



PATENTS ACT 1977

PARTIES	Geo-Pro-Teq IP Pty Ltd
ISSUE	Whether patent application GB 1915720.5 complies with Section 1(2) of the Patents Act 1977
HEARING OFFICER	Ben Buchanan

DECISION

Background

- 1 This decision relates to whether patent application GB 1915720.5 complies with Section 1(2) of the Patents Act 1977 ("the Act").
- 2 The application is the national phase, published as GB 2575400 A, of a PCT application filed on 29 March 2018. The PCT application was originally published as WO 2018/176100 A1 and has an earliest priority date of 31 March 2017.
- 3 The first examination report on this application was largely confined to the issue of patentability, with the examiner objecting that it was excluded under Section 1(2)(c) of the Act. Despite amendment of the application, the examiner maintained the patentability objection in a further examination report. The examiner also suggested the applicant request a hearing to resolve the issue, which the applicant duly did.
- 4 Accordingly, the matter came before me for a hearing on 21 September 2022 at which the applicant was represented by their attorney Bruce Dearling of Hepworth Browne.
- 5 Skeleton arguments were helpfully provided by the attorney in advance of the hearing. Three sets of amended claims were filed to accompany the skeleton arguments, the three sets comprising a main request and first and second auxiliary requests. In particular, I would like to thank the attorney for the figure references aiding construction of the amendments and for their thorough and candid review of the relevant law.
- 6 The only matter which falls to be decided is whether or not the invention is excluded under Section 1(2) as being a method for playing a game, a method for doing business and/or a program for a computer.

Subject matter

- 7 The application relates to a system for identifying problem gamblers and controlling access of an identified problem gambler to gaming systems. In this context a “problem gambler” is deemed to be one whose gambling habits could significantly harm their wellbeing, for example by their being unable to stop gambling when losses become unaffordable. In particular, the system takes data from different gaming systems, identifies corresponding user data from the different gaming systems and combines this data to determine whether the user is a problem gambler. If the user is identified as a problem gambler, then access to the gaming systems is selectively disabled. The main process steps are illustrated by flowcharts in figures 9 and 12 of the application (reproduced below).

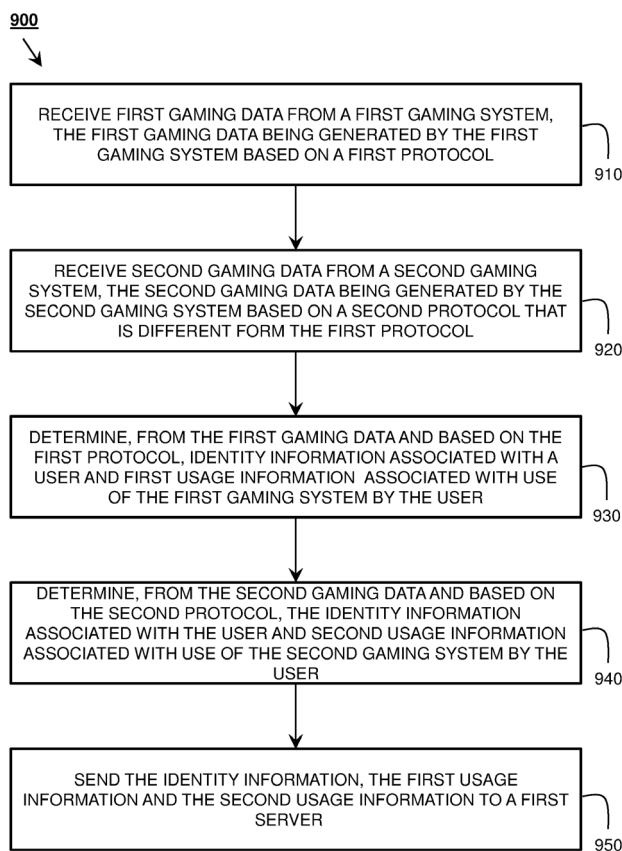


Fig. 9

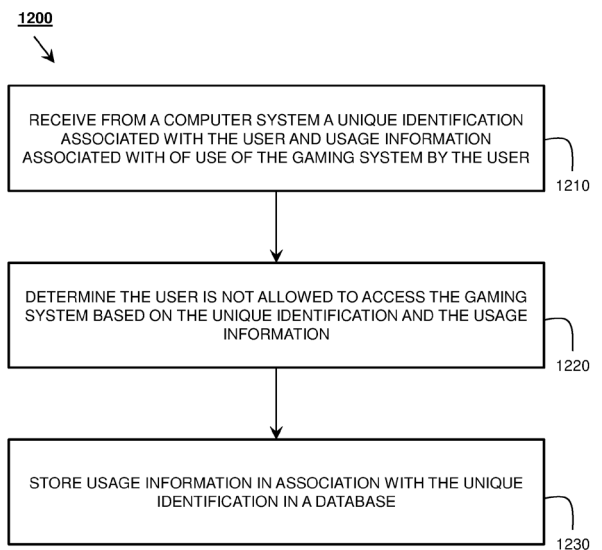


Fig. 12

8

The law

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

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

...

