

Commissioner's Decision #1410
Décision du commissaire n° 1410

TOPIC/SUJET:
J60 (Printed Matter/Imprimés)

Application No.: 2,295,235
Demande n°.: 2 295 235

IN THE CANADIAN PATENT OFFICE

DECISION OF THE COMMISSIONER OF PATENTS

Patent application number 2,295,235 having been rejected under subsection 30(3) of the *Patent Rules*, has been reviewed in accordance with paragraph 30(6)(c) of the *Patent Rules*. The recommendation of the Board and the decision to refuse the application follow.

Agent for the Applicant:

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INTRODUCTION

- [1] This recommendation concerns a review of patent application no. 2,295,235, filed on May 5th, 1998. The application is entitled “Graphical User Interface for Customer Information Management.” The applicant is Siebel Systems Inc.
- [2] The present application relates to the field of graphical user interfaces for presenting event data. More specifically, the invention relates to a graphical user interface for displaying information where the display includes a central point representing the completion stage for an event, and objects representing events, where the radial distance of each object from the centre represents how much time remains until the target completion date of the event (e.g., a business transaction, a sales deal, or a service to be performed).
- [3] In our view, the present claims do not comply with section 2 of the *Patent Act* as they are directed to non-statutory subject matter and we recommend that the application be refused.

APPLICATION HISTORY

- [4] On July 17th, 2014, the Examiner wrote a Final Action pursuant to subsection 30(4) of the *Patent Rules*. The Final Action states that the application is defective on the ground that all claims (claims 1-21) do not comply with section 2 of the *Patent Act* for comprising subject matter that is outside the definition of invention.
- [5] In a January 19, 2015 response to the Final Action, the Applicant presented arguments regarding the non-statutory subject matter defect noted in the Final Action and proposed to amend the claims by adding new dependent claims 14 and 23.
- [6] As the Examiner considered the application not to comply with the *Patent Act*, pursuant to subsection 30(6) of the *Patent Rules* the application was forwarded to the Patent Appeal Board [“the Board”] for review on March 20th, 2015, along with an explanation outlined in a Summary of Reasons [“SOR”]. The non-statutory subject matter defect was maintained in the SOR. Because the rejection was maintained, the proposed claims were not entered, in accordance with subsection 30(6)(b) of the

Patent Rules. The 21 claims as they read prior to the Final Action are on file; the 23 claims submitted in response to the Final Action are considered “proposed claims” and will be treated separately, below.

[7] In a letter dated April 14th, 2015, (the “Acknowledgement Letter”) the Board forwarded the Applicant a copy of the SOR and offered the Applicant an opportunity to make further written submissions and attend an oral hearing. In particular, the Acknowledgment Letter requested that by June 15th, 2015, the Applicant advise the Board which of the following three options it wished to pursue:

- proceed with an oral hearing (with or without providing written submissions in response to the SOR);
- proceed without an oral hearing, in which case the review would proceed based on the written record (which could include written submissions from the Applicant in response to the SOR); or
- withdraw the application, if the Applicant did not want the Board to proceed with a review and for the Commissioner to not issue a Decision.

[8] The Acknowledgement Letter further advised that if the Applicant did not respond, “the review will proceed based on the written record as it presently stands and – unless the panel identifies additional defects in accordance with subsection 30(6.1) of the *Patent Rules* – a Commissioner’s Decision will issue without further communication.”

[9] No response to the Acknowledgment Letter was received by the Board.

[10] A Panel of the Board was formed to conduct a review of this application. The Panel sent a further letter on April 15, 2016 by registered mail to the agent for the Applicant, enclosing a copy of the Acknowledgement Letter and seeking to confirm the Applicant’s continued interest in the matter or alternatively whether the Applicant wished to withdraw its application. The letter requested a response by May 2, 2016. However, the Applicant has neither withdrawn this application nor indicated that it wishes to participate in the review process. Accordingly, this review

is conducted on the basis of the written record up to and including the SOR.

ISSUES

[11] The only issue in this case is whether the claims are directed to statutory subject matter.

