PATENTS ACT 1977

IN THE MATTER OF patent
application GB 9711295.7
in the name of Neil McKirdy

DECISION

Introduction

1. Application GB 9711295.7, entitled "The memory enzyme system", was filed on 3 June 1997 by the applicant, Neil McKirdy. It was accompanied by a Form 9/77 requesting preliminary examination and search, together with the prescribed fee.

2. After a preliminary inspection of the application, which comprises a description, a set of five claims and an abstract, the examiner informed the applicant in an official letter dated 5 August 1997 that he considered that the invention of the application was specifically excluded from patent protection under section 1(2)(c) of the Patents Act 1977 and that refusal of the application under section 18(3) was therefore under consideration. The applicant was given six months in which to submit observations and informed that he would have an opportunity, if he so wished, to come to the Patent Office to present his opinion personally.

3. No reply having been received in the set time period the applicant was given an extension period in which to reply to the official letter of 5 August 1997 and this resulted in the applicant submitting observations which contested the examiner's view in a letter dated 8 April 1998. Shortly afterwards in a further letter dated 13 April 1998 the applicant drew the attention of the examiner to three minor typing errors in

his letter of 8 April 1998.

4. Subsequently, the examiner reiterated his original view concerning section 1(2)(c) in a further official letter dated 21 May 1998, and he also raised a second objection under section 1(1)(c) that it did not seem that the invention was capable of industrial application. He informed the applicant in the letter dated 21 May 1998 that if he wished to be heard before the Comptroller determined the matter he should submit a request for the appointment of a hearing. When no such request was received by the Patent Office the applicant was contacted by telephone and the telephone report on file shows that on 18 November 1998 the applicant confirmed that he did not wish to attend a hearing. It thus falls to me to decide the matter on the basis of the documents on file.

5. The practice followed in the official letters mentioned above, namely of considering whether the application should be refused under Section 18(3) even though no search or substantive examination has been performed, stems from the decision of the Assistant Comptroller in Rohde and Schwarz's Application [1980] RPC 155 where it was held that the Comptroller can apply section 18(3) whenever he chooses.

The Law

6. The relevant sections of the Patents Act 1977 read -

Section 1.

" **1.-**(1). A patent may be granted only for an invention in respect of which the following conditions are satisfied, that is to say -

(a).....

(b)....

(c) it is capable of industrial application;

. (d) the grant of a patent is not excluded by subsection (2) and (3) below;

and references in this Act to a patentable invention shall be construed accordingly.

(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."

Section 4(1)

" ....., an invention shall be taken to be capable of industrial application if it can be made or used in any kind of industry, including agriculture."

The application

7. The application is concerned with a memory enzyme system which "provides a method for introducing logical patterns or sequences, and also for introducing personal involvement, to all facts , data, etc, thus making it easier to note/ recall." Perhaps I should say at this point that the word "enzyme" as used in the application in suit does not fall within the usual definition of "enzyme" which is "a protein acting as a catalyst in a biochemical reaction". The third paragraph of the description explains the term "memory enzyme", reading -

"Just as in biological terms there are enzymes which act as a catalyst to speed up reactions, so in the context of this system a memory enzyme is created to act as a catalyst to speed up and aid the noting/recalling of relevant facts, data, etc. "

8. The statement of claim includes only one independent claim . This claim consists of several sentences, and reads -

"1. A memory enzyme system comprising a physically created memory enzyme which acts as a catalyst to speed and aid the noting/recalling of relevant data, text, etc.

A memory enzyme consists of a straight horizontal line with vertical descending probe(s) and an insertion above the horizontal line of the keyword(s) of the data, text, etc. which is to be noted/recalled. The keyword(s) is directly followed by a bracketted letter or letters obtained from the keyword(s). The keyword(s) and the bracketed letter(s) form the body and head respectively of he memory enzyme, and from which is derived the letter(s), or the equivalent ranking number(s) in the alphabet of such letter(s), shown at the end of the descending probe(s).

By involving the letter(s) or number(s) shown at the end of the probe of a completed memory enzyme with the words, letters numbers shown in the basic or highlighted data, text, etc which is to be noted/recalled, interlocking pattern(s) and/or sequence(s) can be introduced and inserted into or by the highlighted data, text, etc.

The letter(s) or number(s) shown at the end of the probe(s) of a completed memory enzyme, and the noted interlocking insertion(s) form a key and matching lock which is an aid to the noting/recalling of relevant data, text, etc."

9. Specific applications of the memory enzyme system are given in examples in the description. One of these examples relates to recalling that Santa Fe is the state capital of New Mexico. In the description of the application the highlighted words and letters are shown in the colour red.

"Example 2 Interlocking words

For instance to note/recall that the state capital of New Mexico is Santa Fe, the following steps are taken:

Step 1. Select first component, ie New Mexico.

