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D E C I S I O N
of 1 July 2003

Case Number: T 0747/02 - 3.5.1
Application Number: 98963505.7
Publication Number: 1033021
IPC: H04L 29/06, H04L 12/14
Language of the proceedings: EN

Title of invention:

Device for connecting users to computer networks and data transmission method

Applicant:

Netfraternity Network S.P.A.

Opponent:

-

Headword:

Data transmission method/NETFRATERNITY

Relevant legal provisions:

EPC Art. 54.83
EPC R. 27(1)(e)

Keyword:

"Sufficiency of disclosure (yes)"
"Novelty (no)"

Decisions cited:

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Catchword:

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Case Number: T 0747/02 - 3.5.1

D E C I S I O N
of the Technical Board of Appeal 3.5.1
of 1 July 2003

Appellant: Netfraternity Network S.P.A.
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Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 14 January 2002
refusing European application No. 98963505.7
pursuant to Article 97(1) EPC.

Composition of the Board:

Chairman: S. V. Steinbrener
Members: R. S. Wibergh
E. Lachacinski

Summary of Facts and Submissions

- I. This appeal is against the decision of the Examining Division to refuse European patent application No. 98 963 505.7.
- II. The grounds for the refusal were that the application did not meet the requirements of Article 83 and Rule 27(e) (sic) EPC because the application did not disclose a way of realizing a window on a monitor which was "informatically not eliminable in any way" by the user.
- The decision also briefly mentioned the prior art document
- D6: DE-A-19 528 911,
- which had been used earlier in the proceedings as starting document for the assessment of inventive step.
- III. The Appellant (Applicant) appealed against this decision, requesting that the appealed decision be set aside and that a patent be granted on the basis of the application documents decided on by the Examining Division.
- IV. In a communication from the Board the preliminary opinion was expressed that two features in claim 1 lacked a basis in the application as filed. Even if that objection could be overcome it appeared questionable whether the invention was new over D6.

V. At the oral proceedings held on 1 July 2003 the Appellant submitted an amended wording for claim 1 and requested that the appeal be set aside and that a patent be granted on the basis of this amended claim 1.

VI. Claim 1 as filed on 1 July 2003 reads as follows:

"A method for connecting users to computer networks, comprising the steps of:

- providing, in said network, a user's computer station (1, 101) including a monitor screen (9);
- providing, in said network, at least one archive (7, 107) managed by a server of a service provider (5,105);
- combining signals arriving from said network and signals arriving from said at least one archive (7, 107), which signals arriving from said at least one archive are constituted by advertising information,
- transferring said signals to the user's computer station (1, 101);

characterised in that:

- providing that said signals, taken from said archive (7,107) assemble in a dedicated region of the monitor and are unaffected by, and do not affect, the signals that arrive from the network,
- providing that, during the connection, one or more windows (10) managed by the client software supplied by said service provider (5,105), form in said dedicated region of the monitor (9),
- providing that the advertising information is displayed in said windows (10) of the monitor (9) without the user being able to act in any way to eliminate them."

VII. The Appellant argued in the oral proceedings that the subject-matter of claim 1 differed from the disclosure of D6 in three respects.

Firstly, D6 showed a dedicated area *of a browser window* being used to display adverts, whilst the invention dedicated a non-eliminable area *of the monitor* to displaying adverts. "Dedicated" meant not varying in location. Although D6 referred (column 1, line 51) to the user being unable to influence the display of advertising ("eine von ihm nicht beeinflussbare Wiedergabe eines Werbeinhaltes"), this did not correspond to reality, since in D6 another window could be placed over the browser window to obscure the advertising.

Secondly, in D6 the adverts were displayed without dedicated client software, the same software managing the network and advertising information. According to the invention however, the service provider supplied the client software to manage the advertising window, implying the adaptation of the client software to this specific task.

Thirdly, in D6 the network and advertising information displayed by the browser were related, since no advertising occurred if there was no network connection. According to the invention however, the network and advertising information did not affect each other, it being possible to show advertising without an active network connection.

VIII. At the end of the oral proceedings the Board announced its decision.

Reasons for the Decision

1. *Amendments*

The wording of claim 1 derives from claims 1 and 6 and the description (page 2, lines 3 to 6 and page 3, lines 2 to 6 and 15 to 19), all as originally filed. The Board is consequently satisfied that claim 1 complies with Article 123(2) EPC regarding added subject-matter.

2. *Interpretation of claim 1*

2.1 The crucial feature of claim 1 is that windows containing advertising information are displayed "without the user being able to act in any way to eliminate them". Although the expression "in any way" may at first sight appear clear enough, its meaning actually depends on certain presumptions. For example, the Appellant has explained that the claim is not concerned with window elimination techniques not implemented by software, such as simply covering part of the screen with adhesive tape. Similarly, an expert programmer - as opposed to the average user - might in fact be capable of modifying the software in order to eliminate the windows. The intended meaning is thus that the average user cannot make the windows disappear from the screen by using the computer controls normally at hand. The Board agrees that this is a reasonable interpretation of the claim. It must however be

remembered that the patent application does not contain any detailed embodiments. As the Examining Division pointed out, it is in fact not disclosed how windows having the desired property are created. The lack of this information limits the degree to which the feature "without the user being able to act in any way to eliminate /the windows/" can serve to distinguish the invention from the prior art. A strictly literal interpretation is not possible.

