



04 November 2010

**PATENTS ACT 1977**

APPLICANT Intuit Inc.

ISSUE Whether patent application number  
GB 0812561.9 complies with section 1(2)

HEARING OFFICER Dr. S. Brown

---

**DECISION**

**Introduction**

- 1 This decision concerns the issue of whether the invention claimed in UK patent application GB 0812561.9 relates to non-excluded subject matter as required by section 1(2) of the Act.
- 2 The application is entitled "Method and system for facilitating usage of an edition of a software product". It was filed on 9<sup>th</sup> July 2008 and was published as GB2452802 A.
- 3 During the examination process, the examiner reported that the invention defined in the claims was excluded as a mental act and/or a program for a computer. Despite several of rounds of amendment the applicants and the examiner were unable to resolve this issue and a hearing was held on 6<sup>th</sup> September 2010. The applicants were represented by Mr. Simon Davies of D. Young & Co. The examiner, Mr. Jake Collins, also attended.

**Decision in Brief**

- 4 Following the *Aerotel* test, the contribution in this case can be identified as a better way of upgrading software by monitoring usage and enabling the use of a simpler program where suitable. This process may result in the use of a smaller and simpler version of the software which may require less memory and may be more reliable.
- 5 However, I consider that, unlike in *Symbian*, this contribution does not result in the computer itself operating better. This conclusion is reinforced when the signposts in *Cvon* are considered. I am forced to conclude that the contribution consists only 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. I will now explain my decision in more detail:

## The Application

- 6 The claims I was asked to consider at the hearing were filed on 8<sup>th</sup> March 2010. There are 17 claims in total comprising 3 independent claims (claims 1, 5 and 10) which relate respectively to a method, a system, and a computer readable medium comprising software instructions. All are for monitoring the usage of a computer product, making a recommendation for another edition of the product based on the results of said monitoring, then enabling use of the other version. While there are minor differences between the independent claims, claim 1 is typical and reads:

*A computer-implemented method for facilitating usage of a product, comprising:  
obtaining a usage level of a feature in a first edition of the product by the user by recording usage statistics for usage of the product by the user;  
determining an inactivity level of the feature by the user from the usage level, wherein the activity level of the feature is determined over a period of time dependent on usage statistics for other users of the product;  
suggesting a second edition of the product to the user based on the inactivity level of the feature, wherein the second edition of the product corresponds to a lower edition of the product that does not include said feature of the first edition; and  
facilitating use of the second edition of the product by the user.*

## The law and its interpretation

- 7 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.*

8 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.

9 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

10 I do not think that any problems arise over the construction of the claims. The description makes it clear that 'the product' refers to any sort of conventional computer program. The second edition is 'lower' in the sense of being simpler or offering less options or features. Facilitating use of the second edition means installing said edition or otherwise allowing the user to access or purchase it. It is also clear that the monitoring and recommendation steps are performed by a second program.

11 So in short, the claims relate to monitoring the usage of a conventional program, making a recommendation for an updated version of the program based on the results of said monitoring, then enabling the installation of the recommended version. It should be noted that the user may ignore the recommendation and either not update the conventional program or install a different version.

#### Identify the contribution

12 Mr. Davies argued that what has been added to human knowledge in this case is a better way of upgrading software. In many cases the monitoring will result in the recommendation of a 'lower' version of the program. If this version is chosen and installed it will take up less memory and, by virtue of its greater simplicity, be less likely to malfunction.

- 13 Mr. Davies accepted that these benefits would not occur for all users. Some may ignore the recommendation to upgrade to the simpler version or even have the less simple version recommended to them. However, Mr. Davies felt that a significant number of users would end up with the simpler version and so when considering many users there would be a net contribution overall. Further, the claims were limited only to the case where use of the second 'lower' edition was enabled.
- 14 I am happy to accept Mr. Davies's identification of the contribution. So to summarise the contribution is a better way of upgrading software by monitoring usage and enabling the use of a simpler version where suitable such that some users can use less computer memory and may experience less errors.

Ask whether it falls solely within the excluded matter

- 15 Prior to the hearing, the examiner had reported that the invention defined in the claims was excluded as a mental act and/or a program for a computer. Mr. Davies approached these two issues separately.
- 16 Firstly, he argued that a narrow interpretation of the mental act exclusion was the correct approach. Under this the contribution cannot be excluded as a mental act as aspects of it are performed electronically in 'the real world'. Mr. Davies reminded me of paragraph 62 in the *Aerotel* judgement which states:

*Before us, as we have said in the Appendix, the Comptroller does not support Mann J's decision as to a mental act: we are doubtful as to whether the exclusion extends to electronic means of doing what could otherwise have been done mentally. But it is unnecessary to decide the point, for we are firmly of the opinion that the patent is both for a method of doing business as such and for a computer program as such.*

- 17 Mr. Davies also reminded me of the judgement in *Rajesh Kapur v Comptroller General of Patents* [2008] EWHC 649 (Pat) ("*Kapur*"), where in paragraph 20 Mr. J. Floyd stated in relation to the mental act exclusion that:

*In my judgment the narrow view of the exclusion is the correct one. More specifically I think the correct view is that, provided the claim cannot be infringed by mental acts as such, its subject matter is not caught by the exclusion. It seems to me that if this were not so the scope of the exclusion would be unacceptably broad, as well as being uncertain in scope. It follows that the exclusion will not apply if there are appropriate non-mental limitations in the claim. In those circumstances it will not be possible to infringe the claim by mental acts alone, and the invention will not comprise a method for performing a mental act.*

- 18 I am grateful for Mr. Davies bringing these points to my attention. Following the approach in *Aerotel* and for the sake of argument and brevity, I am willing to accept the narrow interpretation and move on to the program exclusion.

