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D E C I S I O N
of 19 September 2002

Case Number: T 0721/00 - 3.5.1
Application Number: 91917852.5
Publication Number: 0502173
IPC: H04N 1/21, H04N 1/387

Language of the proceedings: EN

Title of invention:

Mechanism for controlling presentation of displayed image

Patentee:

EASTMAN KODAK COMPANY

Opponent:

Spandern, Uwe

Headword:

Storage of digital images/EASTMAN KODAK

Relevant legal provisions:

EPC Art. 54(2), 123(2)

Keyword:

"Main and first auxiliary requests - novelty (no)"
"Second auxiliary request - added subject-matter (yes)"
"Third auxiliary request - novelty (yes)"
"Remittal to first instance (yes)"

Decisions cited:

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Catchword:

-



Case Number: T 0721/00 - 3.5.1

D E C I S I O N
of the Technical Board of Appeal 3.5.1
of 19 September 2002

Appellant: EASTMAN KODAK COMPANY
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Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 15 May 2000
revoking European patent No. 0 502 173 pursuant
to Article 102(1) EPC.

Composition of the Board:

Chairman: S. V. Steinbrener
Members: R. Randes
S. C. Perryman

Summary of Facts and Submissions

I. This appeal is against the decision of the Opposition Division revoking the European patent 0 502 173.

II. The Opposition Division revoked the patent on the grounds that the subject-matter of claim 1 of the main request was not novel, having regard to any one of the teachings of the two documents

D1: JP-A-61 157 152

D3: JP-A-61 054 771

and their respective English translations and, moreover, because the subject-matter of claim 1 of the auxiliary request did not meet the requirements of Article 123(2) EPC.

III. The Appellant (Patentee) appealed against this decision, duly filing a notice of appeal, paying the appeal fee and filing a statement of the grounds. Initially he requested that the contested decision be set aside and a patent be granted on the basis of a main request, including amended independent claims, or on the auxiliary request. The amendment of claim 1 (and other independent claims) of the main request consisted in specifying that the "digital database" was stored "on a removable medium".

IV. After a submission by the Respondent, the Board in an annex to a summons to oral proceedings expressed the preliminary opinion that the contested decision appeared to be well founded and that it was doubtful, whether the amendment of claim 1 of the main request

could contribute to novelty of the invention as claimed.

V. During the oral proceedings held before the Board on 19 September 2002 the Appellant maintained the following requests filed with letter dated 31 July 2002:

a main request, claim 1 being identical to the one filed with the grounds of appeal, and moreover three auxiliary requests, each of the requests containing twenty-five claims, claims 1 and 12 of each request being independent claims.

Claim 1 of the main request reads as follows:

"For use with a digital image processing system in which images are digitized by an opto-electronic device (12) for storage in a digital database (16) on a removable medium, a method of storing and retrieving said digitized images comprising the steps of:

- (a) storing on the removable medium in said digital database respective data files associated with each of said digitized images, each digitized image having an orientation and an aspect ratio; and
- (b) for each of said respective data files (21D - 25D) storing on the removable medium, in said digital database, a presentation control file (21H - 25H) containing first data (31) representative of the orientation of the associated digitized image as stored by said digital database and second data (33) representative of the aspect ratio of

the associated digitized image as stored by said digital database;

- (c) reading out from said database data representative of a digitized image stored in step (a) in a manner that depends upon the contents of its associated presentation control file stored in step (b) and coupling the read out data to an image reproduction device (22) such that the reproduced image is reproduced by said image reproduction device (22) in an upright orientation."

Claim 12 of the **main request** is an apparatus claim corresponding to the method claim 1, thus including means features corresponding to the step features (a) to (c) of claim 1.

Claim 1 of the **first auxiliary request** includes the whole text of claim 1 of the main request and additionally at the end the following feature:

"and at the correct aspect ratio".

Claim 1 of the **second auxiliary request** is amended in relation to claim 1 of the main request in that the first part of feature (c) reads as follows (the text in bold represents matter that in substance is said by the Appellant to be new in relation to feature (c) of claim 1 of the main request):

"reading out from said database data representative of a digitized image stored in step (a) in a manner **such that the pixels to be displayed are extracted in an order depending on** the contents of its associated

presentation control file stored in step (b)....".

Claim 1 of the **third auxiliary request** includes the whole text of claim 1 of the main request and additionally at the end the following feature:

", the reading out step comprising the generation of readout address/clock signals for controlling data access rate and order".