(c) a scheme, rule, or method for performing a mental act, playing a game or doing business, or a program for a computer;

...

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.

- 10 The assessment of patentability under Section 1(2) is governed by the judgment of the Court of Appeal in *Aerotel*¹, as further interpreted by the Court of Appeal in *Symbian*². In *Aerotel* the court reviewed the case law on the interpretation of Section 1(2) and set out a four-step test to decide whether a claimed invention is patentable:

(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.

- 11 The Court of Appeal in *Symbian* made it clear that the four-step test in *Aerotel* was not intended to be a new departure in domestic law; it was confirmed that the test is consistent with the previous requirement set out in case law that the invention must provide a “technical contribution”. Paragraph 46 of *Aerotel* states that applying the fourth step of the test may not be necessary because the third step should have covered the question of whether the contribution is technical in nature. It was further confirmed in *Symbian* that the question of whether the invention makes a technical contribution can take place at step 3 or 4.

- 12 Lewison J (as he then was) in *AT&T/CVON*³ set out five signposts that he considered to be helpful when considering whether a computer program makes a technical contribution. In *HTC/Apple*⁴ the signposts were reformulated slightly in light of the decision in *Gemstar*⁵. 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

¹ *Aerotel Ltd v Telco Holdings Ltd & Ors Rev 1* [2007] RPC 7

² *Symbian Ltd v Comptroller General of Patents* [2009] RPC 1

³ *AT&T Knowledge Ventures/CVON Innovations v Comptroller General of Patents* [2009] EWHC 343 (Pat)

⁴ *HTC v Apple* [2013] EWCA Civ 451

⁵ *Gemstar-TV Guide International Inc v Virgin Media Ltd* [2010] RPC 10

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.

Application of the Aerotel approach

Step (1): Properly construe the claim

- 13 The latest claims are those filed with the attorney's skeleton arguments on 13 September. There are two independent claims, claim 1 to a computer system and claim 4 to a computer implemented method. Aside from peripheral details of the computer system, e.g. memory, processor and interfaces, the claims are otherwise essentially identical and they can be treated as having the same effective scope. Claim 1 of the main request reads as follows (underlining indicates the only amendment made to the claims from those previously submitted which were the subject of the most recent examination report):

1. A computer system for processing gaming data from two or more gaming systems and controlling gaming use on at least one of said gaming systems, the computer system comprising:

a memory device configured to store machine-readable instructions;

a processor connected to the memory device; and

a first communication interface connected to the processor and configured to connect to a first gaming system; and

a second communication interface connected to the processor and configured to connect to a second gaming system that is different from the first gaming system;

a third communication interface connected to the processor and configured to connect to a first server;

wherein the processor obtains the machine-readable instructions from the memory device and is configured by the machine-readable instructions to:

receive, via the first communication interface, first gaming data from the first gaming system, the first gaming data being generated by the first gaming system based on a first gaming protocol;

receive, via the second communication interface, second gaming data from the second gaming system, the second gaming data being generated by the second gaming system based on a second gaming protocol that is different from the first gaming protocol;

determine, from the first gaming data and based on the first gaming protocol, identity information associated with a user and first usage information associated with use of the first gaming system by the user;

determine, from the second gaming data and based on the second gaming protocol, the identity information associated with the user and second usage information associated with use of the second gaming system by the user;

send the identity information, the first usage information and the second usage information to the first server via the third communication interface for use in determining if the user is a problem gambler;

receive an instruction from the first server; and

in response to the instruction, cause the first gaming system or the second gaming system not to be used by the user for gaming if the user is determined to be a problem gambler.

