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Datasheet for the decision of 27 October 2006

Case Number: T 0309/05 - 3.5.03

Application Number: 00963659.8

Publication Number: 1224575

IPC: H04L 29/06

Language of the proceedings: EN

Title of invention:
System and method for generating domain names and for facilitating registration and transfer of the same

Applicant:
Raredomains.com, LLC

Opponent:
-

Headword:
Domain name generation/RAREDOMAINS.COM

Relevant legal provisions:
EPC Art. 52(2), 56

Keyword:
"Inventive step - (no)"
"Formulation of technical problem"

Decisions cited:
T 0025/85, T 0038/86, T 0641/00

Catchword:
1. Where a combination of non-technical and technical features is claimed, the consideration of inventive step requires that the problem be restricted to its technical aspects (point 4.2, following T 0641/00).

2. The problem of automating the generation of Internet domain names, so that only names which are both available and desirable are presented to a potential buyer, must therefore be stripped of aesthetic and semantic considerations, since these lie in a field excluded from patentability by the provisions of Articles 52(2)(b) and 52(2)(c) EPC (Points 4.7 and 4.9). Reformulating the problem into non-technical and technical components leaves as a technical problem simply the concatenation of a text string provided by a user with a predetermined string (Points 4.11 and 4.12).

3. The subject-matter and activities specified in Article 52(2) EPC can be considered to be "non-technical", as that term has been used by the boards (Point 4.10).

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Beschwerdekammern | Boards of Appeal | Chambres de recours

Case Number: T 0309/05 - 3.5.03

D E C I S I O N
of the Technical Board of Appeal 3.5.03
of 27 October 2006

Appellant: Raredomains.com, LLC
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Representative: Callon de Lamarck, Jean-Robert
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Decision under appeal: **Decision of the Examining Division of the European Patent Office posted 21 October 2004 refusing European application No. 00963659.8 pursuant to Article 97(1) EPC.**

Composition of the Board:

Chairman: A. S. Clelland
Members: D. H. Rees
R. Moufang

Summary of Facts and Submissions

I. This is an appeal against the decision of the examining division to refuse the European patent application number 00 963 659.8 originally filed as International application number PCT/US00/25770, with publication numbers 1 224 575 and WO 01/22286 respectively. The reason for refusing the application, given in a written decision issued on 21 October 2004, was that the subject-matter of independent claim 1 did not involve an inventive step with respect to the disclosure of document

D1: WO 99/09726 A

II. Notice of appeal was filed and the appropriate fee paid on 21 December 2004. A statement setting out the grounds of appeal and including new claims 1 to 13 of a main and an auxiliary request was filed on 18 February 2005.

III. In a communication accompanying a summons to oral proceedings to be held on 27 October 2006 the board gave its preliminary opinion that the claimed subject-matter appeared to lack an inventive step, starting out from the disclosure of D1 and taking into account the disclosure of:

D5: "Domain names California Tortilla," https://register.worldnic.com/servlet/nsi.regplus.main.UpdateDomainList, 19 January 1998,

which had been mentioned in examination, or taking into account another document which is not relevant to the present decision.

The board also noted an apparent typographical error in claim 1 of both requests.

IV. In preparation for the oral proceedings the appellant submitted two new sets of claims correcting the error which had been pointed out.

V. At the oral proceedings the appellant requested that the decision under appeal be set aside and that a patent be granted on the basis of claims 1 to 13 of the main request or, in the alternative, claims 1 to 13 of the first auxiliary request, both filed by fax on 28 September 2006 or claims 1 to 13 of the second auxiliary request filed at the oral proceedings.

VI. The independent claims of the main request read as follows:

"1. A system for generating a domain name and for facilitating registration of the same, comprising:
a data storage facility storing a plurality of user unspecified terms which can be prefix or suffix for use in generating at least one registerable domain name; and
a processor arrangement coupled to said data storage facility and configured to be accessed by a user system via an electronic data network, to receive at least one user specified term from said user system, to generate at least one candidate domain name, to query a data source to determine if said at least one candidate

domain name is available for registration, and to notify said user system of said at least one candidate domain name when said at least one candidate domain name is available for registration,
characterized in that
said processor arrangement is configured to generate at least one root name by concatenating said at least one user specified term with said at least one user unspecified term stored in the data storage facility, and to generate at least one registerable domain name by concatenating said at least one root name with a top level domain.

