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**Datasheet for the decision
of 17 February 2012**

Case Number:	T 1639/07 - 3.5.01
Application Number:	01306755.8
Publication Number:	1207482
IPC:	G06F 17/60, G06F 3/12, G06F 13/00

Language of the proceedings: EN

Title of invention:
E-mail printing apparatus and method and E-mail printing
program

Applicant:
CANON KABUSHIKI KAISHA

Headword:
E-mail printing apparatus/CANON

Relevant legal provisions:
EPC Art. 52(1), 123(2)

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

Keyword:
"Inventive step (no)"

Decisions cited:
–

Catchword:
"An effect cannot be validly used in the formulation of the
technical problem if the effect requires additional
information not at the disposal of the skilled person even
after taking into account the content of the application in
question."(See point 2.5 of the reasons)

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Case Number: T 1639/07 **-** 3.5.01

D E C I S I O N
of the Technical Board of Appeal 3.5.01
of 17 February 2012

Appellant: CANON KABUSHIKI KAISHA
(Applicant)   30-2, 3-chome Shimomaruko
                        Ohta-ku
                        Tokyo   (JP)

Representative: Hitching, Peter Matthew
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Decision under appeal: **Decision of the Examining Division of the**
                        European Patent Office posted 26 February 2007
                        refusing European patent application
                        No. 01306755.8 pursuant to Article 97(1) EPC
                        1973.

Composition of the Board:

Chairman: R. R. K. Zimmermann
Members: W. Chandler
                   G. Weiss

Summary of Facts and Submissions

I.   European patent application number 01 306 755.8
        (publication number EP 1 207 482 A2) claims priority
        from a previous patent application filed in 2000 for an
        e-mail printing apparatus, method, and program.

II.   The examining division refused the application for lack
        of inventive step. The decision was announced in oral
        proceedings on 16 January 2007 and posted in writing on
        26 February 2007. According to the decision, the
        closest prior art was a printer receiving e-mails and
        automatically printing the received e-mail, as
        acknowledged in the application at pages 1 to 3 (cf.
        paragraph 0003 f. of the A2-publication of the present
        application). A user of such a printer would, as a
        matter of everyday experience, find printouts of
        e-mails with garbled text. A skilled person trying to
        tackle this problem had two possibilities: First, an
        administrative solution, printing the part of the
        e-mail the user considered to make sense and chopping
        off the rest. Second, a technical solution clearly more
        difficult to implement, namely determining exactly the
        part of a received e-mail containing valid and relevant
        information and printing only this meaningful part of
        the e-mail. The administrative solution was simple and
        straightforward: providing a print limit set by the
        user, based on its experience about the average ratio
        between valid and invalid information in garbled
        printouts, and automatically stopping the print-out if
        the print limit set is encountered. The automation of
        such a print process was a normal goal, the
        implementation straightforward and without any
        inventive merits.

III.   Against the decision of the examining division, the
       appellant (applicant) lodged an appeal on 4 May 2007,
       paying the appeal fee on the same day. By letter
       received by the EPO on 2 July 2007, the appellant filed
       a statement setting out the grounds of appeal on the
       basis of a new set of claims replacing all previous
       claims on file.

IV.   After having received a negative opinion from the Board,
       the appellant filed two new sets of claims as main and
       auxiliary requests by a letter dated 15 November 2011.
       Claim 1 of the main request reads as follows (brackets
       [1]<>, [2]<> etc. are added for convenience of reference):

         "An e-mail printing apparatus (301) for receiving e-
         mail including an abnormal e-mail having annexed
         image data and also having imperfect MIME
         information that misdescribes the annexed image data
         as text data and for executing printing of the
         received e-mail, the apparatus comprising reception
         means (506, 507) for receiving e-mail,
         the apparatus being characterised by:
         [1]<>
         setting means (712, 516, 711) for setting whether a
         limit to printing is to be executed and for setting
         a [2]<> print limit for at least one of a number of
         lines, a number of characters, a number of pages and
         a data size [3]<in printing> the e-mail received by the
         reception means; and
         control means (517) for, [4]<> if it is set by said
         setting means that a limit to printing is to be
         executed and if the received e-mail exceeds the [2]<>
         print limit set by said setting means (701),

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controlling a printer (423) to print the received e-mail up to the [2]<> print limit set by said setting means without printing that portion of the received e-mail which exceeds the set [2]<> print limit whereby, when the received e-mail is such an abnormal e-mail and the e-mail with meaningless text data arising from the misdescribed image data exceeds the print limit set, the printing of at least some of that meaningless text data is prevented, and for, [4]<> if it is set by said setting means that the limit to [2]<> printing is not to be executed [5]<>, controlling the printer to print the received e-mail regardless of the [2]<> print limit set by said setting means."

The amendments of claim 1 of the auxiliary request in respect to claim 1 of the main request are as follows:

[1]<> reads "determining means (517) for determining from MIME information included in a header of the received e-mail whether or not subsequent data of the received e-mail is text data;".
[2]<> reads "text".
[3]<> reads "in case of printing body text data in".
[4]<> reads "if it is determined by said determining means that the subsequent data is text data and".
[5]<> reads "or if it is determined by said determining means that the subsequent data is not text data".

