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**Datasheet for the decision
of 23 September 2020**

Case Number: T 2271/16 - 3.5.07

Application Number: 05008167.8

Publication Number: 1587002

IPC: G06F17/21

Language of the proceedings: EN

Title of invention:
Document processing apparatus, control method therefor,
computer program, and computer-readable storage medium

Applicant:
CANON KABUSHIKI KAISHA

Headword:
Book-binding application/CANON

Relevant legal provisions:
EPC Art. 56, 84

Keyword:
Claims - clarity - main request (no) - clarity - first
auxiliary request (no) - clarity - second auxiliary request
(yes)
Inventive step - second auxiliary request (yes)

Beschwerdekammern

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Case Number: T 2271/16 - 3.5.07

D E C I S I O N
of Technical Board of Appeal 3.5.07
of 23 September 2020

Appellant: (Applicant)	CANON KABUSHIKI KAISHA 3-30-2, Shimomaruko, Ohta-ku Tokyo (JP)
Representative:	TBK Bavariaring 4-6 80336 München (DE)
Decision under appeal:	Decision of the Examining Division of the European Patent Office posted on 18 May 2016 refusing European patent application No. 05008167.8 pursuant to Article 97(2) EPC

Composition of the Board:

Chair	R. de Man
Members:	C. Barel-Faucheux
	E. Mille

Summary of Facts and Submissions

I.   The applicant (appellant) appealed against the decision
        of the Examining Division refusing European patent
        application No. 05008167.8.

II.   The decision cited, *inter alia*, the following
        documents:

        D1: US 2003/0056176 A1, 20 March 2003;
        D7: US 2003/0056179 A1, 20 March 2003.

        The Examining Division decided that the subject-matter
        of the independent claims of the main request and first
        to third auxiliary requests and of claims 1 and 16 of
        the fourth auxiliary request lacked inventive step in
        view of document D1. The fifth and sixth auxiliary
        requests were not admitted into the proceedings under
        Rule 137(3) EPC.

III.   In its statement of grounds of appeal, the appellant
        maintained the requests considered in the decision
        under appeal as a main request and second to seventh
        auxiliary requests and filed a new first auxiliary
        request. It submitted copies of the text of the claims
        of all requests.

IV.   In a communication accompanying the summons to oral
        proceedings, the Board introduced the following
        documents:

        D8: US 2003/0208565 A1, 6 November 2003;
        D9: US 6 429 947 B1, 6 August 2002.

The Board raised a number of clarity objections and expressed the preliminary opinion that the subject-matter of claim 1 of all requests lacked inventive step.

V.   By letter of 20 December 2019, the appellant replaced its first to seventh auxiliary requests with amended first to seventh auxiliary requests.

VI.   During oral proceedings held on 23 September 2020, the appellant filed a new second auxiliary request and maintained its previous second to seventh auxiliary requests as third to eighth auxiliary requests. At the end of the oral proceedings, the chairman pronounced the Board's decision.

VII.   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 or, in the alternative, of one of the first to eighth auxiliary requests.

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

"A document processing apparatus which creates a book file managed by a hierarchical structure and formed from document data, characterized by comprising:
    setting means (1400) for setting an attribute for a folder (4001, 4002);
    detection means (4200) for detecting storage of data into the folder (4001, 4002);
    creation means (4300) for, when said detection means detects that data is stored into a first folder (4001, 4002) set by said setting means, creating document data based on a setting of the first folder (4001, 4002), and

import means for importing the document data on any layer of a book file which has already been created."

IX.   Claim 1 of the first auxiliary request reads as follows:

"A document processing apparatus which creates a book file managed by a hierarchical structure of three layers and formed from document data, the book file corresponding to a first layer and having at least one chapter, which corresponds to a second layer, where the chapter includes at least one page, which corresponds to a third layer, characterized by comprising:
        setting means (1400) for selecting a folder and setting an attribute for a folder (4001, 4002), the attribute relating to layout information and printer setting information;
        detection means (4200) for detecting storage of data into the folder (4001, 4002);
        creation means (4300) for, when said detection means detects that data is stored into a first folder (4001, 4002) for which an attribute is set by said setting means, creating document data from the data stored into the folder based on a setting of the attribute for the first folder (4001, 4002), and
        import means for importing the document data on any layer of a book file which has already been created."

