Internal distribution code:

(A) [-] Publication in OJ
(B) [-] To Chairmen and Members
(C) [-] To Chairmen
(D) [X] No distribution

Datasheet for the decision of 8 April 2022

Case Number: T 1056/19 - 3.4.03

Application Number: 12871943.2

Publication Number: 2828815

IPC: G06Q30/02, H04W4/20

Language of the proceedings: EN

Title of invention:
METHOD AND SYSTEM FOR ADVERTISING USING A MOBILE COMMUNICATION DEVICE

Applicant:
Licensing IP International Sarl

Relevant legal provisions:
EPC Art. 56
RPBA Art. 12(4)

Keyword:
main request - inventive step - (no)
auxiliary request - admitted (no)

Decisions cited:
G 0001/04, T 0603/89, T 0258/03, T 1892/10, T 1670/07, T 1741/08

Europäisches Patentamt
European Patent Office
Office européen des brevets

Beschwerdekammern

Boards of Appeal

Chambres de recours

Boards of Appeal of the
European Patent Office
Richard-Reitzner-Allee 8
85540 Haar
GERMANY
Tel. +49 (0)89 2399-0
Fax +49 (0)89 2399-4465

Case Number: T 1056/19 - 3.4.03

D E C I S I O N
of Technical Board of Appeal 3.4.03
of 8 April 2022

Appellant: (Applicant)	Licensing IP International Sarl 32 Boulevard Royal 2449 Luxembourg (LU)
Representative:	Glück Kritzenberger Patentanwälte PartGmbB Hermann-Köhl-Strasse 2a 93049 Regensburg (DE)
Decision under appeal:	**Decision of the Examining Division of the European Patent Office posted on 14 November 2018 refusing European patent application No. 12871943.2 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chairman	M. Papastefanou
Members:	M. Ley
	E. Mille

Summary of Facts and Submissions

I. The appeal is against the decision of the examining division to refuse European patent application No. 12 871 943.2 pursuant to Article 97(2) EPC.

The decision was a so called "decision on the state of the file" in which the examining division referred to the annex to the summons to attend oral proceedings dated 20 March 2018.

The examining division held that claims 1 to 3, 5 to 10, 12 and 13 lacked clarity (Article 84 EPC), the application did not disclose at least one way of carrying out the claimed invention (Article 83 and Rule 42(1)(e) EPC) and that the subject-matter of claim 1 did not involve an inventive step (Article 56 EPC).

II. This appeal is the second appeal in relation with European patent application No. 12 871 943.2. The first appeal was filed against the decision of the examining division to refuse the application dated 1 September 2017. The examining division ordered an interlocutory revision (Article 109(1) EPC) of its decision due to a procedural error, see point 2. of the annex to the summons to attend oral proceedings dated 20 March 2018, as well as the reimbursement of the appeal fee.

III. The appellant requested that the decision under appeal be set aside and a patent be granted on the basis of the claims underlying the decision (claims 1 to 13 filed with entry into the regional phase before the EPO) as its main request, or on the basis of an

auxiliary request (claims 1 to 7) filed with the statement setting out the grounds of appeal.

IV. Reference is made to the following document:

D3 Tab (GUI), Wikipedia entry of 28 February 2012

V. Claim 1 according to the main request has the following wording (labelling added by the board):

A method for providing advertisements on a mobile communication device,
(a) *the mobile communication device includes a microprocessor, a user input mechanism, means for mobile access to a communication network and a graphical user interface upon which is displayed a mobile web browser under the control of the microprocessor, wherein the mobile web browser supports multiple browser tabs, the method comprising;*
(b) *identifying at least one URL link to which it is desired to add an advertising functionality, the at least one URL link being associated with source content of a primary first web page;*
(c) *adding the advertising functionality to the at least one URL link to create at least one modified URL link,* **(d)** *wherein upon the addition of the advertising functionality to the at least one URL link, selection of the at least one modified URL link results in opening both a primary first web page directly associated with the at least one URL link clicked by the user and a secondary second web page.*[sic]
(e) *receiving from a user of the mobile communication device a request for source content containing the at least one modified URL link;*

