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**Datasheet for the decision
of 18 December 2013**

Case Number: T 1249/10 - 3.5.03

Application Number: 01961110.2

Publication Number: 1247386

IPC: H04L29/06

Language of the proceedings: EN

Title of invention:

Digital recording in an IP based distributed switching platform

Patent Proprietor:

Nice Systems Ltd.

Opponent:

Graf Software GmbH

Headword:

Call recording/NICE

Relevant legal provisions:

EPC R. 99(1) (a), 99(1) (c)

EPC Art. 56

RPBA Art. 13(1)

Keyword:

Admissibility of appeal - (yes)

Inventive step - (no) main request, auxiliary requests 1, 3, 4

Late-filed request - admitted (no) auxiliary request 2

Decisions cited:

Catchword:



**Beschwerdekammern
Boards of Appeal
Chambres de recours**

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Case Number: T 1249/10 - 3.5.03

D E C I S I O N
of Technical Board of Appeal 3.5.03
of 18 December 2013

Appellant: Graf Software GmbH
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Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 6 May 2010
rejecting the opposition filed against European
patent No. 1247386 pursuant to Article 101(2)
EPC.**

Composition of the Board:

Chairman: F. van der Voort
Members: B. Noll
R. Menapace

Summary of Facts and Submissions

- I. This appeal is against the decision of the opposition division rejecting the opposition filed against European patent no. 1247386.
- II. The opposition division found that the claimed subject-matter was novel and involved an inventive step having regard, *inter alia*, to the following document:

E10: ETSI ES 201 671 V1.1.1 (July 1999):
Telecommunications security; Lawful Interception (LI); Handover interface for the lawful interception of telecommunications traffic.

Further, late-filed documents, *inter alia* document E50.1, were not admitted into the opposition proceedings.

- III. Notice of appeal was filed on 9 June 2010. The appeal fee was paid the same day.
- IV. In the statement of grounds of appeal it was argued that substantial procedural violations had occurred in the oral proceedings before the opposition division since the opposition division had failed to adequately examine the relevance of late-filed document E50.1 of its own motion and had further violated the opponent's right to be heard by not granting the opponent extra time during the oral proceedings for reconsidering its arguments as to why E50.1 was *prima facie* relevant (point 1 of the statement of grounds of appeal). Furthermore, insufficient disclosure was argued in the statement of grounds of appeal as a new ground for opposition (point 2 of the statement of grounds of appeal). In point 3 of the statement of grounds of

appeal, the patentability of the invention as claimed in the patent in suit was addressed, inter alia, the inventive step (Article 56 EPC) of the claimed subject-matter having regard to E10.

- V. With a letter dated 25 November 2010 and filed in response to the appeal the respondent (patent proprietor) did not give its approval to considering the new ground for opposition, i.e. insufficient disclosure. Further, it argued that, inter alia, document E50.1 was inadmissible. As regards patentability, arguments in support of novelty and inventive step were provided. As an auxiliary measure, oral proceedings were requested.
- VI. In a communication accompanying a summons to oral proceedings the board drew the parties' attention to points to be discussed during the oral proceedings, in particular the alleged substantial procedural violations, the admissibility of the further ground for opposition, the admissibility of document E50.1 and the interpretation of the claims for the purpose of the assessment of novelty and inventive step.
- VII. With a letter dated 18 November 2013 the respondent requested that the appeal be rejected as inadmissible. Further, claim sets of a first, a second and a third auxiliary request were filed and a further auxiliary request ("auxiliary request 3a") was specified by reference to the third auxiliary request.
- VIII. In a letter dated 10 December 2013 the appellant stated that the appeal was filed in the name of Graf Software GmbH, Mainzer Strasse 36, 55411 Bingen.

IX. Oral proceedings before the board were held on 18 December 2013. In the course of the oral proceedings the respondent filed a fourth auxiliary request and withdrew auxiliary request 3a.

The appellant requested that the decision under appeal be set aside and that the patent be revoked.

