

30 August 2007

PATENTS ACT 1977

APPLICANT Countrywide Surveyors Ltd

ISSUE Whether patent application number
GB0415445.6 complies with section 1

HEARING OFFICER John Rowlatt

DECISION

Introduction

- 1 Patent application GB0415445.6 was filed on the 04 July 2004 in the name of Countrywide Surveyors Ltd. The application is entitled “Method and apparatus for managing survey workflow across a distributed system”.
- 2 Initially, the application was not searched, with the search examiner issuing a report under Section 17(5)(b) stating his belief that the application was excluded under Section 1(2)(c) of the Act as a method of doing business and/or a program for a computer. However, the applicant submitted observations regarding the report and requested the examiner to perform a search. Although the examiner remained of the opinion that the application related to excluded matter, he conducted a search under 17(5), in light of the applicant’s responses, and the search report was issued on the 16 May 2005.
- 3 Following a request for accelerated examination, a first substantive examination report was issued on the 26 October 2005 in which the claims were considered to relate to a number of separate inventions and that certain claims were obvious. Amendments were subsequently filed to overcome the plurality and inventive step objections. In the subsequent exam report dated 29 March 2007, using the test formulated in *CFPH LLC’s Application*¹, the advance provided by the amended claims was considered to relate to a method of doing business and a program for a computer.
- 4 In the most recent examination report, dated 15 November 2006, the examiner assessed patentability based on the four step test approved in the Court of

¹ *CFPH LLC’s Application* [2005] EWHC 1589 (Pat), 2006 RPC 5

Appeal judgment in *Aerotel/Macrossan*² and remained of the opinion that the invention of claims 1-21 & 25-33 relate to a program for a computer and a method of doing business and that claims 22-24 & 34 were claimed as computer programs and were not patentable.

- 5 Further correspondence failed to resolve this issue and the matter came therefore came before me at a hearing on 02 July 2007. Dr. Simon Davies, of D Young and Co, appeared for the applicant. The examiner, Mr. Ben Widdows, also attended.
- 6 Before discussing the outstanding objection, Dr. Davies registered his concern regarding the decision by the search examiner initially not to search the application; he contended that the results of the search clearly have been useful in understanding the contribution made by the invention. Furthermore, he suggested that it had cost his client a lot of money to get to the point of search. However, Dr. Davies was also at pains to point out that he considered that the processing of the present application had not in any way been incorrect or sub-standard.
- 7 I do not believe the search examiner was incorrect in his initial decision to not search the application – it is a matter of judgment. Indeed, a report under Section 17(5)(b) gives the applicant the chance to file observations which, if they convince the examiner that a meaningful search can be performed (as in the present case), requires a search to be performed³. Although the examiner has subsequently found it useful to use the located prior art to assist in framing his objection, his initial decision suggests that formal objection would have arisen without it. I am therefore content that the initial course of action was not inappropriate.

The Application

- 8 The application relates to a method, system and computer program(s) for managing survey workflow across a distributed system. The distributed system includes a requesting party connected to a network, a central office system and portable client systems, with the central office system managing the workflow of a requested survey instruction and the resulting survey performed on a portable device by an assigned user.
- 9 The current claims, filed with amendments dated 22 February 2006, include five independent claims: method claims 1 & 21, corresponding computer program(s) claims 23 & 24 and system claim 25 (which corresponds the method claim 21). There is also a claim, claim 22, to a set of computer programs for implementing methods of earlier claims and omnibus claims 32-34 representing method, system and computer program respectively. Dr. Davies confirmed at hearing that, regardless of the outcome whether the invention is patentable, claims 22, 23, 24 & 34, directed to computer programs *per se*, would be deleted and I will not consider them further. The remaining claims read:

² *Aerotel Ltd v Telco Holdings Ltd and others and Macrossan's Application* [2006] EWCA Civ 1371, [2007] RPC 7

³ MOPP 17.95

“1. A method of managing survey workflow across a distributed system comprising a central office system and multiple portable client systems, said method comprising:

receiving a survey work instruction from a requesting party over a network into the central office system;

creating a record for said survey work instruction in a database at said central office system, each survey work instruction record having a status associated therewith;

creating an entry in an electronic diary for a user assigned to the survey work instruction, said entry including a link to said survey work instruction in the database;

downloading said electronic diary entry and said survey work instruction onto a portable client system corresponding to said user over a wireless data link;

entering information by the user into the portable client system to complete the record for the survey work instruction and updating the status of the record accordingly;

uploading the completed record for the survey work instruction from the portable client system over the wireless data link to the database at said central office system; and

returning the completed survey work instruction from the central office system to the requesting party.”

