



5 Claim 1 as presented on 6 September 2004 read as follows:

A computer-based man-hour management system which manages man-hours for producing automobiles, comprising:

a standardized man-hour management system which controls:

a walk man-hour conversion table for performing registration management of standardized man-hours for walks which are generated by works,

a work constituent condition table for performing registration management of constituent works for use in managing the man-hours, and having conditions for each of the constituent works, and

a standardized man-hour table for performing registration management of standardized man-hour analysis contents and standardized man-hours for the constituent works or the constituent work conditions which are under the registration management of said work constituent condition table;

a main man-hour management system which controls:

a main man-hour management table for performing registration management/reorganization management of constituent work items in units of processes, data being assigned to the constituent work items from said walk man-hour conversion table, said work constituent condition table and said standardized man-hour table, or data being inputted and set to the constituent work items, and

a process name table for performing registration management/reorganization management of names of the processes;

man-hour output means for outputting man-hour information by being assigned data from said main man-hour management table and said process name table;

the system further comprising a plurality of connection terminals, each terminal having a display on which respective icons are shown for launching the standardized man-hour management system, the main man-hour management system and the man-hour output means.

6 There is also a second independent claim, claim 9, which is sufficiently differently set out to merit quoting in full. It reads:

7 A method of controlling the production of automobiles, comprising:

providing a plurality of connection terminals, each terminal having a display on which respective icons are shown for launching a standardized man-hour management system, a main man-hour management system and a man-hour output means;

launching the standardized man-hour management system via its respective icon and:

registering, in a walk man-hour conversion table, the standardized man-hours for walks which are generated by works,

registering, in a work constituent condition table, the constituent works for use in managing the man-hours, the work constituent condition table having conditions for each of the constituent works, and

registering, in a standardized man-hour table, standardized man-hour analysis contents and standardized man-hours for the constituent works or the constituent work conditions registered in said constituent condition table;

launching the main man-hour management system via its respective icon and:

registering/reorganizing, in a main man-hour management table, constituent work items in units of processes, data being assigned to the constituent work items from said walk man-hour conversion table, said work constituent condition table and said standardized man-hour table, or data being inputted and set to the constituent work items, and

registering/reorganizing, in a process name table, names of the processes;

launching the man-hour output means via its respective icon to output man-hour information from said main man-hour management table and said process name table; and

modifying automobile production on the basis of said information.

- 8 These claims differ from those originally filed mainly in the specific reference to automobile production and the reference to a plurality of terminals.

### **The Law**

- 9 The examiner has reported that the invention to which the patent relates is excluded from patentability by section 1(2) of the Patents Act 1977 as it relates to a method of doing business and a program for a computer. Section 1(2) reads:

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.

- 10 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 have regard to decisions of the European Boards of Appeal under this article in deciding the patentability of the invention to which the application in suit relates.

### **Interpretation**

- 11 In matters of patentability, it has been established both in UK and EPO practice that an invention which makes a technical contribution will be held patentable notwithstanding that it may fall into one of the categories in section 1(2). This principle follows in particular the decision of the Court of Appeal in *Fujitsu Limited's Application* [1997] RPC 608 and the words of Aldous LJ at page 14:

“...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 the EPO and has been applied since 1987. It is a concept at the heart of patent law.”

- 12 This is the basis for a statement issued in the form of a Practice Notice, with which Mr Gill indicated that he was familiar, on 19 April 1999 which reads: “The Patent Office has taken the view that the authorities decide that it is the absence of a substantive technical contribution in the subject matter which would render an invention unpatentable and that it is not possible to rescue inherently unpatentable subject matter from its fate merely by changing the semantic form of the claims, *e.g.* by dressing a program for a computer up as a carrier or a conventional computer containing the program. However, the Courts were not able to identify any substantive technical contribution in any of these authorities and as a result they rejected the applications for that reason. Consequently, they did not elaborate on the position in the event there is such a contribution.”

### **Argument**

- 13 At the hearing, Mr Gill acknowledged that the appropriate test to be applied is that of technical contribution. However he argued that the test should be applied to the invention claimed, and not, as the examiner had argued in an examination report, the “essence” of the invention.
- 14 The argument has centred on the system claims and not the method claims, and I shall address these primarily.

