Intellectual Property Office

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PATENTS ACT 1977

APPLICANT Language Line Services Inc

ISSUE Whether patent application GB1103236.4 complies with the requirements of sections 1(1)(d) and 1(2)

HEARING OFFICER B Micklewright

DECISION

1 This decision concerns whether the invention set out in patent application GB1103236.4 relates to excluded matter. The examiner has maintained throughout the examination of this application that the claimed invention is excluded from patentability under section 1(2) of the Patents Act 1977 ("the Act") as a program for a computer and a method of doing business. The applicant has not been able to overcome the objections despite amendments to the application.

2 The examiner offered a hearing and this was accepted but the applicant subsequently requested to be heard on the papers in their final letter dated 1st April 2014. In addition to the arguments presented in that final letter I have also considered all of the correspondence on file. The extended compliance period expired on 12 April 2014.

3 The final claim set was filed on the 28th January 2014. This comprised a total of 112 claims over 15 pages, with claims 1, 18, 27, 44, 66, 88 and 110 being independent. An appendix to this decision contains the text of these seven independent claims.

The Invention

4 The independent claims broadly cover the same invention, namely a web-based system for evaluating a person's language translation skills by providing written and oral examinations to the person, collating and evaluating the examinations, then providing the person with examination results and a certificate to the candidate if they have passed both examinations.

The Law

5 The examiner raised an objection under section 1(2) of the Act stating that the invention is not patentable because it relates *inter-alia* to one or more categories of

excluded matter. The most 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.*

6 There is a large amount of case law in relation to the provisions of section 1(2). The most significant recent judgments of the Court of Appeal on the matter are *Aerotel/Macrossan*[1] and *Symbian Ltd's Application*[2]. Following the guidance in *Symbian* I will use the four-step approach explained at paragraphs 40-48 of *Aerotel* and ensure in my consideration of steps (3) and (4) that I determine whether the invention makes a technical contribution. The test is:

> *(1) Properly construe the claim;*
>
> *(2) Identify the actual contribution;*
>
> *(3) Ask whether it falls solely within the excluded subject matter;*
>
> *(4) check whether the actual or alleged contribution is actually technical in nature.*

7 The Court said in *Symbian* (see paragraphs 8-15) that the structured four-step approach to the question in *Aerotel* was not a new departure in domestic law and that it remained bound by its previous decisions, particularly *Merrill Lynch*[3]. The *Aerotel* test is intended to be equivalent to the prior case law test of "technical contribution".

8 When considering the computer programme exclusion, it can be helpful to consider the 'signposts' set out in paragraph 40 of *AT&T/CVON*[4] which provide guidelines when considering whether a computer program makes a relevant technical contribution beyond the exclusion. These signposts were subsequently endorsed in *Gemstar*[5], but were reworded as follows:

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[1] *Aerotel Ltd v Telco Holdings Ltd and Macrossan's Application* [2006] EWCA Civ 1371; [2007]
[2] *Symbian Ltd v Comptroller-General of Patents* [2009] RPC 1
[3] *Merrill Lynch's Application* [1989] RPC 561
[4] *AT&T Knowledge Ventures/CVON Innovations v Comptroller General of Patents* [2009] EWHC 343 (Pat)
[5] *Gemstar-TV Guide International Inc v Virgin Media Ltd* [2010] RPC 10

(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 the program makes the computer a better computer in the sense of running more efficiently and effectively as a computer;

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

Assessment of the claims

9 There are seven independent claims in the application which broadly cover similar ground, but there are some differences between the claims. I will therefore consider them in groups.

Claims 1 and 27

(1) Properly construe the claims

10 The final form of claim 1 is given below:

1. A method comprising:

providing a web-based screening, with a processor, of a candidate on a prerequisite;

evaluating, with the processor, the screening to determine if the candidate passes the screening;

providing a web-based written examination, with the processor, to a qualified candidate, the qualified candidate passing the screening;

evaluating, with the processor, the web-based written examination to determine if the qualified candidate passes the web-based written examination;

providing an oral examination to the qualified candidate if the qualified candidate passes the web-based written examination;

providing examination results to the qualified candidate;

evaluating, with the processor, the examination results to determine if certification is to be provided to the qualified candidate; and

providing certification, with the processor, to the qualified candidate if the qualified candidate passes both the written examination and the oral examination, the processor using a web-based scoring instrument to rate the web-based written examination.

