

**HIGH COURT OF DELHI
CORAM: JUSTICE PRATHIBA M. SINGH
Date of Decision: 2nd April, 2024**

C.A.(COMM.IPD-PAT) 395/2022

GOOGLE LLC Appellant

Versus

THE CONTROLLER OF PATENTS Respondent

Legislation:

Section 117A of the Patents Act, 1970
Sections 2(1)(ja), 15, 11 of the Patents Act, 1970
Articles 54 (1) and (2), 56, 83, 84, 123(2) EPC (European Patent Convention)

Subject: Appeal against the refusal of a patent application titled 'Managing Instant Messaging Sessions on Multiple Devices' (Application No. 5429/DELNP/2007) on the grounds of lack of novelty, inventive step, and non-patentability under Section 3(k) of the Act.

Headnotes:

Patent Refusal - Managing Instant Messaging Sessions - Refusal by Controller on grounds of lack of novelty, inventive step, and non-patentability under Section 3(k) - Key features: Concurrent Sign-on and Session Transfer, User Preference for Non-Mirroring, Selective Transfer and Visibility of Sessions, Ceasing Message Visibility Based on Preference [Paras 25-27, 44-45, 51-52].

Prior Art D1 (US2003101343) - Detailed analysis comparing the patent application and prior art - Found significant overlap in functionalities, especially regarding session data transfer and user preferences - Court held that additional features in the subject patent were obvious extensions and lacked inventive step [Paras 28-34, 36-38, 40-41, 47-49].

Inventive Step Analysis - Application of established tests and considerations - Concluded that the subject patent application's features were obvious to a person skilled in the art [Paras 42-43, 51-52].

Misrepresentation by Appellant - Incorrect submission regarding status of corresponding European patent application - Rejection of both parent and divisional applications by EPO for lack of inventive step - Imposition of costs for presenting incorrect facts [Paras 53-55, 56-57].

Decision - Patent application by Google LLC for managing instant messaging sessions found lacking in inventive step and novelty - Claims considered obvious extensions of prior art D1: US2003101343 - High Court dismissed

the appeal, affirming the decision of the Controller of Patents to refuse the patent application.

Referred Cases:

- Murata Manufacturing Company Limited T0970-00-3.4.2
- Avery Dennison Corporation v. Controller Of Patents And Designs (2022/DHC/004697)
- Agriboard International LLC v. Deputy Controller of Patents & Designs [C.A.(COMM.IPD-PAT) 4/2022]
- Actavis v. ICOS [2019 UKSC 15]
- F. Hoffmann-La Roche Ltd. and Ors. v. Cipla Ltd., 2016(65) PTC 1 (Del)
- Windsurfing International Inc. v. Tabur Marine Ltd., [1985] RPC 59
- Pozzoli Spa v BDMO SA, [2006] EWHC 1398 (Ch)

Representing Advocates:

Mr. Vineet Rohilla et al. for the appellant

Mr. Arjun Mahajan, SPC with Mr. Apoorv Upmanyu for the respondent

JUDGMENT

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Prathiba M. Singh, J.

1. This hearing has been held through hybrid mode.

A. Background

2. The present appeal under Section 117A of the Patents Act, 1970 (hereinafter '*the Act*') was originally filed by the Appellant- Google LLC before the Intellectual Property Appellate Board (hereinafter, '*IPAB*') in the year 2020. Thereafter, upon the abolition of the IPAB and the enactment of the Tribunals Reforms Act, 2021, the present appeal stood transferred to this

Court. The Appellant seeks *inter alia* an order to set aside the order dated 27th November, 2019 (hereinafter, '*impugned order*') issued by the Respondent.

3. The Appellant company is a Delaware Limited Liability Company (LLC) incorporated under the laws of United States of America located at Amphitheatre Parkway, Mountain View, California, 94043 and is the Assignee of the subject patent application by virtue of an assignment between the original applicant AOL LLC and Google LLC.
4. Vide the impugned order, the application for grant of a patent bearing number 5429/DELNP/2007 titled '*Managing Instant Messaging Sessions on Multiple Devices*' (hereinafter '*subject patent*') of the Appellant was refused by the Id. Assistant Controller of Patents and Designs (hereinafter '*Controller*') under Section 15 of the Act. The subject patent application was filed on 13th July, 2007 before the Indian Patent Office (hereinafter '*IPO*'). It was filed as a PCT National Phase application claiming priority from a US Patent application i.e., application no. US 11/025,849. The priority date of the subject patent application is 30th December, 2004. The international filing date of the corresponding PCT application, bearing number PCT/US2005/047358 is 30th December, 2005 and accordingly, the term of the patent, if granted, comes to an end on 29th December, 2025. The subject patent application was published as per Section 11 of the Act on 17th August, 2007. The Appellant filed a Request for Examination on 19th November, 2008.
5. Initially, after the filing of a Request for Examination by the Appellant, the IPO issued a First Examination Report ('*FER*') dated 25th November, 2014 citing three prior art documents and raising objections of lack of novelty and inventive step, as also an objection under Section 3(k) of the Act. Other objections regarding insufficiency of disclosure, lack of clarity, and other procedural issues, were also raised by the Controller in the said FER.
6. The prior art documents D1: US2003101343 as also D2: US2004068567, were cited by the Controller in support of the objection for lack of novelty. To substantiate the objection of inventive step, the Controller cited an additional prior art document D3: US2003055977. As per the Controller, the said prior arts disclosed the invention and when read together disclosed all the embodiments of the application. The details of the cited prior arts are hereinunder:
 - D1: US2003101343 titled '*System for providing continuity between messaging clients and method therefor*', published on 29th May, 2003.

- D2: US2004068567 titled '*Method and system for transferring a computer sessions between devices*', published on 8th April, 2004.
 - D3: US2003055977 titled '*System for automated, mid-session, userdirected, device-to-device session transfer system*', published on 20th March, 2003.
7. In response to the said FER, the Appellant filed a reply dated 24th November, 2015 along with an amended set of claims. In order to overcome the objections under requirement for novelty and inventive step, the Appellant amended the claims to introduce the following features:
- *"in response to determining that a user is signed on concurrently to a first instant messaging controller on a first device and a second instant messaging controller on a second device, enabling the user to select one or more instant messaging sessions to transfer to the second instant messaging controller"*
 - *"receiving from the user a preference not to mirror transferred instant messaging sessions during an idle or away state"*
 - *"making user-inspired instant messages perceivable on both the first instant messaging controller on the first device and the second instant messaging controller on the second device so that the user is able to view an entire instant messaging conversation of user-inspired messages and co-user messages on the first instant messaging controller and the second instant messaging controller"*
8. The Appellant in its response to the FER stated that the abovementioned features would overcome the objections of novelty and inventive step. To overcome the objections under Section 3(k) of the Act, the Appellant relied on the technical effect exhibited by the messaging controllers to initiate the transfer of messaging sessions and enabling instant messaging sessions on parallel devices.
9. Thereafter, a hearing notice dated 3rd March, 2017 was issued by the IPO retaining the objections of lack of novelty, inventive step and nonpatentability under Section 3(k) of the Act. The said hearing was fixed for 15th March, 2017. After the hearing, the Appellant submitted the written submissions and a new set of amended Claims dated 30th March, 2017. In the said written submissions the Appellant claimed that the subject invention had differentiating features in comparison to the cited prior arts. In particular, the Appellant claimed that none of the cited prior arts disclosed the feature of interruption to mirroring, nor mirroring the messaging sessions during idle or away state. The Appellant further stated that the feature of ceasing of instant messaging in response to the user preference when the messaging controller is in idle or away state, was also absent in the cited prior arts. To address the

objection raised under Section 3(k) of the Act, the Appellant stated that the subject matter of the application involved technical steps enabled by the hardware features resulting in technical effect, and thus the same ought to be granted a patent. However, despite the contentions made by the Appellant, the Controller refused the application for grant of the patent under Section 15 of the Act, and the impugned order was passed. Aggrieved by the impugned order, the Appellant has filed the present Appeal.

B. Submissions

10. In the present appeal, notice was issued vide order dated 25th July, 2022 and subsequently, pleadings were completed. The appeal was taken up for hearing. Ld. Counsel for the Appellant submitted that the premise of the objections of the Id. Controller were based on the teaching of only one prior art document, i.e., D1: US2003101343. Ld. Counsel took the Court through the Complete Specification of the subject patent application and the prior art D1. Further, the Appellant also submitted a comparative chart of the pending Claims of the subject patent application and extracts of prior art D1.

11. According to Id. Counsel, there were two main features in the subject patent application which were not disclosed in the prior art document D1. Firstly, the preference which the users can give to cease instant messaging while the devices are in an idle stage and secondly, the conscious choice of the user to trigger the instant messaging feature. As per Id. Counsel for the Appellant, the prior art only relates to transmission of messages between two devices which is different from the Appellant's invention claimed in the subject patent application.

