

Commissioner's Decision #1420

Décision du commissaire n° 1420

TOPICS: A11: New Matter
 B00: Indefiniteness
 G00: Utility
 J50: Mere Plan
 O00: Obviousness

SUJETS: A11 : Nouvelle matière
 B00: Indéfini
 G00: Utilité
 J50: Simple Plan
 O00: Évidence

Application No: 2,529,210

Demande n°: 2 529 210

IN THE CANADIAN PATENT OFFICE

DECISION OF THE COMMISSIONER OF PATENTS

Patent application number 2,529,210 having been rejected under subsection 30(3) of the *Patent Rules* (SOR/96-423), has consequently been reviewed in accordance with paragraph 30(6)(c) of the *Patent Rules*. The recommendation of the Patent Appeal Board and the decision of the Commissioner are to refuse the application.

Agent for the Applicant

FINLAYSON & SINGLEHURST

700 – 225 Metcalfe Street

OTTAWA Ontario

K2P 1P9

INTRODUCTION

- [1] This recommendation concerns the review of rejected patent application number 2,529,210, which is entitled “Call Processing System”, and is owned by Assurant, Inc. A review of the rejected application has been conducted by the Patent Appeal Board pursuant to paragraph 30(6)(c) of the *Patent Rules*. As explained in more detail below, our recommendation is that the application be refused.

BACKGROUND

The Application

- [2] Patent application 2,529,210, based on a previously filed Patent Cooperation Treaty application, is considered to have been filed in Canada on June 14, 2004, and was made available to the public on December 29, 2004.
- [3] The application relates to the assignment of incoming calls from customers to a human agent in a call management system that might be used, for example, in a telephone sales or marketing office. The application attempts to assign particular types of calls (or callers) to different groups of agents, where an agent is assigned a call based on the particular agent’s past performance in persuading a customer to change his/her mind.

Prosecution History

- [4] The application, containing claims 1-65 (“claims on file”), was rejected in a Final Action (“FA”) dated February 10, 2014 on five grounds: new subject matter, non-statutory subject matter, lack of utility, obviousness and indefiniteness. In its response to the FA dated August 8, 2014, the Applicant submitted a new set of claims 1-64 (“Proposed Claim Set 1”) and arguments in favour of their patentability.
- [5] The application was forwarded to the Patent Appeal Board with a Summary of Reasons (“SOR”) setting out why the Examiner considered claims 1-30, 32, 33, 35, 36 and 45-65 on file to be defective. The SOR also indicated that claims 31, 34, and 37-44 on file were considered by the Examiner to be allowable, and that certain claims of Proposed Claim Set

1 (claims 30-33 and 36-48) were considered by the Examiner to be allowable. The SOR was forwarded to the Applicant on April 9, 2015.

- [6] In a letter dated August 6, 2015, the Applicant provided a written response to the SOR, replacing Proposed Claim Set 1 with a second set of proposed claims 1-16 (“Proposed Claim Set 2”) corresponding to the claims indicated as “allowable” in the SOR, and a statement that they should be acceptable for that reason.
- [7] The present Panel was formed to review the application pursuant to paragraph 30(6)(c) of the *Patent Rules*. In a letter dated May 30, 2016 (“the Panel Letter”), we set out our preliminary analysis and rationale as to why, based on the record before us, the claims on file do not comply with the *Patent Act*. The Panel Letter also stated that Proposed Claim Set 2 would not appear to overcome the defects in the claims on file.
- [8] The Panel Letter also offered the Applicant an opportunity to be heard. In correspondence dated July 14, 2016, the Applicant declined the offer to attend an oral hearing, but indicated that brief comments on the Panel letter would be submitted.
- [9] In a response to the Panel Letter dated September 16, 2016 (the “Reply Letter”), the Applicant did not present any arguments on the substantive points made in the Panel letter regarding the grounds for rejection. Instead, the Applicant’s Reply Letter argued that for procedural reasons, the Panel should have accepted the indication in the SOR that claims 31-33 and 37-44 were allowable, and thus Proposed Claim Set 2 should have been found acceptable to the Panel.
- [10] We will first address the Applicant’s procedural argument, regarding the acceptability of Proposed Claims Set 2, prior to addressing the five substantive issues on which the rejection of the application is based.

