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Datasheet for the decision of 17 November 2008

Case Number: T 1106/08 - 3.5.04

Application Number: 98120872.1

Publication Number: 0899739

IPC: G11B 27/30

Language of the proceedings: EN

Title of invention:
Image reproduction system

Applicant:
CANON KABUSHIKI KAISHA

Headword:
-

Relevant legal provisions:
RPBA Art. 11

Relevant legal provisions (EPC 1973):
EPC Art. 56
EPC R. 67

Keyword:
"Inventive step (no - main and auxiliary request)"

Decisions cited:
-

Catchword:
-

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Case Number: T 1106/08 - 3.5.04

D E C I S I O N
of the Technical Board of Appeal 3.5.04
of 17 November 2008

Appellant: CANON KABUSHIKI KAISHA
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Ohta-ku
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Representative: TBK-Patent
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Decision under appeal: **Decision of the Examining Division of the European Patent Office posted 29 January 2008 refusing European application No. 98120872.1 pursuant to Article 97(1) EPC 1973.**

Composition of the Board:

Chairman: F. Edlinger
Members: A. Dumont
B. Müller

Summary of Facts and Submissions

I. The appeal is directed against the decision by the examining division to refuse European patent application 98 120 872.1, published as EP 0 899 739 A2 and filed as a divisional application of the earlier European patent application 92 108 064.4.

II. The refusal was based on the ground that the subject-matter of claim 1 according to all requests then on file lacked an inventive step in view of the prior art combination of

D1: DE 38 31 291 A1

with the general knowledge of the person skilled in the art of computer operating systems.

III. With the statement of grounds of appeal, the appellant requested that the appealed decision be set aside and that a patent be granted on the basis of the claims discussed during the oral proceedings before the examining division. A fair copy of these claims according to a main request and an auxiliary request was enclosed in the statement of grounds of appeal.

IV. Independent claim 4 according to the main request reads as follows.

"A print instruction method comprising:

a reading step of reading, from a storage medium which stores plural still image information and time information for each still image information, the time information;
a setting step of inputting start and end times for setting a time period; and

a determining step of determining, by using the read time information, the stored still image information whose time information is within the set time period between the start and end times; and
a print instruction step of instructing the performing of a printing operation to print all the still image information read by said reading step whose time information is determined by said determining step to be within the set time period between the inputted start and end times."

V. Claim 1 according to the auxiliary request reads as follows. Features which have been added to claim 4 according to the main request are underlined.

"A print instruction method comprising:

a reading step of reading, from a storage medium which stores plural still image information and time information for each still image information, the time information;
a setting step of inputting start and end times for setting a time period; and
a determining step of <u>automatically</u> determining, by using the read time information, the stored still image information whose time information is within the set time period between the start and end times; and
a print instruction step of instructing the <u>automatic</u> performing of a printing operation to print <u>subsequently</u> all the still image information read by said reading step whose time information is determined by said determining step to be within the set time period between the inputted start and end times."

VI. The reasons in the decision under appeal are essentially as follows.

D1 disclosed a print system in which the user identified still images by setting a marker information

("Markierungssignal") and in which the so-marked files were subsequently automatically printed. The invention improved the printing system known from D1 by providing the possibility of selecting still images by their recording or storing times. Usual computer operating systems (for example the well-known "Windows" operating system) allowed the user to use a batch file to automatically select and print files according to a time information. The invention resulted therefore from an obvious improvement of the system according to D1.

The examining division also noted that the invention according to claim 1 would even lack novelty with regard to operating systems which stored each file together with additional information such as the time of storage and which allowed the selection of files according to this information and the printing out of them together.

