





FIG. 5

5 This decision is based on the most recent set of claims, filed on 27 November 2014. There are 6 claims: claim 1 relates to electronic gaming apparatus and claim 6 relates to machine-readable media having stored instructions to configure a processor to operate as a gaming apparatus of claim 1. Claim 1 reads:

- "1. An electronic gaming apparatus, comprising:  
a wagering game server operable to host an online communal wagering game;  
a plurality of social network servers operable to host respective social network websites;  
a number of user terminals each operable to access a respective social network website via one of said social network servers; and  
a communications network providing communication between the wagering game server and the said social network servers and between the user terminals and their respective social network servers;  
wherein each said social network server is further operable to:  
receive communal wagering game content from the wagering game server, and  
provide a wagering game interface to one or more associated user terminals, on the basis of the received communal wagering game content; and

wherein each user terminal comprises:  
 a social network gaming module configured to:  
 display the wagering game interface provided by its associated social network server,  
 receive wagering game playing inputs from a user via the displayed wagering game interface, and  
 provide the wagering game playing inputs to the wagering game server to transact the online wagering game. [sic]  
 wherein the wagering game server is operable to provide the communal wagering game content to the one or more social network servers,  
 receive wagering game playing inputs from one or more social network user terminals, and  
 transact the online wagering game;  
 and wherein a first one of the user terminals is operable to:  
 receive via its input means social communication data input by a first user and addressed to a second user terminal; and  
 transmit said social communication data to its associated social network server;  
 wherein the social network server is operable to:  
 receive said social communication data;  
 determine whether or not said second user terminal is a user terminal associated with the social network server, and  
 if said second user terminal is a user terminal associated with the social network server, to provide said communication data directly to the second user terminal; and  
 if said second user terminal is a not a user terminal [sic] associated with the social network server, to provide said social communication data to the wagering game server;  
 wherein the wagering game server is operable to:  
 store information correlating participants in the communal wagering game and their respective associated social network servers;  
 receive said social communication data from a social network server;  
 identify from the database the social network server associated with the second user terminal; and  
 communicate said social communication data to the identified social network server;  
 wherein the identified social network server is operable to provide the social communication data to the second user terminal; and  
 wherein the second user terminal is operable to display the social communication data.”

## **The law**

- 6 The section of the Act concerning inventions excluded from patentability is section 1(2), which reads:

“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)...

(b)...

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

(d)...

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.”

7 In order to decide whether an invention relates to subject matter excluded by section 1(2), the Court of Appeal has said that the issue must be decided by answering the question of whether the invention reveals a technical contribution to the state of the art. The Court of Appeal in *Aerotel/Macrossan*<sup>1</sup> set out the following four-step test to help decide the issue:

1) Properly construe the claim;

2) Identify the actual (or alleged) contribution;

3) Ask whether it falls solely within the excluded subject matter;

4) Check whether the actual or alleged contribution is actually technical in nature.

8 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.

9 In *Symbian Ltd's Application*<sup>2</sup>, the court made it clear that in deciding whether an invention is excluded, one must ask does it make a technical contribution? It does not matter whether it is asked at step 3 or step 4. If it does, then the invention is not excluded.

10 The case law on computer implemented inventions has been further elaborated in *AT&T/CVON*<sup>3</sup>.

### **Application of the Aerotel test**

#### Step 1: Properly construe the claim

11 The construction of the claims is straightforward and poses no problems. Claim 1 concerns an electronic gaming apparatus where a wagering game server operable to host an online communal in communication via a communications network with a plurality of social network servers operable to host social network websites. User terminals of each social network server display a wagering game via an interface provided by their associated social network server. The apparatus allows social communication data to be transmitted from a first user terminal to a second user

---

<sup>1</sup> *Aerotel Ltd v Telco Holdings Ltd (and others) and Macrossan's Application* [2006] EWCA Civ 1371

<sup>2</sup> *Symbian Limited's Application* [2008] EWCA Civ 1066

<sup>3</sup> *AT&T Knowledge Ventures LP and CVON Innovations Limited* [2009] EWHC 343

terminal, which is achieved by the wagering game server being operable to store information correlating participants in the communal wagering game and their respective social network servers.

