



BL O/226/06

10th August 2006

PATENTS ACT 1977

APPLICANT Sony Electronics, Inc

ISSUE Whether patent application numbers
GB 0423858.0 and GB 0423859.8 relate
to patentable inventions

HEARING OFFICER Bruce Westerman

DECISION

Introduction

- 1 Patent applications GB 0423858.0 and GB0423859.8 are the national phase cases of applications originally filed under the Patent Cooperation Treaty.
- 2 Both cases were examined in the usual way before the UK Patent Office, by two different examiners. On both cases, prior art was initially raised as relevant to considerations of novelty and/or inventive step, but this has now been resolved. Again on both, objection was raised that the respective invention was not patentable as being in an area excluded under section 1(2) of the Patents Act 1977. On both cases, however, it became clear that no agreement could be reached on the issue of patentability, and so hearings were offered and accepted to determine this on each.
- 3 The matters therefore came before me on 26 July 2006, where Dr Jonathan DeVile (of the firm D Young & Co) appeared for the applicant. Both examiners (Matthew Cope and Steven Gross) also attended.
- 4 At the outset of the hearing, Dr DeVile said that he felt it important to think about the two cases separately, because, he said, although they are based on a common specification, the ideas are quite distinct. Nevertheless, he dealt with issues common for the two cases and the legal background, then diverting to consider the two separately. In view of this I think it will be more economical if I were to deal with both cases in this one decision. In presenting his case, Dr DeVile made use of a PowerPoint ® presentation, which I found helpful and the copy he left with me I found an extremely useful aide-memoire in considering the issues after the hearing.

The Applications

- 5 Both applications are concerned with improvements in peer-to-peer

communication between users of a communications network, but, as Dr DeVile said, are concerned with distinct and different improvements in the two cases. In GB0423858.0, the invention is to do with revealing information of interest to a user by attaching information to a file representing previous users, so that a subsequent user can establish a communications session with a previous user to find related information files. In GB0423859.8, the invention is to do with identifying users with similar interests by polling a user community to find users with common interests which each has selected by recording an identifier for the interest. Both cases have claims to methods, machine-readable medium incorporating instructions to perform the method, and device or apparatus claims for performing the method. I think it is enough for present purposes if I quote the method claims for the two inventions here.

6 *GB0423858.0* – claim 1 reads:

1. A computerized method, comprising:

receiving at a first user device a digital content file having metadata representing user history information, the user history information including data representing an alias name of a previous user of the digital content file;

reviewing the user history information; and

establishing a peer-to-peer communications session via a communications network with a second device associated with the previous user as a result of reviewing the user history information, to initiate a relationship with the previous user of the digital content file in accordance with the user history information, and

searching for a related digital content file based on the alias name using the relationship established by the peer-to-peer communications session.

7 *GB0423859.0* – claim 1 reads:

1. A method to visually identify to a first of a plurality of users on a data communications network, which of one or more of a plurality of other users of data processing devices share a common interest, the method comprising;

generating first persona information in response to a selection by a first user of media items for entertainment using a first data processing device associated with the first user, the first persona information including media identifiers representing the user's selection of media items for entertainment;

generating a polling query message, the polling query message including at least part of the first persona information,

communicating the polling query message from the first data processing device to a second data processing device via the data communications network;

correlating within the second data processing device the media identifiers included in the first persona information with data identifiers included in

second persona information associated with a second user of the second data processing device;

to identify common media identifiers between the first and second persons information;

adapting the polling query message to identify the common media identify the common media identifiers,

communicating the adapted polling query message to the first data processing device

generating and displaying a visualization of the first and second data processing devices relative to a common interest identified in the first and second persona information of the first and second users at the first data processing device in accordance with the common media identifiers; and

initiating a relationship between the first and second devices based on the common media identifiers.

The Law

8 The examiners took objection under section 1(2) of the Act, which states:

“1(2) It is hereby declared that the following (among 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.”

9 As explained in the Practice Notice¹, issued on 29 July 2005, current practice before the UK patent office reflects the approach adopted by Peter Prescott

¹ “Patent Office Practice Notice: Patents Act 1977: Examining for patentability” – see <http://www.patent.gov.uk/patent/notices/examforpat.htm>

QC, sitting as a Deputy Judge, in his judgment in *CFPH*². He established a test which comprises the following two steps:

Identify what is the advance in the art that is said to be new and not obvious (and susceptible of industrial application).