Claim 27, in its final form, reads:

27. A computer program product comprising a computer useable medium having a computer readable program, wherein the computer readable program when executed on a computer causes the computer to:

provide a screening, with a processor, of a candidate on a prerequisite;

evaluate, with the processor, the screening to determine if the candidate passes the screening;

provide a written examination, with the processor, to a qualified candidate, the qualified candidate passing the screening;

evaluate, with the processor, the web-based written examination to determine if the qualified candidate passes the web-based written examination;

provide an oral examination to the qualified candidate if the qualified candidate passes the written examination;

provide examination results to the qualified candidate;

evaluate, with the processor, the examination results to determine if certification is to be provided to the qualified candidate;

provide certification, with the processor, to the qualified candidate if the qualified candidate passes both the written examination and the oral examination, the processor using a web-based scoring instrument to rate the written examination.

11 I have construed the references to 'web based' broadly to mean that a computer network is at the very least used to deliver and collect documents using world-wide-web protocols etc. The references to 'with a processor' in claim 1 have been construed to mean that a computer or computers are used, which is also an implicit requirement of the term 'web based'. It is known in the art that web technology can use web documents which include scripting, a form of computer program, and that programs and/or scripts may also reside on the web server specifically for use with those documents. Thus it is implicit that in practice, some part of the method of claim 1 is likely to be embodied in a computer program.

12 Claim 27 explicitly refers to a computer program that provides for substantially the same method as recited in claim 1 except that only some elements are defined as "web-based". It seems that there may be a drafting error in this claim, for example with the lack of antecedent to "the web-based written examination". I will construe this claim to include at least a web-based scoring instrument but in any event this does not impact on my decision.

13 Neither of these claims clearly specifies the degree of automation which may be provided by the processor or program. I have therefore construed the claims broadly to mean that some aspects of the method could be partly performed manually by a person using the web-based processor and / or computer program. In other words, I do not construe these steps narrowly to mean they are completely automated and only require interaction with the candidate. There is support for this construction in the description, which also refers to using telephone or postal services in some circumstances, for example.

14 I have read the specification carefully with a view to construing the '*web-based scoring instrument*' in these claims. The only relevant part of the description is in paragraph 53 which states:

> *... In one embodiment, the written examination can be web-based. In other words, the written examination can be delivered through a web site. The language interpreter can then take the written examination through the web site. Further, the written examination* ***may be rated by a web-based scoring instrument****. In an alternative embodiment, the written examination can be implemented in written form without the Internet. ...*

There is no disclosure of any method of scoring. Neither is there a clear indication of automatic assessment of the content of answers or even of an automated tallying of marks or comparison of marks with a grading scheme. The claim echoes the description in saying the examination 'may be rated'. The term 'instrument' is thus essentially meaningless and has been ignored. I've construed this to mean nothing more that the examination is marked and a score determined, whether automatically or manually.

(2) Identify the actual contribution

15 Claims 1 and 27 both present a method of assessing a person by screening on a prerequisite, asking questions, receiving answers, scoring the answers and deciding if the person has 'passed' the assessment. In detail, three stages of questions are required and that the assessment score is provided to the person, possibly with a certificate. Claim 1 specifies that communication is 'web-based' and that the method requires use of a processor. Claim 27 is not considered limited to web-based communication except for the scoring instrument, but does explicitly embody a computer program running on a processor.

16 In the agent's letter dated 27 January 2014 it is argued that the contribution is

> *"a method of automatically evaluating language interpreter candidates through the use of web-based tools provided by a processor".*

Further in that letter, when responding to the Examination Report of 26 November 2013, it is stated that the amendments to the claims which refer to steps acting 'with a processor' and being 'web-based' means that

> "*the invention of claim 1 is directed to the automatic evaluation of the language interpreter and not merely the remote provision of examinations*".

It is also argued that web technology

> *"may improve the efficiency with which the screening … provision and evaluation of examinations is achieved"*

and

> *"improves the speed and efficiency with which the written examinations are rated."*

17 I disagree with this formulation of the contribution because there is no disclosure of automatic evaluation either explicitly or implicitly in the specification. Reading the

description, it is clear that using web tools is not the only communication means envisaged for all of the steps; there are references to using telephones or postal services in some circumstances. Furthermore no specific details of automation are provided. I am aware that, at the priority date, web-servers and web-browser-clients are able to automate form filling, the sending of questions, receiving corresponding answers and that scripting / programming can run on both the server and browser to process the data sent and data received. If a skilled addressee were to implement the invention, they would likely provide some degree of automation as this is one of the reasons web-tools are chosen in general. However, the specification does not give details of such processing, instead only general phrases such as, for example, 'web-based' are used. The 'web based' implementation may merely assist in communicating between the candidate and a human evaluator.