- 14 Despite the length of the claim, it is considered to be straightforward to construe. Note that the very last part of the claim “*if the user is determined to be a problem gambler*” relates to the system determining that the user is a problem gambler and is not referring to the user resolutely being a problem gambler.
- 15 In summary, the claim requires a computer system having memory, a processor and three communication interfaces, two for communicating with first and second gaming systems and the third for communicating with a server. The processor is configured to receive gaming data from the first and second gaming systems, the data from each having different protocols, from which the processor resolves to extract data relating to the identity of the user and their use of the respective gaming system. This information is sent to the server which determines if the user is a problem gambler, and if they are then access to the first and/or second gaming system is blocked for the user.
- 16 Claims 1 and 4 of the first auxiliary request are significantly amended. Claim 1 now reads as follows (with reference numerals omitted):
1. *A computer based gaming environment for processing gaming data, the computer-based gaming environment comprising:*
 - a first gaming system and a second gaming system independently operable from and different to the first gaming system;*
 - a stub appliance in communication with the first gaming system and the second gaming system, where the stub appliance includes:*
 - a memory device configured to store machine readable instructions;*
 - a processor connected to the memory device; and*
 - a first communication interface connected to the processor and configured to connect to the first gaming system;*

a second communication interface connected to the processor and configured to connect to the second gaming system;
a third communication interface connected to the processor;
a first server coupled to and in communication with the stub appliance through its third communication interface;

wherein the processor of the stub appliance through its third communication interface executes the machine readable instructions from the memory device and thereby is configured to

receive, via the first communication interface, first gaming data from the first gaming system, the first gaming data generated by the first gaming system based on a first gaming protocol;

receive, via the second communication interface, second gaming data from the second gaming system, the second gaming data being generated by the second gaming system based on a second gaming protocol that is different from the first gaming protocol;

determine, from the first gaming data and based on the first gaming protocol, identity information associated with a first user and first usage information associated with use of the first gaming system by the first user;

determine, from the second gaming data and based on the second gaming protocol, second identity information associated with a second user and second usage information associated with use of the second gaming system by the second user, and to determine whether the second identity information is the same as the first identity information, thereby to establish whether use of the second gaming system is by a common user;

send said identity information, the first usage information and the second usage information to the first server via the third communication interface, whereafter, for the common user,

the first server is configured:

to determine, based on usage information reported to the first server, whether use by or behaviour of the common user with respect to the second gaming system and the first gaming system is indicative of a problem gambler, and

to generate and send an instruction to this effect; and

in response to receipt of the instruction at the stub appliance, control operation of the first gaming system or the second gaming system by disabling use thereof by the common user for gaming if the user is determined to be said problem gambler.

- 17 Claim 4 of the first auxiliary request is amended in a similar manner albeit it is directed to a computer implemented method and lacks the physical features of the environment (memory, processor, etc.).
- 18 There was some discussion at the hearing regarding the construction of the claims of the first auxiliary request. As these claims were submitted with the skeleton arguments just prior to the hearing, they have not been formally examined. Nevertheless, in order to construe them it is necessary to understand the derivation of the features of the claims. One feature, in particular, stood out as lacking direct support in the original application and that was the step of determining “*whether the second identity information is the same as the first identity information*” as follows:

determine, from the second gaming data and based on the second gaming protocol, second identity information associated with a second user and second usage information associated with use of the second gaming system by the second user, and to determine whether the second identity information is the same as the first identity information, thereby to establish whether use of the second gaming system is by a common user;

- 19 At the hearing the attorney identified paragraph [81] of the description as providing support for this feature, in particular the final two sentences which read:

Usage information, particularly, the first usage information and the second usage information, reflects the behaviours of the user across gaming systems that may be operated by different operators, which can be used to determine if the user is a problem gambler. This way the stub server 120 is able to monitor behaviours of the same user across different gaming systems.

- 20 Although this passage does not explicitly set out a step of determining whether the first and second identity information is the same, I am happy to accept that it is implicit that, in order to build up a picture of whether or not any particular user is a problem gambler, the system must extract identity information from the different gaming systems, and, where that identify information reflects a unique user, the gaming behaviour of that user across the different gaming systems is aggregated. This latter step is reflected in the subsequent part of the claim which specifies sending the identity information, the first usage information and the second usage information to the server. The next part of the claim then sets out that the server analyses this aggregated information to determine whether or not the user is a problem gambler.
- 21 The final part of the claim deals with disabling access to at least one of the gaming systems if the user is determined to be a problem gambler. This is understood to be a general restriction so that any time a previously identified problem gambler subsequently attempts to access the gaming system they will be prevented from doing so. For example, a blocklist may be created to deny access to a gaming system for a user previously identified as a problem gambler (see paragraph [86] of the application). In other words, there is no requirement to re-assess or re-determine whether a user is a problem gambler every time they attempt to access a gaming system.