(f) *transmitting to the user the source content for viewing in a first browser tab of the mobile web browser;*
(g) *receiving from the user of the mobile communication device a request for the source content associated with the at least one modified URL link;*
(h) *opening a second browser tab and transmitting a primary first web page directly associated with the at least one URL link for viewing in the second browser tab;*
(i) *transmitting a secondary second web page for viewing in the first browser tab which is positioned hidden from view by the user of the mobile communication device.*

Claim 1 according to the auxiliary request corresponds to claim 1 with the following amendments for features (b), (c) and (d):
(b') *identifying at least one URL link ~~to which it is desired to add an advertising functionality, the at least one URL link~~ being associated with source content of a primary first web page;*
(c') ~~*adding the advertising functionality to the at least one URL link to create*~~ *creating at least one modified URL link,* **(d')** ~~*wherein upon the addition of the advertising*~~ *as added functionality to the at least one URL link, whereby the selection of the at least one modified URL link results in opening both a primary first web page directly associated with the at least one URL link clicked by the user and a secondary second web page~~.~~, the method comprising the following steps:*

VI. The appellant's relevant arguments are reproduced in section 3.2 below.

Reasons for the Decision

1. The appeal is admissible.

2. The invention concerns a way of displaying advertisements on a mobile communication device, e.g. a smartphone. When a user clicks on a "modified" URL link of a web page displayed in a first browser tab of a mobile web browser, a second browser tab opens and shows a primary web page directly associated to the URL link, wherein a secondary web page having advertising content is transmitted for viewing in the first browser tab which is positioned hidden from view by the user of the mobile communication device.

3. Main request - Inventive step (Article 56 EPC)

3.1 The examining division identified the steps of a method for providing advertisements as non-technical aspects of claim 1, see the annex to the summons to the oral proceedings dated 20 March 2018, paragraph bridging pages 4 and 5, and considered this subject-matter as a method of doing business as such.

The remaining subject-matter involved technical aspects and related to a mobile communication device, wherein resource locations were represented by "clickable" URL links and content got represented on web pages, i.e. a conventional mobile phone with web browser supporting tabs and a particular advertising presentation strategy using at least two tabs, see, page 5, penultimate paragraph of the annex to the summons to the oral proceedings of 20 March 2018.

Such mobile communication devices with tab-web browser were notoriously well known as was its use in the

context of mobile web browsing following clickable links to web pages representing contents on the Internet, as was also confirmed by the background art on page 1 of the application, see the same annex to the summons to the oral proceedings, page 5, last paragraph. Reference was also made to Wikipedia entry D3 representing common general knowledge. JavaScript was also regarded as notoriously well known at the priority date of present application.

The presentation strategy of the advertisements itself was an aim to be achieved in the non-technical field of advertising. It would thus have been given to the skilled person (e.g. a JavaScript programmer) by a marketing person requesting the implementation of such tab-based advertising strategy on a mobile web browser supporting such tabs. The skilled person would have provided a JavaScript program such that the non-technical advertising method could be executed on such a conventional mobile tab web browser using standard data processing techniques without any technical consideration (see third and fourth paragraphs on page 6 of the same annex to the summons to oral proceedings).

3.2 The appellant disagreed and argued that the "remaining method features", i.e. the method features identified by the examining as non-technical, described a procedure to link a secondary additional (advertising) content to a requested primary content, and to place the linked secondary content in a second browser tab, whereby the second tab with the secondary data content was arranged to be hidden under the first tab on the graphic user interface of the mobile device. Thus, this method related to a certain way of displaying different data in different tabs of a web browser of the mobile

device, which had an effect on the user. The solution how to handle and display of data from different resource locations in the different tabs of a web browser on a display of a mobile communication device was of technical nature.

There was a "strong link between the technical and non-technical features" and their separation was not appropriate. Both technical and non-technical features resulted in the above mentioned technical effect ("to handle and display the different data in the web browser on the graphic user interface of the mobile phone"), see statement setting out the grounds of appeal, page 6, second paragraph. Reference was made to G1/04, T 603/89, item 2.5, T 258/03, T 1892/10, item 5 and T 1670/07.