X.   Claim 1 of the (new) second auxiliary request reads as follows:

"A document processing apparatus configured to create a book file and to manage an existing book file having a hierarchical structure of three layers and formed from

document data, the book file consisting of a book as a
first layer, and at least one chapter, which
corresponds to a second layer, where the chapter
includes at least one page, which corresponds to a
third layer, characterized by comprising:

    setting means (1400) for setting an attribute for
a folder (4001, 4002), the attribute relating to layout
information and printer setting information;

    detection means (4200) for detecting storage of
data into the folder (4001, 4002);

    creation means (4300) for, when said detection
means detects that data is stored into a first folder
(4001, 4002) for which an attribute is set by said
setting means, creating document data from the data
stored into the folder based on the attribute set for
the first folder (4001, 4002),

    means for selecting a book file into which the
document data is to be imported, wherein the book file
is a newly created book file or an existing book file,
and

    import means for importing the document data on
any layer of the book file."

Claims 2 to 15 are directly or indirectly dependent on
claim 1.

Claim 16 reads as follows:

"A method of controlling a document processing
apparatus configured to create a book file and to
manage an existing book file having a hierarchical
structure of three layers and formed from document
data, the book file consisting of a book as a first
layer, and at least one chapter, which corresponds to a
second layer, where the chapter includes at least one

page, which corresponds to a third layer, characterized by comprising:

a setting step of setting an attribute for a folder, the attribute relating to layout information and printer setting information;

a detection step of detecting storage of data into the folder;

a creation step of, when data is detected in the detection step to be stored into a first folder (4001, 4002) for which an attribute is set in the setting step, creating document data from the data stored into the folder based on the attribute set for the first folder (4001, 4002),

a selecting step of selecting a book file into which the document data is to be imported, wherein the book file is a newly created book file or an existing book file, and

an importing step of importing the document data on any layer of the book file."

Claims 17 to 31 are directly or indirectly dependent on claim 16.

Claim 32 reads as follows:

"A computer program characterized by comprising a function of executing steps in a method defined in any one of claims 16-31."

Claim 33 reads as follows:

"A computer-readable storage medium characterized by storing a computer program defined in claim 32."

XI.   The text of the third to eighth auxiliary requests is not relevant to this decision.

XII.   The appellant's arguments, where relevant to the
        decision, are discussed in detail below.

Reasons for the Decision

1.   The appeal complies with the provisions referred to in
        Rule 101 EPC and is therefore admissible.

2.   *The invention*

2.1   The application is concerned with creating a single
        electronic document file ("a book file") from one or
        more electronic document files generated by pre-
        existing general applications. The structure of such a
        book file is shown in Figure 3 of the published
        application. As explained in paragraphs [0034] to
        [0040], it contains a list of document pages 413 and
        information organising the document pages into a three-
        layered hierarchy (401, 405, 409) corresponding to
        "book"/"document", "chapter" and "page".

2.2   A book file may have attributes that are set at the
        page, chapter or book level. Such attributes may affect
        the layout of the page. For example, a "4UP" attribute
        signifies that a page of the book file corresponds to
        four document pages in a 2×2 layout (paragraph [0038]).
        Attributes may also control printer functionality such
        as the insertion of tabbed index paper for chapter
        separation and stapling (paragraphs [0043] and [0048]).

2.3   The claimed invention relates to a mechanism by which
        the user may specify which attributes to apply to
        document data being imported into the book file. This
        mechanism is described in paragraphs [0105] to [0115].
        It allows the user to set up and assign attributes to

one or more "hot" folders in a shared file system.
These hot folders are monitored by a "hot folder
program". When the hot folder program detects that a
new file is stored in a hot folder, the document data
in the file is imported into the book file and
processed in accordance with the attributes assigned to
the hot folder.

Main request

3.   *Clarity - Article 84 EPC*

3.1   Claim 1 of the main request is directed to a "document
        processing apparatus which creates a book file managed
        by a hierarchical structure and formed from document
        data", which expresses that the claimed apparatus
        creates a book file.

