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**Datasheet for the decision  
of 10 November 2021**

**Case Number:** T 1639/18 - 3.5.07

**Application Number:** 11180094.2

**Publication Number:** 2428902

**IPC:** G06F17/30

**Language of the proceedings:** EN

**Title of invention:**

Online content ranking system based on authenticity metric values for web elements

**Applicant:**

Disney Enterprises, Inc.

**Headword:**

Content ranking based on authenticity metric/DISNEY  
ENTERPRISES

**Relevant legal provisions:**

EPC Art. 56, 123(2)  
RPBA 2020 Art. 13(1), 13(2)

**Keyword:**

Amendment after summons - exceptional circumstances - main request and first to third auxiliary requests (no)  
Amendment to appeal case - amendment detrimental to procedural economy (yes) - main request and first and second auxiliary requests  
Inventive step - fourth auxiliary request (no)  
Amendments - added subject-matter - fifth to eighth auxiliary requests (yes)

**Decisions cited:**

G 0003/08, G 0001/19, R 0014/10, T 0005/81, T 0228/89,  
T 1173/97, T 0861/04, T 0154/04, T 1216/08, T 0309/10,  
T 0654/10, T 0489/14, T 1028/14, T 0752/16, T 1924/17



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Case Number: T 1639/18 - 3.5.07

**D E C I S I O N**  
**of Technical Board of Appeal 3.5.07**  
**of 10 November 2021**

**Appellant:** Disney Enterprises, Inc.  
(Applicant) 500 Buena Vista Street  
Burbank, CA 91521 (US)

**Representative:** Carpmaels & Ransford LLP  
One Southampton Row  
London WC1B 5HA (GB)

**Decision under appeal:** **Decision of the Examining Division of the  
European Patent Office posted on 5 February 2018  
refusing European patent application No.  
11180094.2 pursuant to Article 97(2) EPC**

**Composition of the Board:**

**Chair** J. Geschwind  
**Members:** M. Jaedicke  
P. San-Bento Furtado

## **Summary of Facts and Submissions**

- I. The appellant (applicant) filed an appeal against the examining division's decision refusing European patent application No. 11180094.2 (published as EP 2 428 902 A1).
- II. The documents cited in the contested decision were:  
D1: US 2006/0167864 A1, published on 27 July 2006  
D2: US 6,480,837 B1, published on 12 November 2002  
D3: US 2005/0060312 A1, published on 17 March 2005
- III. The examining division refused the application for lack of inventive step regarding the subject-matter of independent claim 1 of the main request and each of the first to third auxiliary requests over the prior art disclosed in document D1. The examining division considered that some aspects of the claimed subject-matter were non-technical.
- IV. In its statement of grounds of appeal, the appellant maintained the requests considered in the contested decision and filed a new fourth auxiliary request.
- V. In a communication under Article 15(1) RPBA 2020, the board expressed, among other things, its provisional opinion that the subject-matter of claim 1 of the main request and each of the first to fourth auxiliary requests lacked an inventive step in view of document D1 and that claim 1 of each of the first to fourth auxiliary requests did not meet the requirements of Article 123(2) EPC.
- VI. By letter of 8 October 2021, the appellant submitted a new main request and new first and second auxiliary

requests and renumbered its prior requests as the third to seventh auxiliary requests.

VII. In the course of the oral proceedings, held as scheduled on 10 November 2021, the appellant was heard on the relevant issues. It submitted a new third auxiliary request, renumbered its prior third to seventh auxiliary requests as the new fourth to eighth auxiliary requests, and submitted procedural requests that the case be remitted to the department of first instance for further prosecution on the basis of the new third auxiliary request and that the appeal fee be reimbursed.

Furthermore, it "reserved the appellant's right to file a petition for review" and made a written submission to be annexed to the minutes of the oral proceedings stating the following:

"During the appeal proceedings on 10.11.2021, I filed a new auxiliary request 3 which removed former claims 1 to 11 of auxiliary request 3 - formerly the main request filed with the appeal on 4.6.2018.

On the basis that this auxiliary request 3 is not admitted into the proceedings, this would be a substantial procedural violation on the basis that a fundamental violation of the applicant's right to be heard had taken place (Art. 113(1) EPC) since claim 12 was not mentioned in the decision dated 5.2.2018, nor in the preliminary opinion dated 10.11.2020."

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

VIII. The appellant's final requests were that:

- the decision under appeal be set aside and that a patent be granted on the basis of one of the main request and the first and second auxiliary requests, all three requests submitted with the letter of 8 October 2021, or on the basis of the new third auxiliary request submitted during the oral proceedings before the board
- the case be remitted to the department of first instance for further prosecution on the basis of the new third auxiliary request and that the appeal fee be reimbursed or
- the decision under appeal be set aside and that a patent be granted on the basis of one of the fourth to eighth auxiliary requests filed with the statement of grounds of appeal as the main request and the first to fourth auxiliary requests

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

" A computer-implemented method for identifying and providing search results to a user, comprising:

retrieving, by a computer system (100), a set of data from one or more computer servers (102), wherein the set of data includes data for a plurality of web elements;

for each of the web elements in the set of data, determining an authenticity metric value, wherein the authenticity metric value is assigned based on a number of links required to reach a web element from a seed web page (300) having a pre-assigned authenticity weight, wherein the pre-assigned authenticity weight is manually pre-assigned based on input or using authenticity indicia;

associating the determined authenticity metric value

with its corresponding web element of the set of data;  
receiving a search request including a search query;  
identifying a set of web elements from the plurality  
of web elements based on the search request, wherein  
each identified web element is identified based on its  
relevance to the search query;  
ranking the identified web elements to generate a  
list of ranked web elements;  
processing the list of ranked web elements based on  
the authenticity metric value associated with each  
identified web element to generate a modified list of  
ranked web elements; and  
transmitting the modified list of ranked web  
elements to a client device."

