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**Datasheet for the decision
of 31 May 2023**

Case Number: T 0570/20 - 3.5.01

Application Number: 13785029.3

Publication Number: 2846301

IPC: G06Q30/02

Language of the proceedings: EN

Title of invention:
INFORMATION DISTRIBUTION SYSTEM

Applicant:
Dentsu Inc.

Headword:
Information distribution system/DENTSU

Relevant legal provisions:
EPC Art. 56
EPC R. 137(3), 116(1)
RPBA 2020 Art. 12(6)

Keyword:
Inventive step - providing information based on user state (no
- non-technical)
Auxiliary request - admissibility (no)

Decisions cited:

G 0002/88, T 0641/00, T 2469/12, T 0136/13, T 0115/85,
T 0976/97, T 2324/14



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Case Number: T 0570/20 - 3.5.01

D E C I S I O N
of Technical Board of Appeal 3.5.01
of 31 May 2023

Appellant: Dentsu Inc.
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Minato-ku
Tokyo 105-7001 (JP)

Representative: Schwarz & Partner Patentanwälte GmbH
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Decision under appeal: **Decision of the Examining Division of the
European Patent Office posted on 15 October 2019
refusing European patent application No.
13785029.3 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chairman M. Höhn
Members: L. Falò
E. Mille

Summary of Facts and Submissions

- I. This is an appeal against the examining division's decision to refuse European patent application No. 13785029.3.
- II. The application was refused on the ground of lack of inventive step (Article 56 EPC) over notoriously known technical means.
- III. 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 the main or of the auxiliary request, both re-filed therewith and corresponding, respectively, to the refused main request and to the first auxiliary request presented, but not admitted, during the oral proceedings in examination. The appellant further requested remitting the application to the first instance if formal amendments needed to be fulfilled before the patent could be granted. There was a further auxiliary request for oral proceedings prior to any adverse decision by the Board.
- IV. In the communication accompanying the summons to oral proceedings the Board set out its preliminary view that the main request did not involve an inventive step and that it was minded not to admit the first auxiliary request into the appeal proceedings.
- V. The appellant informed the Board that it would not attend the oral proceedings in a letter dated 9 September 2022. The oral proceedings were subsequently cancelled.

VI. Claim 1 of the main request reads:

"An information delivery server capable of communicating with a terminal device, the information delivery server comprising:

a history information recording section that records, as user history information, information on a location and a time of the terminal device when an access request is transmitted from the terminal device to the information delivery server;

a state database forming section that analyzes the user history information for a predetermined analysis time period, and forms a state database in which combinations of locations and times of the terminal device are associated with states of a user of the terminal device; and

an action pattern analysis section that analyzes a pattern of actions of the user of the terminal device on the basis of the state of the user and the location and the time of the terminal device when the access request is made; wherein

the state of the user includes a first state with a tendency to select information for working with priority over information for amusement, and a second state with a tendency to select information for amusement with priority over information for working, and wherein

the information delivery server further comprises:

a receiving section that receives information on a present location of the terminal device; and

an information delivery section that determines whether a present state of the user is the first state or the second state on the basis of the present location and time of the terminal device and delivers to the terminal device information according to the present state of the user and the pattern of actions of the user".

VII. Claim 1 of the auxiliary request differs from the main request by the addition, at the end of the claim, of the expression:

"wherein the state database forming section converts information on the location and the time of the terminal device into information on a kind of area and a kind of time and forms the state database by associating the combination of the kind of area and the kind of time with the state of the user".

VIII. The appellant's arguments can be summarised as follows:

The examining division failed to properly take into account and apply the current case law in respect of "mixed-type inventions" (the so-called "Comvik approach"). Forming combinations of locations and time was *per se* technical and, moreover, associating these combinations with the states of the user provided the users with state-based information or, alternatively, avoided the need for users to manually input their state into the terminal device.

The closest prior art was document D1. Starting from this document, the objective technical problem was "*to more accurately send messages to the user and to*

implement this solution in such a way that is convenient for the user".

The examining division should have admitted the auxiliary request under Rule 116 EPC because it selected a "computerised system" as closest prior art for the first time during oral proceedings, thereby changing the subject of the proceedings.

