

25 April 2008

## PATENTS ACT 1977

APPLICANT    Con Francis Shivnen

ISSUE    Whether patent application number GB  
0510974.9 complies with section 1(2)

HEARING OFFICER    R C Kennell

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## DECISION

- 1     This application was filed on 31 May 2005, claiming a priority of 3 June 2004 from an earlier Irish application. It was published under serial no. GB 2 414 831 A on 7 December 2005.
- 2     Despite amendment of the claims during substantive examination, the applicant has been unable to persuade the examiner that this is a patentable invention within the meaning of section 1(2) of the Act. In its letter of 27 January 2008, the applicant said it did not wish to attend or be represented at a hearing. I am therefore deciding the matter on the basis of the papers on file, including further submissions dated 17 April 2008 which I had invited in view of the judgment of Patten J in *Symbian Ltd* [2008] EWHC 518 (Pat).

### The invention

- 3     The invention relates to a computerised system for recording a candidate's scores in a driving test as the test progresses. As the specification explains, the replacement of the paper forms used by test examiners, although desirable, is not straightforward. Simple replication of the existing forms on screen with the use of a pointing device such as a mouse is ruled out by their size and complexity and by the difficulty of reducing the number of sections and faults to make a simpler form. Drop-down menus might in theory help, but would be difficult to use in a moving vehicle. The need is for a portable system which is small enough and simple enough to be easily used in a moving vehicle, but which will still allow the examiner to see all the faults recorded throughout the duration of the test.
- 4     The claims in their latest form comprise independent claims 1 -24 / 52 to portable computing devices, claims 25-50 / 53 to computer-implemented methods and

claim 51 to a computer program executable to perform the method. Claim 25 reads:

“A computer implemented method for recording a candidates test scores comprising the steps of:  
displaying a primary menu, the primary menu having a plurality of user selectable category icons where each category icon corresponds to an associated category of faults in a driving test,  
displaying a secondary menu in response to the activation of an individual category icon by a user, wherein the secondary menu identifies individual faults associated with the activated category, each individual identified fault having displayed and associated therewith at least one user selectable grade of fault,  
displaying the primary menu in immediate response to the selection by the user of a fault in the secondary menu, and storing the individual fault and grade of fault, wherein said primary menu and secondary menu are not concurrently displayed, the method further comprising the step of displaying a progress indicator for each user selectable category icon indicating faults incurred in the associated category.”,

whilst claim 1 is to a portable computing device comprising a user display, user data entry means, and data storage means and means for executing a driving test system stored therein as executable code, the system corresponding to the above method steps and including a graphical user interface.

- 5 Despite the smallness of the screen, the system is stated to be particularly suitable for implementation on a handheld device using a stylus and touch sensitive screen for data entry rather than the more cumbersome option of a laptop computer and keyboard. The applicant explains (see letters of 27 July 2006, 11 January 2007 and 17 April 2008) that the invention avoids the problem that movement of the vehicle causes movements of the stylus which are larger than the size of the selectable areas when the existing forms are squeezed on to a small screen. However the applicant says that the invention allows the same amount of information to be input on a small screen as on a large one, because it does not operate in the same way as conventional menu arrangements. Thus the primary menu disappears once the secondary menu appears but it requires only two “clicks” (or stylus taps) to enter a fault and its grade and cause the primary menu to reappear in updated form with an indication of the progress of the candidate in any of the categories of fault.

### **The law and its interpretation**

- 6 Section 1(2) reads:

“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) a discovery, scientific theory or mathematical method;
- (b) a literary, dramatic, musical or artistic work or any other aesthetic creation whatsoever;

- (c) a scheme, rule or method for performing a mental act, playing a game or doing business, or a program for a computer;
- (d) the presentation of information;

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.”

7 It is not disputed that the assessment of patentability under section 1(2) is now governed by the judgment of the Court of Appeal in *Aerotel Ltd v Telco Holdings Ltd* and *Macrossan's Application* [2006] EWCA Civ 1371, [2007] RPC 7 (hereinafter “*Aerotel*”). In this case the court reviewed the case law on the interpretation of section 1(2) and approved a four-step test for the assessment of patentability, which is explained at paragraphs 40-48, namely:

- 1) Properly construe the claim
- 2) Identify the actual contribution (although at the application stage this might have to be the alleged contribution)
- 3) Ask whether it falls solely within the excluded matter
- 4) Check whether the actual or alleged contribution is actually technical in nature.

