

PATENTS ACT 1977

APPLICANT Translution Holdings plc

ISSUE Whether patent application number GB
0508494.2 complies with section 1(2)

HEARING OFFICER Mrs S E Chalmers

DECISION

Introduction

- 1 Application number GB 0508494.2 (International application number PCT/GB2003/004726) was filed on 4 November 2003, claiming priority from an earlier GB application dated 6 November 2003, and republished under serial no. GB 2410107 A on 20 July 2005. An examination report was issued on 28 September 2005, and rounds of correspondence followed between the examiner and the applicant's agents.
- 2 The examiner has maintained throughout an objection that the invention claimed in this application is excluded from patentability as a computer program under s1(2) of the Patents Act 1977, which the applicant has not been able to overcome despite amendment of the claims.
- 3 A hearing was arranged but the agents wrote on 11 June 2007 filing further arguments and saying the applicant no longer wished to be heard and wanted a decision on the papers. This decision covers only the question of excluded matter, leaving other questions to further processing of the application, if appropriate.
- 4 The correspondence between the examiner and the applicant's agent during the prosecution of the application was based on the law as it then stood in the light of case law. However on 27 October 2006, the Court of Appeal handed down its judgment in the matter of *Aerotel Ltd v Telco Holdings Ltd and Macrossan's Application* [2006] EWCA Civ 1371 ("*Aerotel/Macrossan*") setting out a new test for patentability, as outlined below. The examiner therefore wrote to the applicant in a letter dated 18 April 2007 re-assessing the application in the light of this new test and indicating that he still believed the claimed invention to be excluded.

The Invention

- 5 The invention concerns a communications system for the automatic translation of electronically transmitted messages eg via email. Messages sent may be directed to a translation system to translate the message into the language of the intended recipient, before being forwarded to the recipient. Similarly messages received may be directed to a translation system if the sent message is in a language different to that of the recipient. After translation, the message is forwarded to the recipient. Hence both incoming and outgoing messages can be sent for translation. The sending and receiving system can reside on the same system and be associated with the same user thus facilitating communication between users on the same system and with other users who do not have the associated translation technology of the invention.
- 6 There is a single independent, non-omnibus claim, claim 1, which reads as follows:

A communication system for a human communication comprising a sending system arranged to send a communication from a sender, a receiving system arranged to receive a communication from a recipient, and a translation system, wherein the sending system is arranged, when sending a communication, to determine a first human perceptible language associated with the sender and a second human perceptible language associated with the recipient and, if the first and second languages are different, to send the communication to the translation system for translation, together with the address of the receiving system thereby to enable the translation system to receive the diverted communication for translation, and to forward the translated communication to the receiving system, but if the first and second languages are the same, to send the communication directly to the receiving system, and wherein the receiving system is arranged, on receiving a communication, to determine a first human perceptible language associated with the sender and a second human perceptible language associated with the recipient and, if the first and second languages are different, to send the communication to translation system for translation, together with the address of the receiving system thereby to enable the translation system to receive the communication for translation, and to return the translated communication to the receiving system, but if the two languages are the same, to accept the communication sent to the receiving system.

Dependent claims 2-36 relate to further details of the system.

The Law

- 7 The examiner raised an objection under section 1(2)(c) of the Patents Act 1977 that the invention is not patentable because it relates to a program for a computer as such:

1(2) It is hereby declared that the following (amongst other things) are not inventions for the purpose of the 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 provisions shall prevent anything from being treated as an invention for the purposes of the Act only to the extent that a patent or application for a patent relates to that thing as such.

- 8 As explained in the notice published by the UK Intellectual Property Office on 2 November 2006¹, the starting point for determining whether an invention falls within the exclusions of section 1(2) is now the judgment of the Court of Appeal in *Aerotel/Macrossan*. In *Aerotel/Macrossan* the court reviewed the case law on the interpretation of section 1(2) and approved a new four-step test for the assessment of patentability, namely:
- 1) Properly construe the claim;
 - 2) Identify the actual contribution;
 - 3) As whether it falls solely within the excluded matter; and
 - 4) Check whether the contribution is actually technical in nature.
- 9 As stated at paragraphs 45-47 of the judgment, reconciling the new test with earlier judgments of the Court of Appeal in *Merrill Lynch* [1989] RPC 561 and *Fujitsu* [1997] RPC 608, the fourth step of checking whether the contribution is technical may not be necessary because the third – asking whether the contribution is solely of excluded matter – should have covered the point.
- 10 As stated in their written submissions of 11 June 2007, the agents accept this is the correct test to apply.

Analysis

Construing present claim 1

- 11 The construction of the claim presents little difficulty. For avoidance of doubt, in my analysis, I have used the term ‘language’ to indicate a ‘human perceptible’ language (as specified in the claim) as distinguished from a computer programming language. As currently drafted, I consider the claim to cover a communications system, arranged to send and receive communications between users and a translation system. Messages sent by a user in a language that is different from a language associated with the intended recipient, are sent to the translation system to be translated into the language of the intended recipient, and forwarded to the recipient. Similarly, when a communication is received in a language that is different from a language associated with the recipient user, the communication is sent to the translation system to be translated into the language associated with the recipient, and the translated message is then forwarded to the recipient.

Identifying the contribution made by the invention.

- 12 Turning now to step 2 of the test and the actual contribution made by the invention. The agent argues that the contribution is the distinction over the prior art, namely US 5884246. The US document discloses a communications system for automatic translation of electronically transmitted messages in which control of the translation is all performed at the sending system and only outgoing messages can be sent for translation. In contrast, the claimed system can also send incoming messages for translation and onward transmission to the recipient

¹ <http://www.ipo.gov.uk/patent/p-decisionmaking/p-law/p-law-notice/p-law-notice-subjectmatter.htm>

and the agent argues that this further message routing ability provides the contribution. Although I am not bound to accept the assertion of this starting point is the disclosure of the US document, I do agree that this is substantially the contribution of the invention as currently claimed in claim 1.

Whether the contribution falls solely within excluded matter

- 13 The agent argues that the contribution provided by the new routing of messages in a communications system is 'technical' and hence goes beyond a computer program as such.
- 14 I agree that the routing of messages could be regarded as 'technical' within the broadest definition of the term and that technical means such as a computer are used to implement the invention. However, that is not in itself enough to make the invention patentable. While the end result of implementing the invention is the new routing of messages, it is achieved by programming the system to have the necessary functionality to determine the language of, and hence to suitably route, communications within the system. The fact that this happens in the context of a communications system does not to my mind make it any less a computer program as such. I therefore find the contribution falls squarely within the computer program exclusion.

Check whether the contribution is actually technical in nature.

- 15 Given my finding above I do not need to apply this step.

Other claims

- 16 The dependent claims relate to details of the system of claim 1. The agent has submitted no argument that any of them would avoid exclusion if claim 1 were excluded, and I can see nothing in any of the claims that would do so.

Conclusion

- 17 I therefore find that the invention as presently claimed is excluded from patentability under section 1(2)(c). I therefore refuse the application in accordance with section 18(3).

Appeal

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

MRS S E CHALMERS

Deputy Director acting for the Comptroller