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**Datasheet for the decision
of 28 June 2019**

Case Number: T 1388/14 - 3.5.03

Application Number: 03811044.1

Publication Number: 1579672

IPC: H04M15/00, H04L12/14, H04Q7/38

Language of the proceedings: EN

Title of invention:
A METHOD OF COMMUNICATION AND COMMUNICATION SYSTEM

Applicant:
Nokia Technologies Oy

Headword:
METHOD OF COMMUNICATION/NOKIA

Relevant legal provisions:
EPC Art. 52(1), 56
RPBA Art. 12(4)

Keyword:
Inventive step - main request (no)
Late-filed requests - first and second auxiliary requests
- requests could have been filed in first instance proceedings
(yes)



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Case Number: T 1388/14 - 3.5.03

D E C I S I O N
of Technical Board of Appeal 3.5.03
of 28 June 2019

Appellant: Nokia Technologies Oy
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Decision under appeal: **Decision of the Examining Division of the
European Patent Office posted on 21 January 2014
refusing European patent application No.
03811044.1 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chairman F. van der Voort
Members: J. Eraso Helguera
J. Geschwind

Summary of Facts and Submissions

- I. An appeal was lodged by the applicant against the decision of the examining division refusing European patent application No. 03811044.1, published as PCT application with publication No. WO 2004/045195 A1. The refusal was based on the grounds that claim 1 of each of a main request and first to third auxiliary requests was not clear (Article 84 EPC) and that the subject-matter of the independent claims of each request did not involve an inventive step (Articles 52(1) and 56 EPC).
- II. In its decision, the examining division referred, *inter alia*, to the following prior art documents:
- D1: "3rd Generation Partnership Project; Technical Specification Group Service and System Aspects; Telecommunication management; Charging management; Charging data description for the IP Multimedia Subsystem (IMS) (Release 5)", 3GPP TS 32.225 V5.0.0 (2002-09)
- D2: J. Rosenberg et al, "SIP: Session Initiation Protocol", RFC 3261 (June 2002)
- III. In the statement of grounds of appeal, the appellant requested that the decision under appeal be set aside and that a patent be granted on the basis of the claims of a main request or, in the alternative, on the basis of either a first or a second auxiliary request, all requests filed with the statement of grounds of appeal. Oral proceedings were conditionally requested.
- IV. In a communication accompanying a summons to oral proceedings, the board gave its preliminary opinion,

inter alia, that the subject-matter of the independent claims of the main request did not appear to involve an inventive step (Articles 52(1) and 56 EPC) having regard to the disclosure of documents D1 and D2 and that the auxiliary requests raised questions as to their admissibility into the appeal proceedings (Article 12(4) RPBA).

V. In its letter of response dated 17 May 2019, the appellant submitted arguments in support of novelty and inventive step of the claimed subject-matter and in support of the admissibility of the auxiliary requests.

VI. Oral proceedings were held on 28 June 2019.

The appellant requested that the decision under appeal be set aside and that a patent be granted on the basis of the claims of the main request or, in the alternative, on the basis of either the first or the second auxiliary request, all requests as filed with the statement of grounds of appeal.

At the end of the oral proceedings, the chairman announced the board's decision.

VII. Claim 1 of the **main request** reads as follows:

"A method of communication comprising:
attempting to set up a session between a calling party (100) and a called party (102) via a first call state control function (104) and a second call state control function (106), wherein said calling party (100) and the called party (102) are arranged to operate in accordance with a SIP protocol;
after a confirming response comprising a 200OK message has been received from said called party (102) at said

second call state control function (106), the method characterized in that it comprises:
determining if said attempt to set up a session has failed, wherein said determining comprises setting a time and determining that set up of said session has failed based on at least one of an acknowledgement from a calling party has not been received within said time, and receipt of a BYE request indicating a failure in processing the 200OK message at the first call state control function (104); and
preventing at least one of said calling party (100) and said called party (102) from being charged for said session, if said attempt to set up a session is determined to have failed."

VIII. Claim 1 of the **first auxiliary request** reads as follows:

"A method of communication comprising:
attempting to set up a session between a calling party (100) and a called party (102) via a first call state control function (104) and a second call state control function (106), the second call state control function (106) comprising a serving call state control function for said called party (102), wherein said calling party (100) and the called party (102) are arranged to operate in accordance with a SIP protocol; and
after a confirming response comprising a 200OK message has been received from said called party (102) at said second call state control function (106), sending an initial accounting request from said second call state control function (106) to a charging entity; and
characterized in that the method comprises
determining if said attempt to set up a session has failed, wherein said determining comprises setting a time and determining that set up of said session has

failed based on at least one of an acknowledgement from a calling party has not been received within said time, and receipt of a BYE request indicating a failure in processing the 200OK message at the first call state control function (104); and preventing at least one of said calling party (100) and said called party (102) from being charged for said session, if said attempt to set up a session is determined to have failed, wherein said preventing comprises sending a final accounting request message from said second call state control function (106) to said charging entity indicating that said session is determined to have failed, and which causes charging information to be cancelled."

