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**Datasheet for the decision
of 19 November 2021**

Case Number: T 1227/17 - 3.5.01

Application Number: 12783107.1

Publication Number: 2786326

IPC: G06Q10/10

Language of the proceedings: EN

Title of invention:

METHOD AND APPARATUS FOR DISPLAYING E-MAIL MESSAGES

Applicant:

Unify Patente GmbH & Co. KG

Headword:

E-mail read status indication/UNIFY

Relevant legal provisions:

EPC Art. 56

Keyword:

Inventive step - setting read flag when both message and attachment have been opened (no - administrative rule)

Decisions cited:

T 0641/00



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Case Number: T 1227/17 - 3.5.01

D E C I S I O N
of Technical Board of Appeal 3.5.01
of 19 November 2021

Appellant: Unify Patente GmbH & Co. KG
(Applicant) Otto-Hahn-Ring 6
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Decision under appeal: **Decision of the Examining Division of the
European Patent Office posted on 16 December
2016 refusing European patent application No.
12783107.1 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chairman W. Chandler
Members: A. Wahrenberg
Y. Podbielski

Summary of Facts and Submissions

I. The case concerns the applicant's appeal against the examining division's decision to refuse European patent application No. 12783107.1 (published as WO 2014/056516 A1) on the grounds of lack of clarity (Article 84 EPC), added matter (Article 123(2) EPC), and lack of inventive step (Article 56 EPC).

II. The appellant requested that the decision to refuse the application be set aside and that a patent be granted on the basis of the main request or one of the first to third auxiliary requests, all submitted with the grounds of appeal. The grounds of appeal also contained auxiliary requests A and B.

III. Claim 1 of the main request reads:

A method for displaying e-mail messages on a display (1) to a user of an e-mail message viewer, the method comprising:

a) displaying a list of received e-mail messages (1) with a list entry (4) for each received email message;

b) displaying binary information indicating the read/unread status of each received email message in the list;

characterized by

c) using a software running on a user's personal computer or other personal information technology

equipment or on a provider's information technology equipment, which is permanently monitoring texts or more generally contents displayed to the user when reading his received messages and automatically comparing these displayed texts and contents with contents of other e-mails received by the same user;

d) switching the read/unread status information of each received first email message from "unread" to "read" by said software when the text and attachments of this particular first e-mail message have been displayed at least partially to the user when opening this particular first e-mail message;

e) switching the read/unread status information of each received second email message from "unread" to "read" by said software when the text and attachments of this particular second e-mail message have been displayed at least partially to the user when opening a particular first e-mail message.

IV. Claim 1 of the first auxiliary request replaces "at least partially" with "completely" in features d) and e).

V. Claim 1 of the second auxiliary request adds the word "earlier" before "received second e-mail message" in feature e), and new feature f):

including attachments of earlier e-mail messages or references, e.g. a link or hyperlink, to such attachments in a later e-mail message, so that all the information contained in a chain of e-mail message exchanges between several users in a user's e-mail message box, including incoming and outgoing e-mail messages, is included in a later e-mail message, so

that a user can easily access all attachments appearing in any message of such a chain of e-mail message exchanges between several users easily by opening a later or the last message of a mail thread belonging to the same issue or topic.

VI. Claim 1 of the third auxiliary request further adds the following feature:

g) hiding each received second e-mail message when the text and attachments of this particular second e-mail message have been displayed completely to the user when opening a particular first e-mail message

and/or

displaying a reference to or a copy of the text and attachments of a second e-mail message, hidden or displayed as "read" in a first e-mail message, not or only partially containing this text and attachments.

VII. Auxiliary requests A and B are worded as follows:

"Auxiliary request A:

Nevertheless, if the Board should be of the opinion that ... the objected replacement would not contravene Article 123(2) EPC than [sic] it is requested as an auxiliary request A that the word "attachments" instead of the present used word "contents" be retained in line 26, step c) in claim 1 of the main request and all the further auxiliary requests.

...

Auxiliary request B:

As a precaution as an auxiliary request, this general

definition of contents ", i.e. message text and possible attachments," could be incorporated into line 24 after the word "contents" of step c) in claim 1 of the main request and if necessary into all the auxiliary requests filed herewith, which is requested as an auxiliary request B, if auxiliary request A ... would contravene Article 113(2) EPC!"

- VIII. In the communication accompanying the summons to oral proceedings, the Board tended to agree with the examining division that the subject-matter of claim 1 of the main request lacked an inventive step over D6. The same applied for the first auxiliary request. Moreover, the Board was minded not to admit the second and third auxiliary requests into the appeal proceedings. The Board furthermore tended to see auxiliary requests A and B as inadmissible as they had not been clearly defined.
- IX. In response to the communication, the appellant informed the Board that nobody would attend the oral proceedings.
- X. The Board informed the appellant that, since the appellant would not be represented at the oral proceedings, the oral proceedings were cancelled.