- 22 These parts of the claim have been construed as set out above. The preceding parts of the claim are considered straight forward to construe, noting that the stub appliance is essentially a label for identifying that the processor, memory and communication interfaces are part of a single computing device.
- 23 In summary, the claim requires a system having a computing device comprising a memory, a processor and three communication interfaces, two for communicating with first and second gaming systems and the third for communicating with a server. The processor is configured to receive gaming data from the first and second gaming systems, the data from each having different protocols, from which the processor resolves to extract data relating to the identity of a user and their use of the respective gaming systems. The processor then determines if the identity of the user is the same for both the first and second user. Where the identity of the user is the same, that common identify and the information on their use of both gaming systems is sent to the first server where it is analysed to determine if that use is indicative of the user being a problem gambler. If the user is identified as a problem gambler, then the server reports this to the computing device which blocks the user from using at least one of the gaming systems.
- 24 Claim 1 of the second auxiliary request is largely identical to claim 1 of the first auxiliary request, save that the final part of the claim is amended as follows (additions shown by underlining, deletions by strikethrough):

in response to receipt of the instruction at the stub appliance, ~~control~~ cause operation of the first gaming system or the second gaming system by selectively to be disabled ~~ing use thereof by~~ for the common user for gaming ~~if~~ when the user is ~~determined~~ identified by the instruction to be ~~said~~ the problem gambler.

- 25 The changes to claim 1 of the second auxiliary request are not considered to affect the scope of the claim, nor its construction. The amendments appear to be clarifying in nature. For the most part they make it clear that disabling of the gaming system is based on the instruction and does not require a new determination.
- 26 The other change made in the second auxiliary request is the deletion of the independent method of claim 4 and claims dependant thereon. The attorney appeared to be under the misapprehension that the method claim would be more likely to fall within the scope of the exclusions of Section 1(2)(c) than the equivalent system of claim 1. However, as a matter of substance over form, the precise nature of the claim is largely immaterial provided the contribution remains the same, for it is that which is determinative.
- 27 In accordance with the attorney's request, I will consider first whether the claims of the main request are excluded. If I find the main request to be excluded, I will go on to consider the first and second auxiliary requests.

Step (2): Identify the actual or alleged contribution

- 28 Guidance on how to identify the contribution is given in paragraph 43 of *Aerotel*, where the court accepted the proposition that identifying the contribution 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.”

29 The examiner identifies the contribution as follows:

“A computer implemented method for processing gaming data from two or more gaming systems comprising determining identity information associated with a user and associated usage information from the data received from first and second gaming systems and generated by first and second gaming protocols; communicating said data to a first server such that the system may determine whether the user is a problem gambler; and responsive to a determination that the user is a problem gambler preventing the user from using the first or second gaming system.”

30 This contribution is based on the previously submitted claims. I did not understand the attorney to disagree with this contribution, save that it ought to be amended to take account of the amendments made to the claims of the main request.

31 At the hearing the attorney made the point a number of times that the invention was about carrying out a risk assessment to minimise harm to a user. Although there is no explicit mention in the application about risk assessment, I consider it implicit that in order to determine if a user is a problem gambler for minimising harm, then that must be conducted by a risk assessment. Minimising harm seems to be an important part of the *problem to be solved by the invention* and the risk assessment is part of *how the invention works*. I therefore consider that they form part of the contribution.

32 My formulation of the contribution of the claims of the main request is accordingly (underlying indicating changes from the contribution put forward by the examiner):

“A computer implemented method for processing gaming data from two or more gaming systems for controlling access to at least one of said gaming systems, comprising determining identity information associated with a user and associated usage information from the data received from first and second gaming systems and generated by first and second gaming protocols; communicating said data to a first server such that the system may carry out a risk assessment to determine whether the user is a problem gambler; and responsive to a determination that the user is a problem gambler preventing the user from using the first or second gaming system to minimise harm to the user.”

33 The attorney has not specified what they consider the contribution is for the first (or second) auxiliary request. Nor was this covered at the hearing.

34 I consider the contribution for the first auxiliary request to be largely the same as that for the main request but additionally including the step of identifying a common user and aggregating the usage data for that common user. The contribution is therefore assessed as:

“A computer implemented method for processing gaming data from two or more gaming systems for controlling access to at least one of said gaming systems, comprising receiving first and second gaming data from first and second gaming systems, the gaming data being generated by first and second gaming protocols; determining first and second identity information from the first and second gaming data and associated first and second usage information; where the first and second identity information relate to a common user, aggregating the usage information for the common user and carrying out a risk assessment of the aggregated usage information to determine whether the common user is a problem gambler; and responsive to a determination that the common user is a problem gambler preventing them from using the first or second gaming system to minimise harm to the common user.”

- 35 I have previously identified that claim 1 of the second auxiliary request contains only clarifying amendments over claim 1 of the first auxiliary request, and that they have the same effective scope. The contribution of the invention of the second auxiliary request is therefore the same as the contribution of the first auxiliary request.

Steps (3) & (4): Does the contribution fall solely within excluded subject matter; check if the contribution is actually technical.