12. Ld. Counsel also submits that the corresponding patent applications have been granted in the USA and Canada. Upon a query from this Court as to whether the corresponding patent was applied before the European Patent Office (hereinafter, 'EPO'), Id. Counsel for the Appellant submitted that the corresponding patent application before the EPO was abandoned.

13. Considering the technical nature of the matter, vide order dated 22nd November, 2023 the Court had directed a concerned official from the IPO to be present to assist the Court. Parties were also permitted to file written submissions. Accordingly, when the appeal was taken up for hearing on 13th December 2023, Mr. Neeraj Tayal, Id. Deputy Controller of Patents (hereinafter 'Deputy Controller'), appeared before the Court virtually and submitted that the Appellant was attempting to obtain a monopoly on the features of receiving of a preference and also the conscious preference of the user to trigger the instant messaging feature i.e. not to mirror the same

content in two devices. These functionalities, according to the Id. Deputy Controller, are clearly contained in the prior art document.

14. In support of his assertions, the Id. Deputy Controller referred to pages 81 and 91 and paragraphs 32 and 97 of the cited prior art D1: US2003101343 to substantiate his argument. According to the Id. Deputy Controller, the ceasing of the instant messaging is discussed in prior art D1 when there is completion of a data transfer, *albeit* not explicitly in an idle or away state. However, he submitted that a comprehensive analysis of prior art D1 provides sufficient motivation for a person skilled in the art to extrapolate from existing functionalities and develop a conscious feature for mirroring messaging sessions during idle or away states.

15. While acknowledging that novelty might not be compromised, Mr. Tayal suggested that the inventive step would be affected by the perceived overlap between the teachings of D1 and the subject patent application. He contended that the logical progression and foreseeable evolution of messaging communication systems, as evidenced by D1 read with other prior arts, could provide the groundwork for integrating additional features aimed at enhancing user experience and session continuity. Thus, Mr. Tayal submitted that while the subject patent may introduce a novel feature, it would still be obvious and lacking inventive step in view of the scope of existing technologies and practices outlined in the prior arts.

16. In addition, Mr. Arjun Mahajan, Id. Counsel appearing for the Respondent submits that the Appellant has not disclosed true facts in respect of the corresponding European patent application bearing application number EP 05 855 851.1. It is his submission that the corresponding European patent application was rejected by the EPO Examining Division vide decision dated 18th December, 2015, which held that subject patent invention lacked novelty and inventive step. Id. Counsel referred to paragraphs 1.2.2, 2.2.2, and 2.2.4 from the Section '*II. Reasons for the decision*' of the said decision as also the final conclusion of the decision of the EPO.

17. At this stage, Id. Counsel appearing for the Appellant, Mr. Vineet Rohilla, has attempted to distinguish the subject patent application from the prior art cited by the Controller, by arguing that in the Complete Specification of the subject patent application i.e., both in the claims as also in the drawings (at page 47), a clear option is given to the user for the purposes of setting up preference as to whether the user would like the viewing of the instant messaging session on the device when the device is in idle or away state.

This, according to him, is a step forward from the disclosure in the prior art D1.

18. Mr. Vineet Rohilla, Id. Counsel points out that in the prior art D1, the idle or away state is discussed, however, there is no preference given to the user. The adding of a preference is also not motivated from D1 as the purpose of D1 as stated in paragraph 14 of the said prior art is to have a continuity and not for giving a preference to the user. Therefore, he urged that the prior art document, D1 would not destroy novelty and in any case, since there is no motivation, the inventive step is also would not be affected.

19. Ld. Counsel for the Appellant further argued that the USPTO which has granted the subject patent had also considered the office action of the EPO as also the First Examination Report issued by the IPO. However, the patent was still granted, and thus, some credence ought to be given to the same. Finally, it is his submission that an *ex post facto* analysis of a patent application is not permissible while judging inventive step. For the said purpose, he relied upon the decision dated 15th September, 2004 of the Board of Appeal of the European Patent Office in ***T 0970/00 – 3.4.2*** concerning ***Murata Manufacturing Company Limited***.

20. Mr. Neeraj Tayal, Id. Deputy Controller countered the submissions of the Appellant on the basis of para 32 of the prior art D1. He submitted that a comprehensive reading of the said paragraph would demonstrate that the plurality of session preferences includes one session for timeout setting for participation in the messaging session which is the actual feature claimed by the Appellant in the subject patent application. He emphasises that the presence of the timeout setting is as part of the plurality of session preferences discussed in the prior art D1.

21. Mr. Vineet Rohilla, Id. Counsel counters the above submission and submits that while the messaging session is on in one device, the user cannot be given a preference in D1 to mirror or not in the other device. Ld. Counsel for Appellant asserts that in the prior art D1, there is no provision for the user to choose whether to mirror the messaging session on another device while the session is ongoing on one device.

22. The Court has considered the submissions of both the parties, the prior arts and authorities cited as also the record of the prosecution of the subject patent before the Indian Patent Office as also some of the other IP Offices.

C. Analysis and Findings

23. The impugned order would show that the IPO has refused the subject patent application on the ground of lack of novelty and inventive step. The Controller has cited the same three prior art documents, as cited in the FER, to substantiate the grounds for refusal of the subject patent application. The relevant extracts of the impugned order are set out below:

“Now, regarding objections 1 and 2, that claims 1-17 lack novelty and inventive step in view of prior art document D1: US 20030101343 and inventive step in view of the documents D1, D2: US 20040068567 and D3: US 20030055977; it is submitted that-inter-alia the step of "receiving from the user a preference not to mirror transferred instant messaging sessions during an idle or away state" and "in response to the preference, ceasing instant messages being perceivable on the first messaging controller when the first messaging controller is in an idle or away state" as recited in claim 1 is not taught or disclosed by any of the cited references.

xxx

xxx xxx

Even if any argument against novelty is considered, the proposed solution in form of allowing the user to set a preference not to mirror sessions in an idle or away state cannot be said to be not obvious to a person skilled in the art, in view of the above findings.

No other feature, as distinguished from the citations, is put forth by the Patent Agents of the applicant during the hearing submissions.

Thus, in view of the aforementioned facts, the objections, as regards, that the subject matter of claim is not new and lacks inventive step, persist. The instant application no. 5429/DELNP/2007 does not comply with the requirements of The Patents Act, 1970. I, therefore, hereby order that the grant of a patent is refused under the provisions of Section 15 of 'the' Act.

24. After assessing the record and considering all the submissions and authorities cited, the present appeal raises the following question that deserve consideration:

- (i) Whether the rejection of the Appellant's patent is sustainable or not?
- (ii) Whether the subject invention satisfies the other tests of novelty, inventive step and industrial application and is entitled to the grant of patent protection?

C1. Claim Construction

25. As set out in the introductory paragraphs, the subject patent application, filed on 13th July, 2007 is titled as '*Managing Instant Messaging Sessions on Multiple Devices*'. The patent specification as filed had 20 claims. The same are extracted as **Appendix 1** herewith. In the originally

filed Claims, all the 20 claims were method Claims. The subject patent application, however, after amendment, describes a system for managing instant messaging sessions across multiple devices.

26. For the purpose of this appeal, the claims considered in the present appeal are the amended set of claims filed at the stage of hearing before the Patent Office, i.e., a total of 17 claims extracted in **Appendix 2** herewith. The first independent claim of the subject patent application is set out below:

“1. A method (100) for transferring instant messaging sessions, the method comprising: in response to determining that a user is signed on concurrently to a first instant messaging controller (725) on a first device (325a) and a second instant messaging controller (740) on a second device (325b), enabling the user to select one or more instant messaging sessions to transfer to the second instant messaging controller; receiving from the user a preference not to mirror transferred instant messaging sessions during an idle or away state; receiving a selection (105), from a user within a user interface, of at least one instant messaging session from among multiple instant messaging sessions to transfer from the first instant messaging controller on the first device to at least the second instant messaging controller on the second device; transferring (115) at least a portion of the selected instant messaging session from the first instant messaging controller on the first device to the second instant messaging controller on the second device; and making (120) the transferred portion of the instant messaging session perceivable on the second instant messaging controller on the second device; making user-inspired instant messages perceivable on both the first instant messaging controller (725) on the first device (325a) and the second instant messaging controller (740) on the second device (325b) so that the user is able to view an entire instant messaging conversation of user-inspired messages and co-user messages on the first instant messaging controller and the second instant messaging controller; and in response to the preference, ceasing instant messages being perceivable on the first messaging controller when the first messaging.”

