



PATENTS ACT 1977

APPLICANT Fisher-Rosemount Systems, Inc

ISSUE Whether patent application
 GB0717004.6 complies with section 1(2)

HEARING OFFICER H Jones

DECISION

Introduction

- 1 Patent application GB0717004.6 relates to what is described as a graphical programming language object editing and reporting tool and was filed on 31st August 2007 in the name of Fisher-Rosemount Systems. The issue before me is whether the invention relates to a program for a computer and is excluded from being patented, but is made slightly more complicated by the presence of a main set and an auxiliary set of claims which may relate to separate inventions. This is further complicated by the fact that the main and auxiliary claims were filed on the last day of the compliance period for putting an application in order and the question of whether it is possible to extend the compliance period to allow certain amendments to be put into effect.
- 2 The examiner has argued throughout his examination of the application that the invention presented in the various versions of the main claims is excluded as a computer program. With the deadline for putting the application in order looming, the applicant filed a further set of amended main claims together with an auxiliary set to be considered only if the main set was found to be unallowable. The examiner then argued that it was not possible to allow the auxiliary claims to be treated as formally filed because the period for putting the application in order had elapsed and that there was no possibility to extend. The applicant disagreed and requested a hearing to decide the matter. This hearing was held on 27th March 2012 and the applicant was represented by Mr Nick Wallin of Withers & Rogers. I am very grateful to Mr Wallin for the very detailed skeleton argument presented before the hearing and for his further submissions afterwards, which I have taken full account of in reaching my decision.
- 3 I shall deal with the procedural aspects relating to auxiliary claims and whether the compliance period can be extended before moving on to consider the main issue of whether the invention relates to a patentable invention.

Auxiliary claims

- 4 Mr Wallin filed two replacement claim sets in response to the examiner's report dated 14th October 2011. These were filed on 13th December 2011, the final day of the compliance period. In his covering letter, Mr Wallin explains that the first claim set (to a method of designing a process control entity) has been marked "main request" and the second set (to a method of operating a process control entity) has been marked "first auxiliary request" with the intention that the examiner should examine the main request first, and to consider the first auxiliary request only if the main request were found to be unallowable. He goes on to say that if the main request is unallowable, but the first auxiliary request is allowable, then the applicant would appreciate and would still request a hearing be held to discuss the patentability of the main request.
- 5 In his letter dated 25th January 2012, the examiner explains that he has considered the amendments and arguments in Mr Wallin's letter of 13th December and that he remains of the opinion that the invention is unpatentable. He suggests that the matter be decided at a hearing and that the necessary arrangements would be made. Although he does not specifically refer to the claim set or sets that he considered to be unpatentable, the examiner does say later in the letter that "for completeness, I also note the auxiliary request, which you have suggested be considered at the hearing". The examiner also reminded Mr Wallin of the need to request an extension to the compliance period by filing Patents Form 52.
- 6 In his letter dated 29th February 2012, Mr Wallin explains that he came to consider the case again on that day in order to report the notice of the hearing to the applicant. He says that before doing so he telephoned the examiner with a question as to whether, if he were to withdraw the main request, the need for a hearing could be avoided. He also asked the examiner when he believed it would be necessary to file a Form 52 requesting an extension of time. Mr Wallin goes on to explain that having researched the matter at both the examiner's side and the attorney's side, and after two further telephone conversations, two issues became apparent as relevant. The first issue was whether the compliance period could be extended more than two months after the end of the period (more on this later) and the second was whether the first auxiliary request filed on the last day of the compliance period formed part of the application. With regard to this second issue, the examiner concluded that that it did not constitute a formal amendment and that it was now too late to have it formally filed. In response to this, Mr Wallin filed two Forms 52 with his letter of 29th February with the aim of resurrecting the application and retaining the possibility of filing allowable amendments after the hearing.
- 7 In his final letter of 12th March 2012 setting out the issues to be addressed at the hearing, the examiner explains the reason why he believes the first auxiliary request cannot be regarded as a formal amendment. He refers to section 19(1) which states that "at any time before a patent is granted in pursuance of an application the applicant may, in accordance with the prescribed conditions and subject to section 76 below, amend the application of his own volition." He says that the Office's Manual of Patent Practice describes amendments as being *ex nunc* (effective from the date of filing) and that this suggests that there is no option for the Comptroller to decide to insert a provisional claim in response to his own decision; amendments have to be made and filed by the applicant. The examiner explains that an auxiliary request can only act as a procedural tool to help inform the applicant of what further amendments to make.

8 In his skeleton argument, Mr Wallin disagrees with the examiner's interpretation of section 19. He says that, in his experience, auxiliary requests have been readily considered by the Office after the end of the compliance period without any such issues being previously raised. He refers to two decisions of the Office where this appears to be the case ([BL O/044/11](#) and [BL O/211/07](#)). He also says that the Courts are also amenable to considering auxiliary requests, and refers in particular to the case of *Nokia v IPCOM*¹ where the judge commented that he did not encourage such an approach if it was an attempt to try out a number of amendments that would have the effect of raising costs, but saw no legal issues in there being a main and auxiliary request to amend being on file at the same time. Mr Wallin also points out that the practice of filing multiple auxiliary requests is quite common in pre-grant procedures at the European Patent Office.