VII. In the statement of grounds of appeal the appellant argued that the examining division based the decision on the knowledge of the skilled person by successively referring to different versions of the Windows operating system (Windows 95 in the summons to attend oral proceedings and Windows 3.1 in the oral proceedings). The division however did not provide documentary evidence for its assertions, despite the repeated requests by the appellant to do so. The appellant argued that it could not be accepted that the claims on file were rejected on the basis of a citation of the name of an operating system without introducing at least part of the documentation of the cited system, which should have referred to the features which the examining division wanted to combine with document D1 so as to prove the non-patentability of the claims on file. Already for that reason the appeal was justified in the appellant's view.

VIII. In a communication sent in preparation for the oral proceedings, the board expressed the preliminary opinion that storing files with additional information comprising time and date and using a batch file for automatically printing the files selected on the basis of this additional information were features of operating systems known at the priority date of the present application. The board moreover drew the appellant's attention to the fact that the present application disclosed in detail an embodiment with images stored as analogue signals on a (8 mm) video tape but did not disclose any particulars for embodiments for the processing of electronic image files in general. Such particulars therefore seemed to be known to the skilled person. The contribution of the present application to the art did not seem to lie in the provision of additional time information in electronic files and/or in the principle of batch processing in general. Otherwise objections of lack of support by the description (Article 84 EPC 1973) or of lack of sufficient disclosure (Article 83 EPC 1973) would have to be considered.

The board furthermore drew attention to an additional prior art document (cited in the European search report)

D3: EP 0 271 020 A2

and indicated that the question of inventive step would also have to be discussed in view of D3 taken alone or in combination with D1.

IX. Oral proceedings before the board took place on 17 November 2008.

X. The appellant requested that the decision under appeal be set aside and that a patent be granted on the basis of claims 1 to 18 according to the main request submitted with the statement of grounds of appeal or on

the basis of the claims 1 to 3 according to the auxiliary request submitted with the statement of grounds of appeal.

XI. The argumentation by the appellant, insofar as it is relevant for the assessment of inventive step, may be summarised as follows.

It was not contested that retrieving pictures on the basis of attributes as well as batch processing in general were known in the prior art. D3 disclosed however a retrieval based on a single time piece of information, in particular a single day, not a time period. Each image was displayed as a still image to allow index information to be added, which showed that D3 went in a different direction. Furthermore, the printing of pictures displayed on the screen in D3 required a user to confirm the printing of each picture, this process being lengthy due to the limited memory and processing capacity (at the priority date). The automatic and consecutive printing of a series of pictures without intervention of the user was thus not disclosed. The prior art did not suggest the features which were missing from D3. The subject-matter of the independent claims was therefore not obvious.

Reasons for the Decision

1. The appeal is admissible.

2. *Procedural matters*

2.1 The appellant's criticism of the examining division for not providing documentary evidence for the relevant features of the operating system(s) referred to by the examining division (see point VII above) was discussed in the oral proceedings before the board as to whether

it constituted a request for remission to the department of first instance pursuant to Article 11 RPBA (OJ 2007, 536).

2.2 The board explained that the priority date of May 1991 of the present application might constitute a special reason for not remitting the case even if the board came to the conclusion that the first instance procedure was flawed with fundamental deficiencies.

2.3 The board also expressed doubts whether fundamental deficiencies (within the meaning of Article 11 RPBA) or a substantial procedural violation (within the meaning of Rule 67 EPC 1973) were in fact apparent in the present case.

The explanations given by the examining division as to how, on the basis of common general knowledge, a person skilled in the art would have designed a method for determining and automatically printing stored images having date information within a set time period might have been misleading for the applicant. This is certainly true for the references to Windows 95, which was not yet available at the priority date. Although this procedure is open to criticism, the board expressed the opinion that the essential features for carrying out the invention were actually known from existing operating systems (see also point VIII above) and that the present claims did not specify that the determining and printing of stored information was carried out by particular measures (for instance batch processing, loop processing or other known determining and printing steps). In the oral proceedings the appellant no longer contested that such measures were known *per se*.

2.4 The appellant, following these explanations, has not made an explicit request to remit the case to the first instance. Furthermore the proceedings have already been pending for around sixteen years (the parent application was filed in May 1992).

