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**Datasheet for the decision
of 19 June 2017**

Case Number: T 2568/11 - 3.5.06

Application Number: 05764461.9

Publication Number: 1779214

IPC: G06F1/00

Language of the proceedings: EN

Title of invention:

METHOD AND SYSTEM FOR AUTOMATED INTELLIGENT ELECTRONIC
ADVERTISING

Applicant:

Bookstaff, Blake

Headword:

Automated intelligent electronic advertising/BOOKSTAFF

Relevant legal provisions:

EPC 1973 Art. 56

Keyword:

Inventive step - (no)

Decisions cited:

Catchword:



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Case Number: T 2568/11 - 3.5.06

D E C I S I O N
of Technical Board of Appeal 3.5.06
of 19 June 2017

Appellant: Bookstaff, Blake
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Decision under appeal: **Decision of the Examining Division of the European Patent Office posted on 15 July 2011 refusing European patent application No. 05764461.9 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chairman W. Sekretaruk
Members: A. Teale
M. Müller

Summary of Facts and Submissions

I. This is an appeal against the decision, dispatched with reasons on 15 July 2011, to refuse European patent application No. 05 764 461.9 on the basis that, amongst other reasons, the subject-matter of claim 1, received on 19 May 2011, did not involve an inventive step, Article 56 EPC, in view of D1 and common general knowledge, as exemplified by D5. These documents are:

D1: US 2003/0191689 A1

D5: Rodolphe Michel, "DB2 UDB e-business Guide Redbooks - An IBM Redbooks publication", 26 July 2002, XP007918880, ISBN 0738424498, retrieved from the Internet from URL:<http://www.redbooks.ibm.com/redbooks/pdfs/sg246539.pdf> on 9 June 2011.

II. A notice of appeal was received on 15 September 2011 in which the appellant requested that the decision be set aside and that, as a main request, a patent be granted on the basis of the claims filed on 19 May 2011, a copy of these claims accompanying the notice. As an auxiliary request the appellant requested oral proceedings should the board contemplate not granting a patent. The appeal fee was paid on the same day.

III. With a statement of grounds of appeal, received on 22 November 2011, the appellant filed claims according to an auxiliary request and requested grant of a patent based on said claims.

IV. In an annex to a summons to oral proceedings the board set out its provisional view on the appeal, stating

inter alia that claim 1 of both requests seemed to lack inventive step over D1 and common general knowledge, as exemplified by D5.

V. In a letter received on 20 April 2017 the appellant stated that "... neither the applicant nor its representative will attend the oral hearings before the Examining Division scheduled for June 22, 2017." No amendments or arguments were submitted by the appellant.

VI. In a communication from its registry dated 15 May 2017 the board invited the appellant to withdraw its auxiliary request for oral proceedings, stating that, if the appellant did so, the board would cancel the oral proceedings and issue its decision immediately.

VII. In a letter received on 18 May 2017 the appellant withdrew its auxiliary request for oral proceedings. The board then cancelled the oral proceedings.

VIII. The application is thus being considered in the following form:

Description (both requests):

pages 1 to 20, as published in WO 2006/005001 A2.

Claims:

Main request: 1 to 16, received with the notice of appeal and the same as the claims in the decision.

Auxiliary request: 1 to 16, received with the grounds of appeal.

Drawings (both requests):

Pages 1/4 to 4/4, as published in WO 2006/005001 A2.

IX. Claim 1 according to the main request (including the numbering of the features filed with the grounds of appeal) reads as follows:

- "1. A method for automatically processing electronic information messages, comprising:
 2. receiving an electronic information message on a network device (20) via a communications network (18) from a source device (12, 14,16);
 3. parsing the electronic information message to identify one or more keywords in the electronic information message;
 4. submitting the identified one or more keywords from the network device (20) to one or more public (22,24) or private search engines
 - 4.1 as one or more static or dynamic search engine queries via the communications network,
 - 4.2 wherein the private search engines are cached directly in memory on the network device (20)
 - 4.2.1 that are used without accessing the communications network;
 - 4.3 wherein the submitting step includes
 - 4.3.1 mapping a single identified keyword into a plurality of related keywords, or
 - 4.3.2 mapping a plurality of identified keywords into a single keyword
 - 4.3.3 before submitting the one or more queries to the one or more public or private search engines;
 5. receiving query results from the one or more public or private search engines;
 6. selecting one or more electronic links from the one or more query results; and
 7. adding the one or more selected electronic links to the one or more identified keywords in the electronic message creating a modified electronic information message,