- 36 The third and fourth steps of the *Aerotel* test involve considering whether the contribution falls solely within excluded categories, and then checking whether the contribution is technical in nature. It is appropriate to consider these two steps together because whether the contribution is technical in nature will have a direct impact on whether it falls solely within excluded matter.
- 37 Although the invention is implemented using a computer program running on a network of computers (a collaboration between disparate systems and disparate protocols as the attorney put it in the hearing), that does not mean that it should immediately be excluded as a computer program as such. In *Symbian*, the Court of Appeal stated that a computer program may not be excluded if it makes a technical contribution.
- 38 At the outset I should point out that, as I said at the hearing, I do not consider that the application relates to a scheme, rule or method for playing a game. No consideration is taken of the nature of a particular game or its rules, nor is the game itself changed in any way. Consequently I shall not consider this category of exclusion further.
- 39 The main argument put forward by the attorney in relation to the patentability of the application was to refer to the High Court decision in *Protecting Kids the World Over (PKTWO)*⁶.
- 40 The application in *PKTWO* was directed to a system for monitoring internet access and to generating a warning to a third party at a remote terminal, e.g. a mobile phone, if inappropriate content was being viewed. In *PKTWO*, the judge allowed the

⁶ *Protecting Kids the World Over (PKTWO) Ltd's Application* [2011] EWHC 2720 (Pat)

application on the basis that there was a technical effect relating to the generation of the message at the remote terminal. The judge said at paragraph 34 of the decision:

I am unable to accept these submissions. I start with the proposition that the generation and transmission of an alert notification to the user/administrator is not a relevant technical process. I accept that in many cases this may be correct. Plainly it was correct in the case of two out of the three patents considered by Mann J in Gemstar, where information was simply displayed on a screen. But what is in play in the present case, namely an alarm alerting the user, at a remote terminal such as a mobile device, to the fact that inappropriate content is being processed within the computer, is in my judgement qualitatively different. First of all, the concept, although relating to the content of electronic communications, is undoubtedly a physical one rather than an abstract one. In that respect it was more akin to the third of the three patents considered by Mann J in Gemstar. Secondly, the contribution of claim 33 does not simply produce a different display, or merely rely on the output of the computer and its effect on the user. The effect here, viewed as a whole, is an improved monitoring of the content of electronic communications. The monitoring is said to be technically superior to that produced by the prior art.

- 41 The attorney argued that the present application is analogous to the invention in *PKTWO* and there is a similar technical effect. In particular, the attorney argued:

*The invention as presently claimed is directly analogous to the permissible subject-matter in Protecting Kids The World Over since the invention describes an interaction between system components and the sending of a message from a server, based on an assessment, to one or other gaming systems to control user access in response to (a) a determined common user identity; and (b) determined prior and attempted activity of that identified user on a different gaming platform. In fact, in *PKTWO*, the system assessed online activity and then generated a message report to the parent based on perceived harm, whereas the presently claimed invention further forces a change in the operational state of one or more independent systems based on an assessment of common user identity and historically assessed activity of that user. The presently claimed invention does not therefore relate to a computer program as such, nor is the invention a “scheme, rule or method of playing a game as such.” Rather, the system provides control of independent system components and, indeed, an applied curtailment of overall system operation based on an assessment and generation of a control message communicated between a server and different first and second gaming systems.*

- 42 I note that the attorney is equating the computer instruction sent from the server to the first or second gaming machines of the present application with the “alarm” message sent to a remote terminal in *PKTWO*, and referring to this instruction as a message in their argument.
- 43 It is equally clear from paragraph 34 of *PKTWO* quoted above, that the technical effect was due in part to the warning being physical rather than abstract, even though it was an electronic communication.

