



wagering game. Both claims relate to the same inventive concept, so I need only consider one of these claims for the purposes of this decision.

5 Claim 1 reads:

Apparatus for generating a portable wagering game for predetermined target devices, which comprises:

(i) a development computer that is connected to a network, the development computer being operable to receive code defining a wagering game for execution in an electronic wagering game machine environment, and to decompose the wagering game into portable widgets for porting to an environment, different from the electronic wagering game machine environment, the development computer being operable:

(a) to analyse the code to identify one or more aesthetic assets, one or more wagering game presentation engines, and game logic of the wagering game;

(b) to wrap the analysed code in a wagering game widget shell code that provides a target user interface for the portable target device in order to generate a game logic widget, a presentation engine widget and an aesthetic assets widget; and

(c) to make the widgets available to a user's computer over the network; and

(ii) a user's computer that is connected to the network and includes a wagering game editor that includes a graphical user interface, the wagering game editor being operable:

(a) to display representations of the one or more aesthetic assets widgets, the one or more wagering game presentation engine widgets, and the game logic widgets into separate palettes; and

(b) to enable the user to select widgets from the palettes;

wherein

(iii) the wagering game editor having a widget compatibility evaluator that is operable:

(a) to determine whether a selected presentation engine widget is compatible with a selected aesthetic assets widget, and if not to output a first notification accordingly,

(b) to determine whether the selected presentation engine widget is compatible with a selected game logic widget, and if not to output a second notification accordingly, and

(c) if the widgets are compatible, to assemble the widgets in order to generate portable wagering game,

(iv) the wagering game editor is operable to cause the user's computer to transmit the generated wagering game over the network to the development computer; and

(v) the development computer is operable selectively to make the generated wagering game available to said target devices over the network.

## The law

- 6 As a Hearing Officer at the IPO, I am bound to follow the decisions of the UK courts. The applicant has argued that the reasoning in *Symbian*<sup>1</sup> expressly approves the EPO Board of Appeal case law and he refers me to paragraph 49 of that judgment:

*"In deciding whether the Application reveals a "technical" contribution, it seems to us that the most reliable guidance is to be found in the Board's analysis in Vicom<sup>2</sup> and the two IBM Corp decisions<sup>3</sup>, and in what this court said in Merrill and Gale. Those cases involve consistent analysis which should therefore be followed unless there is a very strong reason not to do so."* [Emphasis added]

- 7 In *Symbian*, the Court of Appeal considered the role of precedent and the question of whether the UK should follow the EPO practice. The relevant paragraphs are:

33. As we have mentioned, there are three previous decisions of this court on the effect of section 1(2)(c) of the 1977 Act, and, as we have implied, there are a number of decisions of the Board on art 52(2)(c) of the EPC. In principle, the Court of Appeal is bound by one of its previous decisions unless that previous decision is inconsistent with a subsequent decision of the House of Lords (in which case, the previous decision cannot be followed), is inconsistent with an earlier Court of Appeal decision (in which case the court may choose which previous decision to follow), or can be shown to have been arrived at *per incuriam* (i.e. without reference to a relevant statutory provision or other authority) – see *Young v Bristol Aeroplane Co Ltd* [1944] KB 718.

34. However, in *Actavis UK Ltd v Merck & Co Inc* [2008] EWCA Civ 444, Jacob LJ, giving the judgment of the court, held that this court was also free to depart (but not bound to depart) from one of its previous decisions on a point in the field of patent law if satisfied that the Board have formed a settled view on that point, which differs from that arrived at in that previous decision. At [48], Jacob LJ made it clear that the right to depart from a previous decision only arose if the "jurisprudence of the EPO" on the point at issue was "settled", and that, even where that was the case, this court was "not bound to do so": for instance in "the unlikely event" that it thought the jurisprudence was plainly unsatisfactory.

35. This analysis is reinforced by two observations in the House of Lords, namely *Merrell Dow v Norton* [1996] RPC 76 at 82, and, very recently, *Conor v Angiotech* [2008] UKHL 49, [3] where Lord Hoffmann emphasised the desirability of the English courts adopting the same principles as that of the Board when assessing obviousness.

