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**Datasheet for the decision
of 21 October 2016**

Case Number: T 2261/10 - 3.5.07

Application Number: 05736250.1

Publication Number: 1747516

IPC: G06F17/30

Language of the proceedings: EN

Title of invention:

Conducting Internet search from an instant messaging [sic]
application

Applicant:

Yahoo! Inc.

Headword:

Search request via instant messaging/YAHOO

Relevant legal provisions:

EPC Art. 56, 111(1)

Keyword:

Inventive step (yes - with respect to the prior art cited by
the first instance)
Remittal to the department of first instance

Decisions cited:

Catchword:



Beschwerdekammern
Boards of Appeal
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Case Number: T 2261/10 - 3.5.07

D E C I S I O N
of Technical Board of Appeal 3.5.07
of 21 October 2016

Appellant: Yahoo! Inc.
(Applicant) 701 First Avenue
Sunnyvale, CA 94089 (US)

Representative: Boulton Wade Tennant
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Decision under appeal: **Decision of the Examining Division of the European Patent Office posted on 15 July 2010 refusing European patent application No. 05736250.1 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chairman R. Moufang
Members: M. Rognoni
R. de Man

Summary of Facts and Submissions

I. The applicant (appellant) appealed against the decision of the Examining Division to refuse European patent application no. 05736250.1.

II. In the contested decision, the Examining Division came, *inter alia*, to the conclusion that the subject-matter of claim 1 filed by telefax dated 10 March 2008 lacked inventive step in view of the following prior art:

D2: US-A-5 764 916.

III. With the notice of appeal, the appellant requested that the decision under appeal be set aside in its entirety and implicitly requested that a patent be granted on the basis of the claims filed by telefax dated 10 March 2008.

With the statement of grounds of appeal, the appellant requested oral proceedings in case the Board decided, for any reason, not to allow the appeal in whole or in part.

IV. The appellant was summoned to oral proceedings scheduled to take place on 15 September 2016.

V. In a communication pursuant to Article 15(1) RBPA, dated 24 June 2016, the Board essentially agreed with the appellant's assessment of document D2 and found that the reasons given by the Examining Division did not justify the refusal of the application.

However, as the Board was aware of further prior art which might prejudice the patentability of the claimed

subject-matter, the following courses of action were proposed:

- (a) The Board would decide to set aside the decision under appeal and remit the case to the department of first instance for further prosecution. In its decision, the Board would merely point out the relevance of the new prior art, but draw no conclusion as to the inventive step of the claimed subject-matter. In this case, oral proceedings might be cancelled.
- (b) Considering, *inter alia*, the age of the application the Board would conduct a full examination of the appeal in the light of the new prior art and of any submissions the appellant might wish to make. A decision would be given at the oral proceedings scheduled for 15 September 2016.

The Board then drew the appellant's attention to the following prior art and explained its relevance:

D3: US-B1-6 678 673

D4: US-B1-6 430 602.

VI. In response to the Board's communication, the appellant, with letter dated 9 August 2016, gave preference to the first course of action (a), i.e. it requested that the decision under appeal be set aside and the case be remitted to the department of first instance for further prosecution. The appellant therefore assumed that the scheduled oral proceedings would be cancelled.

Additionally, the appellant filed some comments on documents D3 and D4 referred to in the Board's communication.

VII. The Board then informed the appellant that the oral proceedings had been cancelled.

VIII. Claim 1 considered in the contested decision reads as follows:

"A method for searching the Internet in an instant messaging environment, the method comprising:

recognizing (602, 703) at least a portion of an instant message, from a first user to a second user and entered into an instant messaging application on a first client computer (410) of the first user, as a search query, wherein said recognizing comprises identifying a predetermined character string in the instant message as a search trigger;

causing the search query to be displayed (502, 603, 607, 702, 706) to the first user inline in an instant messaging window on the first client computer and to the second user inline in a second instant messaging window on a second client computer (411) of the second user;

causing (503, 604, 708) a web search based on the search query in response to identifying the search trigger in the instant message, the web search retrieving search results, by transmitting the search query to a search server, wherein the search server performs the web search based on the search query; and

automatically causing at least one of the search results to be displayed (505, 609, 611, 711, 713) inline in the instant messaging window on the first client computer and inline in the second instant messaging window on the second client computer."

