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**Datasheet for the decision
of 24 January 2017**

Case Number: T 0678/16 - 3.5.03

Application Number: 13156329.8

Publication Number: 2597927

IPC: H04W76/02

Language of the proceedings: EN

Title of invention:

Apparatus, and associated method, for facilitating radio control system operation with an ICS-capable wireless device

Applicant:

BlackBerry Limited

Headword:

SIP access server/BLACKBERRY

Relevant legal provisions:

EPC Art. 123(2)

Keyword:

Amendments - added subject-matter (yes)

Decisions cited:

Catchword:



Beschwerdekammern
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Case Number: T 0678/16 - 3.5.03

D E C I S I O N
of Technical Board of Appeal 3.5.03
of 24 January 2017

Appellant: BlackBerry Limited
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Decision under appeal: Decision of the Examining Division of the
European Patent Office posted on 7 September
2015 refusing European patent application
No. 13156329.8 pursuant to Article 97(2) EPC.

Composition of the Board:

Chairman F. van der Voort
Members: K. Schenkel
O. Loizou

Summary of Facts and Submissions

- I. This appeal is against the decision of the examining division refusing European patent application No. 13156329.8, publication number EP 2 597 927 A, which was filed as a divisional application of earlier European patent application No. 12151954.0, publication number EP 2 445 300 A. The latter application itself was filed as a divisional application of earlier European patent application No. 09732216.8, publication number EP 2 263 412 A, which was originally filed as international application PCT/US2009/040549, publication number WO 2009/129254 A.
- II. The reason given for the refusal was that the subject-matter of claims 1 to 7 and 9 to 13 of a main request filed with a letter dated 27 February 2014 extended beyond the content of the earlier application as filed (Article 76(1) EPC).
- III. In the statement of grounds of appeal, the appellant at least implicitly requested that the decision be set aside and that a patent be granted on the basis of the claims of the main request as filed with the letter dated 27 February 2014, which were resubmitted with the statement of grounds of appeal. Further, oral proceedings were conditionally requested.
- IV. In a communication accompanying a summons to oral proceedings, the board, without prejudice to its final decision, raised objections under Articles 76(1) and 123(2) EPC against claims 1 and 9.
- V. Oral proceedings were held on 24 January 2017. In the course of the oral proceedings, the appellant filed an auxiliary request, amended it three times, and finally

made the last version, filed at 14.05 hrs, its sole request.

Accordingly, the appellant's final request was that the decision under appeal be set aside and that a patent be granted on the basis of the claims of the auxiliary request filed at 14.05 hrs at the oral proceedings.

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

VI. Claim 1 reads as follows:

"A system comprising user equipment (12) and a Session Initiation Protocol, SIP, access server (152), the user equipment (12) knowing that a cell does support Dual Transfer Mode, DTM, and configured to reject any SIP messages associated with applications that require DTM such as an IP multimedia subsystem, IMS, Centralized Service, ICS, session, by analyzing an indication coded within a SIP URI feature tag, a P-header, an XML body or an SDP description of a received SIP invite message, the indication indicating requirement of an IP multimedia subsystem, IMS, Centralized Service, ICS, session or DTM,

the SIP access server comprising a sender/receiver (164) configured to:

send a first SIP message to user equipment, wherein the first message is a SIP invite message having an indication coded within a SIP URI feature tag, a P-header, an XML body or an SDP description, the indication indicating requirement of an IP multimedia subsystem, IMS, Centralized Service, ICS, session or DTM, the SIP invite message being associated with

applications that require an IP multimedia subsystem, IMS, Centralized Service, ICS, session;

receive from user equipment, in response to sending of the first message and rejection by user equipment of the first message, a SIP error code;

upon receiving the SIP error code, send a second SIP message to user equipment, the second SIP message containing a media feature tag that is embodied in an accept contact header part of the message;

wherein the media feature tag in the second SIP message indicates that the circuit-switched domain should be used for signaling and media."

Reasons for the Decision

1. *Claim 1 - added subject-matter (Article 123(2) EPC)*
- 1.1 Claim 1 includes the feature that the SIP access server comprises a sender/receiver configured to:
"send a first SIP message to user equipment, wherein the first message is a SIP invite message ... , the SIP invite message being associated with applications that require an IP multimedia subsystem, IMS, Centralized Service, ICS, session" (underlining by the board).
- 1.2 The appellant argued that this feature, though not in any of the claims as originally filed, was based on paragraphs [0056] to [0058] of the application as filed. These paragraphs read as follows:

"[0056] In another implementation, the UE 12 knows that the cell does support DTM, and the UE rejects any SIP message, e.g., an SIP INVITE message, associated with applications that require DTM, such as ICS. This association is performed, for example, by analyzing a received SIP URI feature tag, a P-header, an XML body,

or an SDP description. An indication is coded, e.g., within one of these to indicate an ICS session or DTM being required.

[0057] The rejection is carried out by sending an SIP message to the network, such as an SIP 406 not acceptable, an SIP 480 temporarily unavailable, an SIP 606 not acceptable-warning header field coded as 302, etc.

