

PATENTS ACT 1977

APPLICANT Padmanabhan Mahalingham

ISSUE Whether patent application GB0706549.3 is
 excluded under section 1(2) of the Act

HEARING OFFICER A Bartlett

DECISION**Introduction**

- 1 This decision addresses the issue of whether the invention defined in Patent Application number GB0706549.3 relates to subject matter that is excluded under the Patents Act 1977.
- 2 The application was filed on 4 April 2007 by Dr Padmanabhan Mahalingam and is entitled "Diner Conference and Anonymous Telephony". It was subsequently published as GB2449840 on 10 December 2008.
- 3 Throughout the examination process the examiner reported that the invention was excluded as a method of doing business and a program for a computer. Dr Mahalingam and the examiner failed to reach agreement on that point (or on an acceptable form of amendment to overcome the objection) and a hearing was arranged to help me decide the matter. That hearing was held by telephone on 17 April 2012 where a US Patent Attorney, Mr Donald Boys, acted as advocate for Dr Mahalingam (who also contributed personally). The examiner, Mr Jared Stokes, also attended.

The application

- 4 The invention concerns a telephone conferencing system of the sort that allows multiple participants to take part in a single telephone discussion from various locations. As explained in the specification, conventional teleconference calls are hosted by a service provider who sets up the arrangements for the call upon request of one of the participants. Those arrangements typically include the telephone number of the conferencing system of the service provider, a code for the particular conference call and a security pass code to prevent unwanted participants being able to listen in. Participants are provided with the joining instructions and other details such as the time of the call and use them to join the conference call. The invention does away with the need for the service provider to make the arrangements and initiate the conference call. In contrast to the conventional

approach, in the invention the first caller initiates the conference call and sets the conference code and security pass code themselves (having agreed the arrangements, codes etc with other potential participants beforehand). Anyone else can then join providing they know the various codes with the provider's role being merely to provide the telecommunication capability.

5 The claims I was asked to consider were filed with Dr Mahalingham's letter of 15 September 2011. There are 5 claims in total of which claim 1 is the only independent claim. It reads as follows:

1. A conferencing communication system comprising:

a teleconference bridge operating in a network at which multiple participants operating communication devices may dial in and be connected in a conference call; and

a digital voice platform setting up and managing conferences through processors;

characterized in that any person dialling into the teleconference bridge and entering any code after connection, causes a conference to be initiated associated with that code, and any subsequent person dialling in and entering the same code will be connected in the conference initiated by the first person dialling in.

6 Most of the discussion at the hearing focussed on claim 1 but I was also asked to give specific consideration to claims 2 and 5 should I find claim 1 to be excluded. Those claims read as follows:

2. The conferencing communication system of claim 1 wherein the digital voice platform sets up the initiated conference at a first bank of processors, and upon a number of participants causing the first bank of processors to overload, the system adds an overflow bank of processors, thereby eliminating any restriction on a maximum number of participants.

5. The conferencing communication system of claim 4 wherein the system uses the digits of the code to allocate conferences to banks of processors.

The Law

7 Section 1(2) of the Patents Act 1977 sets out various things are not considered to be inventions for the purposes of the Act, 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.

9 The approach to be adopted when deciding whether an invention relates to excluded matter has been considered by the UK courts on numerous occasions. In its judgment in *Aerotel*¹ the Court of Appeal reviewed the case law on the interpretation of section 1(2) and approved a four-step test for the assessment of excluded matter, as follows:

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.

10 In its subsequent judgment in *Symbian*², the Court made clear that the *Aerotel* test is not intended to provide a departure from the requirement set out in the previous case law that the invention must provide a “technical contribution” if it is not to fall within excluded matter.

11 From that I take it that I should apply the *Aerotel* test but that in doing that I must ask the question “is the contribution technical?”.

Applying the Test

12 I will initially focus attention on claim 1 since as agreed at the hearing, if that claim is not excluded then it follows that none of the other claims are either.

13 Step 1 of the test – properly construe the claim – does not present any particular problems in the present case but there are a couple of points worthy of note. Whilst the preamble to the claim does not specify what type of communication it relates to, it is clear from the remainder of the claim and the description that it concerns a teleconferencing system. Thus the system comprises a teleconferencing bridge that multiple parties can dial into to participate in a conference call and a digital voice platform through which the conferences are set up and managed. The remainder of the claim specifies the particular functionality that the system provides, namely the

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

² *Symbian Ltd v Comptroller General of Patents* [2008] EWCA Civ 1066 (08 October 2008)

way that conferences can be initiated by any caller. It is also worth noting that the feature that the first caller enters “any code” when initiating the conference is significant and is a consequence of the way the system works: in contrast to prior art arrangements where the conference host would specify the code which others would need to enter to join, in the invention the host does not have any such role and the code is set by the first caller.

- 14 At step 2 it is necessary to identify the contribution made by the invention. At paragraph 43 of its judgment in *Aerotel* the Court of Appeal provided some guidance on what this step involves when it confirmed:

“it 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.”

