



PATENTS ACT 1977

APPLICANT LexisNexis Risk Solutions, Inc.

ISSUE Whether patent application number
GB1101744.9 complies with Sections 1(1)(b) and
1(2)

HEARING OFFICER Ben Buchanan

DECISION

- 1 Patent application GB1101744.9 entitled “Systems & Methods of Calculating and Presenting Automobile Driving Risks” is derived from the corresponding PCT application filed by Choicepoint Services Inc. on 31 July 2009 and published as WO2010/014965. The application claims an earliest priority date of 31 July 2008, and was republished on 13 April 2011 with the serial number GB 2474405. The applicant’s name was changed to LexisNexis Risk Solutions, Inc. on 15 June 2011.
- 2 The examiner’s first examination report adopted Box No V of the International Preliminary Report on Patentability raising novelty and inventive step objections. The report also raised the issue of excluded matter under section 1(2) and deferred full examination until these objections were addressed.
- 3 Rounds of correspondence have concentrated on these issues. Amended claims have been filed and on 16 January 2013 the examiner issued a further search and examination report objecting to patentability under section 1(2), the novelty and the inventiveness of the amended claims. The applicants filed further amended claims in response on 22 March 2013, which are the most recent claims on file. In the letter accompanying the claims, the applicants counter-argued against all the objections raised by the examiner and requested a hearing if the application should not be found in order. The examiner’s final report set out objections under section 1(2) – excluded matter – and section 1(1)(b) – inventive step, as well as the clarity of the claims. On 1 May 2013, the applicants requested that instead of a hearing the decision should be taken on the papers. The compliance period has been extended twice, and expired on 31st May 2013.

The Invention

- 4 The invention relates in general to a database of driving performance data, which receives data from multiple sources and which may provide data to multiple parties.

- 5 The driving performance data may be used for assessing risk for the purposes of calculating insurance premiums, or other purposes such as advertising and marketing and may be used by bodies including government agencies, employers or for consumer protection.
- 6 The invention uses telematic driver data and vehicle data from on-board devices, and aggregated data from other sources, to produce driving performance data. At least some of the data is processed into a common format. A violation code engine is configured to separate and categorise driver violations in a historical record to provide a driver violation pattern.

The Claims

- 7 The most recent set of claims, filed on 22 March 2012, includes two independent claims: a centralised, shared contributory data repository of driving performance data (claim 1) and a method of obtaining driving performance data derived from received data (claim 8).

Claims 1 and 8 read as follows:

1. A centralized, shared contributory data repository of driving performance data comprising:

a centralized contributory database configured to receive and store telematic driver data and vehicle data from a plurality of unique data sources, the data concerning a plurality of drivers and automobiles, wherein the telematics driver and vehicle data is derived from:

on-board vehicle devices that monitor and record data from various embedded sensors; and information aggregated from multiple disparate contributors in varying data formats;

a data receipt processor operable to manage receipt of telematic driver and vehicle data in a first data format and transform at least some data elements of the telematic driver and vehicle data into a second data format to ensure that data submitted in different formats is put into a common format without compromising the integrity of the data; and a driving performance engine configured to analyse data stored in the centralized database; and

a violation code engine configured to separate violations in a driver historical record into code based categories based on violation codes and, based on the categorized violations, to provide a driver violation pattern to an interested party.

8. A method of obtaining driving performance data derived from received data, the method comprising:

receiving an initial data set into a memory, the initial data set comprising telematic driver and vehicle data derived from:

Information aggregated from multiple disparate contributors in varying data formats; and

on-board vehicle devices that monitor and record data from various embedded sensors;

transforming at least a part of the initial data set into a production data set such that the transformation augments certain data elements in the initial data set into predetermined states, wherein transforming the initial data set into a production data set comprises formatting and validating the initial data set format to ensure that data submitted in different formats is put into a common format without compromising the integrity of the data, and changing elements in the initial data set based on the formatting and validating and separating violations in a driver historical record into code based categories based on violation codes;

storing the production data set into a centralized shared data repository;

receiving one or more data inquiries from one or more interested parties and in response to the one or more data inquiries providing a driver violation pattern based on the categorized violations stored in the centralized data repository.

