



## PATENTS ACT 1977

APPLICANT	Gelliner Limited
ISSUE	Whether patent application GB 1514006.4 complies with section 1(2)
HEARING OFFICER	Dr Carol L Davies

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### DECISION

#### Introduction

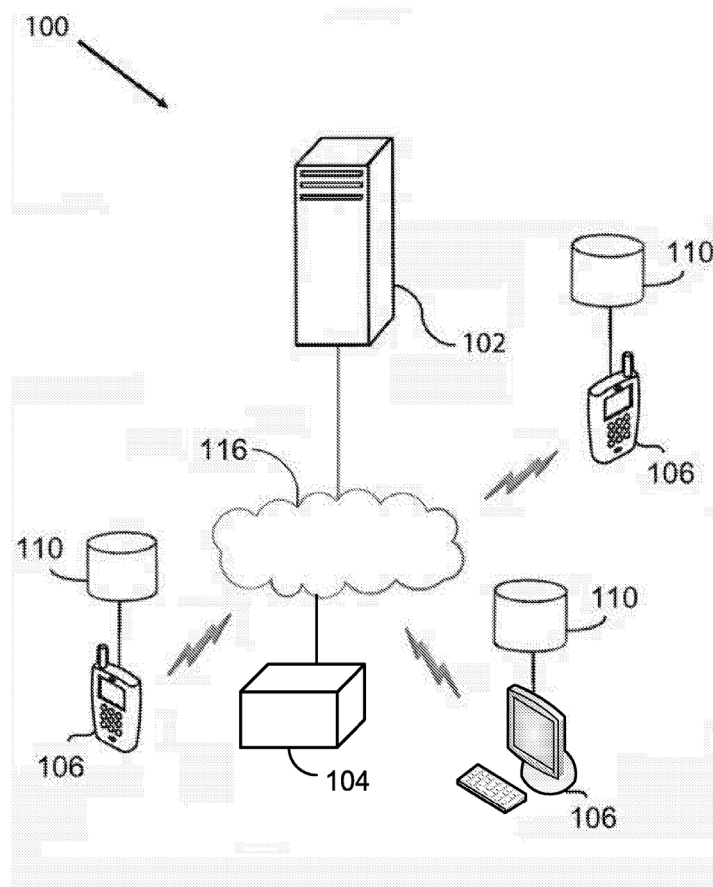
- 1 Patent application GB 1514006.4 ("the application") entitled "Exchanging Physical Cash with an Electronic Funds Account" was filed on 7 August 2015. It was published as GB 2543021 A on 12 April 2017.
- 2 Following a number of rounds of correspondence between the examiner and the applicant's attorney, the examiner remains of the view that the claimed invention is excluded from patentability under section 1(2).
- 3 With the position unresolved the applicant asked to be heard and the matter came before me at a hearing on 1 September 2021. The issue of excluded matter before me was set out in the examiner's pre-hearing report of 23 July 2021. The applicant was represented at the hearing by attorney Mr Edward Round of Marks & Clerk LLP. I thank the attorney for filing skeleton arguments prior to the hearing. The examiner Mr David Maskery was present and I was assisted by Mr Marc Collins.

#### The invention

- 4 The invention relates to a method by which a person can obtain physical cash when an automated teller machine (ATM) is not readily available. The method is a means by which a withdrawer, i.e. an individual wishing to withdraw money as physical cash from their account, can obtain the cash without having to access an ATM. When a withdrawer wishes to withdraw cash, they use a computing device to send a cash request to an application server. The server then sends requests for cash to depositor devices within a set range of the withdrawer device. When the server receives a quote of a cash withdrawal fee for the cash withdrawal from a depositor device it forwards it to the withdrawer device. When the withdrawer device receives the quote, it sends an acceptance of the quote to the application server. The server then sends instruction so that the withdrawer and depositor can meet. When the withdrawer has received the cash from the depositor, messages are sent by both the withdrawer and the depositor to the application server to confirm that the cash

transfer has been completed. Then electronic funds to the amount of the cash transfer and the fee are debited from the withdrawer's account and credited to the depositor's electronic account.