Reasons for the Decision

1. *The invention*
- 1.1 The invention concerns the display of e-mail messages (page 1, lines 12 to 13 of the published application).

1.2 E-mail users face the time consuming and sometimes overwhelming task of going through newly received messages (page 4, line 32 to page 5, line 9). The invention aims at facilitating this task by indicating the read/unread status of each e-mail in the list of displayed e-mails (page 5, lines 17 to 22). The status information is changed from "unread" to "read" when the message text and attachments (if present) have been opened (page 5, lines 22 to 26). In this way, the user can keep track of which e-mail messages have been read. For subsequent e-mails having the same content, the flag is automatically set to "read" when the user opens the first e-mail in the series of e-mails (page 5, lines 26 to 31).

2. *Main request, inventive step (Article 56 EPC)*

2.1 Claim 1 of the main request essentially corresponds to the request referred to as the "third highest request" (also called "fifth auxiliary request") in the decision under appeal, apart from "contents" replacing "attachments" in feature c) (see point 2.2 of the grounds of appeal). The examining division found that the subject-matter of claim 1 of this request lacked an inventive step over the disclosure of D6 (US 2010/262922).

2.2 D6 discloses, e.g. in paragraph [0029], a method for displaying e-mail messages comprising the step of determining whether the content of an e-mail that has been displayed to the user is found in other e-mails within the same thread. If this is the case, all the e-mails in the thread are marked as "read".

2.3 It is common ground that the subject-matter of claim 1 of the main request differs from D6 in that the "read"

indication for an e-mail is set when both the message body and the attachments have been displayed at least partially to the user.

- 2.4 The examining division found that this difference was merely an administrative rule defining when an e-mail was to be considered as having been read. The difference did not solve a technical problem, and no further technical effect on the computer system could be established. An inventive step was therefore denied.
- 2.5 The appellant argued that the automatic setting or switching of flags by software was a technical feature as it produced a technical action and solved the technical problem of informing the user that an email message has already been read.
- 2.6 However, D6 already discloses the automatic switching of a "read" flag. In other words, the technical problem argued by the appellant is already solved in the prior art. Thus the Board agrees with the division that the invention distinguishes itself from the prior art by the rule defining when the flag is to be switched. This rule is not based on any technical considerations. It rather reflects an administrative choice or the user's subjective preferences.
- 2.7 Since the distinguishing feature of claim 1 does not solve a technical problem by providing a technical effect, it does not contribute to inventive step under the "Comvik approach" (see T 641/00 and Case Law of the Boards of Appeal, 9th edition, I.D 9.1.3). Thus, in conclusion, the Board agrees with the examining division that the subject-matter of claim 1 of the main request lacks an inventive step over D6 (Article 56

EPC).

3. *First auxiliary request, inventive step (Article 56 EPC)*

- 3.1 Claim 1 of the first auxiliary request differs from the main request in that the status information is switched to "read" when the text and attachment of the first e-mail message have been displayed *completely* to the user. Setting the read flag when the user has viewed the whole message is disclosed in D6 (see e.g. paragraphs [0032] and [0049]). Thus, the first auxiliary request does not add any feature which further distinguishes the claimed invention from the prior art.

Furthermore, the additional feature of the first auxiliary request concerns the same type of administrative rule as the main request. Thus, it would not contribute to inventive step either.

Therefore, the reasons provided with respect to the main request are applicable also to the first auxiliary request.

4. *Second auxiliary request, admissibility*

- 4.1 The second auxiliary request comprises feature f) which corresponds in part to feature f) in claim 1 of the "eighth highest request" (also called "Fourth auxiliary request") that was not admitted by the examining division under Rule 137(3) EPC. In other words, this subject-matter has not been examined by the examining division.

Under Article 12(4) RPBA 2007, the Board has the power

to hold inadmissible requests which could have been presented or were not admitted in the first instance proceedings. In the Board's view, this is such a request. The purpose of appeal proceedings is primarily a review of the contested decision and not a fresh examination. Indeed, feature f) which is directed to the presentation of the content of e-mails in a thread has little to do with the issues dealt with in the decision under appeal. For these reasons, the Board does not admit the second auxiliary request into the appeal proceedings.

5. *Third auxiliary request, admissibility*

5.1 The Board does not admit the third auxiliary request for the same reasons as given for the second auxiliary request.

6. *Auxiliary requests A and B, admissibility*

6.1 The Board considers auxiliary requests A and B as inadmissible, since they do not depend on the allowability of the main request. Furthermore, the ranking of the requests is not clear, because auxiliary requests A and B each refers to a set of requests. Thus, it is not clear whether the whole set A should be examined after the third auxiliary request, or whether main request A should be ranked after the main request, auxiliary request A after the auxiliary request, and so forth. It is for the appellant to clearly state their requests and to indicate the order in which they are to be dealt with. In the Board's view, this has not been done.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:



T. Buschek

W. Chandler

Decision electronically authenticated