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**Datasheet for the decision  
of 25 July 2008**

**Case Number:** T 1505/05 - 3.5.01

**Application Number:** 02026819.9

**Publication Number:** 1320039

**IPC:** G06F 17/30, H04N 1/00

**Language of the proceedings:** EN

**Title of invention:**  
On-line picture album and print system

**Applicant:**  
NORITSU KOKI CO., LTD.

**Opponent:**  
-

**Headword:**  
On-line picture album/NORITSU KOKI

**Relevant legal provisions:**  
-

**Relevant legal provisions (EPC 1973):**  
EPC Art. 56

**Keyword:**  
"Inventive step (no)"

**Decisions cited:**  
T 0154/04

**Catchword:**  
See points 6 to 8 of the Reasons



Case Number: T 1505/05 - 3.5.01

**D E C I S I O N**  
of the Technical Board of Appeal 3.5.01  
of 25 July 2008

**Appellant:** NORITSU KOKI CO., LTD.  
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**Representative:** Sajda, Wolf E. et al.  
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**Decision under appeal:** Decision of the Examining Division of the  
European Patent Office posted 12 May 2005  
refusing European application No. 02026819.9  
pursuant to Article 97(1) EPC 1973.

**Composition of the Board:**

**Chairman:** S. Steinbrener  
**Members:** R. R. K. Zimmermann  
A. Pignatelli

## Summary of Facts and Submissions

- I. European patent application No. 02026819.9 claiming priority from a Japanese patent application filed in November 2001 concerns a server and photo processing system for printing on-line album pictures.
- II. In oral proceedings held on 19 April 2005, the examining division refused the application. According to the decision issued in writing on 12 May 2005, the reasons were lack of novelty and inventive step, respectively, in the light of documents D1: WO-A-01/37 260, published in May 2001, and D2: EP-A-0 930 774, published in 1999.
- III. The appellant (applicant) filed a notice of appeal on 22 July 2005 and a written statement setting out the grounds of appeal on 22 September 2005.
- IV. In a communication annexed to summons to oral proceedings, the Board made preliminary observations, giving a negative opinion regarding patentability of the invention.
- V. In oral proceedings held on 25 July 2008, the matter was discussed with the appellant on the basis of three sets of claims, the independent claims relevant to this decision reading as follows:

### Main request, claim 4:

"4. A photo processing system downloading data from an on-line album provided on a network to thereby make a photo print, comprising:

- communication means (13) downloading picture data pasted in an on-line album provided by a server system;  
- wherein auxiliary data, which is comment data on a picture or title information on the picture, together with the picture data can be provided from the client (3) side to the on-line album and, when picture data are downloaded therefrom by the communication means (13), the auxiliary data are downloaded together with the picture data; and  
- further including print making means (15) making a photo print on which both the picture and the auxiliary information are formed, based on the picture data and the auxiliary data downloaded,  
characterized in that the system comprises a rear surface printing machine (17) such that the print making means (15) and the rear surface printing machine (17) form a picture on a front surface of a photosensitive material and print the auxiliary information on a rear surface thereof."

First auxiliary request, claim 4 and  
second auxiliary request claim 1:

"A photo processing system downloading data from an on-line album provided on a network to thereby make a photo print, comprising:

- communication means (13) downloading picture data pasted in an on-line album provided by a server system;  
- wherein auxiliary data, which is comment data on a picture or title information on the picture, together with the picture data can be provided which is comment data on a picture or title [sic!], together with the picture data can be provided from the client (3) side to the on-line album and, when picture data are downloaded therefrom by the communication means (13),

the auxiliary data are downloaded together with the picture data,

- an index picture data produced based on the picture data and the auxiliary data are possible to be downloaded; and

- further including print making means (15) making a photo print on which both the picture and the auxiliary information are formed, based on the picture data and the auxiliary data downloaded, and an index print is possible to be made based on the index picture data; and

- further including a rear surface printing machine (17),

characterised in that, in a case of making an index print so as to form auxiliary information below a thumbnail picture, the index print is made based on the index picture data and, in a case of forming auxiliary information on a rear surface of a print, the index print is made so that the print making means (15) prints the thumbnail picture on the front surface of a photosensitive material based on the picture data, and the rear surface printing machine (17) prints the auxiliary information based on the auxiliary data, and in a case of making picture prints of individual pictures, the picture prints of the individual pictures are made so that the print making means (15) prints the pictures on a front surface of a photo sensitive material based on the picture data, and the rear surface printing machine (17) prints the auxiliary information based on the auxiliary data."