“21. A method of managing survey workflow across a distributed system comprising a central office system and multiple portable client systems, said method being performed at the central office system and comprising:

receiving a survey work instruction from a requesting party over a network;

creating a record for said survey work instruction in a database, each survey work instruction record having a status associated therewith;

creating an entry in an electronic diary for a user assigned to the survey work instruction, said entry including a link to said survey work instruction in the database;

downloading said electronic diary entry and said survey work instruction onto a portable client system corresponding to said user over a wireless data link;

uploading a completed record for the survey work instruction from the portable client system over the wireless data link to the database,

wherein said completed record includes information entered by the user into the portable client system and has an updated status; and

returning the completed survey work instruction from the central office system to the requesting party.”

“25. *A central office system for use in managing a distributed survey workflow, wherein said central office system is operable to:*

receive a survey work instruction from a requesting party over a network;

create a record for said survey work instruction in a database and an entry in an electronic diary for a user assigned to the survey work instruction and each survey work instruction record having a status associated therewith, said entry including a link to said survey work instruction in the database;

download said electronic diary entry and said survey work instruction onto a portable client system corresponding to said user over a wireless data link;

upload a completed record for the survey work instruction from the portable client system over the wireless data link to the database, wherein said completed record includes information entered by the user into the portable client system and has an updated status; and

return the completed survey work instruction from the central office system to the requesting party.”

The law

10 The examiner has argued that the claimed invention relates to subject matter excluded from patentability under section 1 of the Act, in particular to a computer program and method for doing business act under section 1(2)(c). The relevant parts of the section read:

1(1) 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)
- (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.

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 purposes of the act only to the extent that that a patent or application for a patent relates to that thing as such.

- 11 As near as is practicable, these provisions have the same effect as Article 52 of the European Patent Convention (EPC) to which they correspond by virtue of being so designated in Section 130(7).

Interpretation

- 12 The test for assessing patentability approved by the Court of Appeal in *Aerotel/Macrossan* comprises the following four steps:

- 1) properly construe the claim;
- 2) identify the actual contribution;
- 3) ask whether it falls solely within the excluded subject matter;
- 4) check whether the actual or alleged contribution is actually technical in nature.

The arguments

- 13 In applying the first step, I do not think there is any difficulty in construing the claims in this particular case, indeed Dr. Davies accepted as much at the hearing. Claims 1, 21 & 25 relate to a method and system of managing survey workflow across a distributed system.

- 14 The second part of the test requires me to identify the actual contribution. Dr. Davies considered this to be the most important of the steps and considered there were two aspects that make the contribution difficult to assess, namely:

- i) in general legal terms, what is meant by ‘contribution’? and
- ii) what actual contribution does the present application make?

- 15 For the first aspect, the general legal concept, Dr. Davies felt the ‘contribution’ in the *Aerotel/Macrossan* test was distinguished from the ‘contribution’ approach in *Merrill Lynch*⁴. Dr. Davies considered the ‘old’ contribution approach from *Merrill Lynch* to have been expressly rejected by the court in *Aerotel/Macrossan*. What the court meant by ‘the contribution’ in the *Aerotel/Macrossan* test, Dr. Davies suggested, was not simply a question of saying, “*What is already known, and what are the new bits?*” He considered that there is a slightly more conceptual level, saying “*What is the invention trying to do? What are the problems? What are the advantages? and so on*”.

