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Datasheet for the decision of 30 October 2009

Case Number: T 1762/06 - 3.5.01

Application Number: 00116163.7

Publication Number: 1098252

IPC: G06F 15/02

Language of the proceedings: EN

Title of invention:
A device for transferring data between an unconscious capture device and another device

Applicant:
Ricoh Company, Ltd.

Opponent:
-

Headword:
Unconscious capture device/RICOH

Relevant legal provisions:
-

Relevant legal provisions (EPC 1973):
EPC Art. 56

Keyword:
"Inventive step - querying for new documents (no - well known alternative)"
"Inventive step - no synergy between features having different immediate effects"

Decisions cited:
-

Catchword:
-

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Case Number: T 1762/06 **-** 3.5.01

D E C I S I O N
of the Technical Board of Appeal 3.5.01
of 30 October 2009

Appellant: Ricoh Company, Ltd.
3-6, Nakamagome 1-chome,
Ohta-ku
Tokyo 143-8555 (JP)

Representative: Schwabe - Sandmair - Marx
Patentanwälte
Stuntzstrasse 16
81677 München (DE)

Decision under appeal: **Decision of the Examining Division of the European Patent Office posted 6 July 2006 refusing European patent application No. 00116163.7 pursuant to Article 97(1) EPC 1973.**

Composition of the Board:

Chairman: S. Steinbrener
Members: W. Chandler
P. Schmitz

Summary of Facts and Submissions

I. This appeal is against the decision of the examining division to refuse the European patent application No. 00116163.7 on the ground that claims 1 and 12 of the main request were not clear (Article 84 EPC 1973). Furthermore, the examining division stated that even a clarified version of the claims would not involve an inventive step over EP-A-0 691 619 (D2) and the skilled person's common general knowledge. The same ground of lack of inventive step applied to claim 1 of the first to sixth auxiliary requests.

II. In the statement setting out the grounds of appeal, the appellant requested that the decision under appeal be set aside and that a patent be granted on the basis of claims 1 to 19 of a newly filed main request. The appellant also made an auxiliary request for oral proceedings.

III. In the communication accompanying the summons to oral proceedings, the Board summarised the issues to be discussed and tended to agree with the examining division that claim 1 lacked an inventive step.

IV. In a reply, dated 5 October 2009, the appellant filed a set of new claims 1 to 19 and commented on the Board's observations.

V. At the oral proceedings before the Board, the appellant requested that the decision under appeal be set aside and that a patent be granted on the basis of claims 1 to 19 filed with the reply dated 5 October 2009. At the

end of the oral proceedings, the Chairman announced the decision.

VI. Claim 1 of the sole request reads as follows:

"A method for transmitting a document from a first device through a portable device to a second device such that communication of the document occurs between the first device and the second device, comprising:

the portable device transmitting an identification information to the first device

the portable device receiving a first encrypted version of the document from the first device;

the portable device is storing the first encrypted version of the document; and

the portable device receiving a query from the second device requesting an indication as to whether the portable device contains one or more new documents to be downloaded;

characterized in that

the portable device is either

a) sending a first key for encryption to the first device,

or

b) in case the portable device is transmitting the identification information to the first device, it selects an encryption scheme or identified a first key, and

and (sic) the portable device is transmitting the document to the second device upon request of the second device."

VII. The appellant argued essentially as follows:

In D2, instead of an electronic document, only the reference or address of the electronic document was transmitted. It was true that for a very small electronic document, the document reference may also have included the electronic document itself. Nevertheless a document reference was still transmitted that was used to access a database of electronic documents to identify and transmit a particular one of the electronic documents to a terminal.

The portable device of the invention sent a key for encryption or transmitted identification information, for instance about the type of transmission software available on the portable device, to the first device, e.g. an office machine, to enable it to send a document to the portable device. According to D2, either the portable device or the transmitting device, the PC of person A, had suitable interfaces, or the suitable interface had to be produced by the portable device on the basis of a communication between an office machine and the portable device.