27. From a perusal of the above extracted Independent Claim, it is clear that the subject patent application primarily discloses the feature for transferring instant messaging sessions concurrently between devices, such as desktop and personal digital assistant ('PDA'), allowing users to continue conversations on different devices. Additionally, the subject application discloses that the system mirrors instant messaging sessions across devices and refresh sessions interrupted by idle or away states i.e., users can indicate their preference for their instant messaging sessions not to be mirrored or duplicated when they are not actively using the messaging application, such as when they are idle or away. Further, the method claimed in the subject patent application provides flexibility in managing instant messaging sessions across multiple devices, allowing for seamless continuation of conversations while also respecting the privacy of the user and also availability preferences.

Specifically, the subject patent application enables the following features:

- Concurrent Sign-on and Session Transfer
- User Preference for Non-Mirroring
- Selective Transfer of Sessions
- Perceivability of Transferred Sessions
- Visibility of User-Inspired Messages
- Ceasing Message Visibility Based on Preference

C2. Assessment of Prior Art

28. At the outset, it is observed that both parties have only pressed into service only one prior art designated as D1, which is a patent application with the following bibliographic details:

Patent Application Publication No.	US 2003/0101343 A1
Publication Date	29 th May, 2003
Title of Application	System For Providing Continuity Between Messaging Clients and Method
Patent Granted	US6983370B2
Date of Grant	3 rd January, 2006
Current Assignee/ Patentee	Google Technology Holding LLC (initially filed by Motorola Inc.)
Status	Active

29. As briefly discussed above the prior art document D1 discloses a messaging communication system provides a structured framework for realtime communication among users through various messaging sessions. It enables users to customize their communication experience through client and session preferences, facilitating efficient and personalized messaging interactions. Relevant figures of the said prior art document are set out hereinbelow for ready reference.

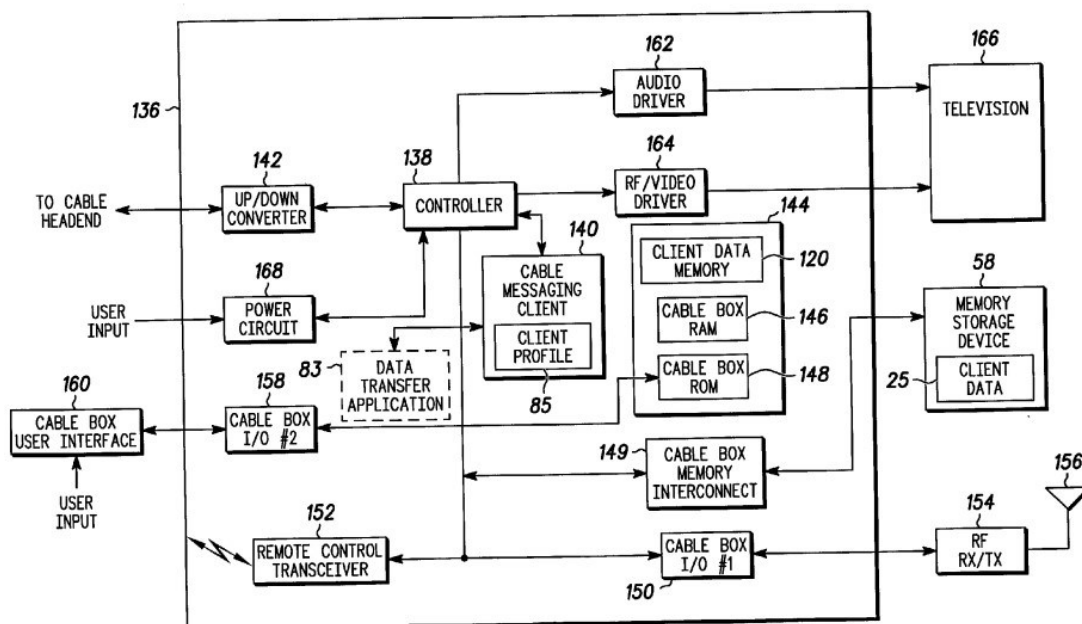
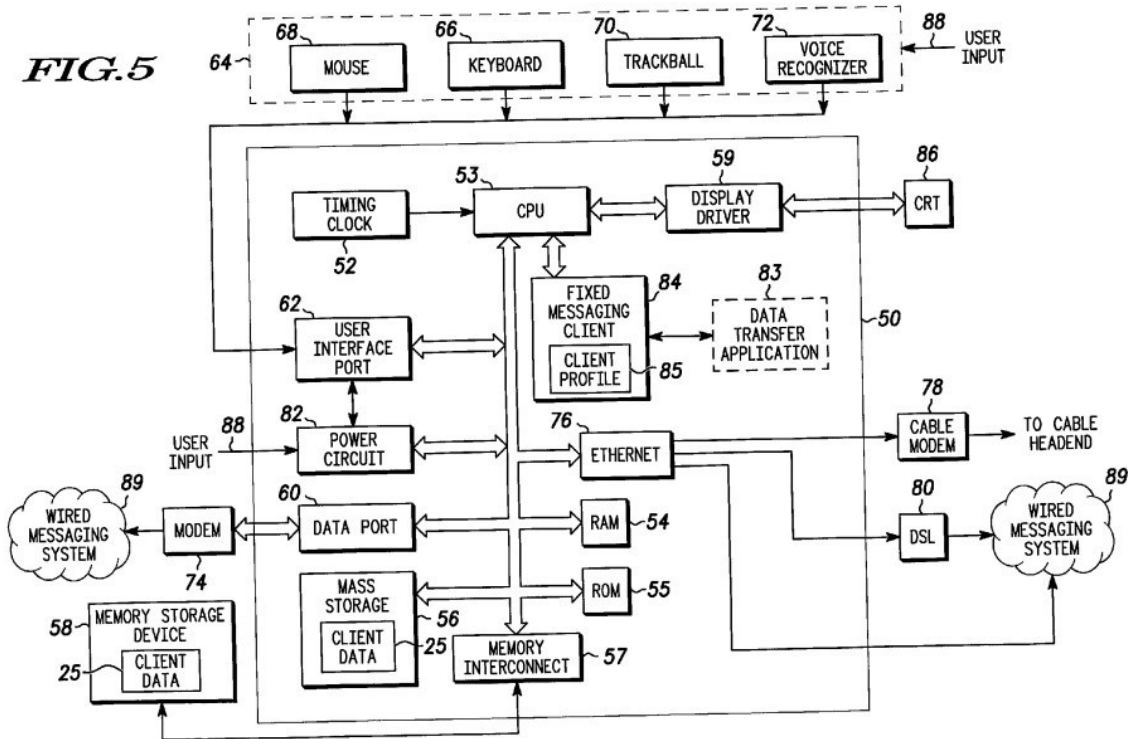
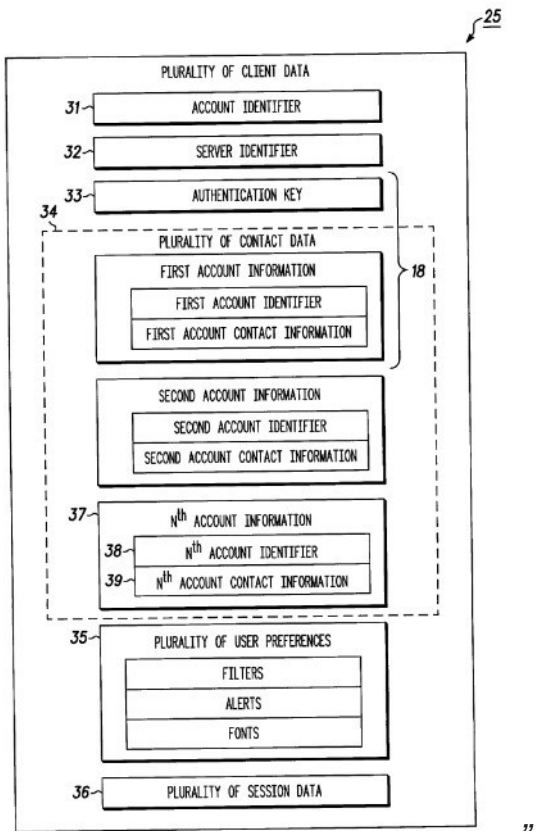


FIG. 7

30. The abstract of the subject patent application outlines a messaging communication system where one client establishes a connection and transfers data to another client. The receiving client then uses that data to establish its own connection. The abstract of the subject patent specification is extracted as under:

“A messaging communication system (10) includes a plurality of messaging clients (12). A first messaging client (14) establishes a first communication connection (16) operating using a plurality of client data (25). The first messaging client (14) transfers the plurality of client data (25) to a second messaging client (20). The second messaging client (20) establishes a second communication connection (22) operating using the plurality of client data (25).”



