

PATENTS ACT 1977

APPLICANT Fisher-Rosemount Systems, Inc

ISSUE Whether patent application number GB
0514167.6 complies with section 1(2)

HEARING OFFICER J J Elbro

DECISION

Introduction

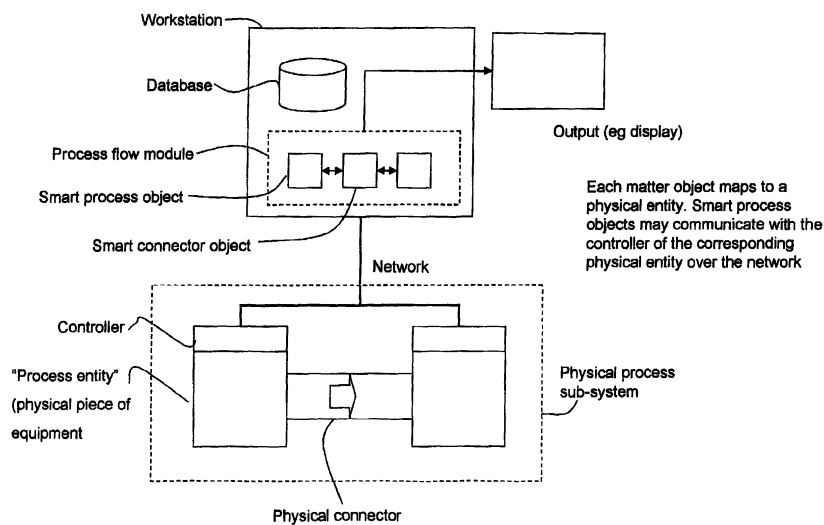
- 1 Application no GB 0324470.4 was filed on 20 October 2003, claiming priority from an earlier US application dated 22 October 2002, and published under serial no. GB 2395801 A on 2 June 2004. An examination report was issued on 30 September 2004, and rounds of correspondence followed between the examiner and the applicant's agents. During this correspondence, applications GB 0514158.5, GB 0514161.9, GB 0514164.3 and GB 0514167.6 were divided out from the original application and published as GB 2417574 A, GB 2418030 A, GB 2417575 A and GB 2418031 A respectively. This decision concerns only application GB 0514167.6
- 2 The examiner has maintained throughout objection that the invention claimed in this application is excluded from patentability as a computer program under section 1(2) of the Patents Act 1977, which the applicant has not been able to overcome despite amendment of the specifications.
- 3 The matter therefore came before me at a hearing, after several postponements, on 2 April 2007, at which the applicant was represented by its patent attorney, Dr Alex Lockey of Forrester Ketley & Co. The examiner, Mr Tyrone Moore, also attended. It was agreed at the hearing that my decision would cover only the question of excluded matter, leaving other questions to further processing of the application if appropriate.
- 4 The correspondence between the examiner and the applicant's agents during prosecution of the application was based on the law as it then stood in the light of case law. However on 27 October 2006, after the hearing had been appointed but before it was held, the Court of Appeal handed down its judgment in the matters of *Aerotel Ltd v Telco Holdings Ltd* and *Macrossan's Application* [2006] EWCA Civ 1371 ("*Aerotel/Macrossan*") setting out a new test for patentability, as

outlined below. The examiner therefore wrote to the applicant in a letter dated 13 November 2006 re-assessing the application in the light of this new test and indicating that he still believed the invention to be excluded.

- 5 Dr Lockey replied in a letter faxed the day of the hearing arguing that the invention as presently claimed was still patentable. However, in the event that I did not agree, he submitted an alternative version of claim 1.

The inventions

- 6 The invention claimed in the application concerns the operation of a process plant – such as chemical or petroleum processing in a network of pumps, flow transmitters and heat exchangers which connect a tank farm and a distillation column - and providing alarms or other outputs to an operator.
- 7 Dr Lockey in his letter of 2 April provided the following diagram to illustrate operation of the system and I broadly adopt his explanation of how it works.



- 8 A simple sub-system of the process plant is shown comprising two “process entities” (eg pumps) connected by a physical connector. The process entities are connected via a network to the controlling workstation. The workstation runs a process flow module, which is made of three smart objects, two smart process objects each corresponding to one of the process entities and a smart link corresponding to the physical connection. The workstation provides a suitable environment in which the process flow module can be configured, stored, and operated, and has a suitable output such as an operator display.

- 9 The smart process objects are self-contained elements. Each includes general

information about the process entity to which it corresponds, a store to hold variable or changing data concerning the entity, graphical information to enable a suitable display to be generated, one or more inputs and outputs to allow the smart process object to receive data from the corresponding entity (or its controller) and other objects, and send data to other smart objects, and one or more “methods”, essentially setting out how the object uses the data, for example to detect errors such as leaks or other conditions, or operating parameters such as mass balances or flows. A smart link is a particular type of smart object which receives as its input flow data from an upstream smart process object, simulates flow within the physical connection, and provides an appropriate output to a downstream smart process object.

