

Internal distribution code:

- (A) Publication in OJ
(B) To Chairmen and Members
(C) To Chairmen
(D) No distribution

D E C I S I O N
of 7 July 2005

Case Number: T 1180/04 - 3.5.3

Application Number: 97307545.0

Publication Number: 0843229

IPC:

Language of the proceedings: EN

Title of invention:

Automatic service requests over the world wide web

Applicant:

CANON KABUSHIKI KAISHA

Opponent:

-

Headword:

Service requests/CANON

Relevant legal provisions:

EPC Art. 52(1), 56

Keyword:

"Inventive step - no - all requests"

Decisions cited:

G 0010/93

Catchword:

-



Case Number: T 1180/04 - 3.5.3

D E C I S I O N
of the Technical Board of Appeal 3.5.3
of 7 July 2005

Appellant:

CANON KABUSHIKI KAISHA
30-2 Shimomaruko
3-Chome Ohta-ku
Tokyo 146-8501 (JP)

Representative:

Perkins, Janet Frances
BERESFORD & Co.
16 High Holborn
London WC1V 6BX (GB)

Decision under appeal:

Decision of the Examining Division of the
European Patent Office posted 28 July 2004
refusing European application No. 97307545.0
pursuant to Article 97(1) EPC.

Composition of the Board:

Chairman: A. S. Clelland
Members: D. H. Rees
R. Moufang

Summary of Facts and Submissions

I. This is an appeal from the decision of the examining division to refuse the European patent application number 97 307 545.0, with publication number 0 843 229. The decision was issued on 28 July 2004 after the examining division had proposed the grant of a patent on the basis of an auxiliary request and the appellant had maintained the main request. The reason given for refusing the main request was that it contained subject-matter extending beyond the content of the application as filed, in violation of Article 123(2) EPC. First and second auxiliary requests were also considered, and found not to involve an inventive step with respect to the disclosure of

D2: US 5 459 552 A

The examining division had proposed the grant of a patent on the basis of the third auxiliary request.

II. The following further documents are relevant to the present decision:

D1: US 5 414 494 A

D5: "HP Unveils Strategy for Future of Printer Management," Hewlett-Packard press release, Palo Alto, CA, US, 4 November 1996, 3 pages.

III. Notice of appeal was filed in a letter dated 22 and received 23 September 2004, together with the appropriate fee. A statement setting out the grounds of appeal was submitted on 3 December 2004. It requested

- grant of a patent on the basis of the main request refused by the examining division and contained a conditional request for oral proceedings. An extract from a technical dictionary was annexed in support of the arguments.
- IV. In a communication accompanying a summons to oral proceedings to be held on 7 July 2005, the board gave its preliminary opinion that not only did the refused main request contain added subject-matter but that the subject-matter of all the requests put to the examining division did not involve an inventive step. In addition to documents already discussed in examination, the board cited D5, originally submitted by the applicant during the examination.
- V. In preparation for the oral proceedings the appellant submitted sets of claims for a main and two auxiliary requests. The main request corresponded to the main request in examination, the first auxiliary request was new, and the second auxiliary request corresponded to the third auxiliary request in examination, i.e. the request on the basis of which the examining division had proposed the grant of a patent.
- VI. At the oral proceedings the appellant requested that the decision under appeal be set aside and that a patent be granted on the basis of the main request or, alternatively, the first or second auxiliary request, all filed with the letter of 7 June 2005, or, in the alternative, that the case be remitted to the first instance for further prosecution.

VII. Independent claims 1 and 13 of the main request read as follows:

"1. A method for communicating status information of a peripheral device to a remote service organization, said method comprising:

detecting (S2001) a condition of the peripheral device for which service is required;

automatically obtaining status information in response to the detected condition, the status information corresponding to the detected condition; and

automatically transmitting (S2004) said status information to the remote service organization, characterised by the steps of:

producing a data packet containing a file which is described by a markup language and includes said status information and a destination field indicating a network address of the remote service organization, said transmitting step comprising automatically transmitting said data packet via a communication network (6, 15, 19, 20).

13. A peripheral device (11) capable of communicating status information to a remote service organization, said device comprising:

detecting means for detecting a condition of the peripheral device for which service is required;

obtaining means for automatically obtaining status information in response to the detected condition, the status information corresponding to the detected condition; and

transmitting means for automatically transmitting said status information to the remote service organization, characterised by:

data packet generation means for producing a data packet containing a file which is described by a markup language and includes said status information and a destination field indicating a network address of the remote service organization, said transmitting means being arranged to automatically transmit said data packet via a communication network (6, 15, 19, 20)."

Claim 12 of the main request is directed to "A computer-readable medium storing computer-executable process steps" implementing a preceding method claim.

