



BL O/200/05

15<sup>th</sup> July 2005

## PATENTS ACT 1977

APPLICANT Mayer, Yaron

ISSUE Whether patent application number GB 0301159.0 meets the requirements of sections 1(1)(b) and 14 and is excluded under section 1(2)(c).

HEARING OFFICER A Bartlett

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## DECISION

### Introduction

1. International patent application number PCT/IL01/00572 was filed on the 24 June 2001 in the name of Yaron Mayer and relates to an internet dating system facilitating more immediate contact between compatible users. It claimed a priority date of 22 June 2000 from an application filed in Israel. The international application was published as WO 01/98856 on 27 December 2001. The application entered the national phase as GB 0301159.0 and was published as GB 2380580 on 9 March 2003.
2. I don't think it unreasonable to say that communication with Mr Mayer during the processing of his application has proven extremely difficult. Mr Mayer lives in Israel. He has nominated the patent attorneys Kilburn and Strode to act as his address for service but it has been readily apparent that they are merely acting as a post box rather than his real representative. What is more their only means of contact with Mr Mayer seems to be via email which has proven to be highly unsatisfactory, particularly given Mr Mayer's selective approach to replying to official letters. To say that has made the handling of Mr Mayer's application difficult would be something of an understatement.
3. Throughout numerous rounds of examination and amendment, the examiner has maintained his opinion that the application did not meet various requirements of the Act which I shall come to in detail later. He suggested on numerous occasions that a hearing would be necessary to resolve the outstanding issues. Attending any hearing in person was clearly problematic for Mr Mayer given his place of residence and he was offered various alternatives including conducting the hearing via a video conference link or having a hearing solely on the papers. Having failed to elicit any satisfactory response as to the type of hearing required, the examiner told Mr Mayer on 8 December 2004 that in the absence of any indication to the contrary in his response due on 10 December, a hearing would be held on the papers.

4. Despite this, Mr Mayer's response filed 10 December made no reference to his preferred format of hearing. Mr Mayer was informed on 14 December by Kilburn and Strode that in light of his silence on this aspect, the Office intended to proceed with a hearing based on the papers. This decision is the result of that hearing.

### **The application**

5. The application concerns a method for searching, finding and contacting dates utilizing an internet based system. The system provides various functionality but the underlying principle is that the system makes it easier and quicker for compatible users to contact each other without having to disclose their telephone numbers. This can be achieved in a number of ways, for example by providing instant messaging, or a link or code which allows routing of a phone call to a potential date whilst keeping the phone number secret.

### **The objections**

6. Throughout the examination process the examiner has maintained objection that the invention defined in the claims is excluded under section 1(2)(c) as a method for doing business and/or a program for a computer. He has also reported that the claims are not limited to a single invention, that they are unclear and that they lack an inventive step over various prior art documents.
7. It is usually the case that by the time an application which is subject to an excluded matter objection comes to be considered at a hearing, issues such as clarity have been resolved. That then allows attention to be focused on the more fundamental objection. Unfortunately that has not been possible on this occasion. As well as being difficult to contact, Mr Mayer has also proven extremely reluctant to depart from his chosen claim format. The claims are bordering on excessive in their absolute number and this is exacerbated by the presence of various alternatives within some of the independent claims. Thus all those objections remain to be addressed. What is more, in the present instance Mr Mayer's chosen claim format is such that I think it necessary to consider the clarity and unity of invention objections first, before moving on to consider whether the invention meets the patentability requirements of section 1 of the Act.

### **The claims**

8. The claims before me were filed with Mr Mayer's letter dated 13 December 2004. There are 113 claims in all, of which 5 are independent. As I have already said, the claims are bordering on excessive in their absolute number and many of them contain a range of alternatives or combinations. For the sake of brevity I shall only reproduce claim 1 in its entirety but doing that provides ample illustration of the issues the examiner has had to deal with in trying to decide whether the application meets the requirements of the Act.
9. Claim 1 as presently on file reads:

An online system for searching, finding, and contacting instantly dates on the internet, wherein the system enables the user to instantly contact potential dates even when said dates do not expose to other users a phone number or at least their actual phone number, comprising a dating questionnaire and at least one of:

- a. A dating system used over at least one instant messaging network, wherein at least one of the following feature exists: An ability to search also for dates who are not currently online, and an ability to search for dates based upon reciprocal compatibility;
- b. An online dating system to which instant messaging features for instantly contacting the compatible dates have been added, wherein the system is adapted to indicate to the user matching dates that are currently online differently from matching dates that are not currently online;
- c. An online dating system to which instant messaging features for instantly contacting the compatible dates have been added, wherein the user can activate the instant messaging features directly from the web browser;
- d. An online dating system wherein if the user does not want his/her phone exposed to other users without control, he/she can mark his/her phone as "protected", which means that other users can access his/her phone only through the system, by using a link or a special code, without knowing the real number, until the user decides to give them the actual number and wherein users can contact the protected phone without anyone having to call them back in order to complete the phone call.
- e. An online dating system wherein users can be notified automatically whenever there is a new potential date that entered the system and has a higher compatibility with him/her than a certain criterion or fulfills a certain condition and wherein said notification is by at least one of: sending an appropriate e-mail message to the user, sending an appropriate instant message to the user, adding the new dates directly into the user's contactee list, automatic phone call to the user, sending an SMS message to the user, adding the new compatible date automatically to the user's contactee list, and adding the new compatible date automatically to the user's contactee list if the new date is especially highly matching.

