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Case Number: T 1701/08 - 3.5.04

Application Number: 99110023.1

Publication Number: 989728

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Language of the proceedings: EN

Title of invention:
Network facsimile apparatus

Applicant:
Panasonic System Networks Co., Ltd.

Headword:

Relevant legal provisions:
EPC 1973 Art. 56

Keyword:
Inventive step (no)

Decisions cited:

Catchword:

Case Number: T1701/08 - 3.5.04

D E C I S I O N
of the Technical Board of Appeal 3.5.04
of 20 October 2011

Appellant: (Applicant)
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Decision under appeal: **Decision of the Examining Division of the European Patent Office posted on 31 March 2008 refusing European patent application No. 99110023.1 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chairman: F. Edlinger
Members: R. Gerdes
C. Vallet

Summary of Facts and Submissions

I. The appeal is against the decision of the examining division to refuse European patent application No. 99 110 023.1.

II. The patent application was refused by the examining division in accordance with Article 97(2) EPC because the subject-matter of the claims according to the applicant's main and auxiliary request was found to lack inventive step in view of the prior art documents

D1: US 5675507 A,
D2: US 5805298 A and
D3: US 5333266 A.

III. With the statement setting out the grounds of appeal, the appellant submitted new sets of claims according to a main request, a first auxiliary request and a second auxiliary request.

IV. In a communication annexed to a summons to oral proceedings, the board drew attention to *inter alia* the following further document:

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 xi to xxvi and pages 3 to 42 (Chapter 1) and 329 to 355 (Chapter 11)

The board indicated that, in its provisional opinion, the subject-matter of claim 1 according to all requests lacked inventive step in view of OD1' in combination

with the common general knowledge of the skilled person.

V. With a letter dated 16 September 2011 the appellant filed replacement claims for the main request and the first and second auxiliary requests.

VI. Oral proceedings were held on 20 October 2011. During the oral proceedings the appellant submitted new claims for the first auxiliary request.

VII. At the end of the oral proceedings the appellant requested that the decision under appeal be set aside and that a patent be granted on the basis of the claims of the main request filed with the letter of 16 September 2011, auxiliarily on the basis of the claims of the first auxiliary request submitted in the oral proceedings, auxiliarily on the basis of the claims of the second auxiliary request filed with the letter of 16 September 2011.

VIII. Claim 1 of the main request reads as follows.

"A network facsimile apparatus (201) being adapted to connect to a telephone network (PSTN) and a computer network, where the computer network includes a terminal apparatus (202) and a destination apparatus being distinct from the terminal apparatus,

the network facsimile apparatus (201) comprising:

a facsimile communication section (9) for receiving facsimile data via the telephone network (PSTN);

converting means (14) for converting facsimile data received by the facsimile communication section (9) into TIFF files;

e-mail receiving means (13) for receiving e-mails including attached TIFF files via the computer network;

a memory (4) that stores the TIFF files as converted by the converting means (14) and the TIFF files included in the e-mails as received by the e-mail receiving means (13);

generating means (11) being adapted to generate an HTML file for a reception list page (602) showing a list of TIFF files stored in the memory (4), whereby this HTML file is stored in the memory (4), and

means (1) for providing a transmission instruction page on which a user at the terminal apparatus (202) can enter an instruction for the network facsimile apparatus (201) to transmit a selected TIFF file to the destination apparatus;

a web server (12) being adapted to transmit the HTML file to the terminal apparatus (202) such that the reception list page (602) is displayed at the terminal apparatus (202), the reception list page (602) including a transmission button;

the web server (12) being further adapted to transmit the transmission instruction page to the terminal apparatus (202) such that the transmission instruction page is displayed at the terminal apparatus (202) when the user chooses a TIFF file on the reception list page (602) and requests the transmission instruction page being transmitted to the terminal apparatus (202) by a

click of the transmission button at the reception list page (602), and

e-mail transmission means (13) being adapted to transmit the selected TIFF file to the destination apparatus via the computer network when the user designates the destination on the transmission instruction page displayed at the terminal apparatus (202)."

IX. Claim 1 of the first auxiliary request reads as follows (amendments to claim 1 of the main request have been highlighted by the board using "strikethrough" for deleted passages and "underlining" for new or amended passages).

