After *Emotional Perception*: what remains?

Nicholas Fox (Fellow) proposes a revision of section 1 of the UK IPO's Manual of Patent Practice.

The Supreme Court's decision in *Emotional Perception AI Ltd v Comptroller General of Patents, Designs and Trade Marks* [2026] UKSC 3 represents the most significant development in UK excluded subject matter jurisprudence since *Aerotel Ltd v Telco Holdings Ltd* and *Macrossan's Application*. In unequivocal terms, the Court held that the *Aerotel* approach should no longer be followed and that UK law should be aligned more closely with the approach adopted by the European Patent Office under Article 52 EPC.

The consequences for the *Manual of Patent Practice* are both obvious and profound. The current version of Section 1 carries an express warning that the guidance contained in paragraphs 1.07 to 1.51.7 of the Manual is 'subject to change' pending review following *Emotional Perception*. That caveat is unusual in both its breadth and significance. It amounts to an acknowledgement by the UK IPO that a substantial proportion of the existing guidance may require reconsideration in light of the Supreme Court's decision.

Much of Section 1 remains capable of being retained, but significant parts of it can no longer be regarded as reflecting the correct legal approach following *Emotional Perception*. Paragraphs 1.09 to 1.39, dealing with the *Aerotel/Macrossan* test and its application, are the most obvious casualties. Those provisions were drafted on the basis that the four-stage Aerotel framework supplied the governing methodology for determining whether claimed subject matter fell within one of the section 1(2) exclusions. Following the Supreme Court's decision, that premise can no longer stand. To that extent, those provisions are now largely superseded.

Other parts of the chapter appear less affected. Paragraphs 1.01 to 1.08, dealing with the statutory framework and the relationship between domestic law and the EPC, remain broadly valid, although some revision will inevitably be required to reflect the Supreme Court's reasoning. Likewise, the sections dealing with the non-Article 52 exclusions, including morality, plant and animal varieties and essentially biological processes, appear capable of remaining substantially unchanged.

One section that appears particularly resilient is paragraph 1.20.3, which concerns the circumstances in which an examiner may assess patentability issues without first conducting a formal search. The authorities cited in support of that guidance, namely *Lenovo*, *CFPH* and *Shopalotto*, are not dependent upon the Aerotel methodology. The underlying propositions that examiners may rely upon their specialist knowledge, apply common sense and experience, and in appropriate cases determine excluded matter issues without undertaking a formal prior art search appear unaffected by the reasoning in *Emotional Perception*.

Indeed, some authorities which occupied only a peripheral role under the Aerotel framework may now assume greater significance. In particular, *Oneida Indian Nation's Application* appears to provide useful guidance on how the Office may approach inventions where a technical effect is asserted but not immediately apparent from the claimed subject matter. The decision emphasises that the relevant enquiry is not whether a claimed technical advantage has been explicitly stated in the application, but whether the asserted advantage is sufficiently credible and connected with the disclosure to justify further investigation. Likewise, *Actavis UK Ltd v Novartis AG* provides valuable guidance on distinguishing claim features which make a genuine technical contribution from those which amount to no more than arbitrary limitations. Similar principles can be seen in *Sandvik IP AB v Kennametal UK Ltd & Anor* [2011] EWHC 3311 (Pat), where Arnold J observed that an arbitrary selection from the prior art is not inventive merely because it represents a point of distinction. Rather, the critical question is whether the specification makes it plausible that the selected feature possesses the technical significance alleged for it. All three decisions focus attention on the existence of a genuine technical contribution rather than the mere presence of a distinguishing characteristic.

These authorities also sit comfortably with established EPO jurisprudence, including G 2/21, which requires an alleged technical effect relied upon for patentability to be encompassed by the technical teaching of the application and derivable from the invention as originally disclosed. An alleged technical effect which cannot be derived from the disclosure, or which is not credibly achieved by the

"Much of Section 1 remains capable of being retained, but significant parts of it can no longer be regarded as reflecting the correct legal approach following *Emotional Perception*."

claimed invention, cannot normally provide a basis for inventive step. Equally, where the distinguishing features do not give rise to a credible technical contribution over the prior art, they may contribute little or nothing to the assessment of inventive step. Viewed in that light, *Oneida, Actavis and Sandvik* may be seen as consistent with the broader EPO approach now endorsed by the Supreme Court.

In that respect, *Emotional Perception* may be seen not only as displacing *Aerotel*, but also as restoring attention to a wider body of authority concerned with technical effect, technical contribution and the identification of features capable of supporting inventive step.

The UK IPO has indicated that it is presently reviewing the implications of *Emotional Perception* before undertaking a comprehensive revision of the Manual. In the meantime, however, practitioners and examiners are left with a chapter that expressly acknowledges its own potential obsolescence. The question therefore arises whether the surviving portions of the Manual can provide the foundation for a revised framework consistent with the Supreme Court's judgment.