- IX. The appellant's arguments relevant to the Board's decision are reported in detail in the reasons below.

Reasons for the Decision

1. The appeal is admissible.
2. The present application is concerned with techniques for performing a web search inline in an instant messaging environment and displaying search results inline in the instant messaging environment (paragraph [0002] of the published application).
 - 2.1 According to the present invention, a user can perform a web search inline in an instant messaging window. The user can enter a search query in the same fashion as typing in and sending an instant message, or type in a predefined search trigger to identify the text as a search query.

The search request is sent to an Internet search server, which processes the request and generates search results. The search results are sent to both the sender and the recipient for display inline in the instant messaging window.

3. Claim 1 considered in the contested decision relates to a method for searching the Internet in an instant messaging environment. The claimed method comprises the following features itemised by the Board:
 - (a) recognizing at least a portion of an instant message, from a first user to a second user and entered into an instant messaging application on a

first client computer of the first user, as a search query,

(i) wherein said recognizing comprises identifying a predetermined character string in the instant message as a search trigger;

(b) causing the search query to be displayed to the first user inline in an instant messaging window on the first client computer and to the second user inline in a second instant messaging window on a second client computer of the second user;

(c) causing a web search based on the search query in response to identifying the search trigger in the instant message,

(i) the web search retrieving search results,

(ii) by transmitting the search query to a search server,

(iii) wherein the search server performs the web search based on the search query; and

(d) automatically causing at least one of the search results to be displayed inline in the instant messaging window on the first client computer and inline in the second instant messaging window on the second client computer.

4. In the contested decision, the Examining Division found that document D2 disclosed all the technical features of the claimed invention required for manual browsing and only differed in the non-technical features and the degree of automation. In other words, document D2 disclosed an instant messaging system with all the technical features for parsing user input, recognising predetermined character strings as triggers and

manually causing said triggers to be processed and displayed accordingly.

4.1 The Examining Division held that the choice as to what kind of strings, triggers and processing or display had to be used was not dictated by technical problems, but rather by specific requirements of the user. Hence, the corresponding features were to be regarded as non-technical.

4.2 In particular, the Examining Division considered that the subject-matter of claim 1 differed from the method disclosed in document D2 in the following:

- (i) the web browsing being web searching;
the trigger being a search trigger;
the query being a search query;
the request being a search request;
the server being a search server;
the results being search results;
- (ii) the causing a web browsing being automatic;
the display of results being automatic;
- (iii) the display of results being inline in both instant message windows.

4.3 The Examining Division pointed out that the features listed under (i) above were clearly of non-technical nature and directed to implementing respective user requirements, i.e. how to perform web searching based on a search query in response to a search trigger on the system of document D2. These features did not involve technical considerations and did not go beyond straightforward adaptation of the method of document D2 to the user requirements. Hence, they did not involve a

technical problem whose implementation could have potentially required an inventive step.

- 4.4 The technical effect of features (ii) was that the browsing and displaying were performed automatically instead of manually as in document D2. The objective technical problem could thus be formulated as how to modify the method of document D2 in order to automatise the browsing. However, the straightforward automation of known manual steps without any further technical considerations and further technical effect was the object of every computer-implemented invention and could not be the basis of an invention.
- 4.5 Feature (iii) was clearly of non-technical nature and directed to the presentation of information. Thus, the subject-matter of claim 1 and, *mutatis mutandis*, of the other independent claims 8, 15 and 20 lacked an inventive step.
5. In the appellant's view, document D2 did not disclose browsing the Internet in an instant messaging (IM) environment, but allowed for hyperlinks to be sent as part of the message between two real-time chat clients. When the user clicked on the hyperlink, a browser (separate from a real-time chat client) was launched and opened the document associated with the URL of the hyperlink. Thus, at most, document D2 provided a method for enabling browsing of the Internet in the browser based on the hyperlink received at the real-time chat client via an instant message. This was not the same thing as searching the Internet in an instant messaging environment.
- 5.1 The appellant has in particular objected to the correspondence drawn by the Examining Division between

the search trigger of claim 1 and an HTML tag in document D2, with the search query of claim 1 being likened to a hyperlink of document D2. In doing so the Examining Division had ignored the term "search", stating that this was clearly a non-technical feature.

