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Datasheet for the decision
of 25 September 2005

Case Number: T 0153/05 - 3.2.04

Application Number: 01935704.5

Publication Number: 1284798

IPC: A63F 13/10

Language of the proceedings: EN

Title of invention:
Providing advertising with video games

Applicant:
INTEL CORPORATION

Opponent:
-

Headword:
-

Relevant legal provisions:
EPC Art. 56, 83

Keyword:
"Sufficiency of disclosure (yes)"
"Inventive step (yes)"

Decisions cited:
-

Catchword:
-

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Case Number: T 0153/05 **-** 3.2.04

D E C I S I O N
of the Technical Board of Appeal 3.2.04
of 25 September 2005

Appellant: INTEL CORPORATION
                            2200 Mission College Boulevard
                            Santa Clara, CA 95052   (US)

Representative: Niederkofler, Oswald
                            Samson & Partner
                            Widenmayerstraße 5
                            D-80538 München   (DE)

Decision under appeal: **Decision of the Examining Division of the**
                            European Patent Office posted 29 September 2004
                            refusing European application No. 01935704.5
                            pursuant to Article 97(1) EPC.

Composition of the Board:

Chairman: M. Ceyte
Members: A. De Vries
                 T. Bokor

Summary of Facts and Submissions

I.   The appellant lodged an appeal, received at the EPO on
        1 December 2004, against the decision of the Examining
        Division notified by post on 29 September 2004,
        refusing the European patent application
        No. 01 935 704.5 filed as an international application
        PCT/US01/16224 and published under the international
        publication number WO-A-01/91869. The fee for appeal
        was paid simultaneously and the written statement
        setting out the grounds of appeal was filed on
        27 January 2005.

II.   The Examining Division held that the subject-matter of
        the pending claims did not meet the requirements of
        Articles 52 and 56 EPC having regard to the state of
        the art as disclosed in the following documents:

        D1: US-A-5 708 845

        D2: US-A-5 823 879.

III.   Oral proceedings were held on 25 September 2006. During
        the oral proceedings the appellant filed a new set of
        claims and requested as sole request that the decision
        under appeal be set aside and a patent be granted on
        the following documents:

        –   claims 1 to 25 as submitted during the oral
              proceedings of 25 September 2006

        –   description pages 2,2B filed 25 August 2006

-       description pages 2A,3,5,6,8,9 filed during the
        oral proceedings of 25 September 2006

-       description pages 1,4,7 as published

-       figure sheets 1/8 - 8/8 as published.

IV.   The wording of the independent claims 1,12 and 21 of
        the sole request is as follows:

        1. A method comprising:
        recognizing (10) user selections (16) of video game
        image elements (12;14) wherein a hot clickable image
        element (14) is provided as one of the image elements
        (12;14) in a video game;
        displaying (38) an advertising in response to a
        selection (16) of said hot clickable image element
        (14);
        collecting information about image elements that are
        not a hot clickable element but have been mouse click
        selected and providing that information to a web server
        at periodic intervals to enable incorporation of said
        selected image elements that are not hot clickable into
        the video game as image elements that are hot
        clickable;
        and converting at least one of the frequently selected
        image elements that are not hot clickable into the
        video game as an image element that is hot clickable.

        12. An article comprising a machine-readable storage
        medium (62) storing instructions that when executed
        enable a processor-based system (45) to:
        recognize (10) user selections (16) of a video game
        image element (12;14);

provide a hot clickable image element (14) as one of
the image elements (l2;14) in a video game;
display advertising (38) in response to selections (16)
of said hot clickable image element (14);
collect information about image elements that are not
hot clickable but have been mouse click selected and
providing that information to a web server at periodic
intervals to enable incorporation of the selected image
elements that are not hot clickable into the video game
as image elements that are hot clickable;
and convert at least one of the frequently selected
image elements that are not hot clickable into the
video game as an image element that is hot clickable.

21. A system comprising:
a processor (46);
a storage (50) coupled to said processor (46), said
storage (50) storing instructions that enable the
processor (46) to implement a video game, recognize
(10) user selections (16) of video game image elements
(12;14), operate a hot clickable image element (14) as
one of the image elements (12;14) in the video game,
display (36) an advertising in response to selections
of said hot clickable image element (14), collect
information regarding image elements that are not hot
clickable but have been mouse click selected and
provide that information to a web server at periodic
intervals to enable incorporation of the selected image
elements that are not hot clickable into the video game
as image elements that are hot clickable, and convert
at least one of the frequently selected image elements
that are not hot clickable into the video game as an
image element that is hot clickable.

