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Datasheet for the decision
of 10 July 2009

Case Number:	T 1001/05 - 3.5.04
Application Number:	99110022.3
Publication Number:	1024651
IPC:	H04N 1/00
Language of the proceedings:	EN

Title of invention:
Network facsimile apparatus and transmission method

Patentee:
Panasonic Communications Co., Ltd.

Opponent:
Canon Kabushiki Kaisha

Headword:
-

Relevant legal provisions:
RPBA Art. 12(4)

Relevant legal provisions (EPC 1973):
EPC Art. 54(2), 56, 114(2)

Keyword:
"Novelty - availability to the public (yes)"
"Inventive step - no (all requests)"

Decisions cited:
-

Catchword:
"Evidence for prepublication of a book (see point 2.1)"

Case Number: T 1001/05 - 3.5.04

D E C I S I O N
of the Technical Board of Appeal 3.5.04
of 10 July 2009

Appellant: (Opponent)	Canon Kabushiki Kaisha 30-2, Shimomaruko 3-chome Ohta-ku Tokyo 146-8501 (JP)
Representative:	Hitching, Peter Matthew Canon Europe Limited 6 Roundwood Avenue Stockley Park Uxbridge UB11 1JA (GB)
Respondent: (Patent Proprietor)	Panasonic Communications Co., Ltd. 4-1-62, Minoshima Hakata-ku Fukuoka-shi Fukuoka 812-8531 (JP)
Representative:	Grünecker, Kinkeldey Stockmair & Schwanhäusser Anwaltssozietät Leopoldstraße 4 D-80802 München (DE)
Decision under appeal:	**Decision of the Opposition Division of the European Patent Office posted 8 June 2005 rejecting the opposition filed against European patent No. 1024651 pursuant to Article 102(2) EPC.**

Composition of the Board:

Chairman:	F. Edlinger
Members:	A. Dumont
	C. Vallet

Summary of Facts and Submissions

I.   The opponent appealed against the decision to reject an
        opposition against the European patent No. 1 024 651.

II.   The opposition was filed based *inter alia* on the ground
        of opposition under Article 100(a) EPC 1973 together
        with Article 56 EPC 1973 that the subject-matter of the
        granted claims did not involve an inventive step in
        view of the documents:

        OD1: E. TITTEL et al.: "Web programming SECRETS with
             HTML, CGI, and Perl", IDG Books Worldwide, Inc.,
             1996, ISBN 1—56884—848—X; two cover sheets,
             pages xv to xxvi and pages 329 to 355 (Chapter 11);
        OD2: US 5 720 014 A.

III.   Further documents relating to OD1 were submitted by the
        opponent. These comprised a Japanese language version
        of Chapter 11 including cover sheets indicating a
        copyright date which were filed together with OD1, an
        ISBN web page for OD1 and an English language
        translation of the Japanese version of OD1 (both filed
        with a letter dated 26 May 2004).

IV.   The opponent appealed and provided substantive
        arguments against the decision under appeal. He also
        argued that the opposition division, in ignoring
        evidence aiming at proving the pre-publication of OD1,
        committed a substantial procedural violation and
        requested the refund of the appeal fee.

        With the statement of grounds of appeal the appellant
        filed further documents, *inter alia*:

OD1':E. TITTEL et al.: "Web programming SECRETS with HTML, CGI, and Perl", ISBN 1-56884-848-X; cover sheets, pages 3 to 42 (Chapter 1) and pages 329 to 355 (Chapter 11), one of the cover sheets indicating a copyright date of 1996 and "First Printing, March 1996", another cover sheet provided with a stamp carrying the date of 28 June 1996 by the British Library.

V.   In a communication dated 6 May 2009 the board *inter alia* stressed that OD1' should be taken into account in the appeal proceedings as relevant additional evidence for the prior publication of OD1, the proof of which was now established in the provisional opinion of the board. However the board considered that it was well-established case law that a wrong assessment of evidence submitted in the course of the proceedings did not amount to a substantial procedural violation.

VI.   In a letter dated 10 June 2009 the appellant withdrew the request for refund of the appeal fee.

VII.   With a letter dated 10 June 2009 the respondent (patentee) filed sets of amended claims according to auxiliary requests I to IV.

VIII.   Oral proceedings before the board took place on 10 July 2009.

IX.   The appellant (opponent) requested that the decision under appeal be set aside and that the European patent No. 1 024 651 be revoked.

