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**Datasheet for the decision
of 19 January 2010**

Case Number: T 0712/07 - 3.5.04

Application Number: 98301195.8

Publication Number: 0860985

IPC: H04N 1/32

Language of the proceedings: EN

Title of invention:

Data communication apparatus and method

Applicant:

CANON KABUSHIKI KAISHA

Opponent:

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Headword:

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Relevant legal provisions:

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Relevant legal provisions (EPC 1973):

EPC Art. 56

Keyword:

"Inventive step - (yes) after amendment"

Decisions cited:

-

Catchword:

-



Case Number: T 0712/07 - 3.5.04

D E C I S I O N
of the Technical Board of Appeal 3.5.04
of 19 January 2010

Appellant:

CANON KABUSHIKI KAISHA
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Representative:

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Decision under appeal:

Decision of the Examining Division of the
European Patent Office posted 17 November 2006
refusing European application No. 98301195.8
pursuant to Article 97(1) EPC 1973.

Composition of the Board:

Chairman: F. Edlinger
Members: C. Kunzelmann
B. Müller

Summary of Facts and Submissions

- I. The appeal is against the decision of the examining division to refuse European patent application No. 98 301 195.8.
- II. The application was refused on the grounds of lack of clarity (Article 84 EPC 1973) and lack of inventive step (Article 56 EPC 1973).
- III. The applicant appealed and filed claims according to a main request and an auxiliary request with the statement of grounds of appeal.
- IV. The board issued a communication pursuant to Article 15(1) of the Rules of Procedure of the Boards of Appeal (RPBA) annexed to a summons to oral proceedings.
- V. In response, the appellant filed new claims according to a main request and an auxiliary request with a letter dated 18 December 2009.
- VI. Oral proceedings were held on 19 January 2010. In the oral proceedings the appellant filed claims 1 to 10 of a sole request replacing the claims of all previous requests. The appellant also filed replacement pages of the description.
- VII. The appellant requested that the decision under appeal be set aside and that a patent be granted on the basis of claims 1 to 10 filed in the oral proceedings.

VIII. Claims 1 reads as follows.

"An image communication apparatus (21) adapted to be connected via a network (26) to a transmission destination terminal (24) having a WWW browser and to a further image communication apparatus (22) different from the transmission destination terminal, the claimed image communication apparatus (21) having an image input/output function (17-19), a network communication function (15) based on TCP/IP, a WWW server function and an electronic mail transmission/reception function, and the claimed image communication apparatus (21) comprising:

first transmission means for transmitting (S109) an electronic mail via said network (26) to said transmission destination terminal (24) using said electronic mail transmission function, the electronic mail including information usable by said WWW browser to locate an HTML file stored by the claimed image communication apparatus, said HTML file including information usable by said WWW browser to locate a display image file and a print image file which are formed from the same image received by said image input/output function and are also stored by the claimed image communication apparatus, image data of the display image file representing a display image for display on the transmission destination terminal (24) to confirm said image received by said image input/output function, image data of the print image file representing a print image for transfer as print data to said further image communication apparatus (22) after the transmission destination terminal confirms the display image, and a data amount of the display image being small relative to that of the print image;

HTML file supplying means operable, when a receiver of the electronic mail at the transmission destination terminal instructs (S112) confirmation of said image received by said image input/output function, to supply the HTML file to the WWW browser responsive to a demand therefrom (S113) designating the HTML file using said information included in the electronic mail;

display image supplying means operable to supply the display image file to the WWW browser responsive to a demand therefrom (S113) designating the display image file using said information included in the supplied HTML file so that the display image is displayed (S114) on a display unit of the transmission destination terminal for confirmation by the receiver of the electronic mail;

reception means for receiving an instruction from the transmission destination terminal (S116) after confirmation of the display image by the receiver of the electronic mail; and

second transmission means for transmitting (S125) to said further image communication apparatus (22) via said network the image data of said print image file on the basis of the instruction received by said reception means."

Claim 10 reads as follows.

