

the part of the Patent Office. Mr Stebbing suggested that it might have been possible to arrange a date for the hearing before the end of the rule 34 period had it not been for the lack of availability of both the Hearing Officer and the examiner. This decision therefore deals with whether the Comptroller has power to extend the rule 34 period in such circumstances.

- 5 Shortly before the hearing, Mr Stebbing submitted a set of amended claims which I agreed to consider alongside those currently on file.

The application

- 6 The application relates to a system for monitoring and updating delivery schedules based on real-time feedback of completed deliveries and modifications made by customers.
- 7 Before a scheduled delivery, the system notifies a customer of the estimated delivery time at a particular location. The customer is able to access the system, e.g. via the Internet, so as to modify the delivery time to one that is more convenient. The customer is also able to modify the delivery location, the system being able to re-calculate a delivery charge and to amend the estimated delivery time on the basis of such a modification. The system creates a delivery schedule to be followed by a delivery person. Once a delivery has been completed, the delivery person enters the actual delivery time into the system, and the system re-calculates the estimated delivery times of the remaining deliveries.
- 8 The system allows for real-time update of delivery schedules to reflect the actual time it takes to complete a delivery to a particular location and to take account of any changes requested by the customer. The application acknowledges that it is well known to track the progress of parcels in a mail delivery system and to automatically schedule deliveries on the basis of zip codes. The application suggests that a disadvantage of the prior art is that delivery services remain inconvenient to the customer because of the lack of information provided regarding estimated delivery time. A further disadvantage is the inability to amend delivery time and location once the delivery schedule has been prepared.
- 9 The amended claims submitted shortly before the hearing contain four independent claims, claims 1, 8, 13 and 14. Claim 1 is directed to an information exchange system used to manage the delivery of goods as broadly described above:

“1. An information exchange system used to manage the delivery of goods, the system comprising:

a delivery scheduling computer for automatically generating and updating real-time delivery schedule information, transmitting the information to a delivery employee, and delivering a selected portion of the information including an estimated delivery time to a remote customer;

a user computer accessible to the remote customer for receiving the selected portion of the delivery schedule information and transmitting a delivery change request to the delivery scheduling computer;

an employee computer accessible to the delivery employee for receiving the real-time delivery schedule information from the delivery scheduling computer;

a network linking the delivery scheduling computer to the user computer and the employee computer; and

a set of user application modules associated with the delivery scheduling computer and user computer for allowing the customer to view the selected portion of the delivery schedule information and enter the delivery change request;

the delivery scheduling computer being responsive to the delivery change request to update the delivery schedule information and automatically recompute a delivery sequence based on the updated delivery schedule;

the system further comprising transmitting means for transmitting the updated delivery schedule information including the recomputed delivery sequence to the employee computer, for enabling the delivery employee to deliver the goods according to the recomputed delivery sequence;

the delivery scheduling computer being further responsive to a delivery completion message transmitted from the employee computer upon completion of a scheduled delivery, the delivery completion message including an actual delivery time, to update the estimated delivery times of remaining deliveries based on the actual delivery time, and said transmitting means being arranged to transmit back to the employee computer modified schedule information including the updated estimated delivery times.”

- 10 Claims 8, 13 and 14 are sufficiently similar in scope to claim 1 that I do not need to quote them in full. All four independent claims define a central computer system linked to both customer and delivery employee, the computer system being able to create a revised delivery schedule based on changes made by the customer and information provided by the delivery employee. The computer system is able to transmit the revised delivery schedule to the delivery employee in real-time.

The law

- 11 The examiner has maintained that the claimed invention relates to subject matter excluded from patentability under section 1(2) of the Act, in particular to a scheme, rule or method for performing a mental act or doing business and/or a program for a computer under section 1(2)(c). 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.

12 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

13 It has been established by the Courts that an invention will not be excluded from patentability by the above subsection if it makes a technical contribution, e.g. *Fujitsu Limited's Application* [1997] RPC 608 at page 614. The principles to be applied under UK law in deciding whether an invention makes a technical contribution 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>. For the purpose of this decision, I consider it necessary only to restate the principles I have applied and not their origin.

