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**Datasheet for the decision
of 13 March 2018**

Case Number: T 1919/12 - 3.5.01

Application Number: 08775543.5

Publication Number: 2179387

IPC: G06Q30/00, G06Q90/00

Language of the proceedings: EN

Title of invention:

DELIVERY OF ADVERTISEMENTS IN MOBILE ADVERTISING SYSTEM

Applicant:

Mavenir Systems Oy

Headword:

Delivery of advertisements / MAVENIR SYSTEMS

Relevant legal provisions:

RPBA Art. 13(1)

Keyword:

Admissibility of sole request (no - diverging and prima facie unallowable subject-matter)



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Case Number: T 1919/12 - 3.5.01

D E C I S I O N
of Technical Board of Appeal 3.5.01
of 13 March 2018

Appellant: Mavenir Systems Oy
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Decision under appeal: **Decision of the Examining Division of the
European Patent Office posted on 14 May 2012
refusing European patent application No.
08775543.5 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chairman W. Chandler
Members: A. Wahrenberg
C. Josefsson

Summary of Facts and Submissions

I. The appeal is against the decision of the examining division to refuse the European application No. 08775543.5 according to the state of the file using EPO Form 2061.

II. The grounds for the refusal were set out in a communication pursuant to Article 94(3) EPC dated 27 December 2011 (the decision wrongly indicated 25 November 2011 and 27 May 2011). In that communication, the examining division considered that the claimed invention did not involve an inventive step over a notorious mobile communication system (Article 56 EPC). The examining division could not identify any technical effect achieved by the distinguishing features of the invention, which went beyond the mere automation of a non-technical administrative process. This would, however, have been obvious to the skilled person.

III. The following documents were cited in the examining division's communication:

D1 US 2007/067267 A1;
D2 US 2007/038516 A1;
D3 US 2003/208754 A1;
D4 WO 00/77978 A2.

It was mentioned that all the technical features disclosed in the application were known from D1 to D4, but this argument was not developed any further.

IV. In the statement setting out the grounds of appeal, the appellant requested that the decision of the examining

division be set aside and that a patent be granted on the basis of an amended set of claims, which, apart from the numbering, corresponded to the set of claims underlying the impugned decision. The grounds of appeal contained arguments concerning the technical nature of the invention as well as arguments in favour of inventive step over D1 to D4.

- V. In the set of claims filed with the grounds of appeal, claim 1 reads as follows:

A method for delivering advertisements in a mobile communication network (103), the method comprising receiving an advertisement to be delivered to a group of recipients over a certain period of time, **characterized** in that the method further comprises scheduling (401-406) delivery of the advertisement to individual recipients of the group on the basis of one or more indicators of advertisement behaviour, the indicators of advertisement behaviour being specific to individual recipients of advertisements and/or to the overall system, wherein said indicators comprise overall or recipient specific number of advertisements that have already been allocated to said certain period of time, the scheduling comprising

- initializing (401) n time slots to said period of time,
- determining (403) time slot availability for each individual recipient on the basis of said one or more indicators of advertisement behaviour, and
- scheduling (405) each recipient, among the time slots available for said recipient, to the first time slot that is available for said recipient or to the time slot that has smallest number of scheduled recipients, and delivering (407) said advertisement as scheduled.

- VI. In a communication accompanying a summons to oral proceedings, the Board set out its preliminary opinion agreeing with the examining division's conclusion that the claimed invention did not provide any technical contribution over the notorious mobile communication system. The Board did not comment on D1 to D4.
- VII. With a reply dated 12 January 2018, the appellant filed an amended set of claims to be considered in place of the claims previously on file. It was submitted that, because of the amendments, the logic of the conclusion in the Board's communication no longer applied to the new set of claims. The appellant furthermore argued that it would not be appropriate for the Board to refuse the application on the basis of issues that had not been considered at first instance. Therefore, if the Board agreed that the subject-matter of the new claims had the required technical character, but was minded to refuse the application on some other ground (e.g. lack of inventive step over any one of D1 to D4), the case should be remitted to the examining division for further consideration.
- VIII. Claim 1 as amended in reply to the Board's communication reads (the additions over previous claim 1 are underlined and the deletions are struck through):

A method for delivering advertisements in a mobile communication network (103), the method comprising:
receiving an advertisement to be delivered to a group of recipients over a certain period of time,
characterized in that the method further comprises:
intercepting and examining, by a delivery layer (203) of a processing system (500) of an advertising system, a short message service, SMS, message

transmitted from a first user device (101) to a second user device (102) associated with a recipient using the mobile communication network;

determining, by an execution layer (202) of the processing system (500) of the advertising system, an advertisement to attach to the SMS message based on behaviour of the advertising system, the step of determining the advertisement to attach comprising determining a score for each of a plurality of selected advertisements, the score based, at least in part, on a length of a respective advertisement text, wherein the length of the advertisement text determines the total number of SMS message segments required for delivering the SMS message and the respective advertisement attached to the SMS message, and determining a selected advertisement with the highest score to minimize SMS message traffic required for delivering the SMS message and the respective advertisement attached to the SMS message;

receiving, by the delivery layer (203) from the execution layer (202), a first advertisement comprising the selected advertisement to be delivered to a group of recipients comprising the second user device (102) over a certain period of time;

scheduling (401-406) delivery of the first advertisement to individual recipients of the group on the basis of one or more indicators of advertisement behaviour, the indicators of advertisement behaviour being specific to the individual recipients of advertisements and/or to the overall system, wherein said indicators comprise overall or recipient specific number of advertisements that have already been allocated to said certain period of time, the scheduling comprising:

- initializing (401) n time slots to said period of time,

- determining (403) time slot availability for each individual recipient on the basis of said one or more indicators of advertisement behaviour, and

- scheduling (405) each recipient, among the time slots available for said recipient, to the first time slot that is available for said recipient or to the time slot that has smallest number of scheduled recipients, and

attaching, by the delivery layer (203), the first advertisement to the SMS message; and

delivering (407) said first advertisement as scheduled.

