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Datasheet for the decision
of 25 January 2013

Case Number: T 1726/09 - 3.5.01

Application Number: 98961846.7

Publication Number: 1040428

IPC: G06F 17/24, G06F 17/21

Language of the proceedings: EN

Title of invention:
Computerized prepress

Patent Proprietor:
VISTAPRINT TECHNOLOGIES LIMITED

Opponents:
TechConsult Ltd. Büro Köln
socoto gmbh & co.kg
Peter Schmidt Group am Main GmbH

Headword:
Authoring in web browser

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

Keyword:
"Inventive step – no (all requests)"

Decisions cited:
–

Catchword:
–

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                     It can be changed at any time and without notice.
C9028.D

Case Number: T 1726/09 - 3.5.01

D E C I S I O N
of the Technical Board of Appeal 3.5.01
of 25 January 2013

Appellant: (Patent Proprietor)	VISTAPRINT TECHNOLOGIES LIMITED Canon's Court 22 Victoria Street Hamilton HM-12 (BM)
Representative:	Fleuchaus, Michael A. Fleuchaus & Gallo Partnerschaft Patent- und Rechtsanwälte Steinerstrasse 15/A 81369 München (DE)
Respondent I: (Opponent 1)	TechConsult Ltd. Büro Köln Marsiliusstr. 11 50937 Köln (DE)
Representative:	Bungartz, Klaus Peter Patentanwälte Bungartz & Tersteegen Im Mediapark 6A 50670 Köln (DE)
Respondent II: (Opponent 2)	socoto gmbh & co.kg Cläre-Prem-Strasse 3 54290 Trier (DE)
Representative:	Bungartz, Klaus Peter Patentanwälte Bungartz & Tersteegen Im Mediapark 6A 50670 Köln (DE)
Respondent III: (Opponent 3)	Peter Schmidt Group am Main GmbH Westhafenplatz 8 60327 Frankfurt (DE)
Representative:	Bungartz, Klaus Peter Patentanwälte Bungartz & Tersteegen Im Mediapark 6A 50670 Köln (DE)

Decision under appeal: **Decision of the Opposition Division of the European Patent Office posted 25 June 2009 revoking European patent No. 1040428 pursuant to Article 101(3)(b) EPC.**

Composition of the Board:

Chairman: S. Wibergh
Members: R. R. K. Zimmermann
P. Schmitz

Summary of Facts and Submissions

I.   European patent EP 1 040 428, based on Euro-PCT
        application WO 99/28834, claims a priority date of
        2 December 1997 for an invention in the field of
        computerized print and print-publishing prepress.
        Claim 1 of the patent as granted reads as follows (the
        subdivision M1, M2,… of claim 1 has been added for ease
        of reference):

        M1 - A method of operating /a/ computer apparatus (202)
             in a system for facilitating creation of an
             electronic document (214) to be output as a
             printed document wherein

        M2 - creation of the electronic document is user
             controlled by operation of a client computer (200)
             in network communication with the computer
             apparatus and

        M3 - printing of the electronic document is by
             operation of a printer (204) in communication with
             the computer apparatus,

        M4 - said computer apparatus storing a computerized
             prepress software system (208, 218) which includes

        M5 - a downloadable document authoring program (208)
             comprising one or more authoring tools for
             authoring the electronic document and

        M6 - a prepress translation component (218) operable to
             produce a prepress format file (220) from the
             electronic document authored by the authoring
             program;
             the method steps performed by the computer
             apparatus comprising:

C9028.D

M7 - outputting (302) the authoring program via the network communication for downloading the authoring program to the client computer;

M8 - receiving (306) via the network communication the electronic document authored using the authoring program;

M9 - saving (306) the electronic document in an internal format of the computer apparatus; and

M10 - translating (308) the electronic document using the translation component from the internal format to a file in a different prepress format which is usable to produce a corresponding printed document on the printer; wherein

M11(a) - the authoring program provided by the computer apparatus is adapted for being executed by a browser in the client computer

M11(b) - so as to provide a display output representing the electronic document in a form in which it is to appear in the printed document,

M12 - and at least one of the authoring tools has one or more functions for allowing a user to select and edit at least one element of the electronic document while at least a portion of the electronic document is simultaneously displayed.

II.   Three oppositions were filed against the patent, invoking, inter alia, lack of inventive step as ground of opposition. In addition to the prior art cited by the opponents, the opposition division introduced prior art on its own motion into the proceedings. Eventually, the following prior art documents proved to be relevant in the present appeal before the Board:

E7: US 5327265 A (McDONALD) 5 July 1994.

E9: SOMMERGUT, Wolfgang. Office-Lösungen für den schlanken Client: Widerstreitende Ansätze. Computerwoche. March 1997, 11/1997, page 17 f.

E10: BRORS, Dieter. Internet-Office: Office-Pakete zunehmend als Application Server. c't Magazin für Computer Technik. May 1997, No. 5/1997, pages 70-72.