The Law

Inventive step

- 8 Section 1(1) deals with the conditions for grant of a patent, and states that:

A patent may be granted only for an invention in respect of which the following conditions are satisfied, that is to say –

(a) the invention is new;

(b) it involves an inventive step;

[other provisions not relevant]

- 9 Section 3 then sets out how the presence of an inventive step is determined:

An invention shall be taken to involve an inventive step if it is not obvious to a person skilled in the art, having regard to any matter which forms part of the state of the art by virtue only of section 2(2) above (and disregarding section 2(3) above).

- 10 It is well-established that the approach to adopt when assessing whether an invention involves an inventive step is to work through the steps set out by the Court of Appeal in *Windsurfing*¹ and restated by that Court in *Pozzoli*². These steps are:

(1)(a) Identify the notional “person skilled in the art”

(1)(b) Identify the relevant common general knowledge of that person;

(2) Identify the inventive concept of the claim in question or if that cannot readily be done, construe it;

¹ *Windsurfing International Inc. v Tabur Marine (Great Britain) Ltd* [1985] RPC 59

² *Pozzoli SpA v BDMO SA* [2007] EWCA Civ 588, [2007] FSR 37

(3) Identify what, if any, differences exist between the matter cited as forming part of the “state of the art” and the inventive concept of the claim or the claim as construed;

(4) Viewed without any knowledge of the alleged invention as claimed, do those differences constitute steps which would have been obvious to the person skilled in the art or do they require any degree of invention?

Excluded matter

- 11 The examiner has raised an objection under section 1(2)(c) of the Patents Act 1977 that the invention is not patentable because it relates to a method for doing business and a program for a computer as such. The relevant provisions of this section of the Act are shown in bold below:

1(2) It is hereby declared that the following (amongst other things) are not inventions for the purpose of the 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 provisions shall prevent anything from being treated as an invention for the purposes of the Act only to the extent that a patent or application for a patent relates to that thing as such.

- 12 As explained in the notice published by the UK Intellectual Property Office on 8 December 2008³, 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*⁴.
- 13 The interpretation of section 1(2) has been considered by the Court of Appeal in *Symbian*⁵. *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/Macrossan* 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*⁶ 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,

³ <http://www.ipo.gov.uk/pro-types/pro-patent/p-law/p-pn/p-pn-computer.htm>

⁴ *Aerotel Ltd v Telco Holdings Ltd and Macrossan's Application* [2006] EWCA Civ 1371; [2007] RPC 7

⁵ *Symbian Ltd v Comptroller-General of Patents*, [2009] RPC 1

⁶ *Merrill Lynch's Application* [1989] RPC 561

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.

- 14 Subject to the clarification provided by *Symbian*, it is therefore appropriate to proceed on the basis of the four-step approach explained at paragraphs 40-48 of *Aerotel/Macrossan* namely:

(1) Properly construe the claim.

(2) Identify the actual contribution (although at the application stage this might have to be the alleged contribution).

(3) Ask whether it falls solely within the excluded matter.

(4) If the third step has not covered it, check whether the actual or alleged contribution is actually technical.

- 15 The operation of this test is explained at paragraphs 40-48 of the decision. 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 46 explains that the fourth step of checking whether the contribution is technical may not be necessary because the third step should have covered the point.
- 16 The examiner and applicants have provided arguments following *Aerotel/Macrossan* and *Symbian* and this is the approach I shall apply.

