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D E C I S I O N
of 7 October 2005

Case Number: T 1011/00 - 3.5.01

Application Number: 93308792.6

Publication Number: 0596724

IPC: H04N 1/32

Language of the proceedings: EN

Title of invention:
Digital scanning technique

Applicant:
SIMPLIFY DEVELOPMENT CORPORATION

Opponent:
-

Headword:
Document imaging/SIMPLIFY DEVELOPMENT

Relevant legal provisions:
EPC Art. 56

Keyword:
"Inventive step (no) "

Decisions cited:
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Catchword:
-



Case Number: T 1011/00 - 3.5.01

D E C I S I O N
of the Technical Board of Appeal 3.5.01
of 7 October 2005

Appellant: SIMPLIFY DEVELOPMENT CORPORATION
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Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 4 May 2000
refusing European application No. 93308792.6
pursuant to Article 97(1) EPC.

Composition of the Board:

Chairman: S. V. Steinbrener
Members: R. R. K. Zimmermann
M.-B. Tardo-Dino

Summary of Facts and Submissions

- I. European patent application number 93 308 792.6 filed on 3 November 1993 claims a priority date of 5 November 1992 for a method of and an apparatus for, automatically creating, identifying, sorting and storing digitally scanned documents in a computer network.
- II. By letter dated 20 June 1997, the applicant (appellant) filed amended application documents in response to a report issued by the examining division, including an amended claim 1 which reads as follows:

"1. A method of automatically creating, identifying, sorting and storing in a computer network, (CN) digitally scanned documents comprising a stack of sheets (Pg1 to PgN; Pg1¹ to PgN¹) containing information (HRI) thereupon that comprises, preparing a stack of successive sheets (Pg1 to PgN) for digitalizing scanning; preceding the top sheet (Pg1) and all other logical sets of sheets within the stack with a cover sheet (1, 1¹) bearing machine-readable code markings (MRI) feeding the cover sheet(s) (1, 1¹) and the stack of sheets into a digitizing scanner (S); during the scanning, recognizing the presence of the cover sheet and thus the beginning of the document scanning characterised by arranging for the machine readable code markings (MRI) to contain identification of the document owner and desired routing of the digital information in the computer network, reading the machine-readable code markings (MRI) of the cover sheet (1,1¹) and recording the identification-routing information thereof; upon the identification of a new

- cover sheet (1, 1¹) or the absence of further sheets fed to the scanner (S), identifying all sheets scanned from the previous cover sheet as a document and thereupon routing the digitized document information scanned therefrom in accordance with the recorded cover sheet identification-routing information; and storing the same in the computer network (CN) for subsequent retrieval or further processing."
- III. The examining division cited document D1 (EP-A-0 096 178, published in 1983) as closest prior art. The application was finally refused for reasons of lack of inventive step. According to the examining division, the machine-readable identification of the document owner on the cover sheet and the identification of the sheets scanned to form a document upon the identification of a new cover sheet or the absence of further sheets were the only features distinguishing the invention from the document distribution system of D1. In particular the features concerning the identification of the document were only a matter of normal design and did not establish an inventive step.
- IV. The refusal decision, dated 4 May 2000, was appealed by the applicant, filing the notice of appeal on 27 June 2000, paying the appeal fee on 11 July 2000, and filing the written statement setting out the grounds of appeal on 8 September 2000.
- V. In a communication issued to the appellant, the Board raised doubts regarding the allowability of the appeal, citing as relevant prior art, document D1 and in addition document D3 (US-A-4 086 443, published in 1978).

VI. The appellant requested oral proceedings, which were held on 7 October 2005. In the oral proceedings, the appellant submitted amendments in particular to claim 1 as filed by letter dated 20 June 1997. By the amendments, the position of the clause "characterised by" was merely shifted upwards before the second method step ("preceded by the top sheets ...") and a comma was inserted at the place where the clause had been removed.

VII. Regarding inventive step the appellant argued that the facsimile systems disclosed by documents D1 and D3 were based on a very old analog technology, which only allowed to transmit a transient copy of a document from one point to another. An average skilled person would never have envisaged using such an outdated technology for distributing documents over a modern computer network. Although D3 was formally incorporated by reference, document D1 made it very clear that the scanner part in the old facsimile system of D3 was only thought to be suitable for use as a scanning unit within the facsimile system of D1.

Unlike the old facsimile systems the present invention transmitted digital data and stored the data permanently in electronic form for subsequent retrieval and further processing. The scanned document was made available thereby to a broad number of users, which was not feasible with the old facsimile systems.

In this context it was an important feature of the invention to identify the document owner in a machine-readable form on the cover sheet. The name or address of the document owner was coded on the cover sheet in

addition to the receiver addresses and after scanning the information, together with the document data, was routed to the computer network. The old facsimile systems were not able to provide such information to users of a computer network.

Having regard to the term "document owner", the appellant held that the application should be construed to mean the author or sender of the scanned document. The phrasing "document owner to whom the document should be assigned or routed" at column 3, lines 34 to 42 of the present application, and similar phrasings elsewhere in the application, only supported its view. The application clearly distinguished the document owner from the receiver addresses, although certainly it was envisaged that the receiver of a document could become the owner of the document.

These features constituted a clearly novel and inventive contribution of the claimed invention over the prior art.