- 5 Figure 1 below depicts a schematic representation of an example system 100 in accordance with example embodiments of the invention. The system 100 includes an application server 102, a point of sale ("POS") terminal 104, one or more computing devices 106, one or more user profiles 110, and a communications network 116. The one or more computing devices 106 can take the form of a mobile wireless computing device. For example, any of the one or more computing devices 106 can take the form of a conventional smartphone handset provisioned with a web browser and a wireless connection to the Internet.
- 6 The one or more computing devices 106 can communicate with the application server 102 and/or the POS terminal 104 using the communication network 116. The communication network 116 can comprise a wide-area network, such as the Internet, or can communicate directly with the POS terminal 104 using a wireless communication link (not shown).
- 7 Communication between the application server 102 and one of the computing devices can be facilitated by using a server-hosted program (not shown), such as a banking application program ("banking app") that is installed and executed on one of the computing devices or accessed using a web browser on one of the computing devices. In another respect, communication between the application server 102 and one of the computing devices can occur using a pair of network interfaces.



**FIG. 1**

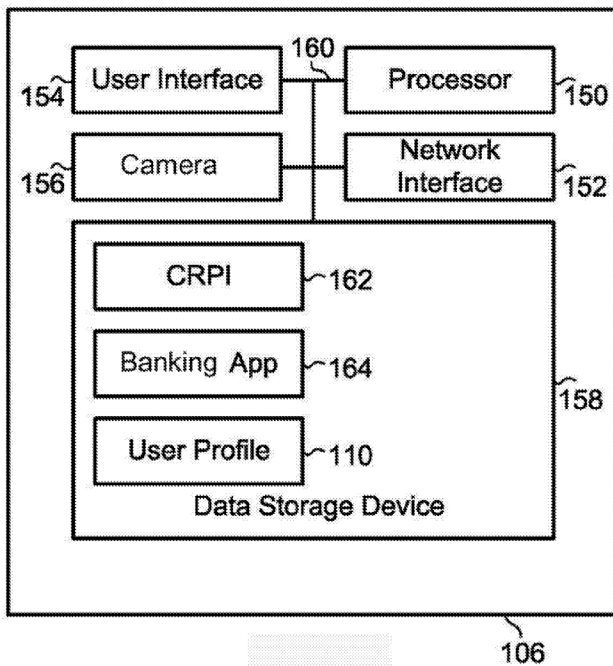


FIG. 2

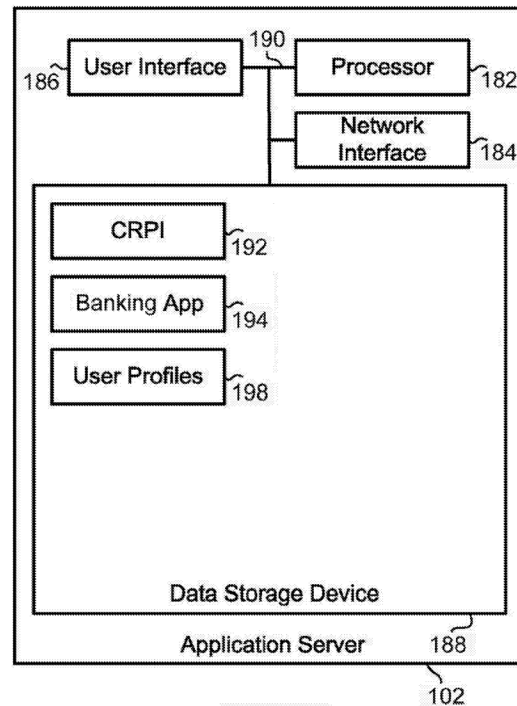


FIG. 3

- 8 Figures 2 and 3 above are examples of a computing device 106 and an application server 102 having a banking app 164, 194 installed thereon. The banking app installed on each of the withdrawer's computing device, the depositor's computing device and the application server enables the method of the invention to be performed. The user of the system 100 may configure a personal ATM functionality of the banking app and specify certain parameters of a cash withdrawal request such as a maximum broadcast radius for the request.
- 9 The claims have not been amended since filing and include sixty-four claims including six independent claims – claims 1, 12, 22, 33, 43 and 54. The independent claims are set out below:

1. *A method comprising:*
  - sending, by a withdrawer computing device to an application server device, a cash withdrawal request having an associated maximum broadcast radius, wherein the withdrawer computing device is associated with a withdrawer electronic funds account, and wherein the cash withdrawal request is for a cash withdrawal of an amount of physical cash;*
  - receiving, by the withdrawer computing device from the application server device, a quote of a cash withdrawal fee for the cash withdrawal, wherein the quote is provided by a depositor computing device located within the maximum broadcast radius, and wherein the depositor computing device is associated with a depositor electronic funds account;*
  - obtaining, by the withdrawer computing device, an acceptance of the quote;*

*sending, by the withdrawer computing device to the application server device, a notification of the acceptance of the quote;*

*receiving, by the withdrawer computing device, an indication that a party associated with the depositor computing device has provided the amount of physical cash to a party associated with the withdrawer computing device; and*

*transmitting, by the withdrawer computing device to the application server device, confirmation that the cash withdrawal has been completed, wherein the withdrawer electronic funds account is debited by the amount of physical cash and the cash withdrawal fee and the depositor electronic funds account is credited by the amount of physical cash and the cash withdrawal fee at least partially in response to the confirmation that the cash withdrawal has been completed.*

12. A method comprising:

*receiving, by a depositor computing device from an application server device, a cash withdrawal request, wherein the depositor computing device is associated with a depositor electronic funds account, wherein the cash withdrawal request is provided by a withdrawer computing device located within a maximum reception radius of the depositor computing device, wherein the withdrawer computing device is associated with a withdrawer electronic funds account, and wherein the cash withdrawal request is for a cash withdrawal of an amount of physical cash;*

*obtaining, by the depositor computing device, an acceptance of the cash withdrawal request;*

*sending, by the depositor computing device to the application server device, a quote of a cash withdrawal fee for the cash withdrawal;*

*receiving, by the depositor computing device from the application server device, a notification of an acceptance of the quote;*

*receiving, by the depositor computing device, an indication that a party associated with the depositor computing device has provided the amount of physical cash to a party associated with the withdrawer computing device; and*

*transmitting, by the depositor computing device to the application server device, confirmation that the cash withdrawal has been completed, wherein the withdrawer electronic funds account is debited by the amount of physical cash and the cash withdrawal fee and the depositor electronic funds account is credited by the amount of physical cash and the cash withdrawal fee at least partially in response to the confirmation that the cash withdrawal has been completed.*

22. A method comprising:

*receiving, by an application server device from a withdrawer computing device, a cash withdrawal request having an associated maximum broadcast radius, wherein the withdrawer computing device is associated with a withdrawer electronic funds account, and wherein the cash withdrawal request is for a cash withdrawal of an amount of physical cash;*

*determining, by the application server device, a depositor computing device that is located within the maximum broadcast radius, wherein the depositor computing device is associated with a depositor electronic funds account;*

*sending, by the application server device to the depositor computing device, the cash withdrawal request;*

*receiving, by the application server device from the depositor computing device, a quote of a cash withdrawal fee for the cash withdrawal;*  
*sending, by the application server device to the withdrawer computing device, the quote;*  
*receiving, by the application server device from the withdrawer computing device, an acceptance of the quote;*  
*sending, by the application server device to the depositor computing device, a notification of the acceptance of the quote;*  
*receiving, by the application server device from the withdrawer computing device, a first confirmation that a party associated with the depositor computing device has provided the amount of physical cash to a party associated with the withdrawer computing device;*  
*receiving, by the application server device from the depositor computing device, a second confirmation that the party associated with the depositor computing device has provided the amount of physical cash to the party associated with the withdrawer computing device;*  
*debiting, by the application server device, the withdrawer electronic funds account by the amount of physical cash and the cash withdrawal fee; and*  
*crediting, by the application server device, the depositor electronic funds account by the amount of physical cash and the cash withdrawal fee.*

