

6. The invention, which is computer based, employs a series of steps in which a language interpreter candidate can be tested from beginning level, through intermediate level and finally to professional level.

7. The claims on which this decision is based are those filed on 14th December 2012. Claims 1 reads as follows:

A method comprising:

determining with a processor if a language interpreter candidate is a beginning level language interpreter candidate, if the language interpreter has a predetermined amount of entry level language interpreter experience or has completed beginning level language interpreter requirements, or if the language interpreter candidate has a predetermined amount of professional level language interpreter experience;

providing if the language interpreter candidate is a beginning level language interpreter candidate, a preliminary self-assessment and a language proficiency test;

providing, if the language interpreter has a predetermined amount of entry level language interpreter experience or has completed beginning level language interpreter requirements, an interpreter skills assessment test; and

providing, if the language interpreter candidate has a predetermined amount of professional level language interpreter experience, a predetermined amount of training in a subject matter field associated with the subject matter skill set, or has passed the interpreter skills assessment test, a subject matter skill set language interpretation certification test.

8. There are also independent claims (17 and 33) directed to a system and computer program product for implementing the method of claim 1. The applicant accepts that if claim 1 is deemed to relate to excluded matter then it follows that claims 17 and 33 will also be excluded.

The Law

9. The examiner has raised an objection under section 1(2) of the Patents Act 1977 that the invention is not patentable because it relates inter-alia to one or more categories of excluded matter. The relevant provisions of this section of the Act are shown in bold below:

1(2) It is hereby declared that the following (amongst other things) are not inventions for the purpose of the Act, that is to say, anything which consists of –

(a) a discovery, scientific theory or mathematical method;

(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) the presentation of information;

but the foregoing provisions shall prevent anything from being treated as an invention for the purposes of the Act only to the extent that a patent or application for a patent relates to that thing as such.

10. As explained in the notice published by the UK Intellectual Property Office on 8 December 2008¹, 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*².

11. The interpretation of section 1(2) has been considered by the Court of Appeal in *Symbian Ltd's Application*³. *Symbian* arose under the computer program exclusion, but as with its previous decision in *Aerotel*, 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 Court was quite clear (see paragraphs 8-15) that the structured four-step approach to the question in *Aerotel* was never intended to be a new departure in domestic law; that it remained bound by its previous decisions, particularly *Merrill Lynch*⁴ 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.

12. Subject to the clarification provided by *Symbian*, it is therefore still appropriate for me to proceed on the basis of the four-step approach explained at paragraphs 40-48 of *Aerotel* namely:

1) Properly construe the claim.

2) Identify the actual contribution.

3) Ask whether it falls solely within the excluded matter, which (see paragraph 45) is merely an expression of the “as such” qualification of section 1(2).

4) If the third step has not covered it, check whether the actual or alleged contribution is actually technical.

13. The applicant has followed this approach in its various submissions.

Step 1 - Properly construe the claim

¹ <http://www.ipo.gov.uk/pro-types/pro-patent/p-law/p-pn/p-pn-computer.htm>

² *Aerotel Ltd v Telco Holdings Ltd and Macrossan's Application* [2006] EWCA Civ 1371; [2007]

³ *Symbian Ltd v Comptroller-General of Patents*, [2009] RPC 1

⁴ *Merrill Lynch's Application* [1989] RPC 561

14. There is no issue with how the claims would be construed.

Step 2 - Identify the actual contribution

15. The applicant argues that the contribution is an improved computer implemented method for processing a language interpreter candidate. It argues that the system provides a fast, efficient and uniform method of processing the language skills of interpreters. This allows appropriate tests to be automatically determined and applied depending upon the result of the automated processing.

16. I am content to accept this as the contribution.

Steps 3 & 4 - Does the contribution fall solely within excluded matter and is it actually technical in nature

17. It is not disputed that the invention is implemented on a computer however that in itself does not necessarily mean that it is excluded as a computer program. If the invention provides a technical contribution then it is not excluded.

18. It was to this point that Mr Williams directed most of his argument. He did so with some gusto though at times his submissions did stray slightly from a considered effort to persuade into what appeared to be more an exercise in how often he could use the word "technical". The net effect was to slightly dilute the arguments he was trying to make. Nevertheless I took his main point to be that the processing of the competence of language interpreters is a technical process. Furthermore the experience level of the language interpreter is inherently technical information concerned as it is with the technical skill of the interpreter.

19. Mr Williams was also keen to distinguish the invention here from the more abstract methods of doing business that have been held to be excluded. He argues that claim 1 relates rather to a technical method by which language interpreter candidates can be automatically processed and certified in an efficient and uniform manner. When pressed by me as to what it was that made the method technical, Mr Williams again pointed to the technical nature of the information ie that the language skills of the interpreter is technical information. He also pointed to the technical implementation of the method.

20. There is a vast quantity of case law on the issue of what does and does not constitute a technical contribution. Not all of the case law is consistent on this and it can sometimes be unwise to attempt to compare cases that have different underlying factual matrixes. In his decision in *AT&T*⁵, Lewison J. (as he then was) did seek to distil some of this case law into a set of signposts that he thought were helpful in assessing whether an invention in certain cases makes a technical contribution. Mr Williams sought support here from the first of these signposts which suggests that in determining whether an

⁵ AT&T and CVON [2009] EWHC 343 (Pat)

invention is excluded regards should be had as to whether the claimed technical effect has a technical effect on a process which is carried on outside the computer. If it does then this points to the invention not being excluded. He argues that the invention here provides communication between the processor and the interpreter candidate to automatically provide an appropriate assessment and this constitutes a clear real world technical effect.

21. I am afraid that I am not persuaded by any of these arguments. I start with the nature of the interpreter's language interpretation skills. The process of interpreting is a process which occurs within an interpreter's brain. Whilst the subject matter of the language to be interpreted may well be technical, this does not make the act of interpreting technical and certainly not in the context of how that term is applied when determining whether an invention relates to excluded matter. Hence the nature of the skill or information being tested and certified does not save the invention.

22. I turn now to the method that is applied to that information. That method is in essence a dialogue between the interpreter and the computer. It starts with a determination of the interpreters language abilities and is then followed by the provision of training or an assessment. None of these steps, or indeed any of the steps set out in the claimed invention involve or produce any technical effect. Rather they are more akin to mental acts. Prior to the decision in *Halliburton Energy Services*⁶ it is possible that the invention here would also have been objected to under the mental act exclusion in the same way as perhaps a method of teaching a language would have been. However that decision has made it clear that mental acts performed by a computer cannot be considered mental acts as such. However I am still of the opinion that, in the absence of any technical effect either within or outside the computer that the invention is excluded as a computer program as such.

23. The examiner has, as noted, objected that the invention is also a method of doing business. It is clear from the description that the purpose of the invention is to provide a standardised method of testing and classifying interpreter candidates to assist businesses in selecting the right interpreter. To the extent that the method claimed is intended for such a business use then I am satisfied that it is also a method of doing business as such.

24. I should add for completeness that I do not believe that the claimed invention has any technical effect on a process which is carried on outside of the computer nor does it provide in any other way the required a technical contribution.

Conclusion

25. I conclude that the invention as claimed is excluded under section 1(2) because it relates to a computer program and a method of doing business as such.

⁶ Halliburton Energy Services Inc [2011] EWHC 2506 (Pat)

26. I have carefully read the specification and can find no saving amendment. I therefore refuse the application under Section 18(3).

Appeal

27. Any appeal must be lodged within 28 days

PTHORPE

Deputy Director, acting for the Comptroller