



1 December 2010

PATENTS ACT 1977

APPLICANT I2 Technologies US, Inc

ISSUE Whether patent application number
GB 0604769.0 complies with section
1(2)

HEARING OFFICER J Pullen

DECISION

Introduction

1. Patent application number GB 0604769.0 was filed on 9th March 2006, claiming priority from an earlier US application 60660543. The application was published on 13 September 2006 as GB 2424097.
2. It was agreed, at the request of the applicant that for efficiency the application should be heard together with the applicant's co-pending applications 0604622.1 and 0604820.1, although it was also agreed that the applications were sufficiently different that I should issue decisions in respect of each application separately.
3. In the examination process the examiner, having already declined to carry out the prior art search on the application because he deemed it would serve no useful purpose, raised objections under section 1(1)(d) of the Patents Act which in turn relates to section 1(2) which is concerned with matter which is excluded from patentability. The examiner particularly maintained objections that the invention as claimed was unpatentable in relating to a computer program, a business method, a mental act and presentation of information as such. Unfortunately the matter could not be resolved by correspondence and the hearing was appointed to decide the matter. The hearing took place on October 1, 2010 before me and the applicant was represented by Mr Stephen Antrobus and Mr Paul Matthews of Barker, Brettell.

The application

4. The application relates to a custom application builder for supply chain management. In particular a user wanting access to supply chain related data may build a "custom" application using data in one or more particular "modules", respective modules relating to subsets of data in the supply chain such as purchase order data, inventory data, forecasting data, invoice data, and management data. Upon selecting the modules they need from a database of modules, the user can customise how the data may be displayed, the specification showing particular forms of tabulation of data.

The claims

5. It was agreed that the hearing should take place on the basis of the claims as originally filed with the application and not the suggested claims filed with the agent's letter dated 7 January 2010. The claims originally filed include six independent claims as follows:

1. A computer-implemented method for building a custom application for supply chain management, comprising:
 - storing application parameters for a trading partner in a supply chain, the application parameters describing at least one customized display of supply chain data for the trading partner based on a role of the trading partner;
 - receiving a request for supply chain data from the trading partner; and responsive to the request, providing the requested supply chain data to the trading partner in accordance with the stored application parameters.

8. A supply chain management system for building a custom application, comprising:
 - a web interface arranged to allow a trading partner to provide application parameters for the custom application;
 - a custom application builder module arranged to generate a request for supply chain data based on the provided application parameters; and
 - a database arranged to store the supply chain data, wherein the database is arranged to return the supply chain data to the custom application builder module based on parameters specified in the request.

11. A method of supply chain management, comprising:
receiving a request from a user for supply chain data stored in a database, the request comprising parameters specifying a category of the supply chain data needed for an application selected by the user;
invoking a procedure to return the supply chain data from the database to the user at least partly based on the parameters in the request; and
returning the supply chain data for display and use by the application according to customization preferences selected by the user.
17. A method of supply chain management, comprising:
selecting a type of application for viewing supply chain data, the supply chain data being stored in a database;
generating a web-based request for the supply chain data based on the selecting; and
selectively customizing a display of at least a portion of the supply chain data returned from the database in response to the web-based request.
21. A supply chain management system, comprising:
a user system accessibly by a user, the user system providing the user a capability to build a custom application requiring supply chain data;
a web interface accessible by the user system, the web interface arranged to handle a request from the user system for the supply chain data; and
a database arranged to store the supply chain data, wherein a procedure in metadata stored in the database is invocable to return the supply chain data based on parameters in the request.
28. A computer-readable medium having instructions recorded therein, the instructions to:
render a web-based application for allowing a user to select an application to customize, the application requiring supply chain data;
receive a request from the user to view supply chain data using the application;
authenticate the request;
transmit the authenticated request to a database having a procedure stored therein, the procedure invocable to return supply chain data specified by parameters in the request;
and
provide the user with at least one of selectable and definable preferences for the application to view and use at least a portion of the returned supply chain data.

The Law

6. The examiner raised an objection under section 1(2)(c) that the invention is not patentable because it relates to a computer program, a business method, a mental act and presentation of information as such; the relevant provisions of this section of the Act are shown below:

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. 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. As explained in the notice published by the UK Intellectual Property Office on 8th December 2008, the starting point for determining whether an invention falls within the exclusions of section 1(2) is the judgment of the Court of Appeal in *Aerotel/Macrossan*¹.
8. The interpretation of section 1(2) has been considered by the Court of Appeal in *Symbian Ltd's Application*². *Symbian* arose under the computer program exclusion, but as with its previous decision in *Aerotel/Macrossan*, the Court gave general guidance on section 1(2). Although the Court approached the question of excluded matter primarily on the basis of whether there was a technical contribution, it nevertheless (at paragraph 59) considered its conclusion in the light of the *Aerotel* approach. The Court was quite clear (see paragraphs 8-15) that the structured four-step approach to the question in *Aerotel/Macrossan* was never intended to be a new departure in domestic law; that it remained bound by its previous decisions, particularly *Merrill Lynch*³, which rested on whether the contribution was technical; and that any differences in the two approaches should affect neither the applicable principles nor the outcome in any particular case. But the *Symbian* judgment does make it clear, that in deciding whether an invention is excluded, one must ask does it make a technical contribution? If it does, then it is not excluded.

¹ *Aerotel Ltd v Telco Holdings Ltd (and others) and Macrossan's Application* [2007] R.P.C. 7

² *Symbian Ltd's Application* [2008] EWCA Civ 1066

³ *Merrill Lynch's Application* [1989] R.P.C. 561

9. Subject to the clarification provided by Symbian, it is therefore appropriate for me to proceed on the basis of the four step approach explained that paragraphs 40-48 of Aerotel/McCrosan namely:

- 1) properly construe the claims
- 2) identify the actual contribution
- 3) ask whether the identified contribution falls solely within the excluded matter
- 4) check whether the actual or alleged contribution is actually technical in nature.

