

**PATENTS ACT 1977**

APPLICANT Sony Interactive Entertainment Inc.

ISSUE Whether patent application GB1804476.8  
complies with sections 1(1)(b) and 1(2)(c)

HEARING OFFICER H Jones

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**DECISION**

**Introduction**

- 1 This decision is concerned with the questions of whether patent application GB1804476.8 relates to excluded matter and whether it is inventive. 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 examiner also objected to novelty and inventive step, and although some objections have been dropped following several rounds of amendments and arguments, he still maintains inventive step objections against all of the claims.
- 2 Despite movement on novelty and inventive step, the objections and arguments in relation to whether the invention is excluded as a computer program have not materially changed during the examination process, so the examiner offered the applicant an opportunity to be heard. The applicant has not requested a hearing, nevertheless the application has come to me for a decision based on the arguments already on file in accordance with Office practice.

**The invention**

- 3 Users of video games who only have a limited amount of time available will still wish to have a fulfilling gaming experience across a broad range of games. The invention addresses this with a method or apparatus to search for videogame activities with a goal which should be achievable within a selected period of time. The starting point need not be the start of a game but could instead be based on a current game state extracted from a save file. The time to the goal from the current game state is based on timing data from other players of the game. The user may then be presented with a list of games with goals achievable within their selected time period.
- 4 The goal may be to complete a quest, engage and defeat a computer-controlled opponent, play a round of a multi-player game, level up a character, reach a key point within a game environment or the like. Thus, achieving a goal may represent only a part of a game. For the purposes of this decision, I have referred to a 'game or game portion' to encompass these various possibilities.

5 There are independent claims directed towards a method (claim 1) and search apparatus (claim 12). Though the claims are in different categories, they plainly relate to the same subject-matter and will stand or fall together. Claim 1 reads as follows:

1. A method of searching for videogame activities, comprising the steps of:

receiving a request comprising a target time for a first player within which to complete an in game activity;

accessing a record of a current game state for one or more games playable by the first player, wherein accessing the record of a current game state for a game comprises extracting information from a save file created for the game;

obtaining timing data for elapsed times between validated pairs of game states, a validated pair of game states for a game including an accessed current game state for the game and a candidate next game state for the game; and

selecting one or more of the plurality of candidate next game states playable by the first player, responsive to the target time and the obtained timing data, in which the timing data for elapsed times between a validated pair of game states is based on timing data collected from a subset of other players.

## The Law

6 The relevant provisions are section 1(1) of the Patents Act 1977 (“the Act”), which sets out requirements for a patent, and section 1(2) of the Act, which says that certain things cannot be protected by a patent.

*1(1) A patent may be granted only for an invention in respect of which the following conditions are satisfied, that is to say*

- (a) the invention is new;*
- (b) it involves an inventive step;*
- (c) ...*
- (d) ...*

*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) ...*
- (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) ...*

*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.*

7 There is well-established caselaw providing guidance on determining whether an invention falls within this exclusion. *In Aerotel Ltd v Telco Holdings Ltd & Ors*<sup>1</sup> the

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<sup>1</sup> [2006] EWCA Civ 1371

Court of Appeal set out the following four-step test for determining whether a proposed invention is excluded under section 1(2), namely:

- 1) properly construe the claims;
- 2) identify the actual or alleged contribution;
- 3) ask whether it falls solely within the excluded subject-matter;
- 4) check whether the actual or alleged contribution is actually technical in nature.

and in *Symbian Ltd's Application*<sup>2</sup>, the Court made it clear that when determining whether a proposed invention is excluded, it does not matter whether the question of "whether the contribution is technical" is asked at step (3) or (4).

- 8 The examiner has based his analysis on *Aerotel*. He has also made appropriate use of the signposts set out in *AT&T v CVON*<sup>3</sup>. I agree that this is the relevant law and note that the applicant has not commented on this, so I assume there is no disagreement on this point.

### **Arguments and analysis**

- 9 I will deal first with whether the invention is excluded under section 1(2)(c).
- 10 The examiner has not identified any difficulties in construing the claims so far as section 1(2) is concerned, and the applicant has not disputed the examiner's construction in this regard.
- 11 The examiner considers the contribution to be:
- providing the user with a game searching system that matches a game to their requested game time.
- 12 The applicant instead characterises the contribution as:
- [an apparatus and method for] generating validated pairs of game states for one or more games in response to a time specified by a user. The present arrangement extracts a current game state from a save file created for a game and advantageously adapts existing videogame content in a user-specific manner to provide new content that is tailored for a user-specified target time.
- 13 This appears to add two features to the examiner's construction: the generation of 'validated game states' – so the contribution includes game portions as well as entire games; and extracting a current game state from a save file – again emphasising that portions of games, or activities within a game, are included in the search.
- 14 There has been little argument on either side, but I think the contribution is:
- 15 An apparatus or method providing a searching system for games or game portions that generates a number of games or game portions ('validated pairs of game states'), obtains timing data for the games or game portions from a subset of other players of the games, based on a current game state from a save file, and selects

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<sup>2</sup> [2008] EWCA Civ 1066

<sup>3</sup> [2009] EWHC 343 (Pat)

one or more games or game portions by matching the timing data with a requested game time.

- 16 The applicant has offered very little by way of reasoned argument that the contribution is outside the excluded fields beyond saying that it provides content tailored for a specific user, and asserting that it is clearly technical.
- 17 An additional argument was made in the attorney's letter of 02 August 2022, that by selecting content for a user that falls within the gaming time, the user will be able to find a save location within the game and so will not need to simply pause the game and leave the device running at the end of that time. Because the examiner referred the application for a decision at this point, he has not responded to this argument, but I will consider it below.
- 18 There is no doubt in my mind that the contribution is implemented through use of a computer program. Lewison J in *AT&T/CVON* set out five signposts ("*the AT&T signposts*") that he considered to be helpful when considering whether a computer program makes a technical contribution. He reconsidered the signposts in *HTC/Apple*<sup>4</sup> in the light of the decision in *Gemstar*<sup>5</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.
- 19 The claimed technical effect operates entirely within the computer program itself. It does not affect a process outside the computer, does not operate at the level of the architecture of the computer and does not result in a better computer, or in the computer being made to operate in a new way, so signposts i) - iv) do not point to anything beyond a computer program as such.
- 20 The selection of a game or game portion for a user to play – even if tailored to a specific user - is not a technical problem, so no technical problem is being addressed. The fact that the user may take a different action upon completing a game portion (such as saving a game and powering down a device) is a by-product of selecting a game portion that can be completed within the available time, but this does not make the selection of a game playable within a specified time a technical problem. Signpost v) therefore also points to the invention being a computer program as such.

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<sup>4</sup> [2013] EWCA Civ 451

<sup>5</sup> [2010] RPC 10

- 21 Taking steps 3 and 4 together, it is clear to me that the contribution is not technical in nature and relates to a computer program as such.
- 22 Having concluded that the claims are excluded as relating to a program for a computer as such, I see no need to consider whether they are also excluded as a method of playing a game or a method of doing business. For the same reason, it is unnecessary for me to consider whether the claims are obvious in view of the prior art cited by the examiner.

### **Conclusion**

- 23 The application is refused under section 18(3) because the invention relates to subject-matter excluded from patentability under section 1(2)(c).

### **Appeal**

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

### **Huw Jones**

Deputy Director, acting for the Comptroller