VIII. The Board announced its decision on the appeal at the end of the oral proceedings.

Reasons for the Decision

1. The appeal complies with the requirements of Articles 106 to 108 and Rules 1(1) and 64 EPC and is thus admissible.

2. The Board, however, considers the appeal not allowable since the invention for which the appellant seeks protection does not meet the requirement of inventive step (Articles 52(1) and 56 EPC).
3. This deficiency already exists in respect of claim 1, which defines a method of automatically creating, identifying, sorting and storing digitally scanned documents in a computer network.

A very similar method is used in operating the document distribution system described in document D1, which anticipates the following steps of the method of present claim 1:

A stack of successive sheets (a job comprising a job control sheet and document or data sheets to be distributed, see D1, page 38, 2nd and 3rd paragraph and claim 2, for example) is prepared for digitalizing scanning (a conventional optical scanner 12 generating a stream of bits, see D1, figure 1 with page 6, lines 34 ff., or claim 2, for example).

The top sheet and all other logical sets or sheets within the stack (the actual document sheets for the job, see D1, page 38, loc.cit.) are preceded by a cover sheet (the job control sheet, see for example figures 1 to 4, reference numeral 10, or page 12, lines 23 to 28) bearing machine-readable code markings (see the various machine-readable markings in figure 4).

The cover sheet and the stack of sheets is fed into the digitizing scanner (see D1, page 38, loc.cit.); during the scanning, the presence of the cover sheet (see for

example D1, page 8, lines 26 ff., page 9, lines 13 to 22, or page 13, lines 2 to 8) and thus the beginning of the document scanning are recognized (see for example page 12, lines 26 to 30).

The machine readable code markings contain identification of the document owner (addressing parameters for one or more receivers 210, see figure 7 and for example page 13, line 35 to page 14, line 30, page 34, lines 31 ff., page 35, lines 12 ff., page 37, lines 15 ff., or claim 4).

There was some dispute whether the term "document owner" in the present application means receiver of the document or not. The Board, however, concludes from the phrasings used in the present application, in particular at column 3, lines 34 to 42, column 5, lines 9 to 16, and column 6, lines 37 to 44 that the document owner is the receiver (recipient) of the document. This is the only possible interpretation in respect of the term "routed" in the phrasing "document owner to whom the document should (is to) be assigned or routed". But also the term "assigned" implies a transfer of rights, title to property or other interests to someone, in this phrasing to the document owner, and thus to the recipient of the transferred document.

Furthermore, the job control sheet shown in D1, figure 4 has markings (location code and extension/list) which encode, in machine-readable manner, the addressing parameters for one or more receivers, thus they identify the document owner in terms of the present invention.

These markings on the cover sheet are automatically read (see for example claim 18 with claim 19) and the information thereof is recorded, first in the scanner buffer (see D1, page 15, lines 26 ff.). The bit streams encoding the parameters are then stored and forwarded to the nodes (see for example page 35, line 20 to page 36, line 11, or see for example claim 17).

Moreover, these markings identify intermediate and destination nodes and thus contain the desired routing of the digitized document data through the computer network (see page 6, lines 15 to 21, page 7, lines 9 to 22, page 11, lines 9 to 13, line 35 to page 12, line 10, page 33, lines 4 to 16, or page 35, lines 22 to 26, for example).

All sheets of a document are scanned and the digitized document information routed in accordance with the recorded cover sheet identification-routing information (see above and, for example, D1, page 37, lines 24 to 31).

Finally, the information is stored in the computer network for subsequent retrieval or further processing (distributing, filing, obtaining etc., see D1, page 8, lines 9 to 14).

4. This leaves as the only possible difference which distinguishes the method of claim 1 from the prior art the feature that the routing of the document information takes place "upon the identification of a new cover sheet (1, 1¹) or the absence of further sheets

fed to the scanner (S)" (see claim 1, pen-ultimate method step).

5. Certainly, an empty entry tray or a new control sheet, placed deliberately or by mistake, will naturally occur in using an automatic document scanning and distributing system of the type disclosed in document D1. Considering that the scanned and digitized data are first transmitted and stored in a node 212 (the safe storage services, see D1, figure 9), before being routed in a store-and forward-process to the receivers (see for example page 37, line 15) the skilled person is quite naturally confronted with the problem to determine when and under which circumstances this routing process should be initialized. An emptied entry tray is certainly an obvious event for triggering the routing process. Anything else would be detrimental to the automatic handling of the document distribution process.

6. Considering furthermore the capability of the D1 system not only to scan and distribute documents automatically but also to recognise and interpret control sheets it seems to be logical, as pointed out by the examining division, that from the event of a new cover sheet the system treats the previous document as ended, thereby "identifying" all the sheets scanned between the previous cover sheet and the new cover sheet as one document.

The same logic is applied in document D3, which like D1 discloses a method and system for automatically scanning, transmitting and printing documents using a control sheet (address card) for controlling the

facsimile communication. The flow diagrams of figures 17 and 18 of document D3 show a routine which provides a forced disconnect (D3, figure 18, reference numeral 228), thus terminating the previous document transmission whenever a new control sheet is detected, and then returns to the starting point of the automatic mode branch routine (see D3, figure 17, branch 212). The forced disconnect instruction clearly identifies the end of the previous scanning job by signalling the disconnect to the facsimile terminal. Similarly, an empty entry tray is detected in D3 to define the end of a job (see figure 18, reference numeral 217). The analogous application of such routines in the document distribution system of D1 does not require any inventive efforts.

7. For these reasons the method of claim 1 lacks the inventive step and is thus not patentable under Articles 52(1) and 56 EPC.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:

M. Kiehl

S. V. Steinbrener