9 At the hearing, I drew Mr Wallin's attention to paragraph 18.63.3 of the Manual of Patent Practice which sets out the Office's practice in relation to auxiliary claims. This paragraph appeared in the Manual for the first time in October 2011 but was not drawn to Mr Wallin's attention before the hearing. The paragraph supports the examiner's view that auxiliary claims are not to be regarded as formally filed and that the examiner is under no obligation to consider them unless they would help the efficient processing of the application. It also supports Mr Wallin's view that the Office should be open to considering auxiliary requests where they assist in the efficient processing of the application, but quite clearly states that such claims are not formally part of the application (although the paragraph does not, as the examiner has done, rely on section 19 as the basis for this statement). The paragraph says:

18.63.3 The application may formally contain only one set of claims at any one time. Applicants sometimes file auxiliary sets of claims, which are alternative claims filed in addition to the main set of claims, for consideration in the event that the examiner has objections to the main claim set. An examiner is under no obligation to consider such auxiliary claims, but may be prepared to consider one or a small number of auxiliary claim sets if the examiner considers that they help the efficient processing of the application towards grant. It should be borne in mind that these auxiliary claims are not formally a part of the application. This means that an auxiliary claim set does not overcome any objections until it is filed as a formal amendment to the application.

10 We discussed the legal basis for saying that the application may formally contain only one set of claims at any one time, but did so very briefly as this was the first time that Mr Wallin had seen this paragraph. After the hearing, I invited Mr Wallin to make further submissions on this point, and I received these by letter dated 10th April 2012. In this letter Mr Wallin argues that the Act and the Rules do not provide explicit support for the statements of practice set out in the Manual, and he suggests that some of the statements may be *ultra vires*. His argument runs as follows:

- There is no statutory basis for saying that the application may formally contain only one set of claims at any one time. Section 14(2)(b) and Rule 12(4) both refer to the need for a "claim or claims", and they do not prohibit more than one set of claims. Moreover, in the present case the auxiliary request is presented as a conditional set of claims, conditional upon the main request not being allowed. The main request and the auxiliary request are therefore presented in sequence. As such, the application does not formally contain more than one set of claims at any one time. Mr Wallin accepts that it would

¹ [\[2012\] EWHC 225 \(Pat\)](#)

be unacceptable to have parallel claim sets, such that an Examiner had to choose which set of claims to grant, but with the present main and first auxiliary requests, this is not the case - they are sequential requests, to be considered one after the other.

- There is no statutory basis for saying that the examiner is under no obligation to consider auxiliary claims, especially ones that have been timely filed. Mr Wallin goes on to say that section 18(2) imposes a positive obligation on an examiner to examine the application, howsoever it is comprised. [Section 18(2) states that on substantive examination of an application, the examiner shall investigate to such extent as he considers necessary whether the application complies with the requirements of the Act and the Rules and shall report accordingly.]
- Paragraph 18.63.3 of the Manual says that “It should be borne in mind that these auxiliary claims are not formally part of the application. This means that an auxiliary claims set does not overcome any objections until it is filed as a formal amendment to the application”. Mr Wallin expressly disagrees with these statements when applied to the facts of the present case, but accepts that there may be circumstances where they are correct. In the present case, the auxiliary request was timely filed in response to a report under section 18(3) before the end of the compliance period. It was filed in the form of replacement sheets to be substituted into the specification. There is nothing in section 18(3) (inviting the applicant to overcome objections by way of amendment) or in section 19 (voluntary amendments by applicant), to say that the auxiliary request should not be considered to be a “formal part of the application”. Moreover, he questions how the replacement pages constituting the auxiliary request could be made any more “formal” - they are presented in exactly the same format as any other replacement pages, including those of the main request, and can therefore be substituted directly into the specification. He can see a situation where the statement in the Manual would be true, for example where an applicant indicates an alternative claim wording in a covering letter without filing formal replacement pages, where further “formal” amendment would be required - if these “formal” amendments were filed after the end of the compliance period then they may be regarded as inadmissible. But this is not the situation in the present case.

11 Mr Wallin’s argument that the Office should allow the filing of auxiliary claims to help efficient processing of an application is in fact consistent with the current practice set out in the Manual of Patent Practice. In other words, what Mr Wallin is arguing should be Office practice is in fact already the case and indeed has been for some time, and the examiner clearly followed this practice when he considered the first auxiliary request before issuing his letter of 25th January 2012 (where he says that he notes the auxiliary request and then draws the applicant’s attention to a further decision of the Office relevant to the involvement of process control claims).

12 When the text relating to the handling of auxiliary claims was added to the Manual of Patent Practice in October last year, the practice of considering auxiliary claims when they helped the efficient processing of an application was already firmly established, and the two office decisions cited by Mr Wallin demonstrate this to be the case (where auxiliary claims were filed in both cases before the end of the compliance

period of the applications). I understand that the text of paragraph 18.63.3 was added to the Manual in order to confirm this practice to external readers.

