



PATENTS ACT 1977

APPLICANT Christopher Curtis

ISSUE Whether patent application GB1116796,2 complies with the requirements of sections 1(1)(d) and 1(2)

HEARING OFFICER B Micklewright

DECISION

Introduction

- 1 This decision concerns patent application GB1116796.2, entitled "Board game" which was filed in the name of Christopher Curtis on 29 September 2011. The application was published on 24 July 2013 as GB 2498507A.
- 2 The examiner objected to the claims on the basis that they are excluded from patentability as a method of playing a game as such. Over several rounds of amendments the aforementioned issue of excluded subject matter remained unresolved. The applicant's representative remained of the opinion that the link between the playing pieces of the game and the rules of the game was more than a method of playing a game as such. Agreement on this matter could not be reached and it fell to me to consider the matter in a hearing on 14 February 2017. The applicant, who was present at the hearing, was represented by Jim Pearson and Natasha Perks from Abel & Imray.

The Invention

- 3 The application relates to a board game in which a plurality of game pieces are moved over a plurality of marked spaces arranged in a grid on a two-dimensional board. The game pieces have different geometrical shapes which move in different ways on the board depending on the number of vertices associated with each individual piece. The applicant alleges that the game is easier to learn and master than chess.

The claims

- 4 The most recent set of claims, filed on 02 December 2016, includes seven claims, in which claim 7 is an omnibus claim. The first claim reads as follows:

"1. Board game apparatus comprising

a set of rules,

a game board and

a plurality of game pieces for moving over the board, the board being provided with a plurality of marked spaces arranged in a grid; wherein

the plurality of game pieces includes a first set and a second set, with each of the first and second set being identical in the number and type of game pieces they comprise, and wherein each of the first and second set comprises

eight first game pieces of cubic form;

eight second game pieces of square-based pyramidal form; and

eight third game pieces of tetrahedral form; and

one fourth game piece which is a unique game piece in each set, and wherein

the rules dictate that the game pieces are to be moved across the board by a number of adjacent marked spaces less than or equal to the number of vertices of the game piece being moved.”

The issues to be decided

- 5 I will decide if the invention is excluded from patentability under Section 1(2)(c) of the Patents Act 1977 (“the Act”) as a scheme, rule or method for playing a game as such. Although not formally raised, it is noted that the latest amendments have re-introduced the subject matter of claim 4, which has previously been objected to as comprising added matter. There is also the matter of the omnibus claim which from 6 April 2017 is no longer allowed as a form of claim except in certain limited circumstances. At the hearing Mr Pearson confirmed that the subject matter of earlier claim 4 was re-introduced in error and would be removed if I was to allow the application to proceed.

The Law

- 6 Section 1(2) of the Act sets out a number of requirements that the claims must satisfy for a patent to be granted. The provisions in this section that are relevant to the current case are (my emphasis):

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

(a) a discovery, scientific theory or mathematical method;

(b) a literary, dramatic, musical or artistic work or any other aesthetic creation whatsoever;

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

(d) the presentation of information;

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

7 The provisions of Section 1(2) were considered by the Court of Appeal in *Aerotel LTD v Telco Holdings Ltd*¹ (“*Aerotel*”) where the following four step test was applied to decide whether a claimed invention is excluded from patentability under section 1(2):

(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.*

8 In *Shopalotto.com Ltd’s Application*² (which pre-dated *Aerotel*) Pumfrey J overturned practice set out in an Official Ruling from 1926³ in relation to games, commenting that “the Official Ruling cannot provide a valid guide to the interpretation of the 1977 Act, the more since the 1977 Act is, as I have indicated, to be interpreted having regard to the provisions of the European Patent Convention.” In *Aerotel* the Court of Appeal made it clear that the four-step test set out above should be used for all excluded categories and this test has since been applied in other cases relating to games such as in *IGT vs The Comptroller General of Patents*⁴ and in *Anderson’s Application*⁵.