PROCEDURAL MATTER

- [11] Although the Applicant’s Reply Letter did not address the substantive issues addressed in the Panel Letter pertaining to claims 1-65 on file, the Applicant did submit arguments why Proposed Claim Set 2 should be acceptable to the Panel.

- [12] Specifically, the Applicant submits that claims 1-16 in Proposed Claim Set 2, corresponding to claims identified in the SOR as being “allowable”, should likewise be allowed in this review. The Applicant points to the signatures on the SOR from the Examiner, Section Head, and Division Chief as indicating that these claims were allowable, and questions why deference has not been accorded these Patent Office officials. The Applicant suggests that the Board is comparable to an appeals court within the structure of the Patent Office, and argues that we are to give such deference as would be given when an appeals court reviews a lower court decision.
- [13] The Panel has considered the Applicant’s arguments, but we respectfully disagree, for the following reasons.
- [14] First, with regard to the argument that the Board is equivalent in operation to an appeals court within the Patent Office, we do not believe this is an appropriate comparison. The Board is not a statutory body, nor does it operate as a court. Rather, the Board is an administrative body comprised of senior Patent Office officials, whose role is to provide an independent review of a rejected application as required by paragraph 30(6)(c) of the *Patent Rules*, and to provide a recommendation to the Commissioner as to the final disposition of the application within the Patent Office.
- [15] Second, with regard to the signatures of the Examiner, Section Head and Division Chief, and whether deference should be accorded to their apparent view that certain claims are allowable, the Panel notes that in accordance with paragraph 30(6)(c) of the *Patent Rules*, the application is rejected and subject to review. Furthermore, pursuant to subsection 30(6.1) of the *Patent Rules*, a review by a panel of the Board may raise “defects other than those indicated in the Final Action notice”. We consider that such defects are not limited to those defects in respect of claims considered by the Examiner to be not allowable, but extend to any defects identified within the entire application.
- [16] In the present case, the Panel undertook its preliminary review of the rejected application and noticed the similarity of the subject matter of claims 31-33 and 37-44, as construed, with that of the remaining claims on file. In view of this similarity, the Panel’s preliminary

view was that the analysis of these claims for statutory subject matter and obviousness resulted in different outcomes than that which was presented to the Applicant in the SOR.

[17] Therefore, in addition to addressing the other issues before us, the Panel Letter provided detailed reasons why all claims 1-65 on file were found to be lacking in statutory subject matter and to be obvious. The Panel Letter also explained why the claims of Proposed Claim Set 2 (which the Applicant assumed to be allowable based on the indication in the SOR) were also unacceptable, based on the same reasons. We offered the Applicant an opportunity to provide written submissions and to attend an oral hearing. The Applicant, however, chose not to avail itself of this opportunity to argue on the substantive issues why the proposed claims were acceptable, instead focussing on the procedural issue.

[18] In view of the above, we proceed with the review of the five substantive issues before us.

ISSUES

[19] This recommendation addresses the following five defects identified in the FA:

1. Claims 1, 10, 12-18, 25 and 46-64 on file contain new subject matter contrary to section 38.2 of the *Patent Act*;
2. Claims 1-30 and 46-64 on file lack statutory subject matter contrary to section 2 of the *Patent Act*;
3. Claims 1-30 and 46-64 on file lack utility contrary to section 2 of the *Patent Act*;
4. Claims 1-30, 35, 36 and 50-65 on file are obvious contrary to section 28.3 of the *Patent Act*;
5. Claims 1, 13, 14, 24, 30, 32, 33, 45, 50 and 54-65 on file are indefinite contrary to subsection 27(4) of the *Patent Act*

LEGAL PRINCIPLES AND OFFICE PRACTICE

Purposive Construction

[20] In accordance with *Free World Trust v Électro Santé Inc*, 2000 SCC 66, 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* §13.05 [revised June 2015], the first step of purposive claim construction is to identify the person skilled in the art and their relevant common general knowledge. The next step is to identify the problem addressed by the inventors and the solution disclosed in the application. Essential elements can then be identified as those elements of the claims that are required to achieve the disclosed solution.