- 13 What remains to be decided is whether the applicant's auxiliary claims (marked the first auxiliary request) can be regarded as being formally filed before the end of the compliance period. Paragraph 18.63.3 of the Manual of Patent Practice clearly states that auxiliary claims are not formally a part of the application. Mr Wallin questions the legal basis for this statement, and asks what more could the applicant have done to make the amendments more formal. I should note at this point that I agree with Mr Wallin's argument that, in theory, there is no material difference between a single set of consecutively numbered claims and any number of main and auxiliary sets of claims having a clear order of ranking.
- 14 So what is the legal basis for saying that auxiliary claims are not formally a part of the application? The relevant sections of the Act appear to be as follows: i) section 14(2) of the Act requires that every application for a patent shall contain a specification containing a description of the invention, a claim or claims and any drawing referred to in the description or any claim; ii) section 14(5) states that the claim or claims shall define the matter for which the applicant seeks protection, be clear and concise, be supported by the description and relate to a single invention or inventive concept; iii) an application can be amended in response to an examination report under section 18(3) or at the applicant's own volition under section 19(1), and amendments take effect as of the date of their filing (even though the term "to be filed" is not defined in the Act or Rules, the ordinary meaning of the term suggests that a document would have to be received by the Office rather than merely being submitted by the applicant, which is consistent with the directions relating to fax filing of documents which say that the date of filing is the date of receipt of the document in the Office); and iv) section 20 states that an application will be deemed to be refused if it does not meet the requirements of the Act before the end of the prescribed period (the compliance date). I also note that paragraph 19.15 of the Manual of Patent Practice sets out the practice for dealing with voluntary amendments filed between the date of issue of the search report and of the first examination report (cf section 19(1) and rule 31(3)), and says that "amendments are effected at the time they are filed, but are not considered by the substantive examiner, for example to see if they add subject-matter, until the first substantive examination."
- 15 I have been unable to find any specific reference in the legislation to the filing of auxiliary claims or any case law relating to the pre-grant handling of such claims. I do not find that Mr Wallin's reference to *Nokia v IPCOM* helps since this case deals with post-grant amendments. The legal basis for examination and re-examination of patent applications at the IPO is set out in section 18 of the Act. Section 18(3) states that if the examiner reports that an application does not meet the requirements of the Act, the Office shall give the applicant an opportunity to make observations on the report and to amend the application within a specified period. As I understand it, the examiner's argument is that it is implicit from this that an applicant can only amend the application in response to a report from the examiner or, alternatively, at his own volition under section 19, i.e. the applicant can only submit amendments that comply with the requirements of the Act after the examiner has reported that the requirements are not complied with or else to do so voluntarily. In other words, there is an implicit order of events set out in section 18(3) and 19(1) that requires the applicant to amend an application after examination and not before, and it is this implicit order of events that provides the basis for saying that auxiliary claims filed before

examination cannot correct for deficiencies found in an application when later examined.

- 16 Mr Wallin's position is that there is no statutory basis for preventing auxiliary claims to be filed and that the Office should therefore allow them. Mr Wallin has referred me to the common practice of filing multiple auxiliary claims in pre-grant proceedings before the EPO and suggests that if the practice is allowable there then it should also be allowable at the IPO. The European Patent Convention (EPC) which governs the processing of patent applications at the EPO is silent on the issue of auxiliary claims. The *Guidelines for Examination in the European Patent Office*² refers to the handling of auxiliary requests at section 4.1 of Part C (Guidelines for Substantive Examination), and notes that following *EPO Legal Advice No. 15/05 (rev. 2)*, *OJ 6/2005, 357*³, "every such request qualifies as text submitted or agreed by the applicant within the meaning of Article 113(2)EPC and therefore must be dealt with in the order indicated or agreed to by the applicant, up to and including the highest-ranking allowable request". Article 113(2)EPC states that:

A113(2). The European Patent Office shall examine, and decide upon, the European patent application or the European patent only in the text submitted to it, or agreed, by the applicant or the proprietor of the patent.

- 17 A recent decision of the President of the EPO concerning cancellation of this legal advice⁴ states that the substance of the advice has already been incorporated into the Guidelines for Examination, which I take to mean that the basis of the legal advice remains valid. Although there is no specific reference in this legal advice to when each of the auxiliary requests would be deemed to be filed, it seems implicit from the guidance that all such requests would be deemed to be filed on the same date and would be considered by the EPO as being formally a part of the application. If an allowable request can be found then this would be confirmed with the applicant under Rule 71(3)EPC before the application is granted. Rules 71(1)-(3)EPC read as follows:

71(1). In any communication under Article 94, paragraph 3, the Examining Division shall, where appropriate, invite the applicant to correct any deficiencies noted and to amend the description, claims and drawings within a period to be specified.

71(2). Any communication under Article 94, paragraph 3, shall contain a reasoned statement covering, where appropriate, all the grounds against the grant of the European patent.

71(3). Before the Examining Division decides to grant the European patent, it shall inform the applicant of the text in which it intends to grant it and of the related bibliographic data. In this communication the Examining Division shall invite the applicant to pay the fee for grant and publishing and to file a translation of the claims in the two official languages of the European Patent Office other than the language of the proceedings within four months.

- 18 The process of granting patents set out by the Act and undertaken by the IPO is slightly different to that at the EPO. To begin with, the Act does not have an equivalent requirement to that of Rule 71(3) of the EPC for confirming the content of the application with the applicant before it is granted. In the context of auxiliary

² <http://www.epo.org/law-practice/legal-texts/guidelines.html>

³ http://legis.obi.gr/espacedvd/legal_texts/anc_reg/en/ap_vi_115_05.htm

⁴ <http://www.epo.org/law-practice/legal-texts/official-journal/president-notice/archive/20120612.html>

claims, this could lead to a situation at the IPO where the applicant has filed a main set and an auxiliary set of claims without any clear indication of the sequence in which these sets should be considered, and the IPO then granting a patent on the basis of the claims set it favoured without the agreement of the applicant. This cannot be right, but then this would not be possible at the EPO because of the additional requirement that auxiliary claims are only permissible in circumstances when the order or ranking of the claims has been clearly indicated by the applicant.

