

PATENTS ACT 1977

IN THE MATTER OF

Patent Application 9519297.7

in the name of Stephen John Wills

DECISION

Introduction

Patent application 9519297.7 entitled "Identification means" was filed by the applicant, Stephen John Wills, on 21 September 1995. At that time, Mr Wills was acting on his own behalf without professional representation. The application, which claimed priority from application 9419226.7 filed on 23 September 1994, was published on 27 March 1996 as GB2293348A.

The application is concerned with assisting in the location of lost or missing children. Police or other authorities are greatly assisted in any searches or investigations if they have immediate access to information about the child. However, when parents discover that their child is missing, they may be unable to provide a full and accurate description because of worry, panic or trauma. They may also not have, or be unable to locate, a recent photograph. Mr Wills' idea is to provide a card carrying both a representation of the child and detailed information about them. Such cards may be held by the parents or grand- parents and school so as to provide an immediate source of accurate, up-to-date information in the event that a child goes missing.

Mr Wills' application as originally filed included two independent main claims with associated dependent and omnibus claims. The main claims read as follows:

Claim 1

"Identification means for use in the recovery of a lost or missing child, said identification means being in the form of a card which carries a representation of the child plus detailed information concerning the child, such information including the name of the child and key physical characteristics of the child."

Claim 5

"A method of producing identification means for assisting in the location of a lost or missing child, said method including:-

- a) taking a photograph of a child,
- b) mounting the photograph on a card,
- c) entering detailed information concerning key physical characteristics of the child on the card, and
- d) applying a protective covering to the card."

The application was passed to an examiner for search and a search report duly issued on 25 October 1995 citing four prior art documents. Although no substantive examination had been conducted at that stage, in the covering letter accompanying the search report, the examiner expressed the *prima facie* view that, in the light of the documents listed in the search report, the application was not patentable. He said he considered the documents demonstrated that laminated identification cards bearing a photograph were well known, eg as a passport or a club membership card. In his view, such a card for use in the recovery of a lost or missing child, ie wherein the card is distinguished from other cards solely on the basis that it bears details of a child, would not be patentable.

Despite this report, Mr Wills proceeded to the next stage and filed a request for substantive examination on 19 September 1996.

The first examination report under section 18(3) duly issued on 3 July 1997 and in it, the

examiner repeated as a formal patentability objection, his earlier *prima facie* view. In his opinion, the cards cited in the search report were examples of well-known identity cards such as passports and club membership cards which bear a photograph of the holder and include other information relating to the holder. While recognising that none of the cited cards were specifically designed to be identity cards for children, he considered that such a use did not constitute a patentable invention because the identification means was distinguished from known identity cards only on the basis that the representation and associated information related to a child.

Although the examiner did not specifically state so in his report, it is clear that he was basing his objection on section 1(2)(d) of the Patents Act 1977 which states that anything which consists of the presentation of information is not an invention for the purposes of the Act.

On 30 December 1997 the Office received Form 51/77, appointing Alpha and Omega to act as agents in the prosecution of Mr Wills' application, together with a response to the examination report. The response included a revised set of claims, all directed to a method of providing identification means. Amended claim 1 read as follows:

"A method of providing identification means for assisting in the location of lost or missing children, said method including:-

- a) taking photographs of the children,
- b) mounting a photograph of each child on a card,
- c) entering detailed information concerning key physical characteristics of each child on the respective card,
- d) applying a protective coating to the card,
- e) producing a second identical card for that child,
- f) giving one of the cards to the school attended by the child, and
- g) giving one of the cards to the parents or grand-parents of the child."

In a further report under s.18(3) dated 27 January 1998, the examiner raised the objection

that the claims did not relate to a patentable invention by virtue of section 1(2)(c) of the Act which excludes "schemes, rules or methods for performing a mental act, playing a game or doing business". In line with the guidance in paragraph 1.24 of the Manual of Patent Practice, he argued that "doing business" was not restricted to the activities of financial institutions or service industries but embraced the organisational and managerial activities of manufacturing industry. Accordingly, in his contention the method of providing identification means for assisting in the location of lost or missing children as defined in the amended claims fell within the scope of the exclusion.

In response to the second examination report, the applicant's agent wrote on 26 May 1998. He argued that method step b) "mounting a photograph of each child on a card" and step d) "applying a protective covering to the card" involved "physical operations", ie steps in a manufacturing process, and that the invention claimed was not directed at "the organisational and managerial activities" of the business but included actual manufacturing steps. An alternative set of claims, all directed to an identification means *per se*, was also submitted for consideration.

Alternative claim 1 read as follows:

"Identification means for use by the police in assisting in the location of lost or missing children, said identification means being produced by a method including: a) taking photographs of the children,
b) mounting a photograph of each child on a card,
c) entering detailed information concerning key physical characteristics of each child on the respective card,
d) applying a protective coating to the card,
e) producing a second identical card for that child,
f) giving one of the cards to the school attended by the child, and
g) giving one of the cards to the parents or grand-parents of the child."

In a third examination report issued on 23 September 1998, the examiner reiterated his

patentability objection with regard to the claims written either in the form of a method of providing identification means, as filed on 30 December 1997, or as identification means *per se* as filed on 26 May 1998.