- 7.1. wherein the modifying step includes modifying a font color, a font size, a font bolding, a font underlining, or a font italicizing of a font for enhancing display the identified keyword in the electronic information message,
8. thereby allowing additional electronic information to be accessed from the modified electronic information message based on information content of the electronic information message."

- X. Claim 1 according to the auxiliary request differs from that according to the main request in that in feature 2 the expression "a source device" has been amended to "a at least one source device" and in that the following feature has been added after feature 3:

"3.1 wherein parsing of an electronic information message [sic] may be executed on the network device (20) or the at least one source device (12, 14, 16);".

Reasons for the Decision

1. Admissibility of the appeal

In view of the facts set out at points I to III above, the appeal fulfills the admissibility criteria under the EPC and is therefore admissible.

2. Summary of the invention

- 2.1 The invention relates to the automatic processing of e-mail or instant messages ("electronic information messages" in the claims) to insert advertising in the form of links to websites found by querying a search

engine or a database using keywords taken from the text of the message.

- 2.2 The description acknowledges prior art e-mail advertising, for instance as a condition of providing a free e-mail service; see paragraph [0008]. It also acknowledges "Gmail" which shows advertising related to the content of an e-mail in the web-interface used to display the e-mail; see paragraph [0009].
- 2.3 The invention seeks to provide a new way of using existing technologies, such as e-mail, for advertising; see paragraph [0008]. Figure 1 shows a system for carrying out the invention, comprising electronic "source"/"target" devices (12, 14, 16), for instance mobile phones and laptop devices, for sending and receiving electronic information messages. The devices are connected to a communications network (18), such as the Internet, which is also connected to a variety of servers (also termed "network devices"), including an e-mail server 20 connected to a database 20' and a search engine comprising a server 22 and a database 22'.
- 2.4 Figure 2 illustrates the steps of a method for carrying out the invention. Initially (step 28) a message is received on a network device, for instance e-mail server 20/20', from a source device. The message is then parsed to identify keywords (step 30). Queries based on the keywords are then submitted via the communications network to one or more search engines (step 32) and results are received (step 34). One or more links are then selected from the search results (step 36) and added to the message, yielding a "modified electronic information message" (step 38). An advantage of this approach is said to be that the links

are always up to date; see paragraph [0043]. The methods according to figures 3 and 4 are similar to that of figure 2, except that queries are submitted to a database rather than to one or more search engines, this option not being claimed.

- 2.5 Examples of keywords are "hotel", "ticket", "airport" and "arrive". Although some keywords can be directly submitted to a search engine, others may be mapped to several keywords, or several keywords can be mapped to one keyword before being submitted to a search engine; see paragraphs [0044] and [0077].
- 2.6 When adding links to a message the identified keywords can also be modified, including a change in font colour or font underlining; see paragraph [0055]. Links may include a "static" search engine query, meaning that the link includes the URL of a search engine and keywords; see paragraph [0083]. The description also refers to "dynamic" search engine queries; see paragraph [0050].
- 2.7 According to paragraph [0042], in the case of private search engines, these may be cached directly in memory on a network device that are used without accessing the communications network. What caching could mean in this context is discussed below.
3. The main request
 - 3.1 The claims of the main request are the same as those upon which the decision was based.

3.2 Clarity, Article 84 EPC 1973

Despite the doubts regarding the clarity of the claims expressed by the board in the annex to the summons, the board finds that the claims are sufficiently clear for the purposes of assessing inventive step.