Claim 12 of the **third auxiliary request** includes the whole text of claim 12 of the main request and additionally at the end the following feature:

", the third means comprising counters (56, 58) for controlling data access rate and order".

1. In the oral proceedings the **Appellant expressed the opinion** that the teachings of D1 and D3 were **not novelty destroying** in respect of any of the independent claims of any of the requests. The argumentation of the Appellant can be summarized as follows:

Main request, claim 1

D1

Having regard to the teaching of document D1, it appeared that the subject-matter of claim 1 of the main request was distinguished therefrom on three different points.

- (i) Firstly claim 1 made clear that the digital

database was supported by one single removable medium, in that it was stated in feature (a) that the data files concerned were stored "on **the** removable medium", whereas in the first paragraph of claim 1 before feature (a) there was a mention of "storage in **a** digital database (16) on a removable medium". Thus feature (a) made clear that there was **a single support** for the database and that this support was removable from the rest of the system arrangement.

- (ii) Secondly the parameters mentioned in claim 1, i.e. the "orientation" and the "aspect ratio" in the sense of the invention were not used in the teaching of D1. The expression "paper-size" could not be compared with the "aspect ratio" of the invention. "Paper-size" was related to the size of the sheets being used in copying machines and not to the size of the images on the sheets (see D1, Figure 1). Moreover, the size of a paper sheet (or even an image) was not an "aspect ratio" in the meaning of the invention. This ratio might be calculable from the length and width of the paper but in D1 no such ratio was mentioned, nor was it suggested that it be calculated. Also the parameter "orientation" in the sense of the invention was not disclosed by the teaching of D1, because the "direction of characters" was not identical to "orientation" in the sense of the invention, which disclosed four different directions,

see Figure 2 of the patent in suit. The direction of characters according to D1 was limited to an image being horizontally or vertically positioned.

- (iii) Thirdly, there were no steps in D1 which corresponded to feature (c) of claim 1. The rotating operation disclosed in Figure 6 of D1 was a standard rotating operation which was always performed in the same way and was not dependent on the contents of an associated presentation control file.

D3

In the proceedings before the Opposition Division as well as the Board there had been an illegitimate combination of the prior art in that what was described on the first pages of D3 (in particular the paragraph bridging pages 3 and 4 of the English translation) had been read together with what was described in the latter part of the document (in particular from page 11 onwards) which latter part dealt with the actual invention described in that document. The first pages indeed mentioned landscape and portrait-oriented images. However the second part of the document purely considered copying machines and how such machines determine the length and the width of a paper sheet. In fact the apparatus used appeared to be arranged for making a difference between A4 and A3 sheets and, could determine, whether a sheet was oriented horizontally or vertically. There was no information that this apparatus was dealing with images in the sense of the present invention.

First auxiliary request, claim 1

According to claim 1 of this request the reproduced image always had to be reproduced - not only as in claim 1 of the main request in an upright orientation - but also **at the correct aspect ratio**. This new feature meant that the image was always reproduced in a way that it was not distorted, for example, persons in the picture should not be made thicker or taller than on the original picture. Such a teaching had not been disclosed in any of the documents. In fact this was also logical, since both D1 and D3 were concerned with copying machines and in principle with the reproduction of written or printed text and not of pictures as in the case of the present invention, which in reality was dealing with pictures on photographic films.

Second auxiliary request, claim 1

According to the Appellant the additional feature contained in claim 1 of the second auxiliary request was supported by the original patent application (see corresponding parts of the patent specification, column 7, lines 47 to 55 and Figures 6 to 8 with corresponding text). Moreover this feature was novel, because the only document D1, showing pixels to be transferred (from memory 42 to memory 43), merely showed an automatic rotation of the picture which was not dependent on any specific control file.

Third auxiliary request, claim 1 and claim 12

Also the feature introduced into claim 1 of this request was considered by the Appellant to be supported by the text referred to above in column 7 (lines 47 to 55) of the present patent specification. Neither D1, nor D3 mentioned this feature and there was absolutely nothing in the documents hinting in the direction of this feature. Thus the subject-matter of claim 1 was novel. Also the corresponding independent apparatus claim 12, containing the feature, "the third means comprising counters for controlling data access rate and order", was supported by the above-mentioned text in column 7 of the patent specification and was therefore also novel.

2. The **Respondent** expressed the opinion that the Appellant, having regard to documents D1 and D3, played with words and tried to give them a signification which they did not have in reality in the present claims. In the technical and scientific field it was usual that different words could be used for the same expressions, for example, the vocabulary could be different in different handbooks concerning the same field. Nevertheless, even if the vocabulary of such handbooks was not always the same, it did not mean that the teachings were different.