X.   The respondent (patentee) withdrew the main request and
      auxiliary requests I and II filed with the letter dated
      10 June 2009 and requested that the patent be
      maintained on the basis of claims 1 to 17 filed with
      the letter dated 10 June 2009 as "Auxiliary Request
      III" (new main request), or alternatively on the basis
      of claims 1 to 17 filed with the letter dated 10 June
      2009 as "Auxiliary Request IV" (new auxiliary request).

XI.   Claim 1 according to the main request reads as follows.

      "A network facsimile apparatus capable of communicating
      with a client (202) connected to said apparatus via a
      computer network, said apparatus comprising:

      a facsimile section (9) which receives an image via the
      telephone network;

      a mail section (13) which receives an e-mail via the
      computer network;

      a storage section (4) which stores various data items
      including the image received by said facsimile section
      (9) and the data of the e-mail received by said mail
      section (13) as document information pieces;

      a HTML generating section (11) which generates a HTML
      file for selecting a predetermined processing request
      on a browser of the client (202); and

      a web server (12) which transmits the HTML file
      generated in said HTML generating section to the client
      (202) in response to a request from the client (202),

while receiving a processing request selected from the
HTML file on the browser of the client (202);

wherein the apparatus further comprises a printing
section (6) for printing the various data items; and

wherein said apparatus further generates a HTML file of
a device setting screen by reading the HTML file from
the storage section (4), wherein the device setting
screen is enabling the client to set said apparatus for
processing the data items upon reception at the
apparatus to store or not to store a data item of the
various data items in said storage section (4) with or
without printing the data item in said printing section
(6), transmits the HTML file to the client, so that the
device setting screen is displayed on the browser of
the client, and when said apparatus receives a setting
request from the device setting screen, the apparatus
is set for the processing of the data items upon
reception at the apparatus to store or not store the
data item in said storage section (4) with or without
printing the data item in said printing section (6)
according to the setting request,

while generating a HTML file of a stored data list with
the document information pieces listed corresponding to
stored data items in said storage section to transmit
to the client, so that the stored data list is
displayed on the browser of the client, and

when said apparatus receives a transmission request for
a terminal on a document information piece selected
from the stored data list, transmitting a stored data

item corresponding to the document information piece selected to a designated destination."

XII.   Claim 1 according to the auxiliary request differs from claim 1 according to the main request by the following addition (set in *italics*) at the beginning of the eighth paragraph (as set out in point XI above):

"wherein said apparatus further generates a HTML file of a device setting screen by reading *in response to a request from the client (202)* the HTML file from the storage section (4),..."

XIII. The reasons in the decision under appeal relevant for the present decision may be summarised as follows.

The patent proprietor contested the fact that OD1 was prior published. Although the opponents (in the course of the opposition proceedings) filed a web page giving a prior publication date for a book bearing the same title and ISBN number as those mentioned on the paper copies filed with the notice of opposition, this was not conclusive evidence that OD1 was in fact pre-published as the copies provided might have come from a later edition bearing the same ISBN number. The onus of conclusive proof rested with the opponents in this respect. Thus the opposition division decided formally not to allow OD1 into the procedure.

Notwithstanding this, OD1 does not refer to a facility in the host server for the generation and delivery to the client of an HTML page listing stored data items at the host apparatus. Nor does OD1 disclose the host generating an HTML page of a device setting screen as

set out in the claims. The generation of such an HTML
page of a device setting screen cannot be derived from
OD1 taken alone without knowledge of the invention.

OD2 discloses a remote terminal setting the storage and
printout modes for a host fax device. However combining
OD1 with OD2 would rely upon knowledge of the claimed
solution, which therefore involves an inventive step.

XIV.   The appellant's (opponent's) arguments may be
        summarised as follows.

OD1 filed with the notice of opposition in conjunction
with additional evidence submitted in the course of the
opposition proceedings and relating to the same ISBN
number proves that OD1 was available before the
priority date. The further copy of OD1 submitted with
the statement of grounds of appeal additionally
indicates a date stamp on OD1' from the British Library
which conclusively proves the pre-publication of OD1.

OD1 discloses a computer-based gateway which can be
implemented on a web basis. In particular the fax
administration screen of figure 11-1 lists the stored
faxes and gives the user the option to print or not to
print a fax, or to store or not to store a fax by
choosing the "Delete" option. More generally, OD1
provides web interfaces for setting devices. The device
setting screen of the invention is not limited to the
settings for data items that have not yet been received
as shown in the "user setting page" according to
figure 17 of the patent in suit. It may be read on any
other screen allowing settings for printing and storing,
so that the HTML file for the device setting screen is

not necessarily different from the HTML file of the
stored data list.