LEGAL PRINCIPLES

Claim Construction

[12] In accordance with *Free World Trust v Électro Santé Inc*, 2000 SCC 66 [*Free World Trust*] essential elements are identified through a purposive construction of the claims done by considering the whole of the disclosure, including the specification and drawings. (see also *Whirlpool Corp v Camco Inc*, 2000 SCC 67 at paras 49(f) and (g) and 52.) In accordance with the *Manual of Patent Office Practice* [MOPOP], Chapter 13.05 *Examination of the claims using purposive construction* (June 2015), available at the CIPO website, the first step of purposive claim construction is to identify the person skilled in the art and their relevant common general knowledge (“CGK”). The next step is to identify the problem addressed by the inventors and the solution put forth in the application. Essential elements can then be identified as those required to achieve the disclosed solution as claimed.

Statutory Subject Matter

[13] The definition of invention is set out in section 2 of the *Patent Act*:

“invention” means any new and useful art, process, machine, manufacture or composition of matter, or any new and useful improvement in any art, process, machine, manufacture or composition of matter.

[14] Following the Federal Court of Appeal decision in *Canada (Attorney General) v Amazon.com Inc*, 2011 FCA 328 [*Amazon FCA*], the Patent Office released two Practice Notices (PN 2013-02 *Examination Practice Respecting Purposive Construction* and PN 2013-03 *Examination Practice Respecting Computer-Implemented Inventions*) that clarified the Patent Office’s approach to claim

construction and computer implemented inventions, respectively.

- [15] As stated in section 12.06.01 of MOPOP, “[w]here a claim includes a feature having a solely intellectual or aesthetic significance, and no statutory feature of the claim appears to form part of the contribution, the claim is objected to under section 2 of the *Patent Act* on the grounds that the feature having solely intellectual or aesthetic significance is not, of itself, a statutory invention”. The phrase “and no statutory feature of the claim appears to form part of the contribution” [emphasis added] reflects the former framework that is no longer followed by the Patent Office. As noted in PN 2013-03, “PN 2013-02 (Examination Practice Respecting Purposive Construction) mandates the use of purposive construction in place of other approaches to claim analysis. In particular, the ‘contribution approach’...is not to be used.” Thus, apart from its reference to the “contribution approach,” section 12.06.01 of MOPOP still reflects current Patent Office practice that features of solely intellectual or aesthetic significance are excluded from the definition of invention. Section 12.06.01 also clarifies that:

The expression "feature having a purely intellectual or aesthetic significance" applies to certain features that cannot, in a practical sense, affect the functioning of an invention. Such a feature therefore cannot change the manner in which the practical form of an invention operates to solve the problem for which it is the solution, and consequently can never be an essential element of a statutory invention.

- [16] One specific example of this principle is printed matter. In particular, section 12.06.04 of MOPOP provides as follows:

12.06.04 Printed matter

A very recognizable application of the principle set out in [12.06.01](#) is in respect of printed matter. Where printed matter does not provide a new functionality to the substrate on which it is printed, there has not been a statutory contribution. For the

printed matter and the substrate to be, together, a practical form of an invention, they must solve a practical problem related to the use of the printed matter in general, and not based on the solely intellectual or aesthetic content of the printed matter itself.

[17] Finally, this section of MOPOP clarifies that “[t]he term "printed matter" should, in this sense, not be restricted to traditional "ink-on-paper" printing. Any display of information wherein the sole contribution is in the information itself is not a statutory invention.” We similarly will use the term “printed matter” to describe not just traditional “ink-on-paper” but to also describe any display of information.

[18] With the guidance of PN 2013-02 in mind, the essential elements of the claims as purposively construed are assessed for subject matter with the above considerations in mind.

ANALYSIS

Claim Construction

[19] In the Final Action the Examiner cited PN 2013-02 and concluded that the present claims – as purposively construed – are directed to a method of displaying information, whereas the Applicant maintains that the claims are directed to a computer system and to a computer-readable medium.

[20] There was disagreement during the prosecution regarding the correct principles to be applied in construing the claims. The Applicant submitted that the Examiner improperly had regard to “the actual invention” rather than construing the claims in accordance with the principles of construction set out in Canadian law.

