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D E C I S I O N
of 6 June 2002

Case Number: T 0621/00 - 3.5.1

Application Number: 94114711.8

Publication Number: 0647057

IPC: H04N 1/387

Language of the proceedings: EN

Title of invention:

System for custom imprinting a variety of articles with images
obtained from a variety of different sources

Applicant:

EASTMAN KODAK COMPANY, et al

Opponent:

-

Headword:

Custom imprinting/EASTMAN KODAK

Relevant legal provisions:

EPC Art. 56

Keyword:

"Inventive step (no)"

Decisions cited:

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Catchword:

-



Case Number: T 0621/00 - 3.5.1

D E C I S I O N
of the Technical Board of Appeal 3.5.1
of 6 June 2002

Appellants:

EASTMAN KODAK COMPANY
343 State Street
Rochester
New York 14650-2201 (US)

Hallmark Cards, Inc.
P.O. Box 419126
Kansas City
Missouri 64141 (US)

Representative:

Barker, Brenda
Kodak Limited
Patents, W92-3A
Headstone Drive
Harrow, Middlesex HA1 4TY (GB)

Decision under appeal:

Decision of the Examining Division of the
European Patent Office posted 7 December 1999
refusing European patent application
No. 94 114 711.8 pursuant to Article 97(1) EPC.

Composition of the Board:

Chairman: S. V. Steinbrener

Members: A. S. Clelland

P. Muehlens

Summary of Facts and Submissions

I. European patent application No. 94 114 711.8 was refused by a decision of the Examining Division dated 7 December 1999 on the ground that independent claims 1 and 6 lacked an inventive step. *Inter alia* the following document was cited:

D2: GB-A-2 246 929.

II. The Applicants appealed, requesting that the decision be set aside and the application be further examined on the basis of the claims considered by the examining division (main request) or on the basis of claims filed with the statement of grounds (auxiliary request). An auxiliary request for oral proceedings was also made.

III. In an annex to a summons to oral proceedings the Board raised issues of clarity and support under Article 84 EPC in respect of the claims of both requests. The Board took the preliminary view that D2 was the correct starting-point for a consideration of inventive step; because of the clarity and support issues only tentative comments could be made on inventive step, but in view of the disclosure of D2 it was difficult to see where an inventive step might lie.

IV. In a fax dated 30 May 2002 the Appellants submitted a revised auxiliary request. At the oral proceedings, held on 6 June 2002, the Appellants withdrew the main request and requested that the decision under appeal be set aside and a patent be granted on the basis of claims 1 to 8 filed in the fax dated 30 May 2002.

V. Claim 1 reads as follows:

"A method for producing personalized images by combining one or more consumer-generated images with one of a plurality of prestored images, said consumer-generated images being provided to a plurality of input devices (12, 14, 16, 18, 20, 22) to be converted into a suitable digital image signal, the signal being provided to a processing unit (10) that stores said plurality of prestored images and is connected to a plurality of output devices (32, 34, 36, 38, 40, 42), the method being comprising the steps of:

- a) selecting one of said plurality of prestored images (70) each prestored image having one or more predetermined locations (51, 52, 53, 54, 55) wherein said consumer generated images are to be placed;
- b) selecting a desired output format or output device (32, 34, 36, 38, 40, 42);
- c) providing one or more of said consumer-generated images to one of said plurality of input devices (12, 14, 16, 18, 20, 22);
- d) displaying said selected prestored image (70) and said one or more consumer-generated images on a display screen of said processing unit (10);
- e) automatically adjusting resolution, color balance, density and contrast saturation of the consumer-generated image in relation to the selected prestored image and the selected output device by use of preprogrammed instructions in the processing device (10); and

f) combining said one or more consumer-generated images with said selected prestored image (70) such that said one or more consumer generated images is placed in said one or more predetermined locations (51, 52, 53, 54, 55) so as to form a merged image;

g) displaying, storing, transmitting, or printing the combined and adjusted image at the selected output device (32, 34, 36, 38, 40, 42)."

Claims 2 to 8 are dependent on claim 1.

VI. In the course of the oral proceedings the Appellants stated that the technologies used by the invention had individually all been known at the priority date; the claims were however directed at an inventive combination of these technologies. The invention differed from the system for producing "holiday snaps" known from D2 in using professionally prepared prestored images and automatic sizing and colour balancing of the consumer-generated images to produce a seamless transition between the two. The result was comparable to the work of a photographic studio, but with considerable savings in time and cost to the user. D2 did not disclose prestored images or adaption of the consumer-generated images relative to prestored images. Indeed D2 did not disclose automatic image adjustment; page 7, stage 8 showed that the consumer had a "YES/NO" choice as to whether adjustment occurred. The invention also differed from D2 in giving the consumer no choice as to where the consumer-generated images appeared in the prestored image. D2 did not disclose predetermined locations for the consumer generated images. On the contrary, D2 (page 7, stage 3) mentioned the user being able to move the consumer-generated images around on

the screen.

