

PATENTS ACT 1977

APPLICANT Adobe Inc.

ISSUE Whether patent application GB1513403.4 is
excluded under section 1(2)

HEARING OFFICER H Jones

DECISION

Introduction

- 1 This decision relates to one of several applications from the same applicant that are broadly concerned with marketing activities in a digital environment. In each case the examiner is of the view that the applications relate to subject-matter excluded from patentability by virtue of section 1(2) of the Patents Act 1977 (“the Act”), more specifically as methods for doing business and programs for a computer as such. I have already issued a decision refusing three of the other applications on this basis ([BL O/360/19](#)).
- 2 The application describes content creation and deployment collaboration techniques, with multiple users having time-limited access to content as part of a workflow and users having different creation/editing rights in order to improve the efficiency of the workflow.
- 3 The examiner reported that a search would serve no useful purpose under section 17(5)(b) and, following several rounds of correspondence and some amendments to the specification, it falls to me to reach a decision based on the papers on file as to whether the application complies with section 1(2). I note that the examiner is of the view that the application as amended includes subject-matter that was not disclosed in the original specification. This has no bearing on the question of patentability and I will not consider it further.
- 4 I have dealt with the applicant’s points in relation to the law in my earlier decision (paragraphs 5-10) and do not propose to repeat them here.

The invention

- 5 The application, which was published as GB2532827, describes methods for creating content and deploying it as part of a marketing activity. As amended, there are independent method and system claims to the same inventive concept. Claim 1 reads as follows:

1. In a digital medium environment for creating a marketing activity, where the marketing activity involves creation of content as part of the marketing activity,

a system to create the content comprising one or more modules implemented at least partially in hardware, the one or more modules configured to perform operations comprising:

monitoring interaction of one or more users with content available via a shared network resource, wherein access to the shared network resource is managed by a managing user of the shared network resource and access is granted to the shared network resource to at least one other said user by the managing user, and

wherein access is granted to the at least one other said user, with a specific time limitation for that access, as part of a workflow initiated by the managing user to create the content, the workflow including one or more tasks that are specified through interaction with an activity stream;

collecting comments and markups made in association with the content as part of the monitored interaction;

automatically converting the content to include watermarking, digital rights management, or generated thumbnails;

wherein interactions with the content made by a user of a first user type are assigned a higher priority for processing within the shared network resource than interactions with the content made by a user of a second user type;

exposing a user interface for display to the at least one other said user that includes:

the converted content and the markups in which at least one of the markups is disposed over a display of the converted content; and

an activity stream that includes the collected comments;

responsive to the comments and markups being made by a user of the first user type, presenting the content and the markups for review without requiring approval by the managing user of the shared network resource; and

responsive to the comments and the markups being made by a user of the second user type, presenting the content and the markups for review and requiring approval by the managing user of the shared network resource.

6 The first step is to properly construe the claims. The attorney submits that the claims are sufficiently clear such that they see no need to further construe the terms, whereas the examiner finds the references to various different users and types somewhat confusing. I have some sympathy with the examiner in this regard. However, I think it is sufficiently clear that there are multiple users of at least two different types and more importantly I do not believe that this has any bearing on the section 1(2) question before me.

7 I move now to the next step, which is to identify the actual contribution. The attorney and the examiner agree that contribution is:

a networked computing system which is capable of granting users shared access to modify/create an item of content in a time limited manner and

where the representations of the content provided to the user are in a (unusable for malicious purposes) converted format, whilst prioritising and throttling processing of files within the shared network resource and avoiding unnecessary review and approval workflows for particular users.