36. Given that there are decisions of this court and of the Board which relate to the ambit of the computer program exclusion in art 52, the right basis for assessing that ambit in this court should be as follows. If the judgments in the Court of Appeal cases give tolerably clear guidance which would resolve the issue on this appeal, then we should follow that guidance, unless it is inconsistent with clear guidance from the Board, in which case we should follow the latter guidance unless satisfied that it is wrong.

- 8 The applicant has argued that, in the case of *Symbian*, the Court has said that I may follow the EPO practice in favour of any inconsistent UK precedent. I do not accept this argument. Paragraph 34 of *Symbian* states that 'this Court', that is the Court of Appeal, may depart from, although it is not bound to depart from, its previous decisions if it is satisfied that the Board has formed a settled view on an issue. If I could be certain that the Court of Appeal would follow the EPO's approach, it might be difficult for me to continue to follow the precedent set in *Symbian*. However, the Court of Appeal clearly did not consider the law at the EPO to be settled at the time of *Symbian*. Further, even if the Court did now consider the law settled it is not

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<sup>1</sup> *Symbian Ltd v Comptroller-General of Patents* [2008] EWCA Civ 1066

<sup>2</sup> Decision T 84/0208 (Vicom)

<sup>3</sup> Decision T 83/0006 (IBM) and Decision T 85/0115 (IBM)

certain that it would adopt the EPO approach, as it is not bound to depart from its earlier precedent.

- 9 The decision that the Court of Appeal may choose to depart from its own previous decisions does not allow me, as a Hearing Officer within the IPO, to choose to depart from the Court's previous decisions even if, and I do not decide this issue here, I consider the law to be settled within the EPO. I therefore do not accept the applicant's submission that I may re-interpret UK case law: this is a matter for the Court.
- 10 The section of the Act concerning inventions that are excluded from patentability is section 1(2), which reads:

*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) ...;*

*(b) ...;*

*(c) a scheme, rule or method for performing a mental act, playing a game or doing business or a program for a computer;*

*(d) ...; 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 In order to decide whether an invention relates to subject matter excluded by section 1(2), the Court of Appeal has said that the issue must be decided by answering the question of whether the invention reveals a technical contribution to the state of the art (cf *Aerotel*<sup>4</sup> and *Symbian*). The Court of Appeal in *Aerotel* set out the following four-step test to help decide the issue:

1) construe the claim;

2) identify the actual (or alleged) contribution;

3) ask whether it falls solely within the excluded subject matter;

4) check whether the actual or alleged contribution is actually technical in nature.

- 12 The operation of the test is explained at paragraphs 40-48 of the judgment. Paragraph 43 confirms that 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. Paragraph 47 adds that a contribution which consists solely of excluded matter will not count as a technical contribution.
- 13 In *Symbian Ltd's Application*, the court made it clear that in deciding whether an invention is excluded, one must ask does it make a technical contribution? It does not matter whether it is asked at step 3 or step 4. If it does, then the invention is not excluded.

## **Arguments and analysis**

### Step 1: construe the claim

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<sup>4</sup> *Aerotel Ltd v Telco Holdings Ltd and Macrossan's Application* [2006] EWCA Civ 1371

- 14 Construing the claims is straightforward: the claims define an apparatus and a method as defined in claim 1 and claim 8 respectively. These claims have equivalent scopes and define a development computer and a user's computer which are operable as defined in the claims.

