

PATENTS ACT 1977

IN THE MATTER OF

Application No. GB 9720151.1

In the name of Fujitsu Limited

DECISION

Introduction

1. Patent application GB 9720151.1 entitled “Software Development and Software Design Evaluation” was filed on 22nd September 1997 in the name of Fujitsu Limited. The application claims priority from a Japanese application that was filed on 18th March 1997.
2. A search was conducted and a search report issued on 26th February 1998. In his covering letter the examiner reported that an issue of patentability existed and would be dealt with more fully at substantive examination. The application was published on 23rd September 1998 as GB 2323456.
3. The first examination report under section 18(3) was issued on 25th September 2001, and in it the examiner reported that the claimed invention related to a scheme, rule or method for performing a mental act, or doing business, and/or a program for a computer as such; consequently in his opinion the application was excluded from patentability by section 1(2)(c) of the Act. Initially the examiner also raised an objection on the grounds of obviousness, but this issue has since been resolved. No examination was carried out with regards to the clarity of the application given the patentability objections raised.
4. The applicant responded to the first examination report but the examiner maintained the original objections. The official file shows several further rounds of correspondence between the examiner and the agent representing the applicant. However, the examiner has maintained that the claims are excluded from patentability. The examiner and the applicant’s agent concluded that further correspondence was unlikely to resolve the matter and the applicant duly requested a hearing. That hearing took place on 4th September 2001. At the hearing the applicant was represented by Mr Timothy Stebbing of Haseltine Lake & Co.

The Application

5. The application concerns a method of designing and developing software using a computer. According to the invention, a prototype is developed which allows the user to record comments on the various elements and screens of the system which can then be forwarded to the development engineers. The prototype is developed following a request from a user which is analysed by server-based software. The analysis involves preparing a quotation for acceptance by the user based on a historical database of other developments. The claims have been amended since the application was originally filed. Claim 1, as considered at the hearing, now reads:

1. A development system for software which allows a user to place an order for a software product, and make a review of functional specifications of the software during a development process thereof, comprising:

(a) a client computer comprising
software product order means for placing an order for a software product via a network;

prototype display means for displaying a prototype of the software product under development on a monitor screen, and

user feedback notification means for sending comments and suggestions concerning functional specifications for the prototype over the network; and

(b) a server comprising
similar case searching means for accepting the software product order from the user and retrieving similar case data that relates to the ordered software product,

process content determination means for determining contents of the software product, based on the similar case data that is retrieved by said similar case searching means,

quotation means for issuing a price quotation for the software product,

authentication key assignment means for giving an authentication key to the user, when the user has accepted the price quotation and a software development contract has been made,

prototype presentation means for presenting the prototype to the user via the network,

user feedback distribution means for distributing the comments and suggestions received from the client computer to development engineers in charge of developing the software product;

comment-space inclusive prototype presentation means for generating a comment-space inclusive prototype by adding a comment space to a prototype of the software product under development to allow the user to write comments and suggestions about features of a screen or data items included in the screen as part of the prototype, and for sending the comment-space inclusive prototype to the client computer for presentation to the user;

identification data storage means for storing information for identifying the screen and the items, as well as information for identifying development engineers involved in the development of the software products and

user feedback distribution means for receiving from the user the comments and suggestions about the screens and/or the items from the user through the network, and distributing the received comments and suggestions to the development engineers, based on the information stored in said identification data storage means;

wherein said comment-space inclusive prototype presentation means establishes a communication link between the client computer of the user and another client computer of the development engineer, based on the information stored in said identification data storage means, and presents the same screen as displayed on the second-mentioned client computer of the development engineer on the first-mentioned client computer of the user; and

said user feedback distribution means directly distributes said comments and suggestions provided by the user, to the development engineer by using a messaging service.

6. Dependent claims 2 and 3 and the omnibus type claims 4 and 5 were not expressly discussed during the hearing. It was understood that they would stand or fall with claim 1.

The Law

7. The examiner has objected that the application relates to a scheme, rule or method for performing a mental act, or doing business, and/or a program for a computer as such. This objection is based on section 1(2) of the Act, the essential parts of which are shown in bold below:

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.

8. This particular section of the Act corresponds to articles 52(2) and 52(3) of the European Patent Convention. As section 130(7) of the Act confirms, these respective provisions are so framed as to have, as nearly as practicable, the same effect. It is well established that whilst I am bound by the decision of the courts in the United Kingdom, I must also have regard to the decisions of the European Patent Office Boards of Appeal, at least insofar as they relate to these particular articles of the Convention.
9. It has been established by the Courts that an invention will not be excluded from patentability by the above provision if it makes a technical contribution. That is to say, if an invention makes a technical contribution, then it is *more than* one of the above excluded items, and cannot be regarded as “that thing *as such*”. This principle has been clearly set out by the Court of Appeal in Fujitsu Limited’s Application¹. At page 614, Aldous LJ said:

“However it is and always has been a principle of patent law that mere discoveries or ideas are not patentable, but those discoveries and ideas which have a technical aspect or make a technical contribution are. Thus the concept that what is needed to make an excluded thing patentable is a technical contribution is not surprising. That was the basis for the decision of the Board in *Vicom*. It has been accepted by this Court and by the EPO and has been applied since 1987. It is a concept at the heart of patent law.”