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

"A method of communication comprising:
attempting to set up a session between a calling party (100) and a called party (102) via a first call state control function (104) and a second call state control function (106), the second call state control function (106) comprising a serving call state control function for said called party (102), wherein said calling party (100) and the called party (102) are arranged to operate in accordance with a SIP protocol; and after a confirming response comprising a 200OK message has been received from said called party (102) at said second call state control function (106), sending an initial accounting request from said second call state control function (106) to a charging entity; buffering charging information in said second call state control function (106); and characterized in that the method comprises

determining if said attempt to set up a session has failed, wherein said determining comprises setting a time and determining that set up of said session has failed based on receipt of a BYE request indicating a failure in processing the 200OK message at the first call state control function (104); and preventing at least one of said calling party (100) and said called party (102) from being charged for said session, if said attempt to set up a session is determined to have failed, wherein said preventing comprises marking the buffered charging information and cancelling resources allocated to the session before said time expires; and sending a final accounting request message from said second call state control function (106) to said charging entity indicating that said session is determined to have failed, and which causes charging information to be cancelled."

Reasons for the Decision

1. *Main request - claim 1 - inventive step (Articles 52(1) and 56 EPC)*
- 1.1 The board concurs with the appellant that the features in the preamble of claim 1 of the main request are known from D1. More specifically, D1 discloses a method of communication comprising:

attempting to set up a session between a calling party and a called party via a first call state control function and a second call state control function, wherein the calling party and the called party are arranged to operate in accordance with the SIP (Session Initiation Protocol) protocol (D1, Figs 5.1 and 5.2: The originating UE (User Equipment) sends an INVITE

message which is forwarded by a plurality of CSCFs (Call Session Control Functions) towards the terminating UE); and

receiving from the called party at the second call state control function a confirming response comprising a 200OK message (Figs 5.1 and 5.2: The terminating UE sends back a 200OK message which is forwarded by the CSCFs towards the originating UE).

1.2 The subject-matter of claim 1 of the main request differs from the method disclosed in D1 in that it comprises the following additional steps:

i) determining if said attempt to set up a session has failed, wherein said determining comprises setting a time and determining that set up of said session has failed based on at least one of an acknowledgement from a calling party has not been received within said time, and receipt of a BYE request indicating a failure in processing the 200OK message at the first call state control function; and

ii) preventing at least one of said calling party and said called party from being charged for said session, if said attempt to set up a session is determined to have failed.

1.3 The board understands claim 1 such that the above-cited determining step takes place after the reception at the second call state control function of the confirming response comprising the 200OK message, in accordance with claim 1 as filed and Figs 2 and 3. Furthermore, in this determining step, the acknowledgement and the BYE request are understood to be received by the second call state control function, again in accordance with

Figs 2 and 3. The appellant agreed with this interpretation of claim 1.

1.4 The objective technical problem solved by the claimed subject-matter was formulated by the appellant as "how to modify D1 to improve the handling of SIP session data so that users are not incorrectly charged". For the sake of argument, the board accepts this formulation.

1.5 The skilled person starting out from D1 and aiming at improving the handling of SIP session data would have appreciated that D1 does not deal with the situation wherein the set-up of the SIP session fails. In order to improve the handling of SIP session data in this respect, the skilled person would have considered document D2:

1.5.1 Document D2 is an authoritative document on the SIP protocol (D2, page 1, "This document specifies an Internet standards track protocol" and "Category: Standards Track") and defines, *inter alia*, that a successful session initiation between a calling party and a called party in accordance with the SIP protocol requires a three-way handshake (see D2, page 77 ff., section 13.1, "Initiating a session" - "Overview"). Specifically, D2 discloses:

1) the calling party sending an INVITE request to the called party (see D2, page 77, last paragraph: "When a user agent client desires to initiate a session (for example, audio, video, or a game), it formulates an INVITE request."),

2) the called party sending a 2xx response to the calling party after reception of the INVITE request

(see D2, page 78, first paragraph: "After some time, those UASs [*User Agent Servers*] can accept the invitation (meaning the session is to be established) by sending a 2xx response."), and

3) the calling party sending an ACK (Acknowledgement) to the called party after reception of the 2xx response (see page 78, second paragraph: "Once it receives a final response, the UAC [*User Agent Client*] needs to send an ACK for every final response it receives." and "For 2xx responses, the ACK is generated by the UAC core.").

1.5.2 D2 also teaches how the parties should react to different eventualities relating to such initiation, in particular:

D2 suggests how to handle the situation in which, in the three-way handshake mentioned above, the called party does not receive the expected ACK. The called party starts a timer after having sent the 2xx response (see D2, page 85, last paragraph: "it is necessary to periodically pass the response directly to the transport until the ACK arrives. The 2xx response is passed to the transport with an interval that starts at T1 seconds and doubles for each retransmission until it reaches T2 seconds"). If the timer expires before an ACK is received, it is determined that the session cannot proceed (see D2, page 86, second paragraph: "If the server retransmits the 2xx response for $64 \cdot T1$ seconds without receiving an ACK, the dialog is confirmed, but the session SHOULD be terminated.").

