



# UK Hearings Digest 2018

A Short Guide to Excluded Subject-Matter Hearings at the UKIPO in 2018



“[It] seems therefore that there is a burden upon an examiner to demonstrate that an invention falls foul of the exclusions and that to overcome such an objection an applicant must do more than ‘show that ... it arguably covers patentable subject-matter’”

-Landmark Graphics

## INTRODUCTION

In producing this guide, we have considered the decisions issued by the UK IPO which relate to Computer Implemented Inventions (CII) in 2018. The aim of the guide is to provide interesting practice points or points of difference between UK IPO practice and that of other offices around the world, with a particular focus on the EPO. We have tried to provide hints and tips for prosecuting applications in the field in front of the UK IPO and indeed advice if the reader ever has cause to take an application through to a hearing. We are strong advocates of the procedures of the UK IPO and the benefits in filing UK patent applications compared to other jurisdictions. In particular, the UK provides a cost effective, flexible and manageable process that is typically the correct commercial choice for many businesses. To our mind, jurisdiction choice is a commercial decision first and foremost with legal aspects influencing the commercial realities. This is important to remember; too often we can be led by legal aspects.

From reading the decisions in 2018, one thing that is increasingly clear is the increased stability and certainty now provided by the UK IPO, particularly at Hearings level. While the examination process may occasionally provide variable outcomes, in the majority of cases the hearing decisions were balanced, predictable and comprehensive. Indeed it was often the case that the Hearing Officers expanded on conclusions reached by the examiners, particularly when defining the ‘actual contribution’ part of the UK test. We may still disagree with some of the decisions where the inventions seemed to us to be inherently technical but in the main the UK IPO can be seen to have developed a largely stable practice. Gone are the days when the processing of applications in CII by the IPO was the proverbial ‘crapshoot’ or simple futility. In the past where it was considered folly to file a CII application at anything other than the EPO, it is no longer the case. While the approaches of the two offices are not the same, we have reached a point of harmonisation where the two results are likely to be broadly equivalent although there are some edge cases where we would recommend one office over the other in order to increase the chances of securing meaningful protection.

We hope you will find this guide useful. We also hope that many of the practice points we have identified will translate into practice in your local jurisdiction and give pause for thought.

For further reading, the decisions can be found here: <https://www.ipo.gov.uk/p-challenge-decision-results/p-challenge-decision-results-gen.htm?YearFrom=2018&YearTo=2018>

## STATISTICS

We analysed UK IPO Hearing Officer decisions from 2018 to assess an applicant's chance of overcoming each of the main exclusions to patentability at a hearing. The results of our analysis are below.

It should be kept in mind that in many cases more than one objection was raised, such that overcoming one type of objection does not necessarily mean that the hearing ultimately went in the applicant's favour.

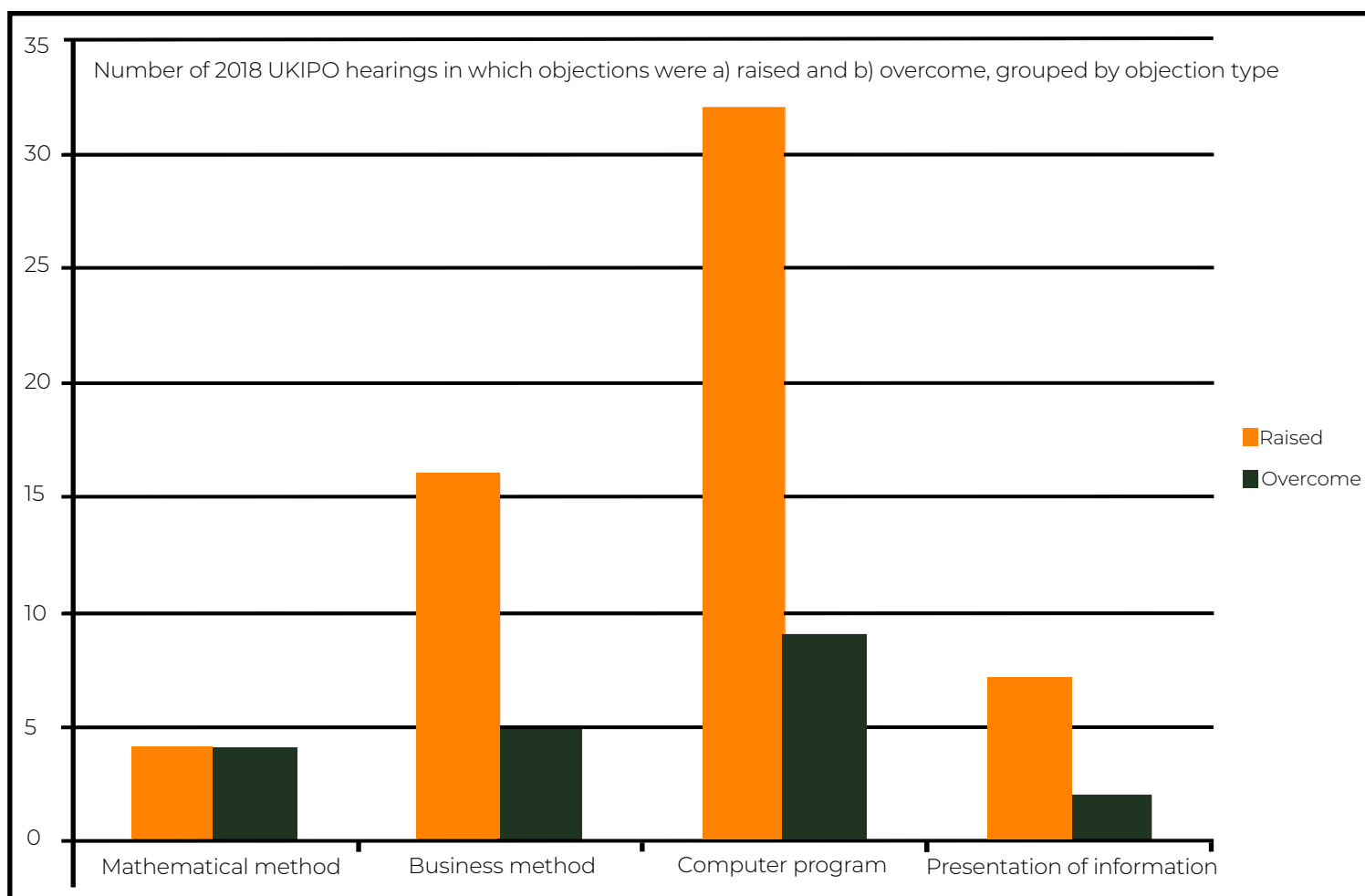
This being said, just over a third of hearings in 2018 resulted in the Hearing Officer deciding in favour of the applicant. This is encouraging given that applications which make it to a hearing are, by their very nature, sitting (at best) right on the bounds of patentability. This demonstrates that the IPO Hearing Officers are giving due consideration to

