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**Datasheet for the decision
of 22 November 2018**

Case Number: T 2276/13 - 3.5.07

Application Number: 04253389.3

Publication Number: 1489529

IPC: G06F17/30, G06F17/60

Language of the proceedings: EN

Title of invention:

Method and apparatus for prioritising a listing of information providers

Applicant:

YellowPages.com LLC

Headword:

Prioritising a listing of information providers/
YELLOWPAGES.COM

Relevant legal provisions:

EPC Art. 56

Keyword:

Inventive step - all requests (no)

Decisions cited:

T 0115/85, T 0154/04, T 1143/06, T 1235/07, T 1741/08



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Case Number: T 2276/13 - 3.5.07

D E C I S I O N
of Technical Board of Appeal 3.5.07
of 22 November 2018

Appellant: YellowPages.com LLC
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Decision under appeal: **Decision of the Examining Division of the
European Patent Office posted on 17 June 2013
refusing European patent application
No. 04253389.3 pursuant to Article 97(2) EPC**

Composition of the Board:

Chairman R. Moufang
Members: M. Jaedicke
P. San-Bento Furtado

Summary of Facts and Submissions

I. The applicant (appellant), which at the time was Ingenio LLC, appealed against the decision of the Examining Division refusing European patent application No. 04253389.3. The application claims a priority date of 18 June 2003.

II. The Examining Division's decision was given on EPO form 2061 and referred for its reasons to a communication dated 30 January 2013. In that communication, the Examining Division had objected that the subject-matter of claims 1 to 20 of the then pending sole request lacked inventive step over the prior art disclosed in each of the following documents (in order of appearance in the communication of the Examining Division):

D7: WO 01/01217 A2, published on 4 January 2001;

D2: US 2002/0010608 A1, published on 24 January 2002;

D1: US 6,223,165 B1, published on 24 April 2001;

D3: WO 01/28141 A1, published on 19 April 2001.

Moreover, the Examining Division had considered some of the claimed features to be related to business policies.

III. In the course of the appeal proceedings, the appellant merged with and into YellowPages.com LLC.

IV. In the statement of grounds of appeal, the appellant requested that the decision be set aside and that a patent be granted on the basis of the sole request submitted with the grounds of appeal.

- V. In a communication under Article 15(1) RPBA accompanying the summons to oral proceedings, the Board *inter alia* expressed its provisional opinion that the subject-matter of claim 1 of the sole request submitted with the grounds of appeal lacked inventive step in view of document D7. Some of the features seemed to merely reflect business policies.
- VI. In a letter dated 22 October 2018, the appellant maintained its sole request as main request. Moreover, it submitted an auxiliary request and arguments in favour of both requests.
- VII. By letter of 9 November 2018, the appellant withdrew its request for oral proceedings and stated that it would not attend oral proceedings if they took place. It made no further substantive comments on the Board's communication.
- VIII. The appellant requested that the decision under appeal be set aside and that a patent be granted on the basis of the claims of the main request, or in the alternative on the basis of the claims of the auxiliary request.
- IX. Oral proceedings were held as scheduled in the absence of the appellant. At the end of the oral proceedings, the chairman pronounced the Board's decision.
- X. Claim 1 of the main request reads as follows:
"A computer implemented method of providing users (101) with access to information providers, carried out on an information provider search engine (107), comprising:
i) maintaining a database of information providers (111, 200), in response to receiving from a user (101) a request for a type of information

provider, identifying in said database (111, 200) a set of one or more information providers that satisfy the request;

- ii) prioritising the set of information providers and displaying the prioritised set of information providers to the user (101), said prioritising being carried out in accordance with an availability status associated with each information provider in the set;
- iii) after the user (101) selecting one of the information providers from the displayed prioritised set (109, 901), providing the user (101) with access to the selected one of the information providers;
- iv) the step of prioritising the set of information providers is also carried out in accordance with a value received from each information provider within the set, the value representing an amount of fees that the information provider will be charged by the operator of the information search engine in return for a user (101) making a chargeable selection by selecting the information provider from the displayed prioritised set (109, 901);
and,
- v) in that an information provider is not charged the fee value if the information provider is selected from the displayed prioritised set (109, 901) by a user (101) who has used the information provider search engine:
 - a) to make a chargeable selection of that information provider more than a predetermined number of times within a predetermined period of time,
 - or

b) to make more than a predetermined number of chargeable selections of information providers within a predetermined period of time,

or

c) had communication with the information provider within a predetermined period of time prior to selecting the information provider;

characterized by:

vi) limiting the number of requests that a user (101) can impart in a single day, or over a predetermined period of time."

