



BL O/184/05

30 June 2005

PATENTS ACT 1977

APPLICANT

Koizumi Norihiro

ISSUE

Whether patent application number GB0312470.8 is excluded under section 1(2)

HEARING OFFICER

P R Slater

DECISION

Introduction

- 1 Patent application GB0312470.8 entitled "Address inquiry system, computer program product, and method therefor" was filed on 30 October 2001 in the name of Koizumi Norihiro. It is derived from international application PCT/JP2001/009516 which was published by WIPO as WO02/37330 and claims priority from an earlier Japanese application JP2000329940, filed on 30 October 2000. The application entered the national phase and was re-published as GB2386225 on 10 September 2003.
- 2 The Japanese Patent Office acting as International Searching Authority issued an International Search Report on the 30th November 2001 citing a number of Japanese documents as background art only. An International Preliminary Examination Report was established on 18th April 2001.
- 3 In his first examination report dated 15th April 2004, the examiner reported that the invention was excluded from patentability under section 1(2) as being both a program for a computer, a mental act and/or a method of doing business, and that, insofar as it was claimed in claims 23-25, the invention lacked an inventive step. The application was subsequently amended to overcome the inventive step objections, but the examiner maintained his objection regarding the patentability of the invention insofar as it related to a computer program and a method of doing business in further examination reports dated 9th November 2004 and 17th February 2005.
- 4 Having been unable to resolve the matter through either amendment or argument, the matter came before me to decide at a hearing on 17th June 2005 at which the applicant was represented by Dr Robin Waldren of Lloyd Wise.

The Application

- 5 The application relates to, what is effectively, an online address book in which people can

register their new address, for example, their e-mail address, postal address or URL alongside their old one. This is then stored in a remote database. Anyone wishing to contact that person at their new address can do so by submitting a request to the remote database which includes the old address. The new address will then be disclosed to the enquirer based upon certain predetermined rules, or the addressee may, under certain conditions, need to be contacted to obtain permission for the address to be disclosed. In certain circumstances, where an old e-mail address or URL is used an automatic enquiry may be made to ascertain the new address.

- 6 The most recent set of claims were filed on 11 February 2005. There are currently 22 claims of which two are independent. Claims 1 and 8 read as follows:

“1. A communication system comprising a changer terminal operable by a changer, an enquirer terminal operable by an enquirer of a new address of the changer based on an old address of the changer, and a central computer processing means remote from each terminal and arranged for communication with each terminal over the internet, wherein the system is such that:

central computer storage means are associated with and accessible by the central processing means, the central storage means storing a database that relationally stores at least the old address, the new address, and an address disclosing condition capable of setting a permission condition whereby the changer judges whether to give permission to disclose the new address;

in response to receiving an enquiry signal that includes the old address from the enquirer terminal, the central processing means searches the data base for the new address corresponding to the old address, and for the address disclosing condition;

in response to the address disclosing condition including the permission condition, the central processing means transmits a signal seeking conformation from the changer terminal that the new address may be disclosed; and

in response to receiving confirmation from the changer terminal, the central processing means transmits a signal communicating the new address to the enquirer terminal.”

“8. A communication system for making an enquiry about an address, the system comprising a registrant terminal operable by a registrant, an enquirer terminal operable by an enquirer who wishes to know the address of the registrant, and a central computer processing means remote from each terminal and arranged for communication with each terminal, wherein the system is such that:

central computer storage means are associated with and accessible by the central processing means, the central storage means storing an address data base, in which the registrant registers his or her own address, the database relationally storing an address disclosure condition;

in response to receiving an enquiry about the address of the registrant from the enquirer via the enquirer terminal, the computer processing means judging whether to disclose the address to the enquirer based on the address disclosure condition; and

in response to judging that the address is to be disclosed, the computer processing means sending the address of the registrant to the enquirer terminal”

The Law

- 7 The examiner has maintained that the application is excluded from patentability under section 1(2)(c) of the Act, as relating to a method for doing business and a program for a computer as such. The relevant parts of this section read:

“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)

(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)

but the foregoing provision shall prevent anything from being treated as an invention for the purpose of this Act only to the extent that a patent or application for a patent relates to that thing as such.”

- 8 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 (EPC), to which they correspond. I must therefore also have regard to the decisions of the Boards of Appeal of the European Patent Office (EPO) that have been issued under this Article in deciding whether the present invention is patentable.