- X. Claim 1 of the first auxiliary request differs from claim 1 of the main request in that it adds after "from a seed web page (300) having a pre-assigned authenticity weight" the text "based on a search term" and replaces the text "receiving a search request including a search query" with the text "receiving a search request including the search term".
- XI. Claim 1 of the second auxiliary request differs from claim 1 of the main request in that it adds after the text "to generate a modified list of ranked web elements" the text ", wherein the step of processing includes excluding from the modified list a web element associated with an authenticity metric value that does not meet a pre-defined threshold".
- XII. Claim 1 of the third auxiliary request reads as follows:  
"A system (100) for ranking web elements, the system comprising:

a memory (608) for storing an authenticity index (212);  
and

a processor (602), coupled to the memory, wherein the processor is configured to:

    receive a search request including a search query;  
    identify a set of web elements based on the search request, wherein each web element is identified based on its relevance to the search query;

    rank the web elements to generate a list of ranked web elements;

    associate an authenticity weight to each of the web elements,

    wherein the authenticity weight is assigned based on the number of links required to reach a web element from a seed web page (300) having a pre-assigned authenticity weight, wherein the pre-assigned authenticity weight is manually pre-assigned based on input or using authenticity indicia;

    process the list of ranked web elements based on at least the authenticity weight associated with each of the web elements to generate a modified list of ranked web elements (302); and

    transmit the modified list of ranked web elements to a client device (104)."

XIII. Claim 1 of the fourth auxiliary request reads as follows (itemisation of the features added by the board):

[A] "A method for determining at least one authenticity metric value for a set of data, comprising:

[B] retrieving, by a computer system, the set of data from one or more computer servers, wherein the set of data includes data for a plurality of web elements;



- [C] for each of the web elements in the set of data, determining an authenticity metric value,
- [C1] wherein the authenticity metric value is assigned based on a number of links required to reach a web element from a seed web page having a pre-assigned authenticity weight, wherein the pre-assigned authenticity weight is manually pre-assigned based on input or using authenticity indicia; and
- [D] associating the determined authenticity metric value with its corresponding web element of the set of data."

XIV. Claim 1 of the fifth auxiliary request differs from claim 1 of the fourth auxiliary request in that it adds the text "to associate a low authenticity metric with a web element designed to push malware to a computer system of a user" after the text "a seed web page having a pre-assigned authenticity weight" (see feature C1).

XV. Claim 1 of the sixth auxiliary request differs from claim 1 of the fifth auxiliary request in that it adds the text "; and excluding from the set of data a web element associated with an authenticity metric that does not meet a predefined threshold" at the end of claim 1 and omits the word "and" after "indicia;".

XVI. Claim 1 of the seventh auxiliary request differs from claim 1 of the fourth auxiliary request in that the text after "having a pre-assigned authenticity weight" reads as follows:  
"which is manually pre-assigned based on input or using authenticity indicia;  
associating the determined authenticity metric value with its corresponding web element of the set of data;

identifying a web element that is associated with a low authenticity metric value, which does not meet a predefined threshold, as one designed to push malware to a computer system of a user; and

excluding from the set of data the web element identified as one designed to push malware to a computer system of a user."

XVII. Claim 1 of the eighth auxiliary request differs from claim 1 of the seventh auxiliary request in that it removes the word "and" before "excluding" and adds the text "; and transmitting the set of data to a client device (104)." at the end of the claim.

XVIII. The appellant's arguments relevant to the decision are discussed below.

## **Reasons for the Decision**

### **The invention**

1. The application relates to determining at least one authenticity metric value for a set of data including data for a plurality of web elements (description as originally filed, paragraph [0005]).
  - 1.1 In its background section, the application explains that in the typical search scenario on the internet, "a user transmits a search request to a search service. Based on the search request, search results are identified and provided to the user. Many search services perform additional processing to determine the order or ranking of the search results. For example, some search services determine the ranking of search results based on popularity metrics, e.g., site traffic

[or] number of linking sites, [...] and provide ranked/ordered results in response to search requests. As is well-known, internet content providers will often attempt to influence ranked search results not by providing more compelling content, but by other means. [...] For example, a manipulated page for unauthorized sales of [...] movies might be able to obtain a high popularity rating, but what the typical user will want to see is a more authentic page" where a product can be bought legitimately (description, paragraph [0003]).

- 1.2 According to the application (description, paragraph [0018]), a web element can refer to, for example, a web page, a website, an online advertisement, web content, web objects or any combination of these storable in electronic form.