Argument and Analysis

- 17 The Examiner's final correspondence dated 2 April 2013 sets out three objections against the most recent claims: Excluded matter; Inventive step and Clarity. In considering either of the first two objections I must construe the claims and so I will by necessity consider the clarity issue. However, if I find the application is excluded or is not inventive and I do not consider that amendments to the claims can overcome one of these objections, then I need not consider the other objection. This is a common approach as for example recently followed by the Hearing Officer in *Aueon Inc.*⁷.
- 18 Consequently I shall first consider the objection which has been maintained by the Examiner throughout proceedings which asserts that the application is excluded from patentability under section 1(2). If I find in the applicants' favour I shall then consider whether the current claims define an inventive step. If I decide that the application is excluded and that there is nothing in the application which may enable my finding to be overcome, then the question of whether the claims define an inventive step is moot.

Construing the claims (step 1)

- 19 The first step is to construe the claims. In their respective most recent correspondence, the applicants and the examiner each summarise what they regard

⁷ Aueon Inc.'s Application BL O/248/13

the claims to relate to slightly differently. In their letter of 22 March the applicants state:

“...the claims relate to a centralized, shared contributory data repository of driving performance data.”

20 In his letter of 2 April 2013 the examiner states:

“Claims 1-17 relate to a method and shared centralised repository for receiving and processing vehicle and driver data from disparate data sources, to provide a driver violation pattern to an interested party.”

21 I do not think these different summaries indicate disagreement, but I note that the examiner’s construction specifically reflects the feature of disparate data sources which the applicants’ arguments in correspondence rely on, and which is defined in the claims. The examiner also specifically reflects the provision of a driver violation pattern – what the invention produces – which features in the independent claims.

22 However the latter feature, of providing a driver violation pattern, is, to my mind, not clearly defined by the claims alone. It is not clear from the claims whether violations in a driver historical record are identified from the telematic driver and vehicle data stored in the centralised database. In other words, it is not clear from the claims whether the violation engine makes use of the driver and vehicle data previously defined by the claims as aggregated and processed from multiple sources.

23 Section 125(1) of the Act states:

For the purposes of this Act an invention for a patent for which an application has been made or for which a patent has been granted shall, unless the context otherwise requires, be taken to be that specified in a claim of the specification of the application or patent, as the case may be, as interpreted by the description and any drawings contained in that specification, and the extent of the protection conferred by a patent or application for a patent shall be determined accordingly.

24 The current authority on claim construction is found in *Kirin-Amgen Inc v Hoechst Marion Roussel Ltd*⁸, where Lord Hoffman held that “When applying a ‘purposive construction’, the question is always what the person skilled in the art would have understood the patentee to be using the language of the claim to mean”.

25 Reference to the description, for example on page 20 at lines 2-10 and page 30 at lines 10-20, aids interpretation of the claims; it is clear that occurrences of violation of vehicle operation (e.g. speeding) are identified from the driving performance data in the centralised contributory database and violation codes are applied, and it is on the basis of these applied codes that the violation engine defined in the claims categorises violations and provides a driver violation pattern.

26 I therefore construe the claims to mean that the violation pattern is provided on the basis of violation codes assigned to driving performance data which is received from multiple sources and stored in the centralised contributory database.

⁸ *Kirin-Amgen Inc v Hoechst Marion Roussel Ltd* [2005] RPC 9

- 27 In his letter of 2 April, the examiner raises an objection in respect of claims 1 & 8, stating that it is unclear how transforming data from a first format to a second format necessarily ensures that data is put into a common format. I note a related problem which is that the driver and vehicle data received and stored from multiple sources in the database is defined as *telematic*, whereas the data selectively transformed into a second format is defined as *telemetric*. Conventionally, these two terms appear to have different meanings⁹, but there is no suggestion in the application that the terms are used as anything other than synonyms. For example Figure 1 and the supporting description on pages 12-14 describe determining whether a party is willing to share *telemetric* information, and then (if so) providing a device to allow *telematic* recording. This renders the feature of transforming the data furthermore unclear.
- 28 I think having regard to the application as a whole, in particular the parts I referred to above, a skilled person would understand that the patentee uses the language of the claim to mean that data from multiple different sources, including (telematic) data representing driver and vehicle usage, from the vehicle itself, or from providers who collate such data about vehicles and drivers, is selectively transformed into a common format.
- 29 In summary, then, I construe the claims as the examiner did. They relate to a method and shared centralised repository for receiving and processing vehicle and driver data from multiple data sources, to provide a driver violation pattern to an interested party. I would also add that processing the data includes selectively transforming the data into a common format.