- 44 In my opinion, a computer *instruction* to enable or disable access does not possess the same level of physicality as the “alarm” message of *PKTWO*. The access control means for enabling or disabling access merely acts upon the instruction. It is the determination of “problem gambler” status and the generation of the instruction which has been added. I do not think, unlike in *PKTWO*, that the instruction derived from the determination of a problem gambler, on the basis of which access may be subsequently controlled, is therefore necessarily physical. It seems to me to be the type of message which might be characterised as an abstract electronic communication, or which is at least more akin to the two *Gemstar* cases referred to where information was displayed on a screen. Furthermore, these instructions are considered to be integral with and wholly part of the computer program. This may be contrasted with the situation in *PKTWO* where it is the display of the message to a third party which is considered to give the message its physical characteristic. Accordingly, I do not agree that a “message”, in the form of computer instructions, sent to the first or second gaming system provides a technical effect which takes the invention outside the exclusions of Section 1(2)(c).
- 45 Although there are additional similarities between this application and *PKTWO*, I do not consider that they help the applicant as they were not part of the reasoning which led to *PKTWO* being found allowable.
- 46 For example, the attorney was keen to stress that in *PKTWO* a risk assessment was being carried out to determine if the Internet content being viewed might be harmful to the user. That correlates with the risk assessment and minimisation of harm featured within the current application, and the attorney’s view was that the assessment of risk was technical. However, I do not consider that this represents the required technical effect to remove the application from the exclusions. The reasoning in *PKTWO*, as set out in paragraph 34 of the judgment, is based on the physical nature of the message and the improved monitoring of the content of electronic communications. There is no suggestion in the reasons given that the risk assessment itself provides the technical effect. Indeed, the judgment in *PKTWO* contrasts the improved monitoring with a contribution that “*merely relies on the output of the computer and its effect on the user*”. That characterisation appears to match the contribution of the current invention whereby it is the denial of access to the gaming system which minimises any harm.
- 47 The attorney also argued that there was a further technical step in the present application over and above that in *PKTWO*, namely the disabling of access to the gaming system. I think this argument was suggesting that “access control” is technical. This is immaterial to the comparison and as I have noted above, the access control means itself merely acts upon the instruction. The contribution reflects the problem of dissuading problem gamblers, by determining that a user is a problem gambler and instructing an access control means accordingly. There is no “better control means” per se. The present application lacks the physical message of *PKTWO*. Whatever is added by the instruction to selectively disable access is part of the computer program *as such*, and is not a technical contribution. The step of subsequently causing or controlling access dependent upon the instruction does not change this.
- 48 In order to further determine if the contribution is technical in nature I will consider the *AT&T* signposts.

49 I need only consider the first and fifth signposts. At the hearing the attorney agreed that the second to fourth signposts, often referred to as the “better computer” signposts, were not relevant to the invention. The attorney’s arguments are based on the system being a better system overall rather than any of the computing devices which make up the system being better computers as such.

First signpost – whether the claimed technical effect has a technical effect on a process which is carried on outside the computer

50 The attorney argued at the hearing that there was an effect outside the computer on several grounds:

- i) The contribution involves causing the first or second gaming systems to disable access for a problem gambler. The first or second gaming systems were said to be *outside the computer*.
- ii) Furthermore, this effect of controlling access was said to be *technical* because it does not relate to playing a game per se, nor is it a business method in the sense that it is not a purely administrative procedure.
- iii) The attorney also suggested that the assessment of risk to the individual could also be categorised as *technical* and the consequent minimisation of harm was outside the computer.

51 I consider that the computer, for the purposes of assessing this signpost, is the entire computer system including the first and second gaming systems, the stub appliance and the first server. This is consistent with the comments of Birrs J in *Lantana*⁷. The invention in *Lantana* related to a method for sending files from a remote computer to a local computer, in which the files are requested by sending an email including instructions for which files are required. The remote computer replies to the email with the requested files. This invention was found to be excluded (and this decision was upheld on appeal). At paragraph 30-31 Birrs J stated:

30. *I start by noting that this invention consists entirely of software running on a conventional computing arrangement. I use the term "computing arrangement" rather than computer because the applicant is at pains to point out that this system requires two computers connected by a "telecommunications network". So it does but at the relevant date (2008) two computers connected across the internet was an entirely conventional computing arrangement. The fact that two computers and the internet are required is not what makes a software invention patentable.*

31. *The invention here is therefore in the tricky territory I identified in Halliburton (paragraph 37) because everything is going on inside the computer, or rather inside the computing arrangement. Thus the first signpost cannot assist the applicant.*

52 Accordingly, the various computers and the gaming systems of the present invention are considered to define a single *computing arrangement* and any effects of the first and second gaming systems do not represent effects carried on outside the

⁷ *Lantana Ltd v Comptroller-General* [2013] EWHC 2673 (Pat) – upheld on appeal.

computer as specified by the first signpost. In common with the decision in *Lantana*, the first signpost does not assist the applicant.

53 Paragraphs 32 and 33 of the *Lantana* judgment are also considered relevant to the patentability of the current application. These paragraphs read as follows:

32. *I will consider the four effects relied on. The first one is no more than the fact that the invention involves communication between two computers over the internet. This cannot help. At the priority date in 2008 (as today) this was entirely conventional and cannot form part of anything contributed by the invention. The same goes for the third effect, that files or information are transferred from one computer to another over a telecommunications network.*