Furthermore, the portable device of the invention received a query from any second device requesting an indication as to whether the portable device contained one or more new documents to be downloaded. Afterwards, the portable device was able to transmit the document to the second device. According to D2 it was necessary to use a location technique to know which kind of office machine was available in the vicinity (see page 5, in particular lines 13 to 22 of the application as published). On the basis of this knowledge it was

possible to initiate a communication between the PDA and another PC, the PC of person B. D2 clearly disclosed (see page 6, lines 1 to 15) that on the basis of an icon displayed on the PDA of the receiving person B, the receiving person B was able to decide that the transmitted document address had to be sent to another office machine to be retrieved from a database to be printed out for the personal use of the other person B.

The distinguishing features had the synergistic effect that they allowed a completely automatic communication between a portable device - a PDA of a person - and office machines e.g. computers, or scanners. By dividing this common effect of the invention, which was not known from D2, into two inappropriate objects, the examining division had defined two problems in such a way that contained pointers to the solution.

According to D2, a user interface was employed to send and receive document references. According to page 4, lines 48 to 53, a user interface could also be fully or partially omitted from the PDAs. It was vaguely disclosed that a suitable user interface could be reproduced which user interface should correspond to that of a suitable device. How this should work was not disclosed.

Reasons for the Decision

1. The appeal complies with the requirements referred to in Rule 65(1) EPC 1973 and is therefore admissible.

The application

2. The application concerns the problem of automatically and securely transferring documents between a first device and a second device (computers and/or office equipment) using a portable device.

3. In one embodiment of the invention (Figure 2), a user can copy a document on a photocopier (201), which automatically ("unconsciously") transmits an electronic version to a portable device (shuttle memory appliance - SMA 202) worn by the user. When the user returns to his or her PC (203), the data is further unconsciously downloaded to the PC (paragraphs 12 and 16 of the published application). A second embodiment (Figure 3) applies the same principles to the transfer of a document between two PCs (paragraph 31). Thus the application discloses unconsciously transferring documents both to and from the portable device. The application also discloses that transfers in either direction may be "conscious", i.e. manual (e.g. paragraphs 13 and 30).

Inventive step

4. It is common ground that D2 discloses a system for transmitting a document from a first to a second device (page 2, lines 3 to 5) through a portable device (Figure 1 - Tab). In particular, the portable device transmits identification information to the first device (page 6, line 20) and receives and (implicitly) stores an encrypted (using shared key technology) version of at least the document reference ("document token" - page 6, lines 33 to 37).

5. The examining division considered at point 2.1 of the reasons for the decision that claim 1 differed from D2 by two groups of features, namely that the portable device:

i) a) sends a first key for encryption to the first device, or

b) transmits an identification information to the first device which allows the first device to select an encryption scheme or to identify the first key;

ii) receives a query from the second device requesting an indication as to whether the portable device contains one or more new documents to be downloaded.

6. In examination and appeal, is was argued that another difference was that D2 explicitly did not transmit "documents", but only references to documents, so that less storage in the portable device was required. However, the Board agrees with the examining division that D2 also discloses at page 3, lines 11 and 12 that the reference may include a "very small" document, which falls under the term "document" used in the claim. In the Board's view, the fact that a reference may be transmitted as well does not affect this.

In any case, it would be obvious to a skilled person that the transmittable data volume depends on the storage capabilities of the portable device and hence on the availability and affordability of memory capacity.

7. In appeal, claim 1 has been amended and put in the two-part form. The above feature in group ii) has been put

in the pre-characterising part. However, the Board can find no disclosure in D2 that the second device queries the portable device for new documents, and thus continues to maintain it as a difference. This group has also been augmented by the last feature of the characterising portion, which recites that the portable device transmits the document to the second device "upon request" of the second device. In the Board's view, the amendments in appeal, and the re-drafting in the two-part form, have resulted in a claim that is not entirely clear. However, for the purposes of this decision, the Board assumes the meaning of the features is the same as that used in examining proceedings and repeated by the appellant in the appeal proceedings.