[21] More particularly, the Applicant submits that the construction analysis set out in the Final Action fails to consider the guiding principles set out in *Free World Trust*.

[22] The Panel will first consider the claims on file and will later address the proposed claims.

The claims on file

[23] The application contains 21 claims on file. Claims 1 and 14, the only two independent claims, read as follows:

1. A computer system comprising:
 - a display device;
 - a processor coupled to said display device, said processor, configured to determine one event to be displayed, and another event to be displayed, wherein the one event and the other event are unrelated to each other;
 - configured to generate for display an event object corresponding to said one event, and another event object corresponding to the other event;
 - configured to determine one radial distance from a central point on the display as a function of a translation value stored in memory, a target date for completion of the one event and a current date, wherein the translation value relates a predetermined quantity of time to a predetermined radial distance from the central point on the display;
 - configured to determine another radial distance from the central point on the display as a function of the translation value, another target date for completion of the other event and the current date, wherein the one radial distance and the other radial distance are unequal;
 - configured to concurrently display both said event object the determined distance from the central point on the display, and the other event object the determined other radial distance from the central point on the display.

...

14. A computer readable medium containing executable instructions which, when executed in a processing system, causes the system to perform the steps for concurrently displaying information regarding unrelated events comprising:
 - determining one event to be displayed, and another event to be displayed, wherein the one event and the other event are unrelated to each other;
 - generating for display an event object corresponding to said one event, and another event object corresponding to the other event;
 - determining one radial distance from a central point on a display

as a function of a translation value stored in memory, a target date for completion of the one event and a current date, wherein the translation value relates a predetermined quantity of time to a predetermined radial distance from the central point on the display;

determining another radial distance from the central point on the display as a function of the translation value, another target date for completion of the other event and the current date, wherein the one radial distance and the other radial distance are unequal.

[24] The remaining claims depend upon one or the other of these claims either directly or indirectly.

Consideration of the actual invention as part of a purposive construction

[25] In the Final Action and the SOR, there are references to the “actual invention” in discussing construction of the present claims.

[26] The Applicant argued that reference to the “actual invention” in the construction of the claims “lacks proper basis under current Canadian law.”

[27] However, in *Amazon FCA*, the Court considered that an identification of the actual invention may be a relevant aspect of claim construction, stating at paras. 42-44:

[42] This formulation of the issues to be considered does not mean that the Commissioner cannot ask or determine what the inventor has actually invented, or what the inventor claims to have invented. On the contrary, these are relevant and necessary questions in a number of contexts, including novelty, obviousness, and patentable subject matter. It may also arise in relation to other issues, for example, the determination of the identity of the inventor.

[43] However, it seems to me that the jurisprudence of the Supreme Court of Canada, in particular *Free World Trust* and *Whirlpool*, requires the Commissioner’s identification of the actual invention to be grounded in a purposive construction of the patent claims. It cannot be determined solely on the basis of a literal reading of the patent claims, or a determination of the “substance of the invention” within the meaning of that phrase as used by Justice Binnie, writing for the Supreme Court of Canada in *Free World Trust*, at paragraph 46.

[44] Purposive construction will necessarily ensure that the Commissioner is alive to the possibility that a patent claim may be expressed in language that is deliberately or inadvertently deceptive. Thus, for example, what appears on its face to be a claim for an “art” or a “process” may, on a proper construction, be a claim for a mathematical formula and therefore not patentable subject matter. That was the

situation in *Schlumberger Canada Ltd. v. Canada (Commissioner of Patents)*, [1982] 1 F.C. 845 (C.A).

- [28] In the SOR on page 2, paragraph 2, the Examiner states “the final action fully explains why the actual invention of the claims, purposively construed, is non-statutory subject matter.” Thus, the Examiner was aware that the determination of the actual invention must be grounded in a purposive construction of the claims. Moreover, the construction analysis in the Final Action is in keeping with that provided in PN 2013-02, which sets out the Patent Office’s view on purposive construction during examination post-*Amazon FCA*.