- 19 A second difference in the way that patent applications are handled at the IPO compared to the EPO appears to be the requirement in section 18(3) of the Act that an examiner shall give the applicant an opportunity to make observations on the report and to amend the application within a specified period, whereas Rule 71(1)EPC simply requires the Examining Division to invite the applicant, where appropriate, to correct any deficiencies noted and to amend the description, claims and drawings within a period to be specified. It seems to me that this gives EPO examiners more flexibility to amend applications themselves before confirming the content of the application with the applicant under Rule 71(3)EPC and forwarding it to grant.
- 20 A third difference is the time limit specified by section 20 of the Act for putting an application in order. Section 20 requires that the application be treated as having been refused if the application does not comply with the requirements of the Act at the end of the compliance period, whereas an applicant is not bound by such a deadline under the EPC. In the context of auxiliary claims, this gives rise to the need to know the date upon which an auxiliary claim set is deemed to be put into effect and not just filed. For example, in an application having two sets of claims filed shortly before the compliance date and examined afterwards, and having a main set of claims considered not to meet the requirements of the Act and the other found to be allowable, can the application be said to meet the requirements of the Act at the compliance date? The answer must be no, because the application has claims that do not meet the requirements of the Act at the end of the compliance period, and the examiner cannot put into effect the amendments set out in the applicant's instructions (i.e. the clear order of ranking) until a date after the end of the compliance period.
- 21 But does this matter? Well it does if the applicant has no possibility of extending the compliance date beyond that on which the examiner deals with the case. This, of course, would be no different to a situation where a single set of claims had been filed and the applicant had instructed the Office to delete claim 1 if it were found not to meet the requirements of the Act (and where the other claims were allowable). If the examiner deals with the application before the compliance date and finds that claim 1 is not allowable and that the others are, he would have no quarrel in amending the application as per the applicant's clear instructions and then forwarding the case to grant (the act of making "manuscript" amendments to a patent specification in accordance with instructions from the applicant has been common practice at the IPO for a very long time). No further amendments need be filed provided that clear instructions are given for the examiner to follow in the event of an anticipated objection. This might appear to be inconsistent with the examiner's argument that there is an order of events that requires the applicant to amend an application after examination (and not before), but the fact that amendments are not put into effect (by the examiner) until after the application is found to not meet the requirements means that the order, if it exists, is maintained.

- 22 However, if the examiner cannot deal with the case until after the compliance date, for example if amendments are filed on the very last day of the compliance period or if the applicant fails to secure retrospective extension of the compliance period, then the examiner is bound to find that the application does not meet the requirements of the Act at the end of the compliance period and to refuse the application. The consequence of this is that if even if an auxiliary claim set has been filed before the end of the compliance period, the date of putting the auxiliary claim into effect is quite crucial.
- 23 What I conclude from all of this is that there is no legal basis for preventing auxiliary claims to be filed at the IPO and that this is already recognised in current Office practice. I agree with Mr Wallin that there does not appear to be a legal basis for saying in the Manual that “an auxiliary claim set does not overcome any objections until it is filed as a formal amendment to the application” if there are clear instructions for the examiner to follow in the event of the main claim set being found (at a later date) to not meet the requirements of the Act. These instructions would need to be very clear with regard to the steps the examiner should take to overcome an objection on the applicant’s behalf because the Office does not check the content of the application with the applicant before forwarding it to grant (this is to avoid a situation of the examiner having to choose which set of claims to grant, which Mr Wallin admits would be unacceptable). If the application is not examined until after the end of the compliance period then this causes complications that do not arise at the EPO relating to whether the application meets requirements at a particular date. It is necessary, therefore, when deciding whether auxiliary claims can be put into effect at the IPO that account is taken of the compliance date of the application.
- 24 In view of the circumstances of the present application where an auxiliary claims set was filed on the last day of the original compliance period and was not examined until afterwards, the question of whether these claims (or indeed any other subsequently filed claims) can be put into effect will depend on whether it is possible to extend the compliance period. If it turns out to be possible to extend the compliance period in order to allow amendments to be put into effect, there is then the question of whether the instructions regarding the handling of the auxiliary claims contained in the letter of 13th December are sufficiently clear for them to be put into effect.

Extending the compliance period

- 25 On 29th February 2012, Mr Wallin filed two Patent Forms 52 requesting extension of the rule 30 compliance period from 13th December 2011 to 13th April 2012. The first Form 52 is a request made under rule 108(2) for an as-of-right extension of the compliance period by two months (taking it up to 13th February 2012), and the second Form 52 is a request made under rule 108(3) for a discretionary extension of the extended (as-of-right) compliance period by a further two months (taking it from 14th February 2012 to 13th April 2012).
- 26 These two forms were submitted with a covering letter requesting an extension of sixteen days under rule 108(1) to the two month period prescribed by rule 108(2)(c) for filing a request for an as-of-right extension. A request for extension under rule 108(1) does not need to be made on a Patents Form 52 and is allowed at the discretion of the Comptroller. Paragraph 123.37 of the Manual of Patent Practice

describes the circumstances in which discretion would be exercised favourably, and sets out the general principle that an extension should be allowed if the failure to meet the time period was unintentional at the time that the period expired.