VI. The appellant requested that the decision under appeal be set aside and that a patent be granted on the basis of the set of claims 1 to 4 in accordance with the main

request dealt with in the decision under appeal or on the basis of the set of claims filed during the oral proceedings of 25 July 2008 as first and second auxiliary request, respectively.

- VII. According to the appellant's submissions, it was wrong to assess patentability of the invention by starting from traditional photo printing techniques as the examining division did. The skilled person was rather familiar with modern computer-based methods for processing and printing images than with traditional photography or the field of chemical photo printing. On the basis of modern digital methods, it was unusual to separate image and corresponding textual elements and to print them separately on the front and back of a printing paper. Therefore, the skilled person would not combine pieces of the prior art originating from the field of computer-based image processing with antiquated methods of providing handwritten notes on postcards or glossy printing paper as the examining division argued.

The examining division failed to show that the claimed features were specifically disclosed in the prior art, in particular in document D1. Instead of specifically locating the claimed features in document D1 the decision resorted to conclusions and inferences, which was not the correct method to prove lack of novelty. As indicated by the two-part form of the independent claims, the invention was distinguished from, and thus novel over the prior art system of document D1.

Contrary to document D1, however, the invention allowed printing a large detailed image without overlap with

textual elements as well as printing an index picture together with auxiliary information. Those options of printing picture and auxiliary data were not provided for in the cited prior art, neither in document D1 nor in D2. Providing such options clearly solved a technical problem, namely the problem to arrange a number of image elements to fit the limited paper size by using front and back sides of the printing paper. By this unconventional concept, pictures and comments could be displayed in full quality without compromising on the picture size or resolution. The technical solution was the implementation of control means like menus, buttons etc., which allowed the user to select the appropriate option.

VIII. At the end of the oral proceedings, after closing the debate and deliberation, the Board announced the decision on the appeal.

### **Reasons for the Decision**

1. The appeal is admissible. The appeal, however, is not allowable since for the reasons given below the subject-matters of claims 4 of the main and first auxiliary requests as well as of claim 1 of the second auxiliary request (see point V above) do not meet the requirement of inventive step (Article 56 EPC 1973).
2. Given the lack of inventive step in all these three requests, other deficiencies of the patent application which had been addressed in the proceedings before the Board are not material to the outcome of the appeal, and are thus not considered further in this decision.

3. It is common ground that document D1 is an appropriate starting point for assessing inventive step. As confirmed by the appellant, it discloses, in combination, the features of the first part of the claims under consideration.

Indeed, document D1 concerns a system for processing, storing and printing digital images using the Internet as a communication means. It describes a computer system, including a so-called minilab (see e.g. page 5, line 6 ff.), which allows users to "coordinate, maintain, store, manipulate, index, display, transmit, share, identify or otherwise process their image portfolio by way of a digital image portfolio stored on the computer system". The digital image portfolio can be used to create "bulk prints, print packages or photo albums" and to transmit the finished product for example via the Internet to a centralised printing location (see page 26, line 27 to page 27, line 7 and fig. 1).

In an embodiment, the user system and the minilab are connected via the Internet, or alternatively both are in data communication with a central computer storing the digital image data (page 46, second paragraph; see also page 62, claim 13).

4. This prior art system provides a variety of functions for processing digital image data including the creation of a package of digital images or an online album combining pictures and related auxiliary data like titles, comments etc. as explained e.g. in the third paragraph on page 17 and in the paragraph



bridging pages 22 and 23. The image portfolio is stored as a database of images in the computer system, for example in the central computer, and is accessible by the user via the Internet for reading, printing etc. of images (see e.g. page 5, lines 6 ff.). Such a computer system is, within the normal meaning of the terms, a server and the image data stored in the database provided by this server may be designated as an "online album" in the sense it is used in the present application, as follows e.g. from paragraph [0037]. The Internet is a suitable communication means to upload picture data from the client to the database and to download picture data pasted in the online album for example to a centralised printing location (see e.g. page 26, line 27 ff.).