- 10 The process flow module, as an assembly of a plurality of smart objects, has associated rules such as process flow algorithms associated with the performance of system-level methods such as mass balance and flow calculations, using data provided by the smart process objects of the process module. Similarly, an operator display, alarm or other output may be generated in accordance with the result of the algorithm.
- 11 The claims on the present application are primarily concerned with the use of a smart objects and process flow modules.
- 12 It transpired at the hearing that in fact the wrong set of claims had been submitted for this application by the agent in the last amendment action. The version that should have been filed was faxed on 5 July 2006, but the subsequent hardcopies were different and accidentally reverted to a previous version. The difference had been noticed by the examiner, who had pointed this out and examined only the most recent set of claims. At the hearing the agent agreed to reamend to the intended version, as in the July fax.
- 13 In these claims, there is a single independent non-omnibus claim, claim 1, which reads as follows:

A process control and viewing system for a process plant having a processor, which controls field devices within the process plant, and comprises a controller and a process flow database, the process flow database comprising:

a plurality of smart process objects, each smart process object including a parameter memory storage adapted to store entity parameter data pertaining to an associated process entity, a graphic representation depicting the associated process entity adapted to be displayed to an operator on a display device, and one or more inputs or outputs, and at least one of the smart process objects including a method adapted to perform a function using the entity parameter data to produce an output related to process operation; and

one or more process flow modules defining an interconnected set of the smart process objects, each process flow module having an associated graphical view to be depicted on a user interface defined in accordance with the graphic representations of the smart process objects.

The law

- 14 The examiner raised objections under section 1(2)(c) of the Patents Act 1977 that the invention in each application is not patentable because it relates to a program for a computer as such. As explained in the notice published by the Patent Office

on 2 November 2006¹, the starting point for determining whether an invention falls within the exclusions of section 1(2) is now the judgment of the Court of Appeal in *Aerotel/Macrossan*. It is not expected that this will fundamentally change the boundary between what is and is not patentable in the UK, except possibly for the occasional borderline case. In *Aerotel/Macrossan* the court reviewed the case law on the interpretation of section 1(2) and approved a new four-step test for the assessment of patentability, namely:

- 1) Properly construe the claim
- 2) Identify the actual contribution
- 3) Ask whether it falls solely within the excluded matter
- 4) Check whether the contribution is actually technical in nature.

15 As stated at paragraphs 45 – 47 of the judgment, reconciling the new test with the earlier judgments of the Court of Appeal in *Merrill Lynch* [1989] RPC 561 and *Fujitsu* [1997] RPC 608, the fourth step of checking whether the contribution is technical may not be necessary because the third step – asking whether the contribution is solely of excluded matter – should have covered the point.

16 At the hearing, Dr Lockey agreed that this was the correct test to apply. However, in his letter of 1 April, he argued that the fourth step was always necessary because of paragraph 46 of the judgement (Dr Lockey's emphasis):

“The fourth step - check whether the contribution is ‘technical’ may not be necessary because the third step should have covered that. It is a necessary check if one is to follow *Merrill Lynch* as we must.”

17 I do not so read the judgment. It seems to me that what the court of appeal is saying is that if an application has failed step 3 (falling wholly within excluded matter), that is an end of it, and the fourth step is not necessary. However, it is conceivable that an application might pass step 3, but still be not technical. In such a situation, the application must be refused, in accordance with *Merrill Lynch*, and hence the fourth step is necessary to ensure consistency with *Merrill Lynch*. It is not a “back door” to allow back in claims to matters falling wholly within excluded subject matter.

18 As noted in paragraph 44 of the judgment, it is often necessary to take the applicant's word for what a contribution is, particularly in terms of difference from the prior art. This is particularly so in this case where the examiner has not yet given full consideration to novelty and inventiveness in view of the outstanding excluded matter objections. However, as the judgment cautions, this does not mean I should simply accept the patentee's version of the contribution if that is not found in the claim.

Analysis

¹ <http://www.patent.gov.uk/patent/p-decisionmaking/p-law/p-law-notice/p-law-notice-subjectmatter.htm>

Construing claim 1

- 19 The claim is essentially to a process control and viewing system comprising a process flow database that contains objects and flow modules.

Identifying the contribution made by the invention

- 20 Turning now to step 2 of the test and the actual contribution made by the invention, Dr Lockey argued that the contribution is the provision of the two-tiered data structure – a lower tier of smart process objects and an upper tier of process flow modules that provide assemblages or groups of the smart process objects. I accept this.

Whether the contribution falls solely within excluded matter

- 21 At the hearing Dr Lockey argued that in the present case the invention was not solely a data structure because it was embedded in the context of the data control and viewing system. It was directed at the two-tier structure which provides improved configuration and monitoring.
- 22 I do not agree. As can be seen in the contribution found above, the claim is about the data structure. This falls squarely within the computer program exclusion.

Check whether the contribution is actually technical in nature.

- 23 Given my finding above, I do not need to apply this step.

Other claims

- 24 The dependent claims relate either to the detail of the database. Dr Lockey did not argue that any of them would avoid exclusion if claim 1 were excluded, and I can see nothing in any of them that would do so.

Conclusion and next steps

- 25 I therefore find that the invention as claimed in the claims faxed in July 2006 is excluded from patentability under section 1(2). I therefore refuse the application in accordance with section 18(3).

Appeal

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

J J ELBRO

Deputy Director acting for the Comptroller