The novelty of the invention according to the valid
claims with respect to OD1 is no longer contested. The
claimed subject-matter however reflects an aggregation,
rather than a combination, of unrelated groups of
features (device setting screen, list of stored
documents), which should be considered separately when
assessing inventive step.

Providing an e-mail section is an obvious extension in
the context of the web browsers according to OD1.

An external printer and a print option for faxes are
mentioned in OD1. This renders obvious the provision of
a print section on the gateway.

OD1 identifies one of the advantages of a CGI program
as offering the ability to customise features specific
to the user's business. Customising settings of a
device was common general knowledge at the priority
date of the patent in suit, for instance in order to
optimise and simplify the administration of incoming
messages. OD2 discloses a network facsimile device
connected over a local area network to a remote
terminal, with a possibility for the user to remotely
customise the settings for printout and storage modes
of the fax device. The skilled person would readily
consider using a web browser and web client/server
architecture to implement the interface for customising
the settings.

How the settings should be customised may result from
non-technical considerations or constraints that would
differ in an office with a paper-based workflow or in a
company concerned with its environmental impact.

As a result, the subject-matter of the claims does not
involve an inventive step over OD1 considered alone
with the common general knowledge, or over a
combination of OD1 and OD2.

XV.   The respondent's (patentee's) arguments may be
        summarised as follows.

The appellant has provided no reason why OD1' could not
be filed in the nine-month time limit for giving notice
of opposition. OD1' is therefore late-filed. The
appellant also failed to demonstrate its *prima facie*
high relevance. As a result, OD1' should not be
admitted into the proceedings. Since the opposition
division has applied the right principles when deciding
formally not to allow OD1 into the procedure, OD1
should still not be allowed into the appeal proceedings.

The e-mail option in OD1 is only an additional way to
distribute received faxes. The e-mail section for
receiving e-mails to be stored and processed as data
items according to the invention is therefore not
suggested in the prior art.

OD1 mentions as a benefit the possibility of dispensing
with the use of costly printers and therefore does not
suggest a print section according to the invention.

The device setting screen of the invention is used to enable a configurable default processing of a plurality of data items (faxes or e-mails) upon reception, as opposed to individually selecting a data item in the stored list. The HTML file for the device setting screen is thus different from the HTML file of the stored data list according to OD1.

There is a mutual influence of the technical effects and advantages obtained, so that the claims are directed to a combination, rather than an aggregation, of features. The device settings directly determine the data items stored in the storage section and contained in the HTML file of the stored data list, so that the settings contribute to a simplified, more used-friendly, accessing of the data items through the web browser. The combination brings about several technical advantages, such as reducing the traffic between server and client by transmitting a list of items instead of the items themselves and limiting the resources needed for storage and printing of the data items. The device setting screen and the stored data list displayed on the browser are therefore interrelated.

OD2 is silent about the user interface or about a connection to the internet. The terminal according to OD2 relies on application software and drivers to send a series of commands to a remote fax apparatus. These software components are proprietary. This teaches away from the invention using standard network and HTML technology. The skilled person would therefore not have envisaged combining OD1 with OD2 when designing a device setting screen.

Reasons for the Decision

1.   The appeal is admissible.

2.   Main request

2.1   OD1 as state of the art

The opposition division found that the appellant did
not adduce conclusive evidence for the pre-publication
of the book from which document OD1 was taken, although
additional evidence for proving the publication date of
OD1 was filed in the opposition proceedings (see
point III above). With the statement of grounds of
appeal the appellant submitted OD1', including
photocopies of the same Chapter 11 of a book available
in the British Library, identified by ISBN 1-56884-848-
X and a cover sheet provided with a date stamp.

It may be argued that doubts relating to the
publication date of OD1 remained in view of the
evidence available to the opposition division. The
board does not have to decide this point in the present
circumstances, since additional and, in the board's
judgment, conclusive evidence was filed with OD1'. The
board has a discretion to admit evidence presented with
the statement of grounds of appeal and in the present
circumstances, where the additional evidence clearly
relates to the case under appeal, the board decided to
take OD1' into account in application of Article 12(4)
of the Rules of Procedure of the Boards of Appeal (RPBA,
OJ EPO 2007, 536).

The respondent has not argued that the pages common to OD1 and OD1' (*i.e.* Chapter 11, pages 329 to 355) differed in contents. In fact, the board considers that OD1 and OD1' are photocopies taken from different copies of the same book identified by the same ISBN (ISBN 1-56884-848-X), one copy available to the appellant in Japan and the other copy obtained from the British Library. OD1' carries a copyright date of 1996 and a date stamp of 28 June 1996 by the British Library, i.e. both prior to the priority date (1999) of the patent in suit.

