

session history (all previously exchanged messages of the first session) and messages temporarily stored at the call server after receipt of the session transfer request. The third session is subsequently used to continue communicating with the remote device.

The claims

5 The most recent (first) set of claims filed prior to the hearing on 28 April 2015 comprises two independent method claims.

6 Claim 1 reads:

A method for transferring a session between multiple devices by a target device, comprising:

selecting, by the target device, a first session established between a source device with a remote device, and sending a request for session transfer for the first session to a call server;

establishing a second session with the call server after sending the session transfer request;

acquiring, from the call server, data through the second session, wherein the data has been transmitted from the remote device via the first session after sending the session transfer request and includes a session history of the remote device and a message transmitted from the remote device via the first session,

sending a message indicating completed acquisition of the data to the call server through the second session; and

establishing a third session with the call server to transfer the first session connected with the source device to the target device.

7 Claim 5 reads:

A method for transferring a session between multiple devices in a call server, comprising:

beginning, upon receiving a request for session transfer for a first session of a source device from a target device, temporarily storing data transmitted from a remote party device via the first session after receiving a request for session transfer for the first session of the source device from a target device;

generating a second session with the target device for providing the temporarily stored data and a session history of the remote device;

if the generation of the second session is completed, ending the temporary storing of data and transmitting the temporarily stored data and the session history to the target device through the second session, and

establishing a third session with the target device to transfer the first session to the target device upon receiving a message indicating completed reception of the temporarily stored data and the session history from the target device.

8 Second and third sets of claims were proposed in the skeleton arguments filed for the hearing, for consideration should the first set of claims be found to lack an inventive step.

9 Independent claim 1 of the second set reads as follows (with additional subject matter underlined):

A method for transferring a session between multiple devices by a target device, comprising:

selecting, by the target device, a first session established between a source device with a remote device, and sending a request for session transfer for the first session to a call server;

receiving, from the call server, a first reply to the request for session transfer, the first reply indicating receipt of the request for session transfer by the caller server

establishing a second session with the call server after sending the session transfer request;

acquiring, from the call server, data through the second session, wherein the data has been transmitted from the remote device via the first session after sending the session transfer request and includes a session history of the remote device and a message transmitted from the remote device via the first session,

sending a message indicating completed acquisition of the data to the call server through the second session; and

receiving from the call server, a second reply to the request for session transfer and

establishing third session with the call server to transfer the first session connected with the source device to the target device.

10 Independent claim 1 of the third set reads as follows (with additional subject matter underlined):

A method for transferring a session between multiple devices by a target device, comprising:

selecting, by the target device, a first session established between a source device with a remote device, and sending a request for session transfer for the first session to a call server;

receiving, from the call server, a Session Initiation Protocol (SIP) Early-offer answer message in reply to the request for session transfer, the SIP Early-

offer answer message indicating receipt of the request for session transfer by the caller server

establishing a second session with the call server after sending the session transfer request;

acquiring, from the call server, data through the second session, wherein the data has been transmitted from the remote device via the first session after sending the session transfer request and includes a session history of the remote device and a message transmitted from the remote device via the first session,

sending a message indicating completed acquisition of the data to the call server through the second session; and

receiving from the call server, an SIP OK message in reply to the request for session transfer and

establishing third session with the call server to transfer the first session connected with the source device to the target device

- 11 Independent claim 5 of the second set and third set of claims comprises additional subject matter corresponding to claim 1 of the second set and third set respectively.

The law

- 12 The relevant parts of Section 1 of the Patents Act 1977 read:

1(1) A patent may be granted only for an invention in respect of which the following conditions are satisfied, that is to say –

(a) ...;

(b) it involves an inventive step;

(c) ...;

(d) ...

- 13 Section 3 of the Act relates to inventive step, and reads:

An invention shall be taken to involve an inventive step if it is not obvious to a person skilled in the art, having regard to any matter which forms part of the state of the art by virtue only of section 2(2) above (and disregarding section 2(3) above).

- 14 It is well established that inventive step should be assessed on the basis of the well-known *Windsurfing*¹ approach as reformulated by Jacob LJ in *Pozzoli*². That test comprises the following steps:

¹ *Windsurfing International Inc. v Tabur Marine (Great Britain) Ltd*, [1985] RPC 59

² *Pozzoli SPA v BDMO SA* [2007] EWCA Civ 588

(1)(a) Identify the notional “person skilled in the art”

(1)(b) Identify the relevant common general knowledge of that person;

(2) Identify the inventive concept of the claim in question or if that cannot readily be done, construe it;

(3) Identify what, if any, differences exist between the matter cited as forming part of the “state of the art” and the inventive concept of the claim or the claim as construed;

(4) Viewed without any knowledge of the alleged invention as claimed, do those differences constitute steps which would have been obvious to the person skilled in the art or do they require any degree of invention?