Step 2: Identify the actual contribution

- 12 In his reports of 6 November 2014 and 9 January 2015, the examiner assesses the contribution as an improved system of integrated wagering and social network functions, which improves the communication channels available to those participating in the wagering game.
- 13 In its letter of 25 November 2014, the applicant appears to agree with the examiner's assessment, but elaborates further by stating that "The contribution in the present case is the provision of a communication channel between a user of a first social network and a user of a second social network who are both involved in playing a communal game provided by a wagering game server, the communication channel being routed via the wagering game server".
- 14 While I accept this assertion by the applicant of the contribution, I note that the term 'communication channel' is not used anywhere in the claims or description as-filed, and in order to avoid placing undue significance on these particular words I have taken them as referring to, in effect, a part of the communication network. In other words, I assess the contribution as being as an improved system of integrated wagering and social network functions in which a communication means is provided between a user of a first social network and a user of a second social network who are both involved in playing a communal game provided by a wagering game server, any communication between the users being directed via the wagering game server.

Steps 3 and 4: Ask whether it the contribution falls solely within the excluded subject matter and whether it is technical

- 15 In his reports of 6 November 2014 and 9 January 2015, the examiner argues that the identified contribution is a method of doing business, a program for a computer, and a method of playing a game. In particular, the examiner has referred to the decision in Merrill Lynch<sup>4</sup> and Halliburton<sup>5</sup> as being relevant with respect to business methods implemented by computer programs. Particular reference is made to the comments of Fox LJ. at page 569 of Merrill Lynch, where he states:

*"The fact that the method of going business may be an improvement on previous methods of doing business does not seem to me to be material. The prohibition in section 1(2)(c) is generic; qualitative considerations do not enter into the matter."*

- 16 Reference is also made to paragraphs 33 to 35 of Halliburton, which state:

*"33. If the task the system performs itself falls within the excluded matter and there is no more to it, then the invention is not patentable (see Symbian paragraph 53 above). Clear examples are from the cases involving computers programmed to operate a method of doing business, such as a securities trading system or a*

---

<sup>4</sup> Merrill Lynch's Application [1989] RPC 561

<sup>5</sup> Halliburton Energy Services Inc. [2011] EWHC 2508 (Pat)

*method of setting up a company (Merrill Lynch and Macrossan). Inventions of that kind are held not to be patentable but it is important to see why. They are more than just a computer program as such. For example, they self evidently perform a task which has real world consequences. As Fox LJ said in Merrill Lynch (p569 at line 27), a data processing system operating to produce a novel technical result would normally be patentable. However that is not the end of the analysis. He continued: "however it cannot be patentable if the result itself is a prohibited item" (i.e. a method of doing business). When the result or task is itself a prohibited item, the application fails.*

*34. The reasoning in Merrill Lynch means that the computer implemented invention claimed there would not have been excluded from patentability if it were not for the combined effect of two exclusions in s1(2) - computer programs and (in that case) business methods. The cases in which patents have been refused almost always involve the interplay between at least two exclusions. A notable exception is the outcome of Fujitsu. However the Court of Appeal in Symbian drew attention to that case as having an arguably inconsistent result (in the passage quoted above and see also paragraph 42 of the judgment) and I note that Fujitsu is not mentioned in the important sentence at the end of paragraph 51 of Lord Neuberger's judgment.*

*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 for doing business may be an improvement on previous methods is immaterial because the business method exclusion is generic."*

17 In its correspondence to the Office of 25 November 2014, the applicant puts forward a number of arguments (listed below) in response to the examiner's objections:

(a). The communication channel does not form part of the wagering game and is independent of the game being played;

(b). The provision of a communication channel via a wagering game server results in the system having novel hardware, i.e. a database at the gaming server which stores a correlation between players and their respective social networks. Thus, the applicant submits, the claimed system operates in a new way to provide a new functionality to the user.

(c). The passage of Merrill Lynch, cited by the examiner, is not applicable in the present case because the present case neither provides nor seeks to provide an improved method of playing a communal game, but is concerned with establishing

communication links where none was previously available so that the technical operation of sending a message from one user to another may be performed.

(d). In contrast to the examiner's argument, the apparatus claimed is not "entirely conventional" as it includes an element undisclosed in the cited art.

(e). The subject matter of the invention is not excluded as the five signposts set out in AT&T/CVON are fulfilled.