The objective problem of the present invention was "how to provide a functionality to display additional linked secondary data in a mobile browser without interfering with the display of the user's originally requested primary data". This was not the type of task given to an "advertising specialist", but to the engineer or programmer to solve in the context of the technology of the web browser and the corresponding hardware environment, as it required technical knowledge and understanding of the functions and the behaviour of the technology of displaying data in a web browser of a mobile device. It was "a genuine technical task". The fact that the secondary content related to advertising did not matter at all in the present application; the secondary content could also be something else, e.g. a warning content or any other content linked with the primary content or even technical content addressed to the user. The invention was not directed to (the type of) the content itself.

The appellant agreed that the "technical hardware" on which the "inventive method" was performed was *per se* known. However it pointed out that the fact, that the relevant skilled person was a computer programmer did not indicate that the claimed invention was non-technical. No user interaction or reaction to the displayed information was necessary to carry out the invention. Reference was made to T 1741/08.

According to the appellant, nearly every single instance of pop-under advertising found in the literature or in patent applications since the late 1990s worked essentially in the same way. A request was made from a user device to a server, in response to which the server delivered content (such as an advertisement) and instructions specifying that the content should be opened (1) in a new browser window, and (2) "under" the already-open browser window, in the sense that the already-open browser window remained the visible window and the new window could not be seen unless the already-open window was closed, diminished, sent to the background or put out of focus in some other way. In other words, according to the appellant, the secondary web page content (with advertising content) would conventionally appear in a new browser window as pop-under, whereas the primary first web page would appear in the initial browser window. The prior art considered pop-under advertising in general, "no less annoying" to the user than pop-up advertisements. For pop-up advertisements, the advertising content appeared in the new browser window that automatically became active and was presented to the user.The conventional use of pop-under/pop-up advertisements in the new browser window would have taught away from the invention. In particular, according to page 1, penultimate paragraph, in conventional browsers of

mobile phones, a new/second tab became automatically the active tab and so, the conventional way (of opening the advertisement in the second tab) would not result in pop-under but in pop-up. The invention aimed also at solving this problem.

Moreover, in the present invention, it was the client's own device, rather than the server, which controlled both the insertion of additional content and the restriction that it should initially be displayed out of focus, in the manner of a pop-under, in an out-of-focus tab within the existing browser window, rather than in a new window according to the conventional way. This interrupted the ordinary functioning of the client device until this process was completed. The interaction with the device's operating system in order to to prevent concurrent operation was a technical feature which made the use of a computing device inherent to the invention. The claimed method was different from known methods of providing pop-under advertising, and no references had been found in the state of the art that would have anticipated it or rendered it obvious.

Finally, the appellant also recalled that a corresponding US Patent had been granted with an essentially identical independent claim. The EPO should under the PPH program "not apply an evaluation of inventiveness which is in direct contradiction with the sophisticated US-standards".

3.3 The board is of the view that the subject-matter of claim 1 lacks an inventive step.

3.3.1 At the priority date of the present application, a mobile communication device as used in the method of

claim 1 was notoriously well known, said mobile communication device (e.g. a smartphone) including a microprocessor, a user input mechanism (e.g. a touch screen), means for mobile access to a communication network (e.g. the Internet) and a graphical user interface (e.g. a display) on which is displayed a mobile web browser under the control of the microprocessor, wherein the mobile web browser supports multiple browser tabs. The appellant agreed that such hardware was known.

At the same date, clickable URL links being associated with source content of a web page were also known. It was, therefore, notoriously well known that a user of a smartphone could open a web page containing an URL link in a first browser tab and that the user could click on said URL link to open an associated web page in a second browser tab. Using a wording close to the wording of features (e) to (h), the steps of 1) receiving from a user of the mobile communication device a request for source content containing a URL link, said URL link being associated with source content of a primary web page, 2) transmitting to the user the source content for viewing in a first browser tab of the mobile web browser and 3) receiving from the user of the mobile communication device a request for the source content associated with the URL link and 4) opening a second browser tab and transmitting said primary web page directly associated with the URL link for viewing in the second browser tab were thus notoriously well known, see e.g. D3, page 2, last four lines to page 3, line 2 (underlining by the board): "Links can most often be opened in several modes, using different user interface options and commands: in a new main window, in the same main window and tab panel, in the same main window and a new tab panel, which is

instantly activated, in the same main window and a new tab panel, which remains in the background until the user switches to it."

