



Claim 1: A method for determining and sending a preferred of two electronic mail messages ("emails"), comprising: receiving information for conducting an A/B split test between two emails, referred to as A email and as B email, the information identifying a particular group, identifying a segment A of the particular group, identifying a segment B of the particular group, providing content for the two emails, including differentiation information between the two emails, and including determination information on how to select one of the two emails as the preferred email and when to select the preferred email; using the information to send the A email to the segment A, to send the B email to the segment B, to receive information indicative of the open rate and/or click rate for emails A and B respectively, and determine the preferred email between the A email and the B email based on the received information, and to send the preferred email to at least a portion of the particular group.

5 Claim 17: A method for determining which email of two or more emails is more likely to be reviewed by a group and sending that email to the group, comprising: identifying a segment of the group to correspond respectively to each of the two or more emails; selecting a characteristic to differ respectively among the two or more emails; sending one of the two or more emails with the differing characteristics to each of the respective segments of the group; determining which of the two or more emails with the different characteristics is reviewed by more members of its segment of the group than other segments; and sending the determined email to one or more of the group.

6 Claim 18: A method for facilitating success of an email campaign by determining which of at least two electronic mail messages ("emails") is acted on more than the other, comprising: creating a first email and a second email, where the first email and second email differ by a selected characteristic; sending the first email to a first segment of a group; sending the second email to a second segment of the group; determining which of the emails is acted on by more members of its respective segment; and sending the email determined to be more acted to one or more members of the group.

### **Issue to be decided**

7 As discussed above, the issue which I must decide upon is whether the invention as set in the claims relates to matter excluded by Section 1(2) of the Act 1977, in particular whether the claims relate to a computer program and/or a business method as such. I note that the "top-up" search has been deferred pending outcome of this decision on patentability. Consequently, should I find in favour of the applicant I will need to remit this application to the examiner for further consideration.

### **The law**

8 The section of the Act concerning inventions that are excluded from patentability is section 1(2), which reads:

*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) a discovery, scientific theory, or mathematical method;*

*(b) a literary, dramatic, musical or artistic work or any other aesthetic creation whatsoever;*

***(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.*

9 In order to decide whether an invention relates to subject matter excluded by section 1(2), the Court of Appeal has said that the issue must be decided by answering the question of whether the invention reveals a technical contribution to the state of the art (cf *Aerotel*<sup>1</sup> and *Symbian*<sup>2</sup>). The Court of Appeal in *Aerotel* set out the following four-step test to help decide the issue:

1) construe the claim;

2) identify the actual (or alleged) contribution;

3) ask whether it falls solely within the excluded subject matter;

4) check whether the actual or alleged contribution is actually technical in nature.

10 The operation of the test is explained at paragraphs 40-48 of the judgment. 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 47 adds that a contribution which consists solely of excluded matter will not count as a technical contribution.

11 In *Symbian Ltd's Application*<sup>3</sup>, the court made it clear that in deciding whether an invention is excluded, one must ask does it make a technical contribution? It does not matter whether it is asked at step 3 or step 4. If it does, then the invention is not excluded.

## **Arguments and analysis**

### Step 1: construe the claim

12 In general there is no problem in construing the claims – they relate to methods for determining which email (from at least two) is more likely to be preferred by a group, and then sending that email to the group.

13 There has been some discussion between the applicant and examiner as to how the phrase “*send the preferred email to at least a portion of the particular group*” should be construed. The applicant contends that such a phrase must mean that the preferred email is only sent to individuals in the group (all or some) who had not

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<sup>1</sup> *Aerotel Ltd v Telco Holdings Ltd and Macrossan's Application* [2006] EWCA Civ 1371

<sup>2</sup> *Symbian Ltd v Comptroller-General of Patents* [2008] EWCA Civ 1066

<sup>3</sup> *Symbian Ltd's Application* [2008] EWCA Civ 1066

received any of the test emails – thus avoiding duplication. The examiner does not consider the phrase to be so limited. Looking at the description – in particular page 11, line 28 – page 12 line 7 – it is clear that the preferred email may be sent to test email recipients i.e. the preferred email can be sent to test email recipients even if they have previously received an email. I therefore agree with the examiner’s claim construction.

- 14 Nevertheless, in order to properly consider the contribution provided by the application as a whole, I shall consider the limitation that the preferred email is not sent to the test recipients (as defined on page 11 lines 28-32).

Step 2: identify the actual (or alleged) contribution

- 15 The applicant has submitted that when assessing the contribution *“the consideration of the invention as a whole should be made”* and that the contribution should not be assessed too narrowly. In particular, the applicant has argued that *“concentrating on the specifics of the claim, rather than the ultimate aim of the claim can lead to erroneous findings of patentability”*. They also refer to the decisions in *Protecting the Kids the World Over Limited*<sup>4</sup> and *Halliburton*<sup>5</sup> to emphasise that an incorrect finding can result from assessing the contribution too narrowly. I do not disagree with this interpretation of the contribution. Furthermore, it appears to be on all fours with the discussion of how to identify the contribution in paragraph 43 of *Aerotel/Macrossan*<sup>1</sup>:

*“How do you assess the contribution?... it is an exercise in judgment probably involving the problem said to be solved, how the invention works, what its advantages are. What has the inventor really added to human knowledge perhaps best sums up the exercise. The formulation involves looking at substance not form.”*

- 16 So what has the inventor really added to the stock of human knowledge? The applicant essentially argues that the contribution is in an improved messaging system which efficiently sends different messages to two groups. In their letters (dated 18<sup>th</sup> April 2012 and 4<sup>th</sup> February 2013) they state that:

*“The contribution of the present invention is to provide an improved messaging system which efficiently sends different messages to two or more groups. As stated in the background section of the application, the sending of too much information (i.e. the use of multiple emails) results in information being lost as well as increasing the computational burden as well as infrastructure requirements.”*

- 17 The applicant asserts that such improvements are not in the business method, rather such improvements are driven by technical considerations and are accordingly not excluded.
- 18 However, considering the invention as a whole, I do not see how the contribution lies in ‘efficiently’ sending messages. Indeed the actual way in which each message is sent to respective group segments is entirely standard. In my opinion the invention is

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<sup>4</sup> *Protecting the Kids the World Over Limited* [2011] EWHC 2720 and

<sup>5</sup> *Halliburton* [2011] EWHC 2508 (Pat)

characterised by what information is sent, and to whom it is sent for the purposes of identifying preferred content – rather than an efficient way of sending information.

- 19 Therefore, considering the problem said to be solved, how the invention works, what its advantages are, I identify the contribution to be a way of effectively targeting an email to a group of recipients by initially testing at least two emails on respective segments of the group to identify a preferred email, and then sending the preferred email to a portion of the group. This process aims to ensure that the email sent to the group is not ignored or overlooked. The contribution I have identified is along the lines of that proposed by the examiner, although I have expanded it further.

Steps 3 and 4: ask whether it falls solely within the excluded subject matter and whether it is technical

- 20 The applicant has argued in their letters that the present invention provides an improved messaging system – by identifying which message should be sent to each group. Without the present invention, it is submitted, both or all messages would have to be sent to each group to ensure that each person received the relevant information.
- 21 In my opinion, effectively targeting an email to a group is a business problem, and the invention solves this problem by implementing a method of market research (i.e. initially sending and assessing emails on test sub-groups). Such a method relates solely to a way of conducting business. The fact that messaging to a group is ‘improved’ in that the content is more likely to be reviewed by a recipient and less messages need to be sent is not an improved messaging system – it is a better, more efficient email marketing campaign. Furthermore, not sending the preferred email to the people in the group who initially conducted the market research (as defined on page 11 lines 28-32) is a better, more efficient way of conducting business. Better ways of conducting business have been expressly refused by the courts, notably in *Merrill Lynch*<sup>6</sup>, at page 569 lines 17-20:

*“The fact that the method of doing business may be an improvement on previous methods of doing business does not seem to me to be material. The prohibition in Section 1(2)(c) is generic, qualitative considerations do not enter the matter”*

- 22 Therefore I am of the opinion that the contribution as I have assessed it relates solely to a method of doing business.
- 23 It is clear that the contribution is implemented using a computer program. However, in considering the nature of this contribution, I am mindful of paragraph 22 of *Aerotel/Macrossan*<sup>1</sup>, which reminds me that just because a computer is used in an invention, it does not necessarily mean that the invention is excluded from patentability. What matters is whether or not the program provides a technical contribution.
- 24 The applicant has argued, in their letter dated 4<sup>th</sup> February 2013, that the A/B testing involves further interaction between the software and the user/recipient. Most notably

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<sup>6</sup> Merrill Lynch [1989] RPC 561

the user is presented with multiple options for defining the test, which the user then provides responses to in the form of inputs. Furthermore, the determination of the preferred email is based on the recipient's actions (i.e. viewing or clicking through emails). This interactivity allegedly improves the accuracy of the system. *Symbian*<sup>3</sup> emphasised (see paragraph 56) the need to look at the practical reality of what the program achieved and, looking at the practical reality of what these interactive features achieve in the present invention, I do not see how they provide a further technical effect or contribution above the running of a computer program implementing a market research application.

- 25 In *AT&T/CVON*<sup>7</sup>, Lewison J reviews the relevant authorities and sets out a number of signposts to a relevant technical effect with regard to computer programs. These are set out at paragraph 40 of the judgment. For completeness I shall consider these signposts:
- i) whether the claimed technical effect has a technical effect on a process which is carried on 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;
  - iii) whether the claimed technical effect results in the computer being made to operate in a new way;
  - iv) whether there is an increase in the speed or reliability of the computer;
  - v) whether the perceived problem is overcome by the claimed invention as opposed to merely being circumvented.
- 26 With regard to the first signpost, the effect external to the computer is the sending of a preferred email, determined through testing, to a portion of a group. As discussed previously the delivery of a targeted or preferred email relates solely to a business method. Therefore the external effect is a business one not a technical one.
- 27 Regarding signposts ii) and iii) the claimed effect does not operate at the level of the architecture of the computer, and the computer does not operate in a new way – it remains a computer running a targeted email campaign application.
- 28 There is no increase in the speed or reliability of the computer itself. Although the email campaign may be better or more effective than prior art applications, it remains a computer running a better application. Therefore signpost iv) does not point towards a technical contribution.
- 29 For signpost v) the alleged problem of too much information being sent to recipients and/or duplicate emails being sent has been circumvented rather than solved, by not sending information that is likely to be overlooked and/or that has already been seen.

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<sup>7</sup> *AT&T/CVON* [2009] EWHC 343 (Pat)

30 I therefore conclude that the signposts do not point towards a technical contribution. Consequently the contribution also relates solely to excluded matter as a computer program.

### **Conclusion**

31 I find that the invention as set out in the claims is excluded under section 1(2)(c) as a computer program and a business method as such. I do not believe that there is any matter in the rest of the specification as a whole which could be added to the claims in order to give a patentable invention. I therefore refuse the application under section 18(3).

### **Appeal**

32 Any appeal must be lodged within 28 days.

**C L Davies**

Deputy Director, acting for the Comptroller