Appeal Decision

Appeal No. 2019-2439

Appellant   MasterCard International Inc.

Patent Attorney   TANAKA, Mitsuo

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The case of appeal against the examiner's decision of refusal of Japanese Patent Application No. 2017-506832, entitled "SYSTEMS AND METHODS FOR MANAGING GROUP CHATS DURING ECOMMERCE SESSIONS" (International Publication No. WO 2016/022898 published on February 11, 2016, National Publication of the translated version published on August 24, 2017, National Publication of International Patent Application No. 2017-524201) has resulted in the following appeal decision.

Conclusion
        The appeal of the case was groundless.

Reason
No. 1 History of the procedures
        The present application was originally filed on August 7, 2015 (Priority claim: August 8, 2014) as an International Patent Application.   The history of the procedures thereof is as follows.
        dated May 2, 2018   : Notice of reasons for refusal
        October 5, 2018   : Submission of Written opinion and Written amendment
        dated October 24, 2018   : Examiner's decision of refusal
        February 22, 2019   : Submission of Written appeal
        dated March 11, 2020   : Notice of reasons for refusal

July 17, 2020   : Submission of Written opinion

No. 2 The Invention

   The inventions according to Claims 1 to 20 are inventions specified by the matters recited in Claims 1 to 20 of the scope of claims amended by the written amendment submitted on October 5, 2018. The invention according to Claim 1 (hereinafter referred to as "the Invention") is as follows.

"[Claim 1]

   A computer-implemented method for managing a group chat during an ecommerce session, the method implemented using an ecommerce chat server in communication with a memory, said method comprising:

   a step of initiating, by the ecommerce chat server, a chat session between at least a first client computer device associated with a first participant and a second client computer device associated with a second participant;

   a step of sharing, by the ecommerce chat server, at least one view of an ecommerce website with the first client computer device and the second client computer device, wherein

the at least one view of the ecommerce website (i) is received by the ecommerce chat server from the first client computer device and (ii) is transmitted by the ecommerce chat server to the second client computer device, the first client computer device and the second client computer device are configured to display the at least one view of the ecommerce website, and the at least one view includes at least one purchasable item;

   a step of initiating, by the ecommerce chat server, a purchase transaction for the at least one purchasable item included in the at least one view of the ecommerce website;

   a step of receiving payment information for the purchase transaction; and

   a step of completing the purchase transaction based on the payment information."

No. 3 Outline of the notice of reasons for refusal issued by the body

   The outline of the notice of reasons for refusal issued by the body is as follows.

1 The invention according to Claim 1 of this application is an invention described in a publication distributed or described in Cited Document 1 which was made publicly available through an electric telecommunication line, in Japan or a foreign country

before the filing of the application.   Thus, the Appellant should not be granted a patent for the invention under the provisions of Article 29(1)(iii) of the Patent Act.

2 The invention according to Claim 1 of this application could have been easily made by a person ordinarily skilled in the art of the invention before the filing of the application on the basis of an invention described in Cited Document 1 distributed in Japan or a foreign country or made publicly available through an electric telecommunication line before the filing of the application.   Thus, the Appellant should not be granted a patent for the invention under the provisions of Article 29(2) of the Patent Act.

Cited Document 1: Specification of U.S. Patent publication No. 2012/0185355

No. 4 Cited Document

(1) Description of the Cited Document

U.S. Patent publication No. 2012/0185355 (published on July 19, 2012, hereinafter referred to as "Cited Document 1"), which is a cited document cited in the notice of reasons for refusal issued by the body and distributed or made publicly available through an electric telecommunication line before the filing of the application, includes the following description with drawings.   The underlines were added by the body.

A ([0016]-[0021])

Also provided is method of providing an online shared shopping session, comprising the steps of:

providing an online store for access to an initial shopper using a communication device;

providing the initial shopper with a communication interface for inviting one or more additional shoppers to shop at the online store together as a group of shoppers;

sending a message to the additional shoppers invited by the initial shopper over a communication network, such that each one of the additional shoppers can join the group of shoppers by responding to the message, wherein the additional shoppers each participate in shopping at the online store using a communication device distinct from others of the shoppers;

providing each one of the shoppers of the group of shoppers with a link to a shared shopping cart for adding one or more items to the shared shopping cart, such that contents of the shared shopping cart can be viewed by all of the shoppers; and

providing each one of the shoppers with a payment interface, such that more than one of the shoppers contributes payment toward purchase of the items added to the shared shopping cart.