2.5 Therefore the board decided not to remit the case to the department of first instance, leaving the question of the presence of fundamental deficiencies undecided.

3. *Inventive step*

3.1 Main request

3.1.1 The present invention as claimed is not limited to a particular type of electronic image files, such as still images stored as analogue signals on a video tape according to the example in figure 12 (see also paragraph [0161] of the application as published).

3.1.2 D3 discloses a filing system in the form of an electronic album, possibly containing thousands of photographs, and a method in which images originating from an electronic still camera should be retrieved in a fast and easy manner. D3 starts from a background where a keyboard is mounted on a camera. This is presented as impractical and D3 sets out that it is desirable to only have a mechanism on a camera which automatically gives a date of taking a photograph by using a microcomputer. The invention in D3 allows for adding index information by a device which can read the information on the image recording medium of the camera (see page 2, lines 16 to 40; claim 1 of D3). Each image is stored in a large capacity file (10 - figures 3 and 4) constituting the storage medium in the terms of claim 4, together with additional index information, such as a person's name, a location or day/time

information. Images read from the file (10) and retrieved using the index information may be printed (see page 2, lines 20 to 46, and page 4, lines 36 to 55). D3 is considered to constitute the closest prior art because it teaches retrieving still pictures based on time information.

3.1.3 The following features according to claim 4 are not disclosed in D3 and render its subject-matter new:

- the inputting of start and end times for setting a time period;
- the determining of the stored still image information whose time information is within the set time period and
- the performing of a printing operation to print all the still image information whose time information is determined to be within the set time period.

3.1.4 The technical problem solved by the distinguishing features set out above can be formulated as improving the convenience of retrieving and printing a plurality of images (see paragraphs [0004], [0010] and [0013] of the application as published).

3.1.5 The image filing system of D3 generally aims to retrieve images from the large capacity file (10) in a convenient and fast manner and explicitly foresees the automatic retrieval on the basis of "index information including approximate day and time which were inputted" (see page 4, lines 44 and 45). As a matter of routine work, the person skilled in the art would envisage the implementation of further search options in order to tailor the process of retrieving images to the user's needs. Retrieving images based on a time period (such as, for instance, vacation time) determined by start and end times constitutes a common desire of users, so that the skilled person would have readily regarded it

as a desirable feature of an electronic album. In the judgment of the board, envisaging a retrieval of selected images based on a time period was therefore an obvious modification of the prior art known from document D3.

3.1.6 The system according to D3 provides for the possibility of consecutively displaying on a screen (9) the retrieved images without intervention of the user ("page turn-over mode") and printing an image whilst it is displayed (see page 4, lines 45 to 51). It is left open in D3 whether printing of each image requires separate confirmation by the user. However the board considers it a matter of normal design for the skilled person to provide a print instruction step to print all the still image information within the set time period in order to also dispense with the user's intervention during the time-consuming printing process in the context of the convenient and fast retrieval system of D3. Moreover this was already suggested in prior art document D1, which teaches the automatic and consecutive printing of selected still images (see "automatisch und fortlaufend" in column 11, lines 50 to 55).

3.1.7 As a result, the method according to claim 4 does not involve an inventive step. The main request is therefore not allowable (Article 56 EPC 1973).

3.2 Auxiliary request

Claim 1 of the auxiliary request differs from claim 4 of the main request by the underlined expressions ("automatically determining... the stored still image information", "automatic performing of a printing operation to print subsequently all the still image information"). These differences do not change the substance of the claim and are encompassed by the determining and print instruction steps considered in points 3.1.5 and 3.1.6 above.

As a result, claim 1 according to the auxiliary request is not allowable for substantially the same reasons as claim 4 according to the main request (Article 56 EPC 1973).

3.3 In conclusion, none of the appellant's requests is allowable.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar The Chairman

D. Sauter F. Edlinger