- 15 Throughout the correspondence, Dr Mahalingam has sought to emphasise the technical nature of the invention. In his view a teleconferencing system is a technical system and therefore not excluded from patent protection. That however is an oversimplification of the position since, if correct, any system involving the use of any technical apparatus, including a computer, would be patentable and it is abundantly clear from the case law that this is not the case in the UK.
- 16 So what is the actual contribution made by the invention of claim 1? Mr Boys and Dr Mahalingam argued that the claim is drafted in terms of the hardware involved (namely the conference bridge and the network) and Mr Boys urged me to view the contribution in terms of the response of the bridge to calls made to it. When viewed from this perspective he said it was evident that the invention resulted in the equipment operating in a fundamentally different way with the conference being initiated when the first caller dials in where as in prior art systems the conference was only initiated upon some action by the service provider. That, he said, pointed to the contribution being a technical one and therefore to the invention being patentable. However, as the above passage from *Aerotel* makes clear, it is the substance of the invention that matters when determining whether an invention is excluded, rather than the form of the claim. In that regard Mr Boys and Dr Mahalingam accepted that the hardware through which the invention is implemented (ie the conference bridge and the network) is not itself novel. Whilst that (as Mr Boys correctly pointed out) does not mean the invention is necessarily excluded, it means in my view that I need to look beyond the hardware itself and consider what that hardware is programmed to do when identifying the contribution.
- 17 That functionality is defined in the final clause of the claim and relates to the way the invention allows conference calls to be initiated by any caller. The above passage from the *Aerotel* judgment also confirms that the problem solved or advantages provided by the invention can also form part of the contribution. In this case the description identifies the advantages as being that conferences can be arranged “on the fly” without any affiliation to or prior arrangement with the conference facility provider, that the initiator can set appropriate levels of security for joining the conference and that the conference is more secure. Thus in my view the contribution is a teleconferencing system programmed to allow a conference call to be initiated by any caller who dials into the conferencing bridge and enters any code, without

prior arrangement with the conference provider, and whereby subsequent callers can join the conference by dialling the bridge and entering the same code.

- 18 Step 3 requires me to decide whether that contribution resides solely in excluded matter. As indicated above, the hardware through which the invention is implemented is not novel and the contribution resides in the functionality that hardware is programmed to provide. In my view what Dr Mahalingam has added to the stock of human knowledge is a new way of administering teleconference calls using a conventional teleconferencing platform whereby all responsibility for initiating the call sits with the first caller rather than with the conference facility provider, whose role is reduced to simply providing the platform for the conference. That contribution is a new teleconference service and falls solely within the business method exclusion. In my view the invention is excluded as a method of doing business as such.
- 19 In so far as the invention is implemented by appropriate programming of known hardware I also consider the invention to be excluded as a program for a computer as such. I have considered all the alleged advantages provided by the invention but in my view these all result from the features of that new business method and do not point to the invention making a technical contribution. In particular, any increase in security results from security codes not being known by the conference provider under this scheme rather than for example by better encryption and indeed is still subject to potential security issues as dial in information must still be provided to all potential participants. In short I can see no technical contribution provided by the invention of claim 1 that would mean the exclusions are avoided.
- 20 Step 4 involves a check of whether the contribution is technical in nature. Whilst a teleconferencing system itself is technical in nature I do not consider the contribution made by this invention to be a technical one – the contribution is a method of doing business, implemented via a computer program.
- 21 At the hearing, I was asked to give specific consideration to claims 2 and 5 if I found claim 1 to be excluded. Both these claims are directed to the way that the system allocates calls to banks of processors. As I understand it from the description, claim 5 defines a system where the code entered by someone wishing to join a particular conference is used to direct their call to a particular bank of processors. As currently drafted I can see no clear technical reason for doing that and as a result I do not consider it to provide the necessary technical contribution.
- 22 As I understand it, claim 2 defines a system in which, in the event that a particular bank of processors becomes overloaded, calls are directed to an overflow bank. This is explicitly stated to be for the purpose of eliminating any restriction on the maximum number of participants to a particular conference. The invention of claim 2 is, it seems to me, providing a technical solution to an altogether more technical problem and does not fall within the exclusions and is potentially patentable (subject to it being novel and inventive which has not been fully tested to date).
- 23 For the sake of completeness I have also considered claims 3 and 4. In my view these merely recite details of the way the service is accessed (the caller entering the access code with or without a prompt) and do not provide the technical contribution I have found to be lacking in claim 1.

Conclusion

- 24 I have found that the invention defined in claims 1, 3 and 4 is excluded as a method for doing business and a program for a computer as such. As currently drafted claim 5 is also excluded under those heads. On the other hand I consider the invention of claim 2 to not be excluded. I therefore give a period of one month from the date of this decision for the filing of amendments to limit the claims to non-excluded subject matter, for example to the contents of claim 2. If such amendments are filed the application will be referred back to the examiner to complete the examination process, including determining whether the amended claim(s) is/are novel and inventive.
- 25 If no amendments are filed within that period, the application will be refused under section 18(3) for failure to comply with section 1(2).

Appeal

- 26 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