Paragraph [0040] reads: "[...] an authenticity weight may indicate the relative authority of a web element for a given category, context, keyword, phrase, search term, filter, etc. For example, a search index may index a Disney.go.com™ web page for the Snow White and the Seven Dwarfs™ film and an online encyclopaedia web page that also discusses the same film. The Disney.go.com web page may be associated with an authenticity weight that is greater than the authenticity weight associated with the encyclopaedia web page because Disney.go.com is the official domain for The Walt Disney Company. As such, with respect to the Snow White and the Seven Dwarfs™ film, the Disney.go.com web page may be considered more authoritative (and thus more authentic) than the encyclopaedia web page)."

Embodiments of the invention enable search results and/or online advertisements to be ranked and filtered

based on authenticity. The embodiments enable more authoritative search results and online advertisements to be ranked higher and be more visible to a user (description, paragraph [0032]). An online advertisement associated with a web page selling pirated copies of motion picture films may be associated with a very low authenticity weight. As a result, the online advertisement may be altogether excluded from a set of online advertisements (description, paragraph [0044]).

- 1.2.1 In some embodiments, search logic may assign an authenticity weight to a web element based on its proximity to a set of seed web pages. For example, if an online advertisement is associated with <electronicsretailer>.com, the authenticity of the online advertisement may be based on the proximity of <electronicsretailer>.com to a seed web page (description, paragraph [0072]).

Paragraph [0074] describes some embodiments as follows: "In some embodiments, the proximity of a web element to a seed web page may be defined by the number of links or hops required to reach the web element from the seed web page. Illustratively, a Disney.go.com web page for the Toy Story 3™ movie may be a seed web page and may be pre-assigned with an authenticity weight of 1. The web page may include links to other web pages, such as web pages on a music site and a social network site. These pages may be assigned a slightly lower authenticity weight, such as 0.9. The web pages on the music and social network sites may, in turn, link to other web pages. These web pages may be assigned even lower authenticity weights, such as 0.8 because they are further in proximity (i.e., they require two hops) from the Disney.go.com web page. In some embodiments,

those web pages that are not directly linked to a core or seed web page may receive relatively low authenticity weights."

**Main request and first and second auxiliary requests -  
admissibility**

2. The main request and the first and second auxiliary requests were filed in response to the board's communication under Article 15(1) RPBA 2020.
  - 2.1 Compared with the requests filed with the grounds of appeal (see sections XIII. to XVII. above), the main request and the first and second auxiliary requests amend claim 1 (see sections IX. and XI. above), *inter alia*, by adding steps relating to receiving a search request, searching web elements and providing search results to a user.
3. *Admissibility under Article 13(2) RPBA 2020*
  - 3.1 Under Article 13(2) RPBA 2020, any amendment to a party's appeal case made after the expiry of a period specified by the board in a communication under Rule 100(2) EPC or, where such a communication is not issued, after notification of a summons to oral proceedings must, in principle, not be taken into account unless there are exceptional circumstances justified with cogent reasons by the party concerned.
  - 3.2 Document CA/3/19, which concerns the approval of the RPBA 2020, provides the following explanatory remarks on Article 13(2) RPBA 2020.

"[...] The basic principle of the third level of the convergent approach is that, at this stage of the

appeal proceedings, amendments to a party's appeal case are not to be taken into consideration. However, a limited exception is provided for: it requires a party to present compelling reasons which justify clearly why the circumstances leading to the amendment are indeed exceptional in the particular appeal ('cogent reasons'). For example, if a party submits that the Board raised an objection for the first time in a communication, it must explain precisely why this objection is new and does not fall under objections previously raised by the Board or a party. The Board may decide to admit the amendment in the exercise of its discretion.

At the third level of the convergent approach, the Board may also rely on criteria applicable at the second level of the convergent approach, i.e. as set out in proposed new paragraph 1 of Article 13. [...]"

- 3.3 The appellant argued that the new requests were a direct response to the board's comments about the technical effects of the distinguishing features in point 7.3 of the summons, in particular that the effects (i) and (ii) were not derivable from the claimed subject-matter. Moreover, in point 7.1.1 of its summons, the board had deviated from the contested decision regarding feature C1. Because of this change of view, the state of the proceedings had changed, and the whole issue of technical effect was up for discussion.

The amendments were suitable for resolving the issues raised by the board, and the board therefore had discretion to admit the newly filed requests under Article 13(1) RPBA 2020. While page 10 of the contested decision mentioned that the filtered data set was not

related to any search results, this was only a single sentence in point 16 of the contested decision relating to the discussion of the technical effect. The appellant also contended that the main argument of the examining division concerning the effect of the distinguishing feature was given in point 13.4 of the contested decision (page 6, last paragraph), which considered search results.

- 3.4 The board is not convinced that, in the current case, there are any exceptional circumstances that could justify the admission of the main request and the first and second auxiliary requests.

The board considers that the above cited explanatory remarks on Article 13(2) RPBA 2020 make it clear that circumstances leading to an amendment have to be exceptional in the appeal, such as an objection raised for the first time in a communication of the board.

