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**Datasheet for the decision  
of 21 September 2007**

**Case Number:** T 0992/05 - 3.4.03

**Application Number:** 99120633.5

**Publication Number:** 0996036

**IPC:** G03D 15/00

**Language of the proceedings:** EN

**Title of invention:**

Method, apparatus, and recording medium for ordering  
photographic prints

**Applicant:**

FUJIFILM Corporation

**Opponent:**

-

**Headword:**

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**Relevant legal provisions:**

EPC Art. 56

**Keyword:**

"Inventive step (no)"

**Decisions cited:**

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**Catchword:**

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Case Number: T 0992/05 - 3.4.03

**D E C I S I O N**  
of the Technical Board of Appeal 3.4.03  
of 21 September 2007

**Appellant:**

FUJIFILM Corporation  
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Tokyo (JP)

**Representative:**

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**Decision under appeal:**

Decision of the Examining Division of the  
European Patent Office posted 10 March 2005  
refusing European application No. 99120633.5  
pursuant to Article 97(1) EPC.

**Composition of the Board:**

**Chairman:** R. Q. Bekkering  
**Members:** G. Eliasson  
T. Bokor

## Summary of Facts and Submissions

I. This is an appeal against the refusal of European patent application 99 120 633.5 for lack of novelty in view of the prior art document

D1: GB 2 286 944 A.

II. In response to a communication of the board accompanying summons to oral proceedings, the appellant applicant withdrew the request for oral proceedings.

III. In a further communication, the board informed the appellant applicant that the oral proceedings appointed were cancelled.

IV. The appellant applicant requests that the decision under appeal be set aside and a patent be granted on the basis of one of the following requests:

Main request:

Claims 1 to 6 filed with the letter dated  
16 September 2003

Auxiliary request:

Claims 1 to 6 filed with the letter dated  
12 November 2004.

V. Independent claims 1 and 3 of the main request read as follows:

"1. A method of receiving an order for outputting a photographic image represented by digital image

data, the order receiving method comprising the step of:

generating an order file enabling selection of the content of an order corresponding to the photographic image,

providing the order file together with the digital image data to a user;

receiving order information regarding the photographic image, the information being generated based on the order file; and

outputting the photographic image based on the order information having been received,

wherein the order file and the digital image data are provided to the user by being recorded in a removable recording medium, or

wherein the order file and the digital image data are provided to the user via a network."

- "3. An apparatus for receiving an order for outputting a photographic image represented by digital image data, the apparatus comprising:

order file generating means (5) for generating an order file (F) enabling selection of the content of an order corresponding to the photographic image,

providing means (CD-R;19) for providing the order file and the digital image data to a user;

receiving means for receiving order information regarding the photographic image, the order information being generated based on the order file; and

output means (7) for outputting the photographic image based on the order information having been received,

wherein the providing means (CD-R; 19) provides the order file (F) and the digital image data to the user by recording the order file (F) and the digital image data (S) in a removable recording medium (CD-R), or

wherein the providing means provides the order file (F) and the digital image data (S) to a user via a network (19)."

VI. Claim 1 of the auxiliary request differs from that of the main request in that the paragraph

"outputting the photographic image based on the order information having been received,"

is amended to (board's emphasis):

"outputting the photographic image based on the order information having been received, **wherein the photographic images are related to an order regarding the images in advance**".

Independent claim 3 of the auxiliary request differs from claim 3 of the main request in that the passage

"output means (7) for outputting the photographic image based on the order information having been received,"

is amended to (board's emphasis):

"output means (7) for outputting the photographic image based on the order information having been received, **wherein the photographic images are related to an order regarding the images in advance**".

VII. The appellant applicant's arguments in support of his requests can be summarized as follows:

- (a) The claimed invention solved the problem of simplifying the process for the user when generating the order information.
- (b) Document D1 did not disclose the step of the laboratory generating an order file enabling selection of the content of an order. What document D1 disclosed was that the photographic film might be scanned by the customer or might also be scanned by the laboratory.

