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Datasheet for the decision of 30 November 2017

Case Number: T 2247/12 - 3.5.04

Application Number: 01939018.6

Publication Number: 1290890

IPC: H04N7/173

Language of the proceedings: EN

Title of invention:
System and method for providing Internet addresses corresponding to an electronic signal to a user

Applicant:
Comcast Cable Communications, LLC

Headword:

Relevant legal provisions:
EPC 1973 Art. 56

Keyword:
Inventive step - main and auxiliary request (no)

Decisions cited:

Catchword:

Europäisches Patentamt
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Beschwerdekammern

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Case Number: T 2247/12 - 3.5.04

D E C I S I O N
of Technical Board of Appeal 3.5.04
of 30 November 2017

Appellant: (Applicant)	Comcast Cable Communications, LLC 1701 JFK Boulevard Philadelphia, PA 19103 (US)
Representative:	EP&C P.O. Box 3241 2280 GE Rijswijk (NL)
Decision under appeal:	**Decision of the Examining Division of the European Patent Office posted on 16 March 2012 refusing European patent application No. 01939018.6 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chairman	C. Kunzelmann
Members:	B. Willems
	G. Decker

Summary of Facts and Submissions

I. The appeal is against the decision of the examining division dated 16 March 2012 refusing European patent application No. 01 939 018.6, filed as an international application and published as WO 01/97522 A2.

II. The documents cited in the decision under appeal included the following:

D1: WO 98/17064 A1 (Gemstar Development Corporation) 23 April 1998 (1998-04-23)

D3: JP 10 257401 A (Access KK) 25 September 1998 (1998-09-25)

D4: JP 2000 023058 A (NEC CORP) 21 January 2000 (2000-01-21)

D5: Anonymous: "*Configuring Internet Explorer 5*", an article dated 23 May 2000 (2000-05-23) and retrieved from the Internet on 13 April 2011 from URL:http://www.bucks.edu/~baruffia/mediaserv/ie5config.htm

III. The application was refused on the grounds that the subject-matter of claims 1 to 14 of the then sole request lacked inventive step (Article 56 EPC) with respect to the combination of the disclosures of documents D1, D3 and D5 or D1, D4 and D5.

IV. The applicant filed an appeal, requesting the board "*to set said decision aside and to grant a patent based on the claims on file or further claims to be filed in the appeal*". In the statement of grounds of appeal, it requested that the impugned decision be set aside and that a patent be granted on the basis of the claims

underlying the impugned decision. The appellant submitted arguments as to why the subject-matter of the claims then on file met the requirements of Article 56 EPC.

V. The board issued a summons to oral proceedings. In a communication under Article 15(1) RPBA (Rules of Procedure of the Boards of Appeal, OJ EPO 2007, 536), annexed to the summons, the board indicated that it tended to agree with the examining division's finding that the subject-matter of claim 1 of the then sole request lacked inventive step.

VI. With a reply letter dated 30 October 2017 to that communication, the appellant filed amended claims according to an auxiliary request. It submitted reasons as to why the subject-matter of claim 1 of both the main and auxiliary request should be considered to involve an inventive step (Article 56 EPC).

VII. With a letter dated 20 November 2017, the appellant withdrew its request for oral proceedings and requested that the proceedings be continued in writing.

VIII. On 30 November 2017, oral proceedings were held in the absence of the appellant.

The chairman noted that the appellant had requested that the decision under appeal be set aside and that a European patent be granted on the basis of the claims of the main request underlying the decision under appeal or of the auxiliary request filed with the letter dated 30 October 2017.

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

IX. Claim 1 of the main request reads as follows:

"A system (20) for providing Internet addresses (46) corresponding to a television program to a user, the system comprising:

a receiver (22) for receiving a plurality of electronic signals, each corresponding to a program, the plurality of electronic signals including one or more Internet addresses (46) embedded therein;

a decoder (28) in communication with the receiver (22), the decoder for extracting the Internet addresses (46) from the plurality of electronic signals without regard for whether the user chooses to access the content at the Internet addresses (46);

a processor (30) in communication with the decoder (28), the processor for compiling a historical list (48) of the Internet addresses (46) extracted from the plurality of electronic signals, wherein the processor includes memory (34) for storing the historical list; and

a web browser (36) connected to the processor (30), the web browser for presenting the historical list (48) of the Internet addresses (46) to the user,

characterized in that the historical list includes Internet addresses (46) extracted over an amount of time selectable by the user, and in that the historical list includes program source information associated with each Internet address, the program source information indicating at least the program name of the program during which each Internet address was extracted."

X. Claim 1 of the auxiliary request differs from claim 1 of the main request in that the characterising part reads (the differences are highlighted in *italics*):

"characterized in that the historical list includes *a number of Internet addresses (46) wherein the number is selectable by the user*, and in that the historical list includes program source information associated with each Internet address, the program source information indicating at least the program name of the program during which each Internet address was extracted."

