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PATENTS ACT 1977

APPLICANT	John Lahiri Khan
ISSUE	Whether patent application number GB 0428269.5 complies with sections 1(2) and 4(1)
HEARING OFFICER	R C Kennell

DECISION

Introduction

- 1 This application was filed on 23 December 2004 and was published under serial no. GB 2423160 A on 16 August 2006. Despite amendment of the claims during substantive examination, the applicant has been unable to persuade the examiner that the invention is patentable. This matter therefore came before me at a hearing on 22 November 2006. The applicant, Mr Khan, who was not professionally represented, attended in person (assisted by Ms Elizabeth Bridgewater) and the examiner, Mr Jake Collins, assisted via videolink.
- 2 It is fair to say that there have been uncertainties in the case law on section 1(2) throughout the life of this application. However, shortly before the hearing was due to take place, the Court of Appeal delivered its judgment in the matters of *Aerotel Ltd v Telco Holdings Ltd* and *Macrossan's Application* [2006] EWCA Civ 1371 (hereinafter "*Aerotel/Macrossan*"), in which it reviewed the case law on the interpretation of section 1(2) and proposed a new four-step test (explained below) for the assessment of patentability. In a notice¹ published on 2 November 2006, the Patent Office stated that this test would be applied by examiners with immediate effect. It did not expect that this would fundamentally change the boundary between what was and was not patentable in the UK, except possibly for the odd borderline case.
- 3 Shortly before the hearing, on 7 November 2006, the examiner alerted Mr Khan to this development. He analysed the invention accordance with the new test approved in *Aerotel/Macrossan* but concluded that objection still arose. Mr Khan did not take up an offer to postpone the hearing, and instead submitted a detailed response which he took me through at the hearing.

¹ <http://www.patent.gov.uk/patent/p-decisionmaking/p-law/p-law-notice/p-law-notice-subjectmatter.htm>

The patent application

4 Following amendment, the claims before me at the hearing were as follows:

“1. An introduction system for making friends and/or dating, comprising a ring for an introduction process in which anyone can try, over any time period and at any location, to attract into an introduction immediately or subsequently anyone they encounter entirely by chance, as well as anyone they encounter otherwise, by using a ring that has a logo and/or is otherwise distinctive in appearance and/or design and that is, by being noticed, identifiable as being for the purpose of effecting introductions in this way.

2. An introduction system according to claim 1, wherein an item of jewellery or item of clothing or bag or band or badge or sticker or other device is used for said introduction process instead of, or in addition to, said ring.

3. An introduction system according to claim 1 or 2, that additionally comprises a set of cards (or similar device) for use visibly or otherwise, to help determine immediately or subsequently the compatibility of participants in that introduction system and/or to provide a reason and/or excuse to terminate an unsuitable introduction immediately or subsequently and/or in providing other information.”

5 The system therefore relies on the use of some item of distinctive appearance, particularly a ring, to attract an introduction, optionally backed up by the use of some means for the potential partners to assess their compatibility. The nearest item of prior art found by the examiner during the search was an article “Shopping gets sexy at Paris’ first singles supermarket” published in October 2003 (hereinafter “the singles supermarket article”). This describes a system in which on one night each week shoppers looking for potential partners are provided with a special purple basket so that they can easily be picked out of the crowd, with a dedicated till being reserved for those wanting to be chatted-up at the checkout.

The law and its interpretation

6 The relevant parts of section 1(2) state (emphasis added):

“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 –

....

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

(d) the **presentation of information**;

but the foregoing provision shall prevent anything from being treated as an invention for the purposes of this Act only to the extent that a patent or application for a patent relates to that thing **as such**.”

and section 4(1) states (emphasis again added):

“Subject to section 4(2) below [*this relates to certain medical inventions*], an invention shall be capable of industrial application **if it can be made or used in any kind of industry**, including agriculture.”

7 In *Aerotel/Macrossan* the Court of Appeal approved a new four-step test for the assessment of patentability under section 1(2), namely:

- 1) Properly construe the claim
- 2) Identify the actual contribution
- 3) Ask whether it falls solely within the excluded matter
- 4) Check whether the contribution is actually technical in nature.