8. Concerning the features of group ii), the fact that D2 discloses at page 4, lines 48 to 53, the possibility of omitting the user interface from the portable device (and indicating the transmission or receipt of a document only by an acoustic signal, for example) apparently led the examining division, at point 4, paragraph 3 of the reasons for the decision, to its formulation of the problem as "to look whether there are new documents without using the user interface". The appellant has protested that this problem points to the solution, presumably by containing the concept of "looking" for documents. It appears rather that the examining division has jumped directly to a specific problem that it considered to be obvious to the skilled person.

9. Nevertheless, the Board considers that this situation is generally best avoided by formulating the problem after first considering the effect of the

distinguishing features. In this respect, the appellant emphasised the aspect of the "unconscious" or automatic transfer. However, in the Board's view, the claimed querying and requesting for new documents by the second device is not an automatic transfer in the broadest sense of the application (see point 3, above), since it does not exclude that a user initiates the query or request. Rather, the Board considers that the effect of the features is to initiate the transfer from the side of the second device. In D2, on the other hand, according to step S2 of the embodiment of Figure 5(a), and page 6, lines 21 to 24, the transfer from the Tab can be in response to an input from the Tab's user interface, i.e. initiated from the side of the portable device. Thus the Board considers that the objective technical problem is to provide an alternative way of initiating the transfer of documents from the portable device to the second device.

10. In the Board's view, in the field of data transmission, querying the portable device for documents is a well known alternative to the portable device broadcasting that it has documents ("pull" versus "push"). The Board would use the above-mentioned idea of omitting the user interface at this point in the argument as evidence of a motivation to do this since in this case it would no longer be possible for the user of the Tab to initiate the transmission. In the Board's view, it is a routine design option to consider transferring only "new" documents. Finally, the newly added qualification of the last feature that the portable device transmits the document "upon request of the second device" is a further obvious aspect of an alternative to a truly automatic transmission after finding new documents.

11. Concerning the features of group i), the Board judges that D2 in fact discloses alternative a). In the Board's view, when D2 goes on to discuss Figure 5(b) of D2, albeit only sparingly at lines 38 to 39 of page 6, as relating to the process carried out in the portable device in one embodiment of the invention, it is a further detail of the previous embodiment. Figure 5(b) contains a step called "Exchange public keys", which in the Board's view, by using the term "exchange", implies that the Tab sends a first key for encryption to the first device, according to alternative a).

12. Nevertheless, in the case that D2 cannot be said to unambiguously disclose alternative a), the Board has also considered the inventive step of alternative b). In this case, the Board agrees with the examining division that the differences under groups i) and ii) relate to different effects that have no synergy, namely a general aspect of security and the above-mentioned initiation of the document transfer. The appellant considers that the encryption features of group i) contribute to the "automatic" communication between devices because they take care of the encryption without the user having to intervene. However, in the Board's view a synergy must exist at the level of the immediate effect of each of the respective distinguishing features, otherwise there is merely a juxtaposition rather like features relating to the input and output stages of an amplifier, both "improving" the amplifier. In the present case, there is no mention of the timing or conditions for the transfer to the portable device that could be considered to define an automatic transfer. Rather, the

immediate effect of the encryption features relates to security as mentioned above.

13. In the light of the fact that D1 already discloses that the portable device receives an encrypted document that must have been encrypted using a key (see point 4, above), the problem solved by this feature could in fact be more specific than the general security aspect referred to by the examining division, namely how to select the key used to encrypt the document. In the Board's view it would be self-evident that if, as disclosed in D2, shared key cryptography is to be used to encrypt the document, the key chosen for encryption would have to depend on who the document is being sent to. Since, as mentioned above, D2 discloses that the portable device sends identification information, the Board judges that it would be obvious to use this to determine who the portable device belongs to, and thus who the document is being sent to, and to select the key accordingly as claimed in alternative b).

14. Accordingly, the subject-matter of claim 1 of the sole request does not involve an inventive step (Article 56 EPC 1973).

15. There being no further requests, it follows that the appeal must be dismissed.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar: The Chairman:

T. Buschek S. Steinbrener