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**Datasheet for the decision
of 10 December 2014**

Case Number: T 1247/10 - 3.5.04

Application Number: 01966472.1

Publication Number: 1329093

IPC: H04N1/00

Language of the proceedings: EN

Title of invention:

METHOD AND SYSTEM FOR MERGING SCAN FILES INTO A COLOR WORKFLOW

Applicant:

Electronics for Imaging, Inc.

Headword:

Relevant legal provisions:

EPC Art. 123(2)

RPBA Art. 13(1)

Keyword:

Amendments - added subject-matter (yes) (main request)

Late-filed request - admitted (no) (auxiliary request)

Decisions cited:

Catchword:



**Beschwerdekammern
Boards of Appeal
Chambres de recours**

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Case Number: T 1247/10 - 3.5.04

D E C I S I O N
of Technical Board of Appeal 3.5.04
of 10 December 2014

Appellant: Electronics for Imaging, Inc.
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Representative: Zimmermann, Tankred Klaus
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Decision under appeal: **Decision of the Examining Division of the
European Patent Office posted on 28 January 2010
refusing European patent application
No. 01966472.1 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chairman F. Edlinger
Members: M. Paci
B. Müller

Summary of Facts and Submissions

- I. The appeal is against the decision of the examining division refusing European patent application No. 01 966 472.1 published as international patent application WO 02/23884 A2.
- II. The application was refused on the grounds that
 - claims 1 and 24 according to the main request met neither the requirements of Article 123(2) EPC nor those of clarity and support of Article 84 EPC; and
 - claims 1 and 24 according to the auxiliary request did not meet the requirements of clarity and support of Article 84 EPC and their subject-matter did not involve an inventive step in view of document D6 (US patent published as US 5 751 287 A).
- III. With the statement of grounds of appeal the appellant filed claims according to a main request and an auxiliary request, replacing all the claims previously on file.
- IV. In a communication under Article 15(1) RPBA (Rules of Procedure of the Boards of Appeal, OJ EPO 2007, 536), annexed to the summons to oral proceedings, the board raised objections under Article 123(2) EPC against several features of claims 1 and 23 according to both requests and of lack of inventive step of the subject-matter of these claims in view of D6.
- V. With a letter dated 10 November 2014, the appellant filed amended claims according to a new main request, replacing all claims previously on file.

- VI. With a letter dated 8 December 2014, the appellant filed amended claims according to first and second auxiliary requests.
- VII. The board held oral proceedings on 10 December 2014. During the oral proceedings, the appellant filed amended claims according to an auxiliary request replacing the claims of the previous first and second auxiliary requests. At the end of the oral proceedings, the board's decision was announced.
- VIII. The appellant's requests are 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 a letter of 10 November 2014, or if the main request could not be granted, on the basis of claims 1 and 2 of the auxiliary request submitted in the oral proceedings on 10 December 2014.
- IX. Claim 1 according to the appellant's **main request** reads as follows:

"A method comprising:

 providing a print device for printing on sheets of paper, the print device coupled with a graphical user interface (GUI);

 providing at least a first and second document files each comprising a plurality of pages, wherein at least one document file from among the first document file and the second document file comprises a scan file;

 providing a plurality of merge templates comprising instructions for printing a document that specify layout parameters and color settings that are specified in a job ticket for a print job including source RGB, color profile, source type, saturation, true color,

smoothing or anti-aliasing, toner reduction, and print modes;

selecting and applying a merge template to create a merged document comprising a plurality of said pages, wherein the merge template further comprises a tool for specifying pagination in said merged print file and imposition of multiple pages on one or more of the sheets of paper;

displaying a thumbnail page image of each of the pages on the GUI;

providing a user a drag-and-drop selection means via the GUI for:

selecting at least one thumbnail page image from the first document file by clicking on the thumbnail page image with a pointing device and dropping said at least one thumbnail page image into said merged; and

selecting at least one additional thumbnail page image from the second document file by clicking on the at least one thumbnail page image with the pointing device and dropping said at least one additional thumbnail page image into said merged document, wherein the at least one thumbnail page image and the at least one additional thumbnail page image comprise selected page images;

combining the selected page images using said merge template, wherein the merge template incorporates instructions for the placement of multiple pages per sheet; and

printing said merged document using said print device."