Since the user may choose between various sizes of images (see e.g. page 17, third paragraph and the paragraph bridging pages 18 and 19), the prior art system makes it possible to produce and download index picture data on the basis of the picture and auxiliary data. Both, picture and auxiliary data can be printed together with auxiliary data using a printing machine which prints on the front and the back of a printing page (see page 24, lines 25 to 28).

It follows that the computer and minilab system of document D1 anticipates at least the preambles of the claims under consideration.

5. Turning to the second (characterising) part of the claims under consideration, it is noted that the wording "form a picture on a front surface of a photosensitive material" and "print ... on a rear

surface thereof" needs some interpretation since a "material" per se has no defined front or back sides. The description, paragraph [0034] f., explains that for exposing and printing pictures on a photosensitive material a laser engine, PLZT engine, a CRT engine and others could be used. The photosensitive material such as paper could be subjected to known developing and drying treatments, thereby enabling making a photo print. The rear surface printing machine could be "a dot impact type, an ink ribbon type and others".

6. Apparently, the application does not refer to any specific photo print method but rather suggests to use a normal printing technique for printing texts and pictures on any common printing paper suitable to reproduce pictures on the front surface in photo quality.

Since document D1 already discloses, as cumulative options, two sided prints ( see e.g. page 24, line 25 ff.) as well as "professional quality photographic prints" (see e.g. page 27, line 1 f.), the Board judges that document D1 anticipates the features of the first and second parts of the claims insofar as the characterising features define the printing functions of the photo processing system.

This leaves only a marginal difference between the claimed subject matter and the prior art, namely that the pictures are formed on the front surface and that the comments etc. are printed on the back side of the printing paper or material as already identified by the examining division with respect to claim 4 of the then (and present) main request.

The functions, however, are already provided by the prior art system of document D1. The user can freely arrange the pictures and the textual materials on the computer screen before printing them as finished pages (see e.g. document D1, page 17, lines 14 ff., page 22, line 17 ff., page 24, lines 25 ff. , page 25, lines 14 ff.).

In addition, any concept of arranging pictures and text which does not solve a specific technical problem is a mere presentation of information. Such a concept does not provide a technical contribution over the prior art and can thus not form a valid basis for novelty and inventive step. The same situation exists with respect to the claims of the auxiliary requests, which characterise the invention by options to select the type of pictures and whether the text is printed on the front or back of the printing paper. These options are typical aspects of presentation of information and are also available to the user of the prior art system.

7. The appellant argued that the invention allowed to arrange pictures and comments such that both can be enjoyed in full quality (see point VII above). This argument, however, fails on the ground that the photo processing system as claimed does not ensure any specified picture size or level of print quality. Considering the broad scope of the claims, there is no causal link between the alleged achievements and the subject matter of the claims.

Although the wording of the claims may justify a broader, less favourable interpretation putting novelty

of the claimed invention in question, the Board accepts the appellant's argument that the invention was distinguished from the prior art of document D1 by providing control means (see point VII above) for selecting the various claimed options of making photo and index prints from the online album.

8. The objective technical problem solved by the claimed subject matter is accordingly the implementation of a suitable functionality for selecting these options. These options define possible arrangements of pictures and text on a printing paper, which may meet aesthetic standards and likings but which do certainly not solve any technical problem. According to the practice of the boards, such kind of non-technical ideas and concepts do not positively contribute to inventive step; they may however appear as a constraint or desideratum in the formulation of the technical problem (see e.g. decision T 154/04 - Estimating sales activity / DUNS LICENSING ASSOCIATES (OJ EPO 2008, 46), Reasons No. 5 ff.).

Graphical user interfaces presenting a menu or on-screen list of commands (buttons etc.) are notorious means for implementing all type of selection functions.

Therefore, considering the objective technical problem, the Board judges the use of such type of control means as a normal design option.

The subject matter of the claims under consideration hence lacks inventive step in the light of document D1 and the general technical background in the field of computing.

**Order**

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

The appeal is dismissed.

The Registrar:

The Chairman:

T. Buschek

S. Steinbrener