Thus the wording of claim 1 of the main request did not at all restrict the digital database to be located on a single removable medium. It could well have been stated that it was located on a single compact disc, but it was not. Therefore the subject-matter of claim 1 did not appear to be distinguished from the teaching of document D1 in

this respect.

Also the second difference alleged to be present by the Appellant in relation to both of the two documents did not appear to be present in reality, because both D1 and D3 disclosed parameters corresponding to "orientation" and "aspect" mentioned in claim 1 of the main request.

It was also apparent from both of the documents D1 and D3 (or implicitly disclosed) that the digitized image stored in the database was manipulated by the contents in the associated control file, so that it was oriented in its new position without being distorted. Thus it was also evident from the documents that the new feature now included in **claim 1 of the first auxiliary request** that the image was reproduced at the correct aspect ratio was of course implicitly disclosed. If the images according to those prior art documents were not reproduced in a normal way (i.e. without distortion), it would have been clearly stated therein that they were reproduced in a different way.

The feature now introduced into **claim 1 of the second auxiliary request** did not meet the requirements of Article 123(2) EPC, since, as already was made clear by the Opposition Division, this feature was not disclosed by the original documents as filed. Further while it was true that this feature was not explicitly disclosed in the two prior art documents, having regard to the prior art, it was self-evident for a skilled man to extract the pixels in the way as claimed.

It was conceded by the Respondent that the new feature included in **claim 1 of the third auxiliary request** was not disclosed in documents D1 and D3, because these documents did not describe how the clock frequency was produced. However, also this feature was self-evident for a skilled person. In fact, it was hard to imagine any other way of reading out the data.

VI. The **Appellant requested** that the decision under appeal be set aside and that the patent be maintained on the basis of claims 1 to 25 of one of the set of claim requests filed as main request or as first, second or third auxiliary request with letter dated 31 July 2002.

The **Respondent requested** that the appeal be dismissed.

VII. At the end of the oral proceedings the chairman of the Board announced the decision.

Reasons for the Decision

1. *Admissibility*

The appeal meets the requirements set out in Rule 65(1) EPC and is therefore admissible.

2. *Main request*

Having regard to the teaching of D1, the Appellant is of the opinion that the method according to claim 1 is distinguished from the one identified in D1 on three different points, i.e. the points (i), (ii) and (iii) as identified in paragraph V.1 above.

Having regard to point (i), the Board is of the opinion that the expression in the first paragraph of claim 1 relating to "a digital database (16) on a removable medium" and the expression in feature (a) of claim 1 relating to "storing on the removable medium in said digital database" does not require that the database be located on a single removable medium in the sense of a single disc. Having regard to the wording of claim 1, the Board is of the opinion that the step of "storing on the removable medium in said digital database" according to feature (a) of claim 1 can also be read onto the teaching of D1. It is true that the database according to D1 is located on two different discs, for example an optical disc 4 and a floppy disc 6 (see D1, Figure 2), however these two discs are according to the opinion of the Board both removable and make up "the removable data medium". Thus the Board does not believe, as suggested by the appellant, that the optical disc 4 is not removable and therefore is of the opinion that point (i) is disclosed by D1.

The Board considers that also point (ii) is disclosed by D1 (see Figure 5 and corresponding text). It is shown therein that the index information (corresponding to the "presentation control file" in present claim 1) includes data giving the "paper size" and also data about the "character direction". Data representing "paper size" in D1 can be considered to correspond to the signification of the expression "second data representative of the aspect ratio" used in claim 1, because a particular aspect ratio is implicit in the size measures and these are representative of a particular aspect ratio, as required by claim 1. In D1 the A4-sheet size is explicitly mentioned.

Also the data for "character direction" mentioned in D1 can be considered to correspond to "first data (31) representative of the orientation... of the image" in present claim 1. The Appellant expressed the opinion that the "character direction" in D1 does not mean the same parameter as "orientation ...of the image" in the present patent specification. This was said to be because the film images according to the present invention must be identified with reference to four different orientations, while a paper sheet in D1 is only vertical or horizontal. However, the Board is of the opinion that claim 1 does not require that four different orientations can be distinguished; it is enough if, as in D1, the system can distinguish between the only two valid orientations.