Arguments and analysis

- 15 What I must do is determine whether the invention does or does not involve an inventive step. To do so, I will work through the steps set out above, firstly with regard to the first set of claims and then, if necessary with regard to the second and third sets of claims.

First set of claims

Step (1)(a): Identify the notional “person skilled in the art”

Step (1)(b): Identify the relevant common general knowledge of that person

- 16 In his report of 11 May 2015, the examiner identified the skilled person as “a designer of messaging/streaming communications systems that operate over data/phone communications networks. They will be aware of normal design materials relating to communications including relevant standards”. At the hearing Mr Jenkins indicated his acceptance of this characterisation, and I am happy to adopt it as correct.

Step (2): Identify the inventive concept of the claim in question or if that cannot readily be done, construe it

- 17 The examiner has construed the invention as “a procedure for transferring the endpoint of an existing communication session to a new device characterised by the new endpoint requesting the change, avoiding message loss during transfer, the particular order for transferring session contents and the use of two sessions at the new endpoint”.
- 18 Mr Jenkins was willing to accept this interpretation and I am willing to adopt it.

Step (3): Identify what, if any, differences exist between the matter cited as forming part of the “state of the art” and the inventive concept of the claim or the claim construed

The examiner objected to the first set of claims on the basis that they are obvious in view of the following document:

Document_to_418R03, 09 September 2007, Open Mobile Alliance (downloaded from the Internet 06 May 2014)

http://member.openmobilealliance.org/ftp/Public_documents/REQ/REQ-CPM/2007/OMA-REQ-CPM-2007-0418R03-CR_RD_Editorial_Comments.zip

- 19 The relevant part of this document, referred to by the examiner, is found in section 5.2.7 on page 12 as follows:
21. After a while, Alice has to leave for an appointment but still wants to continue the discussion with Bob.
 22. She requests the CPM System to list, on her mobile phone, the on-going CPM session(s) from her other devices.
 23. Alice selects the CPM Session she started with Bob on her computer.
 24. She indicates that she would like to have the CPM Session History displayed to her mobile so that she can remember the context of the discussion.
 25. Alice's CPM System sends the CPM Session History to Alice's mobile.
 26. Alice selects the target CPM Session, the CPM System manages the switching of the existing CPM Session from the laptop to her mobile phone, and Alice continues the discussion on her mobile phone.
- 20 The examiner and Mr Jenkins seem to be in agreement that the invention as defined in claim 1 is different from the prior art in two ways: firstly by storing messages during session transfer and secondly by the use of a second session for the transfer of stored messages and a session history and the use of a third session for new and ongoing communications.
- 21 Mr Clarke further argued that the invention is distinguished by the transmission of session history/stored messages separated in time from the transmission of new messages. He asserted that the prior art is merely a broad overview and does not disclose any information on timings, procedures or causation. In particular it does not disclose the separation of session history/stored messages and new messages in terms of sessions and time. He also maintained that the prior art does not disclose transfer of the session history before Alice confirms in step 26 that she wants to continue with the session.
- 22 With regard to the first difference, I agree that the prior art does not disclose storing messages during session transfer.
- 23 With regard to the second difference, the prior art clearly discloses a first session between Bob and Alice's laptop computer in step 23. It also implicitly discloses establishing a connection between the CPM system and Alice's mobile phone for transferring session history to Alice's mobile in step 25. It also discloses switching the existing (first) CPM session from the laptop to the mobile phone for new messages. I therefore agree that the prior art does not explicitly disclose separation of session history/stored messages and new messages in terms of sessions and time. However I believe that the skilled person would consider the steps 21 to 26 of the prior art (described as a "flow") to occur generally in time sequence. So the

session history is sent to Alice's mobile (although not necessarily received) in step 25 before the existing session is switched from laptop to mobile.

Step (4): Viewed without any knowledge of the alleged invention as claimed, do those differences constitute steps which would have been obvious to the person skilled in the art or do they require any degree of invention?