10. Thus, according to claim 1, the applicant is seeking protection for an online dating system as specified in the preamble of the claim and having any single one of features a-e (or any combination thereof). Alternatives a) to c) define specific aspects of the system when instant messaging is the mechanism for immediate communication. Alternative d) does not require any instant messaging capability but instead defines a system whereby telephone contact is enabled without the user's number being exposed. Alternative e) defines a system whereby a user is notified when a compatible date registers for the first time via a range of possible communication methods.

11. Independent claim 10 is a method claim corresponding to claim 1. Independent claim 11 is a system claim focusing on feature a) in claim 10 whereby the system can conduct searches for dates not currently online or based on reciprocal compatibility. Independent claim 112 is a system claim focusing on features b) and c) whereby matching dates that are online are indicated differently than those not online in a system where instant messaging is activated directly from the web browser. Independent claim 113 is the method claim equivalent of claim 112.

## The Law

12. Section 14(5) of the Act specifies a number of requirements that the claims must fulfil for a patent to be granted. It states:

“14(5) The claim or claims shall –

  - (a) define the matter for which the applicant seeks protection;
  - (b) be clear and concise;
  - (c) be supported by the description; and
  - (d) relate to one invention or to a group of inventions which are so linked as to form a single inventive concept.”
13. The rationale for the requirement that the claims are clear is self evident. The claims define the scope of protection sought by the applicant. It is entirely reasonable that upon reading the specification a third party should be able to decide what he or she can do without infringing the claims of the patent. Mr Mayer’s chosen claim format with its large number of claims and multiple options within claims does not in my opinion enable the reader to identify with any degree of certainty whatsoever what is covered by the claims. I therefore find the claims to fall short of the requirement of section 14(5)(b).
14. Section 14(5) also includes the requirement that the claims must relate to a single inventive concept. On occasion, it is so self evident that an application contains more than one invention that the examiner does not need to provide any documentary evidence to back up an objection to plurality of invention. More usually, as in this case, what he or she needs to do is to identify the subject matter that independent claims (or alternatives within those claims) have in common and decide whether that subject matter is known. If the common matter is not known then the claims are considered to relate to a single inventive concept. If it is known then any invention must reside outside the common subject matter and plurality of invention is reported.
15. In the present case, the examiner has identified some prior art which shows the preamble of claim 1 to have been well known at the claimed priority date. Beyond that preamble, the alternatives in the claims diverge such that they do not have any subject matter in common. For example, even though Mr Mayer relied heavily on the “instant messaging” aspect when addressing the excluded matter objection, option d) and most of the alternatives in option e) of claim 1 do not do not require the system to provide such an instant messaging facility. In contrast, instant messaging is at the core of options a) to c) of claim 1.
16. Given that the common subject matter is known and the degree of divergence of the subsequent features, I conclude that the claims do not define a single invention as required by section 14(5)(d).
17. By themselves, either of the above findings is sufficient for me to refuse to grant the application in its present form. However, both these objections could be overcome by amendment and I consider it only right that I go on to consider the other outstanding

objections in this decision. Most significantly I consider it necessary to consider the excluded matter objection.

### **Excluded Matter**

18. In his final examination report, the examiner reported that the application related to a scheme rule or method for doing business and/or a program for a computer as such and was thus excluded under section 1(2)(c) of the Act. The relevant parts of Section 1(2) state that:

“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.

19. It has been established by the Courts that an invention will not be excluded from patentability by the above subsection if it makes a technical contribution<sup>1</sup>. That is to say if it makes a technical contribution it cannot be regarded as relating to an excluded item “*as such*”. Indeed, in seeking to convince the examiner that his application should be granted, Mr Mayer was at pains to demonstrate how his invention made the required technical contribution. However, before I address his arguments on that point in detail, I consider it necessary to address a number of other points.
20. First, whilst it has not been expressly raised by Mr Mayer, I think it would be remiss of me not to say something about the difference in approach to assessing patentability that currently exists between the most recent practice of the Boards of Appeal of the European Patent Office<sup>2</sup> and the British Courts. As a consequence of Section 130(7) of the Act, the excluded matter provisions in the UK Act should have the same effect as their corresponding sections in the EPC. This means that the Comptroller must pay due regard to the decisions of the Boards of Appeal of the EPO in deciding whether an invention is patentable. He is not though bound to follow them. On the other hand, the Comptroller is clearly bound by the judgments of the UK courts. I am in no doubt therefore that where there is a divergence between the judgments of the UK Courts and the EPO Boards of Appeal, I must follow the UK Courts.
21. As the Comptroller’s Hearing Officer found in *Outersonic*<sup>3</sup>, however, the apparent difference in approach is somewhat academic. The existence of a technical contribution is the decisive factor in both the EPO’s and UK Courts’ approach. If there is no technical contribution, then an application will fail under either approach.