Determine whether it is both new and not obvious (and susceptible of industrial application) under the description “an invention” in the sense of Article 52 of the European Patent Convention (EPC) – broadly corresponding to section 1 of the Patents Act 1977.

- 10 I have to say, however, that Dr DeVile, at the hearing expressed doubt as to the applicability of this test, as I discuss below.

Argument as to issues in common and the law

- 11 It is clear from the correspondence, and what was said at the hearing, that the objection taken by the examiners was that the inventions are in substance to a computer program. Dr Devile argued that both these inventions are to do with interactions between devices in communication, and therefore can't be characterized as “a program for a computer”, given the basic principle of construction of statute which requires an exclusion to be construed narrowly.
- 12 He also referred me to section 130(7) which requires that I should, as far as practicable, make a decision which would have the same effect as under the provisions of the European Patent Convention. At the hearing, and more specifically in the correspondence prior to the hearing, Dr Devile alluded to an examination report on the equivalent case to GB0423859.8 from the EPO examiner which he said “hinted very strongly” that the invention made a new and non-obvious contribution to the art.
- 13 He referred me to the TRIPS Treaty, Article 27 of which requires that patents are available in all areas of technology.
- 14 He expressed the view that the application of the CFPH tests is not appropriate in this case, but that I should be considering against a background taught by the decisions in *Vicom*³, *Fujitsu*⁴, *IBM*⁵, *Hitachi*⁶, *Shopalotto*⁷, *ARM*⁸ and *Sun Microsystems*⁹. He said that the UK Courts and Patent Office have used different tests for determining obviousness, and that, in his view, the second of the two *CFPH* tests will lead to different results than applying the test in *Hitachi*, and thus *CFPH* could, in his view, be misleading. He put forward an analysis based on the problem/solution approach for the two cases, which he said is the approach I should follow. He also felt that I should be looking for a

² *CFPH LLC's Application* [2005] EWHC 1589 Pat

³ EPO T 0208/84

⁴ [1997] EWCA Civ 1174

⁵ EPO T 0935/97

⁶ EPO T 0258/03

⁷ [2005] EHC 2416

⁸ BL O/066/06

⁹ BL O/057/06

“technical effect”.

- 15 There was also some discussion at the hearing as to whether the fact that the invention could be embodied in hardware or in software affected the decision as to patentability under the computer program exclusion. Dr DeVile asserted that, if embodied in hardware, this would be a novel in the sense that it reacts in a different way. The examiner argued that this was an occasion where the hardware would react in this different way purely because of the underlying software programming.

Decision on common issues and law

- 16 Taking first the issue of the TRIPS Agreement. The specific article of interest is Article 27 which concerns the range of subject matter for which patent protection must be made available by signatories to the Agreement. The parts of Article 27 which Dr DeVile stressed in his presentation say (with his emboldening to emphasise the relevant words);

“patents shall be available for **any inventions**, whether products or processes, **in all fields of technology**, provided they are new, involve an inventive step and are capable of industrial application.”; and

“patents shall be available and patent rights **enjoyable without discrimination as to the** place of invention, **the field of technology** and whether products are imported or locally produced.”

- 17 The TRIPS Agreement has not changed what is and is not patentable in the UK. It is a general principle that Treaties are not self enacting. Therefore any change in existing law that is to be introduced as a result of a treaty becoming effective need to be enacted in legislation. That the TRIPS Agreement is no exception to this principle was confirmed by Jacob J in *Lenzing AG's European Patent (UK)*¹⁰, where he found that the Agreement has no direct effect. In other words, the Agreement did not automatically override any existing law when it became effective on 1 January 1996. No amendments to the exclusions contained in section 1 of the Act have been deemed necessary following the coming into effect of the Agreement. I therefore do not feel that this argument is of relevance to my current task which is to decide whether the application in suit meets the requirements of the Patents Act.
- 18 It is convenient to turn next to Dr DeVile's submissions on the appropriateness of the *CFPH* approach, namely that this judgment is inconsistent with EPO decisions and practice. In this context I note firstly that one of the principal drivers behind the *CFPH* judgment was to reconcile the differences in the approaches of the EPO and the UK Patent Office on patentability. The Deputy Judge made an extensive analysis of the case law – of both the UK courts and the EPO - before proposing the two step approach referred to above. He concluded that the two approaches should provide the same result if applied properly. In its aim of providing a convergence of approach consistent with case law, this judgment in fact moves away from the old UK approach towards

¹⁰ [1997] RPC 245

the EPO approach.