Interpretation

- 9 Dr Waldren opened his submissions by drawing my attention to the judgment of Nicholls LJ in *Gale’s Application* [1991] RPC 13 at page 323 where he said that:

“... it is of the utmost importance that the interpretation given to section 1 of the Act by the courts in the United Kingdom, and the interpretation given to Article 52 of the European Patent Convention by the European Patent office, should be the same. The intention of Parliament was that there should be uniformity in this regard. What is more, any substantial divergence would be disastrous. It would be absurd if, on an issue of patentability, a patent application should suffer a different fate according to whether it was made in the United Kingdom under the Act or was made in Munich for a European patent (UK) under the Convention.”

- 10 Dr Waldren drew my attention to the words ‘disastrous’ and ‘absurd’ in the context of the above passage, suggesting that I should not merely have regard to decisions of the EPO Boards of Appeal, but that I should follow the current practice of the EPO in this area. In his submission, following the *Sohei*¹, *Pension Benefits*² and *Hitachi*³ decisions the EPO would

¹ *SOHEI/General-purpose management system* [1996] EPOR 253 (T769/92).

² *Pension Benefits Systems Partnership* [2001] 10 OJEP0 441

not regard his invention as relating to excluded matter, in particular because of the presence of technical apparatus – eg. a central computer and remote terminals.

- 11 This particular line of argument has been raised previously in hearings before the Comptroller, but nevertheless the Comptroller’s Hearing Officers have consistently chosen to follow the approach established by the Courts, ie. that an invention will not be excluded from patentability by the above subsection if it makes a technical contribution⁴. The principles to be applied under UK law in deciding whether an invention makes a technical contribution have been rehearsed repeatedly in various recent decisions of the Comptroller’s hearing officers. These can all be found on the Patent Office website at <http://www.patent.gov.uk/patent/legal/decisions/index.htm> .
- 12 For the purpose of this decision, I consider it necessary only to restate the principles I have applied and not their origin. First, it is the substance of the invention which is important rather than the form of claims adopted. Second, whether an invention makes a technical contribution is an issue to be decided on the facts of the individual case. Third, it is desirable that there should be consistency between the Patent Office’s and EPO’s interpretation of the exclusion in the Patents Act and the EPC.
- 13 Dr Waldren also relied upon the *Fujitsu* case⁴ to support his argument that apparatus including technical features should not be excluded from patentability. Although he didn’t expand on this point, I took it that he was referring to the words that I have underlined below in the passage at page 614 lines 40 to 43 where Aldous LJ says:
- “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.”*
- 14 In other words, as I understood him, Dr Waldren was suggesting that the technical features in his claim, eg. a central computer and remote terminals, meant that his invention did have a “technical aspect” as required by Aldous LJ. However, I note that there were also technical features in abundance in the *Fujitsu* case, but the Court nevertheless rejected the application as relating to excluded matter. I am therefore not persuaded by this argument.
- 15 I therefore consider it entirely appropriate, in deciding whether the present invention is excluded from patentability, to consider the following two questions:
- Does the *substance* of the invention relate to a business method and/or a computer program? If the answer to that question is “yes”
 - Does the *substance* of the invention make a technical contribution such that it cannot be said to amount to an excluded item as such?
- 16 Only if the answer to the second question is “no” is the invention excluded under section 1(2).

³ *Hitachi Ltd/Auction Method* (T 0258/03)

⁴ *Fujitsu Limited’s Application* [1997] RPC 608 at page 614.

Does the *substance* of the invention relate to a business method and/or a computer program?

- 17 The examiner has reported that whilst the invention is defined in terms of a communication system and contains various technical features, it is the substance of the invention which matters. In this case, he reported that the invention as a whole would seem to relate to nothing more than an organisational/administrative activity and in particular “a way of defining access to a new address” and that this sort of activity falls within the business method exclusion. He supports his objection by reference to the Hearing Officer’s decision in *Sony Communication Network Corporation*⁵ where the application was defined as a “communications system” for “facilitating the exchange of messages between parties such that a recipient can specify who (s)he receives messages from”. Here, the Hearing Officer stated that a process defining “who is allowed to contact whom” fell within the business method exclusion.
- 18 Having carefully considered all of the arguments made in the correspondence and at the hearing, I am in no doubt that the substance of the invention relates to the management and administration of an online address book and as such falls within the business method exclusion.
- 19 The examiner has also reported that whilst the invention relates to a business method, it is implemented via a computer apparatus and therefore relates to a computer program as such and again falls within the scope of the exclusions laid down in section 1(2)(c).
- 20 Having considered the specification as a whole, it is quite clear that the invention is nothing more than a series of computer programs running on what appears to be a conventional, Internet based network. Indeed, the passage at lines 10 to 15 on page 17 of the specification suggests that in practical terms the majority of those functions carried out by the system are implemented in the form of computer programs and that everything else is entirely conventional. Hence, I consider that prima facie the invention also falls within the computer program exclusion.
- 21 I have found that the invention potentially falls within the “business method” and “computer program” exclusions. However, that is not the end of the matter. I must now decide whether the invention amounts to those things “as such” by applying the technical contribution test.

