



20 October 2010

PATENTS ACT 1977

APPLICANT Phorm UK Inc.

ISSUE Whether patent application number
GB 0619385.8 complies with section 1(2)

HEARING OFFICER S. Brown

DECISION

Introduction

- 1 This decision concerns the issue of whether the invention claimed in UK patent application GB 0619385.8 relates to non-excluded subject matter as required by section 1(2) of the Act. The application is entitled "Targeted content delivery for networks". It was filed on 2nd October 2006 and was published as GB2436158 A.
- 2 During the examination process, it was reported that the invention defined in the claims was excluded as a method of doing business and/or a program for a computer. The applicants and the examiners have been unable to resolve this issue and a decision on the papers was requested on 20th August 2010.

Decision in Brief

- 3 Following the Aerotel test, the contribution in this case can be identified as a service provider which analyses requested content for characteristics, receives browsing information from other service providers and then selects targeted content based on said characteristics and said browsing information. For claim 1, the service provider further embeds a reader in the requested content so that the analysis for characteristics is performed at the node making the request.
- 4 This contribution is not at the same level of generality as Symbian - its benefits only extend to the better delivery of targeted content. Neither the network nor any computing devices on it appear to be working any better because of this invention. I thus conclude that the contribution consists solely of excluded subject matter and does not have a relevant technical effect. It **fails the Aerotel test** as no more than **a program for a computer** as such. I can see nothing that could be reasonably expected to form the basis of a valid claim and therefore **refuse** the application under section 18(3). The applicants may **appeal** within 28 days.

- 5 Due to delays in this Office I will **extend the period of compliance to 19th November 2010**. I will now explain my decision in more detail:

The Application

- 6 For this decision I will consider the most recent version of the claims - i.e. those filed in 'marked up' form with the agents' letter of 18th March 2008. There are 25 claims in total comprising 2 independent claims - the claims numbered 1 and 13. Claim 1 reads:

A method for a service provider to target content delivery to a network node based on information requests from the network node, the method comprising

Receiving a content request from the network node;

Facilitating delivery of requested content to the network node responsive to the content request and embedding a content reader in the requested content delivered to the network node, said content reader executable at the network node to identify one or more characteristics of the requested content;

Receiving supplemental browsing information from a different service provider indicating content requested by other network nodes; and

Facilitating delivery of targeted content to the network node, where the targeted content is selected based on the browsing information received from the content reader and further based at least in part on the supplemental browsing information received from the different service provider.

- 7 Claim 13 is of a similar scope to this except that it does not include the use of an embedded content reader, instead it receives a plurality of content requests for web pages including text from the network node, identifies characteristics of the requested text, and selects targeted content based on these characteristics along with the supplemental browsing information received from the different service provider.

The law and its interpretation

- 8 Section 1(2) reads:

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:

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

.....

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 It is not disputed that the assessment of patentability under section 1(2) is governed by the judgment of the Court of Appeal in *Aerotel Ltd v Telco Holdings Ltd* and *Macrossan's Application* [2006] EWCA Civ 1371, [2007] RPC 7 ("*Aerotel*"). In this case the court reviewed the case law on the interpretation of section 1(2) and approved a four-step test for the assessment of patentability, namely:
- 1) Properly construe the claim
 - 2) Identify the actual (or alleged) contribution
 - 3) Ask whether it falls solely within the excluded matter
 - 4) Check whether the contribution is actually technical in nature.
- 10 The operation of the test is explained at paragraphs 40 - 48 of the judgment. Paragraph 43 confirms that identification of the contribution is essentially a matter of determining what it is the inventor has really added to human knowledge, and involves looking at substance, not form. Paragraph 47 adds that a contribution which consists solely of excluded matter will not count as a technical contribution.

Application of the Aerotel test

Properly construe the claim

- 11 I do not think that any problems arise over the construction of the claims. They relate to methods for a service provider to target content delivery to a network node based on information requests from the network node.

Identify the contribution

- 12 In his letter of 18th March 2008, the agent argued that one aspect of the contribution lay in analysing the requested content 'on the fly' to pull out one or more characteristics. This, it was argued, is a technical advantage over the prior art which uses libraries of URLs built up over time to help target content delivery. I am happy to accept that this is indeed part of the contribution for both independent claims.
- 13 In the same letter, the agent also argued that another aspect of the contribution was the use of supplemental browsing information from other service providers indicating content requested by other network nodes. This aspect was not disclosed in the prior art. Again, I am happy to accept this as part of the contribution for both independent claims.

- 14 Finally, the agent argued that the use of a content reader located at the network node to identify characteristics was a key aspect of the contribution. Again he argued that this represents a technical advantage over the prior art by placing the computing burden at the network node rather than at the service provider. Once again, I am happy to accept this as part of the contribution but only for claim 1. Claim 13 does not include the provision of a content reader at the network node.
- 15 To summarise: The contribution is a service provider which analyses requested content for characteristics, receives browsing information from other service providers and then selects targeted content based on said characteristics and said browsing information. For claim 1, the service provider further embeds a reader in the requested content so that the analysis for characteristics is performed at the node making the request.

Ask whether it falls solely within the excluded matter

- 16 There is no doubt that the contribution is delivered by software running on conventional computing devices in a conventional network. The key question is thus: 'is it more than a program for a computer as such?'
- 17 In *Symbian Ltd v Comptroller General of Patents*, [2008] EWCA Civ 1066 ('Symbian'), it was decided that a software based invention was not excluded "because it has the knock-on effect of the computer working better as a matter of practical reality" [see paragraph 59]. This point is further emphasised in paragraph 34 of *AT&T Knowledge ventures LP & Cvon Innovations Ltd v Comptroller General of Patents* [2009] EWHC 343(pat) ('Cvon'), where Lewison J states:

In Symbian itself, the invention was patentable because it resulted in a faster and more reliable computer. The increase in speed and reliability was not, as I understand the invention, dependent of the type of data being processed or the particular application being used to do the processing. The invention operated at a much higher level of generality within the computer.

- 18 The contribution in this case does not operate at the same level of generality as Symbian. Its benefits only extend as far as making the delivery of targeted content better. To my mind this is a high level software effect. Even claim 1's feature of placing the characteristic identification step at the network node only serves to better share out of the processing burden of performing said delivery. Contrary to the agent's arguments in his letter of 3rd April 2009, neither the network nor any computing devices on it appear to be operating any better because of this invention. Unlike Symbian, the benefits are not there irrespective of the applications being run or the data being processed. Indeed the 'target content delivery' method appears to be no more than a high level application run by the service provider.

- 19 I am thus forced to conclude that the contribution consists only of excluded subject matter being no more than a program for a computer as such. It therefore fails the third Aerotel step.

Check whether the contribution is actually technical in nature

- 20 As reasoned above, the contribution does not have an effect beyond being software to deliver targeted content. This is not a relevant technical effect and thus the application also fails the fourth Aerotel step.

Decision

- 21 I have found that the contribution made by the invention defined in the independent claims falls solely in subject matter excluded under section 1(2). I have read the specification carefully and I can see nothing that could be reasonably expected to form the basis of a valid claim. I therefore refuse this application under section 18(3).

Appeal

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

Extension of period for compliance

- 23 There have been several delays in reaching this point due, at least in part, to errors in this Office. In light of this, under rule 107, I hereby extend the period of compliance for this case to 19th November 2010.

Dr. S. Brown

Deputy Director acting for the Comptroller