



BL O/307/06

26 October 2006

PATENTS ACT 1977

APPLICANT	Rok Corporation Limited
ISSUE	Whether patent application number GB 0315289.9 relates to excluded subject matter
HEARING OFFICER	A Bartlett

DECISION

Introduction

- 1 This decision concerns whether patent application GB 0315289.9 entitled "Gaming system with remote user interface" relates to excluded subject matter.
- 2 Throughout the examination process the examiner has consistently reported that the invention is not patentable on the ground that it was excluded as relating to a method of doing business, a method of playing a game and or a program for a computer, all of which are explicit exclusions in section 1(2). The examiner deferred consideration of novelty and inventive step after the initial examination report pending resolution of what he saw as the more fundamental excluded matter issue.
- 3 Despite numerous rounds of correspondence, the examiner and Applicants have been unable to reach agreement as to the patentability of the invention. The Applicants declined the opportunity to attend a hearing on the issue and asked instead for a decision to be issued on the basis of the papers on file, all of which have been submitted through their Patent Attorney Mr Stuart Geary of Venner Shipley.

The invention

- 4 The invention is best illustrated with reference to the specific embodiment described. According to that embodiment, the invention relates to a system allowing a user to play a computerised version of a game (eg a fruit machine game) on a mobile telephone or similar device. At the user's request, outcomes of the game are generated at a central server and downloaded to the client's device. Upon a further request from the user to play the game, the outcomes are displayed on the user's device e.g. as a computer simulation of the reels of the fruit machine.

- 5 The claims I must consider were filed on 22 June 2005. They number 7 in total with claim 1 being the only independent claim. It reads:

A gaming system comprising:
a portable client including display means; and
a server remote from the client;

wherein the client is configured for sending a play request message to the remote server via a mobile communication network, receiving a play outcome value, provided by the server in response to said play request message, via a mobile communication network and responding to a user input, after receiving the play outcome value, to generate an image at the client in dependence on the received play outcome while no communication or session is in operation between the client and the server, the server is configured for responding to the play request message by generating a play outcome value and transmitting the random play outcome value to the client.

- 6 Relating as they do to a gaming system, and being apparently embodied in software (though this was the matter of some debate in the correspondence as we shall see below), it is easy to see why the examiner was prompted to consider the issue of the excluded categories defined in section 1(2).

The Law

- 7 The examiner has consistently reported that the invention is excluded from patentability under section 1(2)(c) of the Act. 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.”

- 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 that have been issued under this Article in deciding whether the invention is patentable although I am not bound to follow them.

Interpretation

- 9 My approach to interpreting section 1(2) will be governed by the judgment of Peter Prescott QC sitting as Deputy Judge in *CFPH*¹ and the Practice Notice that was issued thereafter (29 July 2005). In that judgment, a two-stage test was advocated at paragraph 95 which can be summarised as:
- (1) Identify what is the advance in the art that is said to be new and not obvious (and susceptible of industrial application) and
 - (2) Determine whether it is both new and not obvious (and susceptible of industrial application) under the description “an invention” in the sense of Article 52 of the European Patent Convention – broadly corresponding to section 1 of the Patent Act 1977.
- 10 This test was restated by Pumfrey J in his judgment in *RIM*² where he said:
- “It is now settled, at least at this level, that the right approach to the exclusions can be stated as follows. Taking the claims correctly construed, what does the claimed invention contribute to the art outside excluded subject matter? The test is a case-by-case test, and little or no benefit is to be gained by drawing analogies with other cases decided on different facts in relation to different inventions.”

Construing the claim

- 11 It is a well established principle of UK patent law that the exclusions are not avoided merely by including elements of hardware in the claims³. To do so would be to extol form over substance. Thus the fact that the claims before me are drafted in terms of a gaming system comprising various elements of computer hardware does not mean the invention is patentable. On the contrary there is no suggestion anywhere in the specification that the hardware by which the invention is put into practice is anything other than conventional. In my view any advance or contribution that the invention makes resides in what that hardware is programmed to do.
- 12 Having argued vigorously in his earlier responses that the invention defined in the claims was not limited to implementation via a computer program, Mr Geary did accept in his letter of 22 June 2005 that it inevitably would be given that that was “the modern way”.
- 13 I am grateful to him for that concession although I do not think it particularly important. In my view any person reading the specification with a view to working the invention would realise that the invention would for all intents and purposes be implemented via a computer program. Thus in light of the

1 *CFPH LLC's Application* [2006] RPC 5

2 *Research in Motion vs Inpro Licensing SARL* [2006] EWHC 70 (Pat)

3 See for example *Gale's Application* [1991] RPC 325

description I interpret the claim as relating in substance to a computer program and thus the invention potentially falls foul of the computer program exclusion. Even if not solely limited thereto, the claims certainly encompass implementation via a program which of itself is sufficient for them to potentially fall foul of that exclusion.