33. *The second effect is that one computer remotely controls another. I do not accept this as a fair characterisation of what is going on. If one computer really was exercising control over another in some way that might be a genuine technical contribution but all that is happening here is one computer is sending an email message to another. That is not control at all. The first email message includes machine readable instructions directed to the remote computer. But this is not something these inventors have contributed to the art at all. Conventional examples of emails which include code which can be executed by the computer receiving the message were mentioned at the hearing. An example can be found in figure 5 of one of the cited prior art documents (US Application 2006/0059129 A1). Mr Beresford submitted that this conflicted with the acceptance by the examiner that the claim was novel and non-obvious. I do not agree. Those matters apply to the claim as a whole, that is to say the entire combination of features. The point here is a different one, i.e. that the idea of an email message containing machine readable instructions as a contribution to the art in this case is wrong. The computers in the claim are not operating in a new way and the third signpost does not assist the applicant.*

54 The attorney has emphasised in the amendments made to the claims and in the corresponding arguments that the system of the invention *controls* the gaming systems. For example, the amendment made to the main request and reflected as controlling access in the contribution specifies controlling gaming use on at least one of said gaming systems. Similarly, one of the amendments to claim 1 of the first auxiliary request is to require that the system controls operation of the first gaming system or the second gaming system.

55 However, in my opinion, some of these arguments go too far and do not accurately reflect the invention. At paragraph 7 of the skeleton arguments, the attorney suggests that “*the change in system operation is forced on one of more of the gaming systems*”. Referring to the description at paragraph [102] and Figure 2 of the specification, the stub appliance receives an instruction based on the details of a problem gambler and controls access to one or more of the gaming systems accordingly. The gaming systems themselves continue to operate, but the specific problem gambler is prevented from accessing them. Suggesting that a change in system operation is forced upon the gaming system does not reflect the disclosure of the application. I do not understand the invention to force the gaming systems to do anything and *force* is not used in the application.

- 56 The sending of the message or computer instruction is conventional. There is therefore no *remote control* of the gaming systems as a consequence of the contribution and no effect outside the computer on this basis either. Although the contribution specifies “controlling access to at least one of said gaming systems” this is not achieved by direct control of the gaming systems, but rather by the provision of a specific instruction on which the processor of the stub appliance acts. It is the particular determination of the “problem gambler” status, and generation of the instruction which has been added; all of which takes place within the computer and is thus not inherently technical.
- 57 The attorney also argued that there was a technical effect by virtue of there being a fundamental change in the operation of the system as a whole, based on the disabling of access to at least one of the gaming systems. However, in line with my reasoning above, I do not consider that this can be characterised as an effect outside the computer system taken as a whole. The gaming systems are part of the computer system and any effect on them is not outside *the computer*.
- 58 The issue of the minimisation of harm to the individual was also raised as an effect outside the computer, but the first *AT&T* signpost requires a *technical* effect outside the computer. I do not consider that the minimisation of harm is a technical effect. It is a consequence of an administrative decision that a gambler is a problem gambler. I will say that whilst the prevention of financial harm, and possibly related wellbeing, is commendable, I regret that it is not an indication of patentability.
- 59 Whether or not someone should be identified as a problem gambler and barred from accessing gaming resources seems to me to be an administrative process. Although the parsing and aggregation of data from multiple sources enables a thorough theoretical determination of whether or not someone is a problem gambler, it is essentially representative of an administrative (or business) decision. The attorney referred to the process being more than the mere automation of an existing business process, and that is no doubt true, but that is chiefly because the computerisation enables a large amount of administrative data to be aggregated and analysed in an allegedly new way. That is still not enough to provide any technical effect (as that is what computers do) which would take the invention outside the exclusions. What results is a new business process. If there is an effect outside the computer, then I consider such an effect is administrative and so also lies in an excluded field such that it cannot be characterised as technical.
- 60 At paragraph 35 of the skeleton arguments the attorney argues:

35. Nor can the invention, objectively, be considered to be a business method as such. The claims are not automating a conventional administrative process. The claims also do not relate to a process of “doing business”. In fact, there are negative commercial reasons for implementing the invention to control overall operation of a multi-component gaming environment that spans different gaming systems operating different protocols. The invention provides an ability for complementary inter-operability [which has not been considered by the examination report]. The Examiner’s allegation in section 24 thus shows, with respect, a bias and closed mindedness to what is or is not “commercial or regulatory in nature”, and the invention relates to a better business method in exactly the same way as the permissible claims in PKTWO does not. In other

words, the existence of a new messaging scheme based on evaluated data is sufficient to place the invention outside the limited “as such” exclusion.