Step 2: identify the actual (or alleged) contribution

- 15 The applicant states that the problem underlying the invention is to provide a computer network apparatus that (i) enables users to generate new wagering games based on existing wagering games that have been developed for playing on specific wagering game machines; and (ii) enables those new wagering games to be made available for execution on other devices (target devices) different from the wagering game machines for which the original (existing) wagering game had been developed.
- 16 To do this, the applicant explains that a conversion process must take place as an electronic game that has been developed for one kind of machine cannot be executed on a different kind of computer. This conversion process involves a first computer decomposing the existing wagering game into portions of code (widgets) that specify parts of the games – such as the game logic and the way it is presented – and to wrap the widgets in code that will enable them to be run on target devices. These widgets are then transmitted over a network to a number of second (users') computers where the widgets can be displayed on a graphical user interface within "palettes" and enabling the user to assemble a new wagering game from the widgets using an editor. The editor on the users' computers can generate and output warnings when widgets that are incompatible with each other are selected, so ensuring that the new wagering game will be functional. The second computers return the new games to the first computer, from which the new games can be made available via the network to the target computers.
- 17 Although there is no succinct statement on file from the applicant, from the arguments before me, it appears to me that he sees the contribution as the combination of (i) the conversion process that enables the widgets to be run on different computers and (ii) the generation of warnings to the user when widgets incompatible with each other are selected, so ensuring that the new wagering game will be functional.
- 18 The examiner argues that the problem addressed by the invention is the creation of wagering games which users will find entertaining and appealing. The advantage of the invention is allowing the wagering game operator to use the creative input of the community in order to modify and develop wagering games. He therefore assesses the contribution as:
- "Generating a portable game for predetermined target devices comprising operating a development computer as defined in the claims and operating a user's computer as defined in the claims, wherein the generation of the game uses the creativity of the user in order to develop a game for the game developer."
- 19 So what has been added to the sum of human knowledge? Looking at the substance of the claims, it seems to me that the contribution must include an acknowledgement of the user input to put the invention into effect as well as the

computer program aspects identified by the applicant. I therefore agree with the examiner's assessment of the contribution.

Steps 3 and 4: ask whether it falls solely within the excluded subject matter and whether it is technical

- 20 There is no doubt that the contribution requires a computer program for its implementation. In fact, the invention uses two different computer programs: one operating on the development computer and one operating on the user's computer. However, in considering the nature of this contribution, I am mindful of paragraph 22 of *Aerotel*, which reminds me that just because a computer is used in an invention, it does not necessarily mean that the invention is excluded from patentability. What matters is whether or not the program provides a technical contribution.
- 21 The Court of Appeal in *Symbian* gave useful guidance at paragraphs 52-58 as to when a program might make a technical contribution sufficient to avoid the exclusion. It particularly emphasised (see paragraph 56) the need to look at the practical reality of what the program achieved and to ask whether there was something more than just a "better program". At paragraph 58 the Court stated that a technical innovation, whether within or outside the computer, would normally suffice to ensure patentability.
- 22 The *Halliburton*<sup>5</sup> judgment gave further guidance at paragraphs 33-36 on how to assess whether an invention implemented in computer software might make a technical contribution. It particularly emphasised the need to consider what task the program (or programmed computer) performed (paragraph 33). Paragraph 34 states "If the task the system performs itself falls within the excluded matter and there is no more to it, then the invention is not patentable" even though the task may have real world consequences. Specifically, paragraph 35 says:
- "The business method cases can be tricky to analyse by just asking whether the invention has a technical effect or makes a technical contribution. The reason is that computers are self evidently technical in nature. Thus when a business method is implemented on a computer, the patentee has a rich vein of arguments to deploy in seeking to contend that his invention gives rise to a technical effect or makes a technical contribution. For example the computer is said to be a faster, more efficient computerized book keeper than before and surely, says the patentee, that is a technical effect or technical advance. And so it is, in a way, but the law has resolutely sought to hold the line at excluding such things from patents. That means that some apparently technical effects do not always count. So a computer programmed to be a better computer is patentable (*Symbian*) but as Fox LJ pointed out in relation to the business method exclusion in *Merrill Lynch*, the fact that the method for doing business may be an improvement on previous methods is immaterial because the business method exclusion is generic."
- 23 Whilst developing games may be a technical task I note that the present invention does not actually create or develop games itself: it is the user that actually creates the game, using the wagering game editor provided by the present invention. The present invention merely provides the tools needed for a relatively unskilled operator to create wagering games from various widgets that the user may select. In assessing whether the contribution is technical, it is convenient to assess the contribution from the conversion process and the widget compatibility evaluator separately.