XI. Claim 1 of the auxiliary request differs from claim 1 of the main request in that the text ", to a single information provider." was added at the end of the claim.

XII. The appellant's arguments, where relevant to the decision, are discussed in detail below.

Reasons for the Decision

1. The appeal complies with the provisions referred to in Rule 101 EPC and is therefore admissible.

The invention

2. The application (see abstract, claims, description, paragraphs [0016] to [0025], Figures 3 to 5) relates to providing access to information providers such as therapists, computer technicians, tax advisors, etc. online by finding the information provider's online service advertisements via a search engine on the internet.

The search engine prioritises the set of information providers satisfying a user request according to various criteria, including the amount of fees that the information provider will be charged by the search engine operator in return for a user making a chargeable selection from the displayed prioritised search results, and the availability status, which indicates availability of an information provider such as available, busy, arrange for later call, not taking calls.

In order to avoid charging the information provider in certain situations it may be defined when a fee is not charged. Moreover, the number of requests that a user can impart in a single day or over a predetermined period of time can be limited.

Main request

3. *Inventive step - Article 56 EPC*

3.1 The characterising part of claim 1 refers to limiting the number of requests. The Board observes that the term "request" is first used in feature i) of claim 1. Feature i) refers to receiving from a user a request for a type of information provider. In other words, the request referred to in feature i) is the user's search query that is received by the search engine. In view of this wording, a possible interpretation of the characterising part of claim 1 could be that the number of search queries receivable from a user is limited. However, such an interpretation would be neither supported by the description, paragraph [0025], on which the amendment was based, nor the appellant's submissions (see statement of grounds of appeal, page 3, "[...] the solution defined by amended claim 1 is a

limit to the number of paid clicks that one end user can impart in a single day, or over a predetermined period of time."). If this interpretation were adopted, claim 1 would fail to meet the requirements of Article 123(2) EPC.

With regard to characterising feature vi), the description (see paragraph [0025]), and the appellant refer to a "paid click", for which a click fee is charged to the information provider. The description also refers in paragraphs [0033] and [0034] to a "request for an information provider" that is received from a user, after which a fee may be charged. Hence, for its assessment of inventive step, the Board interprets the term "request" in the characterising part of claim 1 in the sense of a "paid click", which corresponds to the selection made by the user to which features iii) and v) of claim 1 refer.

3.2 Document D7 discloses a search engine which allows consumers to enter topics or search terms corresponding to a consumer topic of interest, and in which a search is performed for web-sites or advertiser sites that correspond to the consumer topic. Advertisers are permitted to bid for the consumers' attention by establishing reward amounts, and any advertiser sites that result from the search are sorted based upon their bid amounts. The higher-reward advertiser sites, or links to those sites, are displayed more prominently than the lower-reward advertiser sites (see D7, abstract).

3.3 According to the communication referred to in the contested decision for its reasons, D7 discloses all features of the then pending claim 1 (see D7, abstract; pages 3 to 6; page 10, line 6, to page 13, line 6;

page 20, line 6, to page 24, line 7; page 25, line 8, to page 26, line 20; Figures 6A and 6B) except for the features of prioritising information providers in accordance with an availability status associated with each information provider. In the statement of grounds of appeal, the appellant did not contest this finding.

- 3.4 The Board considers that claim 1 of the main request differs from the disclosure of document D7 in that:
- (a) information providers are prioritised additionally in accordance with an availability status associated with each information provider (see feature ii) of claim 1);
 - (b) the number of requests that a user can impart in a single day, or over a predetermined period of time, are limited (see the characterising part of claim 1).

In its reply to the Board's summons, the appellant did not contest this finding.

- 3.5 With respect to difference (a), the appellant submitted that known bidding systems for search engines failed when it came to displaying information providers rather than advertisements for objects or web pages, because human information providers were not always available (description, paragraph [0006]). By prioritising the results based on whether or not a given information provider was available, the invention ensured that a successful connection could be established, because in the application, availability referred to the possibility of the successful establishment of some kind of electronic connection, such as a telephone connection or a live video communication, between the user and the information provider (paragraph [0035]). Thus, difference (a) was not a mere presentation of

information, but rather improved the efficiency with which a user could establish a connection with an information provider. Hence, as this difference had a credible technical effect, it could be considered, according to decision T 1741/08, to contribute a technical solution to a technical problem.