8 Before applying this test, I must clarify one general point which has arisen on the interpretation of the law. In its submission of 17 April 2008 the applicant comments that the examiner's objection under section 1(2) arose only because of a change of Office practice which ought never to have happened because, as explained by Patten J in *Symbian* at paragraph 41, there had been no departure in law.

9 I think this is a misunderstanding of both the examiner's and the Office's positions. Reflecting the comments of Jacob LJ in at paragraphs 46-47 of *Aerotel*, Patten J explains that the case is not intended to be a departure from the law as laid down in earlier Court of Appeal decisions. The Office's practice notice of 2 November 2006<sup>1</sup> following *Aerotel*, and the practice notice of 29 July 2005 following *CFPH LLP* [2005] EWHC 1589 (Pat), [2006] RPC 5 which it superseded, each explained that there had been no fundamental change in what was patentable in the UK - whilst recognising that there might be difficulties over borderline cases. The examiner did indeed raise objection under section 1(2) (on the basis of *CFPH*) in his report of 13 February 2006 only after an earlier letter of 8 August 2005 deferring an examination report had stated that he had no objections so far. However his report acknowledged that he had reconsidered the position in the light of hearing decisions and other cases since 8 August 2005, which he though had clarified the law.

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

## Argument and analysis

- 10 Despite a considerable exchange of correspondence between the examiner and the applicant's patent attorney, the examiner has maintained that the invention is excluded under sections 1(2)(c) and (d) as a method of doing business, as a program for a computer and as the presentation of information.

### The construction of the claims and the contribution of the invention

- 11 Applying, the four-step *Aerotel* test, the first and second steps – the construction of the claims and the identification of the contribution - are not in dispute. However, I think that I need to look a little more closely at the latter, bearing in mind that (see paragraph 43 of *Aerotel*) identification of the contribution is essentially a matter of determining what it is the inventor has really added to human knowledge, and involves looking at substance, not form.
- 12 The examiner and the applicant appear agreed that the contribution is a portable computing device for entering driving test scores during the test by displaying menus and selecting icons in accordance with the method outlined above. Whilst I accept that the invention makes it possible to use portable computing devices for entering scores during a driving test, I do not think that the applicant has actually invented any new hardware or combination of hardware. Rather it seems to me that the contribution lies in the programming of the device, and that what the invention adds to human knowledge as a matter of substance, rather than the particular form in which the invention is claimed, is the computer-implemented method of claim 25 with the benefit that known types of portable handheld computer can be used to carry out a driving test in a moving vehicle.

### Does the contribution relate solely to excluded matter?

#### *Program for a computer*

- 13 It is certainly not disputed that the invention relies on the use of a computer program. As the specification explains (see page 5), the test system of the invention is intended to be written in software and stored as executable code in the computing device, and can be implemented using commonplace programming techniques. That is not necessarily enough to exclude the invention, as is clear from paragraph 22 of *Aerotel*: what I have to decide is whether the contribution that I have identified falls solely within excluded matter.
- 14 I do not think that I need to go through all of the correspondence in detail, but it has highlighted the point which I believe is at the bottom of the dispute – whether (as the applicant argues) the invention makes a contribution extending beyond the above excluded categories “as such” because it solves the allegedly technical problem of using a computer in a moving vehicle to record driving test scores, and involves a change in the way that a user interacts with a computer. The examiner's argument is that the invention makes no contribution to the general field of using computers in a moving vehicle, and that the computer is not being used in any way that it could not already be used in a moving vehicle (except for what the clicks or stylus touches cause the system to do).

- 15 I agree with the examiner. It seems to me that what the inventor has done is to design a program which can cope with the limitations of a small screen but which does not cause the computer to act in any new technical way, or solve any technical problem in the operation of the computer (as might perhaps be the case if, to use a hypothetical example given by the examiner, the program allowed a computer physically to operate underwater when it could not do so before). In my view, any change in the way that the user interacts with the computer is an effect caused solely by the running of the computer program.

*Method for doing business*

- 16 Furthermore, I think that the program implements an overall contribution which is in essence a method for conducting a driving test rather than simply a tool for doing so. In his pre-hearing letter of 28 November 2007, the examiner has for the first time raised an objection that the contribution is excluded as a method for doing business, as well as a computer program and as the presentation of information, but has not given any reasons in support of this head of objection. However, in my view a method for conducting a driving test is a method for doing business.