- 27 Rule 108(2) says that the Comptroller shall extend, by a period of two months, any period of time prescribed by the provisions listed in part 2 of Schedule 4 (which includes the rule 30 compliance period) where a request is filed before the end of a two month period from the relevant date. This two month period for filing the request is prescribed by rule 108(2)(c).
- 28 Rule 108(1) gives the Comptroller a general power to extend any period of time not listed in parts 1 and 2 of Schedule 4. As I have noted above, part 2 of Schedule 4 lists the rule 30 compliance period, but makes no reference whatsoever to the two month period for filing as-of-right extensions set out in rule 108(2)(c). So, on the face of it, the Comptroller does appear to have discretion to extend the two month period set out in rule 108(2).
- 29 The examiner argues that rule 108(7) prevents any extension of the compliance period based on the request filed on 29th February 2012. Rule 108(7) says that no extension may be granted in relation to the periods of time prescribed by the rules listed in part 3 of Schedule 4 (which again includes the rule 30 compliance period) “after the end of the period of two months beginning immediately after the period of time as prescribed (or previously extended) has expired”. In other words, the deadline for filing the as-of-right extension of the compliance period expired on 13th February 2012, and the Comptroller has no discretion to allow a request for extending the compliance period filed after this date.
- 30 Mr Wallin disagrees. He suggests that rule 108(7) acts to fetter the Comptroller’s discretion to allow a discretionary extension (i.e. an extension under rule 108(3)) to any time period listed in part 3 of Schedule 4 if requested two months after the end of the period. In other words, rule 108(7) has no bearing on the two month as-of-right extension grantable under rule 108(2). In his skeleton argument, Mr Wallin suggests that if rule 108(7) were to somehow apply to rule 108(2), such that the mandated two month extension could not be granted, there would be a clear contradiction within the rule as a whole. He suggests that this contradiction could not have been the intention of the Parliamentary draftsman.
- 31 At the hearing it was also noted that rule 108(2)(c) already provides a deadline of two months for requesting an as-of right extension to the compliance period, so why then the need for an identical deadline for filing such a request as provided by rule 108(7)? Mr Wallin suggests that the answer to this question is that rule 108(7) has no bearing on the as-of-right extension under rule 108(2), and I agree with him on this point.
- 32 One of the first issues I must decide is whether rule 108(1) gives the Comptroller discretion to extend the two month period specified by rule 108(2)(c). As I have noted above, rule 108(2)(c) is not listed in parts 1 or 2 of the Schedule 4, so on the face of it there appears to be nothing in the rules to prevent this period being extended at the discretion of the Comptroller. But is this really what the Parliamentary draftsman intended when drawing up these rules?

- 33 It is worth noting that rule 108 contains a total of four “two month” periods: rule 108(2) defines a two month extension period with rule 108(2)(c) defining a corresponding two month cut-off period within which a request must be made, and rule 108(5) defines another two month extension period with rule 108(7) defining a corresponding two month cut-off.
- 34 The periods to which rules 108(5) and rule 108(7) relate are listed in part 3 of Schedule 4, and they are all “fatal” periods which result in termination of the application if they are not met, e.g. the compliance period or the period for requesting substantive examination. So, for a period listed in part 3, there is always a two month cut-off within which an extension request must be made, whether the request is for an as-of-right extension under rule 108(2) (in which case the cut-off is defined by rule 108(2)(c)), or for a discretionary extension under rule 108(1) or rule 108(3) (in which case the cut-off is defined by rule 108(7)). This cut-off provides certainty (in particular for third parties), and is reflected in Office practice when dealing with termination of applications, i.e. we wait for two months after the compliance period has expired to allow for any extension request and if no extension request is received we treat the application as refused with effect from the compliance date.
- 35 If, as Mr Wallin argues, the two month period of rule 108(2)(c) is extendable under rule 108(1) then it would seem reasonable that all of the other two month periods throughout rule 108 are also extendable under rule 108(1) since none is listed in parts 1 or 2 of Schedule 4. The effect of this would appear to be that an extension under rule 108 could be granted at any time, for any amount of time, even if it is an extension to one of the “fatal” periods listed in part 3 of Schedule 4. In other words, an extension to these periods would always remain available (albeit at the discretion of the Comptroller).
- 36 Clearly this is unworkable from a practical perspective, since there would be no certainty about when an application should be terminated. Furthermore, it seems to make a nonsense of the reinstatement provisions set out in section 20A, which states:

*20A(3). The Comptroller shall not reinstate the application if –
(a) an extension remains available under this Act or Rules for the period...*

If an extension always remains available then section 20A appears to be redundant.

- 37 It seems to me that if the Comptroller were to allow periods within rule 108 to themselves be extended under rule 108 then the extension regime of rule 108 would break down and the reinstatement provisions of section 20A would become redundant. This cannot have been the intention when rule 108 was drafted, and leads me to the conclusion that the two month periods specified by rule 108 cannot be extended under rule 108(1). If I am wrong on this point then I consider that the discretion the Comptroller has to allow an extension under rule 108(1) should not be exercised in favour of the applicant for these very same reasons.
- 38 There is a final line of argument to consider. During the hearing I asked Mr Wallin whether he believed there had been any irregularity of procedure connected with the handling of the application that would necessitate certain time periods being extended under rule 107 to allow for corrections to be put into effect. Mr Wallin

submitted arguments in support of this immediately after the hearing, which can be summarised as follows:

- In his letter dated 25th January 2012, the examiner omitted to mention that the auxiliary request might be deemed to be inadmissible at the hearing if it could only be put into effect within the compliance period. In other words, had the examiner mentioned the potential inadmissibility of the auxiliary request, the applicant could have filed a request for an as-of-right extension of the compliance period on time and maintained the possibility of putting the auxiliary request into effect at a later date.
- As it was, Mr Wallin only became aware of the inadmissibility issue during the telephone calls with the examiner on 29th February, and sought to rectify the position by immediately filing a request to extend the compliance period.

