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**Datasheet for the decision
of 26 March 2015**

Case Number: T 1343/10 - 3.5.05

Application Number: 03777035.1

Publication Number: 1584039

IPC: H04L12/58

Language of the proceedings: EN

Title of invention:

METHOD AND SYSTEM FOR FACILITATING INSTANT MESSAGING
TRANSACTIONS BETWEEN DISPARATE SERVICE PROVIDERS

Applicant:

Nokia Corporation

Headword:

Instant messaging between disparate domain names/NOKIA

Relevant legal provisions:

EPC Art. 56, 123(2)

Keyword:

Inventive step - (no)
Amendments - added subject-matter (yes)

Decisions cited:

Catchword:



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European Patent Office
D-80298 MUNICH
GERMANY
Tel. +49 (0) 89 2399-0
Fax +49 (0) 89 2399-4465

Case Number: T 1343/10 - 3.5.05

D E C I S I O N
of Technical Board of Appeal 3.5.05
of 26 March 2015

Appellant: Nokia Corporation
(Applicant) Karakaari 7
02610 Espoo (FI)

Representative: Swindell & Pearson Limited
48 Friar Gate
Derby DE1 1GY (GB)

Decision under appeal: **Decision of the Examining Division of the
European Patent Office posted on 29 January 2010
refusing European patent application
No. 03777035.1 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chair A. Ritzka
Members: P. Cretaine
D. Prietzel-Funk

Summary of Facts and Submissions

I. The appeal is against the decision of the examining division, posted on 29 January 2010, to refuse European patent application No. 03777035.1 on the grounds of lack of inventive step (Article 56 EPC), having regard to the disclosure of

D1: US 2002/0006803 or

D2: EP 1 104 964.

II. Notice of appeal was received on 29 March 2010 and the appeal fee was paid on the same day. The statement setting out the grounds of appeal was received on 26 May 2010. The appellant requested that the decision under appeal be set aside and that a patent be granted on the basis of a main request or any of the first to third auxiliary requests filed with the statement setting out the grounds of appeal. The claims of the main request were identical to the claims of the request on which the contested decision was based. Oral proceedings were requested should any of the requests not be allowed.

III. A summons to oral proceedings scheduled for 26 March 2015 was issued on 5 December 2014. In an annex to this summons, the board gave its preliminary opinion on the appeal pursuant to Article 15(1) RPBA. Objections were raised under Article 56 EPC with respect to all the requests on file, having regard to the disclosure of D1 which the board considered as the closest prior art. Furthermore, the board raised Article 123(2) EPC objections against the second and third auxiliary requests.

- IV. With a letter dated 26 February 2015, the appellant filed a fourth auxiliary request and provided arguments in support of inventive step of this request.
- V. By letter of 24 March 2014 the appellant announced that it would not be attending the oral proceedings.
- VI. Oral proceedings were held as scheduled on 26 March 2015 in the absence of the appellant. After due deliberation on the basis of the pending requests and the written submissions, the decision of the board was announced at the end of the oral proceedings.
- VII. Claim 1 of the **main request** reads as follows:

"A method of facilitating instant messaging (IM) over an electronic communication network, comprising: receiving a first message, from a first address that includes a first domain identified with a first instant message service provider (IMSP1), that is directed to a second address that includes a second domain different from the first domain, the second domain identified with a second instant message service provider (IMSP2); detecting, at the first instant message service provider, that the second domain is different from the first domain; and in response to detecting that the second domain is different from the first domain, mapping the first address to a substitute address that includes the second domain."

Claim 1 of the **first auxiliary request** differs from claim 1 of the main request in that the wording "receiving a first message" has been amended to read "receiving a first instant message".

Claim 1 of the **second auxiliary request** reads as follows:

"A method of facilitating instant messaging (IM) over an electronic communication network, comprising;
receiving a first message from a first address that includes a first domain identified with a first instant message service provider (IMSP1), wherein the first message is packed in accordance with a first standard associated with the first instant message service provider and is directed to a second address that includes a second domain different from the first domain, the second domain identified with a second instant message service provider (IMSP2);
detecting, at the first instant message service provider, that the second domain is different from the first domain;
unpacking the first message at the first instant message service provider;
mapping the first address to a substitute address that includes the second domain;
and
repacking the first message at the first instant message service provider in accordance with a second standard associated with the second instant message service provider".