Reasons for the Decision

1.   The appeal is admissible.

2.   *Amendments*

2.1   The board is satisfied that the amendments to the
        claims do not contravene Article 123(2) EPC.

2.2   Claim 1 as filed during the oral proceedings combines
        the features of originally filed claims 1 and 3, while
        incorporating features of the embodiment described on
        page 5, lines 16-32.

        In particular, the added steps of collecting
        information and converting the clickable status of the
        element are based on page 5, lines 17-20, respectively,
        page 5, lines 23-25 and 27 in combination with page 5,
        lines 30-32.

        The deletion of the feature of pausing from claim 1
        with respect to previous versions is allowable as this
        feature was not present in the originally filed
        independent claims, and also does not feature in all
        the embodiments (cf. the embodiment of figure 6).
        Finally, this feature is not functionally related to
        the further features of claim 1.

2.3   Further independent claim 12 is directed at an article
        comprising a machine readable storage medium and is
        based on original claims 13 and 15, while independent
        claim 21 is directed at a system and is based on
        original claims 23 and 25. Both claims include

appropriately worded features analogous to those of
method claim 1 that derive from the embodiment of
page 5.

2.4   The dependent claims 2-9 correspond to originally filed
       claims 4 and 6-12; dependent claims 13-18 correspond to
       original filed claims 16 and 18-22; while dependent
       claims 22-24 correspond to the originally filed
       dependent claims 26, 29 and 30. The remaining dependent
       claims 10,11,19,20 and 25 are based on page 3,
       lines 17-30.

2.5   Furthermore, the description has been brought into
       conformity with the amended claims and includes
       citations of the prior art documents D1 and D2.

3.   *Sufficiency of Disclosure*

       The Board is satisfied that the claimed invention is
       disclosed in a manner sufficiently clear and complete
       for it to be carried out by a person skilled in the
       art. In particular, as regards the feature of
       collection of information the Board holds that the
       skilled person will, firstly, understand the term
       "image elements that are **not** hot clickable" used
       therein, and, secondly, is able to directly and
       unambiguously derive at least one mode of
       implementation of this feature from the original
       disclosure using common general knowledge.

       As argued by the Appellant, the term "not hot clickable
       image element" is contextually clear in distinguishing
       these elements from those that *are* hot clickable, where
       the term "hot" is commonly used in the present context

to denote hyperlinking, see the definition of "hot clickable" given on page 3, lines 9 to 12. Thus, the "not hot clickable image elements" are those that are not so hyperlinked. The manner in which collection of information about such elements when mouse click selected is realized, is in part inferable from figures 3, 6 and 7, where steps 32, 82 and 96, respectively, presuppose the existence of predefined objects prior to determining whether the object is hot clickable or not. D1 in fact shows such predefined elements in the form of the list of N-data of image elements of interest for hyperlinking. Collection of the required information is then realized by comparison of the cursor coordinates upon occurrence of a mouse click with the image element's coordinates in a manner which is routinely practised in the field, i.e. belongs to the common general knowledge in the present field.

4.   *Inventive Step*

4.1   Document D2 is considered to disclose the closest prior art for the reasons set out below:

This document, see abstract, relates to an interactive gaming scheme, which may be played via the internet, and which, see column 24, lines 19-22, displays advertising in response to selection of hyper-linked image elements. Advertising is furthermore provided selectively to a given player in dependence of that player's user profile, see abstract, while column 23, lines 48-59, considers re-evaluating user profiles with the aim of changing the particular selection of advertising by commencing or ceasing transmission of advertising. From this it may be inferred that D2 also

considers adding (or deleting) advertising, which may
be accessed via hyperlinked image elements, or in other
words, with adding hyperlinks. D2 is thus concerned
with a similar purpose and effect as the present
invention, which also seeks to add hyperlinks see
page 5, final paragraph. For this reason D2 is
considered as the most relevant prior art for assessing
inventive step.

4.2   The method of present claim 1 differs from this known
       method in the following features:

       –   collecting information about image elements that
            are not a hot clickable element but have been
            mouse click selected and providing that
            information to a web server at periodic intervals
            to enable incorporation of said selected image
            elements that are not hot clickable into the video
            game as image elements that are hot clickable;

       –   and converting at least one of the frequently
            selected image elements that are not hot clickable
            into the video game as an image element that is
            hot clickable.

