**INTELLECTUAL**
PROPERTY OFFICE

**PATENTS ACT 1977**

APPLICANT          Idan Zuta & Marc Zuta

ISSUE                    Whether patent application
                            GB0716959.2 complies with section 1(2)

HEARING OFFICER          H Jones

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**Introduction**

1    Patent application GB0716959.2 was filed in the names of Idan Zuta and Marc Zuta on 3$^{rd}$ September 2007. The application relates to a method and system for authoring a patent application. The specification was published as GB 2453318 on 8$^{th}$ April 2009.

2    The examiner dealing with the application issued a combined search and examination report, identifying a number of objections. The most significant objection was that the application related wholly to excluded matter.

3    Subsequent to the issue of that report there were a number of rounds of correspondence between Marc Zuta and the examiner. Mr Zuta strongly disagreed with the examiner's findings, but was unable to persuade him that the application related to patentable subject matter. Having repeated his objection, the examiner finally informed the applicants that he would arrange a hearing to decide the matter.

4    In addition to his contact with the examiner, Mr Zuta has also been engaged in correspondence with other representatives of the office, including senior officials at the highest levels of management. This correspondence included a number of requests for information under the Freedom of Information Act and a series of complaints about unfair treatment. The requested information was provided where possible, but some of the requests were refused. The complaints were carefully considered by management, who decided that they were unfounded.

5    Mr Zuta was given several opportunities to attend a hearing on the substantive issues to present his arguments about the application in person, and was informed that a decision would be issued on the basis of the papers on file if he did not attend the hearing. Mr Zuta does not accept that a hearing officer should decide the fate of the application, and accordingly he has not accepted the offer of attending a hearing.

6       The history of complaints, the freedom of information requests and Mr Zuta's discontent with the appointment of a hearing have no bearing on this decision. My purpose is to look at the application afresh and to decide whether it meets the requirements of section 1(2) of the Patents Act. In doing this I am not bound or influenced by what has already happened, and I will take proper account of the arguments on the subject of patentability advanced by Mr Zuta.

**The application**

7       The description runs to 151 pages, and is accompanied by 31 pages of drawings. It is divided into 17 sections, each said to present a different 'aspect of the invention'. I have read the description a number of times. It is quite involved, and in places it is not straightforward to follow.  Nevertheless it is clear that it relates to a number of interrelated methods which may be used to assist in and/or automate parts of the patent application process. These methods address a variety of perceived difficulties in the process, including improving the dialogue between inventors and their agents, precisely defining and representing inventions in drawings and text, guiding inventors into choosing an appropriate IP protection strategy based on the available choices and associated costs, submitting revised patent applications in the light of search results from a preliminary filing, efficiently searching the prior art, structuring patent applications so they can be efficiently processed, tracking the changes made to patent applications during processing, filing applications more quickly, filing applications in foreign languages, and ensuring that applications meet the requirements of patentability.

8       There are 45 claims, 6 of which are independent. For convenience the independent claims are reproduced in the attached annex.

9       No amendments to the claims have been filed. My decision is therefore based on the claims as originally filed.

**The law**

10      The relevant provision in relation to excluded inventions is Section 1(2).  This 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.*

11  Current IPO examination practice is to use the structured approach set out by the Court of Appeal in its judgment in *Aerotel/Macrossan*[1] for deciding whether an invention is patentable. The test comprises four steps. More recently, the Court of Appeal in the case of *Symbian*[2] confirmed that this structured approach is one means of answering the question of whether the invention reveals a technical contribution to the state of the art. In other words, *Symbian* confirmed that the four-step test is equivalent to the prior case law test of 'technical contribution', as per *Merrill Lynch*[3], *Gale*[4] and *Fujitsu*[5].

**Arguments and analysis**

12  To decide whether the application relates to patentable subject matter I must answer the question of whether one can identify a technical contribution to the state of the art, firstly in relation to the claims as presented, and then in relation to the unclaimed subject matter.

13  Claim 1 defines a method in which an inventor and his agent collaborate, over the internet, to produce a picture describing an invention. The method uses a computer to check for errors in the picture. I can see no hint of a technical contribution here, or, to put in another way, no contribution outside excluded fields. The dialog between inventor and agent is conducted over the internet using conventional hardware which is suitably programmed to somehow validate the information in the picture. The end result of the method is simply a picture, albeit one which accurately represents an invention. Fundamentally, the method amounts to no more than preparing, annotating, checking and refining a drawing. Without the use of computers to automate some of this process it would be a predominantly intellectual exercise performed by the agent in consultation with the inventor. As such, it could well be excluded as being a method for performing a mental act. Likewise, as part of a process of conducting business between an agent and an inventor it could also meet the terms of a business method. In any case, I consider that the contribution falls squarely within the scope of the computer program exclusion.