X. Claim 1 according to the appellant's **auxiliary request** reads as follows:

"A method comprising:

providing a print device for printing on sheets, the print device connected with a graphical user interface (GUI);

providing at least a first and second document file each comprising a plurality of pages, wherein at least one document file from among the first document file and the second document file comprises a first scan file;

displaying a thumbnail page image of each of the plurality of pages of the at least first and second document file on the graphical user interface (GUI);

providing a user a drag-and-drop selection means via the graphical user interface (GUI) for:

selecting at least one thumbnail page image from the first document file by clicking on the thumbnail page image with a pointing device and dropping said at least one thumbnail page image into a first merged document; and

selecting at least one additional thumbnail page image from the second document file by clicking on the at least one thumbnail page image with the pointing device and dropping said at least one additional thumbnail page image into said first merged document, wherein the at least one thumbnail page image and the at least one additional thumbnail page image form selected page images;

combining said selected page images in a desired order in a combining step, wherein said first scan file is merged with said at least first and second document file on a page-by-page basis so that said combined pages form a new first document file;

saving merging instructions generated by said combining step as a generated merge template, wherein said generated merge template is usable at a future time with another set of document files;

providing a plurality of merge templates comprising instructions for printing a document that specify layout parameters and color settings that are specified in a job ticket for a print job including source RGB, color profile, source type, saturation, true color, smoothing, or anti-aliasing, toner reduction, and print modes; wherein one of said plurality of merge templates is said generated merge template;

providing at least a third and fourth document file each comprising a plurality of pages, wherein at least one document file from among the third document file and the fourth document file comprises a second scan file;

selecting and applying a selected merge template from the plurality of merge templates to the at least third and fourth document file to create a second merged document comprising a plurality of selected pages from the at least third and fourth document, wherein the merge template is configured to specify pagination in said merged print file and imposition of multiple pages on one or more of the sheets; and

combining the selected pages of the at least third and fourth document file using said selected merge template to obtain a new second document file."

Reasons for the Decision

1. The appeal is admissible.

Main request - added subject-matter (Article 123(2) EPC)

2. The application as filed relates to a method for merging scan files with document files in a colour workflow (see page 1, lines 8 to 12).

More specifically, the application as filed (see, in particular, figures 1 and 2 and the corresponding description on pages 4 to 7) discloses **two alternative ways** (hereinafter referred to as "**option 1**" and "**option 2**") of creating a merged document file by selecting and combining pages of two or more document files in a desired order.

According to **option 1**, the pages of the document files to be merged are displayed as thumbnail page images in a graphic user interface (GUI) (see figure 2 and page 5, lines 8 to 12). The user then selects pages of the documents, for instance by clicking on the thumbnail page images with a mouse (see page 5, lines 14 to 18). Finally, the user combines the selected pages by dragging and dropping the thumbnail page images according to a desired order, thereby creating a merged document file (see page 5, lines 18 to 21).

According to **option 2**, instead of dragging and dropping page thumbnails as in option 1, the user selects a predefined merge template from a menu of templates (see page 5, lines 37 to 39). The merge template, which comprises merge instructions, then combines the selected pages in a predefined page order in a single

step (see page 6, lines 4 to 18 and page 7, lines 5 to 8), thereby creating a merged document file.

Regarding the merged template used in option 2, the application as filed further provides the following additional information:

- the merge instructions of a merge template may have been scripted, either manually or through the use of a workflow software application (see page 6, lines 3 to 15);
- alternatively, the merge instructions of a merge template may have been generated previously by saving instructions during the manual creation (ie the user dragging and dropping selected pages according to option 1) of a merged document file from another set of document files (see page 5, lines 35 to 37, and page 6, lines 1 to 3);
- in addition to instructions relating to the order of the pages, the merge template may also comprise instructions for placing multiple pages on a single sheet and instructions defining layout parameters and colour settings (see from page 6, line 20, to page 7, line 1).