7. A method for generating a domain name and for facilitating registration of the same, characterized in that it comprises the steps of:
storing at least one user unspecified term for use in generating at least one registerable domain name;
permitting a user to access a server facility via an electronic data network;
receiving at least one user specified term from said user system via said electronic data network;
concatenating said at least one user specified term with at least one user unspecified term to generate at least one root name, and concatenating said at least one root name with a top level domain to generate at least one candidate domain name;
querying a remote data source to determine if said at least one candidate domain name is available for registration; and
notifying said user of said at least one candidate domain name when said at least one candidate domain name is available for registration.

8. A system for generating a domain name and for facilitating transfer of the same between registrants, comprising:
a data storage facility storing at least one user unspecified term which can be prefix or suffix,
a processor arrangement coupled to said data storage facility and configured to be accessed by a user system via an electronic data network, to receive at least one user specified term from said user system, to generate at least one candidate domain name,
characterized in that
said processor arrangement is configured to query a data source to determine if said at least one candidate domain name is available for transfer, to notify said user system of said at least one candidate domain name when said at least one candidate domain name is already registered and available for transfer between registrants, and in that
said processor arrangement is configured to generate at least one root name by concatenating said at least one user specified term with said at least one user unspecified term stored in the data storage facility, and to generate at least one domain name already registered and available for transfer between registrants by concatenating said at least one root name with a top level domain."

In claim 1 of the first auxiliary request it is additionally specified that the data storage facility is a "thesaurus data storage facility" and that the concatenated user specified and unspecified terms have "similar meanings". Independent claims 7 and 8 are correspondingly amended.

Independent claim 1 of the second auxiliary request differs from claim 1 of the main request in specifying "a memory storing a database table including an internal domain name list," the "processor arrangement being further configured to compare each candidate domain name against the internal domain name list for determining if the candidate domain name is not available for registration." Independent claims 7 and 8 comprise equivalent features.

VII. At the end of the oral proceedings the chairman announced the board's decision.

Reasons for the Decision

1. *The prior art*

1.1 Document D1 describes a system in which the user enters a desired "root name" (using the terminology of the present application), for example "turnip", and queries are launched over the Internet as to the availability of domain names consisting of this root name concatenated with various standard domains such as "turnip.com", "turnip.org", "turnip.co.uk", etc.. The results are reported to the user who may request to register one or more of the domain names found to be available.

1.2 Document D5 shows the result of entering a pair of keywords into a system which first uses the input keywords to generate a number of different possible root names and then carries out the same process as D1 (at least for the domains "com", "net" and "org"). The

method used to generate the root names involves firstly capitalising the keywords and then concatenating them, or combinations of one keyword and the first letter of the other, with or without a hyphen between them. Thus in the example given the keywords are "california tortilla" which give rise to suggested domain names such as "California-Tortilla.com", "California-T.net" and "CTortilla.org".

1.3 Although few technical details are given the board considers that no more than the general knowledge of the field would be required for the skilled person to implement the system whose function is illustrated in D5.

2. *"Technical character" of the claimed subject-matter*

It is unnecessary for the board to decide whether the subject-matter of any of the claims is excluded from patentability by the provisions of Article 52(2) and (3) EPC alone, given its conclusion on the question of inventive step - see below.

3. *Novelty*

Neither D1 nor D5 discloses a data storage facility storing a plurality of user unspecified terms, i.e. a plurality of pre-defined strings. The claimed subject-matter of all the requests is therefore novel with respect to these documents.

4. *Inventive step - the main request*

4.1 The invention specified in claim 1 is a system which takes input from a user, for example "Smith", and concatenates this input with stored text strings, such as "ontheweb" and "Internet". The system then queries a data source, typically a domain name registrar, whether the corresponding domain names, e.g. "Smithontheweb.com" and "SmithInternet.com" are available for registration. Those which are found to be available are notified to the user. The claim specifies that the source of the strings to be concatenated is a "data storage facility" and that the generation of candidate domain names, querying and notifying are carried out by a "processor arrangement".

