

**A3 / 2006 / 1007
In the Court of Appeal
Civil Division**

NEAL WILLIAM MACROSSAN

Appellant

and

**COMPTROLLER-GENERAL OF PATENTS, DESIGNS
AND TRADE MARKS**

Respondent

APPELLANT'S SKELETON ARGUMENT

Mental act, as such

1. It is straining the plain wording of the statute unacceptably to regard the current invention as consisting of a method for performing a mental act, as such.
2. An analysis of the patent claim¹ shows that the current invention clearly covers the step of *producing* the relevant documents, (notwithstanding Mann J's hesitation on this point in paragraph 41 of the judgment). The present case is analogous to the *Halliburton case*.² With respect, Mann J did not advance any cogent basis for distinguishing that case.
3. The 'mental act' exclusion is appropriate to cover such things as a method for a person to remember a large number of people's names by using a certain mental process. (Further examples will be given which accord with the plain wording of the statute.)
4. Parliament's use of the words '*as such*' is a clear warning that it is only referring to true and genuine mental acts (i.e. acts performed by the mind of a human). Machines cannot perform mental acts, as such. At most machines can *simulate* mental acts, but they cannot perform mental acts, as such.
5. To the extent that contrary views to the above were expressed in the *Fujitsu case*³, they were *obiter dicta* and should not be followed.

¹ The relevant claim (Claim 1) is recited by Mann J at paragraph 3 of His Honour's judgment (at Tab 4 of the Appeal Bundle).

² [2005] EWHC 1623 Pat. In *Halliburton* Pumfrey J found that the claims could be saved by the addition of the important step of producing something (although in the present case that step is already to be found in the claims). A fuller submission regarding the *Halliburton case* may be seen in paragraphs 45 to 50 inclusive of the Appellant's Reply dated 9 September 2005 (at Tab 5 of the Appeal Bundle).

³ [1997] RPC 608

Program for a computer, as such

6. Whilst Mann J was correct, with respect, to consider the ‘*substance*’ of the invention, he erred in finding that it consisted in substance of a program for a computer, as such.
7. The distinction drawn by the Appellant with cases such as *Raytheon*⁴, *Fujitsu*⁵, *Hutchins*⁶ and other cases was perfectly valid.
8. The error by Mann J. can be seen in his final analysis which is expressed towards the end of paragraph 33 of the judgment as follows:

“ ... while in Fujitsu the end product was apparently the display of a crystal, there is nothing to indicate that the result would have been any different if it had been a physical printout rather than a computer display.”

9. With respect, this remark fails to recognise that the display in the *Fujitsu* case (whether on screen or printed out on paper) only had *informational* value, whereas the documents generated by the current invention have a clear functional use, and physical value, beyond their mere informational value. This is an important distinction, which in the Appellant’s submission takes the current invention beyond the realm of a program for a computer, as such.
10. Again, the approach approved by Pumfrey J in the *Halliburton case*⁷ is highly apposite and points to the patentability of the current invention.

Apprehended (or apparent) bias

11. The Appellant repeats and relies on the submissions made in paragraphs 19 to 33 inclusive of his Reply dated 9 September 2005⁸ (and the footnotes thereto).
12. With respect, His Honour’s judgment seems contradictory as regards the applicability of the rules regarding apprehended bias to the decision in question.⁹

⁴ [1993] RPC 427

⁵ [1997] RPC 608

⁶ [2002] RPC 264

⁷ [2005] EWHC 1623 Pat. – and see footnote 2 above.

⁸ At Tab 5 of the Appeal Bundle.

⁹ Compare paragraph 16 of the judgment where His Honour said that he did not consider that the “*full bias rule*” applied with paragraph 18 where His Honour commented “ ... *those principles do not apply.*”

13. His Honour formed the view¹⁰ that it was not the occasion for a ‘*full consideration*’ of the application of the rules regarding apprehended bias, whereas, in the Appellant’s respectful submission, it was just such an occasion.
14. His Honour seemed to give no consideration to the Appellant’s argument that the proceedings were at least quasi-judicial in nature.¹¹
15. His Honour seemed to give no consideration to strong indications in the Respondent’s own manual (i.e. the *Patent Hearings Manual*) that decisions of the type in question are of a judicial nature and that the appearance of impartiality needs to be preserved.¹²
16. His Honour neglected to consider the second internet publication which the Appellant complained of in paragraphs 31 and 32 of the Appellant’s Reply dated 9 September 2005¹³.
17. His Honour seemed to advance two reasons for excluding the natural justice rules concerning bias. The first was that the proceedings were not *inter partes*. The second was that the proceedings were “... *part of the [patent] application process*” (paragraph 16 of the judgment). With respect, neither reason was persuasive. No case law authorities were cited by His Honour on this aspect.
18. The Patent Office hearing procedure is a very important process in the administration of justice and is designed to bring early finality to disagreements between the Executive and private parties regarding the patentability of inventions (or alleged inventions). If an appearance of partiality is allowed on the part of the Hearing Officer, public confidence in the process will be seriously undermined.

¹⁰ See at paragraph 16 of the judgment – fifth sentence.

¹¹ Paragraph 19, footnote 13 and Schedule 2 of the Appellant’s Reply dated 9 September 2005 (at Tab 5 of the Appeal Bundle). The Appellant’s point here being that even on the older cases (decided before the modern approach of applying natural justice rules regardless of whether the decision was ‘administrative’ or ‘judicial’ in nature, commenced in *Ridge v Baldwin* [1964] AC 40) the Courts would, in the Appellant’s submission, have required the appearance of impartiality given the quasi-judicial nature of the proceedings.

¹² His Honour did however refer to the Manual to support various other propositions – see at paragraph 17 of the judgment. The Appellant appreciates that the Manual does not, of course, promulgate the law – nevertheless the Appellant submits that its contents bear due consideration, particularly where the Comptroller is enjoying the benefit of an approach by the Court which, in the Appellant’s submission, is inconsistent with the Manual.

¹³ At Tab 5 of the Appeal Bundle.

19. Once it is accepted that the rules regarding apprehended bias in *Porter v Magill*¹⁴ apply to such proceedings, it follows quite plainly, in the Appellant's respectful submission, that the decision must be set aside.
20. In so far as His Honour relied on a waiver by the Appellant as regards the 'paragraph 6.33 report'¹⁵, His Honour erred as there was no evidence from which His Honour could properly conclude that there was a *voluntary, informed and unequivocal* election by the Appellant not to complain about the report.¹⁶
21. The clear trend of recent high judicial authority is towards heightening (rather than lowering) the requirement of apparent impartiality in the administration of justice.¹⁷ His Honour's decision was against this trend.

Dated: 12 May 2006

Neal William Macrossan
Appellant

¹⁴ [2002] 2 AC 357 per Lord Hope of Craighead at paragraph 103.

¹⁵ Which it appears His Honour did from reading paragraphs 18 and 19 of the judgment, although His Honour did not use the term '*waiver*'.

¹⁶ Such was considered to be the requirement for waiver in a similar context in *Millar v Dickson* [2002] 1 WLR 1615 at 1629 (paragraphs 31 and 32) per Lord Bingham of Cornhill.

¹⁷ *Porter v Magill* [2002] 2 AC 357 (where the House of Lords replaced the '*real danger*' test with the '*real possibility*' test) and *Lawal v Northern Spirit Ltd* [2004] 1 All ER 187 at 196 para [22].