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<sup>5</sup> Halliburton Energy Services Inc [2011] EWHC 2508 (Pat)

## Conversion process

- 24 Turning first to the conversion process as defined in clause (i) of claim 1. The applicant submits that this process is technical and refers to me to *RIM*<sup>6</sup>. Paragraph 132 of that judgment explains that, in that case, the invention aimed to solve the problem that field (mobile) computers could not handle substantial emails because of their limited processing power. The solution provided by the claimed invention was to modify (reformat) the emails at a server into a form that could be handled by the mobile computers and supply the modified emails to the mobile computer. This enabled the mobile computer to handle emails that it otherwise could not handle. Paragraphs 184 to 186 of the judgment held that this reformatting was a relevant technical effect and accordingly the invention was not excluded.
- 25 Applying this judgment to the present application, the applicant submits that it is clear that the effect, provided by the invention, of providing to target computers new electronic games derived from electronic games which otherwise could not be handled by the target computers is a relevant technical effect which takes the invention outside the exclusions. In other words, the overall effect of the invention claimed is analogous to *RIM* in that reformatting data defining games takes place to enable it to be processed on computers which otherwise could not process it. He also submits that the task of generating wagering games is a technical task.
- 26 I am not convinced that the present invention is analogous to the invention at suit in the judgment of *RIM* and that it was the reformatting of data *per se* that was found to be a technical contribution. Paragraph 186 reads:
- “It is now settled, at least at this level, that the right approach to the exclusions can be stated as follows. Taking the claims correctly construed, what does the claimed invention contribute to the art outside excluded subject matter? **The test is a case-by-case test, and little or no benefit is to be gained by drawing analogies with other cases decided on different facts in relation to different inventions.** *RIM* says that the point does not require elaboration. It contends that all that is claimed, as a matter of substance, is a collection of programs for computers. I think this is wrong. What the claims give is a technical effect: computers running faster and transmitting information more efficiently, albeit ultimately for the purpose of displaying part of that information.” [Emphasis added]
- 27 So while the claimed invention did involve reformatting data that were being transferred to a field computer, doing so resulted in the field computers being able to run faster and the system was able to transmit information more efficiently than prior systems had done. This is what actually provided the patentable, technical, contribution. As far as I can discern from the present application, there is no such similar advantage provided. From the description, notably paragraphs [0004] and [0035], it appears that the purpose of the present invention is to provide tools that allow users to create their own wagering games for use by the wagering game operator. This allows the wagering game operator to use the creative input of the community in order to modify and develop wagering games. The wagering game developer can then test the user created wagering games and possibly reward the users which create popular games. I cannot see any reference to the present invention giving any benefits in terms of faster operation of the computer, greater

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<sup>6</sup> Research In Motion UK Ltd. v Inpro Licensing SARL [2006] EWHC 70 (Pat)

network efficiency, improved reliability, or the like, which would help to persuade me that the present invention provides a technical contribution.