Identify the actual contribution

- 30 For the second step of *Aerotel/Macrossan*, it is necessary to identify the contribution made by the invention. Paragraph 43 of *Aerotel/Macrossan* explains that this is to be determined by asking what it is - as a matter of substance not form - that the invention has really added to human knowledge having regard to the problem to be solved, how the invention works and what its advantages are.
- 31 There seems to be agreement between the applicants and the examiner that the substance of the contribution does not lie in the hardware used as this is conventional. The applicants define the contribution as:
- “enhanced extraction of selected data across multiple (disparate) contributing providers to produce a centralised contributory repository of driving performance data.”
- 32 The examiner identified the contribution as:
- “a data repository that receives driver and vehicle data from a variety of disparate contributors in different formats, transforms the data into a common format, and provides a driver violation pattern to an interested party.”
- 33 I think these formulations are consistent, but I am not sure that either fully covers the pointers in paragraph 43 of *Aerotel/Macrossan* in light of my construction of the

⁹ See for example <http://en.wikipedia.org/wiki/Telematics>

claims. The contribution also lies in combining data from multiple sources - both on-board vehicles and disparate contributors (providers) and (as I found when construing the claims) assigning violation codes and categorising violations to provide a driver violation pattern.

I therefore consider the actual contribution to be:

Receiving data from multiple sources including on-board vehicle devices and disparate contributors, transforming at least some of the data so as to put the data into a common format, assigning violation codes to violations represented by the data and categorising the violations to provide a driver violation pattern.

- 34 This is the contribution defined by the claims and it falls within the scope of the contribution put forward by the applicants. I believe it is consistent with the contributions identified by both the applicants and the examiner. However the contribution I have set out above explains, in the language of the claims, how the invention works and what its advantages are.

Does the contribution fall solely within excluded subject matter? Is the contribution technical in nature? (Steps 3 and 4)

Program for a computer

- 35 There is no doubt in my mind that the contribution requires a computer program for its implementation. The receipt, storage, transformation, analysis and categorisation – the processing – of data within the contribution is all effected by a program for a computer.
- 36 The applicants argue in their letter of 22 March 2013 that (1) “a centralised, shared data repository is more than a computer program as such. It is a piece of technical apparatus, carefully designed to ‘collect, aggregate and analyse’ the...data”. They argue that (2) “improved reliability of data accumulation” is a technical problem and that any solution must therefore perform a technical function. They point out that (3) “the end use, purpose or nature of the data is not the fundamental factor in the assessment of the technical contribution...one must look at the claims as a whole.” They go on to argue that (4) “the claims relate to a technical architecture for receiving, transforming and processing data from ‘multiple and disparate’ contributors in a variety of data formats”. I have enumerated the applicants’ points so that I can deal with them in turn.
- 37 Addressing the first argument (1), Of course a data repository or database is a ‘technical’ apparatus, just as a computer is ‘technical’. However the question is whether the *contribution* is technical, not just the (conventional) apparatus on which the program implementing the contribution is run. Does the program, when run, provide a technical effect?
- 38 In *Halliburton*¹⁰, His Honour Judge Birss confirms at paragraph 30 that, following *Symbian*, a contribution which is implemented entirely as a result of a computer

¹⁰ Halliburton Energy Services Inc [2011] EWHC 2508 (Pat)

program operating on a computer is not excluded if the contribution is technical in nature. He goes on say, at paragraph 35:

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 of doing business may be an improvement on previous methods is immaterial because the business method exclusion is generic.