D2 further suggests that the reception of a BYE request by the called party leads to the termination of an "attempted session" (see D2, page 89, last paragraph:

"The BYE request is used to terminate a specific session or attempted session ... The caller's UA MAY send a BYE for either confirmed or early dialogs, ...").

Hence, the skilled person, starting out from D1 and using the techniques disclosed in D2, would have included in the method of D1 the additional step of "determining if said attempt to set up a session has failed, wherein said determining comprises setting a time and determining that set up of said session has failed based on at least one of an acknowledgement from a calling party has not been received within said time, and receipt of a BYE request indicating a failure in processing the 200OK message at the first call state control function" for the same purpose, i.e. determining a session set-up failure, without exercising any inventive skill.

- 1.6 As to whether the skilled person would have linked the failure of the set-up of a SIP session to a possible incorrect charging (feature ii)), the board notes that feature ii) in claim 1 does not necessarily entail any technical considerations. The appellant argued that it implied that charging records did not have to be created. The board however is not convinced that "preventing at least one of said calling party and said called party from being charged for said session, if said attempt to set up a session is determined to have failed" necessarily requires preventing charging records from being created, since charging records are not mentioned in the claim. In claim 1, "preventing ... from being charged ..." may also relate to a mere administrative step owing to the fact that the claim does not specify any technical details as to how this preventing from being charged is achieved.

1.7 The board thus concludes that the subject-matter of claim 1 of the main request does not involve an inventive step (Articles 52(1) and 56 EPC). The main request is therefore not allowable.

2. *First and second auxiliary requests - admissibility into the appeal proceedings*

2.1 The first and second auxiliary requests were filed for the first time with the statement of grounds of appeal, in which the appellant explained (points 11.2 and 15.2 of the statement of grounds of appeal) that the addition of further distinguishing features, (e.g. "wherein said preventing comprises sending a final accounting request message from said second call state control function to said charging entity indicating that said session is determined to have failed, and which causes charging information to be cancelled", in claim 1 of the first and second auxiliary requests, and "marking the buffered charging information and cancelling resources allocated to the session before said time expires", in claim 1 of the second auxiliary request) enhances the inventiveness of embodiments according to those requests, so that in no way documents D1 to D3 could be combined to provide these features. In point 11.3 of the statement of grounds of appeal, the appellant explicitly refers to "the Examiner's opinion that charging information is an administrative function".

2.1.1 The examining division had already pointed out during the written procedure that the step of "preventing at least one of said calling and called party from being charged for said session, if said attempt to set up a session is determined to have failed" was an

administrative result to be achieved (see the annex to the communication dated 17 September 2013, point 4).

Thus, the applicant already had the opportunity to file the present first and second auxiliary requests before the department of first instance, either in the written procedure or during the oral proceedings scheduled for 1 October 2013, i.e. well before the decision was issued. Instead, in response to the communication dated 17 September 2013, the applicant refrained from making further submissions and merely withdrew its request for oral proceedings, which eventually led to their cancellation, followed by the decision to refuse the application.

- 2.1.2 In its letter in response to the board's communication, the appellant argued that the feature "... and which causes charging information to be cancelled" in claim 1 of the first auxiliary request was "an incorporation of dependent claim 11, which was effectively considered and refused by the Examining Division".

The board notes however that the decision under appeal is only concerned with the independent claims of the requests pending at the time, none of which contained (neither explicitly nor implicitly) the above-cited feature. Hence, the first auxiliary request represents a fresh case. The introduction of this feature in an independent claim for the first time in appeal proceedings means that the examining division was not given the possibility to give a final decision on the merits of this feature. The board would therefore be compelled to give a first ruling on this issue, contrary to the purpose of an appeal proceedings, which is to give a judicial decision on the correctness of an earlier decision of a first instance department.

2.1.3 The appellant further argued that the amendments in the first and second auxiliary requests were "a converging development ... made to strengthen existing arguments rather than to present a completely new line of arguments" and that the claims of the first and second auxiliary requests "do not raise complex new issues and do not require further searching by the Board".

The board notes however that a "converging development" could possibly be considered a prerequisite for the admissibility of a new request into the appeal proceedings, but not as a sufficient condition.

The appellant further submitted that "at the time of filing the Grounds of Appeal it was common practice that amended claims (or at least amended claims that were converging developments of those refused at first instance) could be presented at Appeal".

However, Article 12(4) of the Rules of Procedure of the Boards of Appeal as in force when the statement of ground of appeal was filed gives the board a discretion to hold inadmissible requests which could have been presented in the first-instance proceedings, i.e. irrespective of whether they concern "converging developments".

2.2 In view of the above, the board, exercising its discretion pursuant to Article 12(4) RPBA, did not admit the first and second auxiliary requests into the appeal proceedings.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:



S. Lichtenvort

F. van der Voort

Decision electronically authenticated