The respondent requested that the appeal be dismissed (main request) or that the patent be maintained in amended form on the basis of one of the first to third auxiliary requests as filed with the letter dated 18 November 2013 or on the basis of a fourth auxiliary request as filed during the oral proceedings before the board.

After closing the debate, the board announced its decision.

X. Claim 1 as granted (main request) reads as follows:

"A method for recording at least a portion of an IP data session being between at least one [sic] a first communication device and a second communication device through a network by a recording device (24), comprising:
initiating the data session by said first communication device and establishing connection with said second communication device;
implementing the data session as a conference call through a conference controller in response to initiating the data session such that said first and second communication devices are respectively first and second participant;
characterized by

using the conference controller, entering said recording device (24) to said conference call as a third independent participant, wherein said recording device receives as a third independent participant at least the portion of [sic] data session from each of first and second participants; and recording the data session received as a third independent participant of said conference call using said recording device."

Claim 8 as granted reads as follows:

"A system for recording an IP communication session through an IP network, comprising:

(a) a first communication device for initiating the IP communication session;

(b) a conference controller (30) for implementing a conference call with said first communication device and a second communication device for the IP communication session; and

(c) a recording device (24);

characterized by

said recording device (24) being adapted to participate in at least a portion of said IP communication session as an additional independent connected participant and to record said at least a portion of said IP communication session received as an additional independent connected participant of said conference call, wherein the IP communication session comprises an IP telephony session."

Claim 1 of the first auxiliary request is identical to claim 1 of the main request.

Claim 1 of the second auxiliary request differs from claim 8 as granted in that it includes the following additional feature:

"further comprising a scheduler adapted to determine whether the IP communication session should be recorded by analyzing information about the IP communication session and adapted to control said recording device (24)".

Claim 1 of the third auxiliary request differs from claim 1 as granted in that it includes the following additional feature:

"wherein the recording device (24) joins the data session through a hunt group".

Claim 1 of the fourth auxiliary request is identical to claim 8 as granted.

Reasons for the Decision

1. *Admissibility of the appeal*
 - 1.1 The respondent contested the admissibility of the appeal on the ground that the notice of appeal did not comply with the requirements of Rule 99(1)(a) and (c) EPC.
 - 1.2 However, whilst the board had not yet invited the appellant pursuant to Rule 101(2) EPC to correct the deficiency that its name and address were missing from the notice of appeal (Rule 99(1)(a) EPC), this deficiency was remedied by the appellant with its letter dated 10 December 2013.

1.3 Further, as regards the requirement of Rule 99(1)(c) EPC, the board notes that the notice of appeal does not explicitly contain a request defining the subject of the appeal. However, having regard to the opponent's request before the opposition division that the patent be revoked in its entirety, to the tenor of the impugned decision, according to which the opposition was rejected, and to the fact that the appeal was filed against this decision ("Gegen den Beschluss ..."), it is implicit in the present case that the appellant requested with the notice of appeal that the decision under appeal be set aside and that the patent be revoked in its entirety. For this reason the notice of appeal meets the requirement of Rule 99(1)(c) EPC.

1.4 The board concludes that the appeal complies with Rule 99 EPC. Since the other requirements set out in Rule 101 EPC are also met, which was not contested by the respondent, the appeal is admissible.

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

2.1 Regarding the method as claimed in claim 1 as granted, E10 is considered to represent the most relevant prior art for assessing inventive step. In particular, E10 is a document which specifies a standard for the implementation of a handover interface (HI) for lawful interception of circuit-switched communication content and certain packetized services in a telecommunications network (cf. page 9, the penultimate paragraph of point 1). An overview of the handover interface is shown in figure 1 on page 18. The handover interface serves to establish a communication between the switching function of the network (inner circle at the left-hand part of figure 1) and a recording device (law

enforcement monitoring facility LEMF, cf. the right-hand part of figure 1) for transporting control and content information. The interface comprises three ports (HI1, HI2, HI3) which have the following tasks:

- the first port HI1 serves administrative purposes and need not be further considered here;
- the second port HI2 serves to transport intercept-related information, such as signalling information for establishing the intercept service or for controlling its progress (cf. the first paragraph of point 8 on page 24);
- the third port HI3 serves to transport the content of the communication provided by an internal interception function IIF, which may contain voice or data, from the communications network to the recording device "as a transparent en-clair copy of the information flow during an established, frequently bi-directional communication of the interception subject" (page 31, point 9, first paragraph).

