



PATENTS ACT 1977

APPLICANT I2 Technologies US, Inc.

ISSUE Whether patent application number
GB 0604622.1 complies with section
1(2)

HEARING OFFICER Joanne Pullen

DECISION

Introduction

1. Patent application number GB 0604622.1 was filed on 8th March 2006, claiming priority from two earlier US applications 60659829 filed 8 March 2005 and 11158371 filed 20 June 2006. The application was published on 13 September 2006 as GB 2424096.
2. It was agreed, at the request of the applicant, that for efficiency the application should be heard together with the applicant's co-pending applications 0604769 .0 and 0604820.1, although it was also agreed that the applications were sufficiently different that I should issue decisions in respect of each application separately.
3. In the examination process the examiner, having already declined to carry out the prior art search on the application because he deemed it would serve no useful purpose, raised objections under section 1(1)(d) of the Patents Act which in turn relates to section 1(2) which is concerned with matter which is excluded from patentability. The examiner particularly maintained objections that the invention as claimed was unpatentable in relating to a computer program, a business method, a mental act and presentation of information as such. Unfortunately the matter could not be resolved by correspondence and a hearing was appointed to decide the matter. The hearing took place on October 1, 2010 before me and the applicant was represented by Mr Stephen Antrobus and Mr Paul Matthews of Barker, Brettell.

The application

4. The application relates generally to a program based supply chain management. Here the word "program" is not used directly in relation to a computer program but the program is in this sense is rather a definition of a relationship between trading partners, e.g. such as a manufacturer and a vendor. The invention essentially restricts access to data in the system to those who need to see it or use it, i.e. those defined by a particular trading partner program. The trading partner program may additionally be defined by other factors such as the location, the nature of the item to be traded or taxonomy.

The claims

5. It was agreed that the hearing should proceed on the basis of the claims as filed on 12 January 2010, and not the suggested claims also filed on that date. The independent claims filed 12 January, therefore as follows:
 1. A computer-implemented method of managing supply chain transaction data among a plurality of trading partners in an inter-enterprise supply chain management system receiving the supply chain transaction data from the plurality of trading partners, the method comprising:
 - receiving a definition of a program including at least a first trading relation and a second trading relation, the first trading relation being between a first trading partner and a second trading partner and the second trading relation being between a third trading partner and a fourth trading partner;
 - and
 - allowing actions only on part of the supply chain transactions data satisfying the definition of the program, the part of the supply chain transaction data including at least the first trading relation or the second trading relation.
 15. A user interface for creating a program wherein the interface comprising a template for a user to input (e.g. select or enter) program definers to create program configured to control access to a database of transaction according to the program definers, wherein the program definers comprise a first trading relation and a second trading relation, the first trading relation being between a first trading partner and a second trading partner and the second trading relation being between a third trading partner and a fourth trading partner.

18. A method of creating a program configured to control access to a database of transaction data, the method comprising:
receiving program definers from a user, wherein the program definers comprise a first trading relation and a second trading relation, the first trading relation being between a first trading partner and a second trading partner and the second trading relation being between a third trading partner and a fourth trading partner; and
creating a program with said program definers.

The Law

6. The examiner raised an objection under section 1(2)(c) that the invention is not patentable because it relates to a computer program and/or mental act as such; the relevant provisions of this section of the Act are shown below:

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, 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.

7. As explained in the notice published by the UK Intellectual Property Office on 8th December 2008, the starting point for determining whether an invention falls within the exclusions of section 1(2) is the judgment of the Court of Appeal in *Aerotel/Macrossan*¹.
8. The interpretation of section 1(2) has been considered by the Court of Appeal in *Symbian Ltd's Application*². *Symbian* arose under the computer program exclusion, but as with its previous decision in *Aerotel/Macrossan*, the Court gave general guidance on section 1(2). Although the Court approached the question of excluded matter primarily on the basis of whether there was a technical contribution, it nevertheless (at paragraph 59) considered its conclusion in the light of the *Aerotel* approach. The

¹ *Aerotel Ltd v Telco Holdings Ltd (and others) and Macrossan's Application* [2007] R.P.C. 7

² *Symbian Ltd's Application* [2008] EWCA Civ 1066

Court was quite clear (see paragraphs 8-15) that the structured four-step approach to the question in Aerotel/Macrossan was never intended to be a new departure in domestic law; that it remained bound by its previous decisions, particularly Merrill Lynch³ which rested on whether the contribution was technical; and that any differences in the two approaches should affect neither the applicable principles nor the outcome in any particular case. But the Symbian judgment does make it clear, that in deciding whether an invention is excluded, one must ask does it make a technical contribution? If it does, then it is not excluded.

