

A system for providing information from a computer database containing a plurality of data items, each data item being associated with a geographical location identified by a telephone area code, the system comprising an input element operative to receive, by means of a telephonic connection, information requests having a location parameter comprising a distance, a processing element operative to process said requests, a data extraction element operative to extract, from the database, data items whose associated geographical locations fall within the location parameter specified in the request and an output element operative to convey, also by means of a telephonic connection, information relating to the extracted data items to the information requestor, wherein a geographical location associated with the requestor is identified by the telephone area code included in the request and the processing element is operative to calculate distances between the requestor's geographical location and those of the data items on the basis of the distances between the actual geographic areas to which the respective area codes relate.

- 6 The application relates to advertising car sales. The idea is to allow a prospective purchaser to phone the described system and be provided with information about cars available within a certain distance of a given area, based on telephone standard dialing codes. For example, someone could enter, say, the area code 01633 and a distance of 30km as parameters. They would then receive information on cars for sale in the Cardiff area which is 15km from Newport but not in Bridgend which is about 40km from Newport.

The Law and its Interpretation

- 7 The relevant parts of Section 1(2) read (emphasis added)

“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 The correct approach for assessing an application was handed down by Jacob LJ in *Aerotel Ltd v Telco Holdings Ltd (and Others) and Macrossan's Application [2006] EWCA Civ 1371*. In this case 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:

- 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.

9 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. If a claim fails the third step, it cannot be “revived” by the fourth.

Arguments and Analysis

Step 1: Construction of Claim 1

10 The amended claim is explicitly to a system for extracting information from a computer database in which both the request for information and the information extracted are transmitted using a telephone of some kind.

Step 2: Identification of the Contribution

11 The applicant, in their agent’s letter of 29 May, accept the broad summary by the examiner of the contribution as being a system in which information can be extracted by specifying a telephone area code and a location parameter comprising a distance, with the system then retrieving all relevant items that match that particular request. However, they also identify two other features which they say should be included in the contribution:

- an increase in searching speed (as a tradeoff for reduced accuracy) in the use of telephone codes rather than narrower indicators such as postal codes. This means a larger number of data items can be associated with a given code, reducing the retrieval time.
- increased ease of use and thus reduction of error by using purely numerical information such as telephone area codes. These are easier to input on numeric telephone keypads than codes involving letters or other non-numerical symbols.

12 For the purposes of determining the alleged contribution in making this assessment in relation to the *Aerotel/Macrossan* test, I am willing to accept that these advantages are provided by the claimed system. In that sense, they are part of the contribution to human knowledge made.

13 However, I note that the phone system appears to be a standard arrangement of equipment. In the described embodiment, the user dials in and the system is then driven by a voice prompt system which is answered by the user pressing a

button on the keypad which in turn results in a DTMF tone being issued. The telephone system is itself left untouched – it is instead used in a standard manner to transmit particular types of data. It is as result of the selection of which data to send and receive, and the structure of that data, that the benefits alleged by applicant may arise.

- 14 In my judgment, the contribution therefore appears to be a system which will extract data from a database, receiving and sending information over a telephonic system, in response to specifying a telephone area code and a location parameter.

Step 3: Does the contribution fall solely within excluded matter?

- 15 The contribution above produces no effect beyond the entry of a request to a database which then operates in a normal manner to provide results according to the criterion in the request. Given that the database operates on a computer this contribution is clearly a computer program and falls wholly within excluded matter.

Step 4: Check whether the invention is actually technical

- 16 I do not need to consider this step given my finding above.

Other Claims

- 17 The dependent claims cover details of the location parameter, use of standard DTMF tones, or a standard Interactive Voice Response system to implement the system. No argument has been made that they would take the claims outside of excluded matter and I consider them to be likewise excluded.

Conclusion

- 18 I therefore find the claims of this application excluded from patentability by Section 1(2) because they relate to a computer program as such. I therefore refuse the application under Section 18(3).

Appeal

- 19 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