He accepted that steps b) and d) were "physical operations" but expressed the view that both were conventional, as were steps a) and c), in the manufacture of identity cards. He concluded that the contribution to the art was defined solely by steps e) - g) ie "producing a second identical card for that child", "giving one of the cards to the school attended by the child" and "giving one of the cards to the parents or grand-parents of the child." In the examiner's opinion, these steps fell within the category of inventions excluded under section 1(2).

In his agent's letter dated 19 December 1998 the applicant argued that the examiner's objections were based on a misinterpretation of section 1(2) and referred the examiner to the Manual of Patent Practice in which, at paragraph 1.10, it is stated that "a matter is not prevented from being treated as an invention merely because some of its features fall into an excluded category".

As discussions between the examiner and Mr Wills' agents had failed to resolve the matter, it came before me at a hearing on 17 March 1999 when Mr Michael Brown of Alpha and Omega represented the applicant. The examiner, Mr Graham Russell, and an observer were also present.

The Issues

I should say at the outset that for convenience at the hearing, claim 1 as filed on 30 December 1997 formed the basis of the discussion on the various issues raised. However, Mr Brown made it clear that any form of claim including the method steps a) to g) would be acceptable to the applicant. Mr Brown also accepted that the prior art cited by the examiner in the search report demonstrated that it was known to produce identification cards bearing a photograph and other information about physical characteristics, and

applying a protective coating to the card so produced. He was therefore relying on steps e)-g) to distinguish from the prior art

Mr Brown first took me to paragraph 1.16 of the Manual of Patent Practice which refers to the Court of Appeal's decision in *Genentech Inc's Patent* [1989] RPC 147. I should mention as background that, in *Genentech*, the invention depended on the discovery of certain DNA sequences encoding for human t-PA and it was argued that the patent was invalid because the inventive step was a discovery and therefore excluded by section 1(2)(a). In a majority judgment, the Court of Appeal held that a patent which claimed the practical application of a discovery did not relate to the discovery as such and patentability was not excluded by section 1(2), even if the practical application might be obvious once the discovery had been made. In saying this the Court was following the principle laid down in 1909 in *Hickton's Patent Syndicate v Patents & Machine Improvements Co Ltd*, 26 RPC 339.

Mr Brown recited in particular the following words of Fletcher Moulton LJ in that judgment:-

"In my opinion invention may lie in the idea and it may lie in the way in which it is carried out, and it may lie in the combination of the two; but if there is invention in the idea plus the way of carrying it out, then it is good subject matter for letters patent."

Mr Brown said that I must therefore look at the whole invention, which, in his contention included what he termed "physical steps".

Mr Brown next drew my attention to the following comments made by the EPO Technical Board of Appeal in *Koch & Sterzel*, Decision T26/86, also referred to in paragraph 1.16 of the Manual of Patent Practice:-

"The Board holds that an invention must be assessed as a whole. If it makes use of

both technical and non-technical means, the use of non-technical means does not detract from the technical character of the overall teaching. The [EPC] does not ask that a patentable invention be exclusively or largely of a technical nature; in other words it does not prohibit the patenting of inventions consisting of a mix of technical and non-technical elements."

He reminded me that it has been held to be of the utmost importance that the interpretation given to section 1 of the Act and the interpretation given to Article 52 of the European Patent Convention should be the same. In interpreting the Act, I must therefore have due regard to decisions of the Board of Appeal and take them into account.

Mr Brown then took me to the Court of Appeal's decision in *Merrill Lynch Inc's Application* [1989] RPC 561 in which the original claims were concerned with a computer programmed to trade in securities by analysing customers' buy and sell orders to determine whether the orders should be executed. These were rejected by the Court of Appeal as a method for doing business. Fox LJ says at the foot of page 565:-

"In *Genentech Inc's Patent* [1987] RPC, Whitford J held that the prohibition in section 1(2) was limited to inventions which related to the matters there specified in paragraphs (a) to (d), and did not include modes of using these matters either in a process or in relation to an artefact."

If I understood Mr Brown correctly on this point, he was contending that, claim 1 of the application in suit could be looked upon as consisting of two parts. One part comprised steps e) to g) and he conceded that this fell within the exclusion in section 1(2)(c) of the Act, that is, it is a method for doing business. The other part comprised steps a) to d) which he said amounted to a process, and in particular, a process for assisting the police. He argued that the claim therefore defined a mode of using prohibited steps e) to g) in the process of a) to d), and by analogy with the conclusion of Whitford J in *Genentech*, was allowable.

At this point in the proceedings I reminded Mr Brown that, at page 567, the *Merrill Lynch* decision goes on to refer to *Vicom System Inc's Application, Decision T208/84*, in which the EPO Technical Board of Appeal said that the technical contribution the invention as defined in the claim, when considered as a whole, makes to the known art was decisive in determining whether an invention was excluded. I asked Mr Brown what technical contribution, if any, claim 1 of the application in suit made to the art. He answered that the technical contribution lay in steps e) - g), ie

- e) producing a second identical card for that child,
- f) giving one of the cards to the school attended by the child, and
- g) giving one of the cards to the parents or grand-parents of the child,

which made essential information about the child readily available so that, if the child went missing, the information could be furnished more speedily to the police than would be the case if only one card was provided.