Arguments and analysis

8 I think it will be helpful for me first to briefly set out the arguments made by the examiner in his letter of 7 November and then deal in turn with Mr Khan’s arguments on each of the *Aerotel/Macrossan* steps.

The examiner’s argument

9 The examiner, noting that a ring was not an essential feature of the claim in view of claim 2 and attempting to strip out non-limiting wording from claim 1, construed claim 1 in the following terms:

“An introduction system for making friends or dating, comprising a device for an introduction process in which anyone can try, over any time period and at any location, to attract into an introduction anyone they encounter, by using the device that is distinctive in appearance or design, and that is, by being noticed, identifiable as being for the purpose of attracting encountered people to introduce themselves.”;

he considered the significant points to be that anyone could use the device and that it functioned to alert others whenever and wherever the user was.

10 It was not disputed between the examiner and Mr Khan that the invention was not the device itself but was a system or method of effecting introductions using the device. The examiner accordingly thought that, having regard to the closest prior art identified above, any contribution lay in flexibility as to when and where the device was used (leaving aside the matter of whether that contribution was clearly defined in the claims). However, in his view such systems and methods lacked industrial applicability. Even if they were industrially applicable he thought they would be excluded as a method for doing business (of effecting introductions for dating or making friends), a method of presenting information (that the user wishes to date or make friends), and as a mental act (since the association between the device and the information that the user sought to convey existed only in the mind).

Mr Khan’s arguments

- 11 Mr Khan's submission followed the four-step analysis of *Aerotel/Macrossan* and I will take each of these steps in turn.

Step 1 – construction of the claim

- 12 Mr Khan thought that the examiner's notional re-drafting of the claim had in fact misconstrued it. Highlighting the examiner's mention of the singles supermarket article, he thought that on any reasonable view the flexibility with regard to time and place which the examiner had identified was not achievable using the coloured baskets since they would not work for purely random encounters. Mr Khan thought that his wording was necessary to bring out the fact that the method was for introductions from purely random encounters, but that it would also work in the case of encounters that were not purely random.
- 13 Mr Khan contrasted the singles supermarket baskets with the use of a ring, which for a number of reasons he saw as outstandingly suitable for the method which he had claimed. He accepted that other items might be suitable, even if not as suitable as the ring.
- 14 However, I think that Mr Khan's argument misses the point. In construing the claim the examiner is not trying to differentiate the invention from the prior art. He is trying to decide what exactly is the scope of the monopoly which it is sought to protect (as paragraph 42 of *Aerotel/Macrossan* makes clear), and in doing that he will interpret the claim in the light of the description and any drawings. In my view the examiner has correctly done that, having regard to the fact that Mr Khan on his own admission does not limit the invention to the use of a ring, or to purely random encounters. I note that, contrary to what Mr Khan appears to be saying, the examiner did not in fact mention the singles supermarket article in construing the claim.

Step 2 – identifying the contribution

- 15 As paragraphs 43 – 44 of *Aerotel/Macrossan* explain, this is about identifying what the inventor has really added to human knowledge, looking at the substance of the invention rather than the form in which it has been claimed. Having regard to the prior art, the examiner considers it to lie in the flexibility with regard to the time and place of use of the device (the singles supermarket trolley being usable only at specified times and within the confines of the supermarket).
- 16 Mr Khan pointed out that - unlike the singles supermarket or the age-old method of wearing a carnation on a lapel to effect an introduction, which can only be used at predetermined times and locations - the invention provides a method that works in purely random encounters by using a particular kind of device to locate and bring together potentially socially compatible people from within the wide group of people that could be encountered anywhere and at any time. The examiner accepted this and agreed that the flexibility he had mentioned came down to much the same thing – that the method was not limited to predetermined encounters.