- 3.4.1 Regarding the alleged "change of view" of the board on feature C1 in point 7.1.1 of its communication, the board notes that in the decision under appeal, feature C1 was at least in part considered novel over D1 (see decision under appeal, point 13.4). Furthermore, as explained in more detail below, the board argued in essentially the same manner as the examining division. Therefore, the board does not find the appellant's argument convincing that there was a change of view with respect to C1 justifying the admitting of new amendments under Article 13(2) RPBA 2020.
- 3.4.2 Regarding the argument that the board raised a fresh objection in point 7.3 of the summons, the board does not agree with the appellant for the following reasons.

In its statement of grounds of appeal, the appellant argued that the technical effects of the distinguishing features were the same as those alleged in the first-instance proceedings (see page 3 of the grounds of appeal, point 14.3 of the contested decision and point 7.2 of the board's communication). In point 14.4 of the contested decision, the examining division expressed its view that these effects could not be derived from the claimed subject-matter and on page 8 stated the following: "None of the features of claim 1 defines the provision of search results to a user's computer, data retrieval in response to a query, nor any transmission of the filtered set of data (or of subsets thereof) to a user's computer."

As discussed in the oral proceedings before the board, in point 16 of its decision, the examining division refuted arguments concerning the alleged technical effects of the distinguishing features. It expressed its view that the "filtered data set, as defined in claim 1, is not related to any search results, to any retrieval, indexing or transmission process, and it is not further used according to claim 1".

In point 7.3 of its communication, the board stated the following: "As to the alleged effects (i) and (ii), the Board considers that claim 1 of the main request does not refer to retrieving data, search results or search engines. Hence, the effects (i) and (ii) appear to be not derivable from the claimed subject-matter."

It follows that the board argued in essentially the same manner as the examining division, namely that the alleged effects could not be derived from the claimed subject-matter, *inter alia*, because the claim did not mention retrieval or search results. Consequently, the



board raised no fresh objection. Rather, in essence it agreed with the examining division and remained within the framework of the objection made in the first-instance proceedings.

Moreover, as discussed in the oral proceedings, on page 4, penultimate paragraph of the statement of grounds of appeal, the appellant stated the following:

"In its reasoning, the Examining Division has not provided any explanation as to why any one of the effects (i)-(iii) should not be considered to be technical, apart from stating that 'none of the features of claim 1 defines the provision of search results to a user's computer, data retrieval in response to a query, nor any transmission of the filtered set of data (or of subsets thereof) to a user's computer' (see point 14.4). However, independent claim 12 of the main request includes the feature of the processor being configured to 'transmit the modified list of ranked web elements to a client device'. Thus, claim 12 of the main request must be considered to provide a technical effect at least. In any case, it should not be necessary to amend the independent claims to include this feature because this specifies only one of the possible uses for the set of data defined in claim 1, and choosing one of these uses would unfairly limit the scope of the claim to which the applicant should [be] entitled."

The cited passage of the statement of grounds of appeal demonstrates that the appellant fully understood the examining division's objection and considered appropriate limitations of the subject-matter of claim 1 but decided deliberately not to limit independent claim 1 of the main request nor to file a

new request directed specifically to the subject-matter of claim 12 when it filed its statement of grounds of appeal.

Regarding the appellant's argument that the examining division had considered the effect of the claimed subject-matter with respect to search results in point 13.4 of its decision, the board considers that the examining division in point 13.4 of its decision merely set out for the sake of argument that even when the claimed subject-matter was later applied in a retrieval process for filtering search results, this would also not be a technical effect or involve technical considerations (see also the preliminary opinion of the board expressed in point 7.5.5 of its communication).

Consequently, the board does not see that its provisional opinion in point 7.3 of its communication could justify the filing of amendments in view of exceptional circumstances.

3.5 It follows that the main request and the first and second auxiliary requests are not admissible under Article 13(2) RPBA 2020.

3.6 *Admissibility under Article 13(1) RPBA 2020*

3.6.1 Under Article 13(1), first sentence, RPBA 2020, any amendment to a party's appeal case after it has filed its grounds of appeal or reply is subject to a party's justification for its amendment and may be admitted only at the discretion of the board. The criteria for the exercise of this discretion are set out in Article 13(1), fourth sentence, RPBA 2020. For an amendment to the appeal case to be admitted, the party must provide reasons for submitting the amendment at this stage of

the appeal proceedings (Article 13(1), third sentence, RPBA 2020). For an amendment to a patent application or patent, the requirements set out in Article 12(4), fourth sentence, RPBA 2020 must also be fulfilled (see Article 13(1), second sentence, RPBA 2020), i.e. reasons why the amendment overcomes the objections raised have to be provided.

- 3.6.2 The appellant argued that the main request and the first and second auxiliary requests were admissible as they had a basis under Article 123(2) EPC and were a direct response to the board's comments about the technical effect in point 7.3 of the summons, in particular that the effects (i) and (ii) were not derivable from the claimed subject-matter.
- 3.6.3 In the oral proceedings, the board informed the appellant of its preliminary opinion that the main request and the first and second auxiliary requests seemed to be inadmissible under Article 13(1) RPBA 2020 as these requests raised fresh complex issues under Article 123(2) EPC (Article 13(1) and 12(4) RPBA 2020). The newly filed main request comprised a step of associating the determined authenticity metric value with its corresponding web element of the set of data before the step of receiving a search request including a search query and before any search results are identified. However, according to the description of the application as filed, paragraph [0008], which the appellant cited as basis for the amended main request (see the appellant's letter dated 18 October 2021, page 2, first paragraph), it appeared that the step of associating an authenticity weight was performed only

after the step of identifying the set of search results. The same issue arose for the first and second auxiliary requests.

