



PATENTS ACT 1977

APPLICANT	ImageNPay UK Limited
ISSUE	Whether patent application GB1819590.9 complies with the requirements of section 1(2) of the Patents Act 1977
HEARING OFFICER	Phil Thorpe

DECISION

- 1 Patent application number GB1819590.9 was filed on 30th November 2018 in the name of ImageNPay UK Limited, claiming a priority date of 18th May 2018 from GB application number 1808114.1. The application was published as GB 2573845 A on 20th November 2019.
- 2 The examiner issued a letter on 31st May 2019 under section 17(5)(b) of the Patents Act 1977 (“the Act”) reporting that a search would serve no useful purpose. The letter was accompanied by an examination opinion in which the examiner outlined that the reason a search would serve no useful purpose was because they considered the claims were excluded from patentability as a method for doing business and a program for a computer as such.
- 3 The applicant subsequently requested substantive examination and there followed several rounds of correspondence between the applicant and the examiner. The examiner maintains that the claims are excluded from patentability under section 1(2) as a method of doing business and a computer program. The examiner also considers the claims to be excluded as the presentation of information. The examiner performed a search on 28th December 2022. Following the search, the examiner also considers the claims to lack inventive step. In his letter dated 17th May 2023 the examiner set out in detail their reasoning why the claims relate to excluded matter as such and lack an inventive step.
- 4 The examiner offered a hearing in a letter dated 28th December 2022, and a hearing was subsequently requested by the applicant in their letter dated 18th April 2023. However, on the 27th June 2023, the applicant withdrew their request for a hearing. Despite then being given the opportunity to request a decision on the papers, there has been no further correspondence with the applicant. Furthermore, the application has not been withdrawn.

- 5 In their letter dated 28th December 2023, the examiner noted that in the event that a hearing was not requested, then the application may be passed to a Hearing Officer to make a decision, based on the papers on file, as to whether the application complies with the requirements of the Act. Therefore, as the hearing request has been withdrawn and no further correspondence received from the applicant, the application has been passed to me to decide whether the application should be refused.
- 6 My analysis is based upon the claims filed on 18th April July 2023 and the corresponding specification. For the avoidance of doubt, no further arguments, amendments or auxiliary requests have been filed since the examiner's letter of 17th May 2023.

Subject matter

- 7 The claimed invention relates to using a user electronic device (e.g. a mobile phone) to provide audio/haptic feedback in relation to a digitised transaction card being selected or used to perform a transaction. The user electronic device comprises a processor which is coupled to a communicator and an audio/haptic output unit and can execute a digital wallet application which is associated with a digitised transaction card. User preference information relating to the digital wallet application is obtained and communicated to a management server which returns a notification command. The notification command determines what kind of audio or haptic feedback is provided in relation to the specific digitised transaction card (e.g. a particular sound or vibration pattern). When the digital wallet application is executed (for the purpose of selecting the specific digitised transaction card or using it to perform a transaction) the audio/haptic output unit is controlled to provide the audio/haptic feedback determined by the received notification command.

Excluded matter

The Law

- 8 Section 1(2) of the Act defines certain categories of "things which are not to be regarded as inventions". The relevant provisions of this section of the Act are shown with added emphasis below:

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

- (c) ...a scheme, rule or method for...doing business, or a program for a computer;*
- (d) ...the presentation of information*

but the foregoing provisions shall prevent anything from being treated as an invention for the purposes of the Act only to the extent that a patent or application for a patent relates to that thing as such.

- 9 As explained in the notice published by the IPO on the 8th December 2008¹, the starting point for determining whether an invention falls within the exclusions of section 1(2) is the judgment of the Court of Appeal in *Aerotel/Macrossan*².
- 10 The interpretation of section 1(2) has been considered by the Court of Appeal in *Symbian*³. *Symbian* arose under the computer program exclusion, but as with its previous decision in *Aerotel* the Court gave general guidance on section 1(2). Although the Court approached the question of excluded matter primarily on the basis of whether there was a technical contribution, it nevertheless (at paragraph 59) considered its conclusion in the light of the *Aerotel* approach. The Court was quite clear (see paragraphs 8-15) that the structured four-step approach to the question in *Aerotel* was never intended to be a new departure in domestic law; that it remained bound by its previous decisions, particularly *Merrill Lynch*⁴ which rested on whether the contribution was technical; and that any differences in the two approaches should affect neither the applicable principles nor the outcome in any particular case.
- 11 Subject to the clarification provided by *Symbian*, it is therefore appropriate to proceed on the basis of the four-step approach explained at paragraphs 40–48 of *Aerotel* namely:
- (1) *Properly construe the claim.*
 - (2) *Identify the actual contribution (although at the application stage this might have to be the alleged contribution).*
 - (3) *Ask whether it falls solely within the excluded matter.*
 - (4) *If the third step has not covered it, check whether the actual or alleged contribution is actually technical.*
- 12 There is no dispute concerning the relevant law and its application to the facts of this case.

Argument and analysis

- 13 I have carefully considered the applicant's arguments set out in the correspondence on file, and the relevant law and practice. I agree with the examiner's analysis of the issue of excluded matter as set out in their letter dated 17th May 2023.
- 14 In that letter the examiner identified the contribution made by the invention as:

A system configured to provide audible and/or haptic feedback to a user electronic device in response to a specific digitised transaction card being selected and/or used to perform a transaction, the audible and/or haptic feedback being determined by a notification received from a management server, the notification being determined according to user preference information previously obtained by the user electronic device and communicated to the management server.

¹ <http://www.ipo.gov.uk/pro-types/pro-patent/p-law/p-pn/p-pn-computer.htm>

² *Aerotel Ltd v Telco Holdings Ltd and Macrossan's Application* [2006] EWCA Civ 1371; [2007] RPC 7

³ *Symbian Ltd v Comptroller-General of Patents*, [2009] RPC 1

⁴ *Merrill Lynch's Appn.* [1989] RPC 561

The examiner went on to find that this related to a method of doing business and the presentation of information. The examiner explained their reasoning as follows:

Method of doing business

“Providing a specific physical output which embodies information signifying a particular transaction card does not amount to a technical contribution. Using audio and/or haptic feedback to convey information is entirely conventional and is not where the contribution lies. Rather, the contribution lies in the particular method of capturing, communicating and using user preference information to determine the audible and/or haptic feedback to be provided in response to a specific digitised transaction card being selected and/or used. This is not technical for the reasons already given above.”

Presentation of information

“Using audio and/or haptic feedback to convey information using conventional means is also considered to be excluded under section 1(2)(d) as the presentation of information. Your attention is drawn to the decision in BL 0/268/07, where the Hearing Officer found that the use of a haptic effect in a communications device to indicate a feature of the communicated data related solely to the presentation of information.”

- 15 The examiner also considered the *AT&T* signposts⁵ but could find nothing to indicate that the invention was also not excluded as a program for a computer as such. I can find no fault in the examiner’s detailed assessment and am therefore satisfied that the application fails to meet the requirements of sections 1(2)(c)&(d) of the Act.

Inventive step

- 16 As I have found the claims are excluded under section 1(2), I do not need to go on to determine if the claims involve an inventive step.

Conclusion

- 17 This application is refused under section 18(3) of the Act.

Appeal

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

PHIL THORPE

Deputy Director, acting for the Comptroller

⁵ *AT&T Knowledge Venture/CVON Innovations v Comptroller General of Patents* [2009] EWHC 343 (Pat); [2009] FSR 19