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**D E C I S I O N**  
of 27 June 2000

**Case Number:** T 0997/98 - 3.5.1

**Application Number:** 91308834.0

**Publication Number:** 0478352

**IPC:** H04N 1/32

**Language of the proceedings:** EN

**Title of invention:**

Electronic reprographic printing system

**Patentee:**

XEROX CORPORATION

**Opponent:**

Océ-Nederland B.V.

**Headword:**

-

**Relevant legal provisions:**

EPC Art. 56  
EPC R. 55(c)

**Keyword:**

"Admissibility of opposition (yes)"  
"Inventive step (no)"

**Decisions cited:**

-

**Catchword:**

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Case Number: T 0997/98 - 3.5.1

**D E C I S I O N**  
**of the Technical Board of Appeal 3.5.1**  
**of 27 June 2000**

**Appellant:** XEROX CORPORATION  
(Proprietor of the patent) Xerox Square  
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New York 14644 (US)

**Representative:** Grünecker, Kinkeldey,  
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**Respondent:** Océ-Nederland B.V.  
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**Representative:** Hanneman, Henri W., Dr.  
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**Decision under appeal:** Decision of the Opposition Division of the  
European Patent Office posted 20 July 1998  
revoking European patent No. 0 478 352 pursuant  
to Article 102(1) EPC.

**Composition of the Board:**

**Chairman:** P. K. J. van den Berg  
**Members:** R. S. Wibergh  
S. C. Perryman

## Summary of Facts and Submissions

- I. This is an appeal by the proprietor of European Patent No. 0 478 352 against the decision of the Opposition Division to revoke the patent.
- II. The respondent had opposed the patent on the ground that the invention was not new or did not involve an inventive step having regard to the documents
- D1: IBM Technical Disclosure Bulletin, Vol. 33, No. 2, p. 225, and
- D2: JP-A-62 97463 (translation and English abstract).
- III. The patent proprietor (appellant) had argued that the opposition was not sufficiently reasoned and therefore inadmissible. Furthermore, the cited documents did not disclose the invention or render it obvious.
- IV. The Opposition Division held that the opposition was admissible and that the subject-matter of claim 1 as amended according to the main request ("Annex 1" to the decision) and according to the first to third auxiliary requests (Annexes 2 to 4) was not inventive over D1 or over a combination of D1 and D2.
- V. Claim 1 of the main request ("Annex 1") read as follows (omitting the reference signs):

A method for operating an electronic reprographic system, comprising the steps of:

- scanning a set of original documents which are to be treated within a single print job,
- electronically storing the scanned image data of the

job in a memory in the form of an image file, said image file comprising images of the scanned documents,

- converting the images to electronic pages for printing,
- monitoring the system for interruption in scanning prior to completion of scanning of the job, wherein
  - the images of the successfully scanned documents of the job are retained in operator-accessible memory upon detection of the scanning interruption, to enable access to the stored images when scanning of the set has been interrupted prior to completion of the job, and
- displaying a last image stored in memory when an interruption in scanning is detected.

Independent claim 7 was directed to a corresponding "apparatus for operating an electronic reprographic system".

- VI. The patent proprietor lodged an appeal against this decision. He requested maintenance of the patent based on the main request or on the first auxiliary request considered by the Opposition Division.
- VII. In a communication pursuant to Article 11(2) of the Rules of Procedure of the Boards of Appeal, the Rapporteur expressed the preliminary opinion that D2 seemed to be closer to the invention than D1.
- VIII. On 29 May 2000 the appellant filed claims 1 and 7 of a new second auxiliary request.
- IX. Oral proceedings before the Board were held on 27 June 2000. During the proceedings the appellant re-instated the last two auxiliary requests considered by the

Opposition Division (corresponding to "Annex 3" and "Annex 4" respectively of the decision under appeal). These requests are here referred to as the third and fourth auxiliary requests.

The appellant maintained that the opposition was inadmissible and argued that neither D2 nor D1 rendered the invention obvious. Specifically it was argued that as D2 did not relate to reprography, the skilled person concerned with a problem in the field of reprography would not consider it at all. Even if the skilled person should consider D2, the description given in D2 was not adequate for a skilled person to understand how the device described worked, and so he would disregard D2 also for this reason.

The respondent denied that the opposition was inadmissible and argued that the main claims of all of the appellant's requests were unacceptable for lack of an inventive step.

- X. The appellant requested that the decision under appeal be set aside and that the opposition be rejected as inadmissible or that the patent be maintained on the basis of:
- as main request or first auxiliary request with claims 1 and 7 of Annex 1 or 2 respectively of the decision under appeal and claims 2 to 6 as granted, or
  - second auxiliary request with claims 1 and 7 filed 29 May 2000 and claims 2 to 6 as granted, or
  - third and fourth auxiliary requests with claim 1 of Annex 3 or 4 respectively of the decision under appeal and claims 2 to 6 as granted.
- XI. The respondent requested that the appeal be dismissed.