Point 9.1 on pages 32 and 33 describes the delivery of circuit-switched content of communication by setting up CC (content of communication) links as one-way communication channels from the internal intercept function IIF to the LEMF (figures 4 and 5). "Target" and "other party" respectively correspond to first and second communication devices in the terminology of the patent in suit. Examples of how a call setup is established for various types of call are illustrated in Annex E on pages 71ff. Accordingly, upon receiving a request for setting up a call (cf. page 74, Figure E.1, step 1), the switching function SF_T of the "target" (first communication device) starts setting up both the CC link to the recording device LEMF (steps 2.2 and 2.3) and the call connection to the switching function SF_P of the "other party" (second

communication device), see step 2.4. For a call originating at the "other device" a similar procedure is followed, see page 78, Figure E.4. Hence, a call established between the "target" and the "other party" is set up as a three-party communication between the "target", the "other party" and the recording device, wherein the recording device is operated only as a listener (see point 9.1 on page 32, seventh paragraph). The recording device records the contents of communication transported over the network between the "target" and the "other party" (figures 4 and 5 on page 33).

Thus, using the wording of claim 1 as granted, E10 discloses a method of recording at least a portion of a communication between a first and a second communication device through a network by a recording device, wherein the communication is initiated by the first communication device ("target" or "other party", see above) and a connection is established with the second communication device (step 2.4 in figure E.1). The communication is implemented as a multi-party call, i.e. a conference call, through a conference controller (the switching function SF_T of the target) in response to initiating the communication (step 1 in figure E.1), such that the first and second communication devices are respectively first and second participants in the communication. The switching function SF_T of the target serves to enter the recording device (LEMF) in the conference call as a third independent participant, wherein the recording device receives at least the portion of communication from each of the first and second participants (see figures 4 and 5 on page 33) and records the received communication as a third independent participant of the conference call.

2.2 It thus follows that the method according to claim 1 as granted differs from the above-mentioned method as disclosed in E10 in that the communication to be recorded is an IP data session.

2.3 The skilled person starting out from E10 would however recognise that the recording procedure described therein, whilst primarily designed for circuit-switched content of communication, is also intended for recording packet-switched data and certain packetized services, cf. E10, page 9:

"The standard specifies in detail network/service specific protocols relating to the provision of lawful interception at the handover interface for the following networks/services:

- speech;
- circuit and packet switched data;
- UMTS and similar services."

and

"Version 1.1.1 will be limited to 64 kbit/s for circuit switched content of communication and certain packetized services."

Since at the priority date the Internet Protocol was a well-known protocol for communicating packet-switched data, the skilled person would have considered using the known method also in a communication between the first and second communication devices, which included an IP data session.

Hence, the skilled person would have arrived at the claimed method without the exercise of inventive skill.

2.4 The respondent's arguments may be summarised as follows:

(a) E10 is only concerned with a very general description of administration at a generic handover interface for the provision of lawfully intercepted telecommunications traffic to a law enforcement agency. E10 is not concerned with the recording of an IP data session set up between end devices as a conference call in which the recording device enters the conference call as a participant.

(b) E10 does not disclose further details about packet-switched data services (E10, page 20, "For further study.").

