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**Datasheet for the decision
of 20 November 2009**

Case Number: T 1572/06 - 3.5.01
Application Number: 00936393.8
Publication Number: 1208500
IPC: G06F 17/60, G06F 17/30
Language of the proceedings: EN

Title of invention:

System and method for influencing a position on a search result list generated by a computer network search engine

Applicant:

Yahoo! Inc.

Opponent:

-

Headword:

Search listing/YAHOO!

Relevant legal provisions:

EPC Art. 52(1)

Relevant legal provisions (EPC 1973):

EPC Art. 54(1)(2)

EPC R. 67

Keyword:

"Novelty - no"

Decisions cited:

J 0010/07

Catchword:

-



Case Number: T 1572/06 - 3.5.01

D E C I S I O N
of the Technical Board of Appeal 3.5.01
of 20 November 2009

Appellant: Yahoo! Inc.
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Sunnyvale, CA 94089 (US)

Representative: McLeish, Nicholas Alistair Maxwell
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Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 18 May 2006
refusing European patent application
No. 00936393.8 pursuant to
Article 97(1) EPC 1973.

Composition of the Board:

Chairman: R. R. K. Zimmermann
Members: K. Bumès
G. Weiss

Summary of Facts and Submissions

I. European patent application No. 00936393.8 filed with a priority date of 28 May 1999 and published as International Publication WO-A-00/73960 concerns a computer network search engine apparatus for providing a search result list to the searcher's browser, and a method for operating such an apparatus, where an advertiser pays a money amount for each click-through referral through an advertiser's listing in the search result list, click-throughs being recorded as a retrieval request event at an account management server and redirected to the advertiser's URL via a redirect mechanism.

II. The examining division refused the application. The decision was given orally in oral proceedings on 11 May 2006 and was subsequently put in writing and notified to the applicant on 18 May 2006. According to the decision, the claim requests were not allowable for lack of novelty (then main request and first auxiliary request) and inventive step (2nd auxiliary request), respectively, in the light of document D10. This document is an Internet publication of Go To.com Inc. titled " Advertiser FAQ on Getting Listed", Go to Advertising: Frequently Asked Questions, 20 February 1999, pages 1 to 5 and retrieved from the web site web.archive.on/web/19990220_160623/goto.com/d/about/advertisers/faq.jhtml on 8 December 2005.

Regarding the 2nd auxiliary request, the examining division found a difference between the present invention and the teaching of document D10 in that the retrieval request event comprised the money amount of

the selected listing and an account identifier associated with the selected listing. This related, however, only to the exchange of business related data and lacked technical character. Considering the case law of the boards of appeal in respect to so-called mixed type inventions, the examining division concluded that such features did not support the presence of inventive step.

Despite the negative conclusion, the decision raised a further argument against inventive step based on a message posted in a newsgroup forum on 31 December 1998. The posting was cited as prior art document D13, and a copy of the posting was handed over to the applicant for the first time in the oral proceedings of 11 May 2006.

III. The appellant/applicant lodged an appeal against the refusal of its application on 18 July 2006 and filed a written statement setting out the grounds of appeal, including three sets of claims titled main request and first and 2nd auxiliary requests, on 28 September 2006. In response to a communication issued by the Board pursuant to Rule 100(2) EPC, the appellant filed an amended 2nd auxiliary request on 28 July 2009. A subsidiary request for oral proceedings in case the Board did not allow any or all of the requests then on file was explicitly maintained.

IV. In oral proceedings held before the Board on 20 November 2009, the matter in issue was discussed with the appellant. At the end of the oral proceedings, the Board announced the decision on the appeal.

V. The appellant requested that the decision under appeal be set aside and a patent be granted on the basis of claims according to the main or first auxiliary requests filed with the statement setting out the grounds of appeal or on the basis of claims according to the 2nd auxiliary request filed with letter received on 28 July 2009. Furthermore the appellant requested the reimbursement of the appeal fee.