New subject matter

[21] Subsection 38.2(2) of the *Patent Act* sets forth the conditions under which amendments may be made to the specification of a patent application:

38.2 (2) The specification may not be amended to describe matter not reasonably to be inferred from the specification or drawings as originally filed, except in so far as it is admitted in the specification that the matter is prior art with respect to the application.

[22] The question as to whether matter added to the specification by amendment complies with section 38.2 of the *Patent Act* is considered from the point of view of the person skilled in the art at the time the application was filed.

[23] The assessment as to the presence of new matter therefore requires a comparison of the pending specification with the originally filed specification and drawings, and a determination as to whether the subject-matter of the amendments is that which would have been reasonably inferred from the original specification or drawings by the person skilled in the art at the time of filing.

Statutory Subject Matter

[24] 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.

[25] Following the Federal Court of Appeal decision in *Canada (Attorney General) v Amazon.com, Inc*, 2011 FCA 328 [*Amazon*], the Office released an examination memo PN2013-03 entitled “*Examination Practice Respecting Computer-Implemented Inventions*” that clarified Office examination practice for computer-implemented inventions. This memo was cited in the Panel Letter of May 30, 2016.

[26] As stated in PN 2013-03, Office practice considers that “where a computer is found to be an essential element of a construed claim, the claimed subject matter will generally be statutory... Where, on the other hand, it is determined that the essential elements of a construed claim are limited to matter excluded from the definition of invention” - for example, fine arts, methods of medical treatment, features lacking in physicality, or claims where the subject matter is a mere idea, scheme, rule or set of rules – “the claim is not compliant with section 2 of the *Patent Act*.”

Utility

[27] The statutory basis for the utility requirement is 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;

[28] The utility requirement was described by the Supreme Court of Canada in *Consolboard Inc v MacMillan Bloedel (Saskatchewan) Ltd*, [1981] SCR 504, at p. 525:

There is a helpful discussion in Halsbury's Laws of England, (3rd ed.), vol. 29, at p. 59, on the meaning of 'not useful' in patent law. It means "that the invention will not work, either in the sense that it will not operate at all or, more broadly, that it will not do what the specification promises that it will do".

Obviousness

[29] The *Patent Act* requires that the subject matter of a claim not be obvious. Section 28.3 of the Act provides as follows:

28.3 The subject matter defined by a claim in an application for a patent in Canada must be subject matter that would not have been obvious on the claim date to a person skilled in the art or science to which it pertains, having regard to

(a) information disclosed more than one year before the filing date by the applicant, or by a person who obtained knowledge, directly or indirectly, from the applicant in such a manner that the information became available to the public in Canada or elsewhere; and

(b) information disclosed before the claim date by a person not mentioned in paragraph (a) in such a manner that the information became available to the public in Canada or elsewhere.

[30] In *Apotex Inc v Sanofi-Synthelabo Canada Inc*, 2008 SCC 61 at para. 67, the Supreme Court of Canada stated that it is useful in an obviousness inquiry to follow the following four-step approach:

- (1) (a) Identify the notional "person skilled in the art";
(b) Identify the relevant common general knowledge of that person;
- (2) Identify the inventive concept of the claim in question or if that cannot readily be done, construe it;
- (3) Identify what, if any, differences exist between the matter cited as forming part of the "state of the art" and the inventive concept of the claim or the claim as construed;
- (4) Viewed without any knowledge of the alleged invention as claimed, do those differences constitute steps which would have been obvious to the person skilled in the art or do they require any degree of invention?

Indefiniteness

[31] Subsection 27(4) of the *Patent Act* states:

The specification must end with a claim or claims defining distinctly and in explicit terms the subject-matter of the invention for which an exclusive privilege or property is claimed.