31. A perusal of this prior art document D1 would show that the background art discussed is in respect of the manner in which continuous messaging is enabled between users of multiple electronic devices. Such messaging could be between two individuals or even as part of private chat rooms wherein the user can enter through an invitation or an unrestricted public chat room or a limited access public chat room. The background of D1 discusses the manner in which the users can use different devices for participating in the messaging communication. It also sets out the manner in which, if a particular user has logged onto a device and is engaging in a conversation and needs to again log on from a second device, for example, from a fixed to a mobile device, the user may be required to disconnect the first device and again log in to the messaging platform. The user, however, may not have the history of the chat or the messaging on the second device owing to the discontinuity, though the user may be able to participate in the messaging. This background of the state of the art is captured in the D1 as under:

“[0011] Some messaging services support access of a single account from multiple devices. Further, some messaging services also support simultaneous login of devices on the same account. Still further, some messaging services utilize a resource extension to describe the device that is being utilized to communicate. For example an account user logging in with a mobile device can choose to use "mobile device" as their resource extension while logging into the same account from the home personal computer may utilize a resource extension of "home computer".”

[0012] When using messaging services that allow access from multiple devices, an account user can log on with a first messaging device and engage in conversations with other account users and

later log on with a second messaging device. For example, users of mobile devices would typically benefit if a messaging session in progress on a fixed network device could be continued on a mobile device. This would allow the account user to continue the messaging session when the account user is no longer in proximity to the fixed network device. In addition the account user would benefit if a messaging session that was in progress on a mobile device could be continued on a fixed network device that may have a superior user interface.

*[0013] In order to switch to a different device with existing technology, the account user may have to cause the currently connected device to disconnect from the message server. The account user would then have to cause the second device to connect to the message server and login. Finally, the account user would have to re-initiate each messaging session (one-to-one, public chat, private chat, electronic game) that was in progress on the first device. The disadvantage of this method is the numerous manual operations required of the account user to change devices. A further **disadvantage is the lack of messaging session continuity.** For example, the second device will not have the session history that was available on the first device, and the second device may not be able to re-connect to chat rooms that restrict the number of active account users since another account user may have connected to the chat room after the account user's first device disconnected.*

32. Accordingly, the D1 states that the need for the invention is as under:

"[0014] What is needed is a system and method for maintaining continuity between messaging clients."

33. A perusal of the above background and the need of the invention as stated in D1 shows that there was a long felt need for users to be able to access messaging platforms from multiple devices without losing the continuity. This problem in the art is sought to be remedied by D1 through the invention, which has been patented by Motorola¹. The said prior art document seeks to patent an invention, which is a messaging communication system having a plurality of messaging clients with various features provided for users.

34. Some features, as are relevant for the present analysis are captured in paragraphs 32, 94 and 97 of the said prior art D1.

35. Paragraph 32 of the Complete Specification of the suit patent application describes a messaging communication system where an account user can set various session preferences for communicating within a messaging session. The said paragraph is extracted below:

"[0032] The plurality of session preferences 43 defines certain attributes settable by the account user 30 for communicating within the messaging session 40 using the messaging client 26. The plurality of session preferences 43, for example, can include

¹ 1 Now acquired by Google LLC

text font attributes, filter settings, blocking settings, alert settings, screen names, buddy list groups, electronic mailboxes, parental control settings, an alert option such as alert on receipt of a new real time message or no alert on receipt of a new real time message, guaranteed or non-guaranteed delivery, timeout setting for participation in the messaging session 40, and number of real time messages to retain in the session history 45 and to display. It will be appreciated by one of ordinary skill in the art that the plurality of session preferences 43, in accordance with the present invention, can include any of the session preferences mentioned herein or an equivalent. In one embodiment, the plurality of session preferences 43 includes a session timer. (not shown) The session timer is a preset time period upon which the messaging client 26 is active within the messaging session 40. The plurality of session preferences 43 in one embodiment is transferred to the messaging client 26 when the messaging session 40 is activated. Alternatively, the account user 30 manually can set the plurality of session preferences 43. Alternatively, a default set of session preferences can be preprogrammed in the messaging client 26 to enhance the efficiency of managing the participation in the plurality of messaging sessions 24. The plurality of session participants 44 includes each account user participating in the messaging session 40 along with the account identifier for each participating account user.

36. A perusal of the above extract would show that a user has an option of choosing various preferences for the session for communicating on the messaging platform. Such preferences include by way of illustrations:
- Type of Font
 - Filter settings
 - Alert settings
 - Blocking settings
 - Screen names
 - Parental control settings
 - Timeout settings
 - Number of messages to be retained in a session history
 - Number of messages to be retained and displayed
 - Timer for a session
 - Default settings of session preference, which can be programmed in a manner to enable the user to participate in the messaging sessions
 - Ability for the account user to manually set the session preferences
 - Transfer of session preferences to the messaging client when the messaging session is activated.
37. Further, paragraph 94 of the Complete Specification of the suit patent application outlines the operation of a messaging communication system, as depicted in a flowchart in FIG. 13 of the said prior art. The said paragraph

also discusses the transfer of session data between clients can be interpreted as a form of session continuity or synchronisation. The said paragraph is extracted below:

“[0094] FIG. 13 is a flowchart illustrating the operation of the messaging communication system 10,170 in accordance with the present invention. Beginning with Step 296, the first messaging client 14 establishes the first communication connection 16 for communication within at least one of the plurality of messaging sessions 24 within the messaging communication system 10,170. For example, when the first messaging client 14 operates within the fixed network device 50, the first messaging client 14 accesses the appropriate network and notifies the messaging communication system 10,170 of its connection information (i.e.: IP address and number of the port assigned to the first messaging client 14). Next, in Step 298, the process determines whether or not an authentication is required. It will be appreciated by one of ordinary skill in the art that an authentication can be required of the first messaging client 14, of the first account user 29 utilizing the first messaging client 14, or of the messaging device in which the first messaging client 14 operates, or an equivalent. In Step 300, when an authentication is required in Step 298, a first authentication is performed. The first authentication of Step 300 checks that the first account user 29 or alternatively the first messaging client 14 is authorized to establish the first communication connection 16 and/or authorized to participate within one or more of the plurality of messaging sessions 24. Next, in Step 302, when the first authentication of Step 300 is completed, and also when the authentication is not required in Step 298, the first messaging client 14 operates using the first communication connection 16 and accumulates the plurality of session data 36 for each messaging session 40 for which the first messaging client 14 is participating. In accordance with the present invention, the plurality of session data 36 can include the session identifier 41, the session priority 42, the session preferences 43, the session participants 44, or the session history 45. It will be appreciated by one of ordinary skill in the art that the plurality of session data 36 can include any of the items mentioned herein or an equivalent. Next, in Step 304, the process determines whether a data transfer is required or requested. A data transfer, in accordance with the present invention, is the capability for a first account user 29 to change communication means within the messaging communication system 10, 170 from the first messaging client 14 to the second messaging client 20. For example, when the first account user 29 establishes the first communication connection 16 using the fixed network device 50 and thereafter needs to become mobile, the first account user 29 can transfer the first client data 17 including the plurality of session data 36 accumulated for the first communication connection 16 to the second messaging client 20 which for example can operate on the mobile device 90. When no data transfer is required or requested in Step 304, the first communication connection 16 is maintained in Step 302, whereby the first messaging client 14 continues to accumulate the plurality of session data 36 for each messaging”

session 40 for which the first messaging client 14 participates. In Step 306, when a data transfer is required or requested in Step 304, the process determines if it is necessary to verify the second messaging client 20 prior to transferring the first client data 17 including the plurality of session data 36 to the second messaging client 20. When verification of the second messaging client 20 is required, the second messaging client 20 is verified in step 308. For example, the first messaging client 14 and the second messaging client 20 can both be pre-configured with a private value and the first messaging client 14 can exchange messages with the second messaging client 20 that verify that the second messaging client 20 has the correct private value. Next, in Step 310, after the second messaging client 20 is verified in Step 308 or when no verification is required in Step 306, the first client data 17 including the plurality of session data 36 is transferred from the first messaging client 14 to the second messaging client 20. It will be appreciated by one of ordinary skill in the art that a portion of the first client data 17 can alternatively be transferred in Step 310. It will further be appreciated by one of ordinary skill in the art that the transfer of the first client data 17 can be accomplished using a direct connection between the first messaging client 14 and the second messaging client 20 or a connection through the message server 172, both either via a network connection, a wireless connection such as through the wireless communication system 114, a Bluetooth connection, or IRDA connection, a wired connection such as through the wired communication system 89, a network connection separate from the wireless communication system, an RS-232 connection or the broadcast messaging system 274, or an equivalent.

38. The nature of pre-programmed session preferences as discussed in paragraph 97 deals with how some part of the data could be transferred from one messaging device to a second messaging device. It also discusses how the same could be triggered through different mechanisms, for example when the first device has a break in the power circuit or when a specific command is given from the fixed device or if there is a pre-programmed message to detect the activation of the second device. Paragraph 97 also recognises that the second device can request for transfer of some part of the data from the first device immediately upon the second device being activated.