XI. The examining division's arguments, as far as they are relevant to the present decision, may be summarised as follows:

D1 was identified as the closest prior art for the assessment of inventive step (Article 56 EPC).

The subject-matter of claim 1 of the then sole request differed from the disclosure of D1 by the following non-interrelated features (see decision under appeal, Reasons 2.3 and 2.4):

(a) the historical list included Internet addresses extracted over an amount of time selectable by the user; and

(b) the historical list included programme source information associated with each Internet address, the programme source information indicating the programme from which each Internet address had been extracted.

In the remainder of this decision, these features will be referred to as feature A and feature B, respectively.

Feature A solved the technical problem of "*how to implement an alternative housekeeping system which provides access to recently extracted URLs*" (see decision under appeal, Reasons 2.5). Feature B solved a different technical problem, namely "*how to improve user navigation and selection in the historical list or* [sic] *URLs*" (see decision under appeal, Reasons 2.7).

The person skilled in the art would have limited the stored URLs as suggested by document D5, in order to decrease the time and effort needed for a user to find an Internet address of interest. Moreover, the person skilled in the art would have improved the navigation in the list by storing and displaying the extracted URLs together with context information such as the programme title, as suggested by document D3 (see decision under appeal, Reasons 2.6 and 2.8).

XII. The appellant's arguments, as far as they are relevant to the present decision, may be summarised as follows:

Starting from D1, the objective technical problem was "*how to improve user navigation and selection in the historical list of URLs*". The combination of the features of the characterising portion of claim 1 of the main request and the combination of the features of the characterising portion of claim 1 of the auxiliary request improved user navigation. Hence the "*approach of using two separate partial problems should not be applied*" (see letter dated 30 October 2017, page 1).

Document D3 did not disclose including in a historical list the name of the programme during which the URL had been extracted. The title in the table shown in Figure 13 had not been extracted from a video signal but was a "*descriptive title of the Internet site address*" entered manually by the user (see statement of grounds of appeal, paragraph bridging pages 2 and 3). D3 disclosed using character recognition to extract the URL but not the title (see statement of grounds of appeal, paragraph bridging pages 3 and 4).

The list known from document D5 included Internet addresses which a user had accessed. In contrast, the list according to claim 1 included Internet addresses which a user could access (see letter dated 30 October 2017, page 2, paragraph starting with "Contrarily").

Reasons for the Decision

1. The appeal is admissible.

2. The duly summoned appellant did not attend the oral proceedings. In accordance with Rule 71(2) EPC 1973, however, the proceedings continued without it. In accordance with Article 15(3) RPBA, the board relied for its decision only on the appellant's written submissions. The board was in a position to decide at the conclusion of the oral proceedings since the case was ready for decision (Article 15(5) and (6) RPBA), and the voluntary absence of the appellant was not a reason for delaying the decision (Article 15(3) RPBA). The principle of the right to be heard pursuant to Article 113(1) EPC was observed since, by absenting itself from the oral proceedings, a party gives up this opportunity to be heard (see the explanatory notes to

Article 15(3) RPBA cited in T 1704/06, not published in OJ EPO).

3. *Main request - inventive step (Article 56 EPC 1973)*

3.1 It is not disputed that document D1 is the closest prior art for the assessment of inventive step.

D1 discloses (see decision under appeal, Reasons 2.2):

a system for providing Internet addresses corresponding to an electronic signal to a user (page 2, lines 2 to 5, "*an interactive entertainment network system*"; page 2, lines 5 to 7, whereby "*at least on [sic] of the television signals has embedded data including a particular address site*"), the system comprising:

a receiver for receiving a plurality of electronic signals, the plurality of electronic signals including one or more Internet addresses embedded therein (page 2, lines 15 to 19, "*The display controller includes a tuner for receiving a television signal containing a television program and at least one embedded data unit including a data address site*");

a decoder in communication with the receiver, the decoder for extracting the one or more Internet addresses from the plurality of electronic signals (page 2, lines 15 to 19, "*means for extracting the at least one embedded data unit from the television signal*") without regard for whether the user chooses to access the content at the Internet addresses (page 9, lines 19 to 27);

a processor in communication with the decoder, the processor for compiling a historical list of the one or

more Internet addresses extracted from the plurality of electronic signals (page 10, lines 13 and 14, "*Any number of Internet site addresses can be stored in the directory*"; page 10, lines 21 and 22, "*the directory is managed as a web browser bookmark memory*"), wherein the processor includes memory for storing the historical list (page 2, line 38 to page 3, line 2, *"several data address sites are stored in the memory simultaneously*"); and

a web browser connected to the processor, the web browser for presenting the historical list of the one or more Internet addresses to the user (page 10, lines 30 to 36, "*display the Internet site titles [...] stored in the directory*"; "*the Internet site is connected [...] and information from the Internet site is displayed on the screen instead of the television program*").