Claims 1 and 13 of the first auxiliary request differ from the corresponding claims of the main request only in that the feature "the markup language being a language readable in a web browser," is added.

Claims 1 and 12 of the second auxiliary request differ from claims 1 and 13 respectively of the main request in that the phrase "a file which is described by a markup language and includes ..." is replaced by "an HTML file which includes ...", the dependent claims previously specifying the use of an HTML file having been deleted and the claims appropriately renumbered.

VIII. At the end of the oral proceedings the board announced its decision.

Reasons for the Decision

1. *Procedural issues*

1.1 The board is aware that the present second auxiliary request corresponds to a request for which the examining division proposed the grant of a patent. However, this does not bind the board to grant a patent, or even to remit the case for further prosecution, on the basis of this request. There is no issue of *reformatio in peius* for the reasons given in the Enlarged Board of Appeal decision G 10/93 (OJ EPO 1995, 172).

1.2 For the event that the board could not grant a patent, the appellant made a conditional request for remittal to the department of the first instance, on the ground that the first auxiliary request was new and therefore had not been considered by the examining division. The question of whether to remit a case is an issue to be weighed up by the board, taking into account fairness to the appellant but also avoiding unnecessary prolongation of the examination procedure as a whole. There is no absolute right to have a case remitted simply because a request is new. The request is dealt with, in the light of the board's assessment of the case as a whole, at Point 4 below.

2. *Added subject-matter*

In the principal described embodiment of the claimed invention, status information is communicated to a remote service organisation in the form of an HTML (HyperText Markup Language) file. The independent

claims of the main request however merely specify that a markup language is used, without being restricted to any particular markup language. The examining division held that this generalisation was not derivable from the application as filed, and therefore violated Article 123(2) EPC. In the first auxiliary request, it is now specified that the file is written in a markup language readable in a web browser. With respect to the main request, the board expressed a preliminary opinion agreeing with the examining division in its communication accompanying the summons to oral proceedings. However, in the light of the board's conclusions below concerning the question of whether claims narrower in scope than those of the main and first auxiliary requests involve an inventive step, it has not proved necessary for the board to decide on this issue.

3. *Inventive step*

3.1 The most restricted independent claims are those of the second auxiliary request. Since the board's conclusions on these claims apply equally to the corresponding claims of the other requests, it is appropriate in this case to consider them first.

3.2 The feature, "automatically obtaining status information in response to the detected condition, the status information corresponding to the detected condition," (claim 1), and the equivalent in claim 12, requires interpretation. The application does not give any further details and in the only relevant example, shown in Figure 19, no data is displayed beyond a very brief description of the condition. The board therefore

concludes that the "status information" may be any information associated with the detected condition, including simply its title. However, the board notes that, as pointed out by the appellant in the oral proceedings, the independent claims do specify that the status information concerns "a condition of the peripheral device for which service is required".

- 3.3 D1 and D2 are equally relevant as prior art for the consideration of whether the claimed subject-matter involves an inventive step. Since D2, apparently derived from a Japanese priority document, is less immediately understandable, the board's analysis is based on the disclosure of D1.
- 3.4 D1 discloses the pre-characterising features of claims 1 and 12, and indeed corresponds to the prior art described in the application itself (published application column 1, lines 14 to 31). That is, it describes a method for communicating status information of a peripheral device, such as a copier, to a remote service organisation including detecting a condition for which service is required and transmitting corresponding information to the service organisation (D1, column 2 lines 6 to 11, column 3 lines 23 and 24, and column 6 lines 1 to 5). As an alternative to the direct telephone connection of its preferred embodiment, D1 also envisages communication over a network - column 6, lines 1 to 16, "In accordance with the present invention, with reference to FIG. 4, there is shown a remote communication system including remote host 157 connected to machine 30 through a suitable channel such as telephone line 175 and modems 120, 121 or any other suitable medium such as local and wide

area networks, cellular phone channels, infrared links, and serial channels such as well known RS232 and SCSI serial ports. ... It should be noted that machine 30 and remote host 157 can be interconnected to other suitable stations or devices on a network or by any dedicated communication channel." Further, at column 8, lines 8 to 14, " ... it is well within the scope of the present invention to be able to set predetermined reporting conditions for any number of systems or devices within a network or orbit of devices from a given system or device and to set the conditions for any of these systems or devices to automatically report to any other system or device."

In the claimed invention, a network connection is employed, and the status information is communicated using data packets including a network address of the service organisation. It is further specified that the data communicated is in the form of an HTML file.