4.2 In the board's view this claimed invention involves a mixture of "technical" and "non-technical" considerations and the board finds it appropriate to adopt the approach used in T 0641/00 (OJ 2003, 352 - see in particular Point 7) whereby the problem must be restricted to its technical aspects when deciding the question of whether the claimed subject-matter involves an inventive step; the non-technical aims achieved may be taken into account when formulating this technical problem.

4.3 The appellant argued that document D1 represented the nearest prior art and that the problem overcome by the claimed invention was to facilitate registration of domain names by increasing the number of candidate domain names. The invention gave the advantage that the user did not have to input a variety of trial root names until an available domain name was found.

Document D5 would not lead the skilled person to the claimed invention since it did not disclose or require the use of a data storage facility storing a plurality of user unspecified terms.

4.4 The board does not find this formulation of the problem convincing. The problem of how to generate a number of domain names having a good chance of being available had already been solved by D5, so that the problem proposed by the appellant would at least have to be reformulated as finding an alternative way of increasing the number of candidate domain names. However this reformulated problem has several other solutions which would have been evident to the skilled person, including the very simple and effective solution of simply generating random strings.

4.5 In the communication accompanying the summons to oral proceedings, the board had suggested that the disclosure of document D5 would motivate the skilled person to adapt the system of D1 to search for variants of one or more user specified terms as candidate domain names. The kind of variants generated would seem to be an aesthetic or linguistic choice. The appellant argued that this was not the case, since the claimed subject-matter did not specify anything to do with the meaning of the terms concatenated.

4.6 The board does not find this argument convincing. In the board's view the problem when starting from D1 must be formulated as being how to generate a number of domain names having a good chance both of being available, and of being memorable and otherwise acceptable to the user, which second condition involves

linguistic, semantic and possibly aesthetic considerations. That the domain name is intended to be memorable may be illustrated by the comparison of "Smithontheweb.com" with "Smith5ewzrmca.com", a name generated by suffixing a random string to "Smith". That it must have a good chance of being otherwise acceptable may be illustrated by considering "Smithontheweb.com" compared with "Smithisathief.com". Thus, although the presently claimed features do not specify anything to do with the meaning of the terms, if the meaning were unimportant not all the specified features would be necessary. As an example, suffixed random strings would be more likely to generate available domain names and they would not require "a data storage facility storing a plurality of user unspecified terms".

4.7 Since D5 has already disclosed one solution to the problem of generating memorable and acceptable candidate domain names, the board considers that this document represents the nearest prior art, and that the problem solved with respect to this closest prior art is to provide an alternative way of generating a number of domain names having a good chance both of being available, and of being memorable and otherwise acceptable to the user.

4.8 The appellant mentioned another "problem" overcome by the claimed invention when compared with D5. It was argued that D5 required two user inputs and the claimed invention only one. The board does not agree that this overcomes a problem. Firstly as a formal point the present claims require "at least one user specified term" not exactly one user specified term. Secondly,

the board is not convinced that there is any material difference between inputting two strings and inputting one string which includes a separator character. In fact it would appear that in D5 there is only one field for entering the keywords and that " " or some other designated separator character is simply given a special role in the lexical analysis of the string. Finally, there is nothing in the difference between the two systems which means that the input in the claimed invention is shorter or easier than that in D5. In the invention the input may be the inordinately long name of a Welsh railway station; in D5 it may be "to go".

4.9 The board considers the problem solved by the claimed subject-matter vis-à-vis the disclosure of D5 not to be technical *per se*, since being "memorable" and "acceptable" require aesthetic and semantic considerations which lie in fields excluded from patentability by the provisions of Articles 52(2)(b) and 52(2)(c) EPC.

4.10 The board is aware that it is apparently equating the concept of "not being technical" with the list in Article 52(2) EPC. To be more precise it considers that the subject-matter and activities specified in Article 52(2) EPC can, when interpreted as they have been by the Boards of Appeal, be considered to be "non-technical", as that term has been used by the Boards, without non-technicality necessarily being limited to the list. It is sometimes argued that the items on the list cannot be grouped under the same heading, because they are highly heterogeneous and do not share any identifiable common property, by which a positive property is implicitly meant. This argument is not

wholly convincing - a blue ball and a yellow ball can share the property of being "not red" although they are not the same colour. Equally, the items in the list of Article 52(2) EPC can all be considered not to be technical even if for a variety of reasons.