[32] In *Minerals Separation North American Corp v Noranda Mines Ltd*, [1947] Ex CR 306, 12 CPR 99 at 146, the Court emphasized the obligation an applicant has to make clear in his claims the ambit of the monopoly sought and the requirement for terms used in the claims to be clear and precise:

By his claims the inventor puts fences around the fields of his monopoly and warns the public against trespassing on his property. His fences must be clearly placed in order to give the necessary warning and he must not fence in any property that is not his own. The terms of a claim must be free from avoidable ambiguity or obscurity and must not be flexible; they must be clear and precise so that the public will be able to know not only where it must not trespass but also where it may safely go.

PURPOSIVE CONSTRUCTION

[33] Prior to undertaking an analysis of the issues identified in the FA and SOR, the Panel Letter set out a purposive construction of the claims on file. The Applicant, in its Reply Letter, did not object to the Panel's construction, and therefore, we summarize that construction here.

Person skilled in the art

[34] The Panel Letter (page 2) set out that the person skilled in the art is considered to be a team comprised of call centre personnel including salespeople, managers and business planners, and IT personnel including computer programmers and network technicians.

Common general knowledge (CGK)

[35] The Panel Letter (pages 2-3) set out the relevant CGK of the person skilled in the art based on a reading of the specification and a prior art disclosure:

- a. Knowledge of computerized call centre processing systems, voice and data communication networks, call assignment and routing systems, and the implementation of these systems in conventional hardware, firmware and software;
- b. Knowledge of call centre operations such as call assignments, automated call routing, using live agents, value added assignments, call management, queues, agent availability, agent experience, etc.;
- c. Knowledge of basic sales and business 'best practices' such as customer retention, prioritizing customers, ranking customers (based on for example account size, value, future profitability, loyalty, etc.), maintaining customer loyalty, obtaining value-added sales, and maximizing revenues;
- d. Knowledge of employee performance evaluations and the ranking or rating of employees based on skills and past performance; and
- e. Knowledge of matching a customer with an agent best suited to make a sale, based on agent's performance or previous experience (col 1, lines 34-45, discussing "call center systems typically").

Problem

[36] The problem addressed by the Applicant's invention is set out in the Panel Letter (page 3):

In light of the description (page 1) and the CGK, the skilled person would understand that the problem to be overcome is that in prior art call processing systems, important calls are not efficiently and effectively routed to the best agent for the particular customer's needs.

To the skilled person, the problem would appear to be one of identifying the best person (agent of a sponsor organization) to receive a call from a customer. The skilled person would understand, as the Final Action alludes to on page 2, that the problem relates to aspects of "human personality" and selecting an agent for "persuading the customer to adopt a course of action that is favourable to the sponsor organization. The skilled person would not, in the view of the Panel, consider this to be a computer problem, i.e. not a problem or limitation of the computerized call processing system to process the call assignment to an agent.

Solution

[37] The solution to this problem is identified in the Panel Letter (pages 3-4):

The application provides for a method to assign an important call to an agent most likely to be capable of persuading a customer to change their course of action, based on the agent's demonstrated past performance. As stated in the Final Action (under "Inventive Concept"), the solution pertains to "using an agent's demonstrated past performance in persuading customers to take an action favourable to the sponsor organization to assign the agents to current calls". The Applicant's reply to the Final Action (page 4) appears to agree with this characterization, stating that the "the agent's probable ability to persuade a customer to change his/her mind...is characterized by the agent's past performance in persuading a customer to change his/her mind...".

Therefore, the solution comprises an assessment of whether a customer's call is important (high value) to a sponsor organization, and assigning an important call to an agent with the probable ability to change the customers mind and take a course of action favourable to the organization, based on the agent's past performance in persuading a customer to change his/her mind.