## Reasons for the Decision

### 1. *Admissibility of the opposition*

- 1.1 The appellant is of the opinion that the notice of opposition did not comply with Rule 55(c) EPC since it did not explain in detail why the invention would be obvious in view of D1 and D2. This would have been necessary in particular because of the general obscurity of D2.
- 1.2 The Opposition Division held that the opposition was admissible, and the Board agrees. It is true that the notice of opposition is unusually short - about one page - and that each of the cited documents is dealt with in a few lines only. However, D1 is just one page long and D2 five pages long. Both documents are clearly relevant and it is indicated in the grounds of opposition what feature in the prior art documents is identified with the key feature of the invention. Under these circumstances there is no doubt about the opposition being admissible.

### *The appellant's main request*

### 2. *The invention*

The invention according to claim 1 is a method for operating an electronic reprographic system. During scanning of a set of original documents which are to be treated as a single print job, it can happen that a fault occurs, leading to an interruption of the scanning. It may then be difficult or impossible for the operator to find out how many documents have been

successfully scanned. The problem to be solved can thus be stated as being to facilitate the operator's task after an interruption of scanning. It should be noted that this problem has no particular relation to the fact that the scanning is part of a method of operating an electronic reprographic system.

According to claim 1, this problem is solved by displaying the last image which has been scanned and stored in memory when an interruption is detected. The scanning can then be resumed from that point. Again the solution has no particular relation to the fact that the scanning is part of a method of operating an electronic reprographic system.

3. *The prior art*

3.1 D2 discloses a scanner for converting images of documents to binary data which are compressed and stored in memory. Typically a number of documents are processed in one go. If there is an interruption the operator can press a button to display the last image which was forwarded to memory. The express aim is to avoid overlaps or omissions in the stored data. It is not stated in D2 what further use is to be made of the scanned images.

The appellant has criticized D2 as having a description so inadequate that the skilled person would not know what to do. This criticism is not justified. The concept that if there is an interruption the operator should be provided with a button he can press to display the last image which was forwarded to memory, so that he knows where to restart the scan is clearly disclosed, and putting this concept into practice is

clearly within the knowledge of the skilled person. At worst on reading D2 the skilled person might have doubts as to whether he had exactly reproduced the embodiment that the authors of D2 were describing, but he would have no doubts that he could provide a functional equivalent.

3.2 D1 discloses a method for recovery of a print transaction. In case of a failure the data to be printed and transaction processing information stored in RAM are displayed. By comparing the print-out with the displayed data an operator can determine from what point the printing should be resumed.

4. *Novelty over documents cited by respondent*

D2 describes only a scanning process and therefore does not relate to a **reprographic** system, at least as this expression is used in the patent in suit, namely for a system including a scanner and printer. A number of "notebook tickets" (understood as "forms", the word used in the corresponding English abstract) are scanned consecutively and can thus be regarded as a scan "job", but not necessarily as a "**print job**", as claimed. Scanned data are stored in memory ("higher ranking memory"). Since printing is not mentioned, there is no mention of any conversion to electronic pages **for printing**. The system is monitored for interruption in scanning by means of a memory 11, a section of which is capable of storing the latest scanned image in turn (taken to mean data corresponding to one form). The memory 11 does not simultaneously retain **all** of the successfully scanned images, though these are retained in the higher ranking memory. What is displayed (on pressing a "final image display button") is the last



image in memory 11.

- 4.2 The features printed in bold above represent differences between the subject-matter of claim 1 and D2. Therefore the invention is new over D2.
- 4.3 D1 is concerned with a recovery process where printing is interrupted, but is not concerned with how the print data is obtained, whether possibly by scanning or otherwise. Thus the features in the claim relating to scanning make it new over D1.

5. *Inventive step*

- 5.1 As acknowledged in the introduction to the patent in suit (column 1, lines 13 to 19) reprographic systems treating documents on a "job" basis were known at the priority date of the patent in suit. These systems work in the way that a series of documents are scanned, stored, read out and printed. Once a document is scanned, it can be printed in any number of times or processed in any number of ways, e.g. words deleted or added. Thus the scanned document must be retained in a memory accessible to the operator.
- 5.2 Given the problem of facilitating the operator's task after a scanning fault has occurred in such a reprographic system, the skilled person would naturally consider existing documents concerned with restorative action after a scanning fault, and so consider D2. That D2 does not mention printing is irrelevant: the problem to be solved is not concerned with the printing stage but with the scanning of documents stage. When considering inventive step, as opposed to novelty, it is perfectly legitimate to consider documents relating

only to the area in which the problem occurs, here scanning, even if the documents are not explicitly concerned with the whole process claimed, here reprography including printing.

