



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

These provisions are designated in section 130(7) as being so framed as to have, as near as practicable, the same effect as the corresponding provisions of the European Patent Convention (EPC), i.e. Article 52. I must therefore, also have regard to the decisions of the Board of Appeal or the European Patent Office (EPO) concerning article 52. However, I note that the decisions of the EPO Boards of Appeal do not bind me but that they must be considered carefully in view of the judgements of the Court of Appeal in *Aerotel/Macrossan*<sup>1</sup> and *Symbian*<sup>2</sup>

- 5 in which the Court of Appeal highlighted contradictions between the Board's decisions and expressly refused some of them.
- 6 In *Aerotel/Macrossan*, the Court of Appeal set out a four step test to be followed in deciding whether an invention is excluded:
- (1) properly construe the claim
  - (2) identify the actual contribution
  - (3) ask whether the identified contribution falls solely within the excluded subject matter
  - (4) check whether the actual or alleged contribution is actually technical in nature.

That is the approach I will follow in deciding the present issue.

- 7 In *Symbian* the court made it clear that in the course of making that inquiry, the question "is the contribution technical?" must be asked but that it does not matter if it is asked at step 3 or 4.

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<sup>1</sup> *Aerotel Ltd v Telco Holdings Ltd* [2007] R.P.C. 7.

<sup>2</sup> *Symbian Ltd v Comptroller-General of Patents* [2009] R.P.C. 1.

8 That is the approach I will follow in deciding the present issue.

### **The application**

- 9 The application is concerned with computer-telephony integration for use for example in a call centre. According to the invention, information relating to an incoming call is obtained, a request is sent by the computer-telephony system to a search engine to perform a search based upon said obtained information. The search is carried out across what is termed 'heterogeneous' data, that is, data that is not primarily intended to be used as part of a call system. The results of said search are similarly 'heterogeneous' and are passed to a call handler or 'agent'.
- 10 In doing this the invention seeks to overcome a number of problems associated with prior methods of computer-telephony. In prior systems information relating to a call is passed to a dedicated computer-telephony integration (CTI) server. This information may comprise calling line identification, and or dialling number identification. Further information may be obtained in response to voice or keypad entered information such as for example account numbers. This further information is similarly passed to the CTI server. The CTI server subsequently forwards the call to an 'agent', the agent is also provided with the obtained information. The CTI server may also have access to a customer relationship management (CRM) database, this database may be searched with respect to the obtained information, and further customer information passed to the agent, for example name and address data. A Problem associated with this arrangement is the limitation of the CRM database. A CRM database must be provided and maintained this may be difficult if call centre systems are out-sourced to a third party. Such databases must also be compatible with CTI systems being operated. This is of particular limitation to small clients who may not have the capacity to properly maintain the databases and are thus unable to fully exploit CTI services.

### **The claims**

- 11 The claims before me were those as originally lodged dated 4 November 2009. The claims comprise two independent claims, numbered 1 and 15. These are directed to various aspects of the invention, namely a method for providing computer-telephony integration (claim 1) and apparatus for providing computer-telephony integration (claim 15). The claims stand or fall together and for the purpose of this hearing I need only reproduce claim 1 which reads:

“1 A method of providing computer-telephony integration comprising:

receiving by a computer-telephony system an incoming call;

obtaining by the computer-telephony system telephony information relating to the call;

sending a request by the computer-telephony system to a search engine to perform a search based on the obtained computer-telephony information, wherein the search is performed across a heterogeneous

collection of material not primarily intended for call handling by the computer-telephony system to locate search results comprising material that is likewise not primarily intended for call handling;

forwarding the incoming call by the computer-telephony system to an agent; and

using the search results to provide information to the agent receiving the call.”

- 12 If I find that claim 1 passes (or fails) the requirements of The Act then it follows that a similar finding must also apply (*mutatis mutandis*) to claim 15.

### **Applying the excluded matter test**

- 13 Step one of the test:- construing the claims – this does not present any particular problems in the present instance when read in light of the disclosure. In particular I am of the opinion that the 'heterogeneous' information is clearly defined in meaning and clearly distinguishes the information searched from conventional CTI/CRM database information.
- 14 Step two:- Identifying the contribution. At paragraph 43 of the *Aerotel/Macrossan* judgement, Jacob LJ described step 2 as being essentially a matter of determining what it is the inventor has really added to human knowledge, and involves looking at the substance of the claimed invention, rather than the form of the claim. He also accepted the submission of the Comptroller's Council that the test “is an exercise in judgement probably involving the problem to be solved, how the invention works, what it's advantages are”. Dr. Davies impressed both in earlier submissions (to examination reports) and at the hearing that this approach was crucial in the determination of the contribution. I accept this point.

Before applying step two I invited Dr. Davies to further consider the *AT&T*<sup>3</sup> 'signposts', however Dr. Davies respectfully declined my Offer as he did not consider them relevant to the case in hand and would prefer to rely on the judgements of *Aerotel/Macrossan and Symbian*. I accept Dr. Davies's view and we proceed with the consideration of step 2.