Meaning of terms used in claims

[38] The Panel Letter stated that the skilled person, having read the specification, would not have any difficulty understanding most of the terms in the claims. However, we stated that the expression "*probable ability to establish an affinity with the customer*" found in the claims on file required further consideration, as this expression was alleged to be defective as comprising unacceptable new subject matter (see Issue 1, paragraph 42, below). In its reply to the FA, the Applicant acknowledged the unsupported new subject matter issue, and proposed new wording for this feature, namely the expression "*...based on said particular agent's past performance in persuading a customer to change his/her mind*". As stated in the Panel Letter, we determined that the proposed expression finds support in the specification as filed. Therefore, as explained in the Panel Letter, for the purposes of the Panel's analysis of the issues under review, we adopt the expression "*...based on said particular agent's past performance in persuading a customer to change his/her mind*" as an essential feature of the claims on file. In its Reply Letter, the Applicant did not object to the use of this phrase in the Panel's analysis.

Essential elements

[39] Based on the analysis provided in the Panel Letter, the skilled person would consider the essential elements that provide the solution of claim 1 to be:

- Assessing the importance to a sponsor organization of an incoming call from a customer; and
- Assigning, for calls assessed as important, the call to a particular agent based on said particular agents past performance in persuading a customer to change his/her mind and choose a course of action instead that is favourable to the sponsor organization.

[40] As set out in the Panel Letter (page 5), the remaining independent claims contain the same essential elements, with the following additional features:

- Claim 18: identifying a group of one or more highest performing agents and determine whether to assign the call to that group based on the call's value;
- Claim 25: identifying a group of one or more lowest performing agents and determine whether to assign the call to that group based on the call's value;
- Claim 31: assigning performance ratings to a first, second and third agent, then assigning the agents to a first, second and third group respectively, and finally, assigning the call to one of the groups based on the call's value;
- Claim 35: like claim 18, but defines "correspondence" instead of "call";
- Claim 37: assessing the performance of first and second agents, assigning agents to first and second groups, assigning first and second calls to groups based on value of call, and if first agent is unavailable, assigning the first call to second agent;
- Claim 39: like claim 37 with added feature of an "estimated benefit" associated with attempting to persuade a customer not to cancel a particular service;
- Claims 46, 47, 48, and 50: "system" claims with various combinations of claims 18, 31, 37 and 39; and
- Claim 65: similar to claim 1, with the value of a call now based on a "priority value".

[41] Our review of the dependent claims on file revealed additional features which define the products or services being sold, or define the determination of the agent's past

performance, and grouping of the agent in certain categories (first, second, third, etc.), and combinations of assigning calls based on call value, agent performance, and agent availability

ANALYSIS

1. New subject matter

[42] As stated in the Panel Letter, the skilled person in the art would consider the expression “*probable ability to establish an affinity with the customer*” to be new subject matter not reasonably inferred from the original specification. The Applicant did not take issue with this determination. Accordingly, as stated in the Panel Letter, claims 1-30 and 46-64 on file define new subject matter, contrary to section 38.2 of the *Patent Act*.

[43] However, as stated at paragraph 38 above, for the purposes of the review of the remaining issues, we have adopted the expression “*based on said particular agent’s past performance in persuading a customer to change his/her mind*” to express this essential feature, as proposed by the Applicant in its reply to the FA. We note that this new expression is fully supported by the specification.

2. Statutory subject matter

[44] The FA stated that claims 1-30 and 46-64 on file do not define statutory subject matter, contrary to section 2 of the *Patent Act*. However, as set out in the Panel Letter, the skilled person would understand that all claims on file define business practices and human performance criteria that operate to identify the best suited agent for persuading a customer to take action in the interest of a company. The steps of assessing a customer’s value or importance, assessing an agent’s past performance based on sales and persuasion ability, ranking an agent based on their assessed past performance, and finally, assigning a customer to an agent based on the ranking of the agent are all abstract qualities, determined by certain business rules, business objectives and measurements of human performance. None of these features are considered to define “something with a physical existence, or something that manifests a discernible effect or change” (*Amazon*, at paragraph 66). There are no other essential physical features defined in the claims.

