

The number of vowels in the start word will dictate the number of intermediate steps to reach the single vowel word and therefore the degree of difficulty of the game.

- 5 The application has not been amended and comprises 35 claims in total of which claim 1 is the only independent claim. For the purpose of this decision I need only reproduce claim 1 here. It reads:

1. This invention relates to word puzzles for word games, the puzzles produce a string of dictionary recognised words from a Start Word or Anagram, this string of words either finishes in a single vowel word, or, it starts from a single vowel word, each word in this word string will either reduce, or increase, its length, incrementally by one vowel, at each step of its development, depending on whether a person is working down to a single vowel word, or building up from a single vowel word, Fig 3 Fig 3A, the length of each word string will be dependent on the number of vowels in the Start Word or Anagram, Fig 1 Fig 2 Fig 3, the Start Word or Anagram is presented from the outset, each Start Word or Anagram will produce a minimum of one to a maximum plurality of word strings, some, even providing additional incomplete word strings as well Fig 1, all the words constructed in a word string will have a single vowel in common, Fig 1 Fig 2 Fig 3 Fig 3A, the single vowel that all the words in a word string have in common, can, if so desired, be used as a method of control, as this vowel can set the direction that a word string will go in, this vowel control also allows for a choice to be made when a plurality of word string are produced Fig 3, all the consonants that appear in the Start Word or Anagram have to be used in each and every word constructed irrespective of the number of vowels being used at each step of the word string process, the objective is to produce a string of words that range in length incrementally by one vowel, the shortest word being the single vowel word, the longest being the length of the start word or Anagram, each word in a word string must contain a single common vowel throughout the length of the word string, irrespective of how long the word string gets, on occasions a word string, produced from a Start Word or Anagram, will allow for the addition, or for the substitution, of a vowel, after the word string has been completed, Fig 7A Fig 6A, the vowel substitution choices can also be selectable and controllable by means of the single common vowel that is present in a word string.

- 6 The claim includes various alternatives, preferred features and references to the figures that do not make it easy to define its scope precisely but that does not pose any particular problem in assessing the present issue which is whether the invention is excluded.

The Law

- 7 Section 1(2) of the Act specifies a number of categories of subject matter for which patent protection is not available. The relevant parts of that section read as follows:

"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.”

- 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, to which they correspond. I must therefore also have regard to the decisions of the European Boards of Appeal that have been issued under this Article in deciding whether the present invention is patentable although the only case law referred to in prosecuting this application is from the UK courts.
- 9 The approach to be followed in deciding whether an invention is excluded was approved by the Court of Appeal in *Aerotel*¹. That approach comprises the following 4 steps:

Step one: properly construe the claim

Step two: identify the actual contribution (although at the application stage this might have to be the alleged contribution)

Step three: ask whether it falls solely within the excluded matter

Step four: check whether the actual or alleged contribution is actually technical in nature.

Step 1: Construing the claim

- 10 As indicated above, whilst claim 1 is not particularly precise, that does not present a particular problem for my consideration here: the claim defines the characteristics of a particular word game.

Step 2: identify the contribution

- 11 At paragraph 43 of its judgment in *Aerotel* the Court of Appeal provided some guidance on how this step should be approached when it confirmed that identifying the contribution

“is an exercise in judgment probably involving the problem said to be solved, how the invention works, what its advantages are. What has the inventor really added to human knowledge perhaps best sums up the exercise. The formulation involves looking at substance not form – which is surely what the legislator intended.”

¹ *Aerotel Ltd. v Telco Holdings Ltd & Ors* Rev 1 [2006] EWCA Civ 1371 (27 October 2006)

12 The contribution Mr Anderson's invention makes is a new word game in which players try to move between a multi-vowel start word or anagram and a single vowel word by removing or adding vowels to make intermediate dictionary recognised words having the same consonants.

Step 3: Does the contribution fall solely within the excluded matter?

13 I have no doubt that claim 1 defines the rules for playing a game and thus the contribution the invention of claim 1 makes must also be to the rules for playing a game.

Step 4: Check whether the contribution is actually technical in nature

14 Again I am in no doubt the invention does not provide a technical contribution. Claim 1 is devoid of any technical features whatsoever and relates solely to the rules for playing a game.

15 In light of the above I am in no doubt claim 1 as currently drafted is excluded as relating to the rules for playing a game as such. That is sufficient for me to decide that in its present form claim 1 cannot be granted and I do not consider it necessary to consider whether it is also excluded as a method for performing a mental act or as the presentation of information.

Is there any saving amendment?

16 The dependent claims merely provide more detail of the rules for the game set out in claim 1 and none of them could provide the basis for a valid claim 1.

17 The description includes discussion of various vehicles through which the game could be provided. It suggests that the game could be played using cards or tiles with the start word on one side and the intermediate and single vowel words on the other side. Alternatively the puzzles could be included in a puzzle book, as a computer program, as a tv gameshow or in a newspaper). In my opinion none of these vehicles provide features that could be incorporated into claim 1 to make a valid claim. Those vehicles already form part of the "stock of human knowledge", including the two-sided tiles or cards disclosed in Mr Anderson's earlier applications. If claim 1 were to be limited to the features of any of those vehicles, in substance the contribution would be unchanged and would remain the rules of the game of claim 1 which I have already found to be excluded.

18 Again I do not consider it necessary to decide whether a claim directed to the vehicle for playing the game would also be excluded under any of the other exclusions, including the presentation of information.

19 Thus I can see no possible amendment that would lead to a valid claim.

Other matters

20 In his skeleton argument and at the hearing, Mr Anderson queried why an excluded matter objection was being raised against this application when no such issue was raised on his earlier, granted applications. As I explained at the hearing, each application must be considered on its merits and what has been granted previously

has no bearing on my consideration of this application. I would add though that there has been a shift in emphasis between his earlier applications (with their emphasis on the apparatus used for playing the game described) and the present one where the contribution resides solely in the rules for playing a game. Furthermore Mr Anderson's earlier patents also form part of the stock of human knowledge against which the excluded assessment is made.

Conclusion

- 21 I have found that the invention defined in claim 1 is excluded since it relates to a rule for playing a game as such. I cannot envisage any possible amendment that would avoid that exclusion and I therefore refuse the application under section 18(3) as failing to comply with section 1(2)(c).

Appeal

- 22 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