       In the scheme of D2 addition can be decided, as noted
       above, on the basis of re-evaluated user profiles,
       which are in turn determined on the basis of data
       pertaining to selection of *existing* advertising
       presentations, e.g. by collecting statistical data on
       advertisement viewing (which advertisement has been
       viewed and when, how often, or how long), or by
       evaluating user queries or responses to queries, see
       column 25, lines 15-23 and 61-66, and column 26,

lines 56 to 65. The latter passage indicates that this
may take the form of monitoring activation, i.e.
selection of an *existing* hyperlinked image element,
column 26, lines 61-62. D2 can thus be seen to collect
data on selection of linked ("hot clickable") image
elements, rather than non hot clickable elements as
claimed. Moreover, D2 is not specific on how adding
takes place, and thus includes all manners of addition,
e.g. incorporation of a completely new, hyperlinked
image element, or alternatively using a (non-linked)
pop up window.

4.3   These differences have the effect of linking a not yet
        linked image element on the basis of selection of that
        element itself. This allows an owner to respond to user
        requests (for information) that he will not have
        anticipated. This is in turn motivated by his desire to
        supply additional goods and services (page 5,
        lines 27-30) and ultimately improve "commercialization
        of the economic value generated from these games"
        (page 2, lines 5-6). Within the wider framework of this
        aim and based on the above effect the following
        technical problem may be formulated: *how to add
        hyperlinks in response to non-anticipated requests.*

4.4   The claimed solution is not disclosed in any of the
        cited documents, nor does the Board consider it an
        obvious further modification of any of these documents'
        teachings based on the skilled person's common general
        knowledge.

4.4.1   In particular, none of the disclosed documents
        considers focusing on the (frequency of) selection of
        the *non-linked* image elements as a means of determining
        which additional elements need to be hyperlinked.

        (a)   D2, as noted, is interested only in *existing*
              advertising, and bases subsequent adaptations
              solely on advertising, and thus links, which were
              initially *foreseen* as of interest. It effectively
              teaches to extrapolate or predict future
              adaptations on the basis of usage of such
              existing, foreseen elements, as opposed to the
              claimed invention which seeks to measure
              unforeseen demand. This applies equally to
              addition and deletion of hyperlinks as derivable
              from column 27, lines 24-25 in conjunction with
              column 26, lines 58-65.

        (b)   Further relevant document D1, which also describes
              an interactive video game with hyperlinking of
              image elements to adverts (see e.g. column 8,
              lines 55-67), describes the use of a list of
              N-data comprising a set of predefined image
              elements of likely interest to a programmer (see
              column 7, lines 18-25). When first designing a
              given hyperlinked video game program a programmer
              chooses elements from the links. The list may also
              obviously be used for subsequent updates of a
              program, i.e. elements that were initially not
              selected and thus unlinked nevertheless remain of
              interest for a subsequent update. However, it is
              not derivable from D1 which method or criteria
              might be used to determine which of these
              predefined, unlinked elements are to be selected

for subsequent linking. D1, therefore at best suggests the non selected items of the N-data list as candidates for subsequent linking, but fails to indicate any criteria or any mechanism by which an item might be selected from this list.

4.4.2   The Board also does not consider the claimed solution obvious having regard to common general knowledge of the skilled person. Thus, the approach of the claimed invention which may be regarded as seeking to *measure* unforeseen demand of an item *itself* (via its selection), in the view of the Board, represents too significant a departure from that of in particular D2 by which the demand is *extrapolated* from the usage of *other* elements. D1, which does not develop any approach in this regard, is even further removed.

4.4.3   Even if D1 and D2 are combinable as matter of obviousness, such a combination does not result in the subject-matter claimed. In particular, where D2 is silent on how to add a link, the skilled person would as a matter of obviousness consult D1, where the list of N-Data suggests use of its elements for hyperlinking. Alternatively, D1 could be used as a starting point : where D1 is silent on the criteria for selecting a new element for hyperlinking from the list of N-data (when updating an existing video program, see above), D2 provides an obviously suitable such set of criteria. In such an obvious combination data as to usage of existing links will be collected as taught by D2, and then used to select new links from a set of potential candidates for linking as taught by D1.

4.5   From the above the Board concludes that the method
       according to claim 1 involves an inventive step in the
       sense of Article 56 EPC as required by Article 52(1)
       EPC.

4.6   The same conclusions hold for independent claims 12 and
       21 which incorporate the steps of the method of claim 1
       in the form of corresponding instructions of an article
       with machine readable storage medium, respectively a
       system with processor and storage. These claims also
       meet the requirements of Article 52(1) EPC in
       conjunction with Article 56 EPC.

4.7   Finally, the dependent claims 2 to 11, 13 to 20 and 22
       to 25, which concern particular embodiments of the
       invention also meet the requirements of Article 52(1)
       EPC.

Order

For these reasons it is decided that:

1.   The decision under appeal is set aside.

2.   The case is remitted to the first instance with the
        order to grant a patent on the basis of the documents
        stated in section III above.

The Registrar   The Chairman

G. Magouliotis   M. Ceyte

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