B ([0035]-[0044])

There is further provided a method of providing an online shared shopping session, comprising the steps of:

providing an online shopping mall including a first shopping site and a second shopping site;

registering a plurality of individual shoppers to a shopping group, wherein at least two of the shoppers are accessing the shared shopping session using different communication devices;

providing each one of the shoppers with access to a shared shopping cart for indicating items for purchase by the shopping group from either of the first shopping site and the second shopping site, wherein each one of the shoppers can add items for purchase to the shared shopping cart;

for each one of the shoppers, accepting an individual payment percentage amount indicating a percentage of the total cost of the items to be paid by a corresponding one of the shoppers;

validating that the sum of the individual payment percentage amounts of all of the shoppers totals one-hundred percent;

providing a checkout function to be accessed by each one of the shoppers, wherein for all of the shoppers: each one of the shoppers executes an individual checkout process for receiving payment information from that one of the shoppers, such that subsequent to the individual checkout process, that one of the shoppers has completed the checkout process and has contributed payment toward purchase of the items according to the individual percentage amount corresponding to that one of the shoppers, wherein

when any one of the shoppers first accesses the checkout function, the shared shopping cart is locked such that no more items can be added to the shared shopping cart by any of the shoppers;

when the individual checkout function is completed for all of the shoppers, the sale of the items to the group is completed; and

providing payment to the first shopping site and the second shopping site based on items purchased by the group provided by the respective site.

C ([0090])

Another application for shared shopping functionality would be a shared shopping hosted online shopping mall.   This would entail an entity to host an online mall where a plurality of vendors can transact with customers using the shared shopping features.   A mall in this case should be defined as, but is not limited to, two or more merchants in one area.   This could be online (e.g., one online shopping site), or in an actual physical place (an actual shopping mall or plaza).   Such a place would be defined as a place of business.   Business would be selling goods or services in everyday normal operations.

D ([0093]-[0095])

When shared shopping is extended to multiple connected stores, in particular stores having different, complementary types of merchandise, this constitutes a shared shopping mall.   Shoppers can shop among all stores in a mall before checking out, comparing items among stores, and adding them to a single shared cart until they all have finished shopping.   Shoppers can do this alone, as well as in a shared shopping group.   <u>When the shared shopping mall is extended to include a group communications tool, it becomes a hub for online social activity, by providing texting, chatting, voice, or even video communications tools to enhance the social aspect of the social shopping experience.</u>

...

Other features might include the ability for a customer to log into social networking systems and use chat features. ...

E ([0099])

An important concept in one practical shared shopping approach is the concept of screen sharing, so that shoppers on computers physically remote from each other (and possibly remote from any retail establishment that they may want to patronize) can view common items for discussion and purchase.

F ([0100]-[0103])

Shared carts can be implemented by constructing a separate cart routine.   This would mean duplication of the current cart and would be visible by all individuals in the shopping group.   The final cost of this cart will split among the members of the shopping group in some manner.   When an item is shared between members, the cost of this item can be added to a shopper's individual cart after everyone in that group has purchased the item(s).   The product(s) remain in that temporary cart until payment is

received from all customers, when the product(s) becomes a purchased item for delivery or pickup.

...

Customers can typically pay by cash or credit. The bill can be split based on a combination of those two, cash or credit, on percentages, dollar value, or net realizable value (if it is a replacement item).

...

DEBIT/CREDIT Cards, PayPal or other payment systems, banks and financial institutions, gift cards/certificates, and promotional coupon codes all relate to the payment and can be supported by shared shopping.

G ([0119]-[0125])

Example Methods of Screen Sharing

Screen sharing is a useful method of providing shared shopping functionality. Screen sharing among group members can, for example, be achieved by passing URLs through silent messages between browsers. In essence, if screen sharing is active, the driver browser (the driver is typically the shared shopping session initiator) sends a new URL to all of the passenger browsers (the passengers are the additional members of the shared shopping grout that are not the driver) so that all members of the group can see the page or graphic item represented by the URL. This is processed sequentially, because a driver's browser checks to see if the URL is a page (or other item to be shared) before passing to passengers.

The concept of drawing on a canvas which is used in remote me can also be used - these features use the Java canvas solution. For this method, Java enables a passenger computer to draw exactly what the driver sees on the driver's screen. It keeps track of mouse methods and keyboard actions.