- 39 I will specifically consider the business method exclusion later, but what is clear is that a contribution implemented on a technical apparatus does not necessarily provide a technical contribution. A better computer is patentable, but a better method of doing business, or a better program, if it does not provide a technical effect, is not.
- 40 In his letter of 2 April 2013, the examiner provided extensive arguments as to why the contribution is a program for a computer as such. He referred to *Symbian*, as I have done, and to a number of Office decisions in supporting his argument that whilst the contribution may provide a “better program” it does not provide a technical effect. I will not repeat the arguments here, save to say that consistent with *Halliburton* I agree that the steps of collecting, aggregating and analysing data from multiple contributors are not technical by virtue of their being carried out on technical apparatus. Whether they give rise to a technical effect because they go beyond a better program to provide a better computer is a question I shall return to.
- 41 Regarding the second argument (2), the applicants’ assertion that the contribution provides “improved reliability of data accumulation” is obfuscated by the fact that neither their nor my formulation of the contribution reflects an improvement in reliability. The only basis for this assertion is in the application on pages 2 & 3, which describes increased reliability in the context of up to date data for determining an appropriate insurance premium. In other words the basis for calculating the insurance premium is allegedly more reliable, because it uses more data from multiple sources, and the premium better reflects the risk. Nothing in the description or the claims would seem to define an increase in the reliability of the apparatus. I cannot see how this ‘improved reliability’ reflects a technical problem and that any solution must therefore perform a technical function. I therefore reject this line of reasoning.
- 42 Turning to the third point (3), I agree that “the end use, purpose or nature of the data is not the fundamental factor in the assessment of the technical contribution...one must look at the claims as a whole.”. It is clear that the contribution is the substance of what has really been added to human knowledge, which arises when the claimed invention is put into effect. However if what has been added to human knowledge, in

substance, is characterised by the end use, purpose or nature of the data, that surely is fundamental to the consideration of whether the contribution is technical. In *Halliburton*, at paragraph 33, Judge Birss 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 (see Symbian paragraph 53 above). Clear examples are from the cases involving computers programmed to operate a method of doing business, such as a securities trading system or a method of setting up a company (Merrill Lynch and Macrossan). Inventions of that kind are held not to be patentable but it is important to see why. They are more than just a computer program as such. For example, they self evidently perform a task which has real world consequences. As Fox LJ said in Merrill Lynch (p569 at line 27), a data processing system operating to produce a novel technical result would normally be patentable. However that is not the end of the analysis. He continued: "however it cannot be patentable if the result itself is a prohibited item" (i.e. a method of doing business). When the result or task is itself a prohibited item, the application fails.

- 43 It is therefore necessary to consider whether the task (which will encompass the end use, purpose or nature of the data) when performed by the invention defined by the claims as a whole produces a novel technical result. If the task is merely characterised by the end use, purpose or nature of the data and is not technical, then the invention will be excluded.
- 44 Finally (4), the argument that "the claims relate to a technical architecture for receiving, transforming and processing data from 'multiple and disparate' contributors in a variety of data formats" is addressed at length by the examiner in his letter of 2 April 2013. As I have stated above, receiving, transforming and processing data is implemented by a program for a computer on conventional apparatus. The invention is characterised in that the data comes from multiple disparate sources, and at least some elements are transformed into a common format. Is this technical? Or is it "no more than the manipulation of data by means of a computer program" as the examiner argues?
- 45 The applicants argue that support for this conferring patentability is found following *Protecting Kids The World Over (PKTWO)*¹¹. They allege that the improved generation of an alarm in response to inappropriate communication over the Internet, in solving a technical problem lying outside the computer, is analogous to sharing "disparate data from multiple and diverse organisations to improve the generation of driving performance data". They argue that what is done with the driving performance data is no more relevant to the question of patentability than what is the response to the alarm in *PKTWO*.
- 46 As the examiner has done, I note that at paragraph 35, Justice Floyd found that the contribution lay outside the computer "on the very specific facts of the case". He regarded the content of electronic communications as physical rather than abstract and consequently the monitoring of the content and the generation of an alarm dependent thereon, at a remote terminal, to be technical. The facts of the present invention are different. Data from multiple sources is aggregated, transformed into a common format and used to generate a driver violation pattern. In *PKTWO*, as