14 First, it is the substance of the invention which is important rather than the form of claims adopted. Second, whether an invention makes a technical contribution is an issue to be decided on the facts of the individual case. Third, 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.

15 At the hearing, Mr Stebbing referred me to the Hearing Officer's decision in *Franks' Application* (BL/027/05) in which these exact same principles were applied and which, he believes, sets out the state of play in a fairly clear way.

16 In deciding whether the present invention is excluded from patentability, I shall consider two specific questions:

- does the invention relate to an excluded category? If yes,
- does the invention make a technical contribution?

17 Mr Stebbing agreed that this was the correct approach to follow.

Argument

18 Mr Stebbing did not address me directly on the first question of whether the invention relates to an excluded category. Instead, he took me straight to the question of whether the invention makes a technical contribution, suggesting that there was no need to answer the first question if the second question could be answered in the positive. In doing so, Mr Stebbing was not in any way suggesting that he considered the invention falls within an excluded category, merely that he considered it difficult to separate the two questions in light of the invention. It should also be said that the examiner had difficulty in identifying any particular category of exclusion caught by the invention, but was of the opinion that it had elements of one if not all of a business method, a computer program and a mental act.

- 19 Dealing first with the question of whether the invention relates to an excluded category, there is little doubt that the application relates to a computer system for creating delivery schedules on the basis of information provided to it by customers and delivery personnel. This information can be the preferred time and location for a delivery provided by a customer or the actual time of delivery provided by a delivery person. The claims outline in functional terms the hardware components of a networked scheduling system and also the processing steps involved in the exchange of information. Regardless of the form of the claims, it is clear to me that the substance of the invention is a scheduling system that acts on specific information to create and update delivery schedules in such a way that improves the efficiency and convenience of a delivery service. Although the invention requires a suitably programmed networked computer for its implementation, the advance that the invention seeks to make is in the business of delivering parcels. Indeed, despite the obvious advantages that a networked computer brings to the invention, it is the use of amended delivery information provided by the customer and the actual delivery time information provided by the delivery person that enables an amended delivery schedule to be produced. The examiner has argued that the exercise of processing the additional information to derive an amended delivery schedule could be regarded as a mental act. That may well be the case, but I consider that the invention goes beyond mere processing of information; there is also the step of gathering the relevant information in the first place. In view of this, I have no doubt that the invention falls within the exclusion of section 1(2)(c), both as a method of doing business and as a computer program for its implementation.
- 20 Turning to the question of whether the invention makes a technical contribution, Mr Stebbing referred me to three decisions of the EPO Boards of Appeal as providing guidance on what is regarded as making a technical contribution. In the first of these, *Wabco* (T362/90), the Board of Appeal held that a gear lever which not only indicates the currently engaged gear but also the best gear to engage at any time was patentable, despite having some features which could be regarded as being mere presentation of information. The claim contained very little by way of technical features, but the invention was still regarded as making a technical contribution. The Board of Appeal justified their conclusion by referring to an earlier decision, namely that of *IBM* (T115/85), where it was held that giving visual indications automatically about conditions prevailing in an apparatus or system is basically a technical problem. Even if the basic idea underlying an invention may be considered to reside in a computer program, a claim directed to its use in the solution of a technical problem cannot be regarded as seeking protection for the program as such. Finally, in the Board of Appeal's decision in *Kearney* (T042/87), it was decided that giving visual indications about conditions prevailing in a machine tool that required manual intervention was basically a technical problem.
- 21 Mr Stebbing proceeded to draw an analogy with the present invention. Very briefly, the delivery person can be regarded as the human operator of a delivery vehicle, and the scheduling system provides indirect instructions on how to operate the vehicle in relation to where to drive it and at what speed it should be driven. This, Mr Stebbing argued, represents a solution to a technical problem, which the Boards of Appeal have held as making a technical contribution. Mr Stebbing argued that the technical problem addressed by the present invention is how to guide the operator of a machine, namely the driver of a delivery

vehicle, to operate his vehicle according to desired conditions, namely to meet a delivery sequence.