- 15 At the hearing Dr. Davies identified the contribution as:

“...the removal of the conventional CRM database as it is no longer required, this being a clear change in hardware configuration and brings with it many concomitant benefits, such as the ease of maintenance, etc. Further in the case of a telephone system having no CTI functionality the contribution would be the addition of a CTI server. “

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<sup>3</sup> *AT&T Knowledge Ventures/Cvon Innovations v Comptroller General of Patents* [2009] EWCH 343 (Pat.)

16 Dr. Davies further referred to paragraphs 51-53 of the *Aerotel/Macrossan* judgement in which it is noted that:-

“The important point to note is that the system as a whole is new...[I]t is true that it could be implemented using conventional computers, but the key is a new physical combination of hardware” (paragraph 53)

17 The examiner for his part in his final examination report identified the contribution as:

“...using a search engine to perform a search across a heterogeneous collection of material not primarily intended for call handling by a computer telephony system...[T]he contribution of your invention is the use of the search engine to perform a search in what is a known/conventional CTI system/method.”

18 In my view the contribution made by the invention is a method of providing CTI functionality across 'heterogeneous collection of material' not intended primarily for call handling, this is achieved by a configuration of hardware and software.

19 I am of the opinion that this solves the problem of the necessity of a dedicated CRM database to provide enhanced functionality to a call handling system. My view is concordant with the main principle of Dr. Davies's identified contribution and I note his reference to *Aerotel/Macrossan*; however I am not convinced by the additional subjective contributions of the concomitant benefits which appear to be subject to many other parameters outside of the scope of the claimed invention.

20 The examiners formulation I believe is too narrowly construed from the form of the claim and has not considered the “substance” of the invention.

21 Moving on to steps 3 and 4, what I must now do is decide whether that contribution falls solely in excluded matter. In doing that I will specifically address the question “is the contribution technical?” as *Symbian* dictates I must.

22 The *Symbian* judgement presents a number of points that are relevant to my decision on the present application.

23 Firstly the Court confirmed that, when dealing with a patent application for an invention that is a computer program, the mere fact that the invention is (or uses) a computer is not sufficient to decide exclusion. Instead, the issue must be resolved by answering the question whether the computer program reveals a 'technical' contribution to the state of the art (paragraph 48).

24 Secondly, it was also confirmed that the *Aerotel/Macrossan* test is a reformulation of the technical contribution approach and that, therefore, any application of the steps of the *Aerotel/Macrossan* test must be consistent with the previous precedent regarding technical contribution (paragraphs 7 and 8).

25 Thirdly, in deciding whether an application reveals a 'technical' contribution the Courts judgement in *Symbian* gives guidance on what constitutes a technical contribution, the Court said

“...not only will a computer containing the instructions in question “be a better computer”, as in *Gale*<sup>4</sup>, but unlike in that case, it can also be said that the instructions “solve” a 'technical' problem lying within the computer itself”. Indeed, the effect of the instant alleged invention is not merely within the computer programmed with the relevant instructions” (paragraph 54)

26 Because

“The effect of the alleged invention in the present case improves the speed and the reliability of the functioning of the computer” (paragraph 55) and “there is more than just a “better program”, there is a faster and more reliable computer” (paragraph 56)

27 Thus when the Court applied the third step of the *Aerotel/Macrossan* test it held that the computer program of *Symbian* did not fall solely within excluded matter

“because it has the knock on effect of the computer working better as a matter of practical reality” (paragraph 59)

28 However, at paragraph 50 Lord Neuberger cautioned that:

“Each case must be determined by reference to its particular facts and features, bearing in mind the guidance given in the decisions mentioned in the previous paragraph”.

29 Thus when the Court applied the third step of the *Aerotel/Macrossan* test it held that the computer program of *Symbian* did not fall solely within excluded matter

30 In my view beyond general guidance as to the sort of thing that does and does not confer a technical contribution, these precedents do not provide me with much in the way of direct assistance in deciding whether the present invention makes a technical contribution.

31 It is my view that the present invention contributes a way of providing an enhanced call handling method which negates the necessity for a CRM database as conventional systems, and further provides for the searching of 'heterogeneous' information. Such functionality was not previously possible in computer-telephony systems. Thus although elements of the invention are implemented in software the contribution is technical as it provides a new and enhanced call handling system.

32 For the sake of completeness, in addressing step 4 of the *Aerotel Macrossan* test, I am of the opinion that the contribution made by the invention of claim 1 is indeed technical in nature.

33 As already stated independent claim 15 stands or falls with claim 1, and thus as claim 15 makes the same technical contribution as claim 1, I consider the invention of this claim also to fall outside the computer program exclusion.

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<sup>4</sup> *Gale's Application* [1991] R.P.C. 305

## **Presentation of information**

- 34 I must also say something about the presentation of information objection raised by the examiner. I am of the view that this objection rises from a too narrow construction of the claim based on form over substance. The final line of claim 1 dictates:-

“using the search results to provide information to the agent receiving the call.”

- 35 I am of the view that this is merely the technical outcome of the method and not an attempt to extend protection to a formatted result provided to the agent. I do not see how any reasonable interpretation can result in this function being the presentation of information within the meaning of Section 2(c) of The Act.

I have found that the defined invention of the claims does have a technical contribution and therefore is not excluded under Section 1(2). As that was the only action outstanding at the hearing the application may now be forwarded to grant.

## **Appeal**

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

P.Mason  
Deputy Director acting for the Comptroller