3.2 Further, it is undisputed that the subject-matter of claim 1 of the main request differs from the disclosure of document D1 by the features of the characterising portion of the claim (see decision under appeal, point 2.3, and the appellant's letter dated 30 October 2017, page 1, "*This problem is addressed by the combination of characterizing feature A and characterizing feature B of claim 1*").

3.3 The board agrees with the appellant's definition of the objective technical problem as "*how to improve user navigation and selection in the historical list of URLs*" (see letter dated 30 October 2017, page 1).

The board also shares the appellant's view that feature A and feature B "*together address the above*

problem" (see letter dated 30 October 2017, page 1, last paragraph).

However, unlike the appellant, the board is of the opinion that "*the approach of using two separate partial problems*" can be applied (see letter dated 30 October 2017, page 1, last sentence), because feature A and feature B are functionally not interdependent, i.e. they do not mutually influence each other to achieve a technical success over and above the sum of their respective individual effects (see Case Law of the Boards of Appeal, 8th edition 2016, I.D.9.2.2).

The board notes that the objective technical problem "addressed" by the combination of feature A and feature B is the same as the "*second technical problem (Feature B)*" identified by the examining division in the decision under appeal, Reasons, point 2.7 and the technical problem identified by the appellant "*[t]aking into account this Feature B*" (see statement of grounds of appeal, page 2, fifth paragraph). Thus, the combination of features A and B does not solve a different technical problem than feature B taken separately. Therefore, features A and B contribute to the solution of the same technical problem, i.e. they each improve user navigation and selection in the historical list of URLs.

Feature A improves user navigation and selection by limiting the extent of the list "*to decrease the time and effort it takes for a user to find an Internet address of interest*" (see decision under appeal, Reasons, point 2.6). Feature B improves user navigation and selection by providing "*context information considered useful during navigation*" (see decision

under appeal, Reasons, point 2.8). Each of these features contributes to the solution of the objective technical problem in a manner expected by the person skilled in the art. No synergistic effect is achieved by combining features A and B.

3.4 Thus, the issue is whether the features of the preamble of claim 1 combined with either feature A or feature B are obvious in the light of the prior art.

3.5 *Assessment based on feature A*

3.5.1 The board concurs with the examining division's assessment that the person skilled in the art would have specified for how many days links were to be kept in the historical list (history), as suggested by D5 (see decision under appeal, Reasons, point 2.6).

3.5.2 The board was not convinced by the argument that the person skilled in the art would not have consulted document D5 because "*the list of internet addresses as stored in D5 serves a different purpose*", namely that of forming a list of Internet addresses accessed in the past (see letter dated 30 October 2017, page 2, fourth and fifth paragraphs). The history folder shown in document D5 contains "*links to pages you've visited, for quick access to recently viewed pages*". Thus, the folder contains a list of Internet addresses acquired over a period of time set by the user and which facilitates quick access to Internet pages. Hence, contrary to the appellant's view, the list known from D5 contains URLs "*which a user can access*" (see letter dated 30 October 2017, page 2, fourth paragraph). Moreover, quick access to Internet pages or, in other words, the "*time and effort it takes for a user to find an Internet address of interest*" (see decision under

appeal, Reasons, point 2.6) does not depend on whether the list has been created from addresses acquired by previously accessing the pages or by extracting links from an electronic signal, but it does depend on the length of the list which has to be searched by the user. Limiting the list to recently acquired (viewed) pages by setting the number of days avoids creating a list with an excessive number of entries, some possibly representing stale URLs.

3.6 *Assessment based on feature B*

3.6.1 The board concurs with the examining division's assessment that the person skilled in the art would have included "*context information considered to be useful during navigation*" (see decision under appeal, Reasons, point 2.8).

3.6.2 In the statement of grounds of appeal, page 3, the appellant argued that D3 did not disclose extracting programme source information indicating the programme name. The appellant reasoned that although D3, Figure 13, showed a title, this was the descriptive title of the Internet site address entered manually. This title had not been extracted from the video signal.

The appellant argued that also D1 disclosed storing descriptive titles, not programme names (see statement of grounds of appeal, page 4). However, it did not dispute that D3 (and D4) disclosed storing programme descriptive data together with the extracted URL (see statement of grounds of appeal, the paragraph bridging pages 2 and 3, and page 3, paragraph 3).

3.6.3 In the communication under Article 15(1) RPBA, point 2.6, the board observed that any argument relying on extracting programme names was not reflected in a corresponding feature of claim 1 and had no basis in the application, because extracting data had only been disclosed with respect to Internet addresses.

