

PATENTS ACT 1977

APPLICANT Evolution IP Limited

ISSUE Whether patent application GB1911671.4 is
excluded under section 1(2)

HEARING OFFICER H Jones

DECISION

Background

- 1 Patent application GB1911671.4, now published as GB2576430, was filed in the name of Evolution IP Limited on 15 August 2019. The application relates to a system and method for facilitating the filing of one or more patent applications, and is particularly concerned with ensuring that certain formal requirements are met within required deadlines in order to avoid the possibility of withdrawal.
- 2 The examiner has argued that the invention relates to a method of doing business, a computer program and to the presentation of information, and therefore is excluded under section 1(2) of the Act. He has determined that a search would serve no useful purpose in accordance with section 17(5)(b). The applicant has provided arguments in response but these have not persuaded the examiner, who accordingly offered a hearing. The applicant has waived their right to be heard and has instead requested a decision on the basis of the correspondence on file.

The invention

- 3 The application has two independent claims: claim 1 defines a patent application submission system and claim 12 defines a method of submitting a request to a patent filing system, with both being filed as amended claims on 24 March 2022. The two independent claims relate to the same idea and will stand or fall together. Claim 1 reads as follows:

- 1 A patent application submission system for submitting a request to record or register one or more patents or patent applications to a patent filing system comprising

one or more computing devices for receiving data remotely from a user over the Internet via a web page from the patent application submission system, said data identifying one or more patents or patent applications to be recorded,

a processor and memory configured to perform the steps of:

using said data identifying one or more patents or patent applications to automatically retrieve, from a database of patents and patent applications, further data associated with the or each identified patent or patent application;

displaying to the user retrieved data associated with the or each identified patent or patent application for verification by the user;

upon verification of the displayed data by the user, generating and transmitting a request comprising at least minimum required data associated with the or each identified patent or patent application to one or more receiving computing devices of the patent filing system for further processing;

automatically retrieving a response from the patent filing system, said response including a validation result and data assigned to the request by the patent filing system; and

upon retrieval of a response with a positive validation result, reporting the data assigned to the request to the user.

- 4 As can be seen from claim 1, the invention relates to a computer-based system for receiving certain information concerning the filing of a patent application, retrieving further information relevant to the application and presenting it for verification to a user, before submitting the minimum required information to a remote patent filing system. The application states that the invention aims to reduce human errors resulting from the incorrect or incomplete input of data by the user. Although not specified in claim 1, the invention also includes an ability to track deadlines relating to the patent application and sending alert messages to the user, again with the aim of ensuring that human error is minimised.

The law

- 5 Section 1(2) of the Act lists certain categories of subject-matter which are excluded from patent protection.

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...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.

- 6 The test for establishing whether a patent application relates to one of these excluded categories is set out in the Court of Appeal's judgement in *Aerotel*¹. The steps of the test are as follows:

- (i) properly construe the claim;
- (ii) identify the actual contribution;

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

- (iii) ask whether it falls solely within the excluded subject-matter;
- (iv) check whether the actual or alleged contribution is actually technical in nature.

- 7 The Court of Appeal made clear in *Symbian*² that the question of whether a computer-implemented invention is patentable has to be resolved by asking whether it reveals a technical contribution to the state of the art. Relevant to this question are the five signposts identified by Lewison LJ in *AT&T*³ and *HTC v Apple*⁴, which summarise where the Courts have identified such a contribution. These signposts are:
- 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 the program make the computer a better computer in the sense of running more efficiently and effectively as a computer; and
 - v) whether the perceived problem is overcome by the claimed invention as opposed to merely being circumvented.

Arguments and analysis

- 8 The examiner considers that claim 1 is clear in the light of the description and that it poses no difficulties insofar as construction is concerned (paragraph 7 of his examination report dated 19 April 2022 (“the examination report”). I agree with that view.
- 9 The examiner agrees with the applicant’s identification of the alleged contribution as being a computer system for submitting a request to register one or more patent applications as broadly described above. The system provides the advantages of removing the need to manually complete and submit forms containing the necessary data for securing a filing date at the remote patent filing system, of a simplification of the process and an increased speed and efficiency, of a reduction in error rates and of providing certainty regarding valid filing for the user (paragraph 8 of the examination report). I am satisfied that this is a fair statement of the alleged contribution.
- 10 The difference of opinion between applicant and examiner arises in the assessment of whether the contribution falls solely within the excluded fields. The applicant argues that the invention provides a technical effect on a process carried on outside a computer as envisaged by signpost 1, saying that the step of automatically retrieving certain information necessary for filing a patent application removes the need for the user to enter the data manually, and that the further steps of generating and transmitting the request to the relevant patent system is again done automatically, and may be submitted at any time, once the information is verified by the user. The applicant cites the judgment of the Patents Court in *Lenovo*⁵ in support, this being a case where Mr Justice Briss (as he then was) stated that