Reasons for the Decision

1. The invention concerns a system for selecting information, for example advertisements, to be provided to the users of mobile terminals. If the selection is only based on the users' position, different users in the same area will generally receive the same information (description, paragraphs [0002] to [0005]). The goal of the invention is to better tailor the information provided to the users' needs. To achieve this, a server stores users' information access requests associated with their position and the time at which the request was received. The server makes use of this information, called "user history information", to determine a "state of the user" for a given combination of time and location depending, for example, on whether a user tends to prefer work-related information over amusement-related information. The server also determines an action pattern for the users based on their state, position and location. Finally, the server selects the information to be provided based on the users' present state and action pattern (paragraphs [0006] and [0007]).
2. The examining division refused the application for lack of inventive step (Article 56 EPC) in view of a

notoriously known, general-purpose networked computer. Documents D1 (JP 2002 342367), D2 (JP 2007 233946), D3 (JP 2009 251743) and D4 (JP 2009 251743), were cited as examples of the use of such well-known technology in a similar context.

Main request - inventive step

3. Claim 1 essentially defines a computer server providing information to a user terminal, based on the received terminal location and on user history information.
4. The content of the information provided is cognitive data and does not have a technical significance. It may consist, for example, of advertisements (see description, paragraph [0017]).
5. The selection of the information is based on heuristic, subjective criteria, the formulation of which does not require any technical knowledge or skills. In particular, the "state of the user" represents a tendency of the user to prefer some types of information, for a given time and place, and is determined through a statistical analysis of the cognitive content of the user's past information access requests. The "pattern of action" represents an assessment of users' current activities, based on their state.

The overall effect is to provide users with non-technical information matching their estimated interests and course of action. In the Board's view, this is not a technical purpose and does not credibly solve any technical problem (see, for example, decisions T 2469/12 - *Generating a subgroup of media items/MICROSOFT TECHNOLOGY LICENSING*, point 6.2 and

T 136/13, *Location-based advertising/LOCATOR IP*, point 3.6).

6. The appellant argued that forming combinations of locations and time was *per se* technical and that, following decision T 115/85, associating these combinations with the states of the user made a technical contribution.

The Board is not convinced by these arguments. A combination of locations and times may have a purely administrative relevance, like for example in the case of a work schedule.

In the context of the invention, time and location are associated in the state database with the user state, which indicates whether a user has shown a tendency to select work-related over leisure-related information, or *vice versa*. This information does not concern "conditions prevailing in an apparatus or system", as in the case at issue in T 115/85. It merely reflects the user's past choices for a given time and place and provides, at most, a heuristic estimate of the user's preferences, which does not have a technical significance.

7. The appellant also argued that a technical contribution derived from the fact that the server was able to determine the state of the users based on time and location information, thereby avoiding them having to manually input their state into the terminal device. Also the invention, when compared with D1, enabled "*to more accurately send messages to the user and to implement this solution in such a way that is convenient for the user*".

The Board finds also these arguments unconvincing.

Any increase in the "accuracy" and "convenience" of the information depends on the user's subjective preferences, and cannot be considered a credible and objective effect of the claimed subject matter. As discussed above, determining the "state of the user" in the manner set out in claim 1 represents a heuristic, non-technical manner of estimating said preferences. Hence, in the Board's view, the invention does not solve the technical problem of reducing or avoiding user interaction; rather, it circumvents the problem by replacing the user input with a non-technical algorithm.

8. Another argument was that the examining division failed to properly take into account and apply the current case law in respect of "mixed-type" inventions (the so-called "Comvik approach"), as it based its reasoning on older decisions (in particular, G 2/88).

The Board disagrees. Even though the "Comvik approach" is never mentioned *expressis verbis*, the decision is consistent with its basic principles, namely that only those features which contribute to the solution of a technical problem by providing a technical effect may contribute to the assessment of inventive step, and that the non-technical features which make no technical contribution may be considered as part of the problem to be solved, in particular as requirements or constraints (see decision T 641/00, *Two identities/COMVIK*, Headnote).