Free World Trust principles

- [29] The Applicant’s response to the Final Action states that certain principles set out in *Free World Trust* were not directly addressed: see response to Final Action at page 5.
- [30] Although the Panel agrees with the Applicant that certain *Free World Trust* principles were not explicitly addressed, we note that PN 2013-02 *Examination Practice Respecting Purposive Construction*, which was cited by the Examiner in the Final Action, provides that the principles set out in *Free World Trust* “must take into account the role of the patent examiner and the purpose and context of examination.” The Practice Notice then sets out a framework for construction for the context of the examination of applications. Having reviewed the prosecution, we are of the view that purposive construction was conducted in a manner consistent with the guidance set out in PN 2013-02.
- [31] We turn to the application of that guidance to the present claims.

The person skilled in the art (POSITA) and relevant common general knowledge

- [32] Although there is no discussion of the person of ordinary skill in the art or their common general knowledge in the record, based on our review of the specification we consider that the POSITA is a person skilled in the art of business administration, computer programming and graphical user interfaces. The relevant common general knowledge includes at least knowledge of:

- graphical user interfaces (p.1, line 1);

- traditional graphs and charts (p.1, lines 23-26, and p.2, lines 1-2);
- sales force automation (p.4, 3rd para.); and,
- customer relationship management (CRM) tools (p.4, 3rd para).

The problem to be solved and the solution provided by the invention

[33] The application under the heading “Background of the Invention” states that “it is desirable to consider a maximum amount of available information in formulating a decision” and that “it is desirable to maximize the information presented to a decision maker while presenting the information in such a way as to be readily understood by the decision maker.” Page 2 further states that “it is desirable for everyone from the sales and support personnel to the chief executive officer to be able to take a quick look at significant transaction data and make an efficient determination as to the best potential business prospects to pursue or the most serious support problems to fix.”

[34] The problem and solution were set out in the following passage in the Final Action:

The specification (pages 1 to 2) explains that the problem with conventional graphs and charts is that they can be difficult to use to help a decision maker to compare and assimilate information from numerous events or transactions. Given the limitations of space, the more events or transactions to be compared, the fewer the characteristics of the events that can be included. Thus, the specification seeks to overcome these limitations with an information presentation scheme that permits the efficient presentation and assimilation of information where historical event data is critical and yet there is a large amount of relevant data for each event. For example, the scheme would permit the efficient presentation of information in the general area of customer information management systems.

[35] The Final Action characterizes the problem as the problem of improving presentation and assimilation of information, and the solution as providing a method of displaying information in a certain arrangement. It is evident from the Applicant’s characterization of the Final Action in its response that the Applicant understood the Examiner’s views on this point. Specifically, the Applicant “understands the Examiner as suggesting it is the solution addressed by the current application to provide a method of displaying information in a certain arrangement, in view of the problem of improving presentation and assimilation of information.” However, the

Applicant did not offer an alternative problem or solution in the response to the Final Action. Rather, the Applicant disagreed with the assessment in the Final Action of the essential features of the claim on the basis that the wrong principles of construction were applied.

- [36] The Panel is of the view that according to the record, the problem addressed by the application can be properly understood as improving presentation and assimilation of information, and the proposed solution is to provide a method of displaying information in a certain arrangement.

Essential elements of the claims

- [37] As set out above at para. 12, according to Patent Office Practice, essential elements can be identified as those required to achieve the disclosed solution as claimed.
- [38] Of particular relevance is whether the computer system and computer-readable medium recited in the claim are essential. The Final Action states that they are not essential, that they merely form part of the operating environment and, as a result, the claims are construed as method claims. The Applicant disagrees, stating that the claims are directed to computer systems and computer readable media, pointing to the Applicant's intent as expressed in the wording of the claims and submitting that the step of displaying cannot be performed without the physical medium.
- [39] The Panel is of the view that the computer system and computer-readable media are not essential elements; they are merely the context or operating environment in which the display is presented.
- [40] PN 2013-02 provides that "[s]ome elements of a claim merely define the context or the environment of a specific working embodiment, but do not actually change the nature of the solution to the problem." In this case, the computer system or computer readable media do not serve to solve the problem of improving the presentation and assimilation of information; they merely provide the operating context. Rather, it is the relative position of objects, their color, size, etc. that solves the problem set out to be addressed. Thus, the Panel is of the view that the computer system and computer readable media are not essential elements, and that the essential elements of the present claims are those elements directed to a method of displaying

information rather than to computer systems and computer readable media.