"A network facsimile apparatus (201) being adapted to connect to a telephone network (PSTN) and a computer network, where the computer network includes a terminal apparatus (202) and a destination apparatus being distinct from the terminal apparatus,

the network facsimile apparatus (201) comprising:

a facsimile communication section (9) for receiving facsimile data via the telephone network (PSTN);

converting means (14) for converting facsimile data received by the facsimile communication section (9) into TIFF files;

e-mail receiving means (13) for receiving e-mails including ~~attached~~ TIFF files via the computer network;

a memory (4) that stores the TIFF files as converted by the converting means (14) and the TIFF files included

in the e-mails as received by the e-mail receiving means (13);

generating means (11) being adapted to generate an HTML file for a reception list page (602) showing a list of TIFF files stored in the memory (4) and sender's addresses of each TIFF file stored in the memory (4), whereby this HTML file is stored in the memory (4), and

means (1) for providing a transmission instruction page on which a user at the terminal apparatus (202) can enter an instruction for the network facsimile apparatus (201) to transmit a selected TIFF file; and a destination e-mail address of ~~to~~ the destination apparatus to which the selected TIFF file is transmitted;

a web server (12) being adapted to transmit the HTML file to the terminal apparatus (202) such that the reception list page (602) is displayed at the terminal apparatus (202), the reception list page (602) including a transmission button;

the web server (12) being further adapted to transmit the transmission instruction page to the terminal apparatus (202) such that the transmission instruction page is displayed at the terminal apparatus (202) when the user chooses a TIFF file on the reception list page (602) and requests the transmission instruction page being transmitted to the terminal apparatus (202) by a click of the transmission button at the reception list page (602), and

e-mail transmission means (13) being adapted to transmit the selected TIFF file to the destination apparatus via the computer network when the user

designates the destination e-mail address on the transmission instruction page displayed at the terminal apparatus (202)."

X. Claim 1 of the second auxiliary request reads as follows (amendments to claim 1 of the first auxiliary request are indicated by the board as set out in point IX above).

"A network facsimile apparatus (201) being adapted to connect to a telephone network (PSTN) and a computer network, where the computer network includes a terminal apparatus (202) and a destination apparatus being distinct from the terminal apparatus,

the network facsimile apparatus (201) comprising:

a facsimile communication section (9) for receiving facsimile data via the telephone network (PSTN);

converting means (14) for converting facsimile data received by the facsimile communication section (9) into TIFF files;

e-mail receiving means (13) for receiving e-mails including TIFF files via the computer network;

a memory (4) that stores the TIFF files as converted by the converting means (14) and the TIFF files included in the e-mails as received by the ~~e-~~mail receiving means (13);

generating means (11) being adapted to generate an HTML file for a reception list page (602) showing a list of TIFF files stored in the memory (4) and sender's

addresses of each TIFF file stored in the memory (4), whereby this HTML file is stored in the memory (4), and

means (1) for ~~providing~~generating a transmission instruction page on which a user at the terminal apparatus (202) can enter an instruction for the network facsimile apparatus (201) to transmit a selected TIFF file; and a destination e-mail address~~of the destination apparatus~~or a destination facsimile number to which the selected TIFF file is transmitted;

a web server (12) being adapted to transmit the first HTML file to the terminal apparatus (202) such that the reception list page (602) is displayed at the terminal apparatus (202), the reception list page (602) including a transmission button;

the web server (12) being further adapted to transmit the transmission instruction page to the terminal apparatus (202) such that the transmission instruction page is displayed at the terminal apparatus (202) when the user chooses a TIFF file on the reception list page (602) and requests the transmission instruction page being transmitted to the terminal apparatus (202) by a click of the transmission button at the reception list page (602), ~~and~~

the e-mail transmission means (13) being adapted to transmit the selected TIFF file to the destination apparatus via the computer network when the user designates the destination e-mail address on the transmission instruction page displayed at the terminal apparatus (202),

and the facsimile communication section (9) being adapted to transmit the selected TIFF file to the

destination apparatus via the telephone network (PSTN) when the user designates a destination facsimile number on the transmission instruction page displayed at the terminal apparatus (202)."

XI. The appellant's arguments with respect to inventive step of the claimed subject-matter in view of document OD1' may be summarised as follows.

Main Request

The invention is based on the use of TIFF files for reception, storage and transmission of image files. Even though compression of data files according to the TIFF format is not as efficient as for GIF, the TIFF format was chosen in the invention because it can be consistently used for all operations of the network facsimile machine. In particular, the TIFF format is conventionally used as an attachment for e-mail messages and for facsimile messages.

OD1' constitutes the closest prior art with respect to the subject-matter of claim 1. It does not disclose the use of TIFF files and user-initiated transmission of TIFF files to other computers. Consequently, a transmission instruction page is not provided. The forwarding option, which is referred to in OD1', differs from that of the invention because it operates starting from GIF files. Due to the use of GIF as a file format, a complicated conversion process in multiple steps is needed to receive a facsimile (see OD1', bottom of page 336). Using the GIF format also means that multiple files, each relating to one page, have to be transmitted, instead of one file having multiple pages. OD1' does not provide a motivation to change the image file format.