Hence the board is convinced that OD1 was made available to the public before the priority date of the contested patent. OD1 is thus comprised in the state of the art according to Article 54(2) EPC 1973. Since it was filed with the notice of opposition, it was submitted in due time and cannot be disregarded as late-filed evidence in accordance with Article 114(2) EPC 1973. Since the opposition division did not have a discretionary power in this respect, the point at issue is not whether the opposition division has "applied the right principles" as argued by the respondent. Rather, the board had to decide whether, in view of the evidence now on file, OD1 was pre-published, and the board came to a different judgment on this point.

2.2   Inventive step (ground for opposition under Article 100(a) together with Article 56 EPC 1973)

2.2.1   OD1 discloses a personal computer implementing a network facsimile apparatus on a web basis (a so-called "webified" fax system) capable of communicating with a

client connected to the apparatus via a computer
network with:

- a web server running the CGI facsimile application,
  transmitting an HTML file to the client in response
  to a request from the client;
- a facsimile section which receives a fax image via
  the telephone network connected to a modem;
- a storage section which stores various data items
  including the image received by said facsimile
  section as document information pieces in a working
  fax directory;
- means for generating an HTML file of a stored data
  list with the document information pieces listed
  corresponding to stored data items in the storage
  section to transmit to the client, so that the
  stored data list is displayed on the browser of the
  client (see the fax administration screen of
  figure 11-1 on page 344) and
- means for transmitting a stored data item
  corresponding to a document information piece
  selected to a designated destination when the
  apparatus receives a transmission request for a
  terminal (the client user clicking the "view" button
  in figure 11-1).

The board regards the following features as implicit in
OD1:

- The server generating an HTML file (to be displayed
  on the browser of the client) in response to a
  corresponding request from the client is a feature
  of the HTTP protocol together with CGI applications,
  which are common to both OD1 and the invention (see

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paragraphs [0023], [0027] and [0028] of the patent
specification). This is not contested by the
respondent.

–   The web server transmitting the HTML file generated
    in said HTML generating section to the client in
    response to a request from the client, while
    receiving a processing request selected from the
    HTML file on the browser of the client. This defines
    the response, on the server side, to the client
    browser addressing the homepage of the application
    and accessing the list of the stored data items by
    clicking the FAX RECEPTION LIST or INTERNET
    RECEPTION LIST button on the main page of figure 11
    in the patent in suit. The same process has to take
    place in OD1 before the client browser displays the
    fax administration screen of figure 11-1.

2.2.2   The features of claim 1 missing in OD1 are thus, in
        short:

(a)   a mail section;
(b)   a printing section for printing the various data
      items and
(c)   an HTML file of a device setting screen and the
      processing of a setting request.

2.2.3   An interface to e-mail systems is already foreseen in
        OD1, allowing the distribution of faxes to e-mail
        addresses of further people (see the "mailto" value for
        the HREF variable on page 344 and the e-mail option on
        page 355). OD1 further emphasizes the ability to
        integrate faxes with other internet services as a
        particular advantage of the "webified" fax system (see

page 332, second paragraph). In view of the similarity between the services typically offered for collections of faxes and e-mails, storing incoming e-mails and administering them in a way similar to incoming faxes is an obvious extension of the known electronic communications system. Thus the provision of feature (a) constitutes an obvious step.

2.2.4   Printers are common peripheral devices of computer systems. Indeed OD1 addresses the cost of printers in personal computer packages (see page 330). OD1 also offers a print option instead of, or in addition to, viewing images on the client monitor screen (see page 354) and thus suggests using a printer. OD1 however leaves open whether printing under the control of a printing section is performed on the client side or on the server side. Printing images on a printer connected to the server computer is a choice which has to be made according to the circumstances of the usage, in which a (costly) printer may be remotely shared by several clients. Thus the provision of feature (b) constitutes an obvious step.

2.2.5   OD1 identifies one reason to "webify" a fax system with a CGI program in the ability to customise features specific to the user's business, or to tailor the program to particular needs (see page 332, first paragraph).

OD2 relates to a fax apparatus connected to a remote terminal such as a computer, for instance through a LAN interface. A receive mode of the fax apparatus may be remotely preset by the terminal to one of a "memory receive" mode in which a received fax is stored and not

printed, a "memory receive + printout" mode in which a
received fax is stored and printed, or a "normal
receive" mode in which a received fax is printed and
not stored (see column 33, line 52, to column 34,
line 11). These modes correspond to those according to
the invention as defined in claim 1.