- 17 In assessing the contribution I do not think that the device can be altogether ignored. It seems to me that, whilst in principle any physical type of device can be used, the device has to be identifiable in some way as directed to effecting introductions which can occur randomly as well as in a predetermined way. This is I think necessary in order to distinguish from the use of devices which merely show that one belongs to a specialist group (a point mentioned in the specification), or the use of, say, the purple shopping baskets or lapel flowers of the prior art outside the predetermined situation.
- 18 Bearing in mind that, as explained above in relation to construction, the claims embrace encounters made in any way, I would therefore regard the contribution made by the invention as the use of a device for effecting introductions in a way which need not be limited to predetermined encounters but also allows introductions to be effected following random encounters.

Step 3 – is the contribution solely within excluded fields?

- 19 The examiner has objected both that the contribution is solely within the excluded areas of section 1(2) and that the invention is not capable of industrial applicability under section 4(1). As I explained at the hearing, these two objections are distinct but it is not easy to provide a clear example of an invention which lacks industrial applicability which would not in any case be already excluded under section 1(2). I propose therefore to consider first whether objection is made out under section 1(2).

Business method

- 20 Mr Khan's submission linked the two issues of business method and industrial applicability, and as I understood it there were two lines of argument. The first was that the method was capable of industrial application because it could be adopted by commercial introduction agencies and the necessary devices could be made in large quantities for sale, but at the same time was not a business method because it was intended for use by individuals without the need for such a commercial agency. The second was that, although the method was intended for leisure and social applications (arguably, as he put it, the opposite of a business or industrial activity), it was capable of industrial application because it could be used to make industrial/business friends – but only so long as the wearer of the device identified which industry or business he was from, or if the introduction was made at a particular location associated with the industry or business. If this extra factor was not present, then Mr Khan thought the method could not be a business method. As Mr Khan summed it up at the hearing, the method could be used for business, but was not a method for doing business.
- 21 I do not think that these arguments get Mr Khan anywhere. It seems to me that his arguments run with the hare and hunt with the hounds - one aspect of the invention makes it industrially applicable whilst a different aspect prevents it from being a business method. This is not the right approach to take. As the examiner (rightly in my view) put it at the hearing, if the argument for the

method being industrially applicable rests on it being capable of use by a commercial agency, then that is at the same time the business method of that agency.

- 22 In the light of *Aerotel/Macrossan* the business method test has to be approached by looking at the contribution made by the invention and whether that contribution is, as a matter of substance, a method for doing business. In *Aerotel/Macrossan*, the patent application was for an automated interactive method of acquiring the documents necessary to incorporate a company. The method did the job which otherwise would have been done by a solicitor or company formation agent (see paragraph 63 of the Court of Appeal's judgment). In reaching its judgment the court specifically rejected the judgment of the Patents Court that the method had to relate to the underlying abstraction of business method and had to involve a completed transaction before the exclusion could apply. It held at paragraph 71 that the method was for something more than a tool for use in business and was "for the very business itself, the business of advising on and creating appropriate company formation documents.
- 23 In my view the same reasoning can be applied to Mr Khan's invention. It seems to me that the contribution which I have identified above goes to the way in which the introduction has to be made and is therefore, as the examiner has argued, "for the very business of effecting introductions or making friends".
- 24 I do not think that this hinges on whether the method is carried out by individuals or by a commercial agency. Even if it operates in the social and leisure field, as I see it there must still be some underlying system, set of rules or protocol to publicise the invention and ensure that the device will be identified as being for the purpose intended by the wearer rather than as, say, a mere badge of identity. (I note for instance that the specification envisages the publicizing and making available of an "availability ring", possibly via a central website.) This I think points to something which is fundamentally of a business nature rather than a purely social interaction.
- 25 I therefore think that the invention is excluded under section 1(2) because it relates to a method for doing business as such. However, if I am wrong on that because the method is of a purely social rather than a business nature, then I need to consider whether any of the other exclusions apply.

Presentation of information; mental act

- 26 Mr Khan argued that the invention was not solely a method of presenting information or a mental act, because it also involved other physical acts in that the device had to be worn and physically transported to the point of encounter before any information could actually be presented to another person. He also argued that the introduction process involved more than mere presentation of information or a mental act because people who were potentially socially compatible could be selected from the large group of random encounters and introduced to each other; and that something more than mere mental attraction was involved because people would have to be in close physical proximity in

order to converse.

