



BL O/274/04

7th September 2004

PATENTS ACT 1977

APPLICANT

Alan Derek Dean

ISSUE

Whether patent application number
GB 0106968.1 complies with section 1(1) and 1(2)

HEARING OFFICER

B Westerman

DECISION

Introduction

- 1 Patent application No GB 0106968.1 entitled "System for constructing electronic mail addresses" was filed on 20th March 2001 in the name of Alan Derek Dean, claiming priority from application No GB 0007224.9 filed on 24 March 2000. The application was searched in the normal way. In the letter accompanying his search report dated 1st February 2002, the search examiner observed that, although this would not be considered in detail until substantive examination, he felt that the application might be excluded from patentability by Section 1(2)(c) and/or (d) of the Act. The application was then published on 10th April 2002.
- 2 The first substantive examination report under Section 18(3) was issued on 8 September 2003. In it the examiner formally raised objection that the invention appeared to be excluded from being patentable under the provisions of Section 1(2); and also raised novelty objection under Section 1(1)(a) on the basis of a number of documents, including some found during the customary top-up of the original search. In particularizing the objection under section 1(2), the examiner explained that he considered that the invention could best be considered as a scheme, rule or method for performing a mental act and as the presentation of information, and therefore excluded under sections 1(2)(c) and (d).
- 3 Several rounds of amendment and re-examination followed throughout which the examiner maintained his objection under section 1(2) that the invention was not patentable. The final Office letter on file dated 11 August 2004 reiterated the examiner's view that, notwithstanding the amendment already made, the application was not patentable under section 1(2) and he also pressed objection under novelty and inventive step. Mr Dean's Agents, Williams Powell, responded, in a letter dated 20 August 2004, which ended with a request to be heard if the examiner was minded to maintain his objections.

- 4 A hearing was duly offered, but Mr Dean's Agent, on his behalf, declined to attend and asked that a decision be taken on the papers.

The Application

- 5 The application relates to a method and a system for providing a standardized set of electronic mail addresses based upon personal information. As I have previously said, there has been some amendment during the examination process, and the current set of claims includes independent claim 1 to a method; claims 2 to 6 dependent upon claim 1; independent claim 7 to a system; claims 8 to 12 dependent on claim 7; and claims 13 and 14 which are claims referring to the drawings to the method and system, respectively. The two independent claims read as follows:

1. A method of providing a set of standardised electronic mail addresses for individuals in a geographical region, including obtaining name and location details of individuals in a geographic region, providing a personal name code indicative of the name of each of said individuals, providing a plurality of location codes indicative of a known location of each of said individuals, said location codes including at least one address indicator and a telephone area code indicator, generating a standardised electronic mail address for each of said individuals from said personal name code and the location code indicative of known location of the respective individual, providing a database of said standardised electronic mail addresses for said individuals, and providing a search engine for searching said database using said location codes and said personal name code to locate the associated standardised electronic mail address.

7. A system for providing a set of standardised electronic mail, including means for obtaining name and location details of individuals in a geographic region, means for providing a personal name code indicative of the name of each of said individuals, means for providing a plurality of location codes indicative of a known location of each of said individuals, address generation means operable to generate a standardised electronic mail address for each of said individuals from said personal name code and the location code indicative known location of the respective individual, a database of said electronic mail addresses for said individuals, and a search engine for searching said database using said location codes and said personal name code to locate the associated standardised electronic mail address.

The Law

- 6 As I have mentioned, there are two issues where, in the opinion of the examiner, the current form of the application is contrary to the requirements of the Act.

- 7 One issue is whether the claims are novel and inventive, as required by section 1(1), which states:

“A patent may be granted only for an invention in respect of which the following conditions are satisfied, that is to say -

- (a) the invention is new;
- (b) it involves an inventive step;

- (c) it is capable of industrial application;
 - (d) the grant of a patent for it is not excluded by subsections (2) and (3) below;
- and references in this Act to a patentable invention shall be construed accordingly”

8 The perhaps more fundamental issue is whether the application is excluded from patentability by section 1(2), which states:

“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 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 These provisions are designated in section 130(7) as being so framed as to have, as nearly as practicable, the same effect as Article 52 of the European Patent Convention, to which they correspond. I must therefore also have regard to the decisions of the European Boards of Appeal that have been issued under this Article.

10 The section 1(2) issue seems to me to be rather more fundamental to the decision as to whether or not to grant a patent, and I feel it is convenient to deal with this first.