2.5 The board does not find these arguments convincing for the following reasons:

Re (a): the appellant's arguments are based on an unduly narrow interpretation of the disclosure of E10. The term "lawful interception" merely refers to a legal concept, by defining the legal framework in which a call may be recorded. However, the implementation of the legal concept according to E10 consists of a system for recording the content of the communication to be intercepted, wherein the system sets up a three-party call and forwards the content of communication to a recording device which is a party of the three-party call. Furthermore, the recording process itself is not affected by the communication between end devices being set up as an IP data session, since the recording in E10 is set up at a low communication layer, i.e. the physical or the data link layer, so that any communication session at a higher communication layer is transparently forwarded towards the recording device

(E10, page 31, point 9, "a transparent en-clair copy of the information flow"). Hence, the feature of claim 1 that the communication is an IP data session merely specifies the communication layer at which the communication between the end devices is implemented, which is independent of the setup of the conference call or the recording itself. Moreover, the feature that the call is set up as a "conference" call does not distinguish the claimed method from the method of E10, since any call having multiple (more than two) participants qualifies as a conference call. Further, the claimed method does not define technical features which concern a technical relation between the call being implemented as a conference call on the one hand and the communication between the end devices being an IP data session on the other hand.

Re (b): the indication of "a transparent en-clair copy of the information flow" in E10 implies that any communication at a higher layer, including higher-layer packet-switched data services, is transparently forwarded to the recording device. It is not therefore necessary to know further details about these services for the purpose of transmission and recording of communication information present as an IP session. Moreover, the claimed method does not define technical features in relation to packet switching of the IP data session.

- 2.6 The board concludes that the subject-matter of claim 1 lacks an inventive step (Article 56 EPC). The ground for opposition pursuant to Article 100(a) EPC thus prejudices the maintenance of the patent as granted. The main request is therefore not allowable.

3. *The first auxiliary request - inventive step
(Article 56 EPC)*

Claim 1 of the first auxiliary request is identical to claim 1 as granted. Therefore, the board's findings as regards the main request (cf. point 2 above) also apply to the first auxiliary request.

It follows that the ground for opposition pursuant to Article 100(a) EPC prejudices the maintenance of the patent in amended form on the basis of the first auxiliary request. The first auxiliary request is therefore not allowable.

4. *The second auxiliary request - admissibility*

4.1 As regards the basis for claim 1 of the second auxiliary request, the respondent referred to claims 8 and 11 as granted, the paragraph at page 8, lines 9 to 17, of the international application as published (WO 02/19620 A2) (corresponding to paragraph [0037] of the patent specification) and claims 11 and 21 of the international application as published.

4.2 The added feature (see point X above) requires that the scheduler is capable of analysing information about the IP communication session. The board notes that neither claims 8 and 11 as granted nor claims 11 and 21 as filed include this feature.

Further, the paragraph in the description referred to by the respondent includes the following passage:

*"Scheduler 48 may optionally be manual or automatic.
For the latter implementation, scheduler 48 may optionally analyze information about the IP multimedia*

session, such as the identity of the initiating and/or receiving device, in order to determine whether the session should be recorded."

Hence, information about the IP multimedia session may be analysed if the scheduler is automatic. However, claim 1 does not require the scheduler to be automatic.

4.3 The board is therefore of the view that the feature added to claim 1 is not clearly and unambiguously derivable from the application documents as originally filed.

4.4 Since the amendment in claim 1 of the second auxiliary request does not prima facie meet the requirement of Article 123(2) EPC and the second auxiliary request was filed after the respondent's reply to the appeal, i.e. was filed late in the appeal procedure, the board, exercising its discretion pursuant to Article 13(1) of the Rules of Procedure of the Boards of Appeal (RPBA), did not admit the second auxiliary request into the proceedings.

5. *Third auxiliary request - inventive step
(Article 56 EPC)*

5.1 The additional feature in claim 1 of the third auxiliary request (see point X above) is understood by the board as implying that the recording device is part of a hunt group, in which one of a plurality of recording devices having assigned virtual telephone numbers is selected for recording the communication on the basis of the current availability of the recording device. This interpretation was shared by the respondent and is also supported by the patent specification, according to which "the term "hunt

group" refers to any type of virtual or non-fixed telephone extension systems, in which a central control unit ... determines the physical extension which is used" (cf. the last sentence in paragraph [0022] of the patent specification). Furthermore, it is stated in the patent specification that hunt groups are well-known in the art (cf. the second sentence in paragraph [0022]).