arguments presented by applicants and that such arguments are found convincing in a reasonable number of cases.

The extremely high rate of overcoming mathematical method objections is caused by the set of cases from Landmark Graphics (discussed below) having a common theme, such that these applications all stood or fell together. We therefore view this result as something of an anomaly and do not believe it to be indicative of the mathematical method exclusion having lost its teeth.

For a look at the statistics for 2017, click here: <https://www.gje.com/how-hostile-is-the-uk-ipo-to-computer-implemented-inventions/>

Objection	Percentage overcome
Mathematical method	100%
Business method	31%
Computer program	28%
Presentation of information	29%





## THE LAW - A SUMMARY

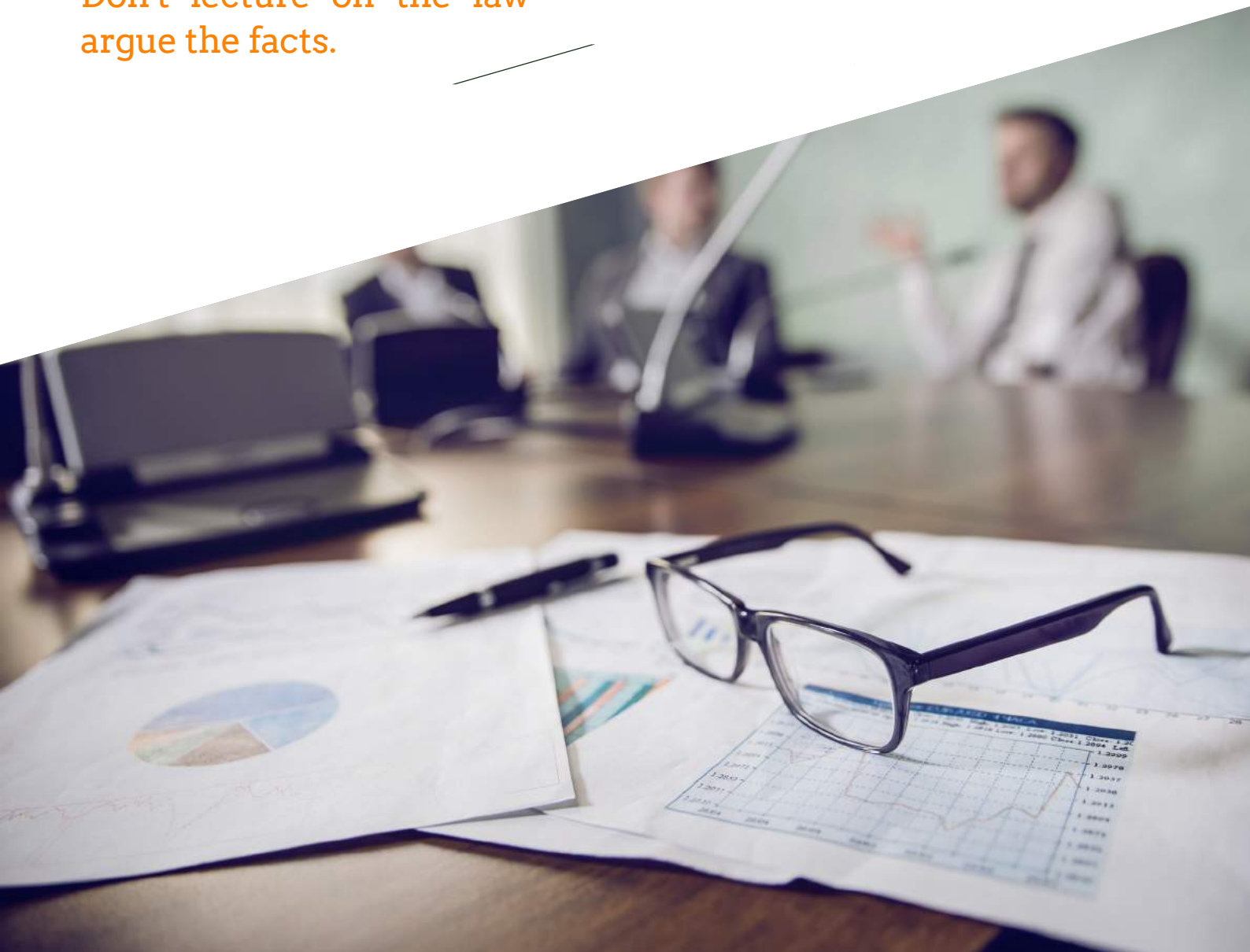
Section 1(2) of the Patents Act lists certain categories of subject-matter which are not considered to be inventions, for example, a method for doing business, or a program for a computer, as such. A concept is considered to be patentable (and not excluded) if it reveals a technical contribution to the state of the art ([Symbian](#)). The four-step [Aerotel](#) test for determining this is:

- (1) properly construe the claim;
- (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.

Known as the [AT&T](#) signposts, there are provided five indications of the presence of anything technical in an invention embodied in a computer:

- 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.