Also the Board cannot agree that the third difference (iii) suggested by the Appellant that image data from the database is read out in dependence upon the content of the presentation control file is not disclosed by D1. The Board agrees with the Opposition Division in this respect, in that D1 (see in particular Figure 8 and associated text) teaches how data is extracted from disc, stored in a buffer, and according to an orientation tag either directly displayed, or rotated and transferred to another buffer for subsequent display in an appropriate orientation which teaching in principle appears to be identical to feature (c) of claim 1 and also includes Appellant's point (iii).

Having regard to the present patent specification, it appears to the Board that claim 1 could well have been restricted, for example to storing the data in a digital database on a single optical disc. Also, it appears that the four orientation possibilities as well

as the expression "aspect" would need further and explicit definition before any distinction over the teaching of D1 could be recognised, in particular with respect to the Appellant's argument that the application of image processing according to the invention is related to images on filmstrips having a certain width and not to images (or text) on separate paper-sheets having different sizes as in D1.

Thus the Board arrives at the conclusion that the subject-matter of claim 1 is not novel over the teaching of D1 (Article 54(2) EPC).

During the oral proceedings the Board announced that the subject-matter of claim 1 of the main request lacked novelty also in respect of the teaching of D3. Thus the Board, having regard to the teaching of D3, in principle agrees with the decision of the Opposition Division. D3 clearly discloses that both the image data and the data concerning size and orientation of the image are stored on the same optical disc (see, for example page 5, last paragraph to page 6, first paragraph). Moreover, the Board cannot agree with the Appellant that D3 should be considered to include two different teachings strictly separated from each other (see paragraph V.1 above). Instead, it appears to be self-evident that the problems relating to the prior art described in the introductory part of the description in D3 (see D3, pages 3 and 4) have to be taken into account when interpreting document D3, since these problems are said to be solved by the invention described in the later part of the description (with the figures) of D3. In the present decision, however, it does not appear to be necessary to show in detail how the Board arrived at this conclusion, since the

Board has already assessed that the subject-matter of claim 1 lacks novelty having regard to the teaching of D1.

3. *First auxiliary request*

Claim 1 of the first auxiliary request is distinguished from claim 1 of the main request with the additional feature that the reproduced image is reproduced "**at the correct aspect ratio**". The Board is, as the Respondent, of the opinion that it is self-evident that reproduced images should normally not be distorted by the reproduction process. Document D1 does not contradict this statement, since in (the schematic) Figures 1b and 1c, in the rotation step shown (see D1, page 11), the ratio is not changed. The size of the real image remains the same. The Board therefore is of the opinion that also the subject-matter of claim 1 of the first auxiliary request is lacking novelty with respect to D1.

4. *Second auxiliary request*

The feature added to claim 1 of this request is the same feature which in the oral proceedings before the Opposition Division was added to claim 1 of the (then) first auxiliary request. The Board is, as the Opposition Division, of the opinion that this feature does not meet the requirements of Article 123(2) EPC. The Board does not agree that the paragraph in column 7 of the patent specification would support this feature. The Board is of the opinion that the actual manner of reading out from the database (40 in Figure 4 in the present patent specification) according to the description of the present patent specification is, as

also made clear by the Opposition Division (see last part of the appealed decision), always the same, but the reading out from the buffer (50) is made in dependence on the content of the presentation control file. Thus there is nowhere disclosed in the original documents that the reading out from the database could immediately be manipulated, i.e. before the data has been input into a buffer.

Thus claim 1 of the second auxiliary request does not meet the requirements of Article 123(2) EPC, since it is amended in such a way that it contains subject-matter extending beyond the content of the application as filed.

5. Third auxiliary request

The new features added to claim 1 and to claim 12 respectively are both supported by the paragraph in the description of the patent specification (column 7, lines 47 to 55) referred to by the Appellant and therefore meet the requirements of Article 123(2) EPC.

The Board also agrees with the parties that these features are not disclosed in any of the documents D1 and D3. In fact both documents are silent on the point how the data in detail is read out from the database. Thus the subject-matter of claim 1 as well as claim 12 is new.

Having regard to the fact that the independent claims 1 and 12 of the third auxiliary request both contain new subject-matter which was not considered by the Opposition Division and since inventive step was not considered at all in the appealed decision, it appears

to the Board that the case should be remitted for further examination to the Opposition Division.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The matter is remitted to the first instance for further prosecution on the basis of claims 1 to 25 of the set of claims filed as third auxiliary request with letter dated 31 July 2002.

The Registrar:

The Chairman:

M. Kiehl

S. V. Steinbrener