33. A method comprising:

*sending, by a depositor computing device to an application server device, a cash deposit request having an associated maximum broadcast radius, wherein the depositor computing device is associated with a depositor electronic funds account, and wherein the cash deposit request is for a cash deposit of an amount of physical cash;*  
*receiving, by the depositor computing device from the application server device, a quote of a cash deposit fee for the cash deposit, wherein the quote is provided by a receiver computing device located within the maximum broadcast radius, and wherein the receiver computing device is associated with a receiver electronic funds account;*  
*obtaining, by the depositor computing device, an acceptance of the quote;*  
*sending, by the depositor computing device to the application server device, a notification of the acceptance of the quote;*  
*receiving, by the depositor computing device, an indication that a party associated with the depositor computing device has provided the amount of physical cash to a party associated with the receiver computing device; and*  
*transmitting, by the depositor computing device to the application server device, confirmation that the cash deposit has been completed, wherein the receiver electronic funds account is debited by an amount equal to the amount of physical cash less the cash deposit fee and the depositor electronic funds account is credited by the amount equal to the amount of physical cash less the cash deposit fee at least partially in response to the confirmation that the cash deposit has been completed.*

43. A method comprising:

*receiving, by a receiver computing device from an application server device, a cash deposit request, wherein the receiver computing device is associated with a receiver electronic funds account, wherein the cash deposit request is*

*provided by a depositor computing device located within a maximum reception radius of the receiver computing device, wherein the depositor computing device is associated with a depositor electronic funds account, and wherein the cash deposit request is for a cash deposit of an amount of physical cash;*  
*obtaining, by the receiver computing device, an acceptance of the cash deposit request;*  
*sending, by the receiver computing device to the application server device, a quote of a cash deposit fee for the cash deposit;*  
*receiving, by the receiver computing device from the application server device, a notification of an acceptance of the quote;*  
*receiving, by the receiver computing device, an indication that a party associated with the depositor computing device has provided the amount of physical cash to a party associated with the receiver computing device; and*  
*transmitting, by the receiver computing device to the application server device, confirmation that the cash deposit has been completed, wherein the receiver electronic funds account is debited by an amount equal to the amount of physical cash less the cash deposit fee and the depositor electronic funds account is credited by the amount equal to the amount of physical cash less the cash deposit fee at least partially in response to the confirmation that the cash deposit has been completed.*

54. A method comprising:

*receiving, by an application server device from a depositor computing device, a cash deposit request having an associated maximum broadcast radius, wherein the depositor computing device is associated with a depositor electronic funds account, and wherein the cash deposit request is for a cash deposit of an amount of physical cash;*  
*determining, by the application server device, a receiver computing device that is located within the maximum broadcast radius, wherein the receiver computing device is associated with a receiver electronic funds account;*  
*sending, by the application server device to the receiver computing device, the cash deposit request;*  
*receiving, by the application server device from the receiver computing device, a quote of a cash deposit fee for the cash deposit;*  
*sending, by the application server device to the depositor computing device, the quote;*  
*receiving, by the application server device from the depositor computing device, an acceptance of the quote;*  
*sending, by the application server device to the receiver computing device, a notification of the acceptance of the quote;*  
*receiving, by the application server device from the depositor computing device, a first confirmation that a party associated with the depositor computing device has provided the amount of physical cash to a party associated with the receiver computing device;*  
*receiving, by the application server device from the receiver computing device, a second confirmation that the party associated with the depositor computing device has provided the amount of physical cash to the party associated with the receiver computing device;*

*debiting, by the application server device, the receiver electronic funds account by an amount equal to the amount of physical cash less the cash deposit fee; and*

*crediting, by the application server device, the depositor electronic funds account by the amount equal to the amount of physical cash less the cash deposit fee.*

### **The issues to be decided**

- 10 The issue for me to decide is patentability i.e. whether the claimed invention relates to excluded subject matter, and in particular whether the invention falls into one of the categories set out in section 1(2)(c) of the Patents Act 1977 as a method of doing business and/or a program for a computer as such.