3.6.4 In the oral proceedings, the appellant argued that the order of the steps in claim 1 was just a "linguistic order", not a required order for carrying out the steps, unless such an order was defined by an interrelationship of the steps. The order of the steps was not an issue under Article 123(2) EPC. While Figure 5 of the application as filed set out a specific order of steps, paragraph [0008] of the description did not disclose such an order.

3.6.5 The appellant's arguments are not *prima facie* convincing. The board considers that the newly filed main request and the first and second auxiliary requests all raise *prima facie* new complex issues under Article 123(2) EPC relating to the order of the claimed steps. Thus, the board exercises its discretion under Article 13(1) RPBA 2020 and does not admit the main request and the first and second auxiliary requests into the appeal proceedings.

### **Third auxiliary request - admissibility**

4. In the oral proceedings, after the Chair had announced the result of the board's deliberation on the admissibility of the main request and the first and second auxiliary requests, the appellant submitted its current third auxiliary request.

5. Admissibility under Article 13(2) RPBA 2020

5.1 The appellant argued that the third auxiliary request was admissible as it merely removed claims 1 to 11 from

its former main request (now renumbered as the fourth auxiliary request). This former main request had been decided on by the examining division. Consequently, the new third auxiliary request added nothing new and did not raise any fresh issue under Article 123(2) EPC. Moreover, the third auxiliary request provided a technical effect in relation to a search. The appellant also argued that the contested decision and the board's communication had not commented on the subject-matter of claim 12. This meant that there were no objections against this claim.

- 5.2 The board does not recognise any exceptional circumstances for admitting the third auxiliary request under Article 13(2) RPBA 2020.

In its summons dated 8 August 2017, the examining division presented an inventive-step objection against the then pending claims 1 to 15. In reply, the appellant filed the former main request (i.e. the current fourth auxiliary request) and two auxiliary requests. In a telephone consultation on 8 January 2018, the appellant was informed that the amendments made in the requests filed in reply to the summons appeared not to overcome the examining division's objection under Article 56 EPC. The appellant then filed a third auxiliary request and was informed in a brief communication dated 17 January 2018 that the then third auxiliary request made no progress toward an allowable claim request and that all issues would be discussed at the oral proceedings. In reply, the appellant announced in its letter dated 19 January 2018 that it would not be represented at the oral proceedings scheduled for 22 January 2018. The oral proceedings took place in absence of the appellant, and the application was refused.

The fact that the contested decision provided only a reasoning for claim 1 of each of the four claim requests considered was correct, to be expected and does not mean that the other claims were allowable. By not attending the oral proceedings, the appellant waived an opportunity to (1) discuss the examining division's objections in detail and (2) ensure by filing requests directed to claim 12 of the former main request that the examining division would also provide a reasoning for the subject-matter of that claim.

In any case, the appellant was informed of the reasoning against the claims throughout the first-instance proceedings and in the contested decision and could have reacted to this reasoning when it submitted its statement of grounds of appeal. In fact, it did react to the reasoning of the contested decision by filing a further auxiliary request with its statement of grounds of appeal. The then filed request (the current eighth auxiliary request) comprised a step of transmitting the set of data to a client device. This could be seen as a reaction to the reasons provided in points 14.4 and 16 of the contested decision where the examining division argued that claim 1 did not refer to any transmission. However, the appellant did not file a request directed specifically to the subject-matter of claim 12 of the former main request (i.e. the current third auxiliary request). It also did not file such a request in reply to the board's communication, which agreed with the examining division. Rather, the appellant filed only the current main request and the current first and second auxiliary requests in reply to the board's communication.

In view of the above, it is clear that the appellant could and should have filed the current third auxiliary

request at the very latest with its statement of grounds of appeal, but preferably earlier (e.g. in reply to the examining division's summons). As the board's communication was essentially in line with the examining division's opinion, it did not introduce fresh objections or lines of reasoning in respect of the former main request which could constitute exceptional circumstances within the meaning of Article 13(2) RPBA 2020 justifying the amendments introduced with the current third auxiliary request. Consequently, the current third auxiliary request is not admissible under Article 13(2) RPBA 2020.

**Request for remittal for further prosecution on the basis of the third auxiliary request and reimbursement of the appeal fee**

6. In the oral proceedings before the board, the appellant submitted the procedural requests that the case be remitted to the department of first instance for further prosecution on the basis of the third auxiliary request submitted in these oral proceedings and that the appeal fee be reimbursed.

6.1 The appellant argued that the examining division had committed a substantial procedural violation under Article 113(1) EPC since claim 12 had not been subject to any reasoning in the contested decision. Consequently, the appeal fee should be reimbursed in full under Rule 103(1) (a) EPC.

7. *Remittal on the basis of the third auxiliary request*

Since the board does not admit the third auxiliary request, a remittal to the department of first instance

for further prosecution on the basis of the third auxiliary request is not possible and has to be refused.