The independent method claims according to these requests read as follows:

Main request:

"26. Method of operating a computer network search engine apparatus (22, 24), the method comprising: storing in a database (38, 40) a plurality of search listings (344), each search listing being associated with an information provider (302), at least one keyword (352), a money amount (358), and a computer network location (356); receiving over the computer network (20) a keyword entered by the user at an input device (24); identifying search listings (344) of the database (38, 40) having a keyword (352) matching the keyword entered by the user; ordering the identified search listings (344) using the money amounts (358) for the respective identified search listings (344); generating a result list (710) including at least some of the ordered search listings; and providing the result list (710) substantially in real time over the computer network (20) to the user; and characterised by:

recording a retrieval request event in response to a retrieval request received over the computer network (20) from the user to retrieve information associated with a search listing (344) selected from the result list (710), the retrieval request event including account identification information for the information provider associated with the selected listing; and charging to an account of the information provider associated with the selected search listing the money amount (358) associated with the selected listing (344)."

First auxiliary request:

"26. A method of operating a computer network search engine apparatus (22, 24),

... [the text omitted is identical to the preamble of claim 26 of the main request]

and characterised by:

recording a retrieval request event in response to a retrieval request received over the computer network (20) from the user to retrieve information associated with a search listing (344) selected from the result list (710), the retrieval request event including the computer network location (356) associated with the selected listing (344) and an account identifier for an account of the information provider (302) associated with the selected listing (344); and charging to the account of the information provider is a money amount (358) associated with the selected listing (344)."

Second auxiliary request:

"26. A method of operating a computer network search engine apparatus (22, 24),

... [the text omitted is identical to the preamble of claim 26 of the main request]
receiving a retrieval request over the computer network (20) from the user to retrieve information associated with a search listing (344) selected from the result list (710);
redirecting the user to the computer network location (356) associated with the selected search listing (344);
recording information from the retrieval request; and
charging, to an account of the information provider (302) associated with the selected search listings (344), the money amount (358) associated with the selected listing (344);
characterised in that:
account identification information coded into the search result list is accessed before the user is redirected to a computer network location (356) and recorded in the account of the information provider (302) associated with the selected search listing (344) along with the information from the retrieval request as a retrieval request event in order to match an account identifier with a computer network location."

- VI. The submissions of the appellant in support of the appeal requests are summarised as follows.
The present two-part form of the independent claims delimited the claimed invention against document D10 as the closest piece of prior art. In the light of document D10 the invention solved the technical problem of how to associate or reconcile simply and dependably, a click with an account of an advertiser to be charged for a click-through from the search result list to the advertiser's website.

The invention solved this problem by recording, in response to a user request to retrieve information associated with a selected listing, a retrieval request event including the "account identification information", a term which was used in the application synonymous to the terms "account identifier" and "account number".

The account identification information was not information merely suitable for identifying an account, but rather information that positively identified an account. A URL was associated with an advertiser but this was not the same as identifying the account of an advertiser. A URL and an account identification information were clearly different things. At p. 4 and 5 of document D10, an example for an account identifier was given which was clearly different from a URL. From this, it was clear that the URL as used in document D10 could not be equated with the account identification information of the present invention. Recording the account identification information as part of a retrieval request event in response to receiving a retrieval request was a novel technical feature of the invention.

To record the account identification information at a particular moment and in a particular way was a technical solution to the technical problem of the invention. Accessing and recording the account identification information at a point of time before the user was redirected to the advertiser's computer network location was an important difference to the prior art. It allowed to reconcile the click with the

correct account by matching an account identifier and URL with an unrivalled accuracy not possible with the prior art systems. By obtaining and recording the account identifier before redirecting the user request to the advertiser's website, mischarging as well as missing to charge the provider's account were avoided. The transaction log generated by the present system was of unsurpassed accuracy and reliability.

