

Commissioner's Decision No. 1471  
Décision du commissaire n° 1471

TOPICS: J-00 Meaning of Art  
J-50 Mere Plan  
J-60 Printed Matter

SUJETS: J-00 Signification de la technique  
J-50 Simple plan  
J-60 Imprimés

Application No. 2 487 991  
Demande n° 2 487 991



IN THE CANADIAN PATENT OFFICE

DECISION OF THE COMMISSIONER OF PATENTS

Patent application number 2487991, having been rejected under subsection 30(3) of the *Patent Rules*, has subsequently 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.

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## INTRODUCTION

- [1] This recommendation concerns the review of rejected patent application number 2487991, which is entitled “Computer based method for representing a project and computer program product implementing same.” The patent application is owned by SAP SE. The outstanding defect indicated by the Final Action (FA) is that the claims do not comply with section 2 of the *Patent Act*. The Patent Appeal Board (the Board) has reviewed the rejected application pursuant to paragraph 30(6)(c) of the *Patent Rules*. As explained below, our recommendation is to refuse the application.

## BACKGROUND

### The application

- [2] Canadian patent application 2487991, based on a previously filed Patent Cooperation Treaty application, is considered to have a filing date of May 30, 2003, and has been open to public inspection since December 11, 2003.
- [3] The application relates to a project development system for graphically representing the status and progress of a project.

### Prosecution history

- [4] On April 27, 2016, an FA was written pursuant to subsection 30(4) of the *Patent Rules*. The FA identified the following defect in the application: claims 1 to 35 (the claims on file) do not comply with section 2 of the *Patent Act*.
- [5] In its September 27, 2016 response to the FA (RFA), the Applicant submitted arguments for allowance, but the Examiner was not persuaded by the arguments to withdraw the rejection.
- [6] Therefore, pursuant to subsection 30(6) of the *Patent Rules*, the application was forwarded to the Board for review, along with the Examiner’s Summary of Reasons. On December 23, 2016, the Board forwarded a copy of the Summary of Reasons, with a letter acknowledging the rejection, to the Applicant. The Applicant did not respond.
- [7] A Panel was formed to review the rejected application under paragraph 30(6)(c) of the *Patent Rules* and to make a recommendation to the Commissioner as to its disposition. Following our preliminary review, we sent a letter on July 17, 2018

(the PR letter) presenting our analysis and rationale as to why, based on the record before us, the subject matter of the claims does not comply with section 2 of the *Patent Act*.

- [8] The Applicant responded to the PR letter on August 1, 2018, indicating its continued interest in the review, but explaining that it was neither requesting a hearing nor making any further written submissions.
- [9] As nothing has changed in the written record since the preliminary review, we have maintained its rationale and conclusions.

## **ISSUE**

- [10] The issue to be addressed by this review is whether claims 1 to 35 define statutory subject matter, thus complying with section 2 of the *Patent Act*.

## **LEGAL PRINCIPLES AND PATENT OFFICE PRACTICE**

### **Purposive construction**

- [11] 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 [*Whirlpool*]). In accordance with the *Manual of Patent Office Practice*, revised April 2018 (CIPO) at §13.05 [*MOPOP*], the first step of purposive claim construction is to identify the skilled person and his or her 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.
- [12] The Applicant disputed this approach in the RFA, contending that instead of focusing on the problem and solution, and determining whether the problem could be solved without an element, one should focus on each element, comparing it to potential substitutes, and determining whether the potential substitutes can provide the same function in the same way and produce the same result as the element. The Applicant also submitted that no source of law has been cited to support the above approach to purposive construction, only practice notices, which do not themselves have the authority of law.

[13] As we explained in the PR letter:

The approach described in *MOPOP* (originally in the practice notices) was developed following *Canada (AG) v Amazon.com Inc*, 2011 FCA 328 [*Amazon.com*] and thus attempts to reflect the principles of that case, as well as those of the earlier *Free World Trust* and *Whirlpool* cases. *MOPOP* does not present itself as an authority or source of law, but instead provides guidance based on the Office’s interpretation of these authorities and sources of law.

For example, *Amazon.com* at paras 43, 44, 47, 61–63, 69, 71 explains that purposive construction “cannot be determined solely on the basis of a literal reading of the patent claims”, that claim language may be “deliberately or inadvertently deceptive” and that a claimed practical application or embodiment may nonetheless not be part of the essential elements of a claimed invention.

The guidance of *MOPOP* at §13.05.02*b* echoes these principles: a properly informed purposive construction must consider the application as a whole—including the problem addressed by the application and its solution. The mere presence of an element in the claim language cannot override consideration of that solution during purposive construction.

### **Statutory subject matter**

[14] 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.

[15] “Examination Practice Respecting Computer-Implemented Inventions,” PN2013–03 (CIPO, March 2013) [*PN2013–03*] clarifies the Patent Office’s approach to determining if a computer-related invention is statutory subject matter.