Don't lecture on the law —  
argue the facts.



## THE CASES

BL O/112/18 (Landmark Graphics Corporation); BL O/138/18 (Landmark Graphics Corporation); BL O/140/18 (Landmark Graphics Corporation); BL O/143/18 (Landmark Graphics Corporation); BL O/148/18 (Landmark Graphics Corporation); BL O/154/18 (Landmark Graphics Corporation); BL O/155/18 (Landmark Graphics Corporation);

Without doubt the most significant series of cases in 2018 was the Landmark Graphics hearings. In early 2018, the UK IPO held a two-day hearing to concurrently deal with sixteen (16!) applications. Each application related to geophysical modelling and while the sixteen applications were examined by different examiners, all came to the same conclusion — that each application was excluded from patentability as it related to a computer program as such. In issuing its decisions the Hearing Officer at the UK IPO grouped the sixteen applications into seven separate decisions according to common aspects.

In all sixteen applications the Hearing Officer determined that the examiners were incorrect and that the inventive concept did not lie in excluded subject-matter. The applicant must be congratulated for pursuing the cases in the way they did. Not only for their perseverance but also for helping the UK IPO to deal with the cases in a flexible manner.

If these applications were considered at the EPO, each application would have necessitated a different hearing, quite possibly on separate days and in different locations. The applicant would have spent sixteen days in either Munich or the Hague, which itself would have been a lot before you include travel time. That is also before you consider that the applicant would have spent well over £65,000 in official fees alone just to get to that point (not including grant fees) compared to roughly £5,000 for the sixteen UK applications. One suspects that few applicants would have continued all sixteen European applications to the hearing stage.

All sixteen cases were considered not to be excluded and there were a few nuggets of information in the decisions that might eventually turn into important practice points at the UK IPO. For example, in their analysis the Hearing Officer made this important point:

*“[The representatives] suggest that an applicant should be given the benefit of the doubt unless there is no reasonable doubt to be had. Insofar as this reasonable doubt is the same as the substantial doubt to which Mann J refers [in *Aerotel*], I can agree with this principle. I consider that the question for me is whether or not there is such substantial doubt regarding each of these seven applications, such that where an applicant makes a reasonable case that their invention is patentable then I am bound to find in their favour. I shall proceed on this basis.”*

Effectively, the Hearing Officer is suggesting that examiners should give the benefit of doubt to the applicants if they can make a reasonable case that an invention is technical.

There are some other interesting points raised in the decision. For example in considering the previous *Halliburton* case, the Hearing Officer looked at the substance of the decision rather than simply applying the narrow conclusion and considered that: “when assessing the actual contribution in a computer-implemented invention, I shall take proper account of the task performed by the computer and determine whether the task falls outside the excluded categories.” From a practical point of view, it seems therefore that it is useful to emphasise the task performed by the computer.

Applying this to the application in question, the Hearing Officer stated: “While the method is implemented using a computer, I do not believe that it is merely a computer program as such and nor is it a mathematical method. It seems very much that the method ‘may be used e.g. in investigating properties of the object’ along the lines described in *Vicom*, the object in question being the modelled geological structure ... [T]he contribution is technical in nature, tied to a very specific technical field of endeavour or task.” The Hearing Officer did not comment on whether the use of real data takes a method outside of the computer program exclusion (however the implication is that it might at least create enough doubt not to raise an objection).

Finally, the Hearing Officer also stated that “[i]t seems therefore that there is a burden upon an examiner to demonstrate that an invention falls foul of the exclusions and that to overcome such an objection an applicant must do more than ‘show that ... it merely arguably covers patentable subject-matter.’” This is a good point to note for all practitioners.



## Don't argue all of the AT&T signposts — 1 or 2 maximum.

of delivering the order from the mobile device to the EPOS system at the premises — computer program).

The application would have been analysed quite differently at the EPO where there is now a clear process established for dealing with inventions like this. Under EPO practice, a 'requirements specification' is created, defining the business requirements of a technical solution, which specification is then given to the skilled person with a notional request to 'implement a technical solution meets these requirements'. The question then becomes whether the technical solution claimed by the applicant would have been obvious in light of this notional request. It is possible the same result would have been reached but using the different approach.

The Hearing Officer's conclusion was that the actual contribution is about the technical considerations and not the advantages, i.e. what has been contributed to the stock of knowledge in the field – here a new platform. However that may still fail the tests if that contribution lies within a computer or a new business method.

### BL O/069/18 (Quikserve Ltd)

The invention of this application solves the problem for a restaurant of how to enable customers to use their own mobile devices to order items from a menu. A platform provides a plurality of EPOS adapters, communication protocols, and communication networks, from which one of each is selected to transmit an order to an EPOS at a specific premises.

In the examination proceedings, the examiner dismissed the invention as providing nothing more than a platform and that this was not a technical contribution. The Hearing Officer accepted that the platform has contributed to the stock of knowledge in this field; however, then went on to conclude that the invention was either a business method or a computer program and so was excluded.

We found the approach here interesting. Essentially the Hearing Officer split the contribution of the claims into two, i.e. it was part business method and part computer program (a method of ordering menu items — business method, and a computer implemented process

### BL O/097/18 (Avaya)

February at the UK IPO was dominated by Avaya who had three decisions published. The first related to media stream tagging and allows the temporal aspects of the tags to be captured in a primary media stream and for this to be provided with a secondary media stream that comprises navigable content. It was decided the invention was a non-technical solution to a non-technical problem. The corresponding US application was granted in 2015 and perhaps this is why the applicant felt inclined to fight it in the UK. A corresponding German application appears to have been refused as well and an appeal is pending in the German Federal Patent Court.

## BL O/104/18 (Avaya)

The invention provides a technique for creating a visual timeline of a telephone conference. A plurality of events, which may relate to a conversation involving several people, can be represented by a single compressed event on the timeline. In response to a selection of the compressed event, an expanded event can show the participants of the conversation to the user.