Regarding the request for refund of appeal fee, the appellant invoked various reasons for procedural violations: First the examining division introduced document D13 during the oral proceedings for the first time without giving the appellant sufficient time to study the document. Although indicating that it would not use document further in the proceedings, the examining division cited it and used the document as prior art in the reasons given for lack of inventive step. Finally, in the oral proceedings, the examining division did not consider and discuss seriously the arguments provided by the appellant on the technical character of the invention and did not give any reasoned response to the arguments at any other time in the proceedings.

Reasons for the Decision

1. The appeal, although admissible, is not allowable since neither one of the present requests seeks protection for an invention which meets the requirements of the Convention. In particular, the methods claimed according to the main request and the first and second

auxiliary requests do not meet the requirement of novelty in the light of prior art document D10.

2. The relevance of document D10 as closest prior art was not disputed neither in first instance nor before the Board. The appellant actually filed independent claims in the two-part form, with the express intention to delimit the invention against the prior art disclosed in document D10. Nevertheless, the Board considered carefully whether this document could serve as prior art at all, taking into account its character as an Internet publication of a FAQ list of frequently asked questions and answers, directed to lay customers rather than to experts and giving technical details more in passing as background information. In the present case, however, the Board has no doubt that the subject-matter which is relevant as prior art to the present invention as claimed derives in an unambiguous manner, at least implicitly, from document D10.

3. Regarding the invention for which the present requests seek patent protection, there have been considerable arguments on the meaning and the scope of the definition "account identification information" considered by the appellant as a key term in the definition of the invention. The appellant interpreted the term as a synonym for "account identifier" and "account number", understood as information not only suitable for identifying but positively identifying the accounts of the respective advertisers.

The Board rejects this interpretation for the following reasons. The present application uses all three terms in slightly different contexts. As nothing else is

indicated, it follows from the normal practice of definition that such different terms should be understood to have different definitional content. Whereas the terms "account identifier" and "account number" appear to be clear from the description, in particular from the explanations given in the context of figure 5, the term "account identification information" can be found only in a single paragraph, the relevant part of which reads as follows:

"A searcher 'clicks' on the hyperlink with a computer input device to initiate a retrieval request to retrieve the information associated with the advertiser's hyperlink. Preferably, each access or 'click' on a search result list hyperlink will be redirected to the search engine Web server work 24 to associate the "click" with the account identifier for an advertiser. This redirect action, which is not apparent to the searcher, will access account identification information coded into the search result page before accessing the advertiser's URL using the search result list hyperlink clicked on by the searcher. The account identification information is recorded in the advertiser's account along with information from the request as a retrieval request event" (see the International publication, p. 15, lines 22 to 31).

It would rather be a surprising feature of the invention to disclose account numbers of advertisers to an anonymous public by having them coded into the search result pages, in particular in view of the importance paid to security considerations in this field (see also p. 13, lines 28 to 31 of the

International publication). In the absence of any disclosure of such a specific meaning in the application, "account identification information" has to be understood according to its normal meaning in a broad sense as any information, even encompassing the names and URLs of advertisers, which enables to identify accounts and in the present more specific context of the invention disclosed, to enable the account management to "associate" the click with an account identifier for the purpose of identifying the account to which a click-through should be charged.

4. Such type of identification information is disclosed in document D10. The prior art process uses "referral URLs" encoded into the search result page (see for example D10, section "Opening a New Advertising Account", the penultimate sentence of the answer to the question "I'm not able to see the site/the online form etc"). At least by means of such URLs the account management is able to track the click-through to the advertiser's site from the search result page and to charge the agreed money amount to the correct account (see last sentence of the answer to the question "What is the \$25 credit amount?").

5. The delimitation of the independent method claims (claim 26 in all requests) against the prior art of document D10 is undoubtedly correct in so far as the respective first claim portion contains only features which form, in combination, part of the prior art of document D10. Taking into account, however, the broad scope of the term "account identification information" (see above), the Board determines that the features of

the characterising portion are also fully in the prior art of document D10.