[16] As explained in *PN2013–03*, where a computer is found to be an essential element of a construed claim, the claimed subject matter is not a disembodied invention (e.g. a mere idea, scheme, plan or set of rules, etc.), which would be non-statutory.

[17] Also relative to the present case, *MOPOP* at §§12.03.05–06 explains that where a claim is directed to subject matter having solely intellectual or aesthetic significance, the claim does not comply with section 2 of the *Patent Act*. An example given of such subject matter is “printed matter,” which, in this sense, should not be restricted to traditional ink-on-paper printing but also includes any means of displaying information.

- [18] For printed matter to be statutory, it and its substrate or display means must provide a solution beyond the intellectual or aesthetic content of the printed matter itself: the solution must provide new functionality.

## ANALYSIS

### Purposive construction

#### *The skilled person*

- [19] In the PR letter, we accepted the identification in the FA of the notional skilled person as a person or team skilled in the fields of project management, project oriented software process development, computers, databases and Internet-based systems. The Applicant has not disputed this identification and we adopt it here.

#### *The CGK*

- [20] Based on the application's (page 1) background description of the state of the art and the above identification of the skilled person, we identified the following concepts as CGK in the PR letter:

- general-purpose hardware and programming techniques;
- the documentation and display of projects, including their status;
- the development and management of projects;
- computerized project development systems facilitating the development and management of projects;
- graphical user interfaces (GUIs); and
- graphs, charts and other visual representations traditionally used to convey information about projects, their status and their progress.

- [21] The Applicant has not disputed this identification and we adopt it here.

#### *The problem and solution*

- [22] The Applicant has not disputed our identification in the PR letter of the problem and solution, so we adopt that identification and its associated reasoning here:

As observed in the FA (pages 3 to 4), the application introduces the invention as being for dynamically and graphically representing a project or process. The application (page 3) explains that many projects can be complex, and projects can involve several different participants in different departments and using



different technologies. A project manager may lack the expertise, information or time needed to sort through progress reports, documentation and milestone realization information from the different aspects of the project.

Accordingly, the FA identified the problem as being how to effectively present project status information. The FA identified the proposed solution as an improved scheme for presenting a user-specific graphical representation of the project, highlighting changes, such as the completion of tasks and milestones, to the manager. Perspective representations are used to readily convey project information.

The Applicant did not dispute these identifications of the problem and solution, and given the context provided by the application and the CGK, we preliminarily adopt them here.

### *The essential elements*

- [23] Independent claims 1 and 21 are directed to methods, independent claim 34 to software, and independent claim 35 to a system. All claims refer to the user-specific perspective representation of a project. The system of claim 35 corresponds to the method of claim 1 and the software of claim 34 is defined as being for the implementation of the method of any of claims 1, 21 or their dependencies.
- [24] For convenience, independent claims 1 and 21 are provided below as representative of different aspects of the invention.

Claim 1. A computer-based method for representing a project, comprising:

accessing a description of the project;

processing the description with program instructions executed by a processor and, at least in part based on results obtained by processing the description, displaying a first element and a second element of the project in a path-shaped perspective representation, the perspective representation being displayed on a display device;

receiving a user identification identifying a user for whom the perspective representation is to be displayed on the display device;

processing the received user identification with software executed by a processor and, at least in part based on a result obtained by processing the received user identification:

marking the first element in the display of the perspective representation on the display device, the marking of the first element indicating an involvement of the identified user with the first element; and

marking the second element in the display of the perspective representation on the display device, the marking of the second element indicating that the identified user is not involved with the second element; and

graphically indicating progress in the project in the display of the perspective representation on the display device.

Claim 21. A computer-based method for representing a project, the method comprising:

receiving a project identification identifying the project;

processing the project identification to access a description of the project identified by the project identification;

processing the description of the project and, at least in part based on results obtained by processing the description, identifying a first task and a second task in the project;

causing a perspective representation of at least a portion of the project to be displayed on a display device wherein, in the perspective representation, the first task of the project is represented as a first element and the second task is represented as a second element;

receiving a user identification identifying a user for whom the perspective representation is to be displayed on the display device; and

processing the received user identification and, at least in part based on a result obtained by processing the received user identification:

displaying information in the perspective representation to convey an involvement of the identified user in performance of the first task; and

displaying information in the perspective representation to convey that the identified user is not involved with the second task.