Paragraph 1.20.3 provides a logical starting point. Building upon the principles already contained in that section, and incorporating the framework identified by the Supreme Court, it should be possible to replace the now-obsolete Aerotel guidance with an approach centred upon the identification of a credible technical effect, the role of searching in evaluating that effect, the intermediate filtering exercise described by the Supreme Court by reference to *G 1/19*, and the identification of those claim features which genuinely contribute to the technical character of the invention before novelty and inventive step are assessed.

The proposed text which follows necessarily reflects one interpretation of *Emotional Perception* and G 1/19. Starting from the existing principles contained in paragraph 1.20.3, it seeks to provide practical guidance for examiners and practitioners while giving effect to the Supreme Court's reasoning and preserving authorities which appear to have survived the decision intact. Whether the UK IPO ultimately adopts a similar approach remains to be seen. The purpose of the draft is therefore not to predict the form of any future revision to the *Manual of Patent Practice*, but rather to illustrate one possible implementation of the framework described by the Supreme Court.

Proposed Replacement Text

Following *Emotional Perception AI Ltd v Comptroller General of Patents, Designs and Trade Marks* [2026] UKSC 3, the Supreme Court held that the four-step approach to assessing excluded matter set out in *Aerotel Ltd v Telco Holdings Ltd & Ors Rev 1* [2007] RPC 7 should no longer be followed.

Instead, the assessment should proceed in accordance with the approach applied by the EPO under Article 52 EPC and endorsed by the Enlarged Board of Appeal in G 1/19. After construing the claim, it should first be determined, using the so-called 'any hardware approach', whether the claimed subject matter possesses technical character by virtue of involving technical means. This requirement will ordinarily be satisfied where the claim involves physical hardware, however conventional. Where that requirement is met, an intermediate step is required before inventive step is assessed. At that intermediate step, the examiner should identify those features, whether technical or non-technical in themselves, which contribute to the technical character of the invention when considered as a whole. The purpose of this intermediate step is not to assess inventive step itself, but to identify those features which are to be taken into account when assessing inventive step.

1.20.03 Preliminary assessment without a search

A formal search may not be required for the examiner to be able to make an initial assessment of patentability.

Peter Prescott QC (sitting as a Deputy Judge) in CFPH LLC [2005] EWHC 1589 (Pat) at paragraph 96 stated that examiners are 'entitled to make use of their specialist knowledge' and are not bound to rely on prior art searches. Pumfrey J stated in *Shopalotto.com Ltd's Application* [2006] RPC 7 at paragraph 12 that certain

features may be 'so notorious that a formal search is neither necessary nor desirable', and that examiners are 'entitled to use common sense and experience.' Birss J in paragraph 17 of *Lenovo (Singapore) PTE Ltd v Comptroller General of Patents* [2020] EWHC 1706 (Pat), noted: 'Some cases may be such that no reference to prior art at all is needed to see that the subject matter is unpatentable and in that kind of case, the extra cost and trouble of a search would be wasted.' Examiners should therefore use their own judgment to determine whether to perform a search, and may accordingly use the provisions of section 17(5)(b) if appropriate (see 17.94-17.101).

1.20.03A Identification of an alleged technical effect

Where, having regard to the specification, common general knowledge and any matters of which judicial notice may properly be taken, the examiner considers that the claimed invention lacks technical means and therefore does not possess technical character, the examiner may raise an objection under section 1(2) without first conducting a formal search.

In such circumstances, if applied, the applicant may be invited to identify:

- the technical problem allegedly addressed by the invention;
- the technical effect said to be achieved; and
- the claim features said to give rise to that effect.

As noted by Floyd QC sitting as a Deputy Judge of the Patents Court in Oneida Indian Nation's Application [2007] EWHC 954 (Pat) at paragraph 25, the question at this stage is not whether the asserted advantage is explicitly set out in an application or has been conclusively established. Where the applicant identifies a technical advantage which is not manifestly inconsistent with the disclosure or common general knowledge, the examiner should generally proceed on the basis that the asserted advantage is capable of investigation in light of the prior art.

An examiner is not required to accept a bare assertion that an invention is 'technical'. The alleged technical effect should be identifiable from the application read with the common general knowledge. An effect which is not encompassed by the technical teaching of the application, or which is presented only as speculation unsupported by the disclosure, should not normally be taken into account. The alleged technical effect relied upon should be derivable from the application as filed and should be one which the claimed invention is capable of credibly achieving.

Where the examiner considers that the alleged contribution is directed solely to a non-technical objective, or that no credible technical effect is identifiable from the disclosure, a search directed to the alleged effect may not be necessary. Any question whether the identified features contribute to the technical character of the invention should then be considered in accordance with the intermediate step described below.

1.20.03B Conduct of a search where a technical effect is alleged

A search may assist not only in determining novelty and inventive step, but also in determining whether an alleged technical effect is attributable to the claimed features and whether those features are capable of contributing to the technical character of the invention.

Accordingly, where a credible technical effect is asserted, a search should normally be directed towards:

- the alleged technical effect;
- the technical means said to give rise to that effect; and
- prior art relevant to the identified technical features.