The decision included a detailed discussion on inventive step, which is unusual at the UK IPO in a case that relates to excluded matter. In this case, the Hearing Officer accepted that there was an inventive step, but refused the application because it related to a computer program as such. Thus, the decision provides an interesting contrast between the way that excluded subject matter and inventive step are handled at the UK IPO versus the EPO. At the EPO, the invention would have been refused under inventive step (if at all) but would have passed the lower hurdle for the statutory exclusions.

The Hearing Officer determined that “the problem addressed by the invention is how to present a record of conference events to a user so that they can easily ascertain what events occur during the course of the conference ... [and could] see no contribution on any technical level, and the problem is not a technical problem but an organisational problem”.

## BL O/107/18 (Avaya)

Here two applications were considered together, again providing a reminder of the flexibility of the UK IPO when scheduling hearings. The first was a method and system for receiving a request from a customer of a communication system service for a software file. Within the request the customer specifies some parameters that determine which users can and cannot use the service. The service provider on receipt of the request prepares a downloadable package made up of the components required for the service and deployment instructions for installing the packages on the customer's server network. Once prepared the file is then transmitted to the customer where it is then installed. The second

**Don't treat the signposts as a list of points to be addressed — only discuss signpost #5 if it is an issue.**

application concerned the unpacking of files from a single download and the subsequent distribution and installation onto the customer's network such that it avoids downtime. Both applications were refused as the Hearing Officer concluded that whilst software may be more effective or operate efficiently, there is no effect on the underlying computer in either case.

There were a couple of interesting points arising from this decision. The first was a reminder that the business method exclusion is a narrow one and should not be over-used by examiners. The Hearing Officer stated “[I] can sympathise with the Examiner's view that on the face of it, this is an order and fulfilment system where the customer specifies what they want and the supplier provides a files [sic] to meet those requirements. However, in this instance I disagree for the following reasons....The application is concerned with the process by which software is specified, created and delivered; as such the appropriate objection in this case is one that it is a computer program ...”

Second, this is one of the rare cases that discussed the fifth 'signpost' for technical contribution of a computer program, that is, whether the perceived problem is overcome by the claimed invention as opposed to merely being circumvented. Here arguments presented by the applicant were dismissed and it was considered that reducing bandwidth by sending less data was an example of circumvention.

## BL O/113/18 (Reward Technology Limited)

The invention relates to a retailer loyalty database system which allows a user to register a loyalty card at first use of the card (compared to a typical system of a user manually filling out information on a paper form which is then processed by an operator). It was argued that this system improves data accuracy and reliability over the prior art since a user would be directly completing registration details on the card issuer registration website. The applicant argued that contribution should be considered at the level of the system as a whole, including the human interacting with it — which would show an improved reliability over the prior art when human factors are taken into account. The Hearing Officer decided that the technical devices were doing no more or less than what was well known and that the underlying substance was a business method.



### BL O/128/18 (Nuna International B.V.)

The application relates to the remote control of an infant care apparatus using a device with a touch display having a graphic user interface comprising a structured menu and features relating to an infant care apparatus having a sensor and sending a warning signal to a remote device when a sensed signal exceeds a predetermined value.

This case was notable in 2018 for its refusal under inventive step rather than excluded subject-matter and the comparatively increased reference to EPO process and law than is usual in these hearing decisions. In refusing the application, the Hearing Officer split the claim into individual integers and considered each separately. While such an approach is valid under UK law, it is far more common to see such an analysis at the EPO under its 'partial problems' approach.

The Hearing Officer also followed an EPO-style approach to assessing the patentability of the invention when he assessed the patentability of the features relating to the GUI. In effect, the officer determined that the GUI was a mere design choice and cannot distinguish the invention as its features are commonplace. Rather than considering these features under excluded subject matter, as might be expected under typical IPO procedure, he considered these features under inventive step and took account of the could/would approach to assessing inventive step that is applied by the EPO.

### BL O/142/18 (Greydog Ventures Ltd.)

This application related to a computer-implemented method of providing tailored services to a user without sharing user data, the method providing a secure trusted intermediary which compares securely stored user profile data with matching rules provided by sources of tailored services. The Hearing Officer decided that the problem in this case is one of users not submitting their details because of concerns regarding the use of such data and that this is not a technical problem. It was considered that the solution of adopting a trusted intermediary is not a technical solution, at least not beyond the fact that it is embodied in a computer system.

It was also interesting to note that hearing decisions can be reached very quickly and remotely (e.g. by video). In this case a final decision was reached before the application was even published, again showing the flexibility and speed of the UK IPO.







Hearing Officers often expand on the examiner's defined contribution.

### BL O/194/18 (Lenovo (Singapore) Pte. Ltd)

The invention relates to improved user object searching, or augmented searching, through the collection, recording and further manipulation of ephemeral data in association with user object event data. This has the advantage that the associations to a user's content are extremely rich and supports low and high order correlations useful in various device applications, in particular searching applications.

This was one of the shortest decisions of the year. The Hearing Officer stated that "I do not consider the mere use of sensor data as having a technical effect on a process outside the computer. I also note that while the contribution utilises real world data and that this real world data is collected based on an object event, there is no direct influence on the real world in any way." This is good to be aware of as in the past it has often been general advice that the use of real data is enough to avoid the exclusions. We wonder how this would have been considered at the EPO. For example, would it have been considered an improved man-machine interaction or that it reduced cognitive burden of the user? In the end at the UK IPO the invention was relatively quickly dismissed under each of the **AT&T** signposts.

### BL O/199/18 (Adobe Systems Incorporated)

This hearing was not notable because of the subject-matter particularly but was instead notable for the convoluted procedure, emphasizing the flexible nature of proceedings at the UK IPO. First, the Hearing Officer seemed to take an unusually collaborative approach by asking for submissions from the examiner during the hearing. Additionally, after the hearing, the officer asked the applicant to provide submissions relating a piece of case law that they had not discussed. In addition to doing so, the applicant also followed up with further submissions after the hearing relating to Landmark Graphics (see above). The flexibility of the UK hearing procedure is undoubtedly an overwhelming positive for the UK IPO but in this instance it did not seem to be procedurally efficient to the casual observer.