14  Claim 19 essentially relates to presenting, on a computer screen via the internet, various choices that are available to an inventor for protecting his invention. The contribution here is a method of helping an inventor to make a choice about how to proceed with protecting his invention. Again, there is no contribution beyond the excluded fields. This is quite clearly a business method, implemented on a computer.

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[1] Aerotel Ltd v Telco Holdings Ltd & Ors Rev 1 [2007] RPC 7
[2] Symbian Ltd's Application [2008] EWCA Civ 1066, [2009] RPC 1
[3] Merrill Lynch's Appn (1989) [1989] RPC 561
[4] Gale's Appn [1991] RPC 91
[5] Fujitsu Limited's Appn [1997] RPC 608

15    Claim 22 describes a process that an inventor and his agent go through, starting with trying to determine what the invention is by filing a preliminary patent application and studying search reports resulting from that application, and continuing by deciding how best to protect the intellectual property, in particular by filing more patent applications. The choices to be made in this process are communicated to the inventor through the agent's website. The process seems to me to be one which patent agents and inventors follow as a matter of course. The contribution is therefore no more than providing some level of automation of such a process using an internet site. Such a contribution cannot extend beyond the excluded fields. There is no technical contribution. The claim defines a business method and a computer program.

16    The idea behind claim 23 seems to be to draft a patent application in which the features of an invention are unambiguously defined using a standard vocabulary of terms, and the interconnections between the features are defined using mathematical operators. Precisely how this might work in practice is not entirely clear to me, but what is clear is that there is no technical contribution. The end result of performing such a method is simply a patent application, albeit a patent application taking a particular form. In my view a method of generating a patent application which is characterised solely by the particular form of its content is clearly excluded as being presentation of information and a method of performing a mental act.

17    Claim 38 is obscure in scope, but with reference to the corresponding portion of the description it evidently relates to formatting a patent application according to a particular structure. As with claim 23 I find that there is no technical contribution and that claim 38 is excluded as relating to presentation of information and a method of performing a mental act.

18    Claim 45 is essentially about trying to ensure that a patent claim describes an invention that defines a contribution over the prior art, and that that contribution is one which is not solely within excluded matter. The method relies upon describing the invention in a particular form which in turn allows the analysis of the contribution to be performed by a suitably programmed but otherwise conventional computer, but the underlying steps in the method are those followed as a matter of course during the processing of any patent application on the borderline of patentability. In short, the contribution is a means of automating part of the patenting process with the end result being, hopefully, a description of an invention which is patentable. This contribution falls solely within the field of computer programming.

19    The 6 independent claims relate to only some of the 17 'aspects of the invention' set out in the description. I have considered these unclaimed 'aspects' to see whether they might form the basis of some patentable claims but I do not see how there can be any technical contribution outside the excluded fields in computer assisted methods of dialog between inventors and agents, in describing inventions and drafting/filing patent applications in particular formats, in using suitably programmed but otherwise conventional computers for searching the prior art, in adding line and column numbers to documents to be faxed, or in

automatically translating patent applications for filing in different countries. I note that none of this uses new computer hardware or a new arrangement of hardware.

20    During processing of the application, Mr Zuta submitted a number of general arguments as to why a patent should be granted for the invention. I will consider each of these arguments in turn.

21    Mr Zuta argued that filing a patent application is an essential step in manufacturing a product, and as such the application makes a technical contribution. I do not consider there to be any merit in this line of argument. Of course, there are products whose process of manufacture is protected by patents, but filing a patent application for that process is not an essential step in that process. Indeed many manufacturers operate their business perfectly well without any patent protection for their processes and products. The claims are not actually directed towards methods of manufacture, but even if they were I do not think it would be reasonable to say that the manufacturing step formed part of the contribution.  As a matter of substance, the specification, especially the claims, relates to filing patent applications, and not to the manufacture of products.

22    Mr Zuta also argued that the invention is patentable since the court in *Astron Clinica*[6] decided that computer programs are allowable at the IPO. *Astron Clinica* in no way suggests that all computer programs are patentable. Rather, it makes clear that a claim to a computer program may be allowable, but only if the program, when run, would carry out a patentable method. I do not consider the application to relate to a patentable method.

23    Mr Zuta argued that the invention had a technical effect since it processes the technical description of a new product or method, and assists in the technical implementation of the invention. In short, he argued that the invention is technical because it relates to the technical details of an invention. There can be no doubt that patents are 'technical' in the everyday English sense of the word, but this in itself is not enough to make the invention patentable. The word 'technical' in the Patent law sense means more than this. For an invention to be patentable there must be a contribution outside the excluded fields, and this contribution must be technical in nature. In my view, there is no such contribution.

24    Mr Zuta noted that the IPO has granted other patents for computer related inventions. This is undoubtedly true, but has no bearing on the issues in this case. Each application must be considered on its own merits.

25    Mr Zuta also argued that granting a patent for the invention would stimulate growth in the UK economy and benefit UK inventors and industry. Even if this were to be true, the potential benefits of granting this patent application cannot override the requirements of section 1(2). My decision must be bound by the Patents Act as interpreted in the light of the relevant case law.