Claim 1 of the **third auxiliary request** differs from claim 1 of the second auxiliary request in that "first standard" and "second standard" have been amended to read "first proprietary standard" and "second proprietary standard" respectively.

The main and first, second and third auxiliary requests contain further independent claims directed to a corresponding program (claim 10) and system (claim 11).

Claim 1 of the **fourth auxiliary request** reads as follows:

"A method of facilitating instant messaging (IM) over an electronic communication network, the method being performed by a first instant message service provider (IMSP1) identified with a first domain and comprising: maintaining a plurality of pools of addresses, each pool including addresses having a different domain that is identified with a different instant message service provider, and each domain being different from the first domain;
receiving a first message, from a first address that has the first domain identified with the first instant message service provider (IMSP1), which is directed to a second address that has a second domain different from the first domain, the second domain identified with a second instant message service provider (IMSP2);
detecting that the second domain is different from the first domain;
in response to detecting that the second domain is different from the first domain,
accessing a pool of addresses, from the plurality of pools of addresses, which includes addresses having the second domain;
reserving a substitute address having the second domain from the pool of addresses which includes addresses having the second domain; and
mapping the first address that has the first domain to the substitute address that has the second domain."

The fourth auxiliary request contains further independent claims directed to a corresponding program (claim 9) and system (claim 10).

Reasons for the Decision

1. The appeal is admissible.
2. Main request - Inventive step (Article 56 EPC)
 - 2.1 D1 represents the closest prior art and discloses (see in particular paragraphs [0008], [0012], [0019], [0043], [0125], [0126] and [0130] to [0133]) a method for registering users with an instant messaging (IM) system. By registering, users are assigned a unique identifier regardless of the appliance, e.g. email-based client application or GSM devices, used by the user to access the IM server. In the case of an email-based client application, the unique identifier (UIN), e.g. "123456", is matched with the user access address (e.g. johnsmith@company.com) and is appended to the URL of the IMSP (e.g. 123456@chikka.com). Any other registered user of the IM community of the IMSP server can then send an IM message to the user who has the UIN 123456 by sending an email to 123456@chikka.com. The message is then automatically directed to the johnsmith@company.com address.
 - 2.2 Therefore, D1 discloses, according to the essential features of claim 1 and using the wording of this claim, a method of facilitating instant messaging (IM) over an electronic communication network, comprising:
 - receiving a first message, from a first address that includes a first domain identified with a first message service provider (*the message sent from address*

johnsmith@company.com of user John), that is directed to a second address that includes a second domain different from the first domain, the second domain being identified with an instant message service provider (the address 639175336647@chikka.com of user Dennis, registered on IM server 167 with UIN "639175336647");

- detecting, at the instant message service provider, that the second domain is different from the first domain (the IM server 167 detects that John is not yet a registered user of the IM service since he does not have an address at chikka.com); and

- in response to detecting that the second domain is different from the first domain, mapping the first address to a substitute address that includes the second domain (the address johnsmith@company.com is mapped to 12125556666@chikka.com, "12125556666" being the UIN allocated to John).

The only differences between the disclosure of D1 and the subject-matter of claim 1 are thus that claim 1 defines that:

a) the domain included in the first address is "identified with a first instant message provider", instead of being the domain of an email server as in D1, and

b) the detection that the second domain is different from the first domain and the mapping of the first address both occur in the first message service provider. In D1, this occurs at the IM server 167, i.e. at the node which sends the IM message to the recipient.

With regard to feature a), the board notes that nothing precludes the IM server 167 disclosed in D1 from receiving messages issued by another IM service provider, provided these messages have in their "From" portion an address including a domain name. Moreover, D1 in paragraph [0012] mentions that interconnecting different IM systems is an issue. The skilled person would thus readily consider that the method of D1 is suitable for enabling IM messaging between users having different IM service providers. Feature a) therefore cannot confer an inventive step on the subject-matter of claim 1.

In respect of feature b), the board agrees in substance with the examining division (see page 9, second paragraph of the impugned decision) that this feature is a straightforward alternative that the skilled person would choose without the exercise of inventive skills.