The invention proposed creating a unified user profile drawing data from two different computer networks and includes pre-processing of data on a backend server to create clusters. The applicant was unsuccessful in arguing there was a technical contribution, the Hearing Officer considering that the advantages the applicant described were a consequence of the program that did not amount to making the computer itself more efficient or effective. Nevertheless the applicant had a minor victory of sorts overcoming the previous method of doing business objection. The Hearing Officer sided entirely with the applicant on this point, remarking that "the data relates to business information but I do not see that as meaning that the claims wholly relate to a method of doing business."

## BL O/206/18 (Corethree Ltd.)

Here again the UK IPO showed its pragmatic approach to scheduling of hearings, combining two applications into one for procedural efficiency. One of the applications was a divisional application of the other. This is an example of how, together with the statutory compliance period, the UK IPO does not allow the 'ever-greening' or 'pending divisionals' practice possible at other patent offices.

The inventions related to a platform for the delivery of content and services to networked connected computing devices, typically smartphones, tablets, and so on. The claims related specifically to a digital ticketing system. The digital ticket when displayed on the respective screen including an animated watermark or an animated image that indicates that the digital ticket is validly available for use.

In the hearing, a lot turned on the issue of the meaning of the term 'validly' and whether it was for security or for clearly "identif[y]ing to a person checking the ticket whether the ticket is valid or not". The applications were refused as being a business method, a computer program AND presentation of information (hitting three exclusions in one claim — isn't one enough?). In essence, the Hearing Officer determined that checking the validity of a ticket was not a technical issue but a business one.

In the decision, the Hearing Officer made it clear there was an issue in the disclosure of the original application and the technical problem that was set out. The Hearing Officer was unimpressed that the technical problem argued wasn't clear from the original application. This is a good practice point to note. It is important that the application as filed indicates at least one technical challenge that the invention, or at least a subset of embodiments, overcomes. Similar points are being raised consistently now in the US as well after [Alice](#) and so it is advisable to spend time on the drafting of the applications to ensure the technical effect(s) attributable to embodiments are clear.

One other minor practice point to note is that Hearing Officers are open to submission of Auxiliary Requests, but in this case they did little to advance the case and were dismissed summarily. On this point, see also BL O/283/18 below – the number of Auxiliary Requests should be minimal.

## BL O/209/18 (Ventana Medical Systems)

Ventana filed a patent application describing a way of presenting digital images of a microscope slide at various levels of detail to a pathologist. The alleged invention was a new arrangement of these images on a screen, which allowed the pathologist to study the images more efficiently and hence perform diagnoses more quickly.

In examination the claims were objected to as relating to no more than the presentation of information and a computer program as such. The Hearing Officer and the applicant broadly agreed that the contribution lay in the fact that the claimed system would allow a pathologist to work more efficiently. Critically, however, the Hearing Officer remarked that the contribution was not "a new clinical insight or an improved diagnostic method". The invention did not involve the use of any new kind of medical data nor did it lead to different diagnoses; the contribution lay solely in the way that the information was presented.

The applicant suggested that the issues at hand were similar to those considered in the well-known [Halliburton](#) judgement. In [Halliburton](#), a computer-implemented method for designing drill bits was held to be patentable for the reason that designing drill bits is a technical task, and finding a better way of doing so constituted a technical problem. Drawing an analogy between [Halliburton](#) and the application, the applicant argued that providing a better virtual microscope that enabled a pathologist to more efficiently make a diagnosis was a technical problem, and that this problem was solved by the claimed invention. The Hearing Officer rejected this reasoning on the grounds that in [Halliburton](#) the contribution lay in the method of designing drill bits, whereas in the claimed invention, the contribution lay solely in the way that the images were displayed and not in the technical activity of carrying out a diagnosis. While the Hearing Officer recognised that Ventana's system provided a concrete benefit to a pathologist carrying out a diagnosis, he took the view that this did not confer any technical character on the invention. The application was therefore refused.

The fate of the application seems to have been sealed from the moment that the contribution was identified as an improved way of displaying microscope slides; all of the applicant's subsequent arguments on the advantages of the invention could not move the examiner away from the position that this contribution lay solely in the presentation of information.

