BL O/205/05

20 July 2005

PATENTS ACT 1977

APPLICANT Resource Partners Group Limited

ISSUE Whether patent application number GB 0020493.3 is excluded under section 1(2)(c)

HEARING OFFICER A Bartlett

DECISION

Introduction

1. Patent application no. GB0020493.3 entitled "System for controlling prescription and dispensing of medical products" was filed on 18 August 2000 in the names of Resource Partners Group Limited. The application was published on 26 June 2002 as GB2370377.

2. In the course of various rounds of substantive examination, the examiner reported that the invention related to excluded matter, that it did not meet the requirements of novelty and inventive step, that the claims did not relate to a single invention and various other more minor issues. All the issues other than the excluded matter objection were satisfactorily resolved by amendments filed by the applicant, the latest amendments to the claims being those filed with the agent's letter of 2 Feb 2005. However, the examiner remained of the opinion that the invention was excluded from patentability and offered the applicant a hearing to decide that issue.

3. In the event, the applicant decided not to attend the hearing and instead requested that the issue be decided on the papers. To assist me in making my decision, the applicants filed a skeleton argument via their representative, Mr Michael J Butler of the Patent Attorneys Frank B Dehn & Co for which I am extremely grateful.

4. In that skeleton, Mr Butler requested that I consider various different claims. More specifically he requested that I consider claim 1 as currently on file, the combination of claim 1 and 2 as currently on file and a supplementary version of claim 1 incorporating the features of claims 1,2 and 3 as currently on file. In making that request Mr Butler was not correct in stating that the claims as presently on file were filed with his letter of 20 December 2004. The latest form of claims on file was actually filed with his letter dated 3 February 2005 and includes the feature in claim 1 that "the prescription data is supplied to a dispensing site *and to the managing site*" (my emphasis). For the avoidance of doubt it is the 3 February wording that I have taken as the basis for the three versions of claim 1 that I have been asked to consider. In doing that I note that

the supplementary claim (ie version 3) filed with the skeleton argument is based on that wording.

The Application

5. The application concerns a system for managing the prescribing of medical items by a prescribing practitioner (doctor) and the dispensing of said medical item by dispensing practitioners (pharmacy).

6. The system comprises a central managing site having a master database containing information regarding the medical items. The doctor is able to select an item from the database and generate a prescription with item data, patient data and doctor data thereon. This prescription data is supplied to the central site and to the pharmacy. The pharmacist is then able to dispense the item or look up an alternative (endorsement) in the master database. Data on the item actually dispensed is then sent to the central site where it may be analysed (e.g. compared to prescribed item data). Further aspects of the system include the generation of a paper prescription form having human and machine readable information and the machine readable information being in the form of an array of dots.

7. The invention therefore enables the pharmacist to replace the prescribed drug with a generic alternative without consulting the doctor. Further it allows for the collection of data on prescribed drugs as well as the dispensed drugs thus apparently saving time for all parties in the prescription management process.

The Claims

8. The three forms of claim I have been asked to consider are as follows:

Claim 1 as filed with the Agent's letter dated 3 February 2005:

> A system for managing the prescribing of medical items by prescribing practitioners and the dispensing of prescribed medical items by dispensing practitioners, wherein: prescribing practitioners, dispensing practitioners and a managing site are provided with access to a master database on data processing means, the master database containing entries for medical items available for prescription, the entry for a medical item in the master database including a unique identifier for the item and containing fields for identifying the medical product concerned, and the form in which the product is to be supplied; wherein a prescribing practitioner selects an item for a patient from the master database using data processing means, and prescription data is generated comprising at least the identifier for the item, a patient identifier and a prescribing practitioner identifier; the prescription data is supplied to a dispensing site and to the managing site, the data is analysed by data processing means at the dispensing site, and the prescribed item or an endorsement is dispensed; dispensed prescription data is generated comprising at least the identifier for the item dispensed, the patient identifier, the prescribing practitioner identifier and a dispensing practitioner identifier; and the dispensed prescription data is transmitted to the managing site for analysis;

and wherein the master database contains details of the permitted endorsements, these details being assessed by the data processing means at the dispensing site in the event that an endorsement is required in place of the item prescribed.

Claim 2 as filed with that letter, ie as above but with the following additional requirement:

> …and wherein a prescription form is printed which carries human readable information concerning the prescribing practitioner, the patient, and a prescribed item; and wherein the prescription form further carries machine readable encoded information which comprises the identifier for the item, the patient identifier and the prescribing practitioner identifier; the encoded information on the prescription form is decoded at a dispensing site; and the prescribed article is identified by comparing the identifier for the prescribed article with details in the master database.