9. Subject to the clarification provided by Symbian, it is therefore appropriate for me to proceed on the basis of the four step approach explained that paragraphs 40-48 of Aerotel/Macrossan namely:
 - 1) properly construe the claims
 - 2) identify the actual contribution
 - 3) ask whether the identified contribution falls solely within the excluded matter
 - 4) check whether the actual or alleged contribution is actually technical in nature.

10. The applicant's representatives agreed that this is the approach to follow.

Applying the excluded matter test

Construe the claim

11. The claims are readily construed such that there is no problem in divining their meaning. As I have referred to above, the word "program" refers to a trading relationship and not to a computer program (this is clearly defined in the specification).

Identify the contribution

12. This is defined in Aerotel/Macrossan test as what the invention has added to human knowledge.

13. The examiner, in his report of 11 September 2009 has identified the contribution to be 'a computer implemented method for managing supply chain information' and in his subsequent report of 1 April 2010 addresses a number alleged contributions put forward by the applicant in his agent's letter of 7 January 2010.

³ Merrill Lynch's Application [1989] R.P.C. 561

14. At the hearing Mr Matthews said the contribution was the restriction of the ability to view and action data to a defined trading partner relationship. Mr Matthews also argued that this contribution was generic, i.e. that although it operates on supply chain data, it needn't do so because it is addressing the general problem of granting permissions for access to the data. I'm afraid I cannot accept this generic nature because the access or permissions are claimed in relation to the state of the transaction and trading relations, so I do not see how it could be applied to access to data in general.

15. On page 3 lines 4-10 of the description the applicant describes various benefits of the invention, which directly address the problems raised in the preceding paragraph of the description. These benefits include:

A convenient mechanism to manage subsets of the supply chain transaction data according to defined criteria

A convenient mechanism to configure the privileges of a company or user involved in supply chain management to view or perform actions on certain supply chain transaction data.

A convenient mechanism to configure such privileges by groups of companies or users within groups.

16. Taking all available information from the case file into account, along with Mr Matthews submissions at the hearing, I consider that the contribution is a supply chain management tool which restricts the ability of trading partners to access data according to definitions of trading partner relationships.

Ask whether the contribution falls within the excluded matter

17. The contribution is restricted to supply chain management which is the definition of a business relationship between the partners in the supply of goods from the raw material supplier right through to the customer. This points me towards the contribution relating to a business method. As the limitations are placed on the availability of data are made in response to the nature of a trading relationship I must conclude that the contribution falls within the business method exclusion.

18. As to the other exclusions as put forward by the examiner, I do not think the presentation of information exclusion is relevant as the invention allows actions on the data, not just viewing.

19. Although I can see the examiner's point as regard's the mental act exclusion I do not need to decide in this respect because of my conclusions as regards the business method exclusion above.

20. As regards the computer program exclusion, a business method implemented using a computer program which runs on conventional hardware remains excluded. Therefore I have no need to consider this further.

Is the contribution technical?

21. Mr Matthews said at the hearing that a contribution of restricting access to data to certain trading partner relationships results in better integrity of the data. While this may be so, does it necessarily result in the contribution being technical? It is clear that the contribution relates to a business method, the claims are restricted to supply chain data and that access is in response to a trading relationship. The access to data is in response to a trading relation and that is a business, i.e. non-technical, aspect. I therefore consider that the contribution is not technical.

Conclusion

22. I conclude that the contribution defined in the claims filed on 12 January 2010 falls within the business method exclusion and therefore that the application relates to matter excluded under section 1(2)(c).

23. Having read the specification I do not think that any saving amendments are possible, including the suggested claims submitted with the agent's letter of 12th January 2010. I therefore refuse the application under section 18 (3).

Appeal

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

J Pullen
Deputy Director acting for the Comptroller