The board considers further that displaying advertising content after clicking on an URL link was notoriously well known at the priority date of the application, as well. It was also known to position said content hidden from view by the user of the mobile communication device ("pop-under advertising"), see the appellant's letter dated 8 March 2022.

3.3.2 From this prior art, the subject-matter of claim 1 differs by the steps of identifying at least one URL link to which it is desired to add an advertising functionality and adding the advertising functionality to the at least one URL link to create at least one modified URL link, wherein selection of the at least one modified URL link results in opening both a primary first web page directly associated with the at least one URL link clicked by the user and a secondary second web page, which is transmitted for viewing in the first browser tab which is positioned hidden from view by the user of the mobile communication device. In other words, what distinguishes the method according to claim 1 from the prior art is that, when a user clicks on a modified URL link in a first web page presented in a first browser tab, a web page with advertisements ("secondary second web page") appears in said first browser tab, wherein the "primary web page" directly associated with the URL link is shown in a second browser tab.

3.3.3 As claim 1 is directed to a method for providing advertisements on a mobile communication device, the board understands that the "secondary second web page"

corresponds to advertising content, i.e. cognitive content. The appellant's argument that the secondary content might be other technical information useful for the user or a warning message is not followed, because claim 1 is clearly directed to a "method for providing advertisements on a mobile communication device" and an "advertising functionality" is added to an URL link.

3.3.4 Contrary to appellant's position, the board is of the view that the decision to display the primary web page in a second browser tab and the advertising content in the hidden first browser tab (instead of displaying e.g. both in the first or in the second browser tab) is not related to any technical problem, but merely relates to the manner in which cognitive content is conveyed to the user on a display of their mobile device. As a user is normally more interested in the content of the primary web page than in the advertising content, the distinguishing features aim at improvements regarding the way information is perceived or processed by the human mind (of the user). They do not produce any technical effect e.g. by credibly assisting the user in performing a technical task by means of a continued and/or guided human-machine interaction process.

The distinguishing features only relate to a way of presenting advertisements - a cognitive content - to a user in accordance to what the examining division identified as non-technical features of claim 1 (see the paragraph bridging pages 4 and 5 of the examining division's annex to the summons to the oral proceedings dated 20 March 2018). No further technical effect within or outside the mobile communication device is achieved. No technical problem is solved by the mixture of technical and non-technical features of claim 1 so

that it cannot be said that a "strong link" exists between them. The board shares the examining division's view that the fact that the non-technical aspects of advertising are performed by the web browser of the mobile device does not necessarily indicate that there is an interaction between these technical and non-technical aspects (see also T 1670/07, cited by the appellant). Decisions G1/04, T 603/89 (item 2.5), T 258/03 mentioned by the appellant do not support its view, as they relate to the question of exclusion from patentability. Neither the examining division nor the board argued that the claimed method would be excluded from patentability (Article 52(2) and (3) EPC).

Contrary to the appellant's view, claim 1 does not specify that the mobile communication device (i.e. the "client's own device") controls the insertion of additional advertising content. Neither the claim not the application as a whole provide any indication that that the ordinary functioning of the client device, i.e. the opening of a primary web page and its presentation of a user, is interrupted.

3.3.5 Thus, the appellant's formulation of the technical problem (see page 7 of the statement setting out the grounds of appeal, first paragraph) does not convince the board. Displaying a secondary web page with advertising content in the first browser tab, wherein the primary web page is displayed in a second browser tab is not more than a strategy of how to display advertisements (i.e. an advertising display strategy or policy). This advertising display strategy does not solve any technical problem or involve any technical considerations, i.e. it does not relate to any technical features.

Hence, by including the non-technical features of claim 1 in its formulation (see T 1892/10, item 4, cited by the appellant), the objective technical problem can be seen as how to implement said advertising display strategy.

3.3.6 The board shares the examining division's view that a skilled person (i.e. a computer programmer), having received the advertising display strategy to be implemented, would use normal programming skills to modify a given URL link so that an advertisement web page appears when the user clicks on the modified URL link. It would be obvious to use the first browser tab for this purpose.