- 15 In support of his argument, Mr Gill directed me to three decisions of the Board of Appeal of the European Patent Office. In the first, *Koch & Sterzel (T0026/86)*, he directed my attention to words in paragraph 3.4: “The Board holds that an invention must be assessed as a whole. If it makes use of both technical and non-technical means, the use of non-technical means does not detract from the technical character of the overall teaching.” He argued that this is support for the need to consider the claim as a whole and not to salami-slice it into technical and non-technical features.
- 16 The second was *IBM (T1173/97)*, in which the Board state: “for the purpose of determining the extent of the exclusion under Article 52(2) and (3) EPC, the said ‘further’ technical effect may in its opinion, be known in the prior art.”
- 17 The third was *Hitachi (T0258/03)*, from which Mr Gill quotes “it is often difficult to separate a claim into technical and non-technical features, and an invention may have technical aspects which are hidden in a largely non-technical context”.
- 18 In presenting his argument, Mr Gill offered up three sets of claims which he presented as a main request, an auxiliary request and a subsidiary request. He also offered a fourth which would only come into play if one of the first three were to be accepted. The amended claims progressively introduce further features into the claims in support of his argument, which as I understand it is that the question whether an invention is patentable should address the claims and not the disclosure as a whole: the “essence” of the invention.
- 19 The new claims offered firstly restrict the claim to “an automobile production plant having a computer-based man-hour management system” rather than the system *per se* to which the claims previously related and state that the plant is arranged such that automobile production is modifiable on the basis of the output information, then introduce a weld position, weld points, a weld length and welding robots, and finally introduce “equipmental man-hours” into the standardized man-hours.
- 20 Mr Gill argues that by including these features the technical contribution of the invention is highlighted.
- 21 This is contrary to the Practice Notice quoted above, but is argued on the basis of the extract from *IBM* quoted above. While I am not bound by this authority, I must take it into account in arriving at a conclusion in the present instance.
- 22 The extract from *IBM* suggests that a technical effect may be known in the prior art. In my view, it is possible for two distinct inventions to have the same technical effect. To that extent the technical effect can be known in the prior art.
- 23 Turning to the application in suit, Mr Gill has argued that the invention involves a technical contribution, in that the production plant can be modified on the basis of information derived from the man-hour management system, and that there is interaction between technical and non-technical aspects of the invention claimed. I cannot accept this, and no amount of incorporation of references to the production plant will change my view. The Practice Notice makes it clear that it is not possible to rescue unpatentable subject matter by changing the semantic form of the claim, and that is all that the sequence of changes to the claim has done.

The specification is clear; all the detail described in a description extending to 145 pages is concerned with the man-hour management system and no specific detail of a production line is included. The system may produce benefits leading to what may be described as technical modifications of the plant, but that does not mean that the invention itself offers a technical contribution, or even that there is any meaningful interaction between technical and non-technical elements.

- 24 In further support of his submission, Mr Gill pointed to a document listed on the search report, namely GB Patent Specification no 1477671, which is directed to a production control system and may be said to bear some similarities to the present invention. I am not bound by previously granted patents, especially those considered under the old Act, and hence am not persuaded to take the grant of this patent into account in arriving at a decision.
- 25 Mr Gill also argued that doubt should be resolved in favour of the applicant. I wholly agree with that principle, but in this instance can see no room for doubt. The whole flavour of the invention, whether expressed as a man-hour management system or an automobile production plant incorporating a man-hour management system, in my view constitutes a method of carrying out business or a program for a computer, and as such is not patentable.

### **Conclusion**

- 26 I have found that the invention claimed in this specification is a method of doing business or a program for a computer, and that there is no technical contribution which would prevent its exclusion from patentability. I can see no form of claim supported by the disclosure that could relate to a patentable invention. Accordingly, I refuse the application under section 18(3) on the grounds that the invention claimed is excluded under section 1(2)(c).

### **Appeal**

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

**M G WILSON**

Deputy Director acting for the Comptroller