### **Reasons for the Decision**

1. The appeal is admissible.

2. *Novelty and inventive step - Main request*

2.1 Document D1 discloses a method of ordering photo prints of images from a film. The user is operating a personal computer 52 which is remotely connected to a central computer 50 having a database 46 containing scanned images from a film (see Figures 1 and 2 with accompanying text). By executing a computer program provided by the photo print vendor on the personal computer, images from the film are displayed on the personal computer. The program enables the user for each image to select number and size of desired prints (see page 12, lines 7 to 20). The information selected by the user is communicated back to the computer 50 (page 12, lines 22 to 27). This information is used to produce photographic prints or photo CDs (see page 12, line 29 to page 13, line 6). The images displayed on the user's personal computer for print selection are either downloaded to the personal computer from the central computer or provided on a removable recording medium, such as a CD (see page 12, lines 7 to 14; page 16, lines 11 to 17).

2.2 The appellant applicant argued that the step of "providing the order file together with the digital image data to a user" in the method of claim 1 (of both requests) was not disclosed in document D1 (see item V(b) above).

2.3 The board agrees with the appellant applicant that the above feature is not directly derivable from document D1. Thus, the method of claim 1 of the main request differs from that of document D1 in the steps of

generating an order file enabling selection of the content of an order corresponding to the photographic image, providing the order file with the digital image data to a user, and receiving order information regarding the photographic image, the information being generated based on the order file.

In the method of document D1 described at page 12, line 6 to page 13, line 25, the corresponding steps are carried out through the means of a computer program executed on the user's personal computer 52 which is connected to the central computer 50 of the photo laboratory (see figure 2). When executed on the personal computer, this computer program creates a graphical user interface displaying the images obtained from the central computer and enabling the user to enter the desired information, such as the number of prints, print size, as well as zooming and cropping, of the images displayed. All information selected by the user is subsequently transmitted back to the central computer 50 of the laboratory (see page 12, lines 14 to 27).

In the claimed invention, on the other hand, an order file (in e.g. HTML format and containing a low-resolution representation of the images ("thumbnail images")) is generated and provided to the user (see application as published, paragraphs 0026 and 0034). The user can enter the information in the order file (e.g. using a web browser) and return the filled-in order file to the laboratory (paragraph 0028).

- 2.4 The above features have the technical effect that the process of ordering prints can be performed on a normal



web browser and would therefore be platform independent, whereas in the method of document D1, the program to be executed on the user's computer must be compatible with the operating system and the hardware installed on the computer.

2.5 The board cannot see any inventive merit in choosing a platform independent implementation of the method of document D1. In particular web browsers were known at the priority date of the application to be suitable for platform independent data exchange. Such a data exchange was usually in form of HTML pages displayed via the web browser where the user could enter the requested information by filling in blank spaces or selecting items from pull-down menus. Therefore, the subject matter of claim 1 of the main request does not involve an inventive step.

2.6 The above reasons apply *mutatis mutandis* for independent claim 3 of the main request relating to an apparatus for receiving an order for outputting a photographic image.

2.7 For the above reasons, in the board's judgement, the subject matter of independent claims 1 and 3 of the main request does not involve an inventive step within the meaning of Article 56 EPC.

### 3. *Novelty and inventive step - Auxiliary request*

Claim 1 of the auxiliary request further adds to the main request the feature that in the step of outputting the photographic image based on the order information having been received, the photographic images are

related to an order regarding the images in advance.  
The corresponding amendment is carried out on  
independent claim 3.

The above feature is however known from document D1,  
since the photographic images are related to order  
information by the user on his personal computer, and  
hence "in advance" (see page 12, lines 22 to 35).

Therefore, the subject matter of independent claims 1  
and 3 of the auxiliary request does not involve an  
inventive step within the meaning of Article 56 EPC for  
the same reasons as for the main request.

## **Order**

### **For these reasons it is decided that:**

The appeal is dismissed.

Registrar

Chair

S. Sánchez Chiquero

R. Q. Bekkering