[45] Additionally, the Panel Letter states that the features of assessing the importance of a customer and ranking an agent based on their past performance in persuading a customer to change their mind and to take action that is favourable to the sponsor organization can be equated to a mental process based on psychological criteria or business rules. In its simplest form, the assessing and assigning steps could be readily implemented without any computerized system, by using pen and paper, or as a mental exercise. Again, the Applicant's Reply Letter did not provide any arguments addressing these points regarding the non-statutory nature of the subject matter of claims 1-65.

[46] Accordingly, as set out in the Panel Letter, claims 1-65 on file define non-statutory subject matter, and therefore do not comply with section 2 of the *Patent Act*.

3. Utility

[47] The FA states that claims 1-30 and 46-64 on file lack utility because the claims are not reproducible, in that they depend on a person's skill, judgement or reasoning to persuade a customer to change their mind, based upon some ability demonstrated through past performance.

[48] We note that neither claim 1 nor any other independent claim specifies that the agent will successfully persuade the customer to change their mind; rather, there is an assignment of an important call to a particular agent who has been identified to receive the call based on his/her past performance in persuading a customer to change their mind. While the manner in which said agents are ranked and selected appears to be based on various performance measurements or business rules (as disclosed, for example on page 19 lines 13-31, and page 21, line 13 through page 22, line 20 of the specification), the assigning of the call to one of these agents would appear to the skilled person as being a reproducible step. As such, we consider that the steps in the independent claims meet the minimum requirements for utility, as they are reproducible independent of the skilled person's judgement or reasoning.

[49] However, as set out in the Panel Letter, dependent claims 5-9 and 54-56 on file contain an explicitly defined outcome of persuading a customer to change their mind. Claim 5, for example, defines the outcome "where the customer is persuaded by the agent..." In the

Panel's view, the skilled person would find these outcomes are not reproducible from the operation of the method defined in the claim without the skill or judgement of the operator. The Applicant did not take issue with this determination. Accordingly, as set out in the Panel Letter, claims 5-9 and 54-56 on file lack utility, and therefore do not comply with Section 2 of the *Patent Act*.

4. Obviousness

[50] In accordance with the four-step approach to performing an obviousness assessment set out in *Apotex Inc. v. Sanofi Synthelabo Canada Inc.*, 2008 SCC 61 [*Sanofi*], the Panel Letter provided the reasoning why the skilled person would consider claims 1-65 on file to be obvious. Again, the Applicant did not provide any substantive arguments in its Reply Letter regarding the Panel's obvious analysis. Accordingly, we summarize that analysis here.

Step 1- Identify the person skilled in the art and the relevant common knowledge (CGK) of that person

[51] The person skilled in the art and their relevant CGK has been presented under Purposive Construction, above, at paragraphs 34 and 35.

Step 2 – Identify the Inventive Concept of the claims in question or, if that cannot readily be done, construe it

[52] As set out in the Panel Letter, the inventive concept comprises the essential elements of the claims; for example, in claim 1 on file:

- Assessing the importance to a sponsor organization of an incoming call from a customer; and,
- Assigning, for calls assessed as important, the call to a particular agent based on said particular agents past performance in persuading a customer to change his/her mind and choose a course of action instead that is favourable to the sponsor organization.

Step 3 - Identify what, if any, differences exist between the matter cited as forming part of the "state of the art" and the inventive concept of the claim or the claim as construed

- [53] The FA cites patent document D1, United States patent 6,453,038, issued September 17, 2002 to *McFarlane, et al.* The document describes a call processing system for the assignment of calls to agents based on the agent's various skills in dealing with a customer. Agents are also ranked or grouped into various pools based on their skill level, in order to effectively distribute the call assignments among the agents. D1 specifically uses performance measurement metrics based on both an agent's acquired skills and an agent's augmented skills, which relate to their ability to use various automated resources. D1 also identifies higher value customers in determining which agent is assigned the call.
- [54] As explained in the Panel Letter, while D1 discloses assessing the importance of a call, assessing an agent's performance using certain metrics, and assigning calls to an agent based on the agent's assessed performance, the skilled person would not consider D1 to disclose assessing the ability of an agent based on the particular agent's past performance in persuading a customer to change his/her mind.
- [55] Regarding the additional aspect of the inventive concept, namely, the feature of persuading a customer "to choose a course of action instead that is favourable to the sponsor organization", the skilled person would not see this as a difference. D1 discloses that an agent's skill or ability is measured in part on past sales made, which would include sales revenue generated. It is inherent in any business that "sales made" is an outcome that is favourable to a company or organization. The system and method in D1, as in other typical call center systems, is specifically designed for serving customers, at least in part by making or supporting sales which are favourable to, and for benefit of, a sponsor organization.
- [56] Therefore, the skilled person would consider the difference between the inventive concept of claim 1 on file and D1 to be assigning the call to an agent based on the particular agent's past performance in persuading a customer to change his/her mind.