With respect to difference (b), the appellant argued that this difference itself was of a technical nature, as the claimed limitation of requests implicitly involved features such as tracking the user's identity, counting how many requests the user had made in the predetermined period of time, and applying some kind of threshold to the count obtained. Although these features were not explicitly stated in the claim, the skilled person was well aware that several technical considerations were required. The claimed method put technical features in place to prevent abuse of the system, thus maintaining the integrity of the system.

Differences (a) and (b) were able to work together to enable the efficient connection of users and information providers while preventing misuse of the system.

Hence, the objective technical problem could be formulated as how to provide a system enabling efficient connection of users to information providers and preventing abuse of that system.

This was solved by prioritising results based on availability and limiting the number of requests a given user could make. As none of the differences were present in document D7, the skilled person could not be motivated to arrive at the claimed solution based on D7 alone. Moreover, as none of the further cited prior art

documents D1 to D3 taught that the number of requests could be limited, the subject-matter of claim 1 of the main request involved an inventive step.

3.6 The Board judges that differences (a) and (b) do not contribute to the technical character of the invention.

3.6.1 Difference (a) is part of feature ii), which concerns the presentation of the list of information providers retrieved by the search engine to a user. The information providers are listed in a prioritised order according to their availability status (see e.g. Figure 9 of the application, which displays a web page with search results and provides the user with an option to sort the search results by "Top Available").

The appellant's argument that the prioritisation was not a mere presentation of information (Article 52(2) (d) EPC) is not convincing, as the prioritisation according to difference (a) in the context of claim 1, is not used for any purpose other than that of presenting the prioritised set of information providers to the user. That the prioritisation is done in accordance with an availability status does not lead to a different assessment. The availability status itself is not further defined in the claim and might just reflect the information provider's willingness to be contacted, i.e. a non-technical subjective preference or a non-technical business policy. Hence, the features according to difference (a) contribute only to the manner in which information is presented (see decisions T 1143/06 of 1 April 2009, reasons 3 and 5, and T 1235/07 of 17 March 2011, reasons 11) and the Board does not see that these features contribute to any technical effect.

In particular, it is not derivable from the features of claim 1 that the method improves the efficiency with which a user can establish a connection with an information provider as alleged by the appellant. For example, the user may still be able to select information providers from the displayed set which are not available, even if they may not be listed in the first positions. In this respect it is noted that the claim does not specify the manner in which the availability status influences the prioritisation. Hence, the appellant's arguments based on decision T 1741/08 of 2 August 2012 do not persuade the Board.

The Board is also aware that, according to decision T 115/85 (OJ EPO 1990, 30), automatically giving visual indications of conditions prevailing in an apparatus or system is basically a technical problem. However, claim 1 is not directed to automatically displaying a state of a technical system, but rather displays information about an information provider's availability for doing business.

In view of the above, the Board considers that difference (a) does not contribute to the technical character of the invention.

3.6.2 Difference (b) represents essentially a business policy for the number of requests that a user can impart over a predetermined period of time in order to ensure a charging of fees that fits business requirements. According to the description, paragraph [0025], the features according to difference (b) mean that "there is a control that prevents a single end user from clicking repeatedly on hundreds of consultants, thus sabotaging the system and deflating the ROI of consultants". The aim to prevent the deflation of the

return on investment (ROI) is a business aim and the wish to prevent a single end user from clicking repeatedly on hundreds of consultants is hence a business requirement.

The appellant argued that difference (b) implied technical considerations as it implicitly required features such as tracking the identification of users. However, the Board does not share the appellant's view that such features mentioned by the appellant are implicit in the method of claim 1 and finds that this argument is also not supported by the description, which does not disclose any of the allegedly implicit features in paragraph [0025]. Nor are any further technical considerations apparent. Hence, the Board is not persuaded by this argument.

As claim 1 does not define in any detail an implementation of the business requirement expressed in difference (b), this difference is considered as a feature that does not contribute to the technical character of the invention.

- 3.7 As none of the differences over document D7 contributes to the technical character of the invention, the features identified as differences do not enter into the assessment of inventive step (see decision T 154/04, OJ EPO 2008, 46). Hence, claim 1 does not meet the requirements of Article 56 EPC.

Auxiliary request

4. *Inventive step - Article 56 EPC*

Claim 1 of the auxiliary request differs from claim 1 of the main request only in that it adds that the

number of requests to a single information provider is limited. However, this amendment does not change the Board's assessment of inventive step, as such a limitation reflects merely a specific business requirement with respect to a single information provider.

Conclusion

5. As none of the appellant's requests can form the basis for the grant of a patent, the appeal is to be dismissed.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:



I. Aperribay

R. Moufang

Decision electronically authenticated