Does the *substance* of the invention make a technical contribution such that it cannot be said to amount to an excluded item as such?

- 22 The examiner was unable to identify a technical contribution resulting from the invention. He reported that the invention appeared to provide a “new tool”, using conventional hardware, to solve a business related problem rather than a technical one.
- 23 Dr Waldren maintained throughout the correspondence and at the hearing that the invention relates to a “communication system” in the form of a dispersed network capable of automatically transferring address data between remote terminals on the basis of certain

⁵ *Sony Communication Network Corporation* (BL 0/374/04)

predetermined rules. He argued that this is clearly technical in nature and should not be excluded from patentability by virtue of the decision in the *Fujitsu case*. He said that the primary advantage is a technical one, and in automating the process, the problems and errors associated with human intervention and frailty are overcome resulting in an increase in accuracy, reliability and speed of operation.

24 There is no suggestion anywhere in the specification that the hardware used to implement the invention is anything other than conventional. Thus, the hardware itself cannot, it seems to me, provide the required technical contribution.

25 To my mind, the problem of eliminating human error is not a technical one. The invention provides a “new tool” using conventional hardware to automate a business process, which could, for example, be carried out by an operator in a call centre. The resulting increase in accuracy, reliability and speed is just the sort of effect one would expect from computerisation. As Aldous LJ made abundantly clear in the *Fujitsu case*, using a computer to overcome such problems is not itself sufficient for an invention to necessarily make a technical contribution. In particular he said at line 38 on page 618:

“Mr. Birss is right that a computer set up according to the teaching in the patent application provides a new “tool” for modelling crystal structure combinations which avoids labour and error. But those are just the sort of advantages that are obtained by the use of a computer program. Thus the fact that the patent application provides a new tool does not solve the question of whether the application consists of a program for a computer as such or whether it is a program for a computer with a technical contribution.”

26 Dr Waldren also drew my attention to the list of “technical” problems bridging pages 2 to 3 of the specification which are said to be solved by the invention. The only one which was discussed at the hearing was that referred to at lines 12 to 15 on page 3 which reads:

“(4) When change information about a telephone number or mail address is given, there is a limit in terms of a period to the present service of a telephone office or post office”

27 The meaning of this passage is somewhat unclear, however my understanding is that it refers to the limited time period during which, for example, the post office will forward mail to a new address. As I said at the hearing this is not a technical problem, rather it is purely a business problem associated with the cost of maintaining the service, there is no reason, other than the cost, for the post office not to continue doing this indefinitely. I cannot see any “technical contribution” associated with solving this, a business problem.

28 Dr Waldren was unable to persuade me that any of the problems listed on pages 2 to 3 of the specification were of a technical nature or that solving them has produced the technical contribution required to save the invention from exclusion.

29 I have considered the entire specification and all the arguments put forward in the correspondence and at the hearing in detail in an attempt to identify the required technical contribution. However, I cannot see anything in the way the invention is implemented or

operates to satisfy myself that the present invention provides one.

Other Issues

- 30 At the hearing, Dr Waldren drew my attention to what at first sight appears to be the corresponding European Patent Application No. EP01978952.8. He presented the European Patent Office examination report, his response to that report and a set of amended claims for my consideration. However, I have since discovered that this application is not strictly speaking an equivalent application, it is merely a similar one, by the same applicant with the same priority date, but differs significantly in its disclosure. The application in question has not been granted and should have no bearing on my decision. I have therefore chosen to disregard it.

Conclusion

- 31 I have found that the invention fails to provide any technical contribution and that it is therefore excluded from patentability as a method of doing business and a computer program under section 1(2)(c) of the Act. Having been unable to identify anything contained in the application that might support a patentable claim, I therefore refuse the application under section 18(3).

Appeal

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

P R SLATER

Deputy Director acting for the Comptroller