18 The contribution is thus a method of assessing a candidate using web-based communications where a candidate is screened on a prerequisite and both a written and oral examination are delivered along with scores and certification.

(3) Does the contribution fall solely within the excluded matter?

19 I consider the administration of examinations for assessing a person's skills or knowledge a method of doing business as such. I note that in the Agent's letter of 28 January 2014 it is accepted that organisational and administrative activities (as such) fall within the 'methods of doing business' exclusion. But the applicant argued that the claims define a technical task rather than an administrative one because the screening, evaluation of examinations and provision of results are carried out by the processor. As is explained above, the specification does not provide any details as to how the screening of candidates or the delivery, collection and evaluation of examinations may be automated. Simply using a processor does not in itself provide a relevant technical contribution.

20 The use of web-based communications, and thus implicitly the use of at least one processor, is present in the contribution identified above. Electronic computers, computer networks and the like are all technical devices and systems. Web-based tools clearly use computer programs and process electronic documentation and may also process pictures, audio recordings and the like. However, in the present invention, there is no contribution made to the art of these web systems, as their operation appears to be entirely conventional. There is no special arrangement of hardware required for the web-based communications. Furthermore there is no specific disclosure of any details relating to special data processing other than the implicit requirement for entirely conventional processing as is typical of web-based technologies.

21 Both the examiner and the applicant's attorney made reference to the *AT&T/CVON* signposts during the prosecution of this application. I note in reading the correspondence on file that there was clear disagreement over the assessment of these signposts. I précis the applicant's arguments below which were mainly contained in the Agent's letter of 16 September 2013. It was contended that the first, third and fifth signpost (listed above) were relevant to the claimed invention in the following manner:

(1) the screening and the oral examination are examples of a process carried on outside the computer;

(3) the computer is being made to operate in a new way to provide web-based screening, a web-based written examination, a web-based scoring instrument and to provide certification;

(5) the problem of choosing a way to implement an evaluation of a candidate is a technical one, not a business one, and thus a technical problem is being solved and not being circumvented.

22 The first signpost relates to whether a technical effect occurs on a technical process outside of the computer. The fact that something occurs outside the computer does not mean that there is a technical effect. In the present case, there is no technical effect but simply conventional communication and the provision of the candidates screening, examination and evaluation. As I make clear above, assessment of a person's skills is not technical in nature and so the fifth signpost is mute.

23 Considering the third signpost, the computing and network apparatus is entirely conventional. The computing apparatus does not function in an improved manner nor is there any improvement to the function of networking or communication apparatus. While any program defines a new set of instructions, the underlying computer is not caused to operate in new way.

24 Thus the identified contribution of claims 1 and 27 does not provide for a computer program that has a relevant technical effect; there is nothing other than a computer program as such. Furthermore the program performs steps that are part of the evaluation of a candidate which of itself is a business method as such.

25 Thus the contribution of these claims lies wholly in the excluded fields of a method of doing business and a program for a computer as such.

(4) Check if the contribution is actually technical

26 I have substantially covered this in the above discussion and have concluded that the contribution of neither claim is technical.

27 It is settled law that merely automating otherwise excluded matter using conventional technology, does not in itself involve any relevant technical contribution. I note that in the Agent's letter of 28 January 2014 there is reference to the invention being:

"not ... mere automation of a known method, but rather a new method of evaluating language interpreter candidates."

This does not change the fact that there is no technical contribution; a new business method is still an excluded business method. I note that HHJ Birss QC (as he then was) in *Halliburton*[6] in paragraph 35 confirms that the use of a computer to implement a new or better business method does not confer patentability.

Claim 18

[6] *Halliburton Energy Services Inc's Applications* [2012] RPC 129

28 Claim 18 is a claim to a system rather than a method as in claim 1, and also includes reference to ‘modules’ and to ‘web servers’ when reciting steps similar to those in claim 1.

(1) Properly construe the claim

29 The term ‘modules’ is taken to be a reference to computer programs, and ‘web servers’ as a reference to computer / processor hardware.