*Reimbursement of the appeal fee*

- 7.1 In accordance with the established case law of the boards (see decisions R 14/10, Reasons 6.3 and T 228/89, Reasons 4.2 referring to T 5/81, Reasons 3), there is no obligation under the EPC to carry out the examination of a European patent application or patent in its entirety, i.e. for all pending claims, if a claim considered unallowable was maintained and no auxiliary request relating to a set of claims not comprising this unallowable claim was submitted. In such a case, the application or patent fails to meet a requirement of the EPC and is open to refusal or revocation.
- 7.2 Since the examining division objected to claim 1 of all requests considered in the contested decision, it follows from the cited established case law that the examining division was not obliged to provide in its decision any reasoning regarding claim 12. Hence, the board is not convinced by the appellant's argument that not considering claim 12 in the contested decision constituted a substantial procedural violation of its right to be heard under Article 113(1) EPC.
- 7.3 As there was no substantial procedural violation in the first-instance proceedings as alleged by the appellant, a reimbursement of the appeal fee under Rule 103(1) (a) EPC is not possible. The board remarks only for completeness that a further reason for not reimbursing the appeal fee under Rule 103(1) (a) EPC is that the



appeal is not allowable (see below for the lower-ranking requests).

**Alleged procedural violation by the board**

8. During the oral proceedings, the appellant declared that it "reserved the appellant's right to file a petition for review" and raised an objection under Rule 106 EPC in respect of the board's decision not to admit the third auxiliary request into the proceedings. The appellant argued that a fundamental violation of the applicant's right to be heard (Article 113(1) EPC) and hence a substantial procedural violation had taken place since claim 12 was not mentioned in the examining division's decision dated 5 February 2018, nor in the board's preliminary opinion dated 10 November 2020 (see section VII. above).

8.1 With regard to this objection concerning the appeal proceedings, the board remarks the following. As explained in detail above, the examining division did not commit any procedural violation in not having included any reasoning for claim 12 in its final decision. In its communication, the board examined claim 1 of each of the requests submitted with the grounds of appeal and on that basis came to the preliminary conclusion that none of the requests was allowable. In view of this, the board had no obligation to examine any of the other independent claims of those requests. Since, furthermore, the contested decision did not provide any reasoning regarding claim 12, and since the appellant did not file with the grounds of appeal any claim request limited specifically to claim 12 as the sole independent claim, the board refrained from providing in its communication a preliminary opinion concerning claim 12 in view of the primary

object of the appeal proceedings to review the decision under appeal in a judicial manner (Article 12(2) RPBA 2020). In doing so, the board did not violate the appellant's right to be heard.

At the oral proceedings before the board, the appellant was heard on (1) whether the first-instance proceedings were tainted with a substantial procedural violation, (2) the admissibility of the third auxiliary request and (3) whether the appellant's right to be heard was observed. In view of this and the board's reasoning provided above for the non-admittance of the third auxiliary request filed in the oral proceedings before the board and in view of its own assessment that the first-instance proceedings were not affected by a substantial procedural violation, the board does not see any violation of the appellant's right to be heard. In particular, the board sees no reason why the non-admittance of the third auxiliary request could constitute a violation of the appellant's right to be heard. The board has discretion not to admit requests filed at such a late stage of the proceedings, the criteria to be applied having been established in the case law of the boards and the Rules of Procedure of the Boards of Appeal. The board's decision not to admit the third auxiliary request was fully reasoned on the basis of these criteria. The board also remarks that the appellant did not submit anything during the oral proceedings that could have been understood as a further objection regarding a procedural violation during the appeal proceedings.

#### **Fourth auxiliary request**

#### 9. *Inventive step - Article 56 EPC*

##### 9.1 *Document D1 as the starting point*

The examining division considered that document D1 was a suitable starting point for assessing inventive step and that it disclosed most features of claim 1. D1 discloses a search engine system for assisting users in locating web pages from which user-specified products can be purchased. Web pages located by a crawler program are scored, based on a set of criteria, according to the likelihood of including a product offering (D1, abstract).

According to the statement of grounds of appeal (page 3), it is common ground that D1 does not disclose feature C1 (for the itemisation of the features of claim 1, see point XIII. above).

9.1.1 While the board notes that the examining division seemed to have identified at least parts of feature C1 in document D1, the board agrees with the appellant that the product score disclosed in D1 (see e.g. paragraphs [0037] to [0040], [0070] to [0072] and [0084]) differs from the authenticity metric determined according to feature C1 of claim 1. The board also agrees with the appellant that D1 discloses determining the product score based on pages linked to the scored page, whereas the claimed authenticity metric considers the number of links that need to be traversed (hops) from a seed web page to reach the scored web page, i.e. it considers web pages linking to the scored page. The board notes that it was well known to use pages linking to a web page for calculating a ranking score of that

web page (see the description of the application, background section, paragraph [0003]: "the number of linking sites"; paragraphs [0079] and [0081]: the "PageRank™ scores" refer to a well-known ranking method used by Google which uses the linking sites for ranking).

As to features A, B, C and D, the board sees no reason to disagree with the contested decision. Features A, B and C are disclosed in D1, paragraph [0037], and feature D is disclosed in paragraph [0040] (see also the further passages of D1 cited in the contested decision for features A, B, C and D). Consequently, the board agrees that the only feature distinguishing the invention over document D1 is C1.