- 27 Although Mr Khan stressed that he was not intending to claim the device in isolation from the process, he nevertheless emphasised that the device was still a physical object and not solely the information on it, and that its distinctive features were functional in that they acted as a trigger for the introduction process.
- 28 It seems to me that these arguments concentrate on the form of the claims and the social consequences that follow from the invention and overlook what the substance of the invention actually is. In my view, the contribution of the invention over and above the prior art is brought about solely by the content of the information and what it conveys to the mind of someone who is encountered. I do not think this is really about the physical processes necessary to bring about an encounter between two people, but how one of them knows that the other is willing to be attracted. As regards presentation of information, I do not think that this objection can be circumvented by the supposedly physical feature of transport which Mr Khan mentions, because all information (even that contained on a sheet of paper) has to be transported to the point where the intended user can access it.
- 29 Accordingly, even if I am wrong in my conclusion about business method, in my view the invention is still excluded under section 1(2) because it relates to the presentation of information as such (and that would also be the case if the invention was the device rather than the method of using it).
- 30 However, even though the invention does in my view depend for its success on what the information conveys to the mind of a user, I am not convinced that it is really about performing a mental act as such – compared with, say, a method for learning a language.

Industrial application

- 31 Having found that the invention is excluded under section 1(2), it is not strictly necessary for me to decide whether the invention is capable of industrial application under section 4(1). However, in my view, none of Mr Khan's arguments above, insofar as they touch on this point, overcome the examiner's objection that the invention is for a method of effecting introductions with a view to making friends and that is not something which has industrial application for the purposes of section 4(1). I do not think it is relevant that the invention is something that can be set up and operated by a commercial agency or can be used for making friends in business and industry.

Step 4 – is the contribution technical in nature?

- 32 A previous examiner, using the approach of earlier case law (see paragraph 47 of *Aerotel/Macrossan*) which gave primacy to the finding of a technical contribution, had been prepared to allow a claim to a package of the device together with a set of introduction cards (currently mentioned in present claim 3 as an optional feature of the invention) which could help to determine the

compatibility of two people once they had been introduced. From this, Mr Khan argued that there had to be something tangible that was intrinsic to the operation of the method for there to be a technical effect, and that since the device (as I understand it, without the presence of the cards) did provide something tangible the invention was therefore patentable.

- 33 I do not think this argument is of any relevance. Even if Mr Khan was correct to equate technical effect with tangibility, paragraphs 46 - 47 of *Aerotel/Macrossan* make clear that the “technical” test may not be necessary because the third step should already have covered the point. The presence or otherwise of a technical effect is therefore a subsidiary factor which will fall to be considered only where an invention passes the first three *Aerotel/Macrossan* steps. However, in my view the contribution made by the present invention does indeed fail the third step. I therefore agree with the examiner that it is not necessary for me to consider whether the contribution is of a technical nature.

Conclusion

- 34 I therefore conclude that the invention is excluded under section 1(2) in that it relates to a method for doing business and to the presentation of information, as such; and that it is not capable of industrial application under section 4(1). These conclusions to my mind apply irrespective of the nature of the device and whether or not it is the ring preferred by Mr Khan.
- 35 Having read the specification carefully, I do not think that any amendment is possible which would overcome my findings. Whatever may have been the position under case law prior to *Aerotel/Macrossan*, I do not think that supplementing the device with cards or something similar to help determine compatibility would now take the invention, when considered as a matter of substance, outside the excluded areas, or make it industrially applicable.
- 36 Mr Khan also submitted that his invention was new and involved an inventive step. However, in the light of my conclusion above, I do not think that it is necessary for me to consider this point
- 37 I therefore refuse the application in accordance with section 18(3).

Appeal

- 38 If Mr Khan does not agree with my decision, he has a right of appeal to the Patents Court. Under the Practice Direction to Part 52 of the Civil Procedure Rules, any such appeal must be lodged within 28 days.

R C KENNEL

Deputy Director acting for the Comptroller