Step 4: Viewed without any knowledge of the alleged invention as claimed, do those differences constitute steps which would have been obvious to the person skilled in the art or do they require any degree of invention?

[57] As set out in the Panel Letter, we will consider the inventive ingenuity of the difference discussed in step 3, above, in relation to claim 1 on file. We will then consider this difference in combination with the additional different features or embodiments defined in the remaining claims.

Independent Claims

[58] Regarding claim 1 on file, the Panel's view is that the skilled person would not consider that the assigning of a call to an agent based on an agent's past performance in persuading a customer to change his/her mind would require any degree of ingenuity.

[59] From D1, the skilled person would know that past performance measurements on an agent's transactions with a customer would include at least "sale(s) made", "contact handled within a predetermined time", and "customer satisfaction". These measurements would be made for many various types of customer, including "sales contact", "trouble contact", and "emergency contact" calls (D1, col. 11, lines 40-46).

[60] While the Applicant asserted at page 9 of its Reply to the FA that the system of D1 is "*...directed to customers having a predisposition to purchase a product and who merely need guidance...*", in our view, the types of calls handled (e.g., "trouble contact" of D1) would logically include at least some calls in which the customer may be unhappy, and may therefore wish to end a service, or be otherwise predisposed to take an action that is unfavourable to the sponsor organization. There is nothing in the teaching of D1 that precludes the agents, or the call processing system itself, from also handling these calls.

[61] Additionally, as D1 measures an agents performance on "sales made", it would be logical that with any type of call from a customer, including a "trouble contact" call, an agent would also attempt to persuade the caller to consider additional services or products in order to both rectify a customer's difficulties, and to increase the agent's "sales made" performance measurement. The skilled person would understand, based on their CGK of basic sales and business 'best practices' such as customer retention, obtaining value-added sales, and maximizing revenues, that "sales made" would include those sales made by an agent offering additional service or products to a customer while they are on the phone, such as for a trouble contact call.

[62] There is no ingenuity in conceiving and implementing the modification of D1 to address customers who are unhappy. Given an agent's inherent predisposition to make more sales, it would be obvious they would attempt to persuade a customer to change their mind in some of those circumstances. Likewise, extrapolating the data of "sales made" in D1 to further identify the "sales made" when a customer is happy or merely needing guidance, and also to identify the "sales made" after persuading customer to change their mind (i.e. a "save") requires no ingenuity and would be within the skills of the skilled person. Therefore, we consider the difference between the state of the art and the inventive concept of claim 1 on file to constitute steps that would have been obvious to the person skilled in the art.

[63] The Panel Letter also provided detailed claim-by-claim analysis of the remaining independent claims 18, 25, 31, 35, 37, 39, 46-48, 50 and 65 on file. None of the independent claims were found to define a difference over D1 that would constitute a step requiring inventive ingenuity considered alone or in combination with the other claimed features. The Applicant's Reply Letter provided no submissions or arguments regarding the independent claims.

[64] Accordingly, independent claims 1, 18, 25, 31, 35, 37, 39, 46-48, 50 and 65 are considered to be obvious having regard to D1 and the common general knowledge in the art.