- 9.2 In its statement of grounds of appeal (page 3), the appellant submitted that the distinguishing feature would give rise to the following technical effects:
- (i) preventing the abusive manipulation of search results
  - (ii) accurately retrieving data in response to a request, thus maintaining search engine functionality
  - (iii) preventing a user's computer from being infected with malicious content, e.g. malware, and reducing the exposure of a user's computer to harmful search results

- 9.3 The board does not recognise these effects.

As to the alleged effects (i) and (ii), the board considers that claim 1 of the fourth auxiliary request does not refer to retrieving data, search results or search engines. Hence, the effects (i) and (ii) are not derivable from the claimed subject-matter.

As to the alleged effect (iii), the board is not convinced that the claimed subject-matter aims at preventing a user's computer from being infected with malicious content. There is no step directly associated with any prevention of infections by malware (such as a computer virus). Claim 1 is silent on any use of the associated authenticity scores, and there is no support in the description for the alleged effect (iii). The description does not disclose many details regarding infections by malware but appears to relate mainly to reducing the likelihood of accessing content violating copyright regulations (for example, pirated copies of movies; see the summary of the invention in points 1. to 1.2.1 above).

Rather, the board considers that the effect of distinguishing feature C1 is to provide an authenticity metric value for web elements based on a (manually) selected set of seed web pages. The idea behind this appears to be to rank web elements higher when they originate from a set of (manually) selected seed web sites and web sites within a certain number of hops from these seed web sites. In other words, results from a certain set of web sites relating to a set of white-listed web sites which are ranked higher.

9.4 In the board's opinion, the effect of providing an authenticity metric value for web elements is not related to a technical application like the control of an industrial process or a technical device external to the computer system. It does not contribute to any "further" technical effect, i.e. a technical effect going beyond the normal electrical interactions within the computer (see T 1173/97, Reasons 13; G 3/08, Reasons 10.2.1; and G 1/19, Reasons 50 and 51). The

board also refers to decision T 489/14, Reasons 2.7, in accordance with which a technical effect relevant for the assessment of inventive step exists if the features of the claim directly achieve a (real) technical effect on physical reality (including both external physical reality and the "internal" physical reality of the computer system in which the invention is implemented). The distinguishing feature C1 does not specify any details about the internal operation of the computer system. Moreover, the board does not see that the distinguishing feature C1 is based on any "further technical considerations" within the meaning of opinion G 3/08, Reasons 13.5.1. The claimed solution relies instead on (non-technical) considerations such as the assumption that official websites and the sites linked to them are less likely to contain certain "undesirable" content.

9.5 Since the appellant cited various decisions in support of the technical character of the claimed invention, the board deems it appropriate to comment on these decisions.

9.5.1 As to cited decision T 1028/14, which dealt with spam filtering for messages, the board notes that the decision states in its Reasons 1.1.3 the following: "Given that the whole application is concerned with telecommunication messages (such as SIP or email messages) and that undesired messages correspond to spam messages, the board is satisfied that the underlying problem to be solved is indeed a technical problem."

In the current case, step C1 is the only distinguishing feature over the disclosure of document D1. However, this distinguishing feature has no recognised technical

effect. Step C1 refers to the provision of an authenticity metric value based on a manually pre-assigned authenticity weight of a web page. This is very remote from the implementation of the method in case T 1028/14, where the metrics are delivered by a reputation engine. Therefore, the appellant's argument based on decision T 1028/14 is not convincing.

- 9.5.2 Decision T 1216/08 (see Reasons 1) concerned authentication of software in a dynamic loading environment where a digital signature was used to authenticate a program image. As the case at issue is neither concerned with program images nor uses digital signatures, the reasoning of the cited decision is not relevant.
- 9.5.3 The appellant also cited decision T 861/04. This decision concerned a search in an electronic program guide for a television. It is evident that the case underlying the cited decision is rather remote from the factual situation of the case at hand. Hence, the board considers that the cited decision, which moreover predates opinion G 3/08, is not relevant for the current case.
- 9.5.4 Cited decision T 654/10 concerns a method of storing and delivering a message to a user over a network in which first an address signal associated with the incoming call is detected. Again, this decision is in a telecommunication context and thus not relevant for assessing technical character in the current case.
- 9.5.5 Decision T 309/10 (Reasons 15) considered that retrieval and accuracy were non-technical in the context of the case at hand and does not support the appellant's case.

- 9.6 In view of the above comments, the decisions cited by the appellant do not support its case. The established case law instead goes against the appellant's case. Decision T 1924/17 (Reasons 12 and 13) summarises the relevant case law in the field and explains that certain aspects of relevance-based information retrieval, for example, in the context of internet search engines, are usually regarded as being based on non-technical considerations. This applies also to this case where, at least in light of the description, the authenticity metric value for web elements is ultimately used to determine the relevance rank (and thus a position in the search results listing) of web elements in the context of internet searches.
- 9.7 In view of the above, the board is not convinced that the distinguishing feature C1 contributes to the solution of a technical problem. Thus, this distinguishing feature does not enter into the assessment of inventive step (see decision T 154/04, Reasons 5(F): "Non-technical features, to the extent that they do not interact with the technical subject matter of the claim for solving a technical problem, i.e. non-technical features 'as such', do not provide a technical contribution to the prior art and are thus ignored in assessing novelty and inventive step)."
- 9.8 Consequently, claim 1 of the fourth auxiliary request lacks an inventive step in view of document D1 (Article 56 EPC).