### **The law**

- 11 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 (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.*

- 12 The examiner and the applicant agree that the assessment of patentability under section 1(2) is governed by the judgment of the Court of Appeal in *Aerotel*<sup>1</sup>, as further interpreted by the Court of Appeal in *Symbian*<sup>2</sup>.
- 13 In *Aerotel*, the court reviewed the case law on the interpretation of section 1(2) and approved a four-step test for the assessment of what is often called "excluded matter", as follows:

*Step one: properly construe the claim*

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<sup>1</sup> *Aerotel Ltd v Telco Holdings Ltd and Macrossan's Application* [2006] EWCA Civ 1371, [2007] RPC 7

<sup>2</sup> *Symbian Ltd's Application* [2008] EWCA Civ 1066, [2009] RPC 1

*Step two: identify the actual contribution (although at the application stage this might have to be the alleged contribution)*

*Step three: ask whether it falls solely within the excluded matter*

*Step four: check whether the actual or alleged contribution is actually technical in nature.*

14 Subsequently, the Court of Appeal in *Symbian* made clear that the *Aerotel* test is not intended to provide a departure from the previous requirement set out in case law, namely that the invention must provide a "technical contribution" if it is not to fall within excluded matter. The *Aerotel* test has subsequently been endorsed by the Court of Appeal in its decisions in both *HTC*<sup>3</sup> and *Lantana*<sup>4</sup>.

15 Lewison J (as he then was) in *AT&T/CVON*<sup>5</sup> set out five signposts that he considered to be helpful when considering whether a computer program makes a technical contribution. In *HTC* the signposts were reformulated slightly in light of the decision in *Gemstar*<sup>6</sup>. The signposts are:

*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.*

16 The signposts are merely guidelines; although they provide a useful aid in assessing the technical character of a claimed invention, they were not intended to provide a definitive test (as Lewison LJ's obiter remarks in paragraph 149 of *HTC* make clear). Several judgments have emphasised this point - John Baldwin QC (sitting as a Deputy Judge) in *Really Virtual*<sup>7</sup> noted that the signposts, although useful, are no more than signposts and that there will be some cases in which they are more helpful than in others. Kitchin LJ made similar remarks in paragraph 51 of *HTC* that their usefulness does not mean they will be determinative in every case.

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<sup>3</sup> *HTC Europe Co Ltd v Apple Inc* [2013] RPC 30

<sup>4</sup> *Lantana v Comptroller-General of Patents, Designs and Trade Marks* [2014] EWCA Civ 1463

<sup>5</sup> *AT&T Knowledge Venture/CVON Innovations v Comptroller General of Patents* [2009] EWHC 343 (Pat)

<sup>6</sup> *Gemstar-TV Guide International Inc v Virgin Media Ltd* [2010] RPC 10

<sup>7</sup> *Really Virtual Co Ltd v UK Intellectual Property Office* [2012] EWHC 1086 (Ch)



## Arguments and analysis

- 17 The examiner maintains that the claims define an invention which consists of a business method and/or a program for a computer. His position is set out most recently in his pre-hearing report. Detailed arguments against the examiner's position are contained in the applicant's response to the initial examination opinion and their skeleton arguments, through their attorney. These arguments were elaborated clearly and helpfully at the hearing by Mr Round. Taking all these arguments into account, I must determine whether the claimed invention relates solely to excluded subject matter under section 1(2).

### Step 1: Properly construe the claims

- 18 The first step of the test is to construe the claims. There are six independent method claims all relating to the different aspects of the overall method. I do not think understanding the meaning of the claims presents any real problem and I consider them to be clear. The applicant and the examiner appear to agree as to the meaning of the claims.