        However, the claim defines "import means" for importing
        document data "on any layer of a book file which has
        already been created". This feature expresses that the
        claimed apparatus operates on a pre-existing book file.

        Claim 1 contains no features that resolve this
        discrepancy.

3.2   The appellant explained that the published application,
        in paragraphs [0054] and [0055], discussed two
        different cases. In the first case, a book file already
        existed and the document data was imported into the
        pre-existing book file. In the second case, the book
        file did not exist and the book file was newly created.
        Thus, in both cases, the document data was added to a
        book file that had already been created.

However, in the Board's view this explanation rather confirms that "which creates a book file", which corresponds to the second case, conflicts with "a book file which has already been created", which corresponds to the first case. While a claim may legitimately be drafted to cover two embodiments, its wording should then make clear that both embodiments are intended to be covered.

3.3   Hence, claim 1 of the main request is not clear (Article 84 EPC).

First auxiliary request

4.   *Clarity – Article 84 EPC*

4.1   Claim 1 of the first auxiliary request is likewise directed to a "document processing apparatus which creates a book file managed by a hierarchical structure of three layers and formed from document data" and defines "import means" for importing document data "on any layer of a book file which has already been created".

4.2   Claim 1 of the first auxiliary request is therefore not clear for the same reasons as given for the main request (Article 84 EPC).

Second auxiliary request

5.   *Added subject-matter – Article 123(2) EPC*

5.1   Claim 1 is based on original claim 1, with a number of amendments taken from the description as discussed below.

5.2   The document processing apparatus is configured not
        only to create a book file but also "to manage an
        existing book file", and it comprises "means for
        selecting a book file into which the document data is
        to be imported, wherein the book file is a newly
        created book file or an existing book file" (Figure 7
        and paragraphs [0054] and [0055] of the published
        application). It further comprises "import means for
        importing the document data on any layer of the book
        file" (paragraphs [0056], [0113]).

5.3   The hierarchically structured book file consists of a
        book, representing a first layer, and at least one
        chapter, representing a second layer. The chapter
        includes at least one page, representing a third layer
        (paragraph [0034]).

5.4   The "attribute for a folder" relates to "layout
        information and printer setting information". This
        finds a basis in paragraph [0037], which discloses
        "layout information" and "function setting information
        of a printing apparatus".

5.5   When the detection means detects that data is stored
        into a first folder, the creation means creates
        document data "based on the attribute set for the first
        folder". This clarifying amendment is based on
        paragraph [0115].

5.6   Hence, the subject-matter of independent apparatus
        claim 1 and of the corresponding independent method
        claim 16 does not go beyond the content of the
        application as filed (Article 123(2) EPC).

6.   *Clarity - Article 84 EPC*

6.1   Claim 1 of the second auxiliary request clarifies that
          the document processing apparatus is configured both
          "to create a book file" and "to manage an existing book
          file". The claim further defines "means for selecting a
          book file into which the document data is to be
          imported, wherein the book file is a newly created book
          file or an existing book file".

          Hence, claim 1 is clearly intended to cover both the
          case in which document data is imported into an
          existing book and the case in which document data is
          imported into a newly created book. The claim therefore
          overcomes the clarity problem discussed in point 3
          above.

6.2   The remaining clarity objections raised in the Board's
          communication against claim 1 of the main request have
          also been overcome by amendment and therefore no longer
          apply to claim 1 of the second auxiliary request.

6.3   Hence, the Board sees no reason to object to the
          clarity of the independent apparatus claim 1 of the
          second auxiliary request. The same applies to the
          clarity of the independent method claim 16.

7.   *Inventive step - Article 56 EPC*

7.1   Document D1 discloses a document processing system for
          producing a single electronic "book file" from one or
          more electronic document files generated by "general"
          applications (paragraphs [0053] and [0058]). The book
          file has a hierarchical structure. It includes a number
          of chapters, each chapter including a number of pages
          (paragraph [0067]).

The structure of a book file is described in paragraphs [0065] to [0069] with reference to Figures 3A and 3B and corresponds to the structure described in the present application.

The system includes a "bookbinding" application that allows a user to choose between creating a new book file and opening an existing book file (paragraphs [0099] and [0100]; Figure 13).