30 Claim 18 includes the following feature which is not present in claim 1:

> *... an oral examination **automated system** that provides an oral examination to the qualified candidate if the qualified candidate passes the written examination; ...*

The only relevant part of the description that I have found that refers to this automation is the following passage in paragraph 5:

> *The oral examination may be delivered to the qualified candidate by a live tester, an automated in-person system, an automated phone system, a web server, or the like. In one embodiment, the automated system may also record responses for scoring.*

I therefore construe claim 18 to include an automated system for delivery of questions and for recording of answers in an oral exam. There is nothing in the specification that describes more than merely the automation of, delivery of and recording of what is implied to be audio recordings of speech. Again it important to note that there is no detail of how this automated system might be realised. I further note that claim 18 does not require the automation to be provided by a processor or through a web server.

(2) Identify the actual contribution

31 The contribution of claim 18 is thus a method of assessing a candidate using web-based communications where a candidate is screened on a prerequisite; a written examination is delivered along with scores and certification; an oral examination is also delivered using at least a degree of automation to deliver questions and to record answers.

(3) Does the contribution fall solely within the excluded matter?

32 As with claims 1 and 27, I consider that contribution is no more that a method of doing business that is partly delivered, and possibly automated, using conventional computer apparatus and/or conventional communication apparatus.

33 Thus the contribution of claim 18 lies wholly in the excluded fields of a method of doing business and a program for a computer as such.

(4) Check if the contribution (of claim 18) is actually technical

34 For the reasons I have given above, the invention of claim 18 is not technical.

Claims 44, 66 and 88

35 Independent claim 44 is another method claim substantially similar to claim 1. In comparison to claim 1 it lacks a reference to the 'web based scoring instrument'. Claim 66 covers substantially the same steps as claim 44 but refers to a system in the style of claim 18. Claim 88 again covers similar ground but refers to a computer program product in the style of claim 27. These claims include further steps that provide additional initial assessment questions prior to those specified in claim 1.

36 The respective contributions made by these claims are the same as that of claim 1. There is therefore nothing in these claims which could lead me to depart from my reasoning in relation to claim 1 set out above. The extra features of these claims are simply further elements of the business method.

37 The contributions of claim 44, 66 and 88 therefore reside solely within the business method and computer program exclusions and are not technical in nature.

Claim 110

38 Claim 110 relates to a system that covers the steps recited in claims 1 and 27. The language is slightly different as it additionally refers to a communications device. I have construed the communications device to be nothing more than conventional hardware used in a conventional manner. This does not comprise a new arrangement of hardware.

39 The claim covers the same ground as has already been discussed. There is nothing in this claim which could lead me to depart from my reasoning in relation to claim 1 set out above. The contribution of claim 110 resides solely within the business method and computer program exclusions as such and is not technical in nature.

Conclusion

40 I therefore conclude that each of the independent claims define an invention which is excluded under section 1(2) as a method of doing business and a program for a computer as such.

41 I have carefully read all of the dependent claims and find no matter in those claims that provides any contribution beyond these exclusions. Thus claims 1 to 112 are all excluded.

42 I have read through the specification but can find no saving amendment. I therefore refuse the application.

Appeal

43 Any appeal must be lodged within 28 days

B Micklewright

Deputy Director, acting for the Comptroller

APPENDIX

Independent claims filed 28th January 2014

1. A method comprising:

providing a web-based screening, with a processor, of a candidate on a prerequisite;

evaluating, with the processor, the screening to determine if the candidate passes the screening;

providing a web-based written examination, with the processor, to a qualified candidate, the qualified candidate passing the screening;

evaluating, with the processor, the web-based written examination to determine if the qualified candidate passes the web-based written examination;

providing an oral examination to the qualified candidate if the qualified candidate passes the web-based written examination;

providing examination results to the qualified candidate;

evaluating, with the processor, the examination results to determine if certification is to be provided to the qualified candidate; and

providing certification, with the processor, to the qualified candidate if the qualified candidate passes both the written examination and the oral examination, the processor utilizing a web-based scoring instrument to rate the web-based written examination.

18. A system comprising:

a web-based screening module that provides, through a web server, a screening of a candidate on a prerequisite and evaluates, through the web server, the screening to determine if the candidate passes the screening;

a web-based written examination module that provides, through the web server, a written examination that is provided to a qualified candidate and evaluates, through the web server, the web-based written examination to determine if the qualified candidate passes the web-based written examination, the qualified candidate passing the screening;

an oral examination automated system that provides an oral examination to the qualified candidate if the qualified candidate passes the written examination;

an examination results delivery module that delivers examination results to the qualified candidate; and
a certification module that evaluates the examination results to determine if certification is provided to the qualified candidate and provides certification, with the web server, to the qualified candidate if the qualified candidate passes both the written examination and the oral examination, the web server utilizing a web-based scoring instrument to rate the written examination.