3. The method of claim 1 comprises *inter alia* the following steps in the following order for merging two documents:

- (a) selecting and applying a merge template to create a merged document [...];
- (b) providing a user a drag-and-drop selection means via the GUI for:
 - selecting at least one thumbnail page image from the first document file by clicking on the thumbnail page

image with a pointing device and dropping said at least one thumbnail page image into said merged document; and selecting at least one additional thumbnail page image from the second document file by clicking on the at least one thumbnail page image with the pointing device and dropping said at least one additional thumbnail page image into said merged document, wherein the at least one thumbnail page image and the at least one additional thumbnail page image comprise selected page images; and

(c) combining the selected page images using said merge template, wherein the merge template incorporates instructions for the placement of multiple pages per sheet.

4. In this sequence of steps (a to c), step (b) comprises a manual (drag-and-drop) merging step belonging to the aforementioned option 1 whereas steps (a) and (c) are automatic merging steps (ie steps according to instructions from a merging template) belonging to option 2.

In the application as filed, however, option 1 and option 2 are described as alternative options. Therefore, the above sequence (a to c) mixes drag-and-drop steps from option 1 and merging steps from a merge template according to option 2, thereby creating a combination of steps **not directly and unambiguously derivable** from the application as filed.

5. The appellant essentially argued that this particular sequence of steps was derivable from the application as filed as a whole, in particular from page 5 and claims 1 and 22. A person skilled in the art would have derived therefrom that the step of selecting pages was a separate step which was then followed by a combining

step. The combining step could be either a manual drag-and-drop operation or the application of a merge template. Moreover, claim 1 listed the steps of the method, but without limiting them to being carried out in that sequence. The merge template in claim 1 was merely used in the combining step.

However, the appellant could not point to specific passages of the application as filed providing a clear disclosure that a combination of a drag-and-drop operation and a combining operation using a selected merge template had been contemplated in the application as filed. In contrast, figure 1 clearly shows the two options as alternative ways, which supports the board's interpretation.

Hence the appellant's arguments did not convince the board that the claimed combination could be directly and unambiguously derived from the application as filed.

6. For the above reasons, the board considers that claim 1 according to the main request contains subject-matter extending beyond the content of the application as filed, contrary to the requirements of Article 123(2) EPC.

Accordingly, the main request is not allowable.

Admissibility of the auxiliary request

7. According to Article 13(1) RPBA, any amendment to a party's case after it has filed its grounds of appeal or reply may be admitted and considered at the board's discretion. The discretion shall be exercised in view of *inter alia* the complexity of the new subject matter

submitted, the current state of the proceedings and the need for procedural economy.

In the present case, the appellant filed amended claims according to the present auxiliary request at a late stage of the oral proceedings following an extensive debate about the original disclosure and the clarity of certain expressions. In the oral proceedings, the appellant made several attempts to overcome objections which had already been raised in the decision under appeal or in the board's communication. The board then gave the appellant a last chance to file claims meeting the requirements of Articles 84 EPC 1973 and 123(2) EPC, on the basis of which inventive step could then be discussed.

After a *prima facie* examination of claim 1 of the auxiliary request, the board came to the conclusion that admitting the auxiliary request would have entailed the continuation of the debate with fresh issues being raised and little prospect for success for at least the following reasons:

- The expression "said first scan file is merged with said at least first and second documents" seems to lack support by the description (Article 84 EPC 1973) because the first scan file is one of the first or second file documents; hence this expression could mean that the first scan file could be merged with itself.
- Each of the last two steps of claim 1, ie the step of "selecting and applying a selected merge template" and the step of "combining the selected pages", creates a merged document file from selected pages of the third and fourth document files, one referred to as "a second merged document" and the other one as "a new second document file". It appears unclear (Article 84 EPC

1973) from the wording of claim 1 whether these two expressions refer to the same merged document file or to two different ones.

Hence, in view of the need for procedural economy, the board exercised its discretion under Article 13(1) RPBA not to admit the auxiliary request into the proceedings.

Conclusion

8. Since the appellant's main request is not allowable and the auxiliary request was not admitted into the proceedings, the appeal must be dismissed.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:



K. Boelicke

F. Edlinger

Decision electronically authenticated