

EIP

All in the Mind? UK High Court Endorses Narrow Criteria for Patentability Exclusion

A recent High Court judgement regarding Halliburton's Patent Applications ([2011] EWHC 2508 (Pat)) signals a new development in the way the UK Intellectual Property Office (UKIPO) handles subject matter excluded from patentability.

The judgement relates to an appeal against the UKIPO's refusal of four of Halliburton's applications. These applications were rejected under S.1(2) PA 1977 because their subject matter was deemed excluded from patentability as schemes, rules or methods for performing a mental act, and as computer programs. Halliburton submitted that the decision to reject their applications was wrong in law following the existing approach to patentability set out by the Court of Appeal in Aerotel v Telco / Macrossan's Application ([2007] RPC 7) and Symbian v Comptroller ([2009] RPC 1).

As all four applications would stand or fall together, HH Judge Birss QC considered only one of them, GB 0523735.9. This application relates to a method of improving the design of roller cone drill bits for drilling oil wells. The method uses a computer simulation (finite element analysis) of the interaction of the drill bit with the material being drilled in order to optimise various design parameters without the need for field-testing.

In assessing the patentability of the main claim, the Court considered the breadth of the mental act exclusion (S.1(2)(c) PA) by weighing up two possible constructions:

- The first construction interprets the exclusion broadly to encompass any act "capable of being performed mentally, regardless of whether, as claimed, it is in fact performed mentally"; this was the view applied by the Hearing Office (following the

UKIPO's Practice Note of 8 December 2008), and was favoured by Aldous LJ in Fujitsu Limited's Application ([1997] RPC 608).

The second construction, favoured by Jacob LJ in *Aerotel*, interprets the exclusion narrowly to encompass only acts that are carried out mentally i.e. acts that are computer implemented would not fall under the mental act exclusion even if they could be performed mentally.

The Court held that "the balance of authority in England is in favour of the narrow approach". Despite the claim not explicitly being limited to implementation on a computer, the Judge found that it would be clear to any skilled reader that this was the case. Therefore, the Court held that Halliburton's application did not fall foul of the mental act exclusion. As Birss QC stated, "the correct scope of the mental act exclusion is a narrow one. Its purpose is to make sure that patent claims cannot be performed by purely mental means and that is all". This goes against UKIPO practice, with the Court explicitly stating that "paragraph 8 of the [Practice Note of 8 December 2008] is wrong in law and should not be followed".

The Court also considered the computer program and mathematical method exclusions and found that these exclusions did not apply. As stated in paragraph 32 of the judgement, "the question is decided by considering what task it is that the program (or the programmed computer) actually performs". The Court confirmed the position reached in *Symbian* and *Merrill Lynch* ([1989] RPC 561) that computer programs that produce a novel technical result are normally patentable, but that "when the result or task is itself a prohibited item, the application fails". Regarding the mathematical method exclusion, the Court held that, "the contribution is not solely a mathematical method (on top of being a computer program) because the data on which the mathematics is performed has been specified in the claim in such a way as to represent something concrete (a drill bit design etc.)".

There are several points to note from this judgement. The UK position that computer implemented inventions are indeed patentable if they perform a function that is patentable has been reaffirmed. Further, the scope of the mental act exclusion has been directly addressed and held to have a narrow scope.

This has important implications for patent applicants, and their patent attorneys, when considering how to protect their computer implemented inventions. Computer implemented algorithms for generating designs of an industrial article may well be seen as patentable. It also appears that the reluctance that applicants have had in the past to admit that an invention is computer implemented may be unnecessary and even undesirable. As Birss QC commented, "the word "computer" is conspicuous by its

absence from the patent claims. I am quite certain that one reason for this is a desire by applicants to try and play down the fact that their inventions are really based almost entirely on computer software. It fools no-one and in some cases makes things more complicated than they need to be”.

This judgement will inevitably lead to the UKIPO having to reconsider its approach to examining computer-implemented inventions in the future and could be the beginning of a more favourable attitude in the UK.