6. According to claim 26 of the main request, the method is distinguished allegedly by the following features from the prior art of document D10 (paragraphing added for convenience):
- A) recording a retrieval request event in response to a retrieval request receives over the computer network (20) from the user to retrieve information associated with search listing (344) selected from the result list (710), the retrieval request event including account identification information for the information provider associated with the selected listing; and
 - B) charging to an account of the information provider associated with the selected search listing the money amount (358) associated with the selected listing (344).

Except for the clarifying amendment "search listing", the claim wording according to the first auxiliary request differs from that of the main request only in the definition of the retrieval request event, which reads as follows (paragraphing added for convenience):

- C) the retrieval request event including the computer network location (356) associated with the selected listing (344) and an account identifier for an account of the information provider (302) associated with the selected listing (344).

Method claim 26 of the second auxiliary request defines the differences to the prior art of document D10 as follows (paraphrasing added for convenience):

D) account identification information coded into the search result list is accessed before the user is redirected to a computer network location (356) and E) recorded in the account of the information provider (302) associated with the selected search listing (344) along with the information from the retrieval request as a retrieval request event in order to match an account identifier with a computer network location.

7. Feature B (above) is anticipated by document D10. Section "Opening a New Advertising Account" indicates in the answer to the question "What is the \$25 credit amount?" that "the bid amounts ... deducted from your account balance as consumers click through to your site from our search results pages", in the answer to the question "How are the search term bids related to this amount?" that "Every time someone clicks through ..., we deduct from your prepaid balance the amount you bid on that given search term ...", and in the answer to the question "What is a bid price?" that "The bid price is the amount you are willing to pay for a user click through to your site from our search results listings after they have performed a search on your search term".
8. Albeit the indications are fairly brief, on the face of it the only sensible interpretation is that for each click-through from the search result page to the advertiser's site, a money amount associated with the listing selected by the click is automatically deducted from the advertiser's account. Doubts raised by the

appellant regarding this interpretation of document D10 were not based on any verifiable facts or evidence and did not go beyond speculative considerations what the skilled person would or would not understand in reading the document.

9. The Board also declines to see in features A, C and E (above) any advance over the prior art of document D10. The document explicitly indicates that "monthly reporting of search term performance, which includes a breakdown of click-throughs for each search term" was provided and that "the major statistics about the visitors - what they searched on, when it was searched on ..." was collected (see section "Account Information/Maintenance", questions "How can I tell how many click-throughs have occurred to my site?" and "How do you measure click-throughs?").

10. It follows from the answers that the search terms and other related information are recorded in response to each retrieval request ("click-through"), whereby the information recorded may defined deliberately as a "retrieval request event" to stay consistent with the terminology used in the present application. In addition, the answer to the question "How do I add/delete search terms to/from my account?" (see section "Account Information/Maintenance") indicates that each search term is associated with an URL, and that each URL is associated with an account number of an account allocated to the advertiser.

Therefore, not only the URL, but also the search terms if recorded according to the prior art process are pieces of information which (at least) enable the

account management to identify the advertiser and the advertiser's account and to match the account number and the URL, which is the computer network location of the advertiser.

11. In summary, all distinguishing features A, B, C, D, and E above, are anticipated in combination, by the prior art process of document D10.

It follows that invention claimed according to the present requests does not comply with requirement of novelty (Article 52(1) EPC and Article 54(1) and (2) EPC 1973) so that the appeal cannot be allowed on its merits.

12. Finally, the request for reimbursement of appeal fees cannot be allowed since it does not meet the condition of allowability of the appeal as set out in Rule 67 EPC 1973 (applicable in the present case, see J 10/07, OJ EPO 2008, 567, Reasons No.7).

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:

T. Buschek

R. R. K. Zimmermann