3.3 Document D1

3.3.1 As set out in the appealed decision, D1 relates to a process, illustrated in figure 2, for adding advertising tag lines including links (see paragraph [0016]) to emails or instant messages (see paragraph [0014]) by parsing (see paragraph [0033]) the email for keywords (e.g. "travel" and "baby"; see paragraph [0054]) and sending the keywords as queries to an SQL data base (the Sponster Ad Database 5; see paragraph [0035]) which returns the advertising tag lines. The identified keywords in the email can be underlined or shown in a different colour; see paragraph [0054], lines 7 to 10. As shown in figure 2, the emails are received from the sender 1 at an "OpenMX Server", which communicates with the "Sponster Web Server" 4, which itself communicates with the "Sponster Ad Database" 5.

3.3.2 The OpenMX Server 2, "Fred's computer (see figure 2, item 1) and the "Sponster Ad Database" 5 in D1 can be seen as the network device (20), the source device and a public or private search engine, respectively, as set out in claim 1.

3.4 Inventive step, Article 56 EPC 1973

The subject-matter of claim 1, understood according to the "one or more public search engines" option in feature 4.1, differs from the disclosure of D1 in the

features that the submitting step includes mapping a single identified keyword into a plurality of related keywords, or mapping a plurality of identified keywords into a single keyword before submitting the one or more queries to the one or more public search engines.

- 3.4.1 According to the decision, these difference features merely set out commonly known query transformations, as, for instance, known from D5 (see linguistic indices on page 300 and thesaurus expansion on page 302), which the skilled person would add based on circumstances or based on non-technical advertising constraints without inventive step, Article 56 EPC 1973.

- 3.4.2 The appellant has argued that the objective technical problem solved by the difference features is to modify the method of D1 in such a way that the quality and quantity of inquiries is increased. There was also no pointer in D5 to the claimed method, so that the appealed decision was based on an *ex post facto* analysis. Given the lack of a definition in the application of "enquiry quality", the board does not accept that keyword mapping always increases "enquiry quality". Moreover the difference features do not necessarily increase the number of enquiries, indeed the option in feature 4.4.2 (mapping a plurality of identified keywords into a single keyword) reduces the number of enquiries. Hence the board is not persuaded that the problem formulated by the appellant is always solved by the invention, this being a prerequisite for considering it as the objective technical problem. Regarding the alleged lack of a pointer in D5 to the claimed subject-matter, the board notes that the appealed decision does not state (see reasons, page 5, 2nd paragraph) that D5 contains a pointer to the invention, but instead cites D5 as an example of

"commonly known query transformations" which the skilled person would have been aware of. The board accepts that the query transformations discussed in D5 (see page 300, 5th paragraph and 302, last paragraph) would have been common general knowledge for the skilled person in the technical field to which D1 belongs, namely search engines and databases.

3.4.3 Hence the board finds that the subject-matter of claim 1 does not involve an inventive step, Article 56 EPC 1973, in view of D1 and the common general knowledge of the skilled person, as exemplified by D5.

4. The auxiliary request

4.1 Clarity, Article 84 EPC 1973

Despite the doubts regarding the clarity of the claims expressed by the board in the annex to the summons, the board finds that the claims are sufficiently clear for the purposes of assessing inventive step.

4.2 Inventive step, Article 56 EPC 1973

4.2.1 The appellant has argued that there was no pointer in the prior art, in particular in D5, to modify the method known from D1 in the claimed manner.

4.2.2 The board takes the view that, in the present context, the amendment of the expression "a source device" to read "at least one source device" does not restrict claim 1. Turning to the added feature setting out parsing of the message either on the network device (20) or on the at least one source device, the board notes that in D1 parsing takes place on the OpenMX Server 2 (see paragraph [0033]), which corresponds to

the network device 20 in claim 1. Hence this alternative is not new over D1 and thus cannot lend inventive step to claim 1. Turning to the alternative in which the message is parsed on the source device, the board finds that this would have been a usual design choice for the skilled person and provides no surprising technical advantage.

4.2.3 Hence the features added to claim 1 in this request do not cause it to involve an inventive step, Article 56 EPC 1973.

Order

For these reasons it is decided that:

The appeal is dismissed

The Registrar:

The Chairman:



B. Atienza Vivancos

W. Sekretaruk

Decision electronically authenticated