¹¹ *Protecting Kids The World Over (PKTWO)* [2012] RPC 13

Justice Floyd acknowledges in paragraph 34, an alert notification is generated and transmitted to a user. He distinguishes this from the ‘simple’ display of information on a screen; the “output of the computer”. In contrast, the present invention aggregates and selectively formats the contents of the data repository and provides output to a user. In claim 8 this is specifically in response to an inquiry and is clearly not an alarm. I am not therefore persuaded that *PKTWO* supports the patentability of the present invention as the facts are different and so do not by analogy suggest the solution of a technical problem lying outside the computer.

The five signposts

47 In considering in detail the applicants’ arguments that the transformation and processing of multiple data is more than a program for a computer as such, the examiner applied the *five signposts* which Lewison J set out in *AT&T*¹². Following *AT&T*, in *Really Virtual*¹³, John Baldwin QC (sitting as a Deputy Judge) noted that the *AT&T* signposts, although useful, are no more than signposts. The applicants’ only argument in respect of any of the signposts is provided in their letter of 4 January 2013 in relation to the previous claims and signpost (i), however I shall consider the present claims in respect of each of the signposts in determining whether the contribution goes beyond a program for a computer as such:

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

48 The applicants’ argument in their letter of 4 January 2013 is that the contribution provides a more accurate and automated analysis of a driver’s performance. The consequences, they argue, are enhanced safety and reduced accidents. However accuracy and automation are exactly the sort of advantages associated with computer processing of data and the processing is carried on inside the computer. The contribution provides a driver violation pattern, which may be used outside the computer to influence a driver’s behaviour and performance, but in their letter of 22 March 2013 in respect of *PKTWO* the applicants argue that “what one does with that driving performance data is no more relevant to the question of patentability...”. I agree. A user acting on the basis of the driver violation pattern is not within the scope of the contribution and in any case such action is the prerogative of the user. The driver violation pattern may be presented as information to the driver, but does not have a *technical* effect outside the computer.

ii) 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;

49 The claimed technical effect relates to the processing of data. Data from multiple sources is selectively transformed into a common format before being processed to produce a driver violation pattern. This operation is at the application level; there is nothing in the patent to suggest a change in the architecture of the computer. The description refers to data provided by different communication networks and

¹² *AT&T Knowledge Ventures’ Application and CVON Innovations Ltd’s Application* [2009] FSR 19 para. 40

¹³ *Really Virtual Co Ltd v UK Intellectual Property Office* [2012] EWHC 1086 (Ch).

standards, from disparate contributors. The applicants' letter of 22 March 2013 refers to this as "different data types...via different technical channels". The transformation of this data into a common format is therefore entirely dependent upon the type of data being processed for the transformation to be effective; it will be necessary to identify the type of data in order for it to be subject to the appropriate transformation. Whilst this will need to take account of the 'technical channel', the operation is not at the level of architecture of the computer and is entirely dependent on the data being processed. The signpost then points away from a technical effect.

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

- 50 The computer does not operate in a new way. The program which is run on it determines the processing of the data and defines the contribution. However no aspect of the operation of the computer itself is new; the only change is to the application-level processing of data.

iv) whether the program made the computer a better computer in the sense of running more efficiently and effectively as a computer¹⁴

- 51 There is no change in the speed or reliability of the computer, nor any suggestion that it runs more efficiently and effectively. The computer is conventional and it is therefore not a "better computer". The only change is to the programmatic processing of driver and vehicle data.