Use of Screen shots - Pictures of screens can be taken and passed, through chat, browsers, and email functions. This may create problems in terms of real-time processing, but there can be mentioned methods where browsers take screen shots and send those to others. For example, shots could be taken and sent out every 45 seconds, while the shared shopping process is continuing.

There are also many scripting languages that can keep track of the shopping session using the browser and which do not need other software.

One preferred version of screen sharing is to use the screen following technique. As mentioned above, this passes URLs back and forth between the browsers to share views. However, each person has control over who is followed. Individuals may also choose

not to follow someone, if desired.   This choice is toggled by checking the box in a group window pane.   This is more realistic and closer to an actual experience of going to the store.   When two people go to the store, they could be looking in the same aisle of products but not actually looking at the exact same products, for example.

For example, a man and wife walk into a jewelry store.   The woman is looking at engagement rings and the man is looking at watches.   If the man is interested in what the woman is looking at, he may ask her what she is doing, or he may go over to the product she is looking at and check it out himself.   On the web in shared shopping, the same can be achieved by the use of screen following: The man could be looking at watches and the woman could be looking at engagement rings.   The women chats, "look at what I found" to the man.   He selects her in their formed group and her URL is passed to his browser, and he is then looking at the same product that she is looking at (and thereby possibly knowing what she is referring to).

H ([0136]-[0138])

FIG. 1 shows an example high-level diagram of the primary participants in an example embodiment, where most of the functionality is provided in a centralized system.   In this case, the primary functionality of the shared shopping system is represented by the system 1 block, which interacts with the primary external entities, the shoppers 2, one or more merchants 3, an administrator/operator entity 4, and other entities 6 (such as suppliers, government agencies, etc.).   At least some of the functionality could be offloaded to one or more merchants.

The shoppers 2 represent a plurality of shoppers who interact directly with the system 1 by receiving shopping sessions where they can shop online for products and services and otherwise interact with the system (by creating and administering their accounts, for example), and by providing payment to the system when they check out.   These shoppers can shop individually, or they can shop as part of one or more groups while socializing with others in the groups, as described in more detail herein.

In contrast, the merchants 3 provide the system with product and service information for the products and services that the merchants wish to provide for the shopping experience.   In some embodiments, merchant websites may provide limited real-time functionality in support of this shopping.   The merchants 3 also communicate with the administrator/operator of the system to provide feedback about the system, to contract for use of the system, to communicate operational details, and to pay for their use of the system, for example.   The administrator/operator may also provide the retailers with various reports about usage of the system 1.   Alternatively, such reports may be

generated by the system 1 itself, and perhaps automatically sent to the retailer.

I ([0140]-[0141])

FIG. 2 shows one example hardware implementation of the system of FIG. 1, among others. The system 1 can be implemented using one or more server subsystems 10 communicating with one or more databases 12. The system 1 is connected to the Internet 18 by a typical manner, such as via a firewall router, for example. The users 16 access the system by using their own user computers 14, which may be simple personal computers, or more complex servers that connect to their own databases, for example. In particular, the Merchants 3 may utilize more complex computer equipment to interact with the system 1, as desired. Other networking solutions other than, or in addition to, the Internet could alternatively be used.

FIG. 2a shows an example embodiment of the system 1 hardware in more detail. Such a system will likely have a web server 10a and a chat server 10b (that may run on the same hardware, if desired). Such servers can be implemented using standard COTS server computers, such as are provided by HP, IBM, or Dell, for example, running a Windows, Linux, Unix, or other commercial operating system. Standard web server applications, such as MS IIS, or Apache Server could be utilized for the web server, and a commercially available chat server such as LlamaChat, OpenCHAT, Ace Operator, FreeCS, MSN Chat, or another chat server could be used to provide the chat server function.

(2) Cited Invention

　　　　According to (1), it is recognized that Cited Document 1 describes the following art (hereinafter referred to as "Cited Invention").

　　　　A system and method which interacts with shoppers, one or more merchants, and an administrator/operator entity, comprises a chat server which are run on a computer (hereinafter referred to as "computer hardware") implementing a server, which is same hardware of a web server, on which a commercial operating system is run (H,I), and provide a shared shopping mall extended to include a group communications tool (D), the system and the method comprising:

　　　　providing an online shopping mall including a first shopping site and a second shopping site (B);

　　　　providing each one of the shoppers of the group of shoppers with a link to a shared shopping cart for adding items to the shared shopping cart, such that contents of the shared shopping cart can be viewed by all of the shoppers (A), providing each one

