



- “1. A method, comprising:
- analysing text from content in an active window;
  - executing a query on the content in the active window without a user having to request the query;
  - embedding a first icon that represents a category of links related to the content in the active window;
  - generating a list of links related to the content in the active window;
  - displaying the generated list of links on a display that is also displaying the active window in response to activation of the first embedded icon; and
  - displaying a summary about a first link related to content when a user moves a cursor over the first link.
2. The method of claim 1, wherein the first icon is embedded in an unobtrusive display area of an application operating in the active window.
3. The method of claim 1, further comprising:
- embedding two or more icons including the first icon in a title bar of an application operating in the active window, wherein each icon represents a different category of links related to the content.
4. The method of claim 1, further comprising:
- highlighting the first icon if one or more of the links related to the content exceeds a minimum threshold relevance rating to the content in the active window.”

### **The law**

- 5 The relevant law is set out in section 1(2) of the Act:

*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) a discovery, a 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 purpose of this Act only to the extent that a patent or application for a patent relates to that thing as such.*

- 6 These provisions are designated in section 130(7) as being so framed as to have, as nearly as practicable, the same effect as the corresponding provisions of the European Patent Convention (EPC), i.e. Article 52. As a consequence, 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

- 7 The correct approach to assessing patentability under section 1(2) is set out in the Court of Appeal's judgment in *Aerotel/Macrossan*<sup>1</sup>, and comprises a four step test as follows:
- 1) properly construe the claim
  - 2) identify the actual contribution
  - 3) ask whether the actual contribution falls solely within the excluded subject matter
  - 4) check whether the contribution is actually technical in nature

- 8 Paragraphs 46 and 47 of the Court of Appeal's judgment provide further guidance regarding the fourth step of the test:

*“46. 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 however if one is to follow Merrill Lynch as we must.*

*47. As we have said this test is a re-formulation of the approach adopted by this court in Fujitsu: it asks the same questions but in a different order. Fujitsu asks first whether there is a technical contribution (which involves two questions: what is the contribution? is it technical?) and then added the rider that a contribution which consists solely of excluded matter will not count as a technical contribution.”*

- 9 With regard to the computer program exclusion, Mr Kenrick referred to a number of authorities which indicate that a method that has a character which exists quite independently of whether it is implemented on a computer, even if the only practical way of implementing it is to use a computer, is not a computer program as such. In other words, the presence of a computer program is not determinative. The examiner agreed.
- 10 The examiner also agreed with Mr Kenrick's analysis of the authorities relating to presentation of information, i.e. that only where the contribution lies in the nature of the information or in the idea of presenting information should the invention be excluded.

## Arguments and analysis

- 11 There is no dispute regarding the construction of the claims, so I can proceed immediately to consider the second step.
- 12 The second step is to identify the actual contribution, which the Court of Appeal rightly recognised is more problematical as it involves an exercise of judgement “probably involving the problem said to be solved, how the invention works, what its advantages are”. The Court also said that the formulation of the contribution involved looking at the substance of the invention and not the form.
- 13 In his skeleton argument, Mr Kenrick says that the contribution made by the invention of claim 1 is an improved man-machine interface provided by a method having particular features. Whilst this formulation of the contribution gives a general indication of the nature of the invention, I said at the hearing that I did not consider it helped in any way identify what the Court of Appeal says are the problems said to be solved or the advantages offered. When pressed on the point, Mr Kenrick argued that it was not necessary to be any more specific because the contribution relied upon by the Court of Appeal in *Aerotel/Macrossan* was also very general. Following a general discussion of

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<sup>1</sup> Aerotel Ltd v Telco Holdings Ltd & Macrossan's Patent Application [2007] RPC 7

the relevance of prior art in assessing the actual contribution, Mr Kenrick agreed that the contribution made by the invention did indeed lie in an improved user interface in which the user is more conveniently able to obtain further relevant information. I note that the invention achieves this by conducting a background search of relevant documents on the basis of text contained in an active window, and presenting the results in a convenient manner to the user in the form of icons displayed on a computer screen. I also note that the only user interface disclosed in the application is a graphic user interface. Despite a detailed description of possible searching algorithms within the application, Mr Kenrick acknowledged that the contribution made by the invention lay in the manner in which the results were displayed to the user and not in the way that they were found in the first place.

- 14 Taking all of the above into account, I find that the contribution made by the invention of claim 1 lies in an improved graphic user interface having an icon which allows convenient access to a list of documents relevant to the content of an active window.
- 15 The third step is to ask whether the contribution falls solely within excluded matter, and in this particular case to whether the contribution is solely a program for a computer or presentation of information. Mr Kenrick says that the contribution relating to embedding an icon and presenting links upon selection of the icon cannot be reasonably said to relate to a computer program, rather it is a contribution in the field of man-machine interfacing, taking into account the way in which a user perceives the display device and interacts with the computer by way of that display device. He accepts that the contribution may be realised by appropriate programming of a computer, but this is at a far later stage in the development process. He says that the computer program is not the invention; rather the computer program implements the invention.
- 16 In my view, a graphic user interface provides a convenient way in which a computer program interacts with the user, both in the way that it presents information to the user and also allows the user to input data into the computer. Therefore, any improvement in a graphic user interface has to be an improvement solely in the way that a computer program interacts with the user, which in my opinion clearly points to a contribution made solely within excluded matter. In other words, a graphic user interface is an inherent part of a computer program, and any improvement in the user interface must be limited to an improvement in the program itself. I therefore consider that the contribution made by the invention of claim 1 falls solely within the meaning of a program for a computer as set out in section 1(2)(c).
- 17 Turning to claim 2-4 of the application, which are each dependant upon claim 1, I consider that the further improvements to the graphic user interface provided by the position of the embedded icon, the addition of a further icon representing a different category of relevant links and the highlighting an icon if the number of relevant links exceeds a minimum threshold, are all improvements in the way that a computer program interacts with the user. Applying the same reasoning as I have done above, I find that the contribution made by each of the inventions defined in claims 2-4 falls solely within the meaning of a program for a computer as set out in section 1(2)(c).
- 18 I have reviewed the remainder of the claims and also the content of the application as filed and have been unable to find anything that extends the contribution beyond the limits of an improved graphic user interface. Whilst it is not strictly necessary for me to consider whether the invention also relates to the presentation of information, I do consider Mr Kenrick's arguments to be persuasive in this regard, i.e. that the addition of an icon conveniently positioned for accessing relevant documents extends beyond the nature of the information displayed or the manner in which it is presented.

### **Conclusion**

- 19 I have found that the invention defined in claims 1-4 relates to a program for a computer and is excluded from patentability under section 1(2). I have reviewed the application in its entirety and have been unable to find anything that can form the basis of a patentable invention. I therefore refuse the application in accordance with section 18(3).

### **Appeal**

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

A handwritten signature in black ink, appearing to read 'H Jones', with a long horizontal flourish extending to the right.

**H Jones**

Deputy Director acting for the Comptroller