#### Widget compatibility evaluator

- 28 The applicant submits that the widget compatibility evaluator defined in clause (iii) of claim1 provides a technical effect which takes the claimed invention outside the exclusions. He notes that the evaluator determines whether the conditions in the system are such that widgets which have been selected for use in combination are in fact technically compatible with each other and, if not, an alarm or alert notification is output. This feature thus addresses the problem that different selected widgets might not work with each other.
- 29 The applicant draws my attention to T 85/0115 (IBM), in which the EPO Board of Appeal held that detecting an outputting an indication of conditions prevailing within a machine or system is basically a technical problem, and concluded that the invention in the case in question, was not excluded from patentability. In particular he notes the following passages:
- (a) Paragraph II of the Summary of Facts and Submissions indicating that the claims relate to decoding stored phrases and obtaining a readout of events in a text processing system;
  - (b) paragraph 3 of the Reasons for the Decision pointing out that the method involves both a means for detecting events in the system and a means for displaying messages;
  - (c) paragraph 7 of the Reasons, stating that the Board takes the view that giving visual indications automatically about the conditions prevailing in an apparatus or system is basically a technical problem.
- 30 Thus, he says, it is clear that the detection of conditions prevailing within a computer system was considered to be a technical contribution.
- 31 The applicant also cites the EPO Board of Appeal decision T 05/0717 (*Labtronix*) where paragraph 5.2 reads:
- “Displaying **the outcome of the previous games** informs the player **of the internal state of the gaming apparatus and of the way it will behave under the occurrence of a further outcome** and is in this way **similar to any display of the internal state of the apparatus in a more classical field, such as displaying the temperature of an internal combustion engine or the pressure of an autoclave**. The rules of the game, on the other hand, do not require any display at all.” [Emphasis added]
- 32 He notes that although the output display in *Labtronix* concerned conditions **within a game**, this was regarded as not excluded even though the rules of games are excluded as such.
- 33 The applicant further argues that a similar approach was followed in the *PKTWO*<sup>7</sup> judgment. He states that this case concerned an invention for monitoring electronic communications for, in particular, language that might be indicative of a paedophile taking part in the communication. When such language was detected, the system would generate an alarm and transmit it to a remote computer. The sole novelty was in the language processing since there was prior art showing a similar system in

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<sup>7</sup> Protecting Kids the World Over (PKTWO) Lrd [2011] EWHC 2720 (Pat)



which an alarm was generated and transmitted but with a different form of language processing. Accordingly, the PKTWO invention was a system for monitoring for particular conditions within a computer system and generating an alarm when such conditions were detected. The invention was held patentable and paragraph 34 states:

“The effect here, viewed as a whole, **is an improved monitoring of the content of electronic communications.** The monitoring is said to be technically superior to that produced by the prior art. That seems to me to have the necessary characteristics of a technical contribution outside the computer itself.” [Emphasis added.]

This, the applicant, submits is consistent with EPO Board of Appeal case law.

- 34 The widget compatibility evaluator which forms part of the present invention gives an indication of incompatibility between widgets in the manner claimed. There is no suggestion that the formation of the message itself is anything other than conventional. It is further noted that the display of the message in the present application is not completely automatic: it relies on the user selecting a number of game widgets from the palettes. The display of a message in the present application therefore does not relate to the “conditions prevailing within a machine or system” as described in *IBM*. It merely provides an alert to the user that certain widgets that have been selected are incompatible, which relates purely to the functioning of software and not to the conditions prevailing within a machine or system as was the case in *IBM*. The claimed invention in *IBM*: “related to a new data structure system embodied in an algorithm, which was faster and required less data storage than the state of the art. The system was concerned with displaying messages, such as the absence of a required disk, to the user on the screen. The Board similarly held the claim was technical in character.” (from paragraph 38, *Symbian*). Therefore, I do not believe the present invention is analogous to the invention in *IBM*.
- 35 I have noted the decision of the EPO Board of Appeal in T 0717/05 (*Labtronix*) drawn to my attention by the applicant. However, I am not persuaded that the present invention is a patentable invention from the reasoning used in this decision, even considering the earlier T 85/115 (*IBM*) decision. The invention of *Labtronix*, in the auxiliary request, related to informing a gaming machine player about past wins and losses in the gaming machine. The present invention does not relate to such a problem. It relates to generating a portable wagering game in which a player is informed when incompatible widgets are used together. I am not convinced that merely informing a user of certain conditions relating to a process that a computer carries out is necessarily patentable: it would depend on other matters, including the reason why the message was being shown to the user
- 36 It is further noted that the reasoning used in the *Labtronix* decision appears to be at odds with that used in an *IGT*<sup>8</sup> judgment. In this judgment four applications relating to various systems comprising gaming machine and gaming systems were found to be excluded from patentability even though the player was informed of conditions within the gaming machine or gaming system which related to game play. Given that I am bound to follow the judgments of UK Courts, *IGT* would appear to have precedence over the EPO Board of Appeal decision of *Labtronix*.