- 24 Mr Clarke argued that storing messages has an identifiable technical advantage of increasing continuity of communications by ensuring that messages are not dropped during session transfer. However I am of the opinion that in designing a protocol for session transfer, not dropping or losing messages would be an obvious requirement. There would be little point in the prior art of Alice receiving the session history "so she can remember the context of the discussion" if the most recent messages from Bob were dropped. The skilled person would therefore almost certainly want to capture and forward messages received during session transfer and the obvious way to do this would be to store messages received at the call server. This difference does not confer an inventive step.
- 25 Turning to the second difference, Mr Clarke maintained that the prior art only discloses a single new session for transmission of session history, stored messages and new messages. He drew my attention to a passage on page 7 of the prior art which reads:
- An underlying assumption is that a CPM conversation should only be composed of one CPM Session at a given time
- 26 He stated that this implies that the first session between Bob and Alice's laptop must be halted before a second session is established, there being no basis for any other interpretation.
- 27 He asserted that transmitting service history/stored messages in a second session and new messages in a third session after transmission of service history/stored messages is completed provides the technical advantage of combating congestion, as a result of separating in time the transmissions and each session having a separate buffer at the receiver.
- 28 It is not clear to me that the prior art only discloses a single new session. On the contrary, I believe that the skilled person, on reading steps 21 to 26 of the prior art, would understand there to be a number of ways of implementing these steps. One way would be to have a single new session. Another obvious way, strongly implied by the wording of steps 25 and 26, would be to use two new sessions: a (second) session for transferring session history and a (third) session created when switching the existing (first) session. This method is further implied by the sequential order of the steps and by the fact that Alice "selects the CPM session" in step 23 for session history transmission (second session) and then again "selects the target CPM session" in step 26 to "continue the discussion" (third session). It would seem unnecessary to select twice for only one new session. This sequence of steps gives Alice the option of reviewing the conversation on her mobile before deciding to continue.

- 29 I am not convinced that the passage on page 7 of the prior art provides any assistance in interpreting steps 21 to 26. Contrary to Mr Clarke's assertion, it seems to me that during session transfer in the prior art, when the session history is sent in step 25 (suggesting a second session), there is still an "existing CPM Session" which is afterwards switched in step 26. In other words two CPM sessions are in place at the same time.
- 30 Finally, although the prior art does not disclose sending a message indicating completed acquisition of session history (as required by claim 1), sending such acknowledgements is conventional. Furthermore, although it is possible for Alice to select the target CPM session in step 26 before the session history has been received, the skilled person would understand that it is equally likely that, in practice, Alice would select the target CPM session in step 26 after seeing all the session history on her mobile. This would be desirable as she can make an informed decision to continue or not.
- 31 For the reasons set forth I therefore conclude that the invention lacks an inventive step over the prior art.

Second set of claims

- 32 Steps 1(a) and 1(b) of the *Windsurfing/Pozzoli* test are the same for all sets of claims so I shall go straight to step 2.

Step (2): Identify the inventive concept of the claim in question or if that cannot readily be done, construe it

- 33 Claim 1 of the second set of claims adds the steps of receiving a first reply to the session transfer request and a second reply to the same session transfer request. Mr Clarke argued that this is an additional inventive concept of two reply messages to a single request, allowing two new sessions to be established from one request.
- 34 I am willing to accept this interpretation.

Step (3): Identify what, if any, differences exist between the matter cited as forming part of the "state of the art" and the inventive concept of the claim or the claim construed

- 35 Mr Clarke reiterated that there is no technical subject matter in the prior art and no detail regarding replies to session requests.
- 36 I agree that the additional steps are not present in the prior art.

Step (4): Viewed without any knowledge of the alleged invention as claimed, do those differences constitute steps which would have been obvious to the person skilled in the art or do they require any degree of invention?

- 37 Mr Clarke argued that the new steps would not be obvious to the skilled person as it is an unconventional approach. Conventionally each new session requires a single request and single reply. The invention provides the technical advantage of indicating, using conventional message types, that two different sessions are to be

established. New message types and additional data are not required. Also the reduction in the number of messages provides a more efficient messaging system.

- 38 The prior art does not disclose two replies to a single session request resulting in two new sessions. I have already stated that the skilled person would appreciate that two new sessions are a possible option in the prior art. However the fact that Alice “selects the CPM session” in step 23 for session history transmission (second session) and then again “selects the target CPM session” in step 26 to “continue the discussion” (third session) seems to suggest that for two sessions, two requests are required. This would teach away from the concept embodied in claim 1.
- 39 I therefore conclude that the invention defined in claim 1 (and correspondingly in claim 5) of the second set of claims is inventive over the prior art.

Third set of claims

- 40 Since I have found the second set of claims to have the required inventive step, there is no need to consider the third set of claims.

Conclusion

- 41 I find the invention defined by the present claims to lack an inventive step over the prior art. I therefore refuse the application under section 18(3) as it currently stands.
- 42 However, I find the invention as defined in the second set of claims to be inventive over the prior art. I hereby give the applicant one month from the date of this decision to formally submit these amendments, noting that consequential amendments to the description will also be required.
- 43 Since the extended section 20 period for putting the application in order for grant expires on 7 July 2015, the applicant will need to file a further Form 52 and fee to request a discretionary extension if he wishes to submit amendments.

Appeal

- 44 Any appeal must be lodged within 28 days after the date of this decision.

MRS SE CHALMERS

Deputy Director, acting for the Comptroller