4.11 The claimed solution to the problem identified by the board can, in order to separate the technical and non-technical contributions, be presented as consisting of two steps. The first step is to specify an alternative (compared to D5) rule for generating memorable and acceptable domain names, the rule adopted being to concatenate a string chosen by a person with one of a number of pre-defined strings. As explained above (Points 4.4 to 4.6) these pre-defined strings must be chosen according to their semantic content. The use of a string combination rule based on the semantics of the terms represented by the strings used is, in the view of this board, an activity excluded from patentability by the provisions of Article 52(2) EPC. The list given in this Article is not exhaustive ("The following in particular shall not be regarded as inventions ..."), and the present activity is comparable both to "rules ... for performing mental acts" (Article 52(2)(c) EPC) and "aesthetic creations" (Article 52(2)(b) EPC). In this view the board follows earlier decisions such as T 0022/85 (OJ 1990, 12) and T 0038/86 (OJ 1990, 384). The features of the first step cannot therefore contribute to an inventive step.

4.12 The second step, which corresponds to the technical problem solved once the first, non-technical part of the solution has been discounted, is simply the implementation of a system which accepts a string from

a user and concatenates a predetermined string or strings to it. In the board's judgement the solution of this problem by provision of a "dictionary" storage (i.e. "a data storage facility storing a plurality of user unspecified terms") and an appropriately programmed processor would not require any inventive step. The appellant has not argued that it would and the application treats the programming necessary as not requiring any further description (page 9, lines 12 to 17).

4.13 Thus the board concludes that the claimed subject-matter does not involve an inventive step with respect to the disclosure of document D5 and the main request is therefore not allowable.

4.14 The board notes that claim 7 defines a method corresponding to the system of claim 1 and lacks an inventive step for the same reasons. Claim 8 relates to the case where a domain name is available not from the domain name registrar but may be bought from someone who has already registered it. It may be inferred therefore that the "data source" specified in claim 8 is not the same as that specified in claims 1 and 7. However neither the claims nor the application as a whole give any indication that there is a technical difference between the two data sources in these two cases. Hence the same arguments apply again.

5. *The first auxiliary request*

5.1 The claims of this request specify that the "data storage facility" takes the form of a thesaurus and that only terms having a similar meaning to the user

input term are selected for concatenation with it. The appellant argued that this meant that the data storage had a different architecture and that the steps of selection would use pointers in a different way to the main request. However, applying the same logic as for the main request the board concludes that the technical problem facing the skilled person in the first auxiliary request is simply the implementation of a system which accepts a string from a user, looks the string up in a thesaurus and concatenates the string with the results. The appellant did not dispute that electronic thesauruses were known at the present priority date (the application treats them as known) and the board concludes that no inventive step would be involved in solving the technical problem. This request is therefore also not allowable.

6. *The second auxiliary request*

6.1 Independent claim 1 of the second auxiliary request differs from claim 1 of the main request in specifying "a memory storing a database table including an internal domain name list," the "processor arrangement being further configured to compare each candidate domain name against the internal domain name list for determining if the candidate domain name is not available for registration." That is, after having generated a candidate domain name the system checks whether it is already known to have been registered (because the system has already registered the name or the query has already been made and answered negatively) before making a request of the domain name registrar. Independent claims 7 and 8 comprise equivalent features.

6.2 This request was submitted in the oral proceedings, so in accordance with Article 10b of the Rules of Procedure of the Boards of Appeal the first issue to be dealt with is whether the request should be admitted. Two considerations are decisive for the board. On the one hand the feature introduced has not apparently been dealt with at any point in the proceedings. Hence if the request were admitted the board would have to re-examine all of the available prior art to see if the additional feature would be obvious in the light of the present documents. If not, the board would have to consider whether the case should be remitted for further search and examination. On the other hand the chances of this request being finally allowable would appear *prima facie* slim. The principle of keeping a record of prior transactions and checking it in order to avoid wasteful repetition of queries would appear to be an obvious one, both in a business or organisational context and in computer science, where it is well known as "caching".

6.3 The board therefore decides not to admit the request.

7. There being no allowable requests the appeal must be dismissed.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar | The Chairman

D. Magliano | A. S. Clelland