Dependent claims

[65] The Panel Letter provided a detailed claim-by-claim analysis that explained why the skilled person would consider the dependent claims on file to be obvious in view of D1 and the skilled persons CGK. The Panel Letter stated that none of the dependent claims add any inventive limitation to the obvious independent claims, either alone or in combination with the other claimed features. In reply to the SOR, and in its Reply Letter, the Applicant did not provide an indication of any specific feature in the dependent claims that, alone or taken in combination with the other claimed features, would render the claims unobvious. We therefore consider that the dependent claims would have been obvious to the person skilled in the art.

[66] In summary, as previously set out in the Panel Letter, claims 1-65 on file are obvious, contrary to section 28.3 of the *Patent Act*.

5. Indefiniteness

[67] The Panel Letter indicated that claims 1, 13, 14, 24, 30, 32, 33, 45, 50 and 54-65 on file are indefinite, based on various typographical errors found in the claims that render said claims unclear to the skilled person. However, the Panel Letter also noted that these minor typographical errors have been corrected in the proposed claim sets.

CONCLUSIONS ON THE CLAIMS ON FILE

[68] As set out in the Panel Letter, regarding the claims on file, the Panel has determined that:

- 1) Claims 1-30 and 46-64 contain new subject matter and thus do not comply with section 38.2 of the *Patent Act*;
- 2) Claims 1-65 comprise non-statutory subject matter and thus do not comply with section 2 of the *Patent Act*;
- 3) Claims 5-9 and 54-56 lack utility and thus do not comply with section 2 of the *Patent Act*;
- 4) Claims 1-65 are obvious and thus do not comply with section 28.3 of the *Patent Act*;
- 5) Claims 1, 13, 14, 24, 30, 32, 33, 45, 50 and 54-65 are indefinite and thus do not comply with subsection 27(4) of the *Patent Act*.

PROPOSED CLAIMS

[69] Proposed Claim Set 2 (comprising claims 1-16) was submitted by the Applicant in response to the SOR. In accordance with paragraph 30(6)(b) of the *Patent Rules*, the proposed claims have not been entered as an amendment. Specific amendments could be required if they are considered necessary for compliance under subsection 30(6.3) of the Rules, i.e., if they overcome the defects in the claims on file without introducing new defects.

[70] The proposed claims 1-16 correspond to claims 31-34 and 37-46 and 48-49, respectively, of the claims on file. The only noted differences are that proposed claims 14, 15 and 16

have been amended to remove the previous expression of "...to establish an affinity with customers..." from corresponding claims 46, 48 and 49. The subject matter of the proposed claims is otherwise the same as the claims on file, in respect of the issues before us in this review, in particular, the issues of statutory subject matter and obviousness.

[71] As set out in the Panel Letter, given the similarity to the claims on file, and in light of the reasons already provided in our analysis of the claims on file, the Panel considers that the skilled person would find that the claims submitted in Proposed Claim Set 2 are defective at least for the reasons that they lack inventive ingenuity and fail to define statutory subject matter.

[72] Therefore, the Panel does not consider that the proposed claims (Proposed Claim Set 2) meet the requirements of a "necessary" amendment under subsection 30(6.3) of the *Patent Rules*.

RECOMMENDATION OF THE BOARD

[73] For the reasons given in this recommendation, and as previously provided to the Applicant in the Panel Letter dated May 30, 2016, we recommend that the application be refused, at least for the reasons that the claims on file define non-statutory subject matter contrary to section 2 of the *Patent Act*, and the claims on file are obvious contrary to section 28.3 of the *Patent Act*.

[74] Further, proposed claims 1-16 do not overcome the defects in the claims on file, and therefore do not constitute a specific amendment that is "necessary" under subsection 30(6.3) of the *Patent Rules*.

Andrew Strong
Member

Paul Fitzner
Member

Nenad Jetvic
Member

DECISION

[75] I concur with the conclusions and recommendation of the Patent Appeal Board that the application be refused, at least for the reasons that the claims on file define non-statutory subject matter contrary to section 2 of the *Patent Act*, and the claims on file are obvious contrary to section 28.3 of the *Patent Act*.

[76] 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 18th day of May, 2017