## BL O/232/18 (Avaya Inc.)

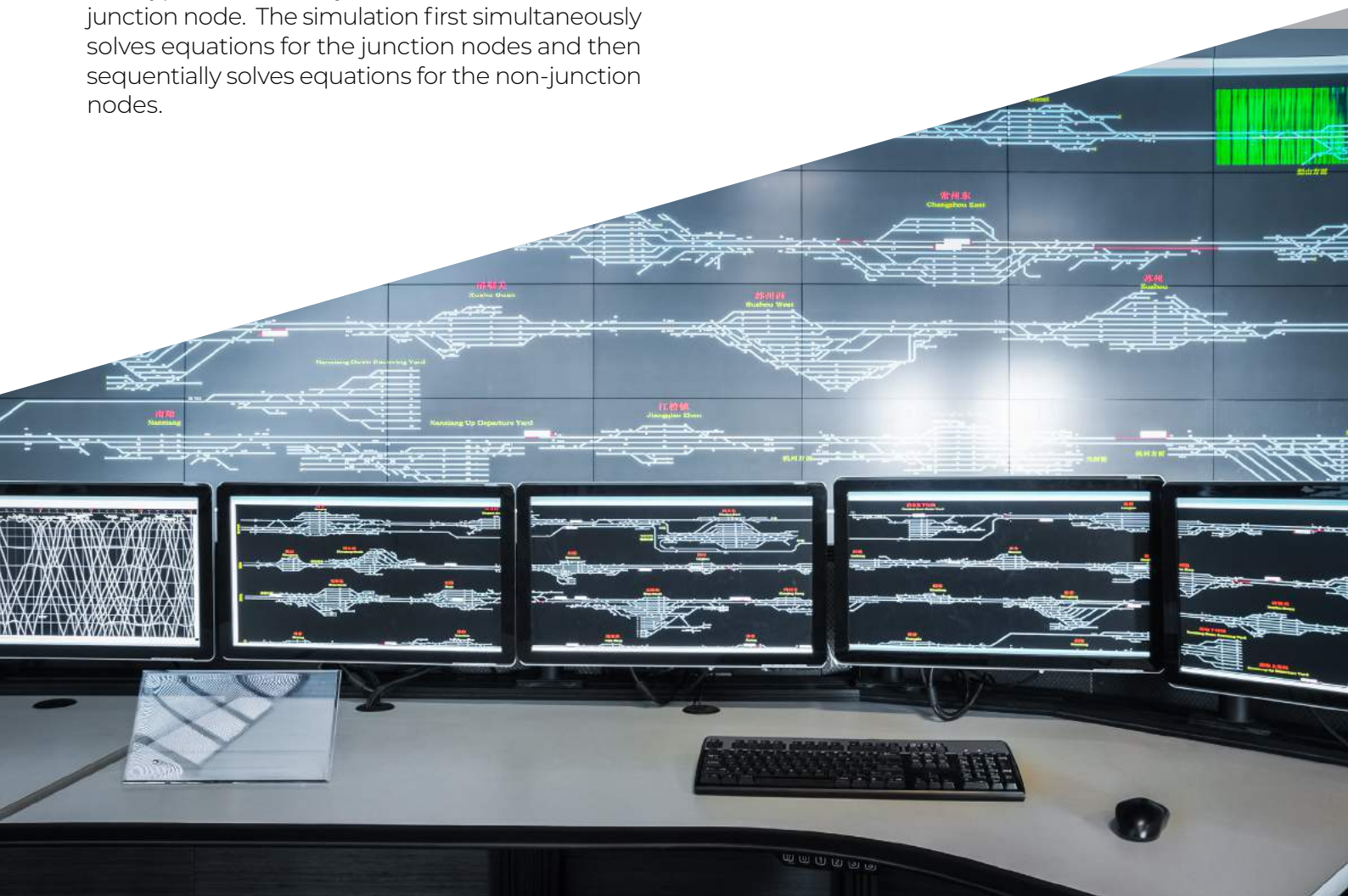
Here is another case from Avaya, one of the busier applicants in 2018. The invention relates to a message delivery system where member configuration data with a prioritised message list is used to deliver audio messages to recipient client devices. A selection of messages is delivered to a recipient based upon criteria designated by the sender and the recipient so that a limited number of the most important messages can be received on a prioritised basis. The Hearing Officer decided that the problem addressed was not related to reducing data transferred in a system but rather ensuring a user can identify a small number of messages which are highest priority. This, the Hearing Officer decided, amounted to a mere automation of an administrative problem concerning how to assist a user manage large volumes of communications. It was decided that this was not technical and so the application was refused.

## BL O/283/18 (Emerson Process Management Power and Water Solutions Inc)

The invention relates to a simulation system for simulating flows between different nodes of a process network such as those used in a power generation plant. The simulation system identifies two types of node: a junction node and a non-junction node. The simulation first simultaneously solves equations for the junction nodes and then sequentially solves equations for the non-junction nodes.

It was decided that the application should be refused because the simulation had no interaction with anything tangible on which it may have a technical effect. The invention was compared to the analysis of the EPO Board of Appeal in [Vicom](#), but the Hearing Officer concluded that the contribution was simply an abstract theoretical representation of a process network and was not susceptible of industrial application.

A practice point to take away from this application was that although the UK IPO will allow Auxiliary Requests their number should be very restricted (compared to the EPO which may consider more). The applicant submitted a main request and five Auxiliary Requests but the Hearing Officer decided they were under no obligation to consider the claims sets of the Auxiliary Requests as the purpose of the hearing was to resolve disagreement and not continue examination, especially as the applicant had had several opportunities for amendment during prosecution. The Hearing Officer therefore asked the applicant to select only one Auxiliary Request for consideration.







### BL O/325/18 (Canon KK)

The application related to data storage for web applications. The invention manages a local storage capacity of a processing terminal to ascertain if a website content and/or page can be viewed by a user when browsing, and facilitating the deletion of data from local storage by evaluating free storage capacity with respect to new data to be viewed and extracting and displaying, to the user in an identifiable manner, candidate data to be deleted, which is then deleted on the user's instruction. This allows the user to continue to view the website content i.e. data stored as cached data when the website is disconnected from a network and/or is offline.

The applicant suggested the function provided by the invention enables the user to easily delete unnecessary content stored. However, the Hearing Officer was not convinced by this line of argument and stated that this was a form of data processing or a way of handling specific data and as such the invention was excluded as a program for a computer as such. The Hearing Officer also implied that the application may also have been refused as presentation of information but that it was not necessary to consider this point.

### BL O/298/18 (Barclays Bank Plc)

The invention aims to provide a solution to the problem of delays between a customer requesting a new mobile account and the time when the mobile account is ready and can be used to carry out payments. The Hearing Officer decided that the automatic creation of a new secured contactless payment account is a business problem and not a technical one and went on to state that "the automatic creation of a new mobile account/wallet is, in one aspect, merely a 'better' business method. In the contributions other aspect, i.e. the generation, transmission and use of data to define the account, this is just the action of one or more computer programs running on standard hardware. Thus after careful consideration I cannot identify any non-excluded technical contribution. ... I find that the invention is excluded as a business method and a program for a computer as such."

When looking at FinTech inventions at the UK IPO it is important to consider the problem that is being solved. If it can be argued that the issue being addressed is a technical one then the application has a greater chance of success. In the case of FinTech inventions, our experience is that likelihood of grant is greater at the EPO, but the challenge of identifying a technical problem still remains at either office.