“[0097] Similarly, the method illustrated by the flowchart of FIG. 13 allows messaging sessions to be easily transferred between different account users. For example, if the first account user 29 is a customer service representative and the first account user 29 is a participant in the plurality of messaging sessions 24 with customers. The first account user 29 may want to transfer a portion of the plurality of messaging sessions 24 to another account user 30 such as a second customer service representative. The second customer service representative would benefit from having, access to the session history 45 of the transferred messaging sessions. For example, the second

customer representative can avoid asking the customer for information already provided to the first account user 29. FIG. 14 is a flowchart illustrating more detail of the operation of the messaging communication system 10,170. Specifically, FIG. 14 illustrates various methods in which the data transfer query (Step 304 of FIG.13) can be answered in the affirmative. The operation begins with Step 302, in which the first messaging client 14 operates using the first communication connection 16 and accumulates the plurality of session data 36 for each messaging session 40 for which the first messaging client 14 is participating. Next, in Step 326, the process determines whether or not the first messaging device in which the first messaging client 14 operates has received a user input requesting the transfer of at least a portion of the first client data 17 including the plurality of session data 36. For example, when the messaging device in which the first messaging client 14 operates is the fixed network device 50 of FIG. 5, the first account user 29 can enter and manipulate information (including requesting the transfer of the first client data 17) by the user input 88 to the user interface 64, e.g., the keyboard 66, the "mouse,"68, the pen or puck activated tablet (not shown), the trackball 70, the audio activated command recognition processor 72, or the like. Similarly, when the first messaging device in which the first messaging client 14 operates is the mobile device 90 of FIG. 6, the first account user 29 can enter a user input such as a button press, a series of button presses, a voice response, or some other similar method of manual response initiated by the first account user 29 to the device user interface 110 of the mobile device 90. Similarly, when the first messaging device in which the first messaging client 14 operates is the cable box 136 of FIG. 7, the user input is made via the cable box user interface 160. It will be appreciated by one of ordinary skill in the art that the user input can be any of the 14 inputs mentioned herein or an equivalent. When a user input requesting the transfer of at least a portion of the first client data 17 including the plurality of session data 36 is not received by the first messaging device in which the first messaging client 14 operates, the process next, in Step 328 determines whether a user input requesting the transfer of at least a portion of the first client data 17 including the plurality of session data 36 has been received by a second messaging device in which the second messaging client 20 operates. For example, when the second messaging device in which the second messaging client 20 operates is the fixed network device 50 of FIG. 5, the first account user 29 can enter and manipulate information (including requesting the transfer of the first client data 17) by the user input 88 to the user interface 64, e.g., the keyboard 66, the "mouse,"68, the pen or puck activated tablet (not shown), the trackball 70, the audio activated command recognition processor 72, or the like. Similarly, when the second messaging device in which the second messaging client 20 operates is the mobile device 90 of FIG. 6, the first account user 29 of the mobile device 90 can enter a user input such as a button press, a series of button presses, a voice response, or some other similar method of manual response initiated by the first account user 29 to the device user interface 110 of the mobile device 90. Similarly, when the second messaging device in which the second messaging

client 20 operates is the cable box 136 of FIG. 7, the user input is made via the cable box user interface 160. It will be appreciated by one of ordinary skill in the art that the user input can be any of the inputs mentioned herein or an equivalent. When a user input requesting the transfer of at least a portion of the first client data 17 including the plurality of session data 36 is not received by the second messaging device in which the second messaging client 20 operates, the process next, **in Step 330 determines whether the second messaging client 20 is the mobile device 90, and if so, whether the transfer of at least a portion of the first client data 17 including the plurality of session data 36 is initiated in response to detection of a movement of the mobile device 90.** For example, the server processor 174 of the message server 172 can be programmed to track the location of each of the plurality of messaging clients 12, and transfer the plurality of session data 36 to the second messaging client 20 in response to the detection of a change of location of the mobile device 90 in which the second messaging client 20 operates. Alternatively, the mobile device 90 can include location-sensing capabilities such as a Global Positioning Satellite receiver, and in response to the detection of a change of location, send a request to transfer the plurality of session data 36.

Alternatively, the second messaging device in which the second messaging client 20 operates can detect its removal from a charging base. Alternatively, the second messaging device in which the second messaging client 20 operates may have a motion-sensing device such as a tilt sensor whose electrical properties change when under motion. When no device movement is detected or alternatively a device movement program is not included in either the mobile device 90 or the message server 172, in Step 330, the process continues to Step 331 in which it is determined whether or not the transfer of at least a portion of the first client data 17 including the plurality of session data 36 is required due to the activation of the second messaging client 20. The activation of the second messaging client 20 can be, for example, in response to a user input to a power circuit 15 that powers the second messaging client 20. Alternatively, the activation of the second messaging client 20 can be in response to an instruction command to activate sent from CPU 53 to the fixed messaging client 84 of the fixed network device 50, from the processor 102 to the mobile messaging client 112 of the mobile device 90, or from the controller 138 to the cable messaging client 40 of the cable box 136. In one embodiment of the present invention, the message server 172 is programmed to detect the activation of the second messaging client 20. In an alternate embodiment, the second messaging client 20 can request the transfer of at least a portion of the first client data 17 including the plurality of session data 36 upon being activated. When the second messaging client 20 is not activated in Step 331, the process continues to Step 332 in which it is determined whether the second messaging client 20 has connected to the message server 172. When no connection of the second messaging client 20 is detected, the process returns to Step 326 and continues checking for the various methods in which the data transfer query (Step 304 of FIG. 13) can be answered in

the affirmative. In Step 333, when there is an affirmative answer to any of the previous Steps 326 to 332, the query of Step 304 of FIG. 13 of whether or not to transfer data is answered in the affirmative.”

39. One of the submissions of the Appellant is that despite the broad disclosure in the prior art document D1, one feature that is not explicitly disclosed in the prior art D1 and is not contemplated is the feature of mirroring of data which is on the first device messaging platform to a second device simultaneously if the user prefers to do so or sets a preference.
40. However, the above extracted portions would show that the data can be easily transferred between the two devices of a particular user in various methods i.e.
 - after verification/authentication or without verification/authentication of the second device;
 - by pre-configuring the second device or by using a direct connection between the first and second device through a network connection between the two devices either wireless or through platform;
 - transfer triggered upon device activation, as described in Steps 330 and 331, in which the system determines whether the transfer of at least a portion of the data, including session data, from the first device is required due to the activation of the second messaging client.
41. D1, therefore, achieves a position wherein two devices of the same user are able to access, at least a part of the messaging or even the complete messaging history depending upon the preferences of the user. Thus, D1 also contemplates the requirement of a user being able to access such messaging platform through two devices simultaneously or consecutively, depending on the preference of the user.

C3. Tests for Assessment of Inventive Step and obviousness

42. This Court has also considered the decision of Technical Board of Appeal of the European Patent Office in ***Murata Manufacturing Company Limited T0970-00-3.4.2 decision cited T-0967/97 dated 15th September, 2004*** relied by the Appellant for submissions of *ex post facto* analysis. In the said decision the Board of Appeal had held as under:

“4.1.2 In the assessment of inventive step according to the problem-solution approach knowledge of the invention and its effects is not only inevitable by the very nature of the assessment, but also necessary, in particular when proceeding to the identification of the closest prior art and to the determination of the technical contribution achieved by the invention over the prior art. However, as repeatedly stressed by the Boards of Appeal (see “Case Law of the Boards of Appeal”, 4th ed, 2001, chapter I, section D-2), the primary purpose of the problem-solution

approach is the objective assessment of inventive step and consequently any ex-post facto analysis, and in particular any conclusion going beyond what the skilled person would have objectively inferred, without the benefit of hindsight knowledge of the invention, from the prior art is of necessity at variance with a proper application of the problem-solution approach (see decision T 967/97, not published in OJ EPO, point 3.3 of the reasons). This applies not only to – among others - the determination of the closest prior art ("Case Law of the Boards of Appeal", supra, chapter I, sections D3.3 and D-3.5), the formulation of the technical problem solved by the invention (supra, chapter I, section D-4.2), and the assessment of what would have been obvious to the skilled person in the light of the state of the art (supra, chapter I, section D-6.1), but also to the determination of the technical contribution of the invention to the prior art. Accordingly, the determination of the technical contribution achieved by the invention over the closest state of the art requires an objective and technically meaningful and consistent comparison of the claimed combination of structural and functional features with the technical information conveyed to the skilled person by the closest state of the art (point 4.1.3 below). Any attempt to interpret the disclosure of the closest prior art so as to distort or misrepresent, based on hindsight knowledge of the invention, the proper technical teaching of the disclosure in such a way that it artificially meets specific features recited in the claim under consideration (point 4.1.4 below) must therefore fail, especially as this would risk unfairly and tendentiously concealing the technical contribution of the invention (point 4.2.2 below) and prejudice the subsequent objective determination of the technical problem solved by the claimed invention."