"An image communication method performed by a first image communication apparatus (21) that is connected via a network (26) to a transmission destination terminal (24) having a WWW browser and to a further image communication apparatus (22) different from the transmission destination terminal, said first image communication apparatus (21) having an image

input/output function (17-19), a network communication function (15) based on TCP/IP, a WWW server function and an electronic mail transmission/reception function, the method comprising:

transmitting (S109) an electronic mail via said network (26) to said transmission destination terminal (24) using said electronic mail transmission function, the electronic mail including information usable by said WWW browser to locate an HTML file stored by the first image communication apparatus, said HTML file including information usable by said WWW browser to locate a display image file and a print image file which are formed from the same image received by said image input/output function and are also stored by the first image communication apparatus, image data of the display image file representing a display image for display on the transmission destination terminal (24) to confirm said image received by said image input/output function, image data of the print image file representing a print image for transfer as print data to said further image communication apparatus (22) after the transmission destination terminal confirms the display image, and a data amount of the display image being small relative to that of the print image; when a receiver of the electronic mail at the transmission destination terminal instructs (S112) confirmation of said image received by said image input/output function on the basis of the contents of the electronic mail, supplying the HTML file to the WWW browser responsive to a demand therefrom (S113) designating the HTML file using said information included in the electronic mail; supplying the display image file to the WWW browser responsive to a demand therefrom (S113) designating the

display image file using said information included in the supplied HTML file so that the display image is displayed (S114) on a display unit of the transmission destination terminal for confirmation by the receiver of the electronic mail;
receiving an instruction from the transmission destination terminal (S116) after confirmation of the display image by the receiver of the electronic mail;
and
transmitting (S125) to said further image communication apparatus (22) via said network the image data of said print image file on the basis of the instruction received from the transmission destination terminal."

Claims 2 to 9 are dependent on claim 1.

- IX. At the end of the oral proceedings the chairman announced the board's decision.

- X. The reasons for the decision under appeal which are applicable to the present amended claims can be summarised as follows.

The closest available prior art was represented by document

D1: WO 96/34341 A1.

D1 disclosed a data communication apparatus comprising means for generating an image file to be stored in a storage means of the data communication apparatus, and a mail transmission means for transmitting an electronic mail to a transmission destination terminal. The communication apparatus was operable to cause

transmission of the stored image file in response to a request.

According to the invention, two image files were generated, namely a display image file and a print image file. The data amount of the display image was small relative to that of the print image. First the display image file was transmitted to the transmission destination terminal. The print image file was only sent from the image communication apparatus after receipt of a request from the transmission destination terminal. Hence the intention of the invention was to reduce the amount of data traffic on the network. However both this problem and the same solution were also addressed in D1. All the aspects of the invention were known from D1 or at least obvious to a person skilled in the art.

XI. The appellant's arguments can be summarised as follows.

D1 did not disclose that the electronic mail included information usable by the WWW browser of the transmission destination terminal to locate the HTML file that in turn included the information to locate the stored display and print image files. Instead the electronic mail in D1 merely informed the user that a message had been received and stored in a message storage and delivery system (MSDS). D1 also did not disclose that the HTML file was supplied in response to a demand from the receiver of the electronic mail and that the HTML supplying means used this information provided in the electronic mail. Instead, according to D1, the user had to access the URL of his MSDS mailbox with a hyper-text browser and then authenticate himself.

Furthermore D1 did not disclose transmission of the image data of the print image file to a further image communication apparatus on the basis of an instruction received from the transmission destination terminal. Instead in D1 a request for a selected facsimile message was sent from the user's computer to the MSDS, and this caused the message to be downloaded to the user's computer, not to a further image communication apparatus different from the user's computer. Thus with the invention the network load on the user's terminal was reduced. Furthermore the invention was more convenient to the user as he could cause download of the print image file to a desired image communication apparatus different from his computer, after inspection ("confirmation") of the display image at his computer.

Reasons for the Decision

1. The appeal is admissible.
2. *Amendments (Article 123(2) EPC)*
 - 2.1 Claim 1 is based on claim 8 as originally filed and includes features disclosed in the description and drawings as originally filed as follows.

The elements connected by a network to the image communication apparatus are disclosed, for instance, in figure 2. The functions of the image communication apparatus are disclosed on page 7, lines 9 to 14, and in figure 1. The functionality of the first transmission means is disclosed, for instance, on page 12, lines 12 to 18, and in figure 3. The features

of the electronic mail are disclosed on page 12, lines 9 to 11, and page 14, lines 3 to 7, in conjunction with page 10, line 24, to page 12, line 3, and in original claim 11. The features of the display image file and the print image file are disclosed, for instance, on page 9, line 7, to page 10, line 8, and in original claim 2. The features of the HTML file supplying means are disclosed, for instance, on page 13, line 16, to page 14, line 10, and in figure 4. The features of the display image supplying means are disclosed, for instance, on page 14, lines 10 to 24. The features of the reception means are disclosed, for instance, on page 12, lines 19 to 24, in conjunction with page 14, line 25, to page 17, line 11. The functionality of the second transmission means was partly contained in original claim 10 and is further disclosed, for instance, on page 18, lines 17 to 25, and in figure 5.