- 5.2 The appellant has also contested the Examining Division's opinion that there was no technical difference between the term "web browsing" and the term "web search". In fact, a web search involved a search engine (or search server) receiving a search query, performing a search based on the search query, and then returning a list of possible relevant search results. In contrast, web browsing simply involved moving between web pages based on embedded hyperlinks that linked those web pages.
- 5.3 In the appellant's view, document D2 did not disclose performing a web search and it was incorrect to ignore the technical meaning of the term "web search" and its distinction from the term web browsing. Furthermore, document D2 did not disclose "causing a web search based on the search query in response to identifying the search trigger in the instant message", because the initiation of the browsing in document D2 was performed when a user clicked on the hyperlink and not in response to identifying the HTML tag.
- 5.4 In contrast to document D2, the method of claim 1 automatically (that is without human involvement) caused a search result to be displayed at the client computer of both the sender and the receiver.
- 5.5 According to the appellant, the objective technical problem solved by the invention of the independent claims was how to modify document D2 so as to provide

an improved method for a user of a chat client to initiate a search and have the search results provided to both participants of the instant messaging session in a convenient manner.

- 5.6 Document D2 only disclosed using HTML as a means to embed hyperlinks in instant messaging. However, there was absolutely no suggestion of automatically performing an action in response to detecting a hyperlink. The only automated action in document D2 was that a hyperlink was displayed in a special format when an HTML tag was identified.
- 5.7 The fact that the search trigger was part of an instant message meant that the originator of the instant message did not need to go to a separate browser or other input window in order to instigate a search, and the recipient of the instant message could have the search started for him without having to do anything at all.
- 5.8 Whilst document D2 provided for a message to be displayed at both client machines, there did not appear to be any clear way to modify D2 so that search results would be displayed automatically at both client machines. Rather, document D2 would require the users of the respective machines to select the hyperlinks displayed at their own respective machines in order to display a page.

There was also no suggestion of using the same instant messaging environment to display search results.

6. The choice to have the search results displayed in the instant messaging window of the instant messaging clients (as opposed to using a separate browser

application and displaying search results in a window of the browser) made viewing and using the search results much easier, particularly on devices with small screens and/or limited processing capabilities. By having the search results already available within the instant messaging client, the user could view those results at the same time as participating in an instant messaging session and could easily make use of those results without having to undergo the time-consuming process of swapping between applications. This was particularly important for devices that could not run separate applications concurrently.

- 6.1 According to the appellant, this aspect of claim 1 did not relate to merely displaying particular data or merely displaying data at a particular location on the screen, but concerned the accessibility of search results in the same environment used for instant messaging to thereby integrate these two technologies (searching and instant messaging). Hence, this aspect of claim 1 did not relate to mere presentation of information.
- 6.2 In summary, the skilled person starting from document D2, when faced with the above mentioned technical problems, would not arrive at subject-matter falling in the scope of claim 1.
7. The Board essentially agrees with the appellant's assessment of document D2 and considers that the reasons given by the Examining Division do not justify the refusal of the application.
- 7.1 In particular, as summarised in its abstract, document D2 relates to a method for real-time network chat on the basis of TCP/IP connections established between a

plurality of clients and a host. A message, which is sent from one of the clients to at least one of the other clients through the host and includes one or more instructions in a markup language such as HTML, is parsed in the receiving chat client and displayed in accordance with the corresponding markup instructions. Where the markup instruction is a hyperlink, the chat client, receiving the message from the host, communicates the URL associated with the hyperlink to a Web browser under user control, and the Web browser requests and receives the desired Web document.

7.2 Although the Examining Division acknowledged these differences (see 4.2 above), it divided them into three different groups and came to the conclusion that the first group merely fulfilled user requirements which did not involve technical considerations. The second group related to automation and the third group was directed to the presentation of information.

7.3 In its approach, the Examining Division failed to acknowledge that the present invention and document D2 were concerned with completely different problems and that sending a hyperlink embedded in a chat message and associating it to a Web browser was very different from sending a search query in an instant message, fetching the search result and displaying it in an instant message window.

Furthermore, in its analysis, the Examining Division neglected the combined effect that the distinguishing features of the claimed method are supposed to achieve.

7.4 Hence, the Board comes to the conclusion that it would not have been obvious to a skilled person starting from

the teaching of document D2 to arrive at the subject-matter of claim 1 (Article 56 EPC).