- 22 First of all, I should point out that the application makes no specific mention of the employee completing his deliveries by vehicle, and the only indirect instructions disclosed in the application that Mr Stebbing can be referring to are the location of the delivery and the time by which that delivery needs to be made. These, quite clearly, cannot be regarded as instructions on how to operate a machine more effectively or more efficiently as is the case in *Wabco*, *IBM* and *Kearney*, because they could equally apply to an employee delivering parcels on foot. In the same way that a map would not provide a technical solution in directing a person to a particular destination, neither can the delivery schedule be regarded as such. In my opinion, the only problem that the present invention seeks to overcome is that of updating delivery schedules based on changing conditions, a problem that arises because of ineffective use of information rather than any technical difficulty. The solution to this problem is provided by way of conventional computer hardware programmed by conventional techniques, which seems to me provides nothing by way of a technical contribution.
- 23 Having reviewed the amended claims filed shortly before the hearing, the claims as filed during processing of the application and also the application as filed, I am unable to find any basis for a valid claim making a technical contribution.

Comptroller's power to extend

- 24 As mentioned earlier, the agent asked whether it would be possible to extend the rule 34 period under the Comptroller's power to alter a time period due to an irregularity which is attributable wholly or in part to an error, default or omission on the part of the Patent Office, i.e. under rule 100. The agent argued that it might have been possible to arrange a date for the hearing before the end of the rule 34 period had it not been for the lack of availability of both the Hearing Officer and the examiner. On the face of it, I do not think that the lack of availability of both the Hearing Office and the examiner can be regarded as an error, default or omission on the part of the Office. This is something that regularly happens in large organizations and especially so around periods of national holiday, as in the present case. However, there remains the argument that the Office could have resolved the position regarding the hearing a lot sooner than it did, thereby reducing the chance of key personnel being unavailable to attend. Having reviewed the correspondence on file, it appears that the examiner suggested that the matter of patentability should proceed to hearing in a letter dated 16th February 2005, some seven weeks before the end of the rule 34 period. In his letter, the examiner recognized the urgency of the case and asked the agent to contact him personally in order to make the necessary arrangements. The agent requested a hearing in a letter dated 14th March 2005, two days before the latest date for reply set by the examiner, and some three weeks before the end of the rule 34 period.
- 25 The fact that a hearing was not offered until so late in the life of the patent is not unusual, nor is the fact that the agent agreed to a hearing so close to the end of the reply period set by the examiner. In most circumstances, it would be possible to arrange a convenient date at such short notice, but, in this instance, it proved impossible. I do not consider that the Office has erred in any way in not offering a hearing sooner than it did; it seems to me that both the

examiner and the agent gave full and timely consideration of each other's arguments at every stage, and that the process of argument and rebuttal came to a natural conclusion in February 2005. From then on, the Office was then in the hands of the agent, who was aware of the need to resolve the date of hearing as soon as possible but had no knowledge of the leave commitments of the Hearing Officer and the examiner. Given only three weeks to arrange a hearing, it is not surprising that the Office could not find a suitable date, although, as I have mentioned earlier, it is usually possible to schedule a hearing at such short notice.

- 26 In view of these circumstances, I do not consider that the Comptroller has power under rule 100 to extend the period for putting the application in order. It should be noted that the applicant can still request to extend this period by two months under rule 110(3) by filing a form 52/77, provided that he does so before 5th June 2005.

Conclusion

- 27 I have found that the invention as claimed in the application fails to provide any technical contribution and that it is therefore excluded from patentability as a method of doing business and a computer program under section 1(2)(c) of the Act. I have found this to be the case for the invention as set out in the claims on file and those submitted shortly before the hearing. Having also found that there is no prospect of any amendment which would result in an allowable claim, I accordingly refuse the application under section 18(3).

Appeal

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

H JONES

Deputy Director acting for the Comptroller