27. A computer program product comprising a computer useable medium having a computer readable program, wherein the computer readable program when executed on a computer causes the computer to:

provide a screening, with a processor, of a candidate on a prerequisite;

evaluate, with the processor, the screening to determine if the candidate passes the screening;

provide a written examination, with the processor, to a qualified candidate, the qualified candidate passing the screening;

evaluate, with the processor, the web-based written examination to determine if the qualified candidate passes the web-based written examination;

provide an oral examination to the qualified candidate if the qualified candidate passes the written examination;

provide examination results to the qualified candidate;

evaluate, with the processor, the examination results to determine if certification is to be provided to the qualified candidate;

provide certification, with the processor, to the qualified candidate if the qualified candidate passes both the written examination and the oral examination, the processor utilizing a web-based scoring instrument to rate the written examination.

44. A method comprising:

providing with a processor, if a language interpreter candidate is a beginning level language interpreter candidate, a preliminary assessment and a language proficiency test;

providing with the processor, 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;

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 by (i) providing a screening of a candidate on a prerequisite, (ii) providing a written examination to a qualified candidate, the qualified candidate passing the screening, and (iii) providing an oral examination to the qualified candidate if the qualified candidate passes the written examination;

evaluating, with the processor, the screening to determine if the candidate passes the screening;

evaluating, with the processor, the web-based written examination to determine if the qualified candidate passes the web-based written examination;

evaluating, with the processor, the examination results to determine if certification is to be provided to the qualified candidate; and

and providing certification, with the processor, to the qualified candidate if the qualified candidate passes both the written examination and the oral examination.

66. A system comprising:

a beginning level language interpreter candidate module that provides with a processor, if a language interpreter candidate is a beginning level language interpreter candidate, a preliminary assessment and a language proficiency test;

an entry level language interpreter candidate module that provides with the processor, 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

a professional level interpreter candidate module that provides, 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 skiff set, or has passed the interpreter skills assessment test, a subject matter skill set language interpretation certification test by (I) providing a screening of a candidate on a prerequisite, (ii) providing a written examination to a qualified candidate, the qualified candidate passing the screening, and (iii) providing an oral examination to the qualified candidate if the qualified candidate passes the written examination, the professional level interpreter candidate module evaluating, with the processor, the screening to determine if the candidate passes the screening, evaluating with the processor, the web-based written examination to determine if the qualified candidate passes the web-based written examination, and evaluating, with the processor, the examination results to determine if certification is to be provided to the qualified candidate; and

a certification module that provides, with the processor, certification to the qualified candidate if the qualified candidate passes both the written examination and the oral examination.

88. A computer program product comprising a computer useable medium having a computer readable program, wherein the computer readable program when executed on a computer causes the computer to:

provide with a processor, if a language interpreter candidate is a beginning level language interpreter candidate, a preliminary assessment and a language proficiency test;

provide with the processor, 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 provide, 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 by (i) providing a screening of a candidate on a prerequisite, (ii) providing a written examination to a qualified candidate, the qualified candidate passing the screening, and (iii) providing an oral examination to the qualified candidate if the qualified candidate passes the written examination, the processor evaluating the screening to determine if the candidate passes

the screening, evaluating the web-based written examination to determine if the qualified candidate passes the web-based written examination, and evaluating the examination results to determine if certification is to be provided to the qualified candidate; and

provide certification, with the processor, to the qualified candidate if the qualified candidate passes both the written examination and the oral examination.

110. A system comprising:

a communication device based screening module that provides with a processor, through the communication device, a web-based screening of a candidate on a prerequisite;

a communication device based written examination module that provides with the processor, through the communication device, a web-based written examination that is provided to a qualified candidate, the qualified candidate passing the screening;

an oral examination automated system that provides an oral examination to the qualified candidate if the qualified candidate passes the written examination;

an examination results delivery module that delivers examination results to the qualified candidate; and

a certification module that provides, with the processor certification to the qualified candidate if the qualified candidate passes both the written examination and the oral examination, the processor utilizing a web-based scoring instrument to rate the written examination, the processor evaluating the screening to determine if the candidate passes the screening, evaluating the web-based written examination to determine if the qualified candidate passes the web-based written examination, and evaluating the examination results to determine if certification is to be provided to the qualified candidate.