OD2 thus teaches that the receive modes for processing
faxes upon reception in a fax apparatus may be set over
a LAN by appropriate commands. OD2 leaves the details
for implementing the setting open. The skilled person
implementing this additional feature in the fax server
software of OD1 would readily envisage a web-based
solution for the user interface, since such interfaces
are explicitly presented in OD1 as advantageous (see
the section "Why Webify a Fax System" bridging
pages 331 and 332). In this context the board considers
the display of a device setting screen on the browser
of the client, to enable the client to set the
apparatus for processing upon reception of data items,
as a straightforward measure for setting individual
client options in a computer network. This allows a
client to set a default option of one of the receive
modes in a way which was commonly known in many
computer applications, such as for the selection of a
printer in a network. The solution with an HTML file of
a device setting screen and a setting request (*i.e.* a
CGI command) according to claim 1 is thus
straightforward and the provision of feature (c)
constitutes an obvious step.

2.2.6   The respondent argues that OD2 teaches away from the
        invention because it concerns a proprietary solution
        different from the invention, resorting to standard

technology such as a web browser, HTML and CGI. OD2
indeed mentions that software components including
application software and drivers for remote operation
are installed on the client and that the fax apparatus
is controlled by specific commands provided by the
terminal (see column 1, lines 41 to 49; column 4,
lines 39 to 52 and column 5, lines 46 to 51). The
present invention however also requires corresponding
components. The CGI string analysis and application
deciding sections are specific software applications
processing the requests on the server (see
paragraph [0028] in the patent specification). Software
components generating hardware-specific commands for
controlling the network interface and the fax
peripheral device are also necessary in the apparatus
according to the invention.

Thus the board cannot find an indication that the
skilled person, starting from a web browser application
as in OD1 and in view of its advantages mentioned
therein, would be led away from combining the teaching
of OD2 with that of OD1, since the setting of receive
modes represented no difficulties in a webified fax
system.

2.2.7   The board does not see the synergetic effects between
features alleged by the respondent for the following
reasons.

The device setting screen allows the user to set the
apparatus to store or not to store data items upon
reception. Items which are set for only printing are
not stored and not added to the stored data list (see
the branch (ST410, ST411) in figure 6 of the patent

specification). As a result, the setting step has an influence on the content of the HTML file generated later for display of the stored data list on the client's browser. However the two steps are consecutive and do not bring about a technical effect beyond the individual foreseeable effects of the consecutive steps.

The respondent identifies several technical advantages of the invention. Reducing the traffic between server and client results from transmitting a list of the stored data item instead of the data items themselves (see also paragraph [0012] in the patent specification). This advantage is also achieved in OD1, which mentions the benefits of not transmitting the full-sized version of a fax item in the case of a slow internet link (see page 335, first paragraph). Limiting the resources needed for storage and printing of the data items are further advantages for the server. They result from common considerations in the field of data processing and are not related to traffic considerations on the network.

As a result, the board does not see the synergetic effect alleged by the appellant, so that separately considering features (a) to (c) mentioned above for assessing inventive step in the context of claim 1 is justified.

2.2.8   In conclusion the provision of features (a) to (c) in an apparatus known from OD1 would have been obvious to a person skilled in the art, and the subject-matter as claimed does not involve an inventive step. The subject-matter of claim 1 thus does not comply with

Article 56 EPC 1973, and the main request is not
allowable.

3.   Auxiliary request

3.1   Claim 1 according to the auxiliary request differs from
        claim 1 according to the main request by setting out
        that the HTML file of a device setting screen is read
        from the storage section in response to a request from
        the client. This additional feature was a usual feature
        of a web server, in which static HTML (web) pages were
        stored on the web server and fetched upon request by
        the client user, for instance in accordance with the
        HTTP protocol. The respondent has also not argued to
        the contrary.

3.2   As a result, this additional feature does not
        substantially change the reasoning set out above
        concerning claim 1 of the main request. Therefore the
        subject-matter of claim 1 does not comply with
        Article 56 EPC 1973 and the auxiliary request is not
        allowable.

4.   None of the requests by the respondent (patentee) being
        allowable, the patent cannot be maintained.

Order

For these reasons it is decided that:

1.   The decision under appeal is set aside.

2.   The patent is revoked.

The Registrar   The Chairman

L. Fernández Gómez   F. Edlinger

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