to a business method. I am not sure whether Mr Lawrence was advancing this argument in relation to claim 12, but if he was, then I would come to the same conclusion that the fact that an appointment document is produced does not change the nature of the claim. I still conclude that it relates to a conventional computer system programmed to carry out a business method, so the invention if any resides in the business method or the computer program.
- 23 In addressing his second argument, Mr Lawrence put it to me that the invention claimed included a technical contribution and thus the claims were allowable even though it might be held that they related to a business method or software. In putting this argument, Mr Lawrence essentially referred to the same features as he had when arguing that the claims did not relate to a business method or software.
- 24 He referred me to the way in which the system restricted the self-scheduling of appointments by applying rules or a pre-authorized scheduling ticket and emphasized the safety aspect of this feature, which he suggested was a technical feature or contribution. He explained that the rules and the scheduling ticket would prevent patients making appointments for inappropriate treatments, for example those that might be detrimental to their health. Likewise, he suggested that this aspect of preventing inappropriate scheduling of appointments minimised processing power, controlled access, reduced the required bandwidth, and led to a more efficient utilisation of available resources. All of these, he claimed, were technical contributions which meant that the claims did not relate to an excluded invention **as such**.

- 25 I am not persuaded that the safety aspect of this system is a technical feature, and in any case it seems to me to be somewhat remote from the method and system claimed. It may be a reason why certain self-scheduling might be disallowed, but it is not a claimed feature.
- 26 The other features put forward by Mr Lawrence relate to the efficient use of computer, server or network. These other features are in my view desirable in any such system. I note that none of them are mentioned in the patent specification. Moreover, if they are achieved it is as a consequence of the business objective of imposing restrictions on the self-scheduling of appointments.
- 27 In *Applied Psychology Research Limited's Application* (BL O/208/04) the alleged invention related to computer apparatus for operating a system of purchasing items over the internet. It was argued in that case that the problem being solved was network overload although it was conceded that there was no reference to that in the specification. In rejecting this argument, the hearing officer said:
- “I am perfectly prepared to accept that network overload is an inherent problem with communication networks. However, I cannot see any link, either explicit or implicit, between the invention disclosed in the application and the general desire to minimise network overload. Had there been an implicit link between the invention and the general desire to minimise network overload, I would have expected to find some indication that network traffic is managed in some way to take account of capacity. I can find no suggestion of this in the application.”
- 28 This is almost exactly the situation we have here. In the present case, if there is more efficient use of the computer system, it arises purely as a result of the modification of the business method employed, namely the use of rules or a scheduling ticket to restrict appointment setting. The problems being solved by the system are inherent problems with such systems. This applies both to the method of claim 1 and the system of claim 12.
- 29 Furthermore, in the recent EPO Technical Board of Appeal Decision in *Hitachi* (T258/03) the Board found that circumventing a technical problem through modification of a business method (rather than solving it by technical means) cannot contribute to the technical character of a computer-implemented invention. Thus there is support both in UK and EPO case law for my view that there is no technical contribution in the present claims of this application.
- 30 Before the hearing, the applicants submitted two further claims which they stated were “for discussion” rather than for formal consideration. They were directed to a system for and a method of self-scheduling appointments. At the hearing I indicated that I could see no technical contribution in either of them so both would fall foul of Section 1(2)(c). In addition, during the hearing, Mr Lawrence presented me with two further claims which he said were also for discussion rather than being formally submitted as amendments. Mr Lawrence suggested that they put greater emphasis on the ‘scheduling ticket’ which the service provider used to set rules for the scheduling of appointments for an individual user, and on the safety aspect, respectively. Although I did not consider them in great depth, I suggested that they too did not introduce anything that might be regarded as a technical contribution and thus render the claims patentable. So had they been submitted formally as amended claims I

would have refused to allow them.

**Appeal**

- 31 Under the Practice Direction to Part 52 of the Civil Procedure Rules, any appeal must be lodged within 28 days of the date the decision issued which was 18 November 2004.

**G M ROGERS**

Deputy Director acting for the Comptroller  
9 December 2004