[0058] In this implementation, the SIP access server sends out a SIP message, e.g., a SIP INVITE message, to the UE. And, the AS receives, in return, an error code, such as the aforementioned 406, 480, 606, etc., error code. Upon receiving the error code, the access server attempts to send the SIP message once again. The SIP AS consults with the DSF in order to establish whether the signaling and bearer can be established over the same transport to the UE such as, e.g., in the circuit-switched domain. If the signaling end bearer is able to be communicated upon the same signaling path, then the session is routed to an SIP element, such as a media gateway, that can route the session over the bearer. In order to attempt to route the session to the media gateway, the SAP AS, e.g., includes in the accept contact header, a feature tag that indicates that the circuit-switched domain should be used for signaling and media. And, e.g., the access server obtains a routing number, e.g. CSRN, MSRN to direct the signaling and media."

The board notes that "DTM" is an abbreviation of "Dual Transfer Mode", and that "ICS" is an abbreviation of "IMS Centralized Service" (cf. paragraph [0001] of the application), in which "IMS", in turn, is an

abbreviation of "IP multimedia subsystem" (cf. paragraph [0004]).

- 1.3 Paragraphs [0056] and [0057] thus describe "another implementation", in which the user equipment (UE) rejects any SIP message associated with applications that require DTM, such as ICS, by sending a SIP error code. From this wording, the board concludes that an ICS application requires DTM, even though there may be further requirements. This was not contested by the appellant.

Paragraph [0058] at the beginning describes that the SIP access server (AS) sends a SIP message to the user equipment (UE) and receives in return an error code, such as the error code mentioned in paragraph [0057]. Hence, the sending of the SIP message to the user equipment is followed by the receipt of the error code by the access server. Paragraph [0058] begins with the wording "In this implementation" and, hence, refers to paragraphs [0056] and [0057], in which it is described that a SIP message which the user equipment rejects by sending an error code is a message associated with an application that requires DTM.

These paragraphs must therefore be read in conjunction and, consequently, provide a basis only for a system in which the receipt of the error code by the access server is in response to the step of sending a SIP message which is associated with any application that requires DTM.

However, in the system of claim 1, the access server comprises a sender/receiver configured to send a first SIP message to user equipment and to receive a SIP error code from user equipment, wherein the first SIP

message is specified as "being associated with applications that require an IP multimedia subsystem, IMS, Centralized Service, ICS, session".

Consequently, in the system of claim 1, the sender/receiver of the SIP access server is configured to send a first message associated with an application that requires an ICS session and, in response, to receive a SIP error code. However, it need not be configured to send a first message associated with any other application that requires DTM, i.e. an application other than an ICS session, and, in response, to receive the SIP error code.

1.4 The appellant essentially put forward the following arguments:

(i) The application disclosed DTM as a synonym for ICS (see, for example, paragraphs [0001], [0008], [0034], [0042], [0050], [0106]). These two terms could therefore be used interchangeably. The appellant referred in particular to the wording "at a location at which DTM capability and, hence, IMS centralised services, are not available" in paragraph [0034] and the wording "stored information, whether an ICS or other DTM related feature is supported" in paragraph [0042] (underlining by the board).

The board does not accept this argument for the following reasons:

The above-cited wording in paragraphs [0034] and [0042] merely indicates that ICS requires DTM and is related to it, but does not imply that these terms are interchangeable. The other paragraphs likewise provide a basis for a certain relationship between the two

terms, but do not imply that these terms can be used as synonyms. In any case, the terms refer to different entities, namely a transfer mode and a service, respectively.

(ii) The reference to "implementations" in the description was not to be read such that the implementations were mutually exclusive, but should rather be understood as introducing examples.

The board notes, however, that in the application the implementations are referred to in a way which distinguishes them from each other. In paragraph [0054], for example, two different implementations are respectively introduced by the wording "In one implementation" and "in one implementation". The subsequent paragraph [0056] begins with "In another implementation", which in the board's view refers to a further, different implementation. This is in line with the wording "In this implementation" in paragraph [0058]. The same applies to the subsequent paragraphs which introduce further implementations, each time using the wording "In another implementation", each time reference being made to the lastly introduced implementation by means of the wording "In this implementation".

The board therefore concludes that the features in paragraphs [0056] to [0058] are disclosed in connection in the context of one specific implementation.

(iii) The appellant also pointed to paragraph [0054] and the fact that it introduced a domain selection function (DSF) and argued that paragraphs [0056] and [0058] also referred to "the DSF". Consequently, these paragraphs had to be read together with paragraph

[0054], which at the beginning referred to "DTM/ICS support", which would underline the interchangeability of the two terms.

The board notes however that from the fact that the implementation disclosed in paragraphs [0056] to [0058] includes the same component (DSF) as in another implementation, it does not necessarily follow that features of these two implementations may be freely combined. Further, the juxtaposition of the two terms DTM and ICS in paragraph [0054] may simply express a certain relationship between them, but not necessarily that they are synonyms.

(iv) The last sentence of paragraph [0056] referred to an indication "to indicate an ICS session or DTM being required", from which it followed that the terms ICS and DTM could be used interchangeably.

The board notes however that the sentence in question is about the indication which is coded in the SIP message received by the user equipment and is not concerned with the receipt of the SIP error code by the access server in response to the sending of a first message associated with an application that requires DTM and, for that very reason, rejected by the user equipment, as described in paragraph [0058] in conjunction with paragraphs [0056] and [0057].

- 1.5 The board therefore concludes that the subject-matter of claim 1 extends beyond the application as filed.
2. There being no allowable request, it follows that the appeal is to be dismissed.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:



L. Malécot-Grob

F. van der Voort

Decision electronically authenticated