39 Although the examiner does not explicitly mention the admissibility of the auxiliary claims in his letter of 25th January, he does quite clearly say that “I should also remind you that...no search has been conducted on this application, and that if you were to be successful at the hearing, that the case would need to be referred back for further examination. Given the expiry of the section 20 period, you should therefore consider carefully filing form 52/77’s requesting an extension to the compliance period”. I believe that this would have given sufficient warning to the applicant, if one were needed, of the need to keep the application alive to allow for continued processing of the application, be that for putting into effect the auxiliary claims or for amending the application in response to search and examination. As such, I do not agree with Mr Wallin that the examiner’s lack of reference to the admissibility of the auxiliary claims constitutes an irregularity of procedure.

Summary of procedural aspects

40 The applicant’s request to extend the compliance period was filed after the end of the two-month period allowed for doing so. Although the rules do not explicitly preclude this two-month period for filing a request for extension from itself being extended, I have concluded that it cannot be possible to do so as there would then be no certainty about when an application should be terminated. If I am wrong on this point then I consider that the discretion the Comptroller has to allow such an extension should not be exercised in favour of the applicant for the very same reason. I have been unable to find any irregularity of procedure that would require the Comptroller to exercise discretion in favour of extending the two-month period.

41 The question of whether instructions regarding the handling of the auxiliary claims contained in the letter of 13th December are sufficiently clear for them to be put into effect is moot given my finding that it is not possible to extend the compliance period. However, for completeness, I should note that that I do not agree with Mr Wallin when he says that the auxiliary request is presented as a conditional set of claims that is conditional upon the main request not being allowed. The main request and the auxiliary request are not presented in sequence as Mr Wallin suggests, because there is a further condition that if the main request is unallowable and the first auxiliary request is allowable, the applicant would still want to request a hearing be held to discuss the patentability of the main request. Contrary to Mr Wallin’s assertion, this means that the application does indeed contain more than one set of

claims at one time, and the examiner could not, on the basis of the instructions provided, cancel the main claim set and replace it with the auxiliary claims.

- 42 Auxiliary claims were filed on the last day of the compliance period. It was not possible for the examiner to consider these claims and to put them into effect until after the end of the compliance period, so they cannot be considered as being formally filed. I must rely on the main set of claims (the “main request”) in deciding whether the invention relates to a program for a computer and is excluded from being patented.

The invention

- 43 The invention relates to graphical programming language object editing and reporting tool for designing a process control entity within an offline database. As Mr Wallin explained at the hearing, the invention allows for collaborative working in the design of process control entities. A user selects one or more programming language object fragments from a library displayed within a stencil view of the graphical display, and the selected fragments are displayed within an object view of the display. The programming language object fragments are logic routines storing process control entities, such as steps, transitions and actions. Using the selected programming language object fragments, the user is able to configure a graphical programming language object for a process control entity within the programming language object view. The graphical programming language object is stored as a configuration file in a format used by the offline database, and may be mapped to a format different from that used by the offline database to generate reporting documentation and sharing the configuration file with a configuration database. It is suggested at page 7 of the specification that engineering productivity is improved by use of such a collaborative tool.
- 44 Mr Wallin says that the main request stands or falls on the allowability of method claim 1 and system 19, and that substance of these two claims is the same for the purpose of deciding whether the invention is excluded. Claim 1 of the “main request” reads as follows:

1. A method for designing a process control entity within an offline database by editing a graphical programming language object, wherein the offline database comprises one of a plurality of databases each communicatively coupled to a central configuration database, the method comprising:

enabling a user to select one or more programming language object fragments from a library of programming language object fragments, each programming language object fragment comprising a programming logic routine for a process control entity;

displaying the one or more selected programming language object fragments within a graphical programming language interface display;

enabling the user to configure a graphical programming language object for a process control entity from the one or more selected programming language object fragments within the graphical programming language interface display;

storing the configured graphical programming language object as a configuration file;

the method further comprising:

receiving a modified form of the graphical programming language object from the

configuration database, wherein data of the modified graphical programming language object is formatted according to a first schema associated with the configuration database;

mapping the graphical programming language object data to a second schema associated with the offline database to form mapped graphical programming language object data;

enabling the user to configure the modified graphical programming language object for a process control entity from the mapped graphical programming language object data;

mapping data of the configured modified graphical programming language object to the first schema associated with the configuration database; and

sending the mapped graphical programming language object data of the configured modified graphical programming language object to the configuration database.

The law

45 The law relating to excluded inventions 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, 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.

Arguments and analysis regarding excluded inventions

46 The provisions of section 1(2) were considered by the Court of Appeal in *Aerotel*⁵ when a four-step test was laid down to decide whether a claimed invention is patentable:

- 1) construe the claim;
- 2) identify the actual (or alleged) 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.