- 19 I think the proper position is that in assessing patentability, I must have regard primarily to the Patents Act and to the precedents on its interpretation provided by judgments of the UK courts. By following the guidance in these judgments, I shall be taking into account EPO decisions to the extent intended and approved by the UK courts. Decisions of the EPO Boards of Appeal are of persuasive value and to the extent they are consistent with the interpretation applied by the UK courts, I can also take them into account directly. Mr Prescott in his discussion in *CFPH* frequently equates what is patentable with technology and technical subject matter and subsequent judgments have confirmed that *CFPH* is not inconsistent with the technical contribution approach eg as in *IBM*, *Hitachi* and *Fujitsu*. However, “consistent with” does not mean “exactly the same as”. What has changed is how one analyses the invention in order to make that determination. The *CFPH* judgment provides a new way, arguably more secure and consistent in its application, of doing so. I am bound to follow this precedent and adopt this way of analysis. However, I feel able to acknowledge, given the body of case law, that, in my view, if the advance in fact involves a “technical effect” then the invention cannot relate to excluded subject matter. The second *CFPH* test does not, unfortunately, assist with the very difficult determination of what is and what is not technical.
- 20 Turning now to the submission that these inventions cannot be “a program for a computer” as, in operation, there are at least two computers (“data processing devices” or “user devices” in the claims) involved, communicating over a network. I am afraid that I cannot agree. My understanding of the inventions taken from the specifications and the explanations given at the hearing is that, in operation of the method, various specified effects and actions take place at one or another of the computers. Looked at from the point of view of the method, this gives the impression that Dr DeVile was emphasizing. However, it seems to me that this is too narrow a view. To be a participating member of the peer-to-peer community within which these inventions work, it would seem to me clear that each data processing device must contain all of the functionality to act as a “first user” and as a “second user” or “previous user”. Therefore, in reality, each device has all of the software, whether or not all of it is in use at any one time.
- 21 As to the argument that the exclusion must be given a narrow view, and thus “a program for a computer” means a single unitary collection of instructions, again, I cannot agree. As was said during correspondence, it is commonplace for programs to be modular, with sub-routines called when appropriate. The Patents Act clearly intends programs to be excluded, and I think it would make a nonsense of the clear intention of Parliament if this exclusion could be avoided merely by saying that different sub-routines are performed in different physical locations eg processors. This is particularly so in the modern world where computers with multiple processors are well-known. I consider that this would equally apply here, even if the processors are separated and connected by a communication link, which was acknowledged at the hearing as conventional.
- 22 I think that this issue is related to the discussion as to hardware/software that

took place at the hearing. The expression of the functionality as a method has been given an importance that belies the substance of the invention. It is well-established law that, in patentability cases, the focus should be on the underlying substance of the invention, not the particular form in which it is claimed. Having carefully considered all of the submissions, I am convinced that, in principle, the inventions lie in the underlying series of instructions and actions to produce the specified effects. Whether this is a program for a computer as such and therefore excluded, will depend upon the application of this principle to the facts of the two inventions.