9 Mr Pearson accepted this, although he cautioned that, in his view, inventions relating to games could be given a tougher ride than inventions relating to programs for computers which should not be the case. I am not sure that this is quite the point. As has often been commented, the exclusions set out in section 1(2) are a disparate collection. The four-step *Aerotel* test sets out a consistent methodology for determining whether a particular claimed invention lies solely in the excluded fields and each case is judged according to its contribution to the art and will require specific considerations.

Assessment

(1) *Properly construe the claim*

10 As regards the first step, Mr Pearson was happy to construe claim in the same manner as the Examiner had done in her pre-hearing report dated 19 December 2016. The only point of construction which appears to me is that the claim is directed towards a board game apparatus and yet also includes a set of rules which relate more to the method of playing the game. I will construe the claim to relate to both the apparatus set out in claim 1 and the rules which dictate how the apparatus functions as a game as set out in claim 1 which in my view is what the skilled reader would understand the words of the claim to mean.

(2) *Identify the actual contribution*

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

² *Shopalotto.com Ltd’s Application [2006] RPC 7*

³ Official Ruling 1926(A) (1926) 43 R.P.C. Appendix p.i.

⁴ *IGT vs The Comptroller General of Patents [2007] EWHC 1341*

⁵ *Anderson’s Application (BL O/112/12)*

- 11 *Aerotel* at paragraph 43 explains what the thinking should be behind determining the actual contribution;

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

- 12 Mr Pearson stated that he believed the contribution lies in the combination of specially shaped game pieces (the apparatus) and the rules, which have a synergy that is more than just the game as such. The combination of game pieces with different numbers of vertices and the way the number of vertices determine how the pieces move on the board result in a board game that is interesting to play and more intuitive than that of chess. Mr Pearson distinguished the present case from previous cases such as *Shopalotto*, *IGT* and *Anderson’s Application* in that in those cases the apparatus was either known or the game was implemented as a program for a computer. The fact that the apparatus is new in the present case distinguishes it from earlier cases.

- 13 In the description of the current application (page 2, lines 28-31) and indeed in claim 1, it is stated that “the rules dictate that the game pieces are to be moved across the board by a number of adjacent marked spaces less than or equal to the number of vertices of the game piece being moved.” I believe this is important as it is saying that it is the rules of the game that determine the form the game pieces will take and how they will interact with one another on the board. Board games comprising a plurality of marked spaces on which are arranged game pieces whose shapes are cubic, square based pyramidal, tetrahedral and spherical are known individually, as was demonstrated in prior art cited by the examiner during prosecution of the application. It is the claimed combination of sets of differently shaped polyhedral game pieces that distinguishes the current application from the prior art. What therefore is the contribution that the applicant has added to human knowledge? As I see it, the contribution lies in the way the rules of the game link the number of vertices of a game piece to the way that game piece moves across the board in the game, and the specific combination of game pieces which then arise out of these rules.

(3) Ask whether it falls solely within the excluded subject matter

- 14 In asking whether the contribution falls solely within the excluded subject matter Mr Pearson stated that whilst board games with individual shaped game pieces of the kind in the current application are known, the particular combination of such differently shaped game pieces was found to be both novel and inventive. This unique combination of game apparatus is a technical and tangible manifestation of the invention which, being mindful of *Aerotel*, should be considered in the same manner as computer software inventions. Mr Pearson stated that if we look at the board game apparatus in the same way as we look at computer hardware and the game rules in the same way as computer software, then the game rules do make a technical and tangible contribution on the apparatus. The problem being solved is an interesting and intuitive board game that can be played by children and adults alike

which is more interesting than draughts but is not as complicated or involved as chess.