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

- 52 The perceived problem is stated in the description as being the acquisition, recording and/or communication of comprehensive, reliable, accurate data representing driver performance. I think this is still a valid formulation, although the present claims and the applicants' most recent letter suggest that the problem of aggregating and processing disparate data into a common format is an integral factor. The claimed invention acquires data from multiple sources, processing it dependent upon its received or communicated format. Any increase in the reliability or accuracy of the aggregated data, or improvement in the generation of driving performance data, is only as a result of *more* data from *multiple* sources. The applicants' letter of 22 March 2013 refers to this as a 'greater wealth' of data. However this circumvents the problem of accurately assessing driver performance in the first place.

- 53 I have found that the five signposts do not indicate the presence of a technical effect. I therefore consider the claimed invention to relate to a program for a computer as such.

Method for doing business

- 54 As the applicants' letter of 4 January 2013 points out, for a claimed invention to be excluded, the contribution must fall *solely* into the excluded territory. Having decided that the contribution is a program for a computer as such, I must now follow

¹⁴ This wording reflects the comments of Lewison LJ in *HTC v Apple [2013] EWCA Civ 451* where he reconsidered the original wording

Halliburton and consider the task which the system performs and decide whether that too is within the excluded territory. The examiner has objected that the claimed invention also falls within the field of a method for doing business.

- 55 In their letter of 22 March 2013, the applicants point out that the task performed by the invention defined by the claims as a whole is to provide a more accurate pattern of driver performance. They go to great lengths to persuade the examiner that the invention is not (just) an insurance tool. Whilst I acknowledge the parts of the description and figures highlighted, there is little doubt in my mind that the system was conceived for that purpose. Nonetheless, if there are other uses, outside of the excluded territory, the claimed invention may make a non-excluded contribution.
- 56 The question is whether any of these other uses are outside of the field of a method for doing business, not whether they are outside the business of insurance. Whilst the description does indicate other uses beyond the insurance industry, the examples given (e.g. on page 12) such as government, research, monitoring, fleet management, tracking, consumer protection, advertising, planning and route design all seem to me to fall within the business method exclusion. There is no detail in the description which helps me to understand how the system performs a task which can provide a non-excluded contribution in practice, outside these areas and beyond a method for doing business as such.
- 57 In their letter of 4 January 2013, the applicants state that “there is no transactional or commercially-oriented aspect” to the claimed invention. That may be so (and apply equally to the present claims), but that does not mean that the contribution is technical. The examiner in his report of 16 January 2013 counter-argued that ‘business methods’ include administrative processes that do not necessarily include transactions or commerce. The contribution relates to the provision of a driver violation pattern, which is derived from aggregated data from multiple sources. The claimed invention may provide more comprehensive data than other systems, but I cannot identify an aspect of the contribution which goes beyond a method for doing business and is technical in nature. As I noted in paragraph 38 above, Judge Birss in paragraph 35 of *Halliburton* said “*the fact that the method of doing business may be an improvement on previous methods is immaterial because the business method exclusion is generic.*” In paragraph 33 of *Halliburton*, Judge Birss said “*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*”.
- 58 Consequently I find that the contribution also relates to a method for doing business as such.
- 59 I have found that the contribution falls solely within excluded subject matter, and does not provide a relevant technical effect. The contribution is not technical in nature because it does not provide a contribution in a non-excluded field, or overcome a technical problem. I have found that the invention does not provide the required technical contribution to satisfy section 1(2).

Inventive Step

- 60 I have found that the claims do not define patentable invention under section 1(2). In reaching this decision I have considered the application as a whole and I cannot

identify any grounds for amendment which might save the application. Therefore I need not consider whether the claims define an inventive step, and so I make no finding in this respect.

Conclusion

- 61 I conclude that the invention as claimed is excluded under section 1(2) because it relates solely to excluded matter; namely a program for a computer and a method for doing business as such.
- 62 Having read the application I do not think that any saving amendment is possible. I therefore refuse the application under section 18(3).

Appeal

- 63 Any appeal must be lodged within 28 days.

Ben Buchanan

Deputy Director, acting for the Comptroller