of the shoppers with access to a shared shopping cart for indicating items for purchase by the shopping group from either of the first shopping site and the second shopping site, wherein each one of the shoppers can add items for purchase to the shared shopping cart (A, B);

providing each one of the shoppers with a payment interface, for each one of the shoppers, accepting an individual payment percentage amount indicating a percentage of the total cost of the items to be paid by a corresponding one of the shoppers, validating that the sum of the individual payment percentage amounts of all of the shoppers totals one-hundred percent, providing a checkout function to be accessed by each one of the shoppers, wherein for all of the shoppers, each one of the shoppers executes an individual checkout process for receiving payment information from that one of the shoppers, such that subsequent to the individual checkout process, that one of the shoppers has completed the checkout process and has contributed payment toward purchase of the items according to the individual percentage amount corresponding to that one of the shoppers, wherein when any one of the shoppers first accesses the checkout function, the shared shopping cart is locked, when the individual checkout function is completed for all of the shoppers, the sale of the items to the group is completed, and providing payment to the first shopping site and the second shopping site based on items purchased (A, B);

initiating a shared shopping session by a driver which is an initiator of the shared shopping session (G);

in use of screen shots, taking pictures of screens and passing them through a chat function, etc. from the driver to a passenger which is an additional member of the shared shopping group, from the passenger to the driver, or between passengers, for example, taking shots and sending them out every 45 seconds, while the shared shopping process is continuing (G);

thereby allowing male and female shoppers in the shopping group to look at the same product (G).

No. 5 Comparison, Judgment
(1) Comparison
The Invention and the Cited Invention are compared below.

A   Regarding the "computer implemented method for managing a group chat during an ecommerce session"
The "shared shopping session" provided by the web server and the chat server in

the Cited Invention corresponds to the "ecommerce session" in the Invention.

The "chat" in the "shared shopping group" during the "shared shopping session" in the Cited Invention corresponds to the "group chat during an ecommerce session" in the Invention.

The "computer hardware" in the Cited Invention on which the "web server" and the "chat server" managing chats are run is a computer which runs the servers and manages a group chat during an ecommerce session, which corresponds to the "computer for managing a group chat during an ecommerce session" in the Invention (a). The "computer hardware", which functions as a server for an ecommerce session and a group chat during the session while communicating with a memory connected to the computer, also corresponds to the "ecommerce chat server in communication with a memory" in the Invention (b).

As above, the "method" in the Cited Invention implemented by the "computer hardware" on which the "web server" and the "chat server" are run, corresponds to the "computer implemented method for managing a group chat during an ecommerce session, the method implemented using an ecommerce chat server in communication with a memory" in the Invention.

B   Regarding the "step of initiating a chat session"

The "shoppers" in the Cited Invention who participate in a shared shopping session as "driver" and "passenger" both participate in a group chat during an ecommerce session.   Thus, the "shopper" in the Cited Invention corresponds to the "participant" in the Invention.

The "shopper" in the Cited Invention carries a computer which is a client of an ecommerce chat server, for participating in a shared shopping session.   Thus, the computer being the client corresponds to the "client computer device associated" with the participant in the Invention.

However, the Invention includes "a step of initiating, by the ecommerce chat server, a chat session between at least a first client computer device associated with a first participant and a second client computer device associated with a second participant", while it is unclear whether or not the matter is included in the Cited Invention.

C   Regarding "a step of sharing" a view

The "pictures of screens" in the "shared shopping session" in the Cited Invention are screen shots of a client computer device associated with a participant who views a

product to be sold by an ecommerce website relating to the shared shopping session. The pictures of screens display the product as a view of the ecommerce website to sell the product, and are shared and displayed between shoppers, thereby allowing male and female shoppers in the shopping group, in the example, to look at the same product. Thus, the "pictures of screens" are "at least one view of an ecommerce website" in the Invention, and correspond to a view which "includes at least one purchasable item".

The matter in the Cited Invention that the "pictures of screens" are passed from a driver to a passenger, from the passenger to the driver, or between passengers, through a "chat function" using a "chat server" for sharing and displaying them, corresponds to "a step of sharing, by the ecommerce chat server, at least one view of an ecommerce website with the first client computer device and the second client computer device, wherein the at least one view of the ecommerce website (i) is received by the ecommerce chat server from the first client computer device and (ii) is transmitted by the ecommerce chat server to the second client computer device, the first client computer device and the second client computer device are configured to display the at least one view of the ecommerce website" in the Invention.