The examining division correctly applied these principles by identifying the features which make a technical contribution, formulating, at least

implicitly, an objective technical problem in terms of an automation task assigned to the skilled person, and assessing the inventiveness of the solution (see decision, points 13 to 16).

9. Accordingly, the Board agrees with the contested decision that a networked computer is the only technical feature of claim 1 and a suitable starting point for assessing inventive step.

Said computer implements, in a straightforward manner, a non-technical scheme for delivering information to users.

In the absence of any technical effect going beyond the mere automation of the scheme, the Board concludes that claim 1 lacks inventive step (Article 56 EPC).

10. In the statement of grounds, the appellant argued that document D1 should be selected as closest prior art.

The Board observes that, in general, one starting point suffices for arguing lack of inventive step (see for example decision T 967/97, *Chipkarte/OVD KINEGRAM AG*, Catchword II). As the Board concluded that claim 1 is not inventive in view of notoriously known technical means, it is not necessary to repeat the assessment of inventive step starting from documentary evidence.

Auxiliary request - admissibility

11. The auxiliary request was not admitted into the examination proceedings under Rule 137(3) EPC. According to Article 12(6) of the Rules of Procedure of the Boards of Appeal, the Board shall not admit requests, facts, objections or evidence which were not

admitted in the proceedings leading to the decision under appeal, unless the decision not to admit them suffered from an error in the use of discretion or unless the circumstances of the appeal case justify their admittance.

12. The examining division decided not to admit the auxiliary request because it was deemed *prima facie* not suitable to overcome the objections of lack of inventive step, and provided arguments in this respect (see decision, points 18 to 20). The Boards of Appeal have generally accepted that the examining division may base its consent to an amendment on *prima facie* considerations and, in particular, that consent may be denied in case of *prima facie* deficiencies (see for example decision T 2324/14, point 2.2.).

13. The appellant argued that the request should have been nonetheless admitted under Rule 116(1) EPC, because the subject of the proceedings had changed. In particular, the examining division had stated for the first time during the oral proceedings that the closest prior art was a "computerised system", even though the preliminary examination report had assessed inventive step starting from document D1 and there had been no explicit indication, during the written examination procedure, that this document was no longer regarded as "closest prior art". Moreover, the fact that the division had discussed, in the communication of 16 August 2019, the technical effects of the differentiating features of claims 1 and 4 over D1 had led the appellant to believe that this document was still considered the starting point for assessing inventive step. The submission of the request was thus a reaction to the unexpected introduction of new prior art, namely the "computerised system".

14. The Board takes a different view. Already in its first communication, dated 16 March 2018, the examining division stated that *"the only identifiable technical aspects of the claimed invention relate to the use of conventional, general-purpose computers"*, for which no documentary evidence was considered necessary (points 2.1 and 2.2), adding that the applicant could still refer to the documents cited in the search report, as they showed the application of such known technology in a similar context (point 2.2). The same arguments were reiterated in the annex to the summons to oral proceedings (points 2.1 and 2.2). Throughout the examination proceedings, the reasoning of the division *in puncto* inventive step did not rely on any documentary evidence. In the communication of 16 August 2019 the examiner merely replied to the arguments put forward by the applicant in his submission of 10 July 2019. Finally, in the minutes of the oral proceedings there is no indication that the auxiliary request has been filed in response to a perceived surprising change in the choice of the closest prior art.

The Board is therefore of the opinion that the examining division made sufficiently clear, during the written procedure, that the main request was considered not inventive over a conventional, notoriously known general purpose computer, as well as over the disclosure of any of D1 to D4. It follows that the explicit identification of the closest prior art with a "computerised system" during the oral proceedings cannot be considered a change in the subject of the proceedings in the sense of Rule 116(2) EPC.

15. In view of the above, the Board concludes that the examining division correctly exercised its discretion not to admit the auxiliary request. Moreover, the Board cannot identify any circumstance which would justify the admission of the request during the appeal proceedings. The request is therefore not admitted (Article 12(6) RPBA).

Other matters

16. Since there are substantial reasons which prejudice the grant of a patent, remitting the case to the examining division for formal amendments, as requested by the appellant, would serve no purpose.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:



T. Buschek

M. Höhn

Decision electronically authenticated