### Step 2: Identifying the actual or alleged contribution

- 19 The examiner considers the hardware used in implementing the method of the invention to be conventional i.e. a standard network of user computers, such as smartphones and servers with a data storage means. In the examiner's view the contribution of the independent claims lies in the method of mediating the transfer of cash for electronic account funds plus a fee between two individuals. The method being embodied as an app running on the users' computing devices and the server.
- 20 Mr Round has argued that the contribution lies in an improvement in the field of digital communications technology, which may be applied to the financial technology (FinTech). Mr Round explained that the communications technology is used in FinTech, but that is a contextual point. He considers the underlying technical contribution to exist outside the FinTech context.
- 21 I am not persuaded by Mr Round's argument on this point. In my view, the contribution does not lie outside the FinTech context. Jacob LJ outlined the considerations to be applied when identifying the contribution made by the claims in paragraph 43 of *Aerotel* – the critical factors for the examiner to consider are emphasised:

*“The second step – identify the contribution - is said to be more problematical. How do you assess the contribution? Mr Birss submits the test is workable – it is an exercise in judgment probably involving the problem said to be solved, how the invention works, what its advantages are. What has the inventor really added to human knowledge perhaps best sums up the exercise. The formulation involves looking at substance not form – which is surely what the legislator intended.”*

- 22 To my mind, to frame the contribution in the broad sense as an improvement in the field of digital communications technology does not capture what the inventor in this case has added to human knowledge. The application as a whole, and the

independent claims specifically, describe the invention as solving the problem of obtaining cash when the banks and ATMs are not available. This problem is solved by the banking app on users' smartphones that works by sending messages between smartphones and banking servers. I agree with the examiner that what has been added to human knowledge is a method of transferring funds between users for cash and a fee. To exclude the FinTech context from the contribution results in the contribution being too broad to my mind. Again, I find myself in agreement with the examiner that the contribution is a solution to the problem of getting cash, in the form of an app on the user's smartphone that brokers the exchange of electronic funds for physical cash between two individuals.

- 23 Therefore, I consider the contribution to be a method of mediating the transfer of cash for electronic account funds plus a fee between two individuals, using an app on the users' computing devices and the server.

Steps 3 and 4: Does the contribution fall solely within excluded matter/is it technical in nature?

- 24 What I must now decide is whether the contribution identified above relates solely to a program for a computer as such and/or a method of doing business as such. This corresponds to step three of the *Aerotel* test.

- 25 The fourth step of the test is to check whether the contribution is technical in nature. In paragraph 46 of *Aerotel* it is stated that applying this fourth step may not be necessary because the third step should have covered the question. This is because a contribution which consists solely of excluded matter will not count as being a "technical contribution" and will not, as the fourth step puts it, be "technical in nature". Similarly, a contribution which consists of more than excluded matter will be a "technical contribution" and so will be "technical in nature".

- 26 In this case, the arguments concerning whether the invention is excluded are very much wrapped up with the question of whether the contribution is technical in nature. Given that, I have considered the third and fourth steps together.

*Computer program*

- 27 In this case, it is clear that the arrangement of hardware used to implement the invention is immaterial to the working of the invention. The hardware is all conventional hardware. Given this point, the contribution must therefore be viewed as being embodied purely in a computer program. Whilst the invention undoubtedly uses a computer program for its implementation, the mere fact that the invention is effected in software does not mean that it should be necessarily excluded as a program for a computer as such. What matters is whether or not the program provides a technical contribution.

- 28 The examiner has made reference to the *AT&T/CVON* signposts in his pre-hearing report and Mr Round has discussed each signpost in his skeleton arguments. I agree that it is useful to consider the signposts on this point. In his assessment of the five signposts the examiner determined that the contribution failed to satisfy any of the signposts. To the contrary Mr Round has argued that all five signposts are in fact satisfied by the contribution.