IX. One week before oral proceedings were scheduled to take place, the appellant withdrew its request for oral proceedings and requested that a decision be taken "according to the state of the file". The Board nevertheless held the oral proceedings in the appellant's absence.

Reasons for the Decision

1. *Background*

1.1 The invention concerns the delivery of advertisements to a particular user or group of users in a mobile communication system. This involves determining what advertisement to deliver to what user at what time.

For example, it is not desirable to deliver advertisements from conflicting or competing campaigns to the same user at the same time. It is also not desirable to overwhelm a user with a load of

advertisements at the same time (see the published application from page 2, line 30 to page 3, line 9).

Figure 3 illustrates an algorithm for selecting *what advertisement* to deliver to a user. Figure 4 shows an algorithm for scheduling delivery of advertisements, i.e. for determining *when* to deliver the selected advertisement to the user.

2. *Admissibility of the appellant's sole request*

2.1 The appellant's sole request was filed in reply to the Board's communication, i.e. after filing of the grounds of appeal. Its admissibility is, therefore, a matter for the Board's discretion (Article 13(1) RPBA).

2.2 In exercising the discretion under Article 13(1) RPBA, there are a number of criteria to be considered. Apart from those explicitly mentioned in Article 13(1) RPBA (complexity of the new subject matter submitted, the current state of the proceedings and the need for procedural economy), it is also relevant to consider whether the amendment in question represents a development of the case as previously set out, or whether it shifts the focus to new issues. Another relevant criterion is whether the amended request has any prospect of success (Case Law of the Boards of Appeal of the EPO, IV.E.4.4.1).

2.3 The appellant appealed on the grounds that the claims rejected by the examining division provided a technical contribution over the prior art. In the grounds of appeal, the scheduling of recipients to time slots (the *when* in figure 4) was presented as the inventive feature of the invention as defined in claim 1.

Claim 1 as amended in reply to the Board's communication additionally comprises attaching the advertisement to an intercepted SMS message, and determining an advertisement to attach to the SMS message such that the SMS traffic required for delivering the SMS message and the advertisement is minimised. This subject-matter has not previously been claimed; it is taken from the part of the description relating to the algorithm in figure 3 (the *what*).

Although the scheduling (the *when*) and the determining of what advertisement to attach to an intercepted SMS message (the *what*) are both present in claim 1, the Board sees no interaction between the two algorithms. Therefore, the appellant's amendment shifts the discussion from "when" to "what", and the focus is placed on a new effect, namely the minimisation of SMS traffic.

2.4 As stated by the appellant in the grounds of appeal, the amended subject-matter has not been considered by the examining division. Indeed, the appellant argued that the case after amendment was so different from the case considered by the examining division that it would not be appropriate for the Board to deal with it. Therefore, the appellant argued that the Board should remit it to the examining division for further consideration.

2.5 In the Board's view, the appellant's arguments why the Board should remit the case to the examining division are rather reasons for not admitting the request at a late stage in the appeal proceedings. The Board notes that the issue of lack of technical character of the scheduling was mentioned already in the European search opinion. The appellant had at least one opportunity

during examination to amend the claims or provide suitable fallback positions in case the arguments in favour of technical character would not be accepted. Also, the appellant could have filed those amendments with the grounds of appeal.

- 2.6 Another relevant criterion is whether the subject-matter of the amended claims is *prima facie* allowable, i.e. whether the new request has a chance of resulting in a granted patent (Case Law of the Boards of Appeal of the EPO, IV.E.4.4.2).

The Board considers that the subject-matter of amended claim 1 *prima facie* infringes Article 123(2) EPC.

In the application as filed (see page 9, line 21 to page 11, line 21), the aim of the claimed algorithm for selecting an advertisement is to provide "*maximum diversity of advertising content to all subscribers while at the same time maintaining a very tight segmentation and personalization*" (page 11, lines 4 to 6). However, the aim that has been introduced in claim 1, namely that of minimising the amount of traffic required to deliver the original message and the advertisement, is described in the application as filed, on page 11, lines 20 and 21, as a general aim, and not as a direct aim of the algorithm. Moreover, the Board does not see any link, in the application as filed, between the computation of a score for selecting an advertisement and the size of the SMS message.

Therefore, the Board takes the view that the feature "*determining a selected advertisement with the highest score to minimize SMS message traffic required for delivering the SMS message and the respective*

advertisement attached to the SMS message" in claim 1 extends beyond the content of the application as filed.

2.7 For these reasons, the Board does not admit the appellant's sole request. As a consequence, the appeal must be dismissed.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:



T. Buschek

W. Chandler

Decision electronically authenticated