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<sup>1</sup> *Fujitsu Limited’s Application* [1997] RPC 14 at page 614.

<sup>2</sup> As exemplified in decision T258/03 Auction method/Hitachi)

<sup>3</sup> *Outersonic Limited’s Application* BL O/273/04

It is then something of a semantic issue whether it is refused as not being an invention for the purposes of patent law (as in the UK approach) or as not providing an inventive step once all the non-technical features have been notionally excised (as in the current EPO approach).

22. Bound as I am to follow judgments of the UK courts, however, I shall assess technical contribution as part of the excluded matter provisions. Having adopted that approach it is logical for me to first consider whether the invention falls within the excluded categories. In doing that I will follow the long established principle adopted by the UK Courts that it is the substance of the invention that is significant, not the precise form of wording adopted in the claims.
23. The invention concerns an internet dating service where users are able to find and contact compatible dates. To my mind that is an administrative activity of the kind that has traditionally been excluded as a method for doing business. Admittedly there is no disclosure in the specification of any cost being incurred for using the service but that it seems to me is by the way. In my opinion, the invention is potentially caught by the business method exclusion. Even if it does not fall strictly within that specific exclusion, I certainly consider the invention to relate to the sort of subject matter excluded under section 1(2). The Comptroller's Hearing Officers have concluded previously<sup>4</sup> that it is not necessary for an invention to fall strictly within any one of the exclusions for it to relate to excluded subject matter. This followed the decision of Aldous J in *Lux Traffic Controls Limited v. Pike Signals Limited* [1993] RPC 107. I can see no reason to come to a different conclusion on this occasion.
24. As for whether the invention also potentially falls foul of the computer program exclusion, I am in no doubt whatsoever that the most convenient means for implementing the invention is via a computer program, irrespective of the form of wording employed in the individual claims. I can certainly see nothing in the specification to suggest that any of the hardware is novel. Thus I consider that prima facie the invention also falls within the computer program exclusion.
25. That though is not the end of the matter. As I have already said above, an invention which would otherwise be excluded is patentable if it makes a technical contribution. It was in trying to convince the examiner that his invention did make such a contribution (and thus did not relate to excluded subject matter *as such*) that Mr Mayer directed most of his efforts in the correspondence. Indeed, Mr Mayer has been extremely rigorous in those attempts. In his letters he has emphasized that the "instant messaging" employed by the invention is not standard since it "creates an integration with online dating with unique features which did not exist before". He has stated that the "protected phone" has "a technical contribution and a clearly technical implementation" since it "involves changing the way that the communication network handles a phone call: instead of using the phone normally through the phone network the user has to contact the system's server in a number of ways and use a special code or link, and then the server itself makes the phone connection to the other user without revealing the other user's phone number to the calling user". He has also commented that his invention involves "being able to search differently and/or to communicate differently" and that this "certainly has a technical effect in itself, regardless of

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<sup>4</sup> See Alan J Venner et al's Application BL O/193/04

whether the improvement is implemented by hardware or by software and regardless of whether providing these features may also have some business implications”. Mr Mayer also believes that his application “contains a large number of significant improvements over the prior art which enable better search and better communication”.