- 3.5 The board notes that in the period before the priority date of the current application, 15 November 1996, use of the Internet and its associated protocols on "intranets" (private networks employing Internet protocols) increased rapidly. In particular, the use of the World Wide Web and of browsers to read HTML "Web pages" was the focus of a great deal of attention. Various documents submitted by the appellant during examination (with a letter dated 29 and received 30 August 2001) show that before the claimed priority date a number of manufacturers of peripheral devices announced products allowing remote access to, and administration of, devices using HTML and standard web browsers. D5 specifically discusses "an easy way to

monitor and manage network printers from standard Web browsers" (page 1, lines 9 and 10) on intranets (page 1, line 7), including a feature whereby, "Administrators can easily set up a map of their facilities, complete with cubicles, offices and other recognizable 'landmarks' and then place printer icons representing their printers at appropriate spots on the map. Once installed, these icons change color depending on the status of the printer," (page 1, lines 34 to 38). The board understands the change in colour to reflect a change in status information. The skilled person, considering how to improve the method disclosed in D1 in the light of developments in Internet usage, would recognise from D5 the advantages of using a standard Internet interface and a standard browser at the remote service organisation for receiving status information. HTML was the most common format for files intended to be read by browsers, even if it was not the only possible choice. It would therefore have been obvious for the skilled person, aware of the disclosure of D5, to consider using HTML for transmitting status information.

- 3.6 Thus the skilled person, seeking to implement the teaching of D1 in the light of developments in the art, in particular in the Internet, would have found it obvious at the priority date of the present application to modify the method to produce a data packet containing an HTML file. The packet would also by its nature include a destination address. The subject-matter of independent method claim 1 of the second auxiliary request therefore does not involve an inventive step. For the same reasons neither does the subject-matter of independent device claim 12.

3.7 In the oral proceedings the appellant advanced the following arguments against this conclusion:

3.7.1 The disclosure of D5 (and the other similar product announcements) was vague and speculative. The various manufacturers wanted to use Web protocols, but did not really know how to best make use of them. In contrast the application presented a working system.

3.7.2 D1 itself mentioned the use of e-mail, without making the jump to reporting the status information by e-mail, one of the options discussed in the present application. This suggested that the apparent obviousness of the invention was a matter of *ex post facto* analysis. D1 could be said to teach away from using e-mail.

3.7.3 The "status information" of D5 was not the same as the status information of D1 and the application. The claimed subject-matter specified that it related to a condition for which service was required. In D5 the status information would relate simply to whether a printer was currently in use, so that a user or administrator would know where to direct new print jobs. Thus the skilled person would not combine D1 and D5, which related to different problems.

3.8 As to the first argument, there is nothing in the application which suggests that implementing a method of producing a data packet including an HTML file was anything more than a routine development. From both the application and the 1996 prior art documents it is clear that the skilled person in the field was expected to be familiar with Web protocols and in particular

HTML. No details of the implementation going beyond the use of HTML are specified in the claims.

3.9 As to the argument that D1 teaches away from the use of e-mail, what is presently claimed is not the use of e-mail but rather the use of HTML. The specific attraction of HTML was its ubiquity, being used with browsers which were already commonplace in 1996. At the application date of D1, 6 December 1993, it is not clear to the board that e-mail had already achieved the degree of standardisation necessary to be attractive as an alternative to the implicitly proprietary protocols employed in D1. The appellant did not present any evidence to suggest that it had. This argument is therefore also not convincing.

3.10 As to the question whether the status information in D5 is the same as that in D1 and the present application, i.e. status information relating to a condition requiring service, the board accepts that D5 does not specify exactly what is meant, and that it is possible that mere print queue information was intended. However, even if the skilled person reading D5 were to interpret it narrowly, the applicability of D5 to the status information of D1, which is taken as the skilled person's starting point, would still, in the view of the board, be immediately apparent. Thus the fact that D5 might be talking about a different, but similar, situation, would not stop the skilled person from applying its teaching to the method of D1.

3.11 Thus the board comes to the conclusion that the subject-matter of the independent claims of the second auxiliary request does not involve an inventive step

with regard to the teaching of D5 applied to the method disclosed in D1.

- 3.12 As noted in Point 3.1 above, these independent claims are the most restricted of the claims of any of the requests. The subject-matters of the independent claims of the main and first auxiliary requests therefore equally do not involve an inventive step.
4. Finally, the board sees no justification for remitting the case to the department of first instance for further consideration (see Point 1.2 above). Although the first auxiliary request is new it differs from requests considered by the department of first instance only in minor details; in particular, it is open to the objection discussed above that the claimed subject-matter does not involve an inventive step.
5. It follows that none of the appellant's requests are allowable and the appeal must be dismissed.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:

D. Magliano

A. S. Clelland