Further, the board argued that the information content of the programme name as such is non-technical and can only contribute to inventive step if it brings about an overall technical effect (see Case Law of the Boards of Appeal, 8th edition 2016, I.D.9.1.3(c), Non-technical features and technical contribution). Displaying the historical list as specified in claim 1 imposes on the system the technical requirement of storing descriptive data in association with an extracted Internet address, irrespective of the information content of the descriptive data.

Storing descriptive data in association with an extracted Internet address is known from both D1 and D3 (D1, page 9, lines 17 to 27: "*a descriptive title for the Internet site address that will enable the viewer to distinguish the Internet site from other Internet sites is also included in the data unit [...] each successively received data unit is placed on the top of a stack in a RAM*"; and D3, paragraph [0059]: "*After entering the title is complete (S702), a new record consisting of a CH data and the date and time data and title data and URL information, to add stored in the URL information table 39 (S703). Thereafter, it is possible to use reading this URL information when needed*").

3.6.4 The appellant did not comment on the board's objections set out in point 2.6 of the communication under Article 15(1) RPBA (and reiterated above).

3.7 Thus, the board concludes that for the reasons set out in points 3.1 to 3.6 above, the subject-matter of claim 1 of the main request lacks inventive step over the combination of the disclosures of documents D1, D3 and D5 (Article 56 EPC 1973).

4. *Auxiliary request - inventive step (Article 56 EPC 1973)*

4.1 Claim 1 of the auxiliary request differs from claim 1 of the main request in that the former specifies that the list includes a number of Internet addresses wherein the number is selectable by the user whereas the latter specifies that the list includes Internet addresses extracted over an amount of time selectable by the user.

4.2 Neither the claims nor the description provide any details about which Internet addresses are listed after the user has selected the number, i.e. the length of the list. The person skilled in the art could imagine various criteria for selecting addresses to be included in the list, such as the most recently or most frequently extracted addresses, or addresses meeting a certain user profile, etc.

4.3 According to the description, extracted addresses are immediately displayed and the historical list is updated to add an Internet address each time a new address is received (see page 10, lines 8 to 11 and page 11, lines 19 to 21). Therefore, according to one example encompassed by the claim, the user can select

the number of most recently received addresses for inclusion on the list.

4.4 As set out in point 3.5.2 above, the time and effort needed for a user to find an Internet address in the list depends on the length of the list he has to search (see also decision under appeal, Reasons, point 2.6). Limiting the list to recently acquired (viewed) pages avoids creating a list with an excessive number of entries, some possibly representing stale URLs.

4.5 Such a limitation of the list of addresses was considered in the impugned decision. Claim 6 of the request forming the basis for the impugned decision reads "*wherein the historical list is configurable to include Internet addresses extracted over an amount of time and of a number selectable by the user*". In the decision under appeal, Reasons, point 2.11, the examining division stated that the quoted feature "*is obvious in view of D1 (page 10, lines 21 to 29)*". The board agrees with this assessment. The passage referred to discloses that "*the directory is managed as a web browser bookmark memory. The website addresses and titles are stored in the directory until they are deleted or replaced by new addresses and titles on a first-in-first-out basis when the directory is full. [Alternatively...] Preferably, the microprocessor is programmed to permit the individual user to select which mode of memory management to utilize*". The most natural way of limiting the list would indeed be by setting (selecting) a number and limiting the entries accordingly.

4.6 In the statement of grounds of appeal (see page 4), the appellant said it had "*restricted [its] arguments to a discussion of inventive step in relation to Feature B*

of the independent claims. It is noted that this discussion can not be taken as an approval of the assertions of the Examining Division regarding D1 and the corresponding receiver, decoder, processor and browser features". Thus, although the appellant made several references to the disclosure of D1, it opted not to comment on the objection the examining division had raised against claim 6.

In the letter dated 30 October 2017 (page 3, fifth paragraph), the appellant asserted that the "*person skilled in the art, when starting from D1, and faced with the problem to improve user navigation and selection in the historical list of URLs, will not find a hint to the claimed solution in D1*". This assertion was left unsubstantiated. In particular, the appellant did not comment on the objection the examining division had raised against claim 6.

Summarising, the appellant had two opportunities to provide counter-arguments to the objections the examining division had raised against claim 6. Each time, it merely gave a general statement which the board does not find convincing.

4.7 Thus, the board concludes that, for the reasons set out above, the subject-matter of claim 1 of the auxiliary request lacks inventive step over the combination of the disclosures of documents D1, D3 and D5 (Article 56 EPC 1973).

5. In view of the above, neither of the appellant's requests is allowable. Hence, the appeal is to be dismissed.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar: The Chairman:

K. Boelicke C. Kunzelmann

Decision electronically authenticated