### BL O/479/18 (Khalil Arafat)

This was a rare victory for applicants (excluding Landmark Graphics of course). The examiner had alleged that the invention was a method of doing business during seven rounds of prosecution. The persistence of the applicant should be admired.

The invention related to a system for verifying the authenticity of printed sheet material, e.g. paper documents. The system associated, in a database, individual invisible identifiers applied to sheets of material to an individual invisible identifier applied to a secure package so that a third-party consumer can scan the sheet material and the packaging to verify the association between the two and be assured of its authenticity. The applicant argued that the invention couldn't be a business method per se because it related to an apparatus including distributed hardware. The applicant asserted that the examiner had dissected the apparatus into its constituent parts but failed to acknowledge the invention as a whole and that it was the functionality which was important, that is, not only can the user activate sheet products quickly and easily for communicating securely on demand, but any number of different users having the relevant equipment can do the same thing. The Hearing Officer agreed with the applicant and concluded the invention was not excluded as being a method of doing business.



solved it must therefore be viewed as having been circumvented.

One suspects the EPO would not have approached the question in the same way as the circumvention argument. Although having basis in EPO case law (T 0258/03 (Hitachi)), the concept rarely arises in practice. The proposed concepts could also potentially exacerbate the technical problem by providing more data congestion and so it would be interesting to think if the EPO might have considered this potential negative in their assessment of inventive step.

### BL O/509/18 (Globoforce Limited)

The invention claimed was a system and method for collating and displaying personnel recognition data within an organisation; more particularly systems and methods for analysing and displaying recognition data along with company organisational data to generate a recognition graph for employees. The invention receives and processes “recognition moments” alongside organisational information and so provides employers with real-time access to such data in a manner that will allow the employers to efficiently determine employee performance, influence, and impact in the organisation.

This was a fairly straightforward decision in which the application was refused for relating to a computer program, business method and the presentation of information as such (all three!). The Hearing Officer accepted that the recognition data sources are people who exist outside the computing network, however, he argued that the recognition data and the people themselves are not “a technical process which exists outside the computer” as required by the first AT&T signpost, but instead are a source or subject of data existing outside the computer. The process of the contribution is the combination of the inputted real-time recognition data with the organisational data, which process is carried out entirely within the computer network, and which is a computer program as such.

The representative relied on the new EPO guidelines relating to business methods (in particular the concept of the ‘business person’) in order to argue that the claimed method was not a business method as such. The Hearing Officer responded that he is bound by the judgments of the UK courts, but engaged in some dialogue based on the EPO guidelines nonetheless — only to find the representative’s arguments unpersuasive.

### BL O/494/18 (Google LLC)

This case fundamentally came down to a disagreement over the technical problem (a very EPO issue). The invention was a computer-implemented method which identifies location-specific webpage content which has been viewed by two or more users in a geographical area with poor mobile telephone reception and/or limited access to other wireless networks. Then, upon determining that a first user is travelling to said geographical area, one or more items of the identified location-specific content are transmitted to the first user’s client device prior to the first user arriving at the geographical location, the items being stored on the user’s client device so that they can be accessed by the user at the geographical location irrespective of whether or not there is mobile telephone reception or access to wireless networks.

The applicant argued that the contribution acted to solve the problem of providing users with required information at a location, but the Hearing Officer held that the problem being addressed was one of poor network reception at a location and that the contribution acted to circumvent rather than solve this problem because information about the location was loaded on the device prior to arriving at the location.

The Hearing Officer considered that the technical problem was one of poor network availability, not the inability to access content which is the result of the problem. The invention did not actually provide the user with improved mobile telephone reception or improved access to wireless networks at their location, hence the underlying technical problem was not addressed or resolved by the invention. As the technical problem has not been



### BL O/569/18 (Lenovo (Singapore) Pte. Ltd)

The claimed invention offered an alternative to traditional computer-based calendar applications by leveraging contextual information about what was currently of interest to a user in order to prioritise the display of upcoming events to that user. In arguing against an excluded subject matter objection, the representative relied primarily on [AT&T signpost \(iii\)](#), which suggests that a computer program may be considered to make a technical contribution if the claimed technical effect results in the computer being made to operate in a new way.

The representative argued that claim 1 requires contextual data to be recorded, wherein that contextual data includes the content of received communications. Therefore, each time such a communication is received, a means to determine the contents of the communications has to be actuated. As common information handling devices usually do not record content of communications, the computer is made to operate in a new way.

However, the Hearing Officer decided that choosing to determine and record certain data, in particular circumstances or in a particular order, is a choice made entirely in software and so the contribution resided in the domain of a computer program as such. Additionally, the Hearing Officer decided that the invention was an administrative task as it was the automation of functionality carried out by a good secretary.

### BL O/621/18 (Intuit Inc.)

The invention is concerned with producing linguistically correct computer generated text.

It was considered that ensuring that computer generated text is linguistically correct having regard to the gender of words used may indeed result in a better human computer interface; however, it is necessary to consider what has produced that. It is not a solution to a technical problem. Rather the problem was a data processing problem with the program that produced the initial linguistically incorrect text. The decision contained a comprehensive discussion of the analogies to earlier case law such as [Gemstar](#) and even EPO Board of Appeal case law such as [T115/85 \(IBM\)](#). The EPO may have perhaps approached this case a little differently, giving more weight to the improved man-machine interface, but it is not clear whether they would have reached a different conclusion.

### BL O/670/18 (General Electric Company)

The invention relates to a method and system for analysing electrical generation data and time usage data in order to identify preferred times for a non-utility microgeneration device (e.g. solar panel). The Hearing Officer decided that the contribution was in a particular software application for analysing electrical production data and outputting a result and that there wasn't anything in the analysis itself of the device and grid data which points towards a technical contribution. It was also decided that the analysis (i.e. the contribution) was a business method as it improved the business of the utility provider.