In the Court of Appeal's decision in *Symbian*⁶, the Court said that the check at step 4 as to whether the contribution is technical in nature can be performed at the same time as step 3. It also confirmed that this structured approach provides one means of answering the crucial question of whether the invention reveals a technical contribution to the state of the art.

⁵ [Aerotel Ltd v Telco Holdings Ltd and Macrossan's Application \[2006\] EWCA Civ 1371](#)

⁶ [Symbian Ltd. v Comptroller-General of Patents \[2008\] EWCA Civ 1066](#)

47 In his skeleton argument, Mr Wallin points to a number of Court decisions that help answer this question of what is to be regarded as a technical contribution. In *AT&T*⁷, Lewison J identifies a number of signposts to a relevant technical effect, namely:

i) whether the claimed technical effect has a technical effect on a process which is carried on outside the computer,

ii) whether the claimed technical effect operates at the level of the architecture of the computer; that is to say whether the effect is produced irrespective of the data being processed or the applications being run,

iii) whether the claimed technical effect results in the computer being made to operate in a new way,

iv) whether there is an increase in the speed or reliability of the computer,

v) whether the perceived problem is overcome by the claimed invention as opposed to merely being circumvented.

48 Mr Wallin says that these signposts are useful in helping decide what is technical and what is not, but they are neither exhaustive nor the final word on the matter, and refers to two further judgments of the Court as providing more guidance on the matter: in *Halliburton*⁸, a computer implemented method of designing a drill bit was found to be more than a computer program as such, and in *PKTWO*⁹, an improved method of monitoring the content of electronic communications was found to be technically superior to that produced by the prior art, which pointed to a technical contribution outside the computer itself. The key point Mr Wallin wished to draw from *Halliburton* was in relation HHJ Birss QC's comments at paras. 34-38 where he says that an excluded computer-implemented invention is one "which almost always involves the interplay between two exclusions" and that such an invention will fail the technical contribution step because the task performed by the computer program would itself be excluded as a business method, a method of playing a game or a mental act. Mr Wallin argues that this view is supported by the earlier *obiter* comments in *Symbian* (para. 19):

"..A program which improves the performance of a computer would not be excluded any more than a program which involved the performance of any other machine. But a program which simply embodies a theory would be excluded because it would not make a technical contribution. And a program embodying a mathematical method or a method of doing business would be excluded, as its only contribution would be in respect of matter within Art 52(2)". [Art52(2) being the EPC's equivalent of section 1(2)]

49 Mr Wallin also refers to Floyd J's review in *PKTWO* of Mann J's decision in *Gemstar*¹⁰ as providing further positive and negative signposts to patentability (at paras. 18, 20, 22, and 34), in particular that i) simply producing a different display is not enough to demonstrate a technical contribution, even if it has an effect on the user, ii) movement of data, even within a computer may be enough to demonstrate a technical contribution, and iii) improved monitoring of the content of electronic communications does involve a technical contribution.

⁷ [AT&T/CVON \[2009\] EWHC 343 \(Pat\)](#)

⁸ [Re Halliburton Energy Services Inc \[2011\] EWHC 2508 \(Pat\)](#)

⁹ [Protecting Kids the World Over's Application \[2011\] EWHC 2720 \(Pat\)](#)

¹⁰ [Gemstar-TV Guide International Inc v Virgin Media Ltd \[2009\] EWHC 3068 \(Ch\)](#)

- 50 Mr Wallin summarises all of this as saying that a computer-implemented invention is likely to be patentable if it does not perform a task considered to be a business method, a mental act or a method of playing a game, and that if the contribution is found to lie in the programming language instead of the task performed, then the invention is unlikely to be patentable.
- 51 In applying the four-step test to the present application, I agree with Mr Wallin that there is no difficulty whatsoever in construing claim 1. For the second step, I also agree that the contribution can be described as that set out in Mr Wallin's skeleton argument, namely the conversion of a graphical programming language object between an online configuration system file format and an offline format to allow a user to move the data object and to permit work on the offline object, and to provide subsequent conversion of the edited offline object back to the configuration system file format for sending back to the configuration database. The invention provides the advantages of improved collaboration and synchronisation in the design and editing of graphical programming language objects.
- 52 The invention potentially falls within the "program for a computer (as such)" category of excluded inventions. In order to decide whether it does or not, I shall adopt the approach taken in *Symbian* of dealing with steps 3 and 4 together and answering the question of whether the invention reveals a technical contribution to the state of the art. In doing so, I shall take account of the "signposts" to a technical contribution that the Courts have provided and are set out above.
- 53 I agree with both Mr Wallin and the examiner that the invention does not have an effect on a process which is carried on outside the computer nor does it operate at the level of the architecture of the computer or operate irrespective of the data being processed. The first and second signposts of *AT&T* are clearly not relevant here. The third and fourth signposts of *AT&T* can be considered together. I agree with the examiner that the computer being used to put the method into effect is entirely standard and that when it is programmed in such a way as to perform the method set out in claim 1, it remains a standard computer albeit running a different application. In other words, the invention may well provide functionality that other computer programs do not provide, but the computer itself works in exactly the same way that one would expect the computer to operate, i.e. it allows data to be input, stored, processed, displayed, and shared with other computers linked to a network. The computer-implemented method may itself be more efficient or reliable, but there is no effect on how the computer operates beyond the normal interaction between an application program and a computer.
- 54 Mr Wallin explains that the third signpost derives from Lewison J's analysis in *AT&T* (paras. 30 and 31) of the EPO BoA's *IBM* decisions ([T115/85](#), [T06/83](#) and [T22/85](#)), where he says that the phrase "technical sense" points towards some generally applicable method of operating a computer rather than a way of handling particular types of data. Mr Wallin argues that since the claim does not recite a specific information format and that the precise forms of the schema are not defined then this would meet the "generally applicable" requirement described by Lewison J. I do not agree with this assessment because, as I have explained above, I do not think that the invention is defining a new way of operating a computer at all.