- 8 I am generally content to adopt their agreed position. I would only comment that the claims relate to both a system and a method, in other words the contribution is not restricted to a system, that the content is part of a marketing activity and that the “unusable for malicious purposes” reflects the reference to watermarking, etc., in claim 1 above.
- 9 My next step is to consider whether the contribution I have identified falls solely within excluded subject-matter, either as a method for doing business as such or a program for a computer as such.
- 10 According to the attorney the contribution is far more than merely a method for doing business or a program for a computer and they go on to argue that the access time limitation and protection of the content are technical features providing a technical implementation addressing technical problems.
- 11 The examiner views the contribution differently, believing that the time limitation and the content protection are administrative, business decisions that do not provide a technical effect. In this regard the examiner quotes HHJ Birss QC in *Halliburton Energy Services Inc.*¹ saying:

35. The business method cases can be tricky to analyse by just asking whether the invention has a technical effect or makes a technical contribution. The reason is that computers are self evidently technical in nature. Thus when a business method is implemented on a computer, the patentee has a rich vein of arguments to deploy in seeking to contend that his invention gives rise to a technical effect or makes a technical contribution. For example the computer is said to be a faster, more efficient computerized book keeper than before and surely, says the patentee, that is a technical effect or technical advance. And so it is, in a way, but the law has resolutely sought to hold the line at excluding such things from patents. That means that some apparently technical effects do not always count. So a computer programmed to be a better computer is patentable (Symbian) but as Fox LJ pointed out in relation to the business method exclusion in Merrill Lynch, the fact that the method of doing business may be an improvement on previous methods is immaterial because the business method exclusion is generic.

- 12 It seems to me that in agreeing that the contribution lies in a system alone could lead one astray here. Undoubtedly a system is required and underlies the activities in the claims and the contribution. It is possible that means for limiting access time or marking content might constitute patentable subject matter. However, in this case, what the inventor has really added to human knowledge (to borrow words from *Aerotel*) is not such means nor a system, but rather the steps in the agreed contribution of which the system must be capable. That might be better thought of as a method. In the end the contribution facilitates collaborative working to create content for a marketing activity. I cannot see that this is anything other than a method of doing business, and the use of network resources, etc., does not change this.
- 13 Although I have decided that the invention is excluded as a business method I will also consider briefly whether it is excluded as a program for a computer. Having considered the *AT&T* signposts I agree with the examiner that there is no technical

¹ *Halliburton Energy Services Inc.*, [2011] EWHC 2508 (Pat)

effect from the claimed invention. In this regard the attorney only says that the contribution falls under at least the fifth signpost.

- 14 The first signpost asks whether the claimed technical effect has a technical effect on a process which is carried on outside the computer. Although clearly allowing for interaction with users of various types, in this case I believe that the activities forming the contribution are performed entirely within a computing system and that there is no technical effect.
- 15 The second signpost asks 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. This is not the case with this application, the claims are very specific about the kinds of data processed.
- 16 At the third signpost I must consider whether the claimed technical effect results in the computer being made to operate in a new way. Here again I agree with the examiner that it does not. The computing system underlying the claimed method and found in the system of the agreed contribution does not operate in a new way beyond performing the required steps, in effect the computer runs a program or application, but is otherwise unchanged by that program or application.
- 17 The contribution does not make the computer a better computer in the sense of running more efficiently and effectively as a computer and hence does not fall under the fourth signpost.
- 18 Since it “solves a technical problem”, the claimed invention falls under the fifth signpost as far as the attorney is concerned. The fifth signpost asks whether the perceived problem would be overcome by the claimed invention as opposed to merely being circumvented. In my view neither the problem nor the solution are technical in this case.
- 19 The final *Aerotel* step is to check whether the contribution is actually technical in nature and I do not believe this to be the case here. I think it should be clear by now that I do not feel that the applicant has raised substantial doubt regarding what is claimed in the current application. Consequently, it is my view that the subject-matter claimed is not patentable as it is both a method for doing business and a computer program as such.

Conclusion

- 20 Patent application GB1513403.4 does not comply with section 1(2) as it relates to a method for doing business and a program for a computer, these being areas of subject-matter excluded from patentability. I therefore refuse the applications under section 18(3).

Appeal

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

H JONES

Deputy Director, acting for the Comptroller