Interpretation and Argument – Section 1(2)

11 Upon reading the correspondence in the case file, it became clear to me that the submissions on behalf of Mr Dean were in agreement with the general principles that I feel that I should apply in deciding whether the present invention is or is not excluded by section 1(2). That helpfully negates the need for me to explain those principles (and their source in precedent) at length, but for completeness I summarise them here.

12 First, in deciding whether an invention is excluded, it is the substance of the invention that is of importance rather than the form of claims adopted. Second, the effect of the final part of section 1(2) is that an invention is only excluded from being patentable if it amounts to one of the excluded areas “as such”. Following decisions of the UK Courts and the EPO Boards of Appeal, an invention is not considered to one of those things “as such” if the invention makes a technical contribution. Third, whether an invention makes a technical contribution is an

issue to be decided on the facts of the individual case. Finally, it is desirable that there should be consistency between the Patent Office's interpretation of the Patents Act and the EPO's interpretation of the EPC.

- 13 It is the examiner's position that the substance of the method and apparatus claims is a system for producing email addresses based upon names and locations of users of the system, and that this is excluded as presentation of information and/or as a scheme, rule or method for performing a mental act, or doing business.
- 14 The submissions put forward on behalf of Mr Dean disagree, saying that, in deciding the substance, it is not acceptable to construe a claim so as to ignore non-excluded features. He says that the database and search engine in the current form of the claim mean that the invention is not an excluded invention "as such".
- 15 They also draw attention to two decisions of the EPO Board of Appeal *Koninklijke Philips Electronics N. V.* T 1194/97 and T 163/85 (helpfully summarized and explained in T 1194/97). The submission argues, on the basis of these cases, that since the EPO there found a record carrier having functional data recorded thereon to be not "presentation of information" as such, then this invention, being the generation and storage of standardised email addresses, should also be allowable.
- 16 Finally, it is argued that the selection of the format of the email addresses defined in the invention provides a technical contribution, in that it avoids any ambiguity and inconsistency. This brings predictability to the system and facilitates ready access to individuals, solving a problem with the current system of self-selected addresses.

Assessment – Section 1(2)

- 17 In assessing the substance of the invention, whilst I should have regard to the claims, I need to look further than this. Having carefully considered all the submissions made on behalf of Mr Dean, I come to the conclusion that the substance of the invention, for the purposes of assessing whether or not the invention is excluded, is the generation and use of a searchable database of personal information for a set of people where, for each person, one item of this information, an electronic mail address, is generated from the specific other items in the way specified in the independent claims. The only example in the application is implemented on a computer, and, of course, searchable databases are commonplace in this context.
- 18 I must now consider whether this substance falls within one of the excluded areas, and if so, whether or not there is a technical contribution which would mean that it cannot be said to fall within the excluded item *as such*.
- 19 The first limb of the examiner's objection is that the substance is the presentation of information. I am not persuaded that this is so. The substance is, in my view, certainly concerned with, and depends upon, the intellectual content of the information. However, in my view, it is not concerned with the presentation of any particular information. Thus for example it is not dependent upon the content being any particular name or address, nor is it

concerned with the arrangement of information displayed.

- 20 In coming to this conclusion, I have carefully considered the EPO Board of Appeal decisions mentioned, but do not find these particularly helpful in this case. The subject-matter allowed in those decisions depended fundamentally on the technical structure and format of data which allows an associated apparatus to regenerate an image. This is not the case in the present invention.
- 21 The second limb of the examiner's objection is that the substance lies in a scheme, rule or method for performing a mental act or doing business. As I have said above, I am convinced that the substance of the invention lies in the intellectual structure of the information, and the intellectual decisions as to what to record, and make available to search. I can find nothing which I characterize as a *technical* contribution to the art in implementing these fundamentally intellectual operations. I thus find that the substance of the invention lies in a scheme rule or method *as such* for performing a mental act or doing business. Whilst I have little doubt that the advantages of less ambiguity and consistency are real, in my view they do not depend upon any technical feature, but only on the intellectual choice of the scheme for deriving the specified item.
- 22 I also find nothing in claims 2 to 6, 8 to 12, 13 and 14 which could avoid this finding. I therefore refuse the application under section 1(2)(c).
- 23 Having come to this conclusion, strictly there is no need to go on to consider the novelty and inventive step objections raised by the examiner. I will, however, consider them for completeness.