V.   In oral proceedings held on 17 February 2012, the matter was discussed with the appellant.

The appellant requested that the decision under appeal be set aside and that a patent be granted on the basis of claims 1 to 8 according to the main or auxiliary

requests, both requests filed with the letter dated
15 November 2011.

VI.   According to the appellant, the invention claimed was
       both novel and inventive over the cited prior art.
       Printing a mixed format e-mail comprising text and
       image data resulted in a large amount of garbled text
       and meaningless printout when the MIME information in
       the content-type header of the was incorrect. The
       present invention addressed this problem directly and
       efficiently, by providing a function for setting a
       predefined limit to text printing. In an error
       situation produced by an incorrectly headed section of
       image data, the invention allowed the printing of a
       number of pages sufficient for reproducing the legible
       text, but avoided waste of paper by truncating the
       meaningless portion of the text output.

       In practice, the user would make an educated guess to
       set an appropriate limit so that in the majority of
       cases the objects of the invention would be attained,
       namely the full printing of non-corrupted e-mail but
       prevention of at least some garbled text in the case of
       a corrupted e-mail. The fact that situations could be
       imagined in which some text of a non-corrupted e-mail
       was not printed or some garbled text was printed did
       not make the solution useless. For the user there is
       still some benefit when wastage of paper, ink/toner and
       energy was reduced. Whatever its shortcomings, the
       solution provided by the invention had the very
       significant advantage of simplicity, which translated
       in turn into a low processing burden and delay.

The prior art did not lead to the invention in any obvious manner. The solution inspired by the prior art would rather have been first to analyze the received e-mail to determine whether garbled text occurred in the e-mail and then to prevent printing of the e-mail in its entirety. The present invention avoided the technical complexity of such a solution by enabling the users to set an upper limit to the number of pages allowed to be printed. This solution, described as "administrative solution" by the examining division, was elegant and flexible and was not disclosed in any piece of prior art cited against the application. Arguing obviousness by constructing a simple alternative between an "administrative solution", allegedly the present invention, and a "technical solution", allegedly implied by the prior art, was an inadmissible ex post facto line of reasoning.

The amendments to claim 1 according to the auxiliary request were supported by the application as filed albeit some inconsistencies existing between the claim and figures 9 and 11 of the drawings, the last erroneously showing that the text print limit also applied to non-text image data. However, throughout the description, limiting the print amount was consistently disclosed in respect to text data only. In particular, at column 8, lines 12 to 24, the application described explicitly that TIFF image data were immediately printed after decoding step 9-10, implying that conditional steps 9-12 and 9-13 did not apply to non-text image data.

One advantage of the embodiment according to the auxiliary request was a further reduction in the

processing burden and delay in printing an e-mail as
print limit processing was skipped for image data and
applied only to the text data of the e-mail.

Reasons for the Decision

1.   The appeal, although admissible, cannot be allowed
         since none of the requests before the Board would
         warrant or require the requested reversal of the
         decision under appeal.

Main request

2.   Claim 1 of the main request does not comply with the
         requirement of inventive step.

2.1   The closest prior art is the e-mail printing apparatus
         acknowledged as prior art in the present application
         (loc. cit.). This supposition about the closest prior
         art was made by the examining division and was not
         disputed by the appellant. According to the application,
         the e-mail printing apparatus in the prior art is able
         to receive a mixed format e-mail from a mail server,
         for example, and to print automatically the body text
         data of the e-mail as well as any annexed image data.
         A corrupted e-mail having a faulty content-type header
         may result in the printout of the image data as text
         data, producing a large quantity of pages containing
         meaningless character trains.

2.2   The characterising portion of claim 1 correctly
         identifies the features that distinguish the claimed
         apparatus from the said closest prior art. According to

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the two-part form, the invention is characterised
essentially by setting means for setting whether a
limit to printing is to be executed and for setting a
print limit and by means for controlling the printer to
print the received e-mail up to the print limit, or, if
the limit to printing is not to be executed, to print
the received e-mail regardless of the print limit set
by the setting means.

2.3   For assessing inventive step the technical problem
        objectively solved in respect to the closest prior art
        has to be determined. The appellant has argued that the
        invention addressed the problem of how to control an
        e-mail printer to avoid printing garbled text when the
        e-mail to be printed was corrupted.

2.4   However, this technical problem is not solved by the
        invention in the whole ambit of claim 1 since depending
        on the print limit set there will be, at the high end
        of possible values, no effect on the amount of garbled
        text printed at all, or, at the low end, a substantial
        loss of meaningful body text data, rendering the
        printout worthless. There is no guidance how to choose
        an appropriate print limit to avoid these
        disadvantageous situations, neither in the claims nor
        anywhere in the application.