- 19 In the judgment of the Court of Appeal in *Symbian Ltd v Comptroller General of Patents* [2008] EWCA Civ 1066 ('Symbian') paragraph 59 states:

*Next, it is appropriate to consider our conclusion in accordance with the guidance given at [40] in Aerotel. Stage 1 is not in issue. As to the stages 2 to 4:*

*Stage 2 Identify the contribution:*

*A program which makes a computer operate on other programs faster than prior art operating programs enabled it to do by virtue of the claimed features.*

*Stage 3 Is that solely excluded matter?*

*No, because it has the knock-on effect of the computer working better as a matter of practical reality.*

*Stage 4 Is it technical?*

*Yes, on any view as to the meaning of the word "technical".*

Mr. Davies argued that in this case, as in *Symbian*, the new way of upgrading software could lead to the computer working better for some users and thus the invention was not excluded and was technical.

- 20 I am not convinced by this reasoning. Paragraph 54 of *Symbian* states that:

*More positively, not only will a computer containing the instructions in question "be a better computer", as in Gale, but, unlike in that case, it can also be said that the instructions "solve a 'technical' problem lying with the computer itself". Indeed, the effect of the instant alleged invention is not merely within the computer programmed with the relevant instructions. The beneficial consequences of those instructions will feed into the cameras and other devices and products, which, as mentioned at [3] above, include such computer systems. Further, the fact that the improvement may be to software programmed into the computer rather than hardware forming part of the computer cannot make a difference – see Vicom; indeed the point was also made by Fox LJ in Merrill Lynch.*

- 21 In this case the invention does not solve a technical problem lying with the computer itself. Mr. Davies made it very clear that the problem overcome was that not all users need the 'full' version of a program. The usage patterns of some users mean they could instead use a smaller and simpler version. To my mind this distinguishes the current case from *Symbian*. Another possible distinction turns on whether the contribution in this case results in a better computer (as in *Symbian*) or just a better choice of new software.

22 Naturally, Mr. Davies argued the former, pointing out to me that the technology of the current case sat below the application level and would work with any conventional program. In short the technology had a broad generic use and some users would just experience better software after upgrading.

23 Again, I am not wholly convinced by this reasoning. In *AT&T Knowledge ventures LP & Cvon Innovations Ltd v Comptroller General of Patents* [2009] EWHC 343(pat) ('Cvon') Lewison J states (at paragraph 34):

*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.*

24 Despite Mr. Davies's arguments I am not convinced that the contribution in this case operates at the same level of generality as that in Symbian. Further, in paragraphs 39-41 of Cvon, Lewison J went on to say:

*It seems to me, therefore, that Lord Neuberger's reconciliation of the approach in Aerotel (by which the Court of Appeal in Symbian held itself bound, and by which I am undoubtedly bound) continues to require our courts to exclude as an irrelevant "technical effect" a technical effect that lies solely in excluded matter.*

*As Lord Neuberger pointed out, it is impossible to define the meaning of "technical effect" in this context, but it seems to me that useful signposts to a relevant technical effect are:*

*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 there is an increase in the speed or reliability of the computer;*

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

*If there is a technical effect in this sense, it is still necessary to consider whether the claimed technical effect lies solely in excluded matter.*

25 Taking these signposts one at a time:

- i. While the conventional program which is being monitored and upgraded may well have an external impact the technical effect of the contribution identified above does not extend this far. Likewise, even if the facilitating step requires external links, the use of such links to install software is very well known. The contribution itself resides solely within the computer.
- ii. The technical effect clearly operates further away from the level of the architecture of the computer than that in Symbian. Despite Mr. Davies's arguments about how it can operate with any conventional program that is clearly not the same level of generality as Symbian achieved. In this case the effect is not produced irrespective of the data being processed or the applications being run. Indeed the contribution sits just below the level of an application and thus at a very high level within the hierarchy of a computer's software;
- iii. In this case the computer itself is not operating in a new way;
- iv. While the invention may result in a software upgrade which may then operate faster, more reliably, or require less memory, the computer remains unaltered. Even the program being monitored and upgraded is operating entirely conventionally. The invention is only offering a more informed choice of upgrade to the user;
- v. The prior art problem of using an unnecessarily large and complex version of a program is overcome but this is a problem relating solely to the operation of a high level software product. The benefits of using less memory and increased reliability claimed by Mr. Davies are mere potential side effects of the invention that may occur, some of the time, for some users. They do not arise directly from the invention.

26 The invention in this case does not meet any of the above signposts with the possible exception of (ii). Looking at this signpost again the key question is: is the contribution made at a low enough level to avoid exclusion? Specifically, is the contribution in this case closer to that of Symbian, which the courts have decided is not excluded, or to the theoretical 'program for a computer as such', which is?

27 To recap: The contribution in this case is a better way of upgrading software by monitoring usage and enabling use of a simpler version where suitable. While this may result in the use of a smaller and simpler version of the program this contribution resides just below the application level. Unlike the contribution in Symbian it does not result in the computer itself operating better. In light of all of this I am forced to conclude that the contribution does not have a relevant technical effect. It thus consists only of excluded subject matter and is 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

- 28 As reasoned above, the contribution does not have a relevant technical effect. Thus the application also fails the fourth Aerotel step.

**Decision**

- 29 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**

- 30 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.

**Dr. S. Brown**

Deputy Director acting for the Comptroller