3.3.7 The appellant's argument that pop-under and pop-up advertisements were known since the 1990s and considered as "annoying" does not support the presence of an inventive step based on positioning advertising content hidden from the user, i.e. in the manner of a pop-under advertising in a hidden browser window or browser tab. The board is not convinced that presenting advertising content hidden from the user, which is "annoying" to the user and does not provide any technical effect or any solution to a technical problem, would imply the presence of an inventive activity.

As stated in points 3.3.1 above, it was already known to present the content of a primary web page in a newly opened second browser tab that becomes instantly activated. The decision to display advertising content in the hidden first browser tab relates to the advertisement display policy to be given to the skilled person for implementation, see points 3.3.4 and 3.3.5

above. In any case, it is an obvious choice for the skilled person when asked to implement said policy.

3.3.8 Regarding the appellant's argument related to the Patent Prosecution Highway (PPH) programme, the board notes that the present application does not appear to have been subject thereof. The board also notes that the PPH programme between the IP5 Offices enables an applicant whose claims have been determined to be patentable/allowable by one of the participating patent offices to have a corresponding application filed with a PPH partner office processed in an accelerated manner, while at the same time allowing the offices involved to exploit available work results (OJ 2016, A106 section II, first paragraph, now replaced by OJ 2019, A106). The PPH programme does not discharge the EPO from reaching its own decision as to whether or not an invention fulfils the requirements of the EPC, which may differ from those of the legal texts of other jurisdictions. Decisions of other patent offices, possibly taken on the basis of different claim versions, are in any case not binding on the board or the EPO.

3.3.9 The appellant also discussed D1 and D2, see the statement setting out the grounds of appeal, page 9, first paragraph. However, the contested decision did not base its findings on these documents. The board does not see the need to discuss those documents in the context of the present decision, either.

3.3.10 In view of the above considerations, the board concludes that the subject-matter of claim 1 does not involve an inventive step in the sense of Article 56 EPC.

4. Auxiliary request - admission (Article 12(4) RPBA 2007)

Claim 1 of the auxiliary request corresponds to claim 1 of the main request, wherein the URL is no longer an URL to which it is desired to add an advertising functionality and wherein an advertising functionality is added to a created modified URL. Instead, the method comprises the step of "creating at least one modified URL link as added functionality to the at least one URL link".

According to the statement setting out the grounds of appeal, the auxiliary request was filed to address "some of the clarity objections" raised by the examining division against the main request. The clarity issues were known to the appellant from the summons to attend oral proceedings dated 20 March 2018 and were also mentioned in shorter form in the communication dated 15 May 2017. Thus, the appellant could and should have filed the auxiliary request during the examination procedure. The appellant had several occasions to discuss and file the auxiliary request (after the communication dated 15 May 2017, in the first statement setting out the grounds of appeal, after the summons to attend oral proceedings dated 20 March 2018).

Moreover, the board has doubts whether the amendments made to claim 1 meet the requirements of Article 123(2) EPC. Throughout the application as originally filed, an URL is identified and modified by adding an advertising functionality. Moreover, the feature "creating at least one modified URL link as added functionality to the at least one URL link" suggests that the modified URL link is the "added functionality", whereas, according to claim 9 as originally filed, the (advertising)

functionality is added to an URL link to obtain a "modified" URL link (see also board's communication dated 8 September 2021, the paragraph bridging pages 12 and 13).

Finally, the appellant has not indicated the reasons why the auxiliary request overcomes the objections under Articles 84 and 56 EPC raised by the examining division against the main request. The requirements of Article 12(2) RPBA 2007 (in combination with Article 25(2) RPBA 2020) are therefore not met.
Anyhow, as also acknowledged by the appellant during the oral proceedings before the board (see minutes, paragraph bridging pages 1 and 2), the amendments made to the auxiliary request do not overcome the objections raised under Article 56 EPC against claim 1 of the main request.

Under the above considerations, the board decided to not take into account the auxiliary request in accordance with Article 12(4) RPBA 2007 (in combination with Article 25(2) RPBA 2020).

5. As no allowable request is on file, the appeal must fail.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar: The Chair:

S. Sánchez Chiquero M. Papastefanou

Decision electronically authenticated