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

³ *AT&T Knowledge Ventures LP, Re* [2009] EWHC 343 (Pat)

⁴ *HTC v Apple* [2013] EWCA Civ 451

⁵ *Lenovo (Singapore) PTE Ltd v Comptroller General of Patents* [2020] EWHC 1706 (Pat)

making a physical interaction obsolete is capable of giving rise to a technical effect (paragraph 25).

- 11 The invention in *Lenovo* concerned the automatic splitting of payments between multiple contactless payment cards presented to a card reader during a purchase transaction, the automatic split being based on user preferences acquired and stored previously. The invention was described as solving the problem of card clashing, a problem that can occur when a physical wallet containing multiple payment cards is presented to a card reader and the system cannot tell which card data should be used for payment. The invention was able to overcome this problem by allowing a purchase to be split across multiple cards presented to and identified by the reader in accordance with user preferences stored in advance. In his judgment, Birss J found that the prior art solution of the user having to press a button to choose which card to use or to split payment was no longer necessary, because the allocation of payment across the cards was handled automatically at the point of sale. As a result of this automatic feature, he said that the card clash problem experienced with contactless payment cards is solved without the user having to take any extra physical step at the point they use their contactless card. He said that this is an effect of the invention which is neither a computer program as such nor a method of doing business as such, nor a combination of the two.
- 12 The examiner says that while there may be some similarities between the facts in *Lenovo* and the present case, namely the reduction of user input, he says that this is not the sole reason for the allowability of the invention in *Lenovo*. He refers to the Hearing Officer's assessment of *Lenovo* in the *Innoplexus AG* decision of [BLO/397/21](#), where it was suggested that it is not the automation of a previous manual process on its own that was decisive but rather that the automation solved a problem with card clash. The examiner suggests that computer programs are routinely developed to remove the need for human input and that this doesn't necessarily mean they provide a technical effect outside of a computer.
- 13 I agree with the examiner that mere automation of a manual process is not sufficient to demonstrate a technical effect outside of computer, and while *Lenovo* shares the same benefit of automation as the present invention, it also had something more. While the present invention does not completely remove the need for human input, its advantages are tied intrinsically to the expected benefits brought about by the computer-implemented automation of a process, namely the direct reduction of human input and the indirect benefits of improved efficiency, speed, accuracy, resilience and availability that computers are known to provide over humans. The process is improved merely because a computer system is being programmed to replicate some of the steps previously carried out manually, so there can be no technical effect outside of the computer.
- 14 The applicant says that further support for a technical effect can be found with reference to signpost 1 and to paragraphs 17-20 of *AT&T* (which deal with the EPO Board of Appeal's decision in *Vicom*), referring to the "real world" activities of filing a patent application and to the suggestion that physical manipulation (by the patent submission system) of electrical signals representing the patent application data in accordance with the procedures defined by the claims is not an abstract process. The Board of Appeal in *Vicom* said that what is decisive in the context of patentable inventions is what "technical contribution the invention as defined in the claim when considered as a whole makes to the known art". The examiner says that the process of filing a patent application and requesting verification is an administrative process

as opposed to a technical one, and that this is sufficient to distinguish it from the general teaching in Vicom. I agree - the suggestion that the process is anything other than an administrative process because of the physical manipulation of electrical signals representing a patent application is quite absurd. When considered as a whole, the contribution made by the invention is a better process for filing patent applications made possible by replacing some of the steps carried out by a human with a suitably programmed computer. This points to the invention as being a program for a computer and a method for doing business at the very least, so I do not need to consider the further point about it also being a presentation of information.

Conclusion

- 15 I am in no doubt that the contribution made by the invention falls entirely within the excluded fields of a program for a computer and a method of doing business. The application relates to a computer-implemented business method and is refused under section 18(3).

Appeal

- 16 Any appeal must be lodged within 28 days after the date of this decision.

Huw Jones

Deputy Director, acting for the Comptroller