The supplementary claim filed with the skeleton argument on 7 April 2005, ie claim 1 as above but with the following additional requirement:

> …and wherein a prescription form is printed which carries human readable information concerning the prescribing practitioner, the patient, and a prescribed item; and wherein the prescription form further carries machine readable information in the form of an array of dots in which is encoded at least the identifier for the item, the patient identifier and the prescribing practitioner identifier; the encoded information on the prescription form is decoded at a dispensing site; and the prescribed article is identified by comparing the identifier for the prescribed article with details in the master database.

The Law

9. 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. 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."

Interpretation

10. As Mr Butler acknowledged in his skeleton argument, there is currently something of a difference in approach to assessing patentability between the most recent practice of the Boards of Appeal of the European Patent Office[1] and the British Courts. As a consequence of Section 130(7) of the Act, the excluded matter provisions in the UK Act should have the same effect as their corresponding sections in the EPC. This means that the Comptroller must pay due regard to the decisions of the Boards of Appeal of the EPO in deciding whether an invention is patentable. He is not though bound to follow them. On the other hand, the Comptroller is clearly bound by the judgments of the UK courts. I am in no doubt therefore that where there is a divergence between the judgments of the UK Courts and the EPO Boards of Appeal, I must follow the UK Courts.

11. Mr Butler was apparently content for me to follow the UK approach. Indeed in his skeleton argument he was at pains to stress that in following that approach I should ensure that I kept the excluded matter test separate from issues of novelty and inventive step. That I have done.

12. As for the practical effect of that difference in approach, the Comptroller's Hearing Officer found in *Outersonic*[2] that the apparent difference in approach is somewhat academic. 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[3]. That is to say if it makes a technical contribution it cannot be regarded as relating to an excluded item "***as such***". According to the most recent EPO case law the existence of a technical contribution is assessed as part of the inventive step test. Thus the existence of a technical contribution is the decisive factor in both the EPO's and UK Courts' approach. If there is no technical contribution, then an application will fail under either approach. Thus it is something of a semantic issue whether it is refused as not being an invention for the purposes of patent law (as in the UK approach) or as not providing an inventive step once all the non-technical features have been notionally excised (as in the current EPO approach).

13. Bound as I am to follow judgments of the UK courts, I shall assess technical contribution as part of the excluded matter provisions. Having adopted that approach it is logical for me to first consider whether the invention falls within the excluded categories. If I find that it does I will also need to consider whether it makes a technical contribution. Only if the answers to those two questions are "yes" and "no" respectively will the invention be excluded.

14. In applying those tests I will follow the long established principle adopted by the UK courts that it is the substance of the invention that is significant, not the precise form of wording adopted in the claims.

15. The invention concerns the management of the processes of prescribing and dispensing medical items. To my mind that is a method of doing business and hence the invention is potentially excluded under section 1(2)(c). Furthermore, I am in no doubt after

---

[1] As exemplified in decision T258/03 Auction method/Hitachi)
[2] Outersonic Limited's Application BL O/273/04
[3] *Fujitsu Limited's Application* [1997] RPC 14 at page 614.

reading the specification that the invention is implemented in software and is therefore also potentially excluded as a program for a computer under the same subsection. That though is not the end of the matter for, as I have explained above an otherwise excluded item is patentable if it makes a technical contribution. I therefore now have to consider whether the invention makes such a contribution.

16. In making that assessment I shall make specific reference to the 3 versions of claim 1 as requested by the Agent.

17. Claim 1 as filed with the Agent's letter of 3 February defines a system for managing the prescribing and dispensing process using a network of computers. In his skeleton, Mr Butler identified "the architecture which enables prescriptions to be issued, endorsements to be made and items to be dispensed, whilst the management site receives information not only as regards what has been prescribed but also of what has been dispensed" as providing the technical contribution. This arrangement, he said, was not conventional.

18. I do not agree that this provides the required technical contribution. For its implementation, the invention of claim 1 undoubtedly uses technical means, namely computers and communication equipment. However, as the Court of Appeal made clear in *Fujitsu,* the mere presence of technical elements in a claim is not sufficient for an invention to make a technical contribution. Having read the specification in its entirety I can find nothing to suggest that the hardware through which the invention is implemented is anything other that conventional. Any novelty it seems to me results from what that hardware is programmed to do. The functionality provided is the ability to generate endorsements of prescribed items and to centrally collect information on the items prescribed and actually dispensed. As I have already stated above that is a business process. It may well be a novel business method, but I fail to see how this new business process when implemented on conventional hardware gives rise to a technical contribution. To find otherwise would render any new business process implemented via a computer system patentable. That would drive a coach and horses through the exclusions and render them virtually meaningless.