- 14 What I must now do is decide whether the invention makes a patentable advance so that it is not a computer program *as such*.

The advance

- 15 During the various rounds of examination and amendment, the Applicants have amended the claims such that in their view the claims relate to patentable subject matter. Their supporting arguments are encapsulated in Mr Geary's letter of 22 June 2005 which I will come to in a moment. In that letter Mr Geary helpfully brought to the examiner's attention several pieces of relevant prior art which had not previously been considered. Amongst these was US-A-2003/064805 ('805 here after) which Mr Geary suggests (and I agree) was the closest prior art to the present invention.

- 16 '805 describes a system wherein a wireless client device may be used to play games which rely on 'game outcomes' generated by a central licensed gaming machine (acting as a server) and not on the portable client itself, the results being displayed on the client device as in the present invention.

- 17 In Mr Geary's view there is no suggestion in '805 that the 'game outcomes' generated by the central device are stored at the client for later use, rather they appear to be acted on immediately they are received (steps 610-625 in figure 6). I do not think the position is quite so clear cut as that. In particular, at paragraph [0099] it is stated that:

"In general, during a wireless game play session, the gaming machine communicates continuously with the wireless game player."

- 18 As I read it, that paragraph does not rule out the possibility that the user device and the central devices do not need to be in continuous communication during the game play process. I accept however that there is no clear disclosure of such and I therefore accept that in this respect the invention defined in present claim 1 is distinguished over the disclosure of '805.

- 19 Mr Geary discussed the advance made by the invention in the following terms:

"According to the present invention, the client device is configured to respond to user inputs to start distinct game request and game 'play' events. In the game request event, the client requests games from the server and the server determines game outcomes, which are communicated back to the client device. Subsequently, in the game 'play' event, the client responds to a user input to generate a display which mimics a game taking place, e.g. fruit machine reels spinning, before settling on a display determined by a game outcome previously

received from the server device. Thus, unlike in the prior art, the client device does not need to be in communication with the server during game 'play'. “

- 20 I am content to use this as the basis for the advance made by the invention which I shall summarise as the separation of the game request and game play steps such that the client and server devices do not need to be in communication during the game play process. This is entirely consistent with what Mr Geary identified as the advantages offered by the invention, namely that by removing the need for continuous communication between client and server the system gives the user more flexibility in that it can be used when communications coverage is limited e.g. when the user is travelling on an underground train.
- 21 Having identified that as the advance, what I must now do is decide whether that is both new and inventive under the description “an invention” in the sense of Article 52 EPC, or (using the formulation of the test from *RIM*) whether the invention leads to any contribution in a non-excluded field.
- 22 In Mr Geary’s view the fact that the invention is inevitably implemented as a computer program does not mean that it is excluded from being patentable. He said the result “achieved by the present invention is clearly of a technical character in the way in which the client becomes much more independent of the server without compromising security.”
- 23 I agree with Mr Geary that loss of reception between mobile devices and a central server is a technical problem. That an invention is directed to solving such a problem does not however mean that it is necessarily patentable. It seems to me that what the Applicants have done is change the way that the game is played by separating in time the generation of outcomes of the game with their display on the user’s device. Whilst I can see clear advantages in doing that - for example to avoid reception problems - to my mind this is not achieved in the present case through any technical solution as would have been the case say if the client device included an improved antenna. Rather, it is achieved by separating the request and display processes.
- 24 To my mind that is on all fours with the EPO Board of Appeal decision in *Hitachi*⁴. That case concerned a Dutch auction conducted online where problems of delays in the transmission of bids were avoided by requiring participants to submit desired price and maximum bids in advance. In that case the Board decided that the technical problem was circumvented by modifying the rules of the auction rather than being solved by technical means and that those modifications could not contribute to the technical character of the subject matter claimed. In my view the solution provided by the present invention – separating the request and display steps - is likewise a circumvention of the connection problem rather than being achieved through technical means. The difficulty of maintaining communication between the server and remote client devices remains.