43. In ***Avery Dennison Corporation v. Controller Of Patents And Designs (2022/DHC/004697)***, the guidelines for satisfying the test of obviousness has been laid down. The relevant portions of the said judgement are set out below:

"Test for Inventive Step/Lack of Obviousness

10. In order to decide this issue, some of the fundamental principles for determining the existence of an inventive step and the lack of obviousness need to be emphasised.

11. For determining inventive step or lack thereof, various approaches and tests have emerged over the years from decisions of courts/authorities as also from examination guidelines of patent offices from different jurisdictions. The same include: **i. Obvious to try approach:**

- This approach involves an analysis of whether in view of the teachings/solutions proposed in the prior art, it was obvious to try and arrive at the subject invention.

ii. Problem/solution approach:

- This approach considers whether in the light of the closest prior art and the objective technical problem, the solution claimed in the invention would be obvious to the skilled person. If the skilled person can decipher the solution being claimed, then the subject matter is held to be obvious.
- This test has been discussed by the Division Bench in *F. Hoffmann* (supra).

iii. Could-Would Approach

• In this approach the question that is raised is whether there is any teaching in the prior art as a whole that would and not simply could have prompted a skilled person, with the knowledge of the objective technical problem, to either modify or adapt the closest prior art to arrive at the subject matter of the claims.

iv. Teaching Suggestion Motivation (TSM test)

• This test originated in the USA as per which, if by the Teaching, Suggestion or Motivation from the prior art, an ordinary skilled person can modify the prior art reference or combine prior art references to arrive at the claimed invention, then the subject matter being claimed is obvious.

• However, the application of this test ought not to be done in a narrow manner as held by the US Supreme Court in the case of **KSR International v. Teleflex, 550 U.S. 398 (2007)**.

12. The above mentioned approaches to determining inventive step have been discussed and debated in various jurisdictions, including the UK, EPO, USA etc. These approaches have also been applied, even with modifications, in order to suit the facts and circumstances of each case by Courts.² Some of these approaches to determine lack of obviousness also find a mention in the Guidelines for Examination published by the European Patent Office.

13. One of the seminal tests for determining inventive step and lack of obviousness was first laid down by the House of Lords in **Windsurfing International Inc.**

v. Tabur Marine Ltd., [1985] RPC 59.

14. In **Windsurfing (supra)** the Court laid down a four-step test to determine whether a patent satisfied the requirement of inventive step and lack of obviousness. The said steps are as under:

- “1. Identifying the inventive concept embodied in the patent;
- 2. Imputing to a normally skilled but unimaginative addressee what was common general knowledge in the art at the priority date;
- 3. Identifying the differences if any between the matter cited and the alleged invention; and 4. Deciding whether those differences, viewed without any knowledge of the alleged invention, constituted steps that would have been obvious to the skilled man or whether they required any degree of invention.”

15. The tests laid down in **Windsurfing (supra)** were again considered by the England and Wales Court of Appeals in **Pozzoli Spa v BDMO SA, [2006] EWHC 1398 (Ch)** and modified by Jacob LJ as under:

- “1. (a) Identify the notional "person skilled in the art"
- (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 done, construe it;

² Actavis Group PTC EHF v. ICOS Corporation, [2019] RPC 9, Human Genome Sciences v. Eli Lilly [2012] RPC 6 and Johns-Manville Corporation, [1967] R.P.C. 479

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?"

16. The *Id. Division Bench* of this Court in **F. Hoffmann-La Roche Ltd. and Ors. v. Cipla Ltd., 2016(65) PTC 1 (Del)** added a further step as elaborated below:

Step No.1 To identify an ordinary person skilled in the art,

Step No.2 To identify the inventive concept embodied in the patent,

Step No.3 To impute to a normal skilled but unimaginative ordinary person skilled in the art what was common general knowledge in the art at the priority date.

Step No.4 To identify the differences, if any, between the matter cited and the alleged invention and ascertain whether the differences are ordinary application of law or involve various different steps requiring multiple, theoretical and practical applications,

Step No.5 To decide whether those differences, viewed in the knowledge of alleged invention, constituted steps which would have been obvious to the ordinary person skilled in the art

and **rule out a hindsight approach**"

xxx

xxx

xxx

18. The above approaches, tests and steps laid down by various courts and authorities – all seek to formulate the manner in which prior arts are to be analysed and a patent application is to be tested on the anvil of inventive step. None of the above approaches and tests are to be adopted in a straightjacketed manner. Each patent application, depending on the field of technology and the nature of the prior arts may require different approaches or tests to be followed or applied. In some situations, the Court may even adopt an approach of combining more than one test as was done by the UK Supreme Court in **Actavis v. ICOS, [2019] UKSC 15**. In the ultimate analysis, the examiner in the patent office or the Court adjudicating the issue would need to identify the elements in the prior art and compare the same with the claims in question from the point of view of a person skilled in the art, as was done by the *Id. Division Bench* of this Court in **3M Innovative Properties Ltd³**. If the same demonstrates a technical advancement over the prior art on the priority date of the application, then the patent would be liable to be granted. Unlike the test of novelty or anticipation which is easier to determine by a straight comparison with the prior art, in the case of obviousness, the attempt of the Court is conjectural – making it a rather difficult exercise.

³ FAO (OS) 292/2014 & CM No. 10651/2014 titled 3M Innovative Properties Ltd. and Ors. vs. Venus Safety and Health Pvt. Ltd. and Ors.

19. The decision of the UK Supreme Court in *Actavis (supra)* identified the ten relevant considerations to be made while assessing obviousness. The Court mentioned that the factors identified in the list are not exhaustive. The relevant considerations are: “(1) First, it is relevant to consider whether **something was “obvious to try” at the priority date**, in other words, whether it is **obvious to undertake a specific piece of research which had a reasonable or fair prospect of success**

...;

(2) Secondly, it **follows the routine nature of the research** and whether there is an established practice of following the research through to a particular point may be a relevant consideration which is weighed against the consideration that the claimed process or product was not obvious to try at the outset of a research programme. ...

(3) Thirdly, the **burden and cost of the research programme is relevant**. But the weight to be attached to this factor will vary depending on the particular circumstances....

(4) Fourthly, the **necessity for and the nature of the value judgments** which the **skilled team would have in the course of a testing programme** are relevant considerations

....

(5) Fifthly, the **existence of alternative or multiple paths of research will often be an indicator that the invention contained in the claim or claims was not obvious**. If the notional skilled person is faced with only one avenue of research, a “one way street”, it is more likely that the result of his or her research is obvious than if he or she were faced with a multiplicity of different avenues. But it is necessary to bear in mind the possibility that more than one avenue of research may be obvious ...

(6) Sixthly, the **motive of the skilled person is a relevant consideration**. The notional skilled person is not assumed to undertake technical trials for the sake of doing so but rather because he or she has some end in mind. It is not sufficient that a skilled person could undertake a particular trial; one may wish to ask whether in the circumstances he or she would be motivated to do so. The **absence of a motive to take the allegedly inventive step makes an argument of obviousness more difficult** ...

(7) Seventhly, the fact that the **results of research which the inventor actually carried out are unexpected or surprising is a relevant consideration** as it may point to an inventive step ...

(8) Eighthly, the courts have repeatedly emphasised that **one must not use hindsight**, which includes knowledge of the invention, in addressing the statutory question of obviousness. That is expressly stated in the fourth of the *Windsurfing/Pozzoli* questions ...

(9) Ninthly, it is necessary to consider whether a feature of a claimed invention is **an added benefit in a context in**

which the claimed innovation is obvious for another purpose ...”

20. This Court in the case of **Agriboard International LLC. v. Deputy Controller of Patents & Designs [C.A.(COMM.IPD-PAT) 4/2022 dated 31st**

March, 2022] held that while rejecting an application for lack of inventive step, discussion on the prior art, the subject invention and manner in which the subject invention would be obvious to a person skilled in the art would be mandatory. Merely arriving at a bare conclusion that the subject invention lacks inventive step would be contrary to Section 2(1)(ja) of the Act itself, is insufficient. The relevant portion of the judgment reads as under: "24. In the opinion of this Court, while rejecting an invention for lack of inventive step, the Controller has to consider three elements-

- the invention disclosed in the prior art,
- the invention disclosed in the application under consideration, and
- the manner in which subject invention would be obvious to a person skilled in the art.

25. Without a discussion on these three elements, arriving at a bare conclusion that the subject invention is lacking inventive step would not be permissible, unless it is a case where the same is absolutely clear. Section 2(1)(ja) of the Act defines 'inventive step' as under:

(ja) "inventive step" means a feature of an invention that involves technical advance as compared to the existing knowledge or having economic significance or both and that makes the invention not obvious to a person skilled in the art.