- 18 Regarding the first of these points, I agree with the applicant that the invention does not relate to a method of playing a game *per se*. While the apparatus involves a wagering game server that hosts a wagering game, the contribution resides in the provision of means that allows different users of the system to communicate with one another during game play, that means is independent of the actual game being played.
- 19 However, turning to points (b) and (c), the provision of a 'communication channel', though undoubtedly requiring technical means for its implementation, such as a communication network, and servers configured in a particular way, is in my view no more than a business method implemented by a computer program, precisely of the kind outlined in the above quoted paragraphs of Merrill Lynch and Halliburton (above). Furthermore, while I agree that the claimed system does provide new functionality to the user by enabling social communication between users of different social networks playing a game hosted by a wagering server, this new functionality is merely an aspect of a method of doing business, in this case gambling, which is enabled by a computer program.
- 20 With regard to point (d), the applicant states in its letter of 25 November 2014, that "none of the cited art contemplates or discloses a memory at the gaming server which stores the correlation between players and their respective social networks. The apparatus now claimed is therefore not "entirely conventional" since it includes an element which is undisclosed in the prior art". However, in my view, the actual physical equipment employed in the invention is conventional in that it would be possible to implement the invention using known servers, which include a computer memory; a known computer network; and known user terminals.
- 21 Turning lastly to point (e), both the examiner and the applicant have also touched upon the 'five signposts' to a relevant technical effect set out in the decision in AT&T/CVON. These have been endorsed in a slightly modified version by the Court of Appeal in *HTC v Apple*<sup>6</sup>, and are reproduced below:

*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;*

---

<sup>6</sup> *HTC Europe Co. Ltd. v Apple Inc.* [2013] RPC 30

*iii) whether the claimed technical effect results in the computer being made to operate in a new way;*

*iv) whether a program makes a computer a better computer in the sense of running more efficiently and effectively as a computer*

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

- 22 With regards to the first of these, the applicant argues that the technical effect is the effect of transferring a communication from a terminal connected to one social network to a terminal connected to another social network. However, the applicant has not gone on to identify any effect carried on outside of the computer, and I do not think that any such effect occurs. The provision of a communication means that allows a user of one social network to communicate with another user of a social network does not involve anything that can be said to take place outside of the system on which the invention is being run. It is merely a system that enables the transfer of information within a conventional computing arrangement which occurs exclusively within the computer.
- 23 I understand the applicant's arguments as being that second signpost is also met as the process of transferring a message from one user to another is independent of the content of the communication. While this may be true, I do not think it properly addresses the second signpost, which is to ask whether the technical effect works at the level of computer architecture. The answer to this question in my view is clearly 'no'. The computer architecture is entirely conventional and does not operate differently at any other level other than in the manipulation of data.
- 24 The applicant argues that the third signpost is met as the computer is being made to operate in a new way, in that a gaming server has not, in the prior art, been used as a conduit for communications between gaming terminals connected to different social network servers. However, to accept the applicant's argument on this point would be to accept that any previously undisclosed computer program involves a technical effect, which is clearly not the case. The computer system of the invention does not operate in a new way beyond that which is found in any computer system operating a new program.
- 25 With regard to the fourth signpost, the applicant states that he does not assert an increase in the speed or reliability of the computer but does assert that a communication route is established where none existed before. The fourth signpost is not met.
- 26 Regarding the fifth signpost, the applicant argues that the problem of providing communications between gaming terminals connected to different social network servers is overcome by the claimed invention and not merely circumvented. I am unable to find any hint in the description as filed that there are any technical problems associated with providing communications between different social networks. Indeed, paragraphs [0004] and [0070] of the description as filed emphasise that the thrust of the invention is to improve the user experience of online wagering games by emulating the social environment provided by real-world casinos. In my view, improving the functionality of a wagering game system to raise



the level of social interaction amongst users is a business not a technical issue. I also consider that this signpost does not point towards a technical contribution.

### **Decision**

- 27 I have found that the contribution made by the invention defined by the claims falls solely in matter excluded from patentability by virtue of section 1(2) of the Act, namely a method for doing business and a program for a computer. Furthermore, 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**

- 28 Any appeal must be lodged within 28 days

**Mrs S E Chalmers**

Deputy Director acting for the Comptroller