- 16 I do not disagree. The Court of Appeal in *Aerotel/Macrossan* fully discussed previous approaches, which it summarized as the ‘Contribution’ approach, the ‘Technical Effect’ approach and the ‘Any Hardware’ approach. In doing so it fully

⁴ Merrill Lynch’s Application [1989] RPC 561

considered, and wholly took account of, *Fujitsu*⁵ and *Merrill Lynch* in its deliberations. The four part test was considered in relation to the statutory test and the Court decided it was a structured and more helpful way of re-formulating the statutory test. It is consistent with the principles enunciated in *Merrill Lynch* and a re-formulation in a different order of the *Merrill Lynch* test (paragraph 41). It is a re-formulation of the approach adopted in *Fujitsu* and asks the same questions, but in a different order (paragraph 47). Further, they concluded that a contribution which consists solely of excluded matter will not count as a technical contribution (paragraph 47).

- 17 I think that what the Court of Appeal meant by the actual contribution is clear; they said, at paragraphs 43 & 44, “*What has the inventor really added to human knowledge perhaps best sums up the exercise. The formulation involves looking at the substance not form – which is surely what the legislator intended.*” and “*In the end the test must be what contribution has actually been made, not what the inventor says he has made.*”
- 18 Following *Aerotel/Macrossan*, it appears to me that, having regard to the problem to be solved, how the invention works and what its advantages are, the important question is whether the contribution over and above the prior art is within excluded territory. If the contribution lies solely in excluded matter, identification of a technical advance does not resurrect the invention.
- 19 In considering what contribution was provided by the present application, his second aspect to this part of the test, Dr. Davies felt that it resided in an ‘entire system’ rather than a small improvement to an existing system and that the invention was technology led, being developed by IT specialists, rather than contributing to a business method. Dr. Davies also submitted a small article by the applicant describing the invention and news article indicating that the system of the present application won the ‘Best Enterprise Mobility Project’ at the Communications in Business Awards. These articles, Dr. Davies suggested, show that the contribution was at a ‘technical’ level.
- 20 That the system may have been developed by IT specialists as an entire system does not seem to me to define the contribution. Although I take note of the summary of the invention by the applicant and the fact that it won an award, these do not help significantly when identifying the *actual* contribution, which requires me to place the invention, as a whole or otherwise, within the context of the prior art.
- 21 Dr. Davies outlined at hearing that there had been a problem with consistent throughput, communications and work flow and that it had been identified that “their IT *support* [my emphasis] isn’t working, *it isn’t supporting our business needs* [my emphasis].” That is, the technical aspects of the central database and the IT hardware itself was not at fault, merely that the way in which communication of instructions and data, and working patterns, operated in the business environment didn’t work as well as the business would like. Indeed, there appears to be no disclosure of any new hardware, or linkage of hardware, merely the introduction of what Dr. Davies called ‘different communication

⁵ Fujitsu Ltd’s Application [1997] RPC 608

facilities'; using the prior art of figure 1 as an example, rather than use a paper-based local diary system and personal contact or telephone, the invention uses standard portable wireless client devices.