First Auxiliary Request

Claim 1 of the first auxiliary request contains the additional feature that the sender's address is displayed on the reception list page showing the list of TIFF files in the network facsimile's memory. This allows the user to decide more easily on the basis of this additional information how to proceed with the file, i.e. whether it should be forwarded, downloaded from the network facsimile apparatus so as to be read by the user, or printed.

Second Auxiliary Request

Claim 1 of the second auxiliary request additionally specifies that the TIFF file can be forwarded via facsimile. The network facsimile apparatus, therefore, provides more flexibility in choosing where to send the TIFF file. ODl' only hints at forwarding by e-mail, but due to its focus on the internet, it does not consider a dual mode of transmission either via e-mail or via facsimile. As a result of the facsimile transmission function it also becomes possible to upload and send facsimiles from any web client via the network facsimile apparatus.

Reasons for the Decision

1. The appeal is admissible.

2. *Main request: inventive step (Article 56 EPC 1973)*

2.1 It is not contested that OD1' may be considered the closest prior art with respect to the subject-matter of claim 1.

2.2 OD1' discloses a network facsimile apparatus (see page 332, last paragraph) being adapted to connect to a telephone network so as to receive facsimile data via the telephone network (page 333, line 3: "answer the modem …"). The network facsimile apparatus provides a connection to a computer network (page 338, line 6: "If your fax server and Web server are one and the same, …"). In addition, OD1' shows facsimile converting means (see pages 336 and 337) and a memory that stores the received facsimile data (page 330, lines 16 to 19; page 333, line 5 and page 353, last paragraph). The network fax contains a web server generating an HTML file for a reception list page (see page 344, figure 11-1) and for transmitting this file to a terminal apparatus (page 331, last paragraph and page 341, chapter "The fax administration screen"). Like the present application, OD1' is aimed at decreasing network traffic, which is why the web server generates a list of facsimiles and only downloads facsimiles to the terminal apparatus at the user's request (see page 335, first chapter and page 344, figure 11-1). The ability to forward faxes and the transmission of faxes as e-mail attachments are disclosed as "future directions for the fax viewer" (see pages 354 to 355) in OD1', i.e. OD1' discloses that it would be desirable

to improve the facsimile viewer by providing one or more of these functionalities.

2.3 OD1' does not directly and unambiguously disclose the following features in combination with the remaining features of claim 1:

(a) use of the TIFF file format for conversion, storage, display and transmission of facsimile files,

(b) e-mail receiving means for receiving e-mails including TIFF files via the computer network,

(c) a transmission button on the reception list page,

(d) a transmission instruction page,

(e) which is transmitted to the terminal apparatus by the web server under the conditions given in claim 1,

(f) e-mail transmission means being adapted to transmit the selected TIFF file to the destination apparatus via the computer network, when the user designates the destination on the transmission instruction page.

In the oral proceedings the appellant accepted this analysis of the differences distinguishing the subject-matter of claim 1 from OD1'.

2.4 Distinguishing feature (a) relates to the use of a different image file format, which has the technical effect that TIFF attachments of e-mails need not be converted into another image file format for storage and forwarding.

The remaining features (b) to (f) extend the functionality of the network facsimile apparatus by making it possible to receive and transmit e-mails including attachments (features (b) and (f)) and by providing a forward function at the terminal apparatus (features (c) to (e), in part (f)).

2.5 The technical problem solved by features (a) to (f) may, therefore, be formulated as how to further improve the functionality of the network facsimile apparatus and the data handling in the network facsimile apparatus of OD1'.

2.6 The board regards the provision of mail receiving means according to feature (b) as an obvious improvement of the Web-based fax server functionality disclosed in OD1'. OD1' proposes "An E-Mail Option" (see page 355) for sending faxes to a specified e-mail address. At the relevant date of the application, e-mail communication already allowed for both transmission and reception of text and multimedia files. This is also outlined in OD1', see page 331, "Because MIME standards allow the inclusion of multimedia in e-mail …", together with page 332, "[t]he ability to integrate faxes with other Internet services …".

2.7 The functionality realised by features (c) to (f), i.e. providing a forward function at the terminal apparatus, was already suggested as a desirable option in OD1' (see point 2.2 above). Hence, an inventive step could only be based on the technical implementation of this functionality.