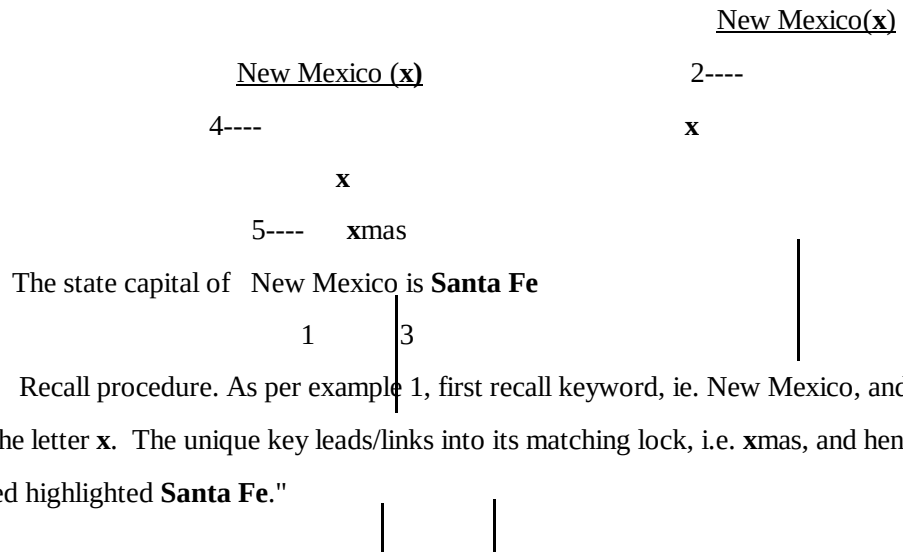
Step 2. Second component. Physically complete the initial basic memory enzyme based on the Step 1 keyword.

Step 3. Select third component, ie **Santa Fe**

Step 4. As before. Initial basic memory enzyme, or its counterpart placed.

Step 5. Here an interlocking word is placed just below the end of the probe of the memory enzyme, and just above the highlighted text.

The introduced interlocking word(s) must make sense, be relevant, logical and contain the letter(s) shown on the probe. The bracketted letter(s), the probe letter(s), and the matching letter(s) in the interlocking word(s) should be similar in colour, size and in a column: In the working shown in example 2, the interlocking word "xmas" has been inserted to link with the highlighted word **Santa**.



Recall procedure. As per example 1, first recall keyword, ie. New Mexico, and its unique key, i.e. the letter **x**. The unique key leads/links into its matching lock, i.e. **x**mas, and hence to the linked highlighted **Santa Fe**."

All the other examples also show horizontal and vertical lines, bracketed letters or numbers, and interlocking patterns or sequences of letters or numbers.

10. The application discloses that the memory system of the invention may be inserted into books, magazines, newspapers, etc., wherever and whenever appropriate, in the main/full text, data, etc., or in its margins, appendices or independently in any suitable space.

Authorities

11. I am aware of two relevant examples which were decided under previous legislation. In Dixon's Application [1978] RPC 687 speech instruction means,

intended to improve speech by conditioning the diaphragm of the speaker and comprising a word drill to be recited by him, the word drill being included in the printed text where horizontal underlining indicated stress and vertical separating lines divided the word into rhythmic groups, were held by Mr Justice Whitford in the Patents Appeal Tribunal to be non patentable under the 1949 Patent Act. And, in Nelson's Application [1980] RPC 173 the Patents Court held that a medium (eg a printed sheet) carrying an instructional message in three parts, that is in pictorial form, in words, and in the form of a humorous reinforcement such as a cartoon, was not patentable under the 1949 Patent Act. In the Nelson application reference was made to the known advantage of humorous pictures fixing facts in the memory.

Conclusion

12. With regard to section 1(2), the examiner objected solely under subsection (c) but it seems to me that I should consider whether objection arises under one or both of subsections (c) and (d) since both presentation of information and a method for performing a mental act can be said to be involved.

13. As far as section 1(2) is concerned, I have carefully considered all the documents present in the application and it does not seem to me that what the present invention is doing involves a technical advance, ie an advance in a technical field. In so far as the system of the invention can be regarded as going beyond the mere presentation of information in the form of lines and letters and/or numbers, and involving an advance, the advance itself lies in an excluded field, namely a method for performing the mental act of remembering. I can see nothing in any of the documents upon which a patent could be granted.

14. Since I find that the application relates to an invention which is excluded from patentability under section 1(2), I do not need to consider in detail the objection raised

under section 1(1)(c). However, it seems to me that the section 1(1)(c) objection is less relevant than the section 1(2) objection since, when the system of the invention is carried out, which system involves the insertion of lines and letters and/or numbers into or by text or data etc. which may be in diaries, magazines or newspapers, an activity is involved which can be regarded as belonging to the useful or practical arts as distinct from the aesthetic or fine arts.

15. Thus, in accordance with my findings under section 1(2) I refuse this application.

16. Since no search has been made on this application, the search fee paid on the Form 9/77 will be refunded.

17. As this decision does not relate to matters of procedure, under the Rules of the Supreme Court any appeal must be lodged within six weeks of the date of this decision.

Dated this 9th day of December 1998

LINDA BLUNT
Principal Examiner, acting for the Comptroller

THE PATENT OFFICE