- 5.3 D2 will immediately suggest to the skilled person, the solution of providing a memory for each successive last image scanned by the scanner, and the provision of a button the operator can press to display the last image which was forwarded to that memory, so that he knows where to restart the scan.
- 5.4 In accordance with the suggestion of D2 already scanned documents will be retained in memory upon detection of scanning interruption. This memory will in accordance with the acknowledged prior art be operator-accessible. Claim 1 does not exclude the use of an intermediate storage memory as in D2 for the last scanned image, but in any case the exact way in which the feature is provided seems only a choice between routine variations involving no inventive skill.
- 5.5 By reference to D2 the skilled person will in an obvious way arrive at a solution as claimed in claim 1.
- 5.6 The appellant has furthermore pointed at a number of obscurities in D2 which are allegedly so serious that the document should be entirely disregarded.

The Board, however, takes the view that any information which is clearly expressed in D2 has been made available to the public even if other passages would perhaps have to be neglected because of obscurity. In particular, there can be no doubt about D2 proposing to display "the last image" even if - as the appellant has

argued - there may be doubts about what "the last image" exactly means: it could be either the last correct image or the image being scanned when the error occurred. However, the operator would know what image is displayed and act accordingly. The aim of finding the point of interruption would be attained in either case. The exact choice of image to be displayed is therefore arbitrary and not indicative of an inventive step.

6. It follows that the appellant's main request must be refused.

*The appellant's first auxiliary request*

7. According to claim 1 of the first auxiliary request the method additionally comprises the steps of "sending the converted images to a printer section for printing" and "purging the sent images from memory to make room for new image data".
8. These features can only be treated as already known in the acknowledged prior art. Sending the converted images to a printing section for printing must inevitably occur if printing is to take place. As every memory for scanned images will finally be filled, a purging step of images already sent for printing will inevitably be necessary at some stage if the apparatus is to remain useful. The addition of these features to the claim does not alter the problem to be solved. When modifying the prior art by reference to D2 to solve the problem these features of the prior art will be retained. Therefore for the reasons already stated in connection with the main request claim 1 of the first auxiliary request must also be considered as obvious.

*The appellant's second auxiliary request*

9. Apart from a number of pure reformulations claim 1 of this request adds the feature of "selecting an image stored last in said operator-accessible memory". This feature is believed to be present in D2 since the operator selects - by pressing a button - the image last scanned and stored. Thus this claim is obvious for the same reasons as given for claim 1 of the main request.

The request is thus not allowable.

*The appellant's third auxiliary request*

10. According to this request, the image data are stored "together with scanner state information", which information may be used "for system recovery". In D2 the storage of the last scanned image in memory 11, together with the storage of all the scanned images in higher memory appears already to meet the requirement for storage of scanner state information which may be used for system recovery, if the term scanner state information is given a broad interpretation. Accordingly on the same arguments as for claim 1 of the main request, claim 1 of the third auxiliary request too is obvious.

However even if the term "scanner state information" were given some more limited meaning, the knowledge that the skilled person can be presumed to have about recovery operations in combination with the arguments already set out above in relation to claim 1 of the main request leads to the same conclusion of obviousness. As pointed out in the decision under

appeal by the Opposition Division, D1 discloses "transaction processing information" stored in RAM together with the data to be printed. The printer can access this information. Although D1 concerns a printer without a scanner the Board finds that the idea of storing state information, which allows a device to continue to operate in the same manner after an interruption has occurred, is recognizably of a general character. The skilled person would thus apply it also to each recovery process for a multi-stage process, and thus also to recovery in relation to the scanning stage in a reprographic process involving both a scanning and a printing stage as now claimed.

The request is thus not allowable.

*The appellant's fourth auxiliary request*

11. Claim 1 according to the fourth auxiliary request adds to the third auxiliary request the feature of "requesting the user to state whether a cancel or save-recovery operation should be carried out".
12. It would obviously be highly inconvenient if a user were compelled each time to have the save-recovery operation of the scanner carried out, even though he preferred to start again. The option given the user by the feature added in claim 1 of the fourth auxiliary request over the claim 1 of the third auxiliary request, thus merely seems the normal, most user-friendly way of implementing the recovery feature already required by claim 1 of the third auxiliary request. This implementation is obvious. Thus for the reasons stated in relation to the third auxiliary request, claim 1 of the fourth auxiliary request is

also obvious.

The last request is thus not allowable either.

**Order**

**For these reasons it is decided that:**

The appeal is dismissed.

The Registrar:

The Chairman:

M. Kiehl

P. K. J. van den Berg