D   Regarding "a step of initiating a purchase transaction"

The "lock" of the "shared shopping cart" caused when "any one of the shoppers" of the "shared shopping group" "first" "accesses" the "checkout function" is to be shared and displayed between shoppers with the "pictures of screens" in C, thereby starting a purchase procedure for an item added to the shared shopping cart.   Thus, the "lock" corresponds to "initiating, by the ecommerce chat server, a purchase transaction for the at least one purchasable item included in the at least one view of the ecommerce website" in the Invention.

E   Regarding "a step of receiving payment information"

The "payment" in accordance with "individual percentage amounts for each of the shoppers" in the Cited Invention corresponds to the "payment information for the purchase transaction" in the Invention.

F   Regarding "a step of completing the purchase transaction"

The matter in the Cited Invention that the purchase transaction (a series of process from lock of a shared shopping cart to completion of item sale and payment) is completed by payment of all of the shoppers, corresponds to "completing the purchase transaction based on the payment information" in the Invention.

(2) Corresponding Feature and Different Feature

According to (1), the Invention and the Cited Invention have the following corresponding feature and different feature.

<Corresponding Feature>
"A computer implemented method for managing a group chat during an ecommerce session, the method implemented using an ecommerce chat server in communication with a memory, said method comprising:

a step of sharing, by the ecommerce chat server, at least one view of an ecommerce website with the first client computer device and the second client computer device, wherein

the at least one view of the ecommerce website (i) is received by the ecommerce chat server from the first client computer device and (ii) is transmitted by the ecommerce chat server to the second client computer device, the first client computer device and the second client computer device are configured to display the at least one view of the ecommerce website, and the at least one view includes at least one purchasable item;

a step of initiating, by the ecommerce chat server, a purchase transaction for the at least one purchasable item included in the at least one view of the ecommerce website;

a step of receiving payment information for the purchase transaction; and

a step of completing the purchase transaction based on the payment information."
<Different Feature>

The Invention includes "a step of initiating, by the ecommerce chat server, a chat session between at least a first client computer device associated with a first participant and a second client computer device associated with a second participant". It is unclear whether the Cited Invention includes the above matter or not.

(3) Judgment on Different Feature

The above-mentioned different feature is examined below.

A "chat function" in an "ecommerce chart server" is implemented also in the Cited Invention. Because of this, the Cited Invention obviously includes a step of initiating a chat session even if it is not clearly indicated. Thus, the above different feature is not a substantial different feature.

Alternatively, a person skilled in the art could easily include "a step of initiating,

by the ecommerce chat server, a chat session between at least a first client computer device associated with a first participant and a second client computer device associated with a second participant" in the Cited Invention.

(4) Appellant's allegation

The Appellant alleges in the written opinion submitted on July 17, 2020 that Cited Document 1 does not disclose or indicate "at least one view of the ecommerce website" in the Invention for the reason that the "screen shot" in Cited Document 1 is an image obtained by capturing a screen of a first user, which is not a view of the ecommerce website, and the second user receiving it cannot operate a webpage function of the ecommerce website through the screen shot.

However, Claim 1 does not specify excluding pictures of screens, etc. from the "view of the ecommerce website" or limitation to a user operable one.

The specification includes the following description: "[0012] In the example embodiment, the first participant is the leader of the chat session. The ecommerce chat server retrieves, from the first client computer device, <u>a view (also known as a screen) of the ecommerce website that is currently being displayed</u> on the first client computer device. The ecommerce chat server displays the retrieved view on a second client computer device." (The underlines were added by the body.) The "screen" as a view of the ecommerce website; i.e., a mode using "pictures of screens", is described. Even considering the specification, it cannot be said that "at least one view of the ecommerce website" is used for specifying a user operable one.

In light of the above, the recitation of Claim 1 does not exclude the "pictures of screens" in the Cited Invention. Thus, the Appellant's allegation is not based on the description of the scope of claims and the specification.

No. 6 Closing

As above, the Invention, which is identical with the Cited Invention, falls under the provisions of Article 29(1)(iii) of the Patent Act.

Alternatively, the Invention could have been easily made by a person skilled in the art on the basis of the Cited Invention. Thus, the Appellant should not be granted a patent for the invention under the provisions of Article 29(2) of the Patent Act.

The present application should be rejected without examining other claims.

Therefore, the appeal decision shall be made as described in the conclusion.

January 7, 2021

Chief administrative judge: SATO, Satoshi
Administrative judge: HAYAMI, Yuta
Administrative judge: AIZAKI, Hirotsune