15 In a further analogy with computer programs, Mr Pearson referred to the considerations made in *Symbian Ltd's Application*⁶ where the question of what amounts to a technical contribution was assessed and it was considered that a computer program may not be a computer program as such if it has an effect outside of a computer. Further, in *AT&T Knowledge Ventures' Application and CVON Innovations Ltd's Application*⁷, Lewison J (as he then was) set out five signposts that he considered helpful when considering whether a computer program made a relevant technical contribution. He reviewed them in *HTC v Apple*⁸ and they now read:

(i) whether the claimed technical effect has a technical effect on a process which is carried on outside the computer;

(ii) whether the claimed technical effect operates at the level of the architecture of the computer; that is to say whether the effect is produced irrespective of the data being processed or the applications being run;

(iii) whether the claimed technical effect results in the computer being made to operate in a new way;

(iv) whether the program makes the computer a better computer in the sense of running more efficiently and effectively as a computer;

(v) whether the perceived problem is overcome by the claimed invention as opposed to merely being circumvented.

16 Focussing on signpost (i) in particular, Mr Pearson referred to *HTC v Apple* where software is used to control the "swipe to unlock" function of a device such as a mobile phone or a tablet. The hardware (device) was known but the novel use of software was found to have an application on a real world tangible object to make it function differently, in essence having a virtual switch, and was considered non-excluded. Mr Pearson argued that the present case is analogous to such cases as synergy resulting from the interaction of the specially shaped pieces (i.e., tangible, real life objects) and the rules of the game, resulting in the interesting and intuitive board game, is where the contribution lies. Indeed Mr Pearson argued that the current application "was better than this" when comparing it with the *HTC v Apple* case in the sense that in the present case the hardware (the apparatus) is novel and inventive.

17 Mr Pearson compared the present case with an example of a board game which would in his view fail the "technical contribution" test. In his example he illustrated a game which utilised game pieces from the well-known game of Ludo where players each have two sets of coloured pieces and where pieces move double the amount indicated on the dice. This scenario would fall within the criteria for the exclusion of a method of playing a game as such since the apparatus is known and it is only the rules of the game that distinguish it from what has gone before.

⁶ *Symbian Ltd's Application* [2009] RPC

⁷ *AT&T Knowledge Ventures' Application and CVON Innovations Ltd's Application* [2009] FSR 19

⁸ *HTC v Apple* [2013] EWCA Civ 451

- 18 Mr Pearson also argued in the hearing that the unique combination of shaped game pieces and their interaction with the rules resulted in a board game possessed technical character since the game pieces were real world, tangible objects that were capable of industrial application.
- 19 I am not convinced that the *AT&T/Cvon* Signposts are particularly helpful when considering board games which do not involve a program for a computer. Moreover the analogy with computer programs is in my view not particularly helpful. As I have already said, it is often commented that the exclusions are a disparate group (see for example paragraph 9 of *Aerotel*). That said, I will consider Mr Pearson's argument that there is some kind of "technical effect" outside of a pure method, rule or scheme for playing a game introduced by the combination of the novel apparatus and the method of playing the game.
- 20 In my view the combination of differently shaped game pieces and how they move on the board depending upon their shape are to my mind determined solely by the rules of the game. The shape of the game pieces and how they interact on the board does not happen in a vacuum, it is the rules of the game that determine this. The core features of the invention are the link between the number of vertices of each playing piece and the way that piece moves across the board, and the numbers of piece on the board at the beginning of the game. Although there are apparatus features present in the claim, the contribution is governed entirely by the rules for playing the game. The contribution therefore lies solely in the excluded field of a method, scheme or rule for playing a game as such.

(4) Check whether the actual or alleged contribution is actually technical in nature

- 21 In accordance with my reasoning above I can find no technical contribution in the specific combination of apparatus and method for playing the game. Rather the contribution lies solely in the field of rules, schemes and methods of playing games and is not technical in nature. The invention is therefore excluded from patentability as a method, scheme or rule for playing a game as such.

Conclusion

- 22 I have found that the current application is excluded from patentability as it relates to a scheme, rule or method of playing a game as such. In light of this conclusion any remaining issues relating to added matter or omnibus claims are moot and need not be considered further. I have inspected the application and can see no amendments which would take the claimed invention out of the excluded fields. I therefore refuse the application.

Appeal

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

B Micklewright

Deputy Director, acting for the Comptroller