2.5   The appellant put forward the argument that the user
        could make an "educated" guess of the print limit. The
        assumption that this would guarantee the success of the
        invention is speculative. The objective technical
        problem must be derived from physical, chemical etc
        effects directly and causally related to the technical
        features of the claimed invention. An effect cannot be

validly used in the formulation of the technical
problem if the effect requires additional information
not at the disposal of the skilled person even after
taking into account the content of the application in
question. There is certainly not enough information in
the present application for determining an appropriate
print limit in any reliable and reproducible manner.

2.6   Except for an automatic stop of printing, the Board can
        not discern any technical effect that might be achieved
        by the invention within the whole ambit of claim 1. The
        effect explicitly mentioned in claim 1 that "the
        printing of at least some of that meaningless text data
        is prevented" is rightly subject to the condition that
        "the e-mail with meaningless text data ... exceeds the
        print limit set". The claim, therefore, does thus not
        exclude the possibility that the print limit is set too
        large as to be effective in reducing garbage printout,
        or too low as to produce a meaningful printout at all.

2.7   Hence, the objective technical problem solved by the
        invention must be found elsewhere. Limiting the
        printout of e-mails might be motivated by technical
        considerations as asserted in the present application,
        but equally well by business concepts or administrative
        rules. Business concepts and administrative rules, for
        example, do not belong to the patentable realm of
        technical inventions and can thus not support the
        patentability of an invention. In assessing inventive
        step, they should rather be treated as a general (non-
        technical) aim supposed to be given to the skilled
        person and forming part of the general framework of the
        objective technical problem an invention solves.

2.8   Such a general non-technical aim consistent with the
        definitions of claim 1 is in the present case for
        example the concept of restricting the access of
        employees to printer resources, a restriction that
        would also apply to printing e-mails, and of achieving
        this by imposing the administrative rule that the
        maximum amount of printout per user and document should
        not exceed a prescribed limit, with the caveat that the
        user should be able to bypass the restriction under
        specific circumstances, directions etc.

2.9   In the present case, a skilled person in the field of
        digital printing who endeavours to implement such a
        concept, would be directed immediately to the objective
        technical problem to be solved, simply by casting the
        general non-technical aim into an operational language.
        This technical problem is as follows: providing the
        prior art printer (see above) with a function for
        automatically limiting the amount of printout of
        electronic documents and with functions for setting a
        value used as print limit and for enabling/disabling
        the limiting function.

2.10   Posing a technical problem that may be derived directly
        from a preceding general non-technical aim does not
        require any technical creativity or inventiveness on
        the part of the skilled person and hence lacks any
        inventive merits. Accordingly, the technical problem
        solved in the present case (see above), does not
        positively contribute to inventive step.

2.11   The solution of the technical problem as defined in
        present claim 1 is obvious in the light of the common
        technical knowledge of the skilled person. The setting

and control means defined in present claim 1 are common components in digital printers; this has not been disputed before the Board. The specific functions of and the interaction between these components as defined in functional terms in the present claim 1 do not go beyond the functionality the technical problem requires to be implemented. Since this functionality is to a substantial extent directly derivable from a non-technical concept as pointed out above, the claimed solution of the technical problem does not provide an inventive technical contribution over the prior art.

2.12   From these considerations, the Board concludes that the subject matter of claim 1 of the main request does not meet the requirement of inventive step of Article 52 (1) EPC and Article 56 EPC 1973.

Auxiliary request

3.   Claim 1 of the auxiliary request is, for reasons of added subject matter, not admissible pursuant to Article 123 (2) EPC.

3.1   The auxiliary request adds among others to claim 1 the feature that "if it is determined by said determining means that the subsequent data is not text data" the printer is controlled to print the received e-mail regardless of the text print limit set.

3.2   It is undisputed before the Board that this feature is not expressly disclosed in the application as filed and that it contradicts what is shown in Figures 9 and 11. According to these drawings there is no such possibility to bypass an enabled print limit.

3.3   The appellant is right when arguing that throughout the
        description the print limit is referred to only in the
        context of limiting text data. However, this does not
        imply any specific disclosure about what happens with
        the image data annexed to an received e-mail. The only
        clear disclosure to this end is found in Figures 9
        and 10, providing a different conclusion, namely that
        the print limit also applies to image data. The passage
        in column 8, lines 11 to 21, cited by the appellant in
        support of its argument that the drawings are wrong in
        this respect, neither justifies the assumption that the
        drawings are wrong, nor supports, in a direct and
        unambiguous manner, the amended feature in question.
        This passage as well other parts of the text are silent
        about the process executed on image data between the
        decoding step 9-10 and step 9-15 of Figure 9 (or 11).

3.4   Thus, even if some doubts regarding the processing of
        image data were justified, there is insufficient
        evidence that the added feature is derivable in a
        direct and unambiguous manner from the application as
        filed. In the absence of such a disclosure, the Board
        concludes that claim 1 of the auxiliary request does
        not meet the requirements of Article 123 (2) EPC.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar: The Chairman:

T. Buschek   R. R. K. Zimmermann