



PATENTS ACT 1977

APPLICANT Thomson Reuters Global Resources Unlimited
Company

ISSUE Whether patent application GB1407511.3 complies
with section 1(2)(c)

HEARING OFFICER Ben Buchanan

DECISION

Background

- 1 This decision relates to the issue of whether the application, GB1407511.3, published as GB2509667A, meets the requirements of section 1(2)(c) of the Patents Act 1977 (“the Act”).
- 2 Throughout the examination process, the examiner has maintained that the application is excluded from patentability under section 1(2)(c) of the Act. In their letter of 1st July 2019, the applicant filed amendments and arguments and requested that the application be passed to a Hearing Officer for a decision on the papers. I note the request in that letter that should the examiner believe that further features or equations in the claims may be beneficial or required, the opportunity to discuss them would be appreciated before the application is passed for a decision. The examiner considered the latest arguments and amendments and summarised his objections in his letter of 17th July 2019. In that letter he informed the applicant that the application would be forwarded for a decision. He has not specifically commented on the point about further features or equations and so I take it that he did not consider that these would change his assessment. The applicant’s arguments and observations are set out in their letters dated 21st January 2019 and 1st July 2019.
- 3 My analysis is based upon the claims filed on 1st July 2019 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 July 2019.
- 4 The specification including the claims, the objections raised by the examiner and the applicant’s arguments and observations can all be viewed at the IPO’s online file inspection service:

<https://www.ipo.gov.uk/p-ipsum.htm>

Subject matter

- 5 The claimed invention relates to a method of providing a database of contracts to enable a user to identify preferred wording. This is achieved by merging a corpora of conceptually related contract texts, comprising contract clauses, into a cluster based on a similarity threshold comparison. The similarity is determined according to a calculated centroid for each corpus. Following a merge of corpora, a new centroid is estimated rather than recalculated, saving computational resource. A model contract is developed based on the probabilities of certain contract clauses appearing in the cluster. This model contract is representative of the “market standard” language for a particular set of contracts. Portions of contract text (e.g. clauses) can then be compared to the model to determine how much they deviate from it (using a so-called “novelty measurement”) and the results can be provided to a user.

The law

- 6 The relevant law is defined in section 1(2) of the Act and can be viewed online at the IPO’s website:

The Act: <https://www.gov.uk/guidance/the-patent-act-1977>

The Rules:

https://www.gov.uk/government/uploads/system/uploads/attachment_data/file/694249/Patents-Rules-2007-06042018.pdf

- 7 The Manual of Patent Practice explains the IPO’s practice under the Act and makes helpful references to relevant case law. The Manual can be viewed online at the IPO’s website: <https://www.gov.uk/guidance/manual-of-patent-practice-mopp>. In particular, sections 1.33-1.39.2 are helpful which relate to business methods and computer programs.
- 8 There is no dispute concerning the relevant law and its application to the facts of this case.

Argument and analysis

- 9 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 as set out in his letter dated 17th July 2019 and find that the application fails to meet the requirements of section 1(2)(c) of the Act.

Conclusion

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

Appeal

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

Ben Buchanan

Deputy Director, acting for the Comptroller