- 5.2 The recording device joining the data session through a hunt group in the above meaning is not disclosed in E10. The feature serves to improve the availability of the recording service.
- 5.3 The board notes that the formulation of the technical problem of improving the availability of the recording service does not contribute to an inventive step, since improving services in telecommunications was at the priority date a common goal for a person skilled in the art. Further, it is independent of the content type of data (voice, data).
- 5.4 The skilled person starting out from E10 and facing the problem of improving the availability of the recording service would consider well-known methods of conventional telephony systems and would therefore encounter line hunting as an appropriate solution.
- 5.5 The respondent argued that in the context of claim 1, i.e. in the field of recording an IP data session, there was no suggestion in the prior art that a recording device would join a data session through a hunt group. Rather, E10 only disclosed that the recording device LEMF constituted an ISDN DSS1 user function (page 32, first paragraph), which implied that the intercepted content of communication was transferred to a fixed network address. This disclosure

would have led the skilled person away from providing the recording device as part of a hunt group.

5.6 The board is not convinced by this argument. In the board's understanding, assigning for each lawful interception activation a fixed LEMF address as disclosed in E10 on page 32 only means that the LEMF address is fixed in relation to a particular activation of lawful interception, i.e. to all the communications which are to be recorded in respect of a particular target. However, this issue is distinct from, and independent of, the question of whether or not the LEMF has a fixed physical address or a virtual address within the communication network.

5.7 The board concludes, in view of the above and taking into account the considerations set out at point 2 in respect of claim 1 of the main request, that the subject-matter of claim 1 of the third auxiliary request lacks an inventive step (Article 56 EPC). The ground for opposition pursuant to Article 100(a) EPC thus prejudices the maintenance of the patent in amended form on the basis of the third auxiliary request. The third auxiliary request is therefore not allowable.

6. *The fourth auxiliary request - inventive step (Article 56 EPC)*

6.1 Claim 1 of the fourth auxiliary request is identical to independent system claim 8 as granted. Claim 1 of the fourth auxiliary request defines system features which correspond to the method features of claim 1 as granted, in which the session to be recorded is an IP communication session, wherein the IP communication

session comprises an IP telephony session (see point X above).

6.2 In addition to the arguments submitted in support of method claim 1 as granted (see point 2.4 above), the respondent argued that the wording "a conference controller (30) for implementing a conference call with said first communication device and a second communication device for the IP communication session" implied that the conference call was actually set up at the communication layer of the IP data session. In E10, however, communication with the recording device LEMF for the purpose of lawful interception was set up at a lower OSI layer. Therefore, the system of claim 1 required an implementation which was different from the interception handover interface as disclosed in E10.

6.3 The board disagrees. The wording of the claim is merely functional and does not consider any specific implementation. Therefore, the wording of claim 1 of the fourth auxiliary request does not stipulate a setup of the conference call at a particular communication layer. The board further notes that the patent specification is unspecific as regards the communication layer at which the conference call is set up.

Further, the feature that the session to be recorded is an IP communication session, wherein the IP communication session comprises an IP telephony session, defines the content of communication at a layer higher than the layer at which the communication is recorded. However, the nature of content at a higher layer has no influence on the recording as such, since the content is transparently forwarded to the recording device at the recording layer. Moreover, the claimed

system does not define technical features in relation to the recorded session being an IP communication session which comprises an IP telephony session.

- 6.4 Hence, the subject-matter of claim 1 of the fourth auxiliary request lacks an inventive step (Article 56 EPC). The ground for opposition pursuant to Article 100(a) EPC thus prejudices the maintenance of the patent in amended form on the basis of the fourth auxiliary request.
7. Since there is no request on file on the basis of which the patent could have been maintained, the patent must be revoked.
8. In view of the fact that the patent is to be revoked, it is not necessary to further consider whether or not procedural violations as alleged by the appellant (see point IV above) had occurred in the opposition procedure in connection with the question of whether or not document E50.1 was admissible.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The patent is revoked.

The Registrar:

The Chairman:



G. Rauh

F. van der Voort

Decision electronically authenticated