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[6] Astron Clinica and other's Applications [2008] EWHC 85 (Pat)

**Conclusion**

26  Having read the entire description I have been unable to identify any saving amendment that could form the basis of a patentable invention. I therefore refuse the application as failing to comply with section 1(2), as it relates wholly to one or more of a business method, a mental act, a computer program and presentation of information.

**Other issues**

27  Whilst the examiner's primary objection to this application was on the grounds of excluded matter, he also raised a number of other substantive issues. The examiner was of the opinion that the claims related to several different inventions. Also, even though only a partial search was conducted, he considered that the claimed methods may not be novel and inventive. In the light of my decision on the subject of excluded matter, I have determined that any further consideration of these issues would serve no useful purpose.

**Appeal**

28  If the applicants disagree with anything in my decision, they have a right of appeal to the Patents Court.  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

**Annex – the independent claims**

1.  A method for communicating an invention in pictures and for processing the pictures, comprising:
    a.  Input invention in pictures (1): One or more pictures are used to describe the invention, in a dialog between inventor and agent, wherein the dialog is performed over the internet;
    b.  Pictures processing (1): A number is assigned to each of the parts of the pictures, or to the significant parts therein, or to groups of parts, and wherein different parts or types of parts have different numbers assigned thereto;
    c.  Input invention in pictures (2): A concise text is attached to the pictures, including at least a Terms list with a name and/or term assigned to each numbered part or group, wherein the numbers assigned to the parts form the link between the pictures and the concise text;
    d.  Pictures processing (2): A computer checks the Terms list for consistency, correctness and completeness, reporting on errors and omissions;
    e.  If required, Preparing corrected pictures and/or re-numbering the parts and/or amending the Terms list so as to correct the detected errors or omissions, in a dialog between the inventor and agent.

19. A method for communicating choices for protecting an invention and for processing a selected choice for implementation, wherein the communication uses the internet with an inventor accessing an agent's internet site, including:
    a.  displaying possible patent protection- related activities to do and their cost, as a bidimensional Stage/Cost matrix including Stages to be performed in a Time vs. Cost domain, and wherein either actual costs or a general measure of relative cost is presented;
    b.  as the inventor points to each element of the matrix, relevant info is displayed;
    c.  the inventor decides whether to proceed with protecting his invention; if negative, then stop the method, Exit; else proceed;
    d.  the inventor chooses which activities to perform and at what cost, and sends a message with his choice to the agent's site.

22. A method for communicating choices for a unified intellectual protection for an invention and for processing a selected choice, wherein the communication uses the internet with an inventor accessing an agent's internet site, including:
    a.  Defining the invention by the inventor, assisted by the agent;
    b.  Filing an urgent preliminary patent application;
    c.  Performing an initial patents search;
    d.  Preparing other IP protection means;
    e.  Studying the search results for an improved definition of the invention;
    f.  Editing and submitting a complete patent application;
    g.  Accelerated search and examination;
    h.  Additional patent searches;

i. Filing patent applications worldwide or an International patent
j. If another invention is discovered, for instance during product development, then repeat steps a -i above.

23. A method for communicating and processing inventions, comprising:
    a. defining the invention and representing it in a concise mathematic form using a standard vocabulary;
    b. processing the mathematic representation of the invention for drafting a patent application and during patent prosecution.

38. A method for communicating inventions and preparing a quality patent application, comprising:
    a. Using a multi-layer systematic approach and method, relating to the structure of the application and the method for drafting it; ie Method M1.
    b. Using a hierarchical method for numbering the parts in the drawings; Method 5 for Quality patent application -parts numbering.

45. A method for communicating inventions and drafting a patent application addressing the UK IPO requirements, comprising:
    a. The invention is disclosed in dialog between inventor and agent, using communications over the internet;
    b. Prepare a description of the invention using a mathematical equation with Standard terms;
    c. search the prior art, convert possibly relevant prior art to mathematical equations, and translate the terms therein are into Standard terms;
    d. compare the invention with prior art using a computer and software which can read and process the mathematical formulas for the above inventions, detecting differences from each of the prior art references;
    e. If the actual contribution versus one or more of the prior art is not significant, repeat steps (a)-(d) to re-define or narrow the scope of the invention so as to address the identified most relevant prior art;
    f. The above steps (a)-(e) are repeated until an invention crystallizes which convincingly differs from the prior art in some precisely defined aspects, then continue; or no such invention is found, then Exit;
    g. the results of the computer comparison of the invention with prior art in (d) above are reviewed to check whether the differences from prior art fall solely within the excluded subject matter;
    h. The above steps are repeated, the results of the computer comparison of the invention with prior art in (d) above are reviewed to check whether at least one of the differences from prior art is technical in nature;
    i. Take Corrective steps if possible and repeat steps (a)-(h), else stop the procedure, Exit.