10. The applicant's representatives agreed that this is the correct approach to follow.

Applying the excluded matter test

Construe the claim

11. There have been no issues raised, by either the examiner or the applicant, with the clarity of the claims and therefore their construction is not disputed.

Identify the contribution

12. This is defined in Aerotel/Maccrossan as what the invention has added to human knowledge. There is unity of invention and it was not suggested, by either the examiner or the applicant, that the contribution is, or should be, different for each of the respective independent claims set out above. Therefore, the claims stand or fall together.

13. Mr Matthews explained that the invention allows a customised data display which only shows a subset of the data relating to a complete transaction, such that the user is not presented with data which is irrelevant to them or which they have no need to see. As was discussed at the hearing, the claims do not however define that the data accessed is a subset of more complete data, merely that the display is customised based on the role of the trading partner wishing to view it. I do accept however that the embodiment in the specification is for the data viewed to be reduced to a subset of the total data relating to a transaction.

14. The advantages of the present invention are given in the description on page 17 as user selection of data to view and/or act on, improved supply chain operations and sharing of custom applications for supply chain management users. In the agent's letter of 7th January 2010, on pages 3 and 4 the contribution is given as 'improving a technical problem within the computer and improving the operation of the computer by building a custom application which allows the computer to run faster and more reliably'.

15. I was not persuaded by Mr Matthews arguments at the hearing to support the assertion in the aforementioned agent's letter that the contribution is 'a novel customisation of an application, based on stored parameters, achieves a faster, more reliable and more secure computer'.
16. I am of the opinion that the contribution is the customisation of an application to display supply chain data based on a role of a trading partner.

Ask whether the contribution falls within the excluded matter

17. The examiner considered that the contribution relates to a business method. The contribution I have expressed above undoubtedly has business aspects to it but Mr Matthews put it to me that that this would not necessarily make it a business method as the invention customises the display in relation to a parameter. The contribution that I have identified above is not this broad and I think that the fact that it is customised supply chain data that is displayed in response to requests made by trading partners must mean that the contribution relates to a business method. I therefore conclude that the contribution relates to a business method.
18. As regards presentation of information, Mr Matthews contended that the contribution could not solely relate to presentation of information because transfer of data was involved, not just display. In my view however the presentation of information is more than that and involves the selection of data to be presented as well as its viewing. This is illustrated by the recent judgement in *Gemstar vs Virgin* which the examiner referred to at the hearing and also in paragraph 10 of his examination report dated 1 April 2010, particularly paragraph 56 in which Mr Justice Mann said the following in this respect in relation to EPO guidelines on presentation of information:
- "The starting point for Mr Birss's distinction is the EPO guidance to which I have referred. The guidance says:
- "A presentation of information defined solely by the content of the information is not patentable. This applies whether the claim is directed to the presentation of the information per se or to processes and apparatus for presenting information. If, however, the presentation of information, as distinct from the information content, has new technical features, there could be patentable subject-matter in the information carrier or in the process or apparatus for presenting the information (see Guidelines C-IV, 2.3.7 - June 2005 version)."
- Mr Birss points particularly to the first sentence, and the concept of a presentation being defined solely by the content of the information. That founds his distinction, which he says is made in the third sentence. I do not think that the passage as a whole really justifies Mr Birss's sharp dividing line. At one level "presentation of information" means "information"; but the concept must mean more

than that. Some aspects of how it is communicated must be within the concept, because otherwise the word "presentation" would be meaningless. That is borne out by the second sentence, which looks to the substance of the matter - if what is happening is that information is being presented, it remains unpatentable even if the claim includes the processes (an important word) or apparatus for communicating (presenting) it. So one cannot escape the exclusion by wrapping up some processes or apparatus with the claim. The distinction is made in the third sentence - if the presentation of information has some technical features over and above the information and its delivery, then it might be patentable. So the contrast is between the content or its mere delivery, on the one hand, and that material plus some additional technical aspect of its delivery, on the other. That approach is consistent with the law on computer programs, discussed above."

19. I therefore conclude that the contribution must relate to the presentation of information per se as it encompasses the selection of data as well as its presentation.
20. The invention is clearly embodied by a computer program, and indeed claim 1 is introduced as a computer implemented method for building a custom "application" which is in itself by definition a computer program. The contribution therefore clearly relates to a computer program, but I must also consider whether the contribution is technical to determine whether it is excluded.
21. The examiner was also of the opinion that the contribution fell within the mental act exclusion, but having found in relation to the other exclusions as I have above, I do not need to decide whether the invention is excluded as a mental act as such.

Is the contribution technical in nature

22. Mr Matthews put it to me that the contribution could not relate to a computer program as such because there was a technical effect, that is the reduction of network traffic by reducing the amount of data transfer necessary owing to the customisation of data presented to the user. This is not in my opinion due to a technical effect of the contribution, but due to a business decision to furnish particular traders with customised information.
23. The speed of the computer, or network, is not a technical problem solved but merely circumvented by sending less data to traders.
24. I therefore conclude that the contribution is not technical, or to put it another way it is not freighted with the necessary technical effect to make the computer program, the presentation of information or the business method patentable.

Conclusion

25. I conclude that the contribution falls wholly within the business method, computer program and presentation of information exclusions and therefore that the application relates to matter excluded under section 1(2).

26. Having read the specification I do not think that any saving amendments are possible. The suggested claims submitted with the agent's letter of 7th January 2010 have a different form, but I believe the contribution to be the same as for the previous set of claims. 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.

J Pullen

Deputy Director acting for the Comptroller