- [41] The dependent claims provide further limitations, adding that the size, color, shape, etc. are used to indicate to the decision maker various characteristics of the event, such as priority and geographical area. These elements are essential as they are refinements on the solution to the problem.

Do the claims comply with Section 2 of the *Patent Act*?

- [42] The Final Action states:

Presentations of information, or schemes for presenting information, defined by their intellectual meaning and appearance, are not directed to advancing the industrial, or manual and productive arts. Such matter is unpatentable. It merely involves the carrying out of a plan or theory of action without the production of any physical results proceeding directly from the operation of the theory or plan itself.

...

The production and presentation of useful information, however, does not make subject matter statutory.

- [43] The Applicant submitted in its response to the Final Action that, even if the present claims were directed to a method of displaying information, the present subject matter is patentable because:

a method of displaying information relates to a manual or productive art, and not to skills of a professional

...

[D]isplaying information in a way which may permit for “efficient presentation of information in the general area of customer information systems” as referenced by the Examiner, for example, would produce a result which directly relates to trade, commerce or industry, by allowing more efficient sales or purchases of goods and services

...

[S]uch a method is believed to have a method of practical application... is a new an inventive method of applying skill and knowledge; and have a commercially useful result...

[44] We are of the view that the position in the Final Action regarding statutory matter is consistent with the teaching in MOPOP as set out at paras. [15]-[17] above. The overriding consideration is whether the display of information, or printed matter, is functional as opposed to “solely intellectual or aesthetic.”

[45] According to the first two pages of the application, the purpose of the invention is to “increase the efficient presentation of information” in order to facilitate accurate decision-making. This is achieved by displaying event objects whose relative position, color, size, or shape convey critical information to a decision maker in an efficient manner. The characteristics of the event objects that are generated and displayed by the present methods are non-functional and have intellectual meaning only to the decision maker. The event objects are a form of non-functional printed matter. Thus, the claims as purposively construed are not within the scope of section 2 of the *Patent Act*.

Proposed claims

[46] As mentioned above, the Applicant filed a proposed set of claims along with its response to the Final Action. The proposed claims added two additional dependent claims, leaving the text of the original claims untouched but for renumbering due to the insertion of the two new proposed claims. The Applicant proposed adding new claims 14 and 23 to “further define the event objects as including an electronic link to detailed information about the respective events.”

[47] The Panel does not consider that the two proposed additional claims remedy the statutory subject matter defect outlined in the Final Action for the reasons set out in para. [45]. Furthermore, the Applicant did not provide any submission as to how the inclusion of an electronic link would overcome the defect.

RECOMMENDATION OF THE PANEL

[48] The Panel recommends that the application be refused because:

- Claims 1-21 do not comply with section 2 of the *Patent Act* for comprising subject matter that is outside the definition of invention.

[49] We are also not satisfied that the specific amendments proposed by the Applicant are necessary for compliance with the *Patent Act* and *Patent Rules*.

Mark Couture

T. Nessim Abu-Zahra

Kristina Bodnar

Member

Member

Member

DECISION

[50] I concur with the conclusions and recommendation of the Patent Appeal Board that the application be refused because:

- Claims 1-21 do not comply with section 2 of the *Patent Act* for comprising subject matter that is outside the definition of invention.

[51] Therefore, in accordance with section 40 of the *Patent Act*, I refuse to grant a patent on this application. Under section 41 of the *Patent Act*, the Applicant has six months within which to appeal my decision to the Federal Court of Canada.

Johanne Bélisle

Commissioner of Patents

Dated at Gatineau, Quebec,

this 13th day of September, 2016.