VII. At the end of the oral proceedings the Board announced its decision.

Reason for the Decision

1. *Admissibility of the Appeal*

The appeal satisfies the requirements mentioned in Rule 65(1) EPC and is consequently admissible.

2. *Amendments*

The Board is satisfied that the amendments made to claim 1 meet the requirement of Article 123(2) EPC (added subject-matter). In the light of the description (see eg column 7, line 46 to column 8, line 1) the Board understands the expression "being provided to a plurality of input devices" to mean "being provided to one of a plurality of input devices".

3. *Novelty*

3.1 D2 is the single most relevant prior art document. It relates to a system which is described as enabling personalised items of stationery, such as greetings cards, postcards and calendars, to be produced on a "while you wait" basis (see page 1, lines 20-30). In particular, page 7 discloses a sequence of steps for scanning a customer-supplied photograph or photographs (step 3), selecting a calendar design (step 4), merging the scanned image(s) with the selected design (step 7), making colour adjustments (Steps 8, 9 and 10, see

below) and printing the combined image (steps 14 and 15). The preamble of claim 1 and steps (b), (c), (d) and (g) are accordingly known from D2.

3.2 At page 8, lines 3 to 5 of D2 the description states that "Each photograph inserted in the machine can be framed with variations of shape or colour". Also, the passage at page 4, lines 25 to 31 refers to enabling the original photograph(s) "to be displayed in whole or part, together with preprogrammed designs and captions held in the machine". The Board accordingly does not accept the Appellants' argument that D2 does not disclose prestored images. The Board also considers that, in the specific case of a calendar, the scanned image(s) cannot simply be placed in any arbitrary location but must have a predetermined location or locations; although step 3 on page 7 states that "Individual pictures can be moved...", this is in the context of arranging pictures relative to each other and does not alter the fact that for a calendar the picture(s) must have a predetermined location or locations. Steps (a) and (f) of claim 1 are accordingly also known from D2.

3.3 The only remaining feature in the claim is step (e). D2 provides a plurality of image adjustments, in particular "Automatic Enhance" (step 8) which brightens the scanned photo(s), "Black & White/Sepia" (step 9) which changes the print colour and "Tint Change" (step 10) which changes the colour of the wording on the selected design. In accordance with page 8, lines 1 to 7 the size of the scanned image can be adjusted either automatically or manually. Such size adjustment would inevitably result in adjustment of the resolution of the scanned image. It is not however clear that D2

enables the automatic adjustment of all the specified parameters, namely resolution, colour balance, density and contrast saturation, in relation to a selected prestored image.

3.4 Hence the Board finds that in the case of a calendar the subject-matter of claim 1 differs from the method known from D2 only in the automatic adjustment of colour balance, density and contrast saturation of the consumer-generated image in relation to the prestored image, step (e).

3.5 The subject-matter of claim 1 is consequently novel, Articles 52(1) and 54 EPC.

4. *Inventive step*

4.1 The system known from D2 is said to operate on a "while you wait" basis, so that speed of operation is of primary importance. Hence the skilled person starting from D2 might be expected to seek to minimise waiting time, increased automation being an obvious solution to this problem. No inventive step can therefore be seen in merely automating the YES/NO and +/- selections required for the image adjustments at steps 8, 9 and 10 discussed at point 3.3 above. Moreover, since these steps occur once the customer-generated image has been scanned (step 2) and the calendar design selected (step 4), the Board regards it as inevitable when using the system known from D2 that the user would make such adjustments taking into account any differences between the scanned image and the selected calendar. Whilst the D2 system can adjust the brightness (step 8) and colour (step 9) of the photograph, and the tint of at least part of the prestored image, the Board can find nothing

inventive in providing a more generalised automatic adjustment of colour balance, density and contrast saturation of the scanned in relation to a prestored image.

4.2 In the Board's view the fact that the prestored images of the application are said to be "professionally produced" does not imply any technical distinction over the disclosure of D2. At most it constitutes an aesthetic difference and not a technical one.

4.3 The Board accordingly concludes that the subject-matter of claim 1 does not involve an inventive step, Articles 52(1) and 56 EPC.

Order

For these reasons it is decided:

The appeal is dismissed.

The Registrar:

The Chairman:

G. Magouliotis

S.V. Steinbrener