The method of claim 10 corresponds to the apparatus of claim 1. The dependent claims are disclosed in original claims 9, 11 and 1 to 7. The amendments made to the description do not go beyond an adaptation to the amended claims.

Thus the board sees no reason for an objection under Article 123(2) EPC.

3. *Clarity (Article 84 EPC 1973)*

- 3.1 The expressions objected to in the decision under appeal are no longer present in the claims. And the board sees no reason for an objection under Article 84 EPC 1973 in the present application documents.

4. *Novelty (Article 54(1), (2) EPC 1973) and inventive step (Article 56 EPC 1973)*

4.1 The closest prior art

It is undisputed that D1 is the closest available prior art. D1 discloses an image communication apparatus in the form of a message storage and delivery system (MSDS). If a message, for instance a facsimile message, is received, it is stored in the system and converted into hypertext mark-up language (HTML). A reduced size HTML image and a full size HTML image may be created according to user preferences (see figures 2, 4(A) and 4(B)). The intended recipient of the message is notified, for instance by electronic mail, that a message has been received. The user then accesses with a browser the URL associated with his MSDS mailbox (see figure 3). In accordance with a number of different options, the user is provided with a listing in one of several formats which may include full and/or reduced size images (see page 11, lines 3 to 13). The user can thus preview a message before selecting it for download via the internet to his computer (see page 19, line 26, to page 20, line 21).

4.2 The distinguishing features

D1 does, at least, not disclose that the MSDS is suitable for transmitting an electronic mail to the intended user which includes information usable by a WWW browser to locate an HTML file including information usable by said WWW browser to locate a display image file and a print image file. And D1 does

not disclose that the MSDS is suitable for transmitting an image file, on the basis of an instruction from the user's computer, to a further image communication apparatus different from the user's computer. The apparatus of claim 1 is thus new (Article 54(1), (2) EPC 1973).

4.3 The effects achieved over the teaching of D1

The MSDS of D1 is conceived to allow a recipient to access messages easily and with minimal costs, at any time at virtually any location world-wide (see page 9, lines 7 to 15). But the MSDS is intended to deliver the message only to the requesting user, who is the intended recipient and owner of the MSDS mailbox (see page 16, lines 3 to 27).

4.4 While application of the teaching of D1 allows the amount of data traffic on the network to be reduced, as correctly stated in the decision under appeal (see point X above), the apparatus of present claim 1 in addition allows for quicker access, via the information included in the electronic mail, to two different image quality files which are both stored in the communication apparatus. On reception of instructions the apparatus is suitable for transmitting the image data of the print image file to a further different communication apparatus. This allows a user at the distant destination terminal to easily and quickly manage image files stored in the claimed communication apparatus and, by inspecting and confirming display image files, to keep control over which image files are transferred to a different communication apparatus without downloading the files themselves (see page 2,

line 12, to page 3, line 1, and page 20, lines 12 to 27).

The decision under appeal is silent on these features which were included in the course of the appeal proceedings (but partly contained in original claim 10). There is nothing in the documents on file to suggest that these features were known in the same or a similar context, and the board has no evidence that accessing and managing different quality image files from the same image as set out in the context of the communication apparatus of claim 1 belonged to the common general knowledge at the priority date.

- 4.5 Thus in the board's judgment the apparatus of claim 1 involves an inventive step (Article 56 EPC 1973).
- 4.6 The method of independent claim 10 comprises method steps which correspond to the functioning of the apparatus as given above. Hence also the method of claim 10 involves an inventive step for the reasons given above.
5. The board sees no other possible objection to the grant of a patent on the basis of the present application documents.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.

2. The case is remitted to the first instance with the order to grant a patent in the following version:
Description:
Pages 5, 11, 12, 15, 16, 18 to 21 as originally filed.
Pages 1 to 3, 6, 10, 13, 14, 17 filed with the letter of 25 September 2003.
Pages 4, 7, 8, 9, 22, 23 received during oral proceedings of 19 January 2010.
Claims:
No. 1 to 10 received during oral proceedings of 19 January 2010.
Drawings:
Sheets 1/5 to 5/5 as originally filed.

The Registrar:

The Chairman:

L. Fernández Gómez

F. Edlinger