- 29 The first signpost asks whether the claimed technical effect has a technical effect on a process which is carried on outside the computer. The examiner has argued that it is quite clear that this does not happen. The entire system is bounded in a single network of computing devices and has no links or effect on anything external to the network or the method being run. Mr Round argued that “outside the computer” means that the process has some real-world effect distinct from the context of the computer on which it is operating, although the processing itself may be carried out entirely within the computer. He contends that there is a process “carried on outside the computer”. I am not persuaded by this argument. In my view, the contribution concerns a new method of mediating the transfer of cash for electronic account funds plus a fee between two individuals, using an app on the users’ computing devices and the server. This takes place entirely within the computing devices of the requestor and depositor and the application server. As such, there is no process carried on outside the computer. Therefore, in my view the first signpost is not met and points away from there being a technical contribution.
- 30 With regard to the second signpost, the contribution is implemented as a software application on an electronic device. The attorney argues that the contribution does work at the architectural level of the computer irrespective of the data being processed i.e. the available transactees is served to a requesting user computer depending on the physical boundary condition – that is, the receipt of a message (regardless of message content) is restricted based on a physical characteristic. I am not persuaded by this argument and I agree with the examiner that the program does not operate at the level of architecture of the computer. The hardware used in implementing the invention is entirely conventional. The program does not change how the computer runs internally. In practice, this means in the sense of the operation of the processor, the cache memory, or other internal components of the computer. There is nothing that is affected below the application layer of the computer arrangement. In other words, the computer is conventional and runs conventionally. Therefore, the second signpost is not satisfied.
- 31 Both the examiner and the attorney have considered the third and fourth signpost together. The third signpost emphasises that the effect must be more than just the running of a program or application on a general-purpose computer – the computer itself must operate differently than it did before as a result of the program being run. The fourth signpost is approached in a similar way to the third. The computer must operate more efficiently and effectively as a result of running the program.
- 32 The examiner considers the computing devices i.e. the computer devices of the requestor/withdrawer, the receiver/depositor, and the application server, being used are entirely standard and so cannot be considered to operate in a new way, they remain computing devices running an application. In addition, whilst the application itself may be more efficient or reliable there is no effect on how the device operates beyond the normal interaction between an application program and the host device.
- 33 The attorney does not agree with this reasoning, as it would exclude from patentability any computer running an application. Mr Round contends that the computers, running the specific application implementing the invention, bring about the technical effect of enabling, or disabling, the distribution of messages around the system. This makes the computing devices “better computers” in that the distribution of messages around the system enables the personal security of the requestor to be

maintained. Again, I am not persuaded by this argument. I consider the computing devices to be operating in the usual way to perform the instructions of the program in the same way as it would for any program. In my view the third and fourth signposts are not met and point away from there being a technical contribution.

- 34 The fifth and final signpost asks whether the perceived problem is overcome by the claimed invention as opposed to merely being circumvented. In his argument, Mr Round has changed approach and defined the problem to be solved as “how to prevent broadcast of location to potential recipient computing devices while distributing a transaction request” and is of the view that this problem is solved by the invention. I disagree with this definition of the problem sought to be overcome by the invention. The problem sought to be overcome by the invention, as set out in the application as filed and particularly in the independent claims, is how a person can obtain physical cash when an automated teller machine (ATM) is not readily available. The independent claims define a method by which the user can broadcast a request for cash, within a certain broadcast radius, and receive offers from depositors to supply the user with cash for a fee. The contribution overcomes the problem through use of the banking app on the computing devices and the application server.
- 35 The examiner considers the claimed system and method to solve the problem, but as the problem is a business problem, it is not a technical problem, and thus the solution is not a technical one. I’m not entirely convinced that the contribution solves the problem of the availability of ATMs to a user. To my mind, the contribution circumvents the problem by removing the need for an ATM to obtain cash. However, I do agree with the examiner that the problem as I have set out above is a business problem and is thus not a technical problem and thus the solution cannot be considered technical. Therefore, the fifth signpost is not satisfied.
- 36 Looking at the fourth step, as discussed above I do not consider the contribution to be technical in nature.
- 37 Therefore, I consider the contribution identified above to relate to a program for a computer as such.

#### *Business method*

- 38 I have identified the contribution above to be a method of mediating the transfer of cash for electronic account funds plus a fee between two individuals, using an app on the users’ computing devices and the server. The invention clearly has a commercial context as set out in the application in that the user obtains cash for a fee and the effect of the contribution is to eliminate the need for an ATM in obtaining cash. This is achieved through the use of conventional hardware programmed to implement the method through the banking app. In *Merrill Lynch*<sup>8</sup> it was discussed at page 569 that the fact that the method may be an improvement on previous methods is immaterial. The prohibition in section 1(2)(c) is generic and draws no distinction between the method by which the mode of business is achieved. The independent

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<sup>8</sup> *Merrill Lynch’s Application [1989] RPC 561*

claims are directed to a method for obtaining cash for a fee. That is simply a method of doing business.