Once a book file has been created or opened, application data can be converted into an electronic original file and imported as a new chapter of the book file (paragraph [0104]). The value of a chapter attribute of the new chapter is set to the value of the corresponding book attribute if it exists and to a default value otherwise (paragraph [0107]). Paragraphs [0073] and [0075] give examples of attributes relating to layout settings and printer settings.

7.2   The apparatus of claim 1 differs from the system of document D1 in that it includes:

-   setting means for allowing the user to configure/ set an attribute for a folder; and
-   detection means for detecting storage of data into the folder.

In addition, when the detection means detects that data is stored into a first folder, the data is processed on the basis of the attributes set for the folder and imported into a layer of the book file.

7.3   In its decision, the Examining Division argued that whether to add data to an existing book file via a

drag-and-drop operation (as disclosed in paragraph
[0104] of document D1) or by storing it in a folder
with predefined attributes was not a technical
consideration but a question of user preferences. The
objective technical problem could therefore be
formulated as "how to provide a UI to select folder and
attributes".

7.4   The Board does not agree. In certain cases the choice
between two known input mechanisms may be a matter of
subjective user preference. However, in the present
case the distinguishing features do not relate to such
a choice but define a specific mechanism that is
implemented with technical means in the form of a file
system and which solves the technical problem of
allowing the user to specify an input data file
together with attributes to be applied to the data in
the file.

7.5   In its communication, the Board suggested that the
skilled person would have found the claimed solution to
this problem both in documents D8 and D9.

        Document D8 discloses "hot folders 24", which are
storage areas for receiving and temporarily storing
image files (paragraph [0027]). When an image file is
copied into one of the hot folders, the file is
automatically processed by an image processing program
and outputted on a printer in accordance with settings
that are specific to that hot folder (paragraphs [0029]
and [0058]).

        Document D9, in column 28, line 63, to column 29,
line 3, likewise discloses a "hot folder"
implementation. Parameter files are placed in
appropriate folders, and then an input file is dropped

into a "waiting" folder. When the input file is
detected, the parameters and the file are communicated
to a ("Trapwise") software tool. The parameter files
are placed by a "trapping processor" (column 28,
lines 27 to 30).

7.6   Neither document discloses means for allowing the user
        to configure attributes for a ("hot") folder. In the
        Board's view, the skilled person, faced with the
        objective technical problem, would therefore not
        consider adding the "hot folders" of document D8 or D9
        to the document processing apparatus of document D1 in
        the expectation of solving the problem.

        Hence, the subject-matter of claim 1 and of the
        corresponding claims 16, 32 and 33 is not rendered
        obvious by a combination of documents D1 and D8 or D9.

7.7   In its communication, the Board also drew the
        appellant's attention to document D7, which appeared to
        have even more overlap with the present application
        than document D1. In particular, Figure 3 of
        document D7, depicting the structure of a book file,
        was identical to Figure 3 of the application.

        Since document D7 does not disclose any of the features
        distinguishing the subject-matter of claim 1 from the
        disclosure of document D1, it does not render the
        claimed invention obvious, either.

8.   *Remittal*

8.1   In view of the above, the decision under appeal is to
        be set aside. However, the dependent claims and the
        description and drawings may still need adaptation. In
        this respect, the Board notes that the drawings as

listed in the Examining Division's decision ("Drawings,
Sheets 1/43-43/43 as originally filed" and "Drawings,
Figures 14-18, 35, 41 filed on 08-03-2016") appear to
contain duplicate figures. Since these are matters that
are more appropriately dealt with by the Examining
Division than by the Board in the framework of a
judicial review of the contested decision
(Article 12(2) RPBA 2020), a remittal is justified
(Article 11 RPBA 2020).

8.2   Hence, the case is to be remitted to the Examining
        Division for further prosecution on the basis of the
        second auxiliary request.

Order

For these reasons it is decided that:

1.   The decision under appeal is set aside.

2.   The case is remitted to the department of first
        instance for further prosecution on the basis of the
        second auxiliary request filed during the oral
        proceedings.

The Registrar: The Chair:

S. Lichtenvort   R. de Man

Decision electronically authenticated