7.5 On the other hand, the Board considers that a more appropriate assessment of the inventive step of the present invention can be made in the light of documents D3 and D4

8. Document D3 is concerned with a system and a method *"for providing appropriate hyperlink based on identified keywords from text messages sent between users"* (see title). According to column 1, lines 51 to 56 of D3, an object of the invention is *"to provide a means by which a user may have made available to him/her relevant information to accompany a communications session with another user without requiring conspicuous action on the part of either user and without unnecessary interruption of the communications session"*.

8.1 An essential feature of the invention according to document D3 is a "parsing apparatus" which comprises the following features recited in the paragraph bridging columns 1 and 2:

- an input to receive text messages sent from a first communications device of the system to another;
- a parser subsystem coupled to receive said text messages, and including processing means arranged to process the received text in accordance with a predetermined processing strategy to identify one or more keywords therein;
- a search subsystem coupled with the parser subsystem and arranged to receive the or each

selected keyword, to selectively transmit one or more such keywords via said network to a search engine coupled with the network, to receive results from the search engine, and to output them to a user of the system.

- 8.2 A network communications system according to D3 is illustrated in Figure 1 and comprises a number of user computer systems 10 to 20, a first remote server 22 for maintaining a chat space and a second remote server 24 which supports a network search service based on a search engine. As explained in column 3, lines 38 to 40, at least some of the user systems include a parser subsystem. *"In operation, with a pair of user systems 12, 20 in communication via the chat-space 32, the parser subsection 40 of the system 12 identifies keywords in the text messages exchanged (or just in those messages sent by the user of system 12) and sends selected ones of those keywords in a string (or as separate entities) as search terms to the search engine 34, [...]. On receipt of the search results (typically in the form of one or more uniform resource locators - URL's - followed by a short segment of human readable content) the user system 12 presents them to the user in such a way as not to intrude on the chat space communication, for example at the periphery of a display on which the text messages are being shown"* (column 3, lines 40 to 52 - underlining added).

According to claim 1 of D3 (last sentence), a search result may be communicated to one or more users. The same is explained in column 3, lines 53 to 55.

- 8.3 As explained in column 6, second full paragraph, different tests are applied to a text message to define a query. One of these tests consists in determining

whether a phrase in the text message may be a question. For example if it begins with "what", "when", "where", *"the value of the whole phrase is enhanced"* (column 6, lines 21 to 24).

- 8.4 Document D4 relates to a method and system for acting on requests and queries received from remotely located users using an instant messaging protocol.
- 8.5 According to document D4 (column 1 line 66 to column 2, line 2), it is an object of the invention (of D4) *"to provide a[n] instant messaging based system which interactively responds to and services requests from remotely located users"*.
- 8.6 As explained in column 2, lines 37 to 48, when the message server receives an IM message from a user, the message is processed to determine the type of request made by the user and the appropriate actions necessary to service the request. In one embodiment, the request is an informational query. In response to such a request, the message server directs the query to an appropriate query response server, which will interpret the request and return a suitable answer. The query response server can be local to the message processing server or remotely accessed via the Internet. The received answer is embedded in a message which is returned to the user, preferably over the instant messaging system.
- 8.7 Alternatively (see D4, column 2, lines 49 to 54), the message server can interpret the request directly using various natural language processing techniques known to those skilled in the art. In one configuration, a table of query patterns is provided and the table is searched to identify the pattern which most closely matches the

received request. Finally, as specified in column 4, line 66 to column 5, line 2, the answer generated by a query response server is returned to the message processor where it is incorporated into an output message which is subsequently sent to the user through the IM network. A query pattern is shown in column 9, lines 33 to 38.

9. In summary, the Board considers that the subject-matter of claim 1 involves an inventive step with respect to document D2 and that, for this reason, the decision of the Examining Division cannot be upheld. However, before a patent can be granted, the claimed subject-matter has to be examined in the light of documents D3 and D4 introduced by the Board into the proceedings.

9.1 Considering that new and more relevant prior art was introduced at a late stage in the appeal proceedings and in order not to deprive the applicant of the possibility of having the issue of inventive step considered by two instances, the Board finds it appropriate to make use of its powers under Article 111(1) EPC and to remit the case to the department of first instance for further prosecution.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the department of first instance for further prosecution.

The Registrar:

The Chairman:



I. Aperribay

R. Moufang

Decision electronically authenticated