*Presentation of information*

- 17 The examiner's objection under the presentation of information head was originally made in respect of the provision of progress indicators on the primary menu screen. In the pre-hearing letter the examiner suggests that overcoming difficulties with the viewing of information would be excluded as presentation of information. I think that would depend on how the difficulty was overcome. However in the present case, the contribution does include the way in which the fault categories, individual faults and grades of fault are displayed on the primary and secondary menus with a progress indicator. As the specification explains at page 10 lines 18-34 it is important for the driving test examiner to have readily available the number of faults both overall and in particular categories, and to be able to review the candidate's progress as the test progresses. Much of the specific description (corresponding to the subject matter of present dependent claims 2-21 and 26-47, which I do not think that I need to recite) is concerned with the manner in which this information is presented on screen. I agree that this is the presentation of information.
- 18 I am therefore satisfied that the contribution of the invention falls wholly within the above three excluded categories. It therefore fails the third *Aerotel* step.

Is the contribution technical in nature?

- 19 Paragraphs 46-47 of *Aerotel* explain that the fourth step of checking whether the contribution is technical may not be necessary because the third step should have covered the point, and that a contribution which consists solely of excluded matter will not count as a technical contribution. Whether the fourth step needs to be undertaken if the invention fails the third step has been considered in a number of court judgments since *Aerotel*.

- 20 For example, in *Oneida Indian Nation* [2007] EWHC 954 (Pat), Deputy Judge (as he then was) Christopher Floyd was clear (paragraphs 10-11) that the identification of a technical advance did not bring back into contention inventions which had been excluded at the third step, and the fourth step was intended merely to make sure that inventions which had passed the third step were technical in nature: an invention would not pass the third step on the strength of technical advances which fell within one of the excluded categories. This view appears to be supported by the subsequent judgments in *Astron Clinica* [2008] EWHC 85 (Pat) (paragraph 45) and *Autonomy Corporation* [2008] EWHC 146 (Pat) (paragraph 34).
- 21 However, in the recent *Symbian* judgment, Patten J (see paragraphs 42 and 58) held that the question of whether a claim fell within excluded matter could not be answered in isolation from the issue of whether it embodied a relevant technical contribution, and that the third and fourth steps were as a matter of law alternatives. He thought it clear from the authorities that the question whether the invention made a relevant technical contribution had to be asked because it was the determinant of whether EPC Art 52(3) (equivalent to section 1(2)) had any application, and that whether it was asked as part of the second, third or fourth *Aerotel* step mattered much less than whether it was asked at all.
- 22 I have to say that I find these judgments difficult to reconcile, but I do not think that I need to attempt this in the present case. I have found above that the contribution programs a device to carry out a business method without causing the computer to act in any new technical way, or solve any technical problem in the operation of the computer. Irrespective of whether, having found the invention to have failed the third *Aerotel* step, I need as a matter of law to go on to the fourth step, I do not think that the contribution is technical in nature.
- 23 Although the applicant considers that the examiner's reasoning cannot be supported in the light of *Symbian*, I think that the present case can be distinguished from it. In *Symbian* Patten J says (paragraph 58) that he fails "to see why a program which has some novel technical effect on an important component in the computer's operating system should not qualify as doing more than merely operating as a computer program notwithstanding that its effect is to solve what on one view is a software problem affecting the functioning and reliability of the computer". I do not think that the present invention does in fact affect the computer's operating system.

## **Conclusion**

- 24 Accordingly, I conclude that the invention of claims 1, 25 and 51 fails the *Aerotel* test and is therefore excluded under sections 1(2)(c) and (d) because it relates to a program for a computer, a method for doing business and the presentation of information, as such.
- 25 Having read the specification I do not think that any saving amendment is possible. As I have mentioned above, claims 2-21 and 26-47 do not make a contribution beyond the presentation of information. The addition of a navigation

module to provide position information to the system, which may be recorded with the fault information or provide audio instructions to a candidate (see claims 22-24 and 48-50) would still seem to be a contribution to a method for doing business.

26 I therefore refuse the application under section 18(3).

### **Appeal**

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

**R C KENNEL**

Deputy Director acting for the Comptroller