26. Thus, the Controller has to analyse as to what is the existing knowledge and how the person skilled in the art would move from the existing knowledge to the subject invention, captured in the application under consideration. Without such an analysis, the rejection of the patent application under Section 2(1)(ja) of the Act would be contrary to the provision itself. The remaining prior arts which are cited by *Id.* Counsel having not been considered in the impugned order, the Court does not wish to render any opinion in this regard."

C4. Comparison of the subject Patent to the prior art D1

44. In the subject patent application, the title itself deals with managing instant sessions with multiple devices. The background of the subject patent application discusses the need for transfer of messaging sessions from one device to the other. The claims as filed, along with the complete specification of the subject patent application are method claims, which permit the user to have a preference for mirroring of the messaging sessions either during idle or an away state. Basis the analysis, it can be noted that though the word mirroring is not used in the prior art document D1, when the claims, description along with the flow charts and figures of the said prior art are compared with the claims of the subject patent with the figures, it makes it

quite clear that the purpose of the subject patent is also for viewing of instant messaging sessions on multiple devices. The mere fact that the preference can be given by the user as to whether the viewing should happen when the device is idle or away, would merely be one command to be given in the device and nothing more.

45. The 'preference' that the subject patent contemplates is, in fact, nothing but one of the illustrative preferences, which document D1 would also enable a person skilled in the art to arrive at and thus would be obvious to a skilled person. For example, the discussion in paragraph 32 sets out a large number of preferences of which, preference relating to viewing when the device is idle or away could be one such preference. Technologically or technically, the preference that is contemplated in the subject patent application could be one of the pre-programmed session preferences as contemplated in paragraphs 32 and 94 of the prior art document D1. Though such a preference is not specifically mentioned and thus, novelty of the subject patent would not be specifically hit, such a preference can be easily imagined by any person skilled in the art. It does not require any imagination or additional innovative technique for such a preference to be included.

46. During the course of arguments, Id. Counsel for the Appellant argued that the following features are not disclosed in the prior art D1:

- that while the messaging session is active or on in one device, the user cannot be given a preference to mirror or not in the other device;
- that there is no provision for the user to make a choice whether to mirror the messaging session on another device while the session is ongoing on one device.

47. In light of the discussion on paragraphs 94 and 97 of the prior art document D1, it is clear that paragraph 94 specifies the feature of transfer of session data, including session history, from one messaging client to another. This transfer implies that the messaging session, or aspects of it, can be replicated on another device, which is a fundamental aspect of mirroring. Further, paragraph 97 specifically mentions the transfer of messaging sessions between different account users. This disclosure clearly suggests that the system being defined in D1, is capable of moving an ongoing session from one device to another, which aligns with the concept of mirroring a session.

48. In respect of the contention that no option or choice is being given to the user to mirror sessions from one device to another, paragraph 32 introduces the concept of user-defined settings for messaging sessions.

Therefore, this flexibility implied by user preferences and the ability to transfer session data and sessions between devices indicate that users could potentially choose whether and also when to mirror sessions on another device.

49. In summary, while the subject patent application provides a specific implementation of user preferences for mirroring instant messaging sessions, the core concept of managing sessions across multiple devices and the flexibility of using user-defined settings for messaging session are already present in the prior art document D1. Moreover, when the actual manner and method of mirroring is already enabled, the same cannot be held to be inventive, merely by making the process automatic unless a negative preference is chosen by the user.

50. In view of circumstances of the present case, Id. Controller had cited the relevant portions of D1 during the examination at FER stage. The analysis of the subject patent application was conducted and the application was stated to be obvious during the FER stage itself not at a later stage. Thus, the argument of the Appellant does not hold in the present case.

51. In the present analysis, the comparison of the subject patent application to the prior art D1 clearly establishes the lack of inventive step.

52. In the opinion of this Court, by applying any of the settled tests the Controller is right when he holds that the step contemplated in the subject patent application lacks inventive step and is obvious to a person skilled in the art. The sum and substance of the above discussion is that despite the submissions made on behalf of the Appellant, the subject invention is not entitled for grant of a patent in view of lack of inventive step. Thus, the present appeal is not tenable and is liable to be dismissed.

D. Conduct of the Appellant

53. Additionally, one important fact also needs to be noted in the present case i.e. one of the submissions made on behalf of the Appellant was that the corresponding EU application of the subject patent was abandoned and not rejected by the EPO. However, Id. Counsel for the Controller of Patents points out that the corresponding subject patent application filed at EPO was not abandoned, but was in fact rejected by the EPO. The order of the EPO has recorded as under:

“The subject-matter of claim 1 is not novel.

2.2.2 Even if the division would consider the feature of allowing the user to set a preference not to mirror transferred instant messaging sessions during an idle or away state as not implicitly disclosed by allowing the user to set the session timer or allowing

the user to input signals to disconnect a client from continued session transfers and thus as a difference, then the same arguments as given in relation to claim 1 of the main request applies (reference is made to section 1.2.2 above). The feature would also lack an inventive step (Art. 56 EPC)

In addition, even if it was considered that the refreshing of messaging session on the first controller was not implicitly disclosed in D1, then such difference would represent a mere implementation choice based on circumstances that lacks inventive step in the sense of Art. 56 EPC.

Since there is no combined effect evident from the two potential differences they can be considered separately as juxtaposition features. The skilled person would therefore arrive at the claimed invention exercising any inventive step in the sense of Art. 56 EPC

54. In addition, it also deserves to be noted that a divisional application of the corresponding EU patent application (which was rejected) was also filed with an identical title at the EPO, which was again rejected on 21st March 2008. The reason for rejection of the divisional application is as under:

“2.3.1 Claim 1

Document D1 is considered to be the closest prior art, it discloses the features of claim 1 (refer to citations for corresponding features of claim 1 of the main request) with the difference of:

auto-selecting the device with the most complete instant messaging session from which to receive the selected instant messaging session if the session is mirrored at multiple other instant messaging controllers on multiple other devices

The division is of the opinion that the claimed invention proposes a mere automation of manual device selection functions previously performed by a human operator. However this alone is in line with the general trend in technology and thus can not be considered inventive according to Art. 56 EPC (refer also to T775/90).

Further, the whole application appears to lack any information on implementing details of on how such automation is to be achieved in the technical IM environment (see section 2.2.2 above).

Even if the division, for the sake of argument, would assume that the skilled person was able to perform the invention over the whole area claimed entirely by using his common general knowledge and without undue burden and without needing inventive skill (refer to EPO GL F-III 1), then any such subject-matter could not possibly involve an inventive step in the sense of Art. 56 EPC.

2.3.2 Dependent claims 2-11 do not appear to contain any additional features which, in combination with the features of any claim to which they refer, meet the requirements of the EPC with respect to inventive step (refer to the reasoning for the main request under section 1.3.2 above).

2.3.3 The subject-matter of claim 12 corresponds to that of any one of claims 1 to 11 expressed in terms of computer readable

media. The same objections as given in relation to claims 1 to 11 under 56 EPC are also applicable to claim 12.

2.4 Applicants arguments

None of the cited documents discloses the feature of autoselecting the device with the most complete instant messaging session, as required by amended claim 1. Furthermore, this feature is advantageous because the user does not need to engage with a user interface to select the device with the most complete session rather the device with the most complete session is auto-selected. This advantage cannot be achieved by any of the cited documents.

1.3.1 Division's response:

The division does not find the arguments convincing for the reasons stated in section 2.3.1 above.

III. Decision

Accordingly, as the requests on file of the European patent application do not comply with the requirements set out in the EPC, for the reasons given (Art. 54 (1) and (2), 56, 83, 84, 123(2) EPC), the application is refused according to Article 97(2) EPC.”

55. Considering the submission made that the EPO application was abandoned and coupled with the fact that the corresponding EU application for the subject patent comprised of not one but two applications, including a divisional application, and that they both were rejected for lack of inventive step, in the present appeal costs are also liable to be imposed. The Appellant in the present appeal not only presented wrong facts to the Court, but also failed to disclose the information regarding the refusal of the EU parent application as also of the divisional application which was filed consequently. Thus, the disclosure requirements under the Act are not complied with.

E. Directions

56. In view thereof, the present appeal is, accordingly, dismissed with costs of Rs. 1 lakh upon the Appellant. 50% of the costs shall be deposited with the office of CGPTDM and remaining 50% shall be paid to the Id. CGSC. 57. The Court would like to record its commendation for the Id. Deputy Controller – Mr. Neeraj Tayal, who assisted the Court in adjudication of the present appeal.