2.2 The Appellant has furthermore argued that the term "dedicated" should be construed as meaning "not varying in location". The Board can find no basis in the original application for such a construction and hence interprets "dedicated" with its usual meaning: "devoted to a task or purpose" (see, for instance, the Oxford Concise Dictionary).

2.3 The Appellant sees a distinction between a "monitor" and a "window". Thus, in the Appellant's view, claim 1 refers to a region of the monitor, as opposed to a region of a window. The description however does not unambiguously make this distinction. It does mention that the advertisement is displayed in a window (see page 3, lines 17 to 19), but not whether that window is part of another window or not. "A region of the monitor" does not therefore exclude the possibility that this region is within a window.

2.4 According to the claim, the signals taken from the archive assemble in a dedicated region of the monitor and are "unaffected by, and do not affect, the signals that arrive from the network". The Appellant has argued that this feature implies that it is possible to show

advertising without an active network connection. The Board cannot however find a basis in the original application for this particular interpretation and the feature is taken here to mean simply that the information flows do not mutually interfere so that all data can be properly displayed.

- 2.5 According to the claim, the client software is "supplied by said service provider". This is seen as an indication of origin without limiting effect. Although such an indication might perhaps in special circumstances imply definite technical properties, this has not been convincingly argued in the present case, nor is there any specific disclosure in this respect.

3. *Sufficiency of disclosure*

In the contested decision the Examining Division concluded that the skilled person would not be able to realize the non-eliminable windows mentioned in the application. In the Board's opinion, however, it is not enough merely to point out certain non-disclosed steps which the skilled person would have to take in order to arrive at the invention (cf point 5 of the appealed decision, dealing in particular with the server-client interaction), because these may have been general knowledge. Therefore, when an objection under Article 83 EPC is raised it is often necessary to demonstrate on the basis of written or oral evidence that such steps could not be taken without undue burden or even inventive activity. As the Appellant has pointed out, however, in the present case the only evidence referred to (namely the closest prior art

document, D6) suggests - if anything - that the skilled person *could* have performed the steps.

The Board is consequently satisfied that the application, although very brief, satisfies Article 83 EPC concerning sufficiency of disclosure.

4. *The description*

The Examining Division held that the application contravened Rule 27(1)(e) EPC since it contained no detailed embodiment. The Board disagrees and finds that, for reasons similar to those outlined in the preceding paragraph, no objection can be raised in this respect.

5. *Novelty*

5.1 D6 forms the closest prior art. The single figure of D6 shows the monitor screen of a user's computer station connected via a network (the internet) to a server of a service provider. The monitor screen shows a browser window comprising a sub-window 10 displaying internet information (a web page) and a sub-window 20 displaying advertising. The features set out in the preamble of claim 1 are consequently known from D6.

5.2 Turning to the characterising features of claim 1, it is clear from D6 (column 1, line 60 to column 2, line 11) that the displayed web-site information in sub-window 10 is "unaffected by, and does not affect", the advertising displayed in sub-window 20. It is also clear that sub-window 20 is "dedicated" to the advertising information.

5.3 D6 states (column 2, lines 12 to 20) that the size of sub-window 20 containing the advertising either cannot be changed or cannot be reduced below a certain size in order to preserve the visibility of the advertisement accepted by the user for obtaining exemption from, or reduction of, connection fees. In the Board's view this amounts to the user "not being able to act in any way to eliminate" the window as set out in claim 1 (see for instance, page 4, lines 17 to 22 of the description). Since also the aims are identical the claim contains no implicit feature which might constitute a difference with respect to D6.

The Appellant has argued that a user of the D6 system would be able to place another window on top of the advertisement window and thus eliminate it by concealment. This may well be true, but the user must first have this idea. If it would *not* occur to him, then the window is, from his point of view, not eliminable. In this situation it might be tempting to distinguish between more or less astute "average" users, but the patent application offers no basis for such distinctions. In fact, as has been pointed out above (see point 2.1), the main problem remains the vague wording of claim 1: "without the user being able to act in any way to eliminate /the windows/", a feature which cannot be equated with "without the user being able to act in any way to eliminate them *in particular by placing another window on top of them*". Since this special kind of elimination is not derivable from the patent application, the invention cannot possibly reside in a technique for preventing it.

5.4 Finally, and contrary to the Appellant's submission, the Board finds no evidence that the disclosure of D6 does "not correspond to reality". When it is said in D6 that the user cannot influence the display of advertisements this is presumably because the author of D6 believed this to be the case. The statement is on the same general level as the wording of the present claim 1. The fact that so similar wordings can be used to describe allegedly different methods supports the view that the present claim wording requires considerable interpretation, which cannot however go beyond the original disclosure.

5.5 Hence the subject-matter of claim 1 is known from D6 and lacks novelty (Article 54 EPC).

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:

M. Kiehl

S. V. Steinbrener