Mr Brown took me next to *Gale's Application* [1991] RPC 305 which concerns a ROM used in calculating a square root of a number with the aid of a computer, the ROM having particular circuitry defined by functional steps. He drew my attention to the passage beginning at line 20 on page 324 of the judgment of Nicholls LJ in the Court of Appeal in which he says:-

"Finally, in *Genentech Inc's Patent* [1987] RPC 553, 566, Whitford J regarded this as trite law:

"It is trite law that you cannot patent a discovery, but if on the basis of that discovery you can tell people how it can be usefully employed, then a patentable invention may result. This in my view would be the case, even though once you have made the discovery, the way in which it can be usefully employed is obvious enough."

Mr Brown went on to argue that, by analogy, you cannot patent a method of doing

business, but if on the basis of that method of doing business you can tell people how it can be usefully employed, for example by making identity cards to assist in the location of missing children, then a patentable invention may result.

For completeness I should mention that although he did not specifically cover the point at the hearing, in a letter to the Office dated 9 March 1999, Mr Brown also indicated his intention to refer to page 313 lines 35-37 of the decision of the Patent Court in *Gale's Application* in which Aldous J, referring to the Court of Appeal's decision in *Genentech Inc's Patent*, stated:-

"Thus it was the view of Purchas L.J. that a disqualified matter could form the basis of a patentable invention provided that it was applied in a technique or process incorporated in a product."

Mr Brown closed his submission by saying that while he recognised that the invention was probably on the borderline of what might be considered a patentable invention, he considered it to be a useful innovation and that any doubt should be resolved in favour of the applicant.

I have carefully considered all the arguments and observations put forward by Mr Brown at the hearing and have studied the relevant authorities and guidance in the Manual of Office Practice.

Having done so, I am clear that in reaching my decision, I must have regard to a number of important principles. I must bear in mind that matter is not prevented from being treated as a patentable invention merely because some of its integers fall into an excluded category. I must consider what technical contribution the invention, as defined in the claim when considered as a whole, makes to the known art. Thus, it is not the nature of an embodiment which is important, but the nature of the central idea or invention which is embodied. To determine this, I must assess and construe the invention claimed as a whole to see whether the contribution it makes goes beyond an excluded category.

I have considered the revised form of claim 1 filed on 30 December 1997 and the alternative version of the claim submitted for consideration on 26 May 1998. These differ from each other to the extent that the former is directed to "A method of providing identification means for assisting in the location of lost or missing children, said method including..." and the latter to "Identification means for use by the police in assisting in the location of lost or missing children, said identification means being produced by a method including...". The method steps a) to g) are the same in each case however, and I consider they define, in substance, the same invention and therefore stand or fall together.

From a reading of the specification in its entirety, it is apparent that the central idea behind the applicant's invention is the realisation that the speedy recovery of missing children would be facilitated if accurate information about their physical characteristics were quickly available. The method adopted to enable this to take place is to produce two identical cards each bearing a child's photograph and details of their physical characteristics, and to make these available to the child's school and parents and/or grand-parents.

This central idea is reflected in the claims which can be said to consist of a method comprising two sets of steps. Steps a) -d) are what might be called the "technical steps" involved in making a suitable card for a child. Mr Brown acknowledged that, having regard to the cited prior art, there is no inventive contribution in these steps. Steps e) - g) are the steps involved in making the cards available to the child's school and parents and/or grand-parents for safekeeping. I am satisfied that these steps amount to a method of doing business and, as such, are integers of the invention falling into an excluded category. However, I must not discount their contribution to the invention simply because of that. Rather I must determine whether, in the context of the claimed invention considered as a whole, they impart a technical contribution to the known art. When pressed on this point, Mr Brown argued that there was indeed a technical contribution in these steps in that by producing two identical cards for each child and giving them to the school and family, the speed with which the police could gain access to the information on the cards was increased.

I have to say that I have considerable difficulty with that argument. There are any number of situations in which identical information pertaining to individuals is kept in two or more locations for convenience and ease of reference. It is commonplace, for example, for plumbers and builders to distribute their business cards to households to be retained and used in an emergency. It seems to me that in essence steps e) - g) amount to nothing more than a conventional method of making information available quickly, distinguished from others only in that the information pertains to children and is filed at their school and with the family. Accordingly, I consider that steps e) - g), when considered in the context of the claimed invention as a whole, fail to provide a technical contribution to the art.

I therefore find that the claims filed on 30 December 1997 and on 26 May 1998 relate to a method of doing business excluded by section 1(2)(c) of the Patent Act 1977.

I have considered whether there is disclosure which could support a claim which would not contravene section 1(2)(c) of the Act, but I have been unable to identify any.

Accordingly, I hereby refuse application 9519297.7.

Appeal

This being a substantive matter, any appeal must be lodged within six weeks of the date of this decision.

Dated this 19th day of March 1999

P E REDDING

Principal Examiner, acting for the Comptroller

PATENT OFFICE