**Fifth auxiliary request**

10. Claim 1 of the fifth auxiliary request differs from claim 1 of the fourth auxiliary request in that it additionally recites the following feature:  
E to associate a low authenticity metric with a web element designed to push malware to a computer system of a user

11. *Added subject-matter*

11.1 The appellant argued that the basis for feature E could be found in the application as filed, paragraph [0003], final sentence to paragraph [0004] and the final sentence of paragraph [0028].

11.2 The board considers that the cited basis provides insufficient support for feature E. Paragraphs [0003] and [0004] belong to the background section and do not disclose the invention. The final sentence of paragraph [0028] reads as follows:

"There may be some sites (e.g., <dishorable-malware-downloader-posing-as-a-freebie-site>.com) that might be of low authoritativeness for all categories and can be associated with a low authenticity metric with respect to the search term (or non-searched terms)."

This sentence is not sufficient to support feature E. The sentence mentions a single example of a website which may be designed to push malware to a user's computer ("dishorable-malware-downloader"). According to the description, paragraph [0026], the term "website" is a collection of network-interfaced hardware and content stored or accessible on it. A "website" is thus different from a "web element" as

specified in feature E as the expression "web element" can also refer to a web page, web content, an online advertisement or another web object (see the description, paragraph [0018], for example).

Furthermore, according to the cited final sentence of paragraph [0028], a low authenticity metric is associated with a website "with respect to the search term (or non-searched terms)". However, feature E does not mention any search or non-searched term. Therefore, the board does not see how the skilled person could derive feature E directly and unambiguously from the cited sentence of paragraph [0028].

In view of the above, and since the appellant did not comment on the board's objection, the board concludes that claim 1 of the fifth auxiliary request does not comply with the requirements of Article 123(2) EPC.

### **Sixth auxiliary request**

12. Claim 1 of the sixth auxiliary request differs from claim 1 of the fifth auxiliary request in that it additionally recites the step of excluding from the set of data a web element associated with an authenticity metric that does not meet a predefined threshold.
13. *Added subject-matter*
  - 13.1 Since claim 1 of the sixth auxiliary request comprises feature E of the fifth auxiliary request and since the appellant did not comment on the board's objection, the board concludes that claim 1 of the sixth auxiliary

request infringes Article 123(2) EPC for the same reasons as provided above for the fifth auxiliary request.

### **Seventh auxiliary request**

14. Claim 1 of the seventh auxiliary request differs from claim 1 of the fourth auxiliary request essentially in that it additionally recites the following features:
- G identifying a web element that is associated with a low authenticity metric value, which does not meet a predefined threshold, as one designed to push malware to a computer system of a user
  - H excluding from the set of data the web element identified as one designed to push malware to a computer system of a user
15. *Added subject-matter*
- 15.1 According to the appellant, feature G was based on the description of the application as filed, page 6, lines 12 to 15 and page 18, lines 3 to 7. Feature H was based on the description, page 1, line 30 to page 2, line 2 and page 6, lines 12 to 15.
- 15.2 The board is not convinced that feature G is directly and unambiguously derivable from the passages cited by the appellant as basis. The application as filed discloses on page 6, lines 12 to 15 that "some sites (e.g., <dishorable-malware-downloader-posing-as-a-freebie-site>.com)" may be assigned a low authenticity metric value. The cited passage on page 18, lines 3 to 7 discloses that search results not meeting a threshold authenticity weight are removed from the set of search results and that an online advertisement associated with a web page selling pirated copies of

DVD movies may be associated with a low authenticity weight.

However, feature G specifies that a web element having a low authenticity metric value is identified as a web element, e.g. a web site, designed to push malware to a computer system. This is different from the cited passage on page 6 in the application as filed according to which a low authenticity metric value may be assigned to a web site seemingly pushing malware. The cited passage on page 18 does not concern a web site pushing malware but one allowing the download of pirated copies of movies. It discloses identifying a website that does not meet an authenticity threshold but not identifying it as one designed to push malware to the user's computer. The appellant did not comment on the board's objection.

Consequently, claim 1 of the seventh auxiliary request infringes Article 123(2) EPC.

#### **Eighth auxiliary request**

16. Claim 1 of the eighth auxiliary request differs from claim 1 of the seventh auxiliary request in that it additionally recites the feature of transmitting the set of data to a client device.

17. *Added subject-matter*

Since the objections under Article 123(2) EPC provided above for the seventh auxiliary request apply also to the eighth auxiliary request and since the appellant did not comment on the board's objections, claim 1 of the eighth auxiliary request infringes Article 123(2) EPC.

18. Since none of the admissible requests are allowable,  
the appeal is to be dismissed.

### **Order**

### **For these reasons it is decided that:**

The appeal is dismissed.

The Registrar:

The Chair:



S. Lichtenvort

J. Geschwind

Decision electronically authenticated