

PATENTS ACT 1977

IN THE MATTER OF GB Patent

Application No 0127329.1 in the name of

Dell USA LP

DECISION

Background

1. Application number GB0127329.1 was lodged on 14 November 2001 as a divisional application seeking the filing date of the parent application number GB9919949.9 under Section 15(4) of the Patents Act 1977.
2. The background to application number GB9919949.9 is relevant to this decision. This application relates to an internet web-site which permits a user to specify computer equipment and place an order for the system so specified. The examiner objected that the invention forming the subject of this application was not patentable in that the application related to a method of doing business, and was therefore contrary to Section 1(1)(d) by reason of the exclusion under Section 1(2)(c) of “a scheme, rule or method for performing a mental act, playing a game or doing business”.
3. The matter came before me at a hearing on 31 August 2001, and I issued a decision on 4 October 2001 refusing the application.
4. During the course of the hearing, the applicants indicated that they might wish to file a divisional application based on GB9919949.9. In order to accommodate this wish, I deferred formal refusal of the application.
5. The divisional application, the application in suit, was duly filed, and the examiner raised the same objection as had been raised against the parent application, namely that the application relates to a method of doing business as such and so is excluded from patentability under sections 1(1)(d) and 1(2)(c) of the Act.

6. The applicants did not agree, and were offered a hearing to determine the matter. A hearing was appointed for 28 August 2002, but on 27 August 2002 the applicants contacted the office to say that they did not wish to attend the hearing but were content for a decision to be issued on the basis of the written submissions.

The application in suit

7. The present application also relates to an internet web-site which permits a user to specify computer equipment and place an order for the system specified. Apart from claims of the omnibus type, there are two independent claims, to a system and to a method, which read as follows:
 1. A system for the on-line configuration of a build to order computer system comprising:
 - an existing computer system operated by a user;
 - a web-based on-line user interface being accessed by the existing computer system via the Internet, comprising:
 - means for determining which of a number of prescribed sets the user operating the existing computer system belongs to;
 - means for temporarily storing the details of a customer configured system to be configured; and
 - a database for dynamically supplying configuration options to a configurator, the configuration options supplied by the database being dependent upon the set in which the user is determined to belong; wherein
 - the validation module includes a built-in logic checking by passive and/or active validation the compatibility of the particular configuration built by the user, wherein passive validation returns upon operation of the existing computer system by the user a message to the existing computer system, if the particular combinations of options are incompatible and/or

cannot be physically built and wherein active validation disables options on the configuration screen which cannot exist with previous options; and

the lead time warning module determines based on the set in which the user is determined to belong an acceptable lead time, compares the lead time for each of the selected options with the acceptable lead time for the set in which the user is determined to belong, and generates upon operation of the existing computer system by the user a general alert and/or a long lead time icon on the configuration screen displayed by the existing computer system for indication an option for which the lead time is greater than the acceptable lead time for the set in which the user is determined to belong.

19. A method for the on-line configuration of a build to order computer system comprising:

providing an on-line user interface to be accessed via the Internet from a user operating an existing computer system;

determining which of a number of prescribed sets the user operating the existing computer system belongs to;

dynamically supplying configuration options for the customer configured computer system to be built from a database to a configurator, the configuration options supplied by the database being dependent upon the set in which the user is determined to belong, wherein the configurator enables the user to on-line build the customer configured computer system from options listed on a configuration screen displayed by the existing computer system;

validating by passive and/or active validation the compatibility of the particular configuration built by the user, wherein passive validation returns upon operation of the existing computer system by the user a message to the existing computer system, if the particular combinations of options are incompatible and/or cannot be physically built and wherein active validation disables options on the configuration screen which cannot exist with previous options; and

determining based on the set in which the user is determined to belong an acceptable lead time, comparing the lead time for each of the selected options with the acceptable lead time for the set in which the user is determined to belong, and generating upon operation of the existing computer system by the user a general alert and/or a long lead time icon on the configuration screen displayed by the existing computer system for indication an option for which the lead time is greater than the acceptable lead time for the set in which the user is determined to belong; and

temporarily storing the details of the customer configured computer system.

8. These claims differ from the claims of the parent application in several details, and I am presented with arguments in writing that, contrary to the conclusion I came to in respect of the parent application, I should find that the invention claimed in this application is patentable.

Submissions

9. The arguments before me are in the form of a letter dated 16 July 2002 from the Agents representing the applicant. The arguments in the letter do not differ materially from those raised in relation to the parent application. The precedents quoted remain the same, and the argument that what is sought to be protected is not a business method in the normal sense but a method of configuring or designing a computer system which may then be built was also raised in the previous proceedings.

Argument

10. The difference between the present application and the parent application resides in the form and content of the claims. The form has not changed very much; where the claim 1 of the parent application was directed to a web-based on-line user interface for enabling a user to custom configure a computer system, claim 1 of the present application is directed to a system for the on-line configuration of a build to order computer system, which includes a web-based on-line user interface. In content, there are features common to the claims of both applications, but the present claims include the validation module with passive and active validation.

11. I am asked to find that this change of content in the claims saves the invention to which the present application relates from the decision I made in relation to the invention forming the subject of the parent application. In that decision, I referred to words put to me by the agents for the applicants at the hearing, and echoed in the letter submitted on the present application, that the correct approach to judging the patentability of a claim is to look at the claims as a matter of substance.
12. In the earlier decision, I said “in substance, the invention provides an interaction between a user and a computer, which to my mind replicates what a customer may do in a store, by telephone or in writing.” The substance of the invention claimed in the present application remains, in my opinion, such an interface.
13. However, the invention may be patentable if its contribution to the art is technical, as correctly pointed out in the submissions. The question before me therefore is whether the features of the invention as set out in the claims represents a technical contribution.
14. The claims, as in the parent application, relate to an interactive system whereby a user can specify the components of a computer system. The interactive system includes built-in logic which checks “by passive and/or active validation the compatibility of the particular configuration built by the user”. Passive validation is defined as returning a message to the existing computer, and therefore to the user, a message if the options chosen are either incompatible or cannot be physically built. Active validation disables options which cannot exist with previous options.

Decision

15. I am not convinced that a validation module including passive and active validation logic imports technical character into the invention. The substance of this feature remains a matter of business practice, whether it is one which would be carried out by a salesperson, as I found with respect to the parent application, or a technician as argued in the submissions. Merely programming a computer to do what a human being might be able to do mentally does not introduce a technical advance. I acknowledge that the number of combinations is larger than a human being might be expected to be able to retain, but the computer is only working under

rules supplied to it and not, so far as the disclosure and in particular the claims would imply, by any independent thought process. In other words, the rules are defined by human beings, even if there are too many combinations for each to be recalled at will.

16. I therefore find that as with the parent application, this application relates to a method of doing business, and accordingly refuse the application under Section 18(3) on the grounds that the invention claimed therein is excluded by Section 1(2)(c).

Appeal

17. This being a substantive matter, any appeal should be lodged within six weeks of the date of this decision.

Dated this 16th day of September 2002

M G WILSON

Deputy Director, acting for the Comptroller

THE PATENT OFFICE