Argument – Section 1(1)

- 24 The examiner has asserted that the invention as defined in claims 1 to 12 is not new because it has already been disclosed in each of:
- D1: WO 99/40527 A1 (A PTY)
D2: US 5987508 A (AGRAHARAM)
- 25 In the alternative, he also asserts that the invention has no inventive step in the light of the two documents above, and also the following two documents:
- D3: "Designing large electronic mail systems" (HILAL et al) International Conference on distributed Computing Systems, published 1988, IEEE Comput. Soc. Press, USA
D4: JP 060261069 A (FUJITSU)
- 26 All four of these documents are clearly concerned with electronic mail, and various ways of devising and dealing with electronic mail traffic involving electronic mail addresses structured to include elements of information relating to name and location (geographical and/or telephone). Mr Dean's Agents, in their responses dated 26 November 2003 and 20 August

2004 analyse these documents and submit there are differences in the present invention from the invention claimed.

- 27 In the case of documents D1 and D2, one difference alleged is that neither of these disclose or suggest generating a standard email address for individuals (by implication all individuals) within a geographical region, since both documents depend upon an individual registering with the service mentioned in the embodiments of the respective patent. In connection with D1, it is also said that the system disclosed is not stand-alone, but could only be used with a mail server of a domain, and thus is only usable by those with an account served by that server. In connection with D2, it is also said that this document does not disclose or suggest the storage of the addresses in a searchable database.

Assessment – Section 1(1)

- 28 I can not see that the differences alleged above are reflected in the wording of claims 1 and 7. Neither of these has, in my view, any restriction as to how and in what sequence the records of individuals are added to the database, and I consider that the addition of one individual's record to a current database is not excluded by the words of the claim. It is not a requirement in either claim that all individuals in a geographical area must be present, even if it could be determined with certainty what restriction to a "geographical region" implies. This is a feature introduced by appendent claims 4 and 10. Neither do the claims exclude use with a particular domain. I will return to the alleged distinction of the searchable database in document D2 below.
- 29 With regard to D1, I consider that it clearly discloses generation of a standardised form of electronic mail address including name information and location information selected from geographic and telephone information (see page 11, lines 11 and 12 and page 12 lines 3 to 8); these so-derived electronic addresses are held in a database (page 11 lines 10 to 14) which is searched in the process disclosed. This must mean that a search engine is present. At first sight, the only difference from claim 1 and 7 of the present application is that these specify the use of codes, in particular telephone area codes, as the geographical and location information, and as the input to the search engine. However, I am not convinced that this is of any substance, particularly since D1 clearly envisages (page 11) the use of telephone area codes as part of the standardised address. Use of a truncated form of the name (eg "john" for "John Smith") is also disclosed, so again I do not see the use of "name codes" as a distinction, certainly not one with any technical restriction. If it does provide a distinction then I consider this to be so self-evident as to be clearly obvious. I therefore find that claims 1 and 7 lack novelty and/or inventive step in the light of D1. I also consider that this document discloses claims 2, 3, 5, 6, 8, 9, 11 and 12.
- 30 With regard to D2, I consider that it clearly discloses a database (see column 6, line 13) which is searchable by entry, for example, of a telephone number, and contains electronic mail addresses the structure of which may include a name or part thereof (eg claim 2, column 8), a telephone number (which includes a telephone area code) and a geographical identifier (eg claims 8 and 9, column 8). Thus I do not agree with the submission that there is no disclosure of a database and search engine in the light of these passages. For similar

reasoning to that under D1 above, I consider the potential distinction by use of the term “codes” not to distinguish or to be clearly obvious. Column 3, lines 34 to 50 describes the way in which the database is populated. As Mr Dean has submitted, this is by individual registration, but as I have said, I do not find this excluded by the words of claims 1 and 7. Again, therefore, I consider that claims 1-3, 5-9, 11 and 12 to lack novelty and/or inventive step in the light of D2.

- 31 Quite rightly, in my view, the examiner has not objected under section 1(1)(a) on the basis of the other two documents, and I do not feel that I need to analyse them in detail except to say they are further examples suggesting the use of a structure for electronic mail addresses involving name, location or telephone number (amongst other things), and the storage and retrieval of these in and from databases. D4 does not disclose plural items of location information in an individual record, and therefore in my view does not form the basis for any objection. D3 is an academic paper setting out many different options with no disclosure or suggestion that the particular selection of information attributes of the present invention is appropriate. I therefore do not consider that they demonstrate lack of inventive step under section 1(1)(b).

Conclusion

- 32 I have found that the invention is excluded from patentability under section 1(2)(c), but is not so excluded by section 1(2)(d). I have also found that the invention defined in claims 1-3, 5-9, 11 and 12 lack novelty and/or inventive step in the light of documents D1 and D2.
- 33 I therefore refuse the application on these two grounds.

Appeal

- 34 Under the Practice Direction to Part 52 of the Civil Procedure Rules, any appeal must be lodged within 28 days.

B WESTERMAN

Deputy Director acting for the Comptroller