### **Aerotel's application**

39 During the hearing Mr Round made reference to the decision in *Aerotel* which he considers to have similarities with the present application and highlights the fact that the system in Aerotel's application was allowed.

40 In *Aerotel*, the contribution was considered to rest in a new physical arrangement of hardware which included a "special exchange".

41 Jacob LJ when considering the invention of Aerotel in paragraph 53 of his judgment, considered the then invention to be:

*"more than just a method of doing business as such."*

Considering the contribution of Aerotel's claimed telephone system, he noted that:

*"the [telephone] system as a whole is new. And it is new in itself not merely because it is to be used for the business of selling phone calls."*

Even though the telephone system of Aerotel could have been "implemented using conventional computers" Jacob LJ held that "the contribution is a new [telephone] system" because it was "a new combination of hardware" in the form of a telephone system including a "special exchange".

42 Notably the High Court in *Aerotel Ltd*<sup>9</sup> later found the Aerotel patent to be excluded when this "special exchange" was shown to be conventional but for its particular payment scheme. The Patents Court therefore reassessed the contribution and found that it related to how the special exchange was used and programmed, so that it fell solely within the business method and computer program exclusions. Therefore, when assessing whether a particular invention relates to a new system or a 'new arrangement of hardware', it should be asked whether the system is new in itself or whether the system is only new due to the business method it performs.

43 In this case there is no new physical arrangement of hardware akin to the "special exchange" in *Aerotel*. Even in the absence of a prior art search, I consider it safe to say that computing devices communicating with each via an application server is not new. Therefore, as in *Aerotel Ltd*, the system may only be new due to the business method it performs through the computer program in the form of the banking app. And as a result, the contribution is also considered to fall solely within the business method and computer program exclusions.

### **Dependent claims**

44 Mr Round highlighted dependent claim 5 which he considers to add further technical features to define the invention as a patentable invention should I find the independent claims to be excluded. Dependent claim 5 reads as follows:

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<sup>9</sup> *Aerotel Ltd v Wavecrest Group Enterprises Ltd & Ors* [2008] EWHC 1180 (Pat)

5. *The method of any of claims 1-4, wherein the depositor computing device is located beyond visual range and auditory range of the withdrawer computing device.*

- 45 Mr Round explained that claim 5 provides additional context to the technical contribution by defining the boundary condition, defined by the maximum broadcast radius, is greater than the visual range and auditory range of the withdrawer computing device i.e. provides means of obtaining connection between the withdrawer device and a depositor device beyond the physical communication scope of the human parties. Mr Round argues that the technical contribution of claim 5 relates to the ability of the devices to provide a reliable exchange of information to enable a physical cash transaction to be brought into effect.
- 46 A solution cannot take technical character from a problem, if the problem to be solved is not a technical problem, although it may have some other technical effect. As discussed above the problem to be solved is considered to be a business problem which is not a technical problem. To my mind, the contribution added by claim 5 is akin to setting a minimum distance the depositor computing device is located from the withdrawer computing device and does not appear to have a bearing on the set maximum broadcast radius. Setting parameters for the method of obtaining cash in the banking app is not considered to be technical or give rise to any other technical effect.
- 47 Therefore, I do not consider the inclusion of the features of claim 5 would take the contribution outside the business method and computer program exclusions.

### **Conclusion**

- 48 I find that the claimed invention is excluded under section 1(2)(c) as a program for a computer as such and as a business method as such. I therefore refuse the application under section 18(3) as failing to comply with section 1(2).

### **Appeal**

- 49 Any appeal must be lodged within 28 days after the date of this decision.

**C.L. Davies**

Deputy Director, acting for the Comptroller