- [25] Based on the problem and solution, we preliminarily accepted the identification in the FA of the essential elements as a series of steps for representing project status information. We considered the wording differences between the independent claims, and between these claims and the claims that depend on them, to simply reflect different embodiments of the same set of essential elements. According to this identification, the essential elements did not include the processor or its associated hardware elements.
- [26] The Applicant disagreed with this identification in the RFA. The Applicant acknowledged that the approach used in the FA to identify the essential elements is consistent with the Office's published guidance on purposive construction, but disputed that guidance, as explained above. The Applicant submitted in the RFA that the processor and hardware elements are essential.
- [27] As we explained in the PR letter, the Office's published guidance is based on the principles in *Free World Trust*, *Whirlpool* and *Amazon.com*, and set out the framework for purposive construction in the context of patent application examination. According to that framework, essential elements are those required to achieve the disclosed solution as claimed.
- [28] The PR letter continued:
- Our preliminary view is that the processor and display device in the present case are not essential elements but merely the context or operating environment in which the project information is graphically represented.
- MOPOP* at §13.05.02c explains that not every element having an effect on the operation of a given embodiment is essential to the solution; some recited elements define the context or environment of the embodiment but do not actually change the nature of the solution.
- In this case, the processor, display device, computer-readable media and other associated hardware elements do not serve to solve the problem of how to effectively present user-specific project status information; they merely provide the operating context. Rather, it is the graphical representation of information of specific meaning that solves the problem to be addressed. Thus, our preliminary view is that the hardware elements are not essential elements and that the essential elements are those elements directed to a scheme for graphically representing the information of the project.
- [29] Since the Applicant made no further submissions following the PR letter, we adopt our preliminary identification of the essential elements here.

[30] Therefore, claims 1 to 20, 34 (in one of its two embodiments) and 35 share the same set of essential elements, a series of steps for representing project status information:

- accessing a description of the project;
- based on the details of the description, presenting a first element and a second element of the project in a path-shaped perspective representation;
- based on a received user identification:
  - marking the first element in the presented perspective representation such that the marking of the first element indicates an involvement of the identified user with the first element; and
  - marking the second element in the presented perspective representation, the marking of the second element indicating that the identified user is not involved with the second element; and
- graphically indicating progress in the project with the presentation of the perspective representation.

[31] Claims 21 to 33 and 34 (in the other of its two embodiments) also share a set of essential elements, which is also a series of steps for representing project status information:

- receiving a project identification identifying the project;
- accessing a description of the identified project;
- based on the details of the description, identifying a first task and a second task in the project;
- presenting a perspective representation of at least a portion of the project with the first task represented as a first element and the second task represented as a second element; and
- based on a received user identification:
  - displaying information in the presented perspective representation such that it conveys an involvement of the identified user with the first task; and
  - displaying information in the presented perspective representation such that it conveys that the identified user is not involved with the second element.

### Statutory subject matter

[32] As construed above, the essential elements are steps for graphically representing project status information according to a certain scheme. The steps for graphically representing project information do not involve new functionality but are instead characterized by the intellectual meaning and appearance of the information.

[33] The Applicant contended in the RFA that the invention is statutory, referencing *Re Fair Isaac Corp's Patent Application 2144068* (2013), 115 CPR (4th) 39, CD 1339 (Pat App Bd & Pat Commr) [*Fair Isaac*] for support. Specifically, the Applicant submitted that the essential elements involving the presentation of displayed information are “something that manifests a discernible effect or change,” unlike the output signal of *Fair Isaac* (at para 40).

[34] As we noted in the PR letter:

Our preliminary view is that the displayed information of the present invention is, by itself, abstract and has only intellectual meaning—like the output signal of *Fair Isaac* (at paras 40, 46, 57). Thus, neither output has physical existence or causes a physical change or effect, and neither invention contains statutory subject matter.

[35] We also noted in the PR letter:

Furthermore, the present invention can be recognized as non-statutory subject matter with reference to *Schlumberger Canada Ltd v Canada (Commissioner of Patents)*, [1982] 1 FC 845 (CA) [*Schlumberger*]. Similar to the method in *Schlumberger*, as characterized in *Amazon.com* (at para 62), the present claims effectively attempt to patent a method of collecting, recording and analysing data, using a computer programmed according to a mathematical formula. The formula in this case is the set of rules directing the computer to determine, display and update the rates of progress. As in *Schlumberger*, the mere presence of a computer or other physical tool does not render the otherwise abstract formula or set of rules patentable. We cannot preliminarily distinguish the present claims from the situation in *Schlumberger*, as described in *Amazon.com* (at paras 62–63, 69).

[36] Having received no further submissions on this matter, our consideration of this issue remains as it was set out in the PR letter: claims 1 to 35 do not define statutory subject matter and thus do not comply with section 2 of the *Patent Act*.

**RECOMMENDATION OF THE BOARD**

- [37] In view of the above, the Panel recommends that the application be refused on the basis that claims 1 to 35 define non-statutory subject matter and thus do not comply with section 2 of the *Patent Act*.

Leigh Matheson  
Member

Paul Fitzner  
Member

Andrew Strong  
Member

**DECISION OF THE COMMISSIONER**

- [38] I concur with the findings of the Board and its recommendation to refuse the application. The claims on file do not comply with section 2 of the *Patent Act*.
- [39] Accordingly, I refuse to grant a patent for this application. Under section 41 of the *Patent Act*, the Applicant has six months to appeal my decision to the Federal Court of Canada.

Johanne Bélisle  
Commissioner of Patents  
Dated at Gatineau, Quebec,  
this 28<sup>th</sup> day of December, 2018.