¹ Fujitsu Limited’s Application [1997] RPC 14 at page 614.

The Argument

10. The issue before me, as I see it, is to determine firstly if the application is a method of performing a mental act, or doing business, or a program for a computer. If this is the case then I must determine what technical contribution to the art is made by the invention. If a technical contribution is present, then the invention could not be said to relate to one of the excluded items **as such**.
11. Mr Stebbing first sought to establish the difference between the applicant's invention and the earlier Decisions cited by the examiner during the substantive examination process. Referring to Fujitsu Limited's Application (above) Mr Stebbing drew my attention to the following words of Aldous LJ on page 616:

"Each case has to be decided upon its own facts".

12. Mr Stebbing then described his application in some detail, in order to emphasise what he regarded as the technical contribution. If I have understood him correctly, he submitted that there was a clear technical contribution in the way in which the system establishes a direct link between the client and the development engineer allowing them to talk through a messaging service. To be clear, Mr Stebbing was not claiming that there was anything new about the messaging service itself or the technology used to implement it, but rather the use of such a service in the particular context of software development.

Rule, scheme or method for performing a mental act or doing business

13. There are clear indications of a business method within the system as a whole. For example, the system involves the development of a software package for a fee. The application refers to an "order and quotation module" and makes it clear that the development will only proceed when such a quotation is accepted.
14. But does this amount to a method of doing business as such? When I consider the claimed invention as a whole, as I am required to do, it appears to me that the 'business' aspects of the invention are only a relatively small part of the overall process. In general terms, the invention is concerned with a process for developing software, and whilst that is something that would normally be done for a price, the invention clearly goes beyond merely establishing what that price should be. Consequently I do not think that the invention as claimed is a rule, scheme or method for doing business as such.
15. The same considerations apply to the question of whether the application relates to a method for performing a mental act as such. A number of the individual steps associated with this invention clearly represent mental processes, which is perhaps not surprising since the invention concerns the development of computer programs, which are usually the product of mental activity. Nevertheless, when considered as a whole, it appears to me that the invention is more than a method for performing a mental act as such. In particular, the use of display elements, storage means and distribution means all suggest to me that the invention claimed in claim 1 is more than a mental act as such.

Program for a computer

16. There can be no doubt that the most convenient means of implementing the invention described in this application is a computer program. Indeed the claim describes a client computer and a server computer, each of which incorporate several modules. Mr Stebbing did not dispute that this was the case, but he maintained that the claimed invention made a technical contribution and was therefore patentable. I therefore conclude that the invention as claimed relates to a program for a computer. I will now go on to consider whether the invention is a program for a computer **as such**, and in particular, to decide whether or not there is a technical contribution.
17. I was reminded by Mr Stebbing that the invention does not concern merely a single computer program, but it involves a network of computers — each of which would presumably be running one or more computer programs. Whilst I accept that this is the case, I do not think that the use of a network necessarily means that the application should not be refused as being a program for a computer. The claim defines a number of components running on apparatus which, when operated together, provide a complete system. It seems to me that running a plurality of computer programs on a network of computers does not, of itself, produce a technical contribution over and above that which would be produced by any program running on a single computer.
18. The concept of using a computer program (or, in practice, several computer programs) to link a software development engineer with a customer for the purpose of providing feedback and other comments appears to be a new idea, at least within the context of a software development system. However, taking the best view I can of the matter, I cannot see that the invention as claimed and as described in this application makes a technical contribution. As I understand the position, the various components used to provide the development system claimed in claim 1 are all conventional. It seems to me therefore, that what the applicant has done is assemble a system utilising known technology to address a particular application — in this case, providing a convenient mechanism for exchanging feedback between a customer and a software development engineer. Even when the individual components of a system such as this are known, it is possible that a particular combination of them could give rise to a technical contribution, but I am unable to identify any such technical contribution in this case. I have carefully considered Mr Stebbing's arguments, but I am not persuaded that the invention is anything more than a computer program written to perform a particular function.
19. Consequently I conclude that the development system defined in claim 1 is a program for a computer as such.

Summary

20. In summary I have decided that the invention as claimed in this application is a program for a computer as such. Having read the specification in its entirety, I cannot envisage any amendment to the claims that would be allowed having regard to section 76, and that would overcome the exclusion to patentability. Accordingly I hereby refuse the application under section 18(3) on the grounds that the invention claimed therein is excluded by Section 1(2)(c).

Appeal

21. This being a substantive matter, any appeal from this decision must be lodged within six weeks of the date of this decision.

Dated this 15th day of November 2002

Stephen Probert
Deputy Director, acting for the Comptroller

PATENT OFFICE