- 55 The fifth of the *AT&T* signposts suggests that a technical contribution can be found when a perceived problem is overcome by the claimed invention as opposed to merely being circumvented. Mr Wallin argues that the invention makes a technical contribution by allowing a local workstation to still edit graphical programming language objects despite not having the necessary software to operate on the format stored in the central configuration database. This, he argues, squarely addresses the perceived problem of local workstations not being provided with appropriate software, by converting the data between respective schema. This is not a circumvention of the problem.
- 56 I agree with Mr Wallin that the invention solves the problem of local workstations not being provided with appropriate software. But this is not a technical problem, which I think is what Lewison J had in mind when he reviewed the precedent cases and arrived at this signpost (reference being made at para. 35 to the EPO BoA's decision in *Hitachi* ([T258/03](#)) which says that "Method steps consisting of modifications to a business scheme and aimed at circumventing a technical problem rather than solving it by technical means cannot contribute to the technical character of the subject-matter claimed"). The problem here is more a logistical issue concerning the format of data used in a collaborative working environment when not all users have access to the same software. The solution is to provide a method of allowing all users to use whatever software they have and to convert between formats as necessary. I do not consider that such conversion of data from one format to another in order to allow this collaborative working to take place can be considered to be a technical solution.
- 57 Mr Wallin's final point in relation to technical contribution is in respect of the further signpost to be found in *PKTWO*, namely that movement of data, even within a computer, may be enough to demonstrate a technical contribution. He argues that the conversion and movement of data between online and offline databases as seen in the present invention should be sufficient to demonstrate a technical contribution. I note that Floyd J says at para. 22 of *PKTWO* that the initiation of data, even if occurring within a computer, may be a relevant technical effect, and says at para. 23 that all the cases he reviewed are highly fact sensitive. The observation regarding movement of data within a computer is drawn from the judgment of Mann J in *Gemstar*, where he says at para. 234:
- "Again the question is whether what the invention achieves has a relevant technical effect. This time I think that it does. This is not merely a computer running a program without any effect in what might be regarded as the outside world. While it does not produce a "better computer" it does actually achieve something which can be regarded as a physical effect, namely the initiation of movement of data from one disk to another (both metadata and TV programme content). That seems to me to be enough to prevent it being just a computer program as such and to render it patentable material. It is true that it does not produce an effect outside the system itself, but it is still an effect."
- 58 The invention in *Gemstar* (the so-called "transfer patent") relates to a means of controlling the transfer of recorded programmes to a secondary recorder such as a VCR or hard disk. A television programme recorded on a digital video recorder set-top box is identified by the electronic programme guide (EPG) displayed on the television screen, and the programme is transferred by applying an on-screen selection mechanism to that data. The facts of this case are quite different to the present application; for example, the present application clearly requires data transferred within the computer in order to allow work to be shared, but there is nothing in the application that suggests this transfer or the initiation of it requires any

special arrangement beyond the data transfer routines that are standard within computers and their operating systems. As such, I do not think this helps me decide the question of whether the present invention reveals a technical contribution to the state of the art.

59 Having reviewed what the relevant authorities have to say regarding technical contribution, I do not consider that the contribution made by the present invention can be regarded as being technical. This leads me to the conclusion that the contribution falls wholly within the excluded category of a program for a computer, i.e. it is a program for a computer as such. The question then arises whether this conclusion is consistent with the reasoning in *Halliburton* where a computer implemented method of designing a drill bit was found to be more than a computer program as such. In his judgment, HHJ Birss QC says at para 74:

“This is not a case in which the cross-check at step 4 presents any difficulties. Designing drill bits is obviously a highly technical process, capable of being applied industrially. Drill bit designers are, I am sure, highly skilled engineers. The detailed problems to be solved with wear and ability to cut rock and so on are technical problems with technical solutions. Accordingly finding a better way of designing drilling bits in general is itself a technical problem. This invention is a better way of carrying that out. Moreover the detailed way in which this method works - the use of finite element analysis - is also highly technical.”

60 I do not agree with Mr Wallin’s assessment of *Halliburton* when he says that the invention was found not to be a computer program as such because it was not a business method, a scheme for playing a game or a mental act. The invention in *Halliburton* was not a computer program as such because the method of designing drill bits was considered to be technical, i.e. it required the technical problems relating to wear and ability to cut rock to be solved and it did so by using finite element analysis which was itself considered to be technical. As I have already mentioned above, the problem solved by the present invention is more a logistical issue concerning the format of data used in a collaborative working environment when not all users have access to the same software. The solution is a method of allowing all users to use whatever software they have and to convert between formats as necessary. I do not consider this to be a technical solution.

Conclusion

61 The invention is a computer program as such and is excluded under section 1(2). The application is refused under section 18(3).

Appeal

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

H Jones

Deputy Director acting for the Comptroller