Thus, claim 1, and the corresponding computer program claim 10 and system claim 11, do not meet the requirements of Article 56 EPC, having regard to the disclosure of D1.

- 2.3 The appellant argued that D1 did not aim at overcoming incompatibilities between different instant messaging systems but rather deal with the creation of user accounts for a single instant messaging system. In the board's judgement however, the method disclosed in D1 enables every user in a network to send an instant message to users registered with the instant messaging system provided by IM server 167. Therefore, D1 enables any user of other instant messaging systems to communicate by instant message with the users of IM

server 167, thereby overcoming any incompatibility between those systems and that by IM server 167.

3. First auxiliary request - Inventive step (Article 56 EPC)

Claim 1 adds to claim 1 according to the main request the feature that the received first message is an instant message.

The appellant argued that D1 disclosed only, in particular in paragraphs [0130] to [0133], the receipt of email messages at an instant message service server. The board however takes the view that since IM server 167 in D1 is adapted to receive also IM messages, the skilled person would readily contemplate, without the exercise of inventive step, the receipt of instant messages instead of email messages by this server.

Therefore claim 1, and the corresponding computer program claim 10 and system claim 11, do not meet the requirements of Article 56 EPC.

4. Second auxiliary request - Article 123(2) EPC

The only passages of the originally filed application documents cited by the appellant as the basis for the amendments to claim 1 (i.e. the paragraph bridging pages 2 and 3, the final paragraph on page 8, the second paragraph on page 7 and the second full paragraph on page 9) do not mention that the received first message is packed and unpacked in the first IMSP according to the standard of this IMSP. These passages rather disclose that the received message is first checked in respect of the domain of the recipient address and then packed according to the standard of

the recipient IMSP, i.e. the second IMSP. Figure 4 corroborates this by showing in box 32 only a packing of the first message according to the standard of the second IMSP (see the term "re-formatting").

Nor do the rest of the originally filed application documents provide any support for the amendments to claim 1.

For these reasons, the board judges that the second auxiliary request does not fulfill the requirements of Article 123(2) EPC.

5. Third auxiliary request - Article 123(2) EPC

Claim 1 contains all the features of claim 1 according to the second auxiliary request, in particular the features objected to by the board as added matter (see paragraph 4).

Therefore, the board judges that the third auxiliary request likewise fails to fulfill the requirements of Article 123(2) EPC.

6. Fourth auxiliary request - Inventive step (Article 56 EPC)

6.1 Admissibility

This request was submitted in response to the summons to oral proceedings. The board considered it as a legitimate attempt to overcome the objections raised by the board under Article 56 EPC and thus admitted it into the appeal proceedings under Article 13(1) and (3) RPBA.

6.2 Claim 1 of this request differs from claim 1 of the main request essentially in that it now specifies that the first IMSP maintains pools of addresses, each pool including addresses having a different domain identified with a different IMSP, and that the first IMSP accesses a pool of addresses corresponding to the domain of the second address in order to reserve a substitute address for the mapping of the first address.

D1 discloses that the UIN assigned to a user is a unique identifier (see paragraph [0043]) and that addresses of the type UIN@chikka.com are assigned to the users in the domain of the second ISMP (see paragraph [0125]). Therefore, D1 implicitly discloses that a pool of addresses having a domain identified with the second server is maintained at the first server, namely the UIN@chikka.com addresses.

The appellant acknowledged in its response to the summons to oral proceedings that D1 disclosed the allocation to the user of an email address of the form UIN@chikka.com. It argued however that D1 did not suggest maintaining a plurality of pools of addresses having a different domain from @chikka.com.

In the board's view, the skilled person would obviously consider that the system of D1 might not be limited to a single recipient IMSP but could be scaled up to include several recipient IMSPs (see in this respect paragraph [0012] which mentions "different IM systems"). As a direct consequence of such scaling up, the first IMSP would have to maintain a pool of addresses for each recipient IMSP.

For these reasons, the board judges that the subject-matter of claim 1 does not involve an inventive step, having regard to the disclosure of D1 (Article 56 EPC).

7. In conclusion, none of the four requests is allowable.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chair:



K. Götz-Wein

A. Ritzka

Decision electronically authenticated