- 22 Dr. Davies also discussed the contribution in the present application with regard to the assessment of *Aerotel* and *Macrossan* respectively. On the basis that *Aerotel* was allowed and *Macrossan* was rejected, he wondered whether the present application was 'closer' to *Macrossan* or 'closer' to *Aerotel*.
- 23 He then ran through a series of arguments in relation to the problems solved and the combination of apparatus involved, in order it seemed to align the present application with *Aerotel* and distance it from *Macrossan*. In particular, Dr. Davies drew my attention to the difference between the present application, represented in Figure 2 of the drawings, and the closest prior art – the 'rococo' document (rococo mobilefrontier survey, rococo software Ltd., 04/04/2003). Dr. Davies considered the combination of hardware and connectivity in Figure 2 to be different from that disclosed in 'rococo' – namely the additional hardware and connectivity of the requesting party – and that this difference took the present application squarely within the reasoning of the *Aerotel* decision and well away from the *Macrossan* decision.
- 24 However, although consideration of similarities may assist me as a guide, it does not seem correct to me to attempt to assess the contribution by asking whether it is closer to *Aerotel* or closer to *Macrossan*. The second step of the test requires me to identify the **actual** contribution and I must do this on its own merits.
- 25 As indicated above, the closest prior art in this area, 'rococo', provides for central control and planning of survey work and demonstrates a server with a back-office database system (i.e. a central office system) which is used for designing surveys, managing representatives and sites in the field, wirelessly downloading and uploading survey information, work schedules, messages and notifications to portable client systems, the server processing captured data returned from the client systems to generate reports for whichever party requested the survey. In 'rococo' the survey is not property survey work but customer market survey; however, I do not believe that the nature of the data collected in the field is relevant to the assessment of the contribution.
- 26 Dr. Davies suggested that there are differences in the hardware between the invention and the prior art, especially 'rococo', and in the overall architecture of the entire system. However, there appears to be no new hardware, which is entirely conventional, but as discussed in paragraph 21 above merely 'different communication facilities'. Although there is a minor difference in the exact nature of the portable client device, for example a tablet PC rather than "any Pocket PC device" of 'rococo', the portable client device of the invention is a conventional, expected alternative, as would be a laptop or notebook computer. In context, the difference is not significant. Further, the hardware arrangement (the "entire system"), represented in Figure 2 of the drawings, does not appear to be anything other than conventional; it is well known to have a central system (i.e. server) communicating and processing data from numerous clients, including the use of wireless links. Therefore, I do not accept that the contribution lies in the hardware nor, as a whole, in the way in which it is linked as an entire system.

- 27 Dr. Davies also suggested that there was distinction over the prior art in the 'connectivity of the requesting party' as the claim refers to "*receiving a survey work instruction from a requesting party over a network into the central office system*". However, the prior art of figure 1 already shows that. Specifically, at lines 23-26 of page 9, "*In the embodiment of figure 2, this new instruction is received directly over an extranet 116, for example a TCP/IP communication over the Internet, rather than having to perform a specific dial-up connection (as in the implementation of Figure 1).*" A dial-up connection, albeit a temporary connection, is still a network connection within the terms of claim 1 by which instructions are received into the central office system. Of course, a TCP/IP connection over the internet may still be via a dial-up connection.
- 28 What, therefore, is there in the current invention over and above the specific prior art, the applicant's own prior system, and the combination of known standard hardware linked in a conventional manner, which might contribute to the stock of human knowledge? It is clear to me that the contribution provided by the invention is the way of processing and managing the data received/sent from/to the central office system and client systems, by assigning, diarying and updating work accordingly, in order to manage the flow of survey work.
- 29 The third step of the test is to ask whether the identified contribution lies solely within an excluded category. Although it may well have been developed by IT workers, the identified contribution is all to do with how various administrative functions are managed in order to better organize the flow of work within a business. I therefore consider this to fall squarely within the business method exclusion.
- 30 Further, as a matter of substance, the actual contribution identified above also resides in the processing of the relevant items of data by a method performed in software only. Consequently, the contribution also falls within the computer program exclusion.
- 31 Claims 1-21 & 25-33 are therefore not patentable as being a method of doing business and as a computer program. Having come to this conclusion it is unnecessary to proceed to step 4 to consider whether the contribution is actually technical in nature. Technical advances falling solely within one of the excluded categories are not enough to allow an invention to pass the third step of the test. Consequently, it is not necessary to apply the fourth step if the invention has failed the third.
- 32 As previously stated, Dr. Davies accepted that claims 22, 23, 24 & 34 would in any case have to be deleted since they were clearly excluded from patentability as programs for a computer.

Conclusion

- 33 I have found that the invention relates to a method of doing business and to a program for a computer. It is not new and non-obvious (and susceptible of industrial application) under the description "an invention" in the sense of Article 52 and is therefore not patentable. I have read the specification in its entirety and cannot identify anything that could form the basis of a patentable

invention. I therefore refuse the application under section 18 as failing to meet the patentability requirements of section 1.

Appeal

- 34 Under the Practice Direction to Part 52 of the Civil Procedures Rules, any appeal must be filed within 28 days of the receipt of this decision.

John Rowlatt
Deputy Director acting for the Comptroller