The implementation as specified in features (c) to (f) involves the provision of a transmission button on the reception list page. When the user chooses a file on

the reception list page and clicks on the transmission button, a transmission instruction page is sent from the web server to the terminal apparatus. The transmission instruction page allows the user to enter an instruction to forward the selected file to the destination apparatus.

The appellant did not contest that this procedure as such describes an implementation of the transmission and forwarding functionality, which the skilled person would consider without the exercise of inventive skills.

2.8 With respect to distinguishing feature (a), the board regards the skilled person in the field of facsimile and e-mail communication to be well-acquainted with different image file formats and to have knowledge of multipurpose internet mail extensions (MIME), which extend the format of e-mails to support non-text attachments. When performing the task of improving data handling, the skilled person would obviously take into account the file format in which facsimile messages or e-mail attachments are received or transmitted as a constraint subject to which optimisation has to be effected. The use of the TIFF file format as a common file format for image files was well-known at the effective date of the present application (see D1, column 11, lines 11 to 23; D2, column 8, lines 38 to 50). Also, the appellant acknowledged that the TIFF format was conventionally used as an attachment for e-mail messages and for facsimile messages. Optimisation of data handling and conversion usually implies finding a reasonable trade-off between the requirements for reducing storage space and computational effort. Depending on the circumstances of the specific case the skilled person would have considered a solution that

minimises the computational effort at the expense of an increase in storage space by handling all e-mail attachments in the format in which they are usually transmitted (see D2, column 8, lines 45 to 47). It was therefore obvious to convert incoming facsimile messages into this common format and to use this format for storage, display and transmission, in particular, since fax forwarding by e-mail communication was intended, as already suggested in OD1'.

2.9 Hence, the board holds that the subject-matter of claim 1 lacks inventive step in view of document OD1'.

3. *First auxiliary request: inventive step (Article 56 EPC 1973)*

3.1 Claim 1 according to the first auxiliary request is essentially distinguished from claim 1 of the main request by the following features:

(g) the reception list page shows "sender's addresses of each TIFF file stored in the memory", and

(h) the transmission instruction page is adapted such that a user can enter a destination e-mail address of the destination apparatus to which the selected TIFF file is transmitted.

3.2 These features provide further details concerning the functionality provided by the reception list page and the transmission instruction page. Neither of these features is disclosed in OD1'.

3.3 Feature (h) allows for the transmission of TIFF files to arbitrary destination e-mail addresses. This

constitutes a straightforward implementation of the "E-Mail Option" suggested in OD1' with the TIFF-file format being used instead of GIF. Hence, it cannot justify an inventive step.

3.4 With respect to distinguishing feature (g) the appellant argued that it provided additional information to the user at the terminal apparatus, which allowed him to decide more easily how to proceed with the file, i.e. whether it should be forwarded, etc. Even if it were accepted that this effect was a necessary consequence of the provision of the senders' addresses, the board still considers this feature to constitute a common measure in the context of e-mail communication.

3.5 Hence, the subject-matter of claim 1 does not involve an inventive step.

4. *Second auxiliary request: inventive step (Article 56 EPC 1973)*

4.1 Claim 1 according to the second auxiliary request is essentially distinguished from claim 1 of the first auxiliary request by the following feature:

(i) the facsimile communication section is adapted to transmit the selected TIFF file to the destination apparatus via the telephone network when the user designates a destination facsimile number on the transmission instruction page displayed at the terminal apparatus.

4.2 OD1' suggests a fax forwarding option (see page 355) according to which a "fax forwarding button" could be

added to the "Admin Screen", which is displayed at the terminal apparatus (see page 344, figure 11-1). OD1' does not explicitly disclose how the destination for facsimile transmission is selected. The contribution of feature (i) therefore lies in a straightforward implementation of the fax forwarding option of OD1' (page 355), which mentions that this option "would permit a fax number to be entered". The board thus considers the implementation according to claim 1 to be a straightforward measure, which the skilled person would have chosen without inventive skill.

4.3 The appellant argued that OD1' only hinted at forwarding by e-mail, but due to its focus on the internet, led away from considering a dual mode of transmission either via e-mail or via facsimile. The board disagrees. As shown above, OD1' suggests at least the individual options of forwarding image files either via facsimile or e-mail. Including both options would have been obvious in a network where both e-mail and facsimile destinations have to be supplied with image files.

4.4 Hence, the skilled person would have arrived at the subject-matter of claim 1 according to the second auxiliary request without any inventive step.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar: The Chairman:

K. Boelicke F. Edlinger

Decision electronically authenticated