19. Whilst the invention may well provide a new tool for administering such a process I can see nothing in the way it is implemented or in any technical problem which it seeks to solve that could provide the required technical contribution. In reaching that conclusion I note what the application as originally filed said was the current state of play regarding the generation and dispensing of prescriptions and the drawbacks with such systems. The existing systems were described as using a mixture of paper and computing resources. The management of such a system involved bundling up used prescriptions (and any endorsements marked on them) to be dispatched to a central point for them to be reviewed for example to allow pharmacists to be paid for the items dispensed. The advantages provided by automating such a system are clear and unmistakable but to my mind they are precisely the benefits you would expect to achieve by using a network of computers to administer such a process. And as the Court of Appeal said in *Fujitsu*, achieving such benefits by computerisation does not of itself provide a technical contribution.

20. In short I can see nothing in claim 1 as filed with the Agent's letter dated 3 February 2005 which could be said to provide a technical contribution.

21. The second version of claim I shall consider is claim 2 as filed with the Agent's letter of 3 February. This includes the additional requirement that a hard copy of the prescription form is printed out carrying data in human and machine readable formats. Furthermore, it goes on to specify the data that is carried in those formats, namely an identifier for the prescribed item, the identity of the person who issued the prescription and the name of the patient. Finally it states that the machine readable data is decoded at the dispensing site so that the dispensed item can be identified by reference to the main database.

22. This is something of an unusual claim. On the one hand, claim 1 to which it is dependant specifies that the prescription data is transmitted directly from the doctor's computer to the pharmacist's. Given that, the printed prescription seems to be redundant. However, it is possible to envisage situations where the printed prescription would still be useful for example if part of the computer network was down at a given time. If you like, the printed prescription provides a back up option.

23. In his skeleton, Mr Butler pursued a persuasive line of argument as to the difference between the documentation necessary to destroy novelty and that needed to show that something was conventional. To destroy novelty he said, any disclosure (including a single disclosure in a patent document) was sufficient. On the other hand, disclosure in one or even a handful of patent documents was not sufficient evidence to prove that something was conventional. That he said was dependant on what was actually in use. I accept that entirely.

24. His reason for arguing that becomes readily apparent when you consider the documents cited by the examiner during prosecution of the application. The search only revealed one disclosure of a prescription carrying human and machine readable data, the machine readable data being in the form of a bar code. In his final examination report the examiner did not pursue this citation for novelty or inventive step purposes because the system of claim 1 appears to be novel (if excluded). Thus in Mr Butler's view I do not have sufficient evidence before me upon which to find that the printed prescription (with machine readable data) is conventional and the invention of the second version of claim 1 to be excluded.

25. On the face of it there is some attraction in that argument. However on closer consideration I think it is ultimately flawed. It relies on the premise that in assessing what is conventional with regard to the present invention I should only consider printed prescriptions. In my opinion, doing that would be to take an unduly narrow approach. I am in no doubt whatsoever from my own personal knowledge that it was entirely conventional at the claimed priority date for printed documents to carry data in both human and machine readable formats – bank cheques and passports being examples that spring immediately to mind. From the documentary evidence provided by the examiner it providing prescription data in both these formats was also clearly in the public domain. In light of that I can see nothing in the specification that points to the provision of a printed prescription carrying precisely the data you would expect it to carry in these two formats that could provide a technical contribution.

26. As for the final (supplementary) version of claim 1 which I have been asked to consider, that corresponds to the second version but with the additional requirement that the machine readable data is in the form of an array of dots. According to the description, the preferred format for this array would be as a "Snowflake" which the application acknowledges is a registered trademark. In describing the invention, the applicant has not considered it necessary to provide any level of detail as to how the required data would need to be encoded into such a format. In view of that, for the application to be sufficient in respect of this feature, I can only conclude that such an encoding technique is itself entirely conventional. I can see nothing in the third version of claim 1 that could add a technical contribution to the substance of version 1.

Conclusion

27. I have found the invention defined in the various versions of claim 1 to fall within the business method and computer program exclusions and moreover that they relate to those excluded items as such since they make no technical contribution. What is more I have been unable to identify anything in the specification which could form the basis for a patentable invention. I therefore refuse the application under section 18(3) as being excluded by section 1(2)(c).

Appeal

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

A BARTLETT
Deputy Director acting for the Comptroller.