- 61 I think aspects of this argument are further examples of the attorney mischaracterising aspects of the invention. I do not consider that the invention itself provides any form of inter-operability between the gaming systems, and there is certainly no control of overall operation of either of the gaming systems. As clarified in claim 1 of the first auxiliary request, the first and second gaming systems are independent.
- 62 Nevertheless, I think the point the attorney was making is that there are negative commercial reasons for implementing a player welfare control system which is coordinated across different gaming systems. There is no doubt an element of truth in this point, and it commendably exceeds current regulatory requirements for player welfare. Ultimately however, I do not consider that just because it may be a counter-profitable business method it should escape the business method exclusion. There may still be sound commercial reasons for disabling access for problem gamblers. For example, temporarily disabling access (until such time as the historical record no longer shows a user to be a problem gambler) may be more preferable for a gaming company than the user deleting their account. I do not see as a general point that a business method ceases to be a business method simply because it is not commercially favourable or even sensible.
- 63 I do agree with the attorney’s point raised at paragraph 36 of the skeleton arguments and at the hearing, that the decision in *Oneida*⁸ is not of relevance. The invention in *Oneida* was directed to apparatus for carrying out a wagering activity, i.e. a specific gaming implementation, and gaming was identified as a specific type of business. *Oneida* was refused as being a business method as such and a computer program as such. The present application does not relate to gaming per se. Nevertheless, it is still considered to be a business method relating to the administration of gaming activities.
- 64 It was also pointed out that the invention was not tied to changes in gaming laws – as was at least partly the case in *Oneida*. Although the attorney suggested that this meant that the invention involves technical choices, I do not agree that is necessarily the case. Whilst gaming laws may dictate changes in gaming systems, they do not preclude other changes being made. Such other changes may not be in the best interests of profitability but that does not necessarily confer any technicality on them. As I have stated above, just because the invention could be considered to be a counter-intuitive business practice, that does not mean it is not a business method.
- 65 I do not consider there is any technical effect outside *the computer* that would satisfy this signpost. The gaming systems are a part of the computer as a whole, following the reasoning of *Lantana*. Access is controlled based on a determination of a user being a “problem gambler”. This is not a technical determination, being an administrative decision on the basis of past gaming behaviour. In this instance the access control is not inherently technical. Finally, the assessment of risk is an administrative process and the consequential minimisation of harm is not technical.

⁸ *Oneida Indian Nation* [2007] EWHC 954 (Pat)

None of these characteristics therefore provide an external technical effect. The first signpost does not point to the invention being patentable.

Fifth signpost - whether the perceived problem is overcome by the claimed invention as opposed to merely being circumvented

- 66 In order to meet the fifth signpost the problem must surely be a technical problem. An invention which overcomes such a technical problem is considered to have a technical character derived from the technical nature of the problem (per Birss J in *Lantana*).
- 67 The problem in this case is considered to be reducing the risk of harm to problem gamblers. This problem is an administrative issue. Whilst the invention solves this problem by identifying and preventing them from accessing a gaming system, it does not derive any technical character from it because it is not a technical problem.
- 68 There is not considered to be any technical problem which the invention overcomes and this signpost is also of no help to the applicant.
- 69 Since I can find no technical effect in the contribution of claim 1, the invention is considered to be nothing more than a program for a computer and a method for doing business as such. Accordingly, it falls within the categories defined in Section 1(2)(c) of the Act and is excluded from patentability.

First and second auxiliary requests

- 70 So far I have fully considered only the contribution identified in the main request. I will now go on to consider the contribution of the first and second auxiliary requests, bearing in mind I have previously found that the contribution of these requests is the same.
- 71 The principal difference between the contribution of the main request and that of the auxiliary requests is in the way the identity information of the gaming data is compared to extract usage data relating to a common user, which is then aggregated and analysed at the first server.
- 72 I do not see that there is anything in this difference that points to a technical effect. It is just another differently defined way of collecting the relevant data, i.e. a part of the computer program. As with the contribution of the main request, any aspects of the contribution which are not a computer program as such fall within the business method exclusion as being administrative actions.
- 73 In relation to the signposts, the contribution of the auxiliary requests does not involve any effect outside *the computer*, nor does it provide a solution to a technical problem.
- 74 In summary, the contribution of the auxiliary requests also lacks a technical effect. The inventions as claimed in the first and second auxiliary requests are also considered to be excluded as nothing more than a program for a computer and a method for doing business as such, and they therefore fall within the exclusions of Section 1(2)(c) of the Act

Other matters

- 75 In the skeleton arguments, and at the hearing, the attorney drew my attention to an equivalent New Zealand patent application 758638 which has now been granted with substantially similar claims. Whilst interesting, this is (as the attorney, to their credit, acknowledged) not binding on me. It is not appropriate for me to consider the examiner's rationale on the equivalent application, but for the reasons set out herein, I am of the opinion that the present application does not meet the requirements of the Act.

Conclusion

- 76 Since the invention fails to comply with Section 1(2)(c) of the Act because it is a method for doing business and a program for a computer as such, the application is refused under Section 18 of the Act.

Appeal

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

Ben Buchanan