Whether the alleged technical effect is actually achieved, whether it is attributable to the relevant claim features, and whether it is capable of contributing to the technical character of the invention and supporting patentability should be assessed in light of the prior art identified by the search.

1.20.03C Intermediate step

Where the claimed invention possesses technical character, for example because it involves technical means and therefore passes the 'any hardware' assessment, the examiner should identify which features contribute to the technical character of the invention when considered as a whole before assessing inventive step. The nature of this intermediate step was outlined by the Supreme Court in *Emotional Perception AI Ltd v Comptroller General of Patents, Designs and Trade Marks* [2026] UKSC 3.

Referring to G 1/19, the Supreme Court explained that, where an invention contains a mixture of features, an intermediate filtering exercise is required before inventive step is assessed. The purpose of that exercise is to identify those features (technical or not technical in themselves) which contribute to the technical solution of a technical problem. Only such features are capable of being taken into account when assessing inventive step.

The Supreme Court explained in paragraphs 105-111, with reference to G 1/19 that:

- the purpose of the intermediate step is to identify which features are to be taken into account when assessing inventive step;
- the exercise serves as a filter for features (whether technical or non-technical in themselves) which contribute to the technical character of the invention when considered as a whole;
- technical features may be disregarded if they make no contribution to the technical character of the invention as a whole;
- non-technical features may be retained where they contribute to the solution of a technical problem (when considering the invention as a whole); and
- novelty and inventive step are not assessed at this intermediate stage.

The intermediate step does not determine whether the invention is patentable. Its purpose is to identify those features which are capable of contributing to the technical character of the invention when assessed as a whole and those which are not. Only after those features have been identified as contributing to the technical character of the invention should inventive step be assessed by reference to those features. However, all features of the claimed invention may be used for assessing novelty.

1.20.03D Features contributing to technical character

The assessment of whether a feature contributes to the technical character of an invention is distinct from the assessment of novelty and inventive step.

Features contribute to the technical character of an invention where, when considered as part of the claimed invention as a whole, they contribute to the solution of a technical problem by technical means.

In computer-implemented inventions, the five so-called AT&T signposts (from *AT&T Knowledge Ventures/Cvon Innovations v Comptroller General of Patents* [2009] EWHC 343 (Pat), as restated in *HTC v Apple* at paragraph [50]) may assist in determining whether a claimed feature contributes to a technical solution of a technical problem:

i) whether the claimed technical effect has a technical effect on a process which is carried on outside the computer;
ii) whether the claimed technical effect operates at the level of the architecture of the computer; that is to say whether the effect is produced irrespective of the data being processed or the applications being run;
iii) whether the claimed technical effect results in the computer being made to operate in a new way;
iv) whether there is an increase in the speed or reliability of the computer;
v) whether the perceived problem is overcome by the claimed invention as opposed to being merely circumvented.

The AT&T signposts are not determinative and should be treated as indicia which may assist in assessing whether a claimed feature contributes to the technical character of the invention as a whole.

Features which merely define an arbitrary parameter will not normally be found to contribute to the technical character of the invention unless they contribute to the solution of a technical problem.

In *Actavis UK Ltd v Novartis AG* [2010] EWCA Civ 82 at paragraphs 36 and 37 Jacob LJ explained that in relation to a patent claim to a plate having a 5¼ inch diameter where no such plate is found to exist in the prior art: '... the 5¼ inch limitation is purely arbitrary and non-technical. It solves no problem and advances the art not at all.' He further observed that 'Trivial limitations, such as specifying the plate diameter, or painting a known machine blue for no technical reason are treated as obvious because they are not inventive.' Such limitations will not normally be regarded as contributing to the solution of a technical problem and may therefore be disregarded when assessing inventive step.

The same principle applies to arbitrary selections from the prior art. In *Sandvik Intellectual Property AB v Kennametal UK Ltd & Anor* [2011] EWHC 3311 (Pat), at paragraph 185 Arnold J observed that an arbitrary selection is not inventive merely because it differs from the prior art. The relevant question is whether the specification makes it plausible that the selected feature possesses the technical significance alleged for it. Features which represent arbitrary selections and which are not shown to contribute to the solution of a technical problem should not normally be taken into account when assessing inventive step.

The same principle may apply to other arbitrary numerical limitations, business rules, presentations of information and other restrictions which make no contribution to the solution of a technical problem.

1.20.03E Features to be taken into account

Following application of the intermediate step, only those features identified as contributing to the technical character of the invention should be taken into account when assessing inventive step (see 3.01-3.101). Features which do not contribute to the technical character of the invention should be disregarded for the purposes of assessing inventive step, regardless of whether those features would otherwise be regarded as technical or non-technical when viewed in isolation.

Where the prior art indicates that the alleged technical effect is not achieved, or is not attributable to the features relied upon, the examiner should reconsider whether those features contribute to the technical character of the invention. An alleged technical effect which is not credibly achieved should not normally be taken into account when assessing inventive step.

Where none of the distinguishing features are found to contribute to the technical character of the invention, or where the distinguishing features do not give rise to a credible technical contribution over the prior art, there will ordinarily be no basis upon which an inventive step can be established.

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