### **BL O/741/18 (Virtual Reading Gym (PTY) Ltd)**

The invention relates to a method and to a system which provide for progressive teaching of improved reading skills to a learner. A learner is presented with a written passage on the monitor. A learning process involves having the learner read the passage and recording words that the learner pronounces incorrectly or cannot pronounce as error words. Corrective feedback is provided to the learner which may optionally include an audible correct pronunciation of the error words and/or, optionally, include a definition of the error words. The plurality of error words is correlated to a set of similar or associated words in a database to provide a set of related training words. Training is also provided with respect to error words and training words. The Hearing Officer was willing to accept that the technical contribution was more than “querying a database” and there is a willingness at hearing level to expand on the contribution from generic dismissal commonly encountered at first instance. However, it was ultimately concluded that none of the steps of the invention produced a technical effect.

### **BL O/758/18 (Blackhawk Network Inc.)**

The invention relates to conducting transactions using transaction card package assemblies, which comprise a card holder containing one or more transaction cards and a sample product. The Hearing Officer stated that the examiner’s interpretation of the contribution “as determining whether a transaction card package assembly and a sample are eligible for correlation ‘in order that goods and services can be more effectively promoted’” was “too narrow as it omits the analysis of received identification data with respect to pre-stored data”. We have seen this in other cases in 2018 (e.g. [O/621/18\(Intuit\)](#)) where the Hearing Officer has disagreed with examiner’s overly narrow interpretation of the actual contribution when applying step 2 of the [Aerotel](#) test.

Nevertheless, the application was rejected as the contribution was found to fall wholly within the business method exclusion. The examiner based this rejection on the fact that no other application of the invention is described except in the field of “conducting financial transactions”. The Hearing Officer explicitly stated a number of times in the decision that the “description indicates, at paragraph [0017], that the transaction cards ‘may be used to transact business’ and I note that here that no other use is described”. The use of the term “business” was clearly a red flag.

## BL O/770/18 (Stoneware, Inc)

This invention aimed to provide an accurate evaluation of the user's current device hardware and network conditions, performed at the time of providing a software service in order to be able to provide a software service best suited for the user's current device hardware or hardware conditions. This hearing was targeted, quite rightly, at a few specific arguments; however, the Hearing Officer determined that the application should be refused because it was a program running on the computer that makes it operate in a new way, rather than the computer itself being made to operate in a new way and that the computer itself does not operate more effectively or efficiently. That is, the contribution simply provides a service to a computer that best meets its current circumstances. We think this would have been considered quite differently at the EPO where the advantages in terms of the service being provided by the user might have been given more patentable weight (we cannot say however whether such arguments would have been successful).

## BL O/787/18 (Fisher-Rosemount Systems, Inc)

This decision issued towards the end of the year provides an interesting conclusion from a technical point of view rather than a particularly interesting legal issue. The key issue was the interpretation of what is considered to be the level of architecture of the computer. Previous decisions have considered that this is not the application layer but the high court [Symbian](#) decision considered that a DLL file at the runtime services layer was capable of making a technical contribution. Although there were disagreements over the defined contribution, the applicant considered it to be "Splitting ... EDDL files' to enable application requests to be serviced with reduced risk of corruption, with more disparate localisation requirements, fewer shutdowns, and more simply, so that better control of a process plant can be achieved." The description taught that locale templates and device description files are said to be provided in a translation layer (second layer) between the applications layer (third layer) and network application/controller subsystem layers (first layer/layer 0).

The examiner considered that the contribution does not operate at the level of the architecture of the computer. The contribution was part of a suite of files which make up the process control system including applications which, in embodiments, are provided within a web browser with EDDL files and locale templates provided as XSLT and/or

XML files for conversion into HTML files to display process control objects within the web browser. Whilst these files might notionally be regarded as being at a lower level than the application within the web browser, the Hearing Officer reasoned that it does not follow that they are at the level of the architecture of the computer or process control system; they remain above that level as elements of web browser code.

This conclusion is important when considering the patentability of inventions at the IPO and whether or not they provide a new and improved computer and hence provide a technical contribution. The Hearing Officer also stressed that the contribution should not be stretched to the system in which the architecture is to operate and that the benefits were not realised in a better process system, considering that better utilisation of available screen area was not a technical advantage.

## BL O/800/18 (Motorola Solutions, Inc)

This was an interesting case which again showed the approach of drawing analogies to previous decisions to aid consideration of the technical contribution. The invention relates to an asset tracking module which monitors the location of pursuit assets, such as law enforcement personnel and vehicles, and passes these to the cornering strategy module, which outputs instructions to the pursuit assets. This was considered a business method and hence excluded.

In considering this concept, the Hearing Officer cited the little known High Court case of [Cappellini](#). This related to the delivery of packages and planning routes and was considered to be a method of doing business (using algorithmic analysis) and hence excluded. It was determined that the effect of the invention was the instructions given to drivers and a method of performing a set of journeys, which is a business method.

Here, the use of real time data did not save the applicant as the sources of data were considered to be known and the technical contribution was considered to lie in the routing instructions for assets, i.e. a set of business instructions. Also included in the decision was a summary of the law that does not restrict the 'doing business' exclusion to financial or commercial activities. Since the contribution was not found technical, the invention also found to be a computer program operating in a conventional way.

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- DCC Australia

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### BL O/809/18 (Hitachi)

This is a rare case where the outcome of the hearing was remittal back to the examiner for continued examination. It was decided that a system of alerting a user to congestion on a construction site and prompting the user to take remedial action did provide a technical contribution. The invention utilised a 3D scanned model of a construction site and a comparison with design data to identify non-design data and produce a warning in response to localised congestion to improve safety. The Hearing Officer compared the case to **PKTWO** where an alarm notification generated more rapidly and reliably was considered to be an effect outside the computer.

### BL O/823/18 (Lenovo (Singapore) PTE. LTD)

At the time of writing, no decision has been published on this case. The application relates to the auto-correction of text using contextual data

derived from one or more sensor and clock inputs. The application was refused as no more than a program for a computer as such.

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