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<sup>8</sup> *IGT v The Comptroller General of Patents* [2007] EWHC 1341 (Pat)

37 I cannot see the significance of *Protecting Kids the World Over* since the present invention relates to a completely different area of technology and addresses different problems. The present invention does not relate to monitoring the content of electronic communications. Taking *PKTWO*, I quote the whole of paragraph 34 in which Floyd J set out his reasons for allowing the application:

"I am unable to accept these submissions. I start with the proposition that the generation and transmission of an alert notification to the user/administrator is not a relevant technical process. I accept that in many cases this may be correct. Plainly it was correct in the case of two out of the three patents considered by Mann J in *Gemstar*, where information was simply displayed on a screen. **But what is in play in the present case, namely an alarm alerting the user, at a remote terminal such as a mobile device, to the fact that inappropriate content is being processed within the computer, is in my judgment qualitatively different.** First of all, the concept, although relating to the content of electronic communications, is undoubtedly a physical one rather than an abstract one. In that respect it was more akin to the third of the three patents considered by Mann J in *Gemstar*. Secondly, the contribution of claim 33 does not simply produce a different display, or merely rely on the output of the computer and its effect on the user. **The effect here, viewed as a whole, is an improved monitoring of the content of electronic communications. The monitoring is said to be technically superior to that produced by the prior art. That seems to me to have the necessary characteristics of a technical contribution outside the computer itself.**" [Emphasis Added]

38 The above shows that it was more than just an indication of the conditions with language which was being processed within the computer that Floyd J found gave the technical contribution that was found to be patentable. The fact that the monitoring was said to be improved appears to have played an important part in the judge's reasoning in determining that the application of *PKTWO* did have a technical contribution.

39 The examiner has also objected that the invention relates to a business method and I agree. Despite the applicant's submission, there is no requirement for trading to take place for an application to be found to be a method for doing business as such. For example, there is no trading in the claimed invention of Mr Macrossan's application as found in the *Aerotel* judgment. Mr Macrossan's application related to the automatic formation of the legal documents needed to incorporate a company but it was still held to be a method of doing business. The sole purpose of the claimed invention, as stated in the description, is to provide tools to users to enable them to create new games, so that the game developer can use the creativity of the community to create games. The invention therefore fails under the business method exclusion since the invention is nothing more than a business tool used by the wagering game developer to allow users create games for them.

40 Finally, Lewison J in his judgment in *AT&T/CVON*<sup>9</sup> identified five "signposts" to help decide whether an invention is excluded. Those signposts are as follows:

1) whether the claimed technical effect has a technical effect on a process which is carried on outside the computer;

2) whether the claimed technical effect operates at the level of the architecture of the computer; that is to say whether the effect is produced irrespective of the data being processed or the applications being run;

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<sup>9</sup> AT&T Knowledge Ventures LP [2009] EWHC 343 (Pat)

3) whether the claimed technical effect results in the computer being made to operate in a new way;

4) whether there is an increase in the speed or reliability of the computer;

5) whether the perceived problem is overcome by the claimed invention as opposed to merely being circumvented.

41 I shall address these signposts in order. Firstly, the present claimed technical effect has no technical effect on a process which is carried on outside of the computer: the invention merely fragments a game into distinct modules and allows a user to create a game from various available modules. There is no control of anything outside of the computers. Secondly, there is obviously no change in the level of the architecture of the computer. Thirdly, the claimed technical effect does not result in the computer operating in a new way beyond that which is found in any computer operating a new program: the two computer programs both perform their own functions without affecting the computer further. Fourthly, there is no increase in computer speed or reliability given by the claimed technical effect. Finally, the problem (the development of new games) is not a technical problem as such, although technical means (the computer programs) are used to solve the problem.

### **Conclusion**

42 The invention does not involve a technical contribution. I find that the invention is excluded under section 1(2)(c) as a computer program and a business method. I can find no possible amendment in the specification that will render the claims patentable. I therefore refuse the application under section 18(3).

### **Appeal**

43 Any appeal must be lodged within 28 days.

MRS S E CHALMERS  
Deputy Director, acting for the Comptroller