GB0423858.0

- 23 At the hearing, Dr DeVile took me through the prior art, US6029161, which was cited at an earlier stage of the proceedings to demonstrate what was new and not obvious about the invention. The examiner took no issue with his analysis. I find myself in agreement with Dr DeVile's analysis, and therefore find that, in answer to the first *CFPH* test, the advance in the art which is said to be new and non-obvious is a computerized method or device where the use of metadata attached to content files allows the identification of an alias name of a previous user to enable searching of other files for content in a communication session with the previous user.
- 24 So I must now turn to the second test. Dr DeVile presented the invention as being a solution to a technical problem. As he said "The technical problem is how to search for media items within a peer-to-peer network" and he emphasized that no server was involved in the search process. He then presented the technical solution as being the provision of the meta-data which includes anonymous identifiers of previous users ("aliases"). He said that advantages of this is that the invention could be used to determine copyright and/or surveys as to usage.
- 25 It was acknowledged at the hearing that the communications techniques and the search techniques were not at the heart of the invention. It is clear to me that the invention depends upon the content of the communications, choice of information to record, and where to record it. Once the decision is taken of what to store and enquire upon, there is neither technical invention to doing this nor any improvement at a technical level. It is clear that the hardware and programming techniques to put the invention into effect (whether embodied in hardware or software) are entirely conventional. Even the absence of a central server, presented as being a technical effect, is a natural consequence of the selection of content and storage location. Thus, any improvement is to do with the choice of intellectual information and the program instructions to use it. Any perceived problems are not solved in a technical manner in the invention, but are avoided by the intellectual selection of information and its storage location. Try as I might, I can not perceive of this as having any technical character, as was argued for. I therefore find that the invention relates to a computer program as such and thus is not an invention that I can say is "new and not obvious (and susceptible of industrial application) under the description "an invention" in the sense of Article 52 of the European Patent Convention (EPC)".

26 At the hearing, I asked Dr DeVile whether, in the event that I found the invention at the level of the independent claims to be not patentable, there was anything within the application that he would argue would confer patentability. He was unable to point to anything. I have carefully considered the content of the application, and can see nothing which I consider would save the application. I must therefore refuse this application.

GB0423859.8

27 As with GB0423858.0, Dr Devile used the documents which were cited during prosecution to demonstrate what was new and not obvious about the invention. Again, the examiner took no issue with this, and I again find myself in agreement with Dr DeVile's analysis. I therefore find that, in answer to the first *CFPH* test, the advance in the art is, in the context of a data communications network including a method or device in which users self-select identifiers to indicate their personal interest(s), a method or device which allows a first user to send a polling enquiry to a second where the list of identifiers is correlated with those of the second whereupon the message adapts and returns the polling message showing which identifiers the second and first users have in common.

28 Dr Devile said that the technical problem is how to identify users within a peer-to-peer network with common interests without using a central server as in the prior art, and again indicated that the method had the advantage that it could be used in copyright protection or in surveying users.

29 Again it was acknowledged at the hearing that the communications link was conventional, as was the correlation operation. I think it is again abundantly clear that the hardware and programming techniques to put the invention into effect (whether in hardware or software) are entirely conventional. The differences lie at the higher, conceptual level of where to store information.

30 I can perceive of no technical advance in deciding to store known information in a different place. Whilst doing this will indeed avoid the need for a central server, this is just what it says, an avoidance of a technical problem, not a technical advance solving this problem. I therefore find that the invention relates to a computer program as such and thus is not an invention that I can say is "new and not obvious (and susceptible of industrial application) under the description "an invention" in the sense of Article 52 of the European Patent Convention (EPC)".

31 I specifically asked Dr Devile at the hearing whether, were I to find the main claims unpatentable, there was anything else in the specification that he would argue as being patentable. He suggested, firstly, including reference to a third user, to reinforce the polling around the community. Secondly, he referred to the possibility of including the feature in this case that an identifier could be a web address of a site which has been visited by a user.

32 I do not consider that either of these would add anything which would change my decision above. I do not consider that extending to a third user would add anything patentable or technical. The invention would still be concerned with

the fundamental idea of storing information in a particular place. As for using a web-site address as one or more of the identifiers, this is all about the intellectual content of the information, and not anything technical. I have considered the rest of the specification, and can see nothing else which I would consider to make the invention fall outside the exclusion, and therefore must refuse the application

Conclusion

- 33 For the reasons given above, I refuse both applications. Also, since I have determined that I can see no saving amendment within either application, I do not give any further opportunity to amend.

Appeal

- 34 Under the Practice Direction to Part 52 of the Civil Procedure Rules, any appeal must be lodged within 28 days.

Bruce Westerman

Deputy Director acting for the Comptroller