58. A copy of this judgement be sent to the Office of the CGPD TM at the email ID: llc-ipo@gov.in for compliance.

PRATHIBA M. SINGH

JUDGE
APRIL 02, 2024/dk/bh/am
F. ANNEXURE 1

What is claimed is:

1. A method for transferring instant messaging sessions, the method comprising:
 - receiving a selection, from a user within a user interface, of at least one instant messaging session from among multiple instant messaging sessions to transfer from a first instant messaging controller on a first device to at least a second instant messaging controller on a second device wherein the user is signed on concurrently to the first instant messaging controller on the first device and the second instant messaging controller on the second device; transferring at least a portion of the selected instant messaging session from the first instant messaging controller on the first device to the second instant messaging controller on the second device; and making the transferred portion of the instant messaging session perceivable on the second instant messaging controller on the second device.
2. The method as in claim 1 wherein receiving the selection includes receiving, from the first instant messaging controller on the first device, the selection of the instant messaging session from among multiple instant messaging sessions.
3. The method as in claim 1 where receiving the selection includes receiving, from the second instant messaging on the second device, the selection of the instant messaging; session from among multiple instant messaging sessions.
4. The method as in claim 1 wherein receiving the selection includes receiving the selection from within an instant messaging conversation interface.
5. The method as in claim 1 further comprising enabling presentation of a listing of the multiple instant messaging sessions to the user at the user interface to enable selection.
6. The method as in claim 1 further comprising enabling presentation of a listing of other instant messaging controllers on other devices to transfer the selected instant messaging session to the user at the user interface to enable selection when the user is signed on to multiple other instant messaging controllers on multiple other devices.
7. The method as in claim 1 wherein making the transferred instant messaging session perceivable includes making the transferred instant messaging session perceivable on both the first instant messaging controller on the first device and the second instant messaging controller on the second device.
8. The method as in claim 1 wherein making the transferred instant messaging session perceivable includes making the transferred instant messaging session perceivable on the second instant messaging controller on the

- second device to the exclusion of being perceivable on the first instant messaging controller on the first device.
9. The method as in claim 1 wherein: the user is signed on to, multiple instant: messaging controllers on multiple different devices; and making the transferred instant messaging session perceivable includes making the transferred instant messaging session perceivable on less than all of the instant messaging controllers on the corresponding devices.
 10. The method as in claim 7 further comprising: detecting an idle state or an away, state on the first instant messaging controller; and disabling perception of the instant messaging session on the first instant messaging controller on the first device in response to the detect idle state or away state.
 11. The method as in claim 10 further comprising:
detecting an active state on the first instant messaging controller; refreshing the instant messaging session on the first instant messaging controller on the first device; and making the instant messaging session perceivable on the first instant messaging controller on the first device.
 12. The method as in claim 11 wherein:
refreshing the instant messaging session includes refreshing the instant messaging session on the first instant messaging controller, on the first device automatically in response to detecting the active state and authentication; and making the instant messaging session perceivable on the first instant messaging controller on the first device includes automatically making the instant messaging session perceivable on the first instant messaging controller on the first device in response to the automatic refreshing.
 13. The method as in claim 11 wherein:
refreshing the instant messaging session includes refreshing the instant messaging session on the first instant messaging controller on the first device in response to input from the user requesting a manual refresh of the instant messaging session; and making the instant messaging session perceivable on the first instant messaging controller on the first device includes making the instant messaging session perceivable on the first instant messaging controller on the first device in response to refreshing.
 14. The method as in claim 1 further comprising enabling the user to perceive and select a subset of ongoing-instant messaging Sessions.
 15. The method as in claim 1 further comprising conditioning whether to present a listing of the multiple instant messaging sessions based on detection of three or more signed on concurrent instant messaging controllers.

16. The method as in claim 1 further comprising conditioning whether to present, at a new instant messaging controller on a new device, menu options that enable selection of which other instant messaging controllers on other devices to transfer one or more instant messaging sessions based on a sign, on to the new instant messaging controller at the new device.
17. The method as in claim 1 further comprising conditioning whether to present, at a new instant messaging controller on a new device, menu options that enable selection of whether to transition instant messaging sessions or to mirror instant messaging sessions on the new instant messaging controller and the new device.
18. The method as in claim 1 further comprising enabling the user to select a portion of the selected instant messaging session for transfer.
19. The method as in claim 1 further comprising enabling the user to select on a per device basis instant messaging session transfer preferences.
20. The method as in claim 1 further comprising making user-inspired instant messages perceivable on both the first instant messaging controller on the first device and the second instant messaging controller on the second device.

G. ANNEXURE 2

We claim:

1. A method (100) for transferring instant messaging sessions, the method comprising:
in response to determining that a user is signed on concurrently to a first instant messaging controller (725) on a first device (325a) and a second instant messaging controller (740) on a second device (325b), enabling the user to select one or more instant messaging sessions to transfer to the second instant messaging controller; receiving from the user a preference not to mirror transferred instant messaging sessions during an idle or away state; receiving a selection (105), from a user within a user interface, of at least one instant messaging session from among multiple instant messaging sessions to transfer from the first instant messaging controller on the first device to at least the second instant messaging controller on the second device; transferring (115) at least a portion of the selected instant messaging session from the first instant messaging controller on the first device to the second instant messaging controller on the second device; and making (120) the transferred portion of the instant messaging session perceivable on the second instant messaging controller on the second device; making user-inspired instant messages perceivable on both the first instant messaging

controller (725) on the first device (325a) and the second instant messaging controller (740) on the second device (325b) so that the user is able to view an entire instant messaging conversation of user-inspired messages and co-user messages on the first instant messaging controller and the second instant messaging controller; and in response to the preference, ceasing instant messages being perceivable on the first messaging controller when the first messaging controller is in an idle or away state.

2. The method as claimed in claim 1, wherein receiving the selection includes receiving, from the first instant messaging controller (725) on the first device (325a), the selection of the instant messaging session from among multiple instant messaging sessions.
3. The method as claimed in claim 1, wherein receiving the selection includes receiving, from the second instant messaging controller (740) on the second device (325b), the selection of the instant messaging session from among multiple instant messaging sessions.
4. The method as claimed in claim 1, wherein receiving the selection includes receiving the selection from within an instant messaging conversation interface (400).
5. The method as claimed in claim 1, wherein enabling presentation of a listing of the multiple instant messaging sessions to the user at the user interface to enable selection.
6. The method as claimed in claim 1, wherein making the transferred instant messaging session perceivable includes making the transferred instant messaging session perceivable on both the first instant messaging controller (725) on the first device (325a) and the second instant messaging controller (740) on the second device (325b).
7. The method as claimed in claim 1, wherein making the transferred instant messaging session perceivable includes making the transferred instant messaging session perceivable on the second instant messaging controller on the second device to the exclusion of being perceivable on the first instant messaging controller (725) on the first device (325a).
8. The method as claimed in claim 1 wherein:
the user is signed on to multiple instant messaging controllers on multiple different devices, and making the transferred instant messaging session perceivable includes making the transferred instant messaging session perceivable on less than all of the instant messaging controllers on the corresponding devices.
9. The method as claimed in claim 1 wherein:

detecting an active state on the first instant messaging controller; refreshing the instant messaging session on the first instant messaging controller (725) on the first device (325a); and making the instant messaging session perceivable on the first instant messaging controller on the first device.

10. The method as claimed in claim 11 wherein:
refreshing the instant messaging session includes refreshing the instant messaging session on the first instant messaging controller (725) on the first device (325a) automatically in response to detecting the active state and authentication; and making the instant messaging session perceivable on the first instant messaging controller (725) on the first device (325a) includes automatically making the instant messaging session perceivable on the first instant messaging controller on the first device in response to the automatic refreshing.
11. The method as claimed in claim 11 wherein:
refreshing the instant messaging session includes refreshing the instant messaging session on the first instant messaging controller (725) on the first device (325a) in response to input from the user requesting a manual refresh of the instant messaging session; and making the instant messaging session perceivable on the first instant messaging controller on the first device includes making the instant messaging session perceivable on the first instant messaging controller on the first device in response to refreshing.
12. The method as claimed in claim 1 wherein enabling the user to perceive and select a subset of ongoing instant messaging sessions.
13. The method as claimed in claim 1 wherein conditioning whether to present a listing of the multiple instant messaging sessions based on detection of three or more signed on concurrent instant messaging controllers.
14. The method as claimed in claim 1 wherein conditioning whether to present, at a new instant messaging controller on a new device, menu options that enable selection of which other instant messaging controllers on other devices to transfer one or more instant messaging sessions based on a sign on to the new instant messaging controller at the new device.
15. The method as claimed in claim 1 wherein conditioning whether to present, at a new instant messaging controller on a new device, menu options that enable selection of whether to transition instant messaging sessions or to mirror instant messaging sessions on the new instant messaging controller and the new device.
16. The method as claimed in claim 1 wherein enabling the user to select a portion of the selected instant messaging session for transfer.

17. The method as claimed in claim 1 wherein enabling the user to select on a per device basis instant messaging session transfer preferences.

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