26. Mr Mayer’s reluctance to depart from his chosen claim format makes assessment of the claims for the presence of a technical contribution an extremely arduous process. However, no matter how much I try, I have been unable to identify anything in the claims which constitutes the technical contribution required to make the invention patentable.
27. The first point I would like to make in this respect is that under UK law, the exclusions are not avoided by the mere presence of technical entities in the claim. Whilst the claimed invention undoubtedly has technical character, that is not the test for deciding whether the invention is patentable. The Court of Appeal made that clear when refusing the application in *Fujitsu* where the invention claimed related to a computerized system for modeling crystal structures. As the Court found in that case, the decisive issue is whether the claimed invention makes a technical contribution. The hardware employed to implement an invention can of course provide the required technical contribution if it is new and inventive. However, I can see nothing in the specification to suggest that the hardware employed in the present case is anything other than conventional, programmed to provide the desired functionality. Thus the hardware itself does not provide the required technical contribution.
28. The Court of Appeal in *Fujitsu* also went on to say that the fact that a computer programmed in a particular way provided a new tool was not necessarily sufficient for it to be said to make a technical contribution. The Court accepted that the invention in *Fujitsu* did indeed provide a new tool (and a useful one at that) but found the advantages of speed and reduced scope for human error were precisely those to be expected by computerizing a process that had previously been conducted manually and did not provide a technical contribution. Thus even if the invention constitutes a tool providing new functionality, that does not mean it necessarily makes a technical contribution.
29. So what of the functionality that the present invention provides? The use of questionnaires as part of the process of finding compatible dates is an entirely standard feature of any dating service, be that conducted through electronic or more conventional communication means. That users of such dating services will in many circumstances want to maintain anonymity whilst still being contactable is also well established as a quick look through the “Personal” columns of any newspaper providing such a service would confirm. Whilst the PO Boxes of those adverts may not provide the potential speed of contact that the present invention provides, ease of contact would in my view be one (if not the) overriding reason for wanting to set up an online dating service.
30. What is more, during the course of the examination process, the examiner identified a number of documents which showed that at the claimed priority date it was known in internet based contact systems to use proxy telephone addresses to allow contact

between parties without actual telephone numbers being disclosed. Thus I do not see how providing that functionality can be said to confer a technical contribution.

31. As for the instant messaging aspects of the claimed invention, as Mr Mayer accepted, instant messaging was well known at the priority date of the invention. He certainly did not invent it as a concept. It seems to me that what Mr Mayer has done is to incorporate a known communication method (instant messaging) into an existing online dating environment. The features offered by this integration, namely the ability to “instantly” contact compatible dates or to indicate compatible dates that are currently online or offline are standard features of instant messaging systems and follow on automatically from the incorporation of instant messaging into an online dating system. I can see nothing in their provision which could be said to make a technical contribution. Rather than solving any technical problem they are merely the specific features of the business model the inventor has chosen. Other features such as searching for dates who are not online based upon reciprocal compatibility and automatic notification of a new potential date are all features that are associated with a standard online dating service and I cannot see how the provision of these features provide the necessary technical contribution either. Furthermore the ability to activate the instant messaging features from a web browser appears to be a conventional software feature.
32. As for Mr Mayer’s assertion that his application “contains a large number of significant improvements over the prior art which enable better search and better communication”, having read the specification very carefully, I can see nothing upon which that assertion could be sustained.
33. The present invention, it seems to me, comprises a computer system programmed to provide a range of functionality which the inventor has identified as being desirable for users of online dating services. Even if those features were not already known in online dating services then in my opinion that does no more than confirm that Mr Mayer’s dating service is better than (or at least different from) those previously available. However, just because a particular business model may be better than another does not alter the fact that it is still a business method and in the absence of a technical contribution, excluded from being patentable. On the basis of all the evidence available to me, the implementation of all these functions seems to involve nothing more than conventional programming techniques and cannot to my mind provide the required technical contribution.
34. To date, my assessment of excluded matter has focused entirely on claim 1. In that assessment I have not been able to identify anything in claim 1 as presently drafted which could be said to make a technical contribution. I therefore find the invention defined in that claim to be excluded under section 1(2)(c). Moreover, I can see nothing in any of the other claims or anywhere in the specification which could form the basis of a patentable invention.
35. In reaching that conclusion I note the reference Mr Mayer made to a number of quotes from internet articles regarding the issue of excluded matter and to granted patent GB2312975 as support for his argument that his invention should be patentable. Whilst interesting, such articles are of no help to me in determining whether an invention is



patentable. Neither are previously granted patents. What I must do is decide whether the application in suit is patentable based on its individual facts. In doing that I am bound to follow decisions of the courts. I am not bound to take account of what has been granted previously and certainly not what the author of an article says should be patentable.

### **Inventive Step**

36. The examiner has also reported that a large number of the claims, at least in respect of some of the alternatives allowed within them, are contrary to section 1(1)(b) of the Act since they do not involve an inventive step over the prior art. In view of the complex nature of the claims, a comprehensive analysis of inventive step would involve an inordinate amount of effort. Having already found the application to be devoid of any subject matter which could constitute a patentable invention it seems to me to be counter intuitive to then go on to assess whether those various claims or combinations of features provide an inventive step.

### **Conclusion**

37. I have found that the claims do not meet the requirements of section 14(5)(b) and (d) in that they are not clear and do not relate to a single inventive concept. Moreover, as far as the form of claims allows me to deduce, the invention defined in the claims fails to make a technical contribution and is excluded under section 1(2)(c) as a method for doing business and/or a program for a computer as such. I therefore refuse the application under section 18(3).

### **Appeal**

38. Under the Practice Direction to Part 52 of the Civil Procedures Rules, any appeal must be lodged within 28 days

**A BARTLETT**  
**Deputy Director acting for the Comptroller.**