4 Hitachi T0258/03

- 25 In his various letters, Mr Geary argued that *Hitachi* was not applicable to deciding the present case because the Board's reasoning was expressed in assessing inventive step rather than whether the invention related to excluded subject matter. Whilst Mr Geary is right that the circumvention reasoning was developed when considering inventive step, I do not agree that it is not applicable to the present consideration. The Board concluded that only those features that contribute to a technical character are to be taken into account when assessing inventive step. In deciding that the adapted auction method could not be taken into account in that assessment, the Board made it clear that the circumvention solution did not provide a contribution in a non-excluded area. To my mind it follows that the Board's argument regarding a solution that circumvents a technical problem (rather than solving it by technical means) is applicable to deciding whether an invention relates to excluded or non-excluded subject matter.
- 26 In reaching that conclusion I am reassured by the fact that in his judgment in *CFPH*, Deputy Judge Prescott also applied the "circumvention" reasoning in deciding that the *CFPH* inventions were not patentable. More particularly, at paragraph 118 of that judgment, and after specifically considering the Hearing Officer's finding that the inventions circumvented the technical problem rather solving it by technical means, Peter Prescott QC decided that the invention in *CFPH* solved the technical problem of lack of bandwidth via a business fix and was thus unpatentable. That *Hitachi* was refused as lacking an inventive step clearly did not affect his view as to the applicability of the "circumvention" reasoning when deciding whether an invention related to excluded subject matter.
- 27 As for Mr Geary's "technical character" argument, whilst I would agree that the invention has "technical character" by virtue of it being implemented via software and using computer and communication hardware, the UK courts have (as I have indicated above) made it abundantly clear that that is not sufficient for the exclusions to be avoided under UK law.
- 28 As I see it, the separation of the request and display steps is an advance in the administration of the game play process in a remote game play system. In the embodiment described this is implemented as a computer program. To use the terminology of *CFPH*, the advance lies within the software used, making the client unit more flexible by adding the function of optionally delaying the game play until initiated by the user. While this advance may be beneficial to the user, it is a matter of design choice and does not actually lead to any of the devices involved functioning differently on a technical level. Thus I do not consider the invention provides an advance that is new and not obvious (and susceptible of industrial application) under the description "an invention" in the sense of Article 52 of the European Patent Convention.
- 29 To use the formulation from *RIM*, the invention does not contribute any advance outside of the excluded field of computer software.
- 30 The examiner also reported that the invention is excluded as a scheme, rule or

method for playing a game or doing business. The claims are clearly directed to a gaming system and set out a change in the way a user plays the game – by requesting the central server to generate multiple results at one time so that they can be played back later. On one level that could be viewed as a change to the scheme rule or method for playing the game. Similarly it is clear that the gaming system could involve payments and rewards as part of an electronic betting system and could thus be viewed as a method of doing business whereby the user buys a certain number of plays in advance, with the results being stored locally for him to playback later.

- 31 Having already found it to be excluded as a program for a computer as such I do not consider it necessary to decide whether it also falls foul of the business method and games exclusions. However I will say that in light of the judgment in *Macrossan*⁵ where Mann J concluded (at paragraph 30) that the business method exclusion “is aimed more at the underlying abstraction of business method” rather than a tool or activity which might be used in a business activity, it is certainly arguable that the present invention is more akin to a tool for use in a business activity rather than a business method as such. Thus the invention may well not fall within that particular exclusion as interpreted by Mann J.

Conclusion

- 32 I have found that in substance the invention is a program for a computer. Moreover, having been unable to identify any non-excluded advance made by it, I consider the invention defined in the claims to be excluded as a program for a computer as such.
- 33 Having read the specification carefully I can see no possible amendment that could form the basis of a patentable invention. Following the Board of Appeal’s decision in *IBM*⁶ a claim to the invention embodied in hardware might well be subject to precisely the same fate as one embodied in software. There is however no disclosure of such an implementation and I do not need to consider that point further.
- 34 I therefore refuse the application as relating to a program for a computer as such which is excluded under section 1(2).
- 35 I do not consider it necessary to decide whether the invention is actually novel and inventive although I would say that the various amendments made do appear to distinguish the invention presently claimed over the prior art considered to date.

Appeal

⁵ *Macrossan’s Application* [2006] EWHC 705 (Ch)
⁶ *IBM T22/85*

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

A Bartlett

Deputy Director acting for the Comptroller