E11: MICHEL, Dieter. Dick und dünn: Applix Anyware und Corel Office for Java. iX Magazin für Professionelle Informationstechnik. July 1997, No. 7/1997, pages 58-62.

III.   The opposition division revoked the patent for lack of inventive step of claim 1 as granted and the respective claim 1 of eight auxiliary requests. The decision in writing was posted on 25 June 2009. According to the decision, the invention was distinguished from the closest prior art, the application suite *Corel Office for Java* as disclosed in document E11, by differences in features M1, M3, M4, M6, M10, and M11(b) (see claim 1 above), which however did not amount to an inventive contribution over the prior art. These features provided the possibility of creating and printing a document. In order to add such kind of functionalities to the Corel Office suite of document E11, a skilled person would consider it obvious to translate the document to a well-known prepress format like a PostScript file and to send the prepress format file to a printer connected via a network to the server (computer apparatus). Moreover, since a WYSIWYG functionality was a commonly desired feature of text processing applications like WordPerfect, adapting the

client component accordingly and thus implementing
feature M11(b) was another obvious design feature.

IV.   The patentee (appellant) lodged an appeal against the
       revocation decision on 24 August 2009, paying the
       appeal fee on the same day, and filed the grounds of
       appeal on 5 November 2009. Together with the notice of
       appeal, the appellant filed a main request and
       auxiliary requests 1 to 8. Claim 1 of the main request
       contained claim 1 of the patent as granted.

       The case was heard and decided in oral proceedings
       before the Board on 25 January 2013. The appellant
       requested that the decision under appeal be set aside
       and that the patent be maintained on the basis of the
       main request filed with the notice of appeal dated
       24 August 2009, alternatively on the basis of the
       auxiliary requests 1 or 2 filed during the oral
       proceedings before the Board. The former auxiliary
       requests filed with the notice of appeal were
       withdrawn.

       The respondents (opponents) requested that the appeal
       be dismissed.

V.   Claim 1 of auxiliary request 1 contained, additionally
       to claim 1 of the main request, the following feature
       at the end of feature M11(b):

       by providing a text tool in the authoring program for
       allowing a user to input a text string in the
       electronic document, the method comprising receiving by
       the computer apparatus said text string input by the
       user and sent by the authoring program, the computer

apparatus translating the text string into an image,
and sending the image from the computer apparatus back
to the client computer for display in place of the
roughly displayed text string input in the electronic
document.

VI.   In claim 1 of auxiliary request 2 it was additionally
        specified that the text string was being displayed in a
        rough manner while being input by the user. The whole
        claim reads:

        M1 - A method of operating a computer apparatus (202)
             in a system for facilitating creation of an
             electronic document (214) to be output as a
             printed document wherein
        M2 - creation of the electronic document is user
             controlled by operation of a client computer (200)
             in network communication with the computer
             apparatus and
        M3 - printing of the electronic document is by
             operation of a printer (204) in communication with
             the computer apparatus,
        M4 - said computer apparatus storing a computerized
             prepress software system (208, 218) which includes
        M5 - a downloadable document authoring program (208)
             comprising one or more authoring tools for
             authoring the electronic document and
        M6 - a prepress translation component (218) operable to
             produce a prepress format file (220) from the
             electronic document authored by the authoring
             program;
             the method steps performed by the computer
             apparatus comprising:

M7 - outputting (302) the authoring program via the
      network communication for downloading the
      authoring program to the client computer;

M8 - receiving (306) via the network communication the
      electronic document authored using the authoring
      program;

M9 - saving (306) the electronic document in an
      internal format of the computer apparatus; and

M10 - translating (308) the electronic document using
      the translation component from the internal format
      to a file in a different prepress format which is
      usable to produce a corresponding printed document
      on the printer; wherein

M11(a) - the authoring program provided by the computer
      apparatus is adapted for being executed by a
      browser in the client computer

M11(b) - so as to provide a display output representing
      the electronic document in a form in which it is
      to appear in the printed document

M13 - by providing a text tool in the authoring program
      for allowing a user to input a text string in the
      electronic document,

M14 - said text string being displayed in a rough
      manner while being input by the user,

M15 - the method comprising receiving by the computer
      apparatus said text string input by the user and
      sent by the authoring program,

M16 - the computer apparatus translating the text
      string into an image, and

M17 - sending the image from the computer apparatus
      back to the client computer for display in place
      of the roughly displayed text string input in the
      electronic document,

M12 - and at least one of the authoring tools has one
or more functions for allowing a user to select
and edit at least one element of the electronic
document while at least a portion of the
electronic document is simultaneously displayed.

VII.   The arguments presented by the parties to the Board
with respect to inventive step considered in the light
of document E11 as closest prior art may be summarised
as follows.

The respondents rejected any interpretation reading
into claim 1 the definition of a WYSIWYG functionality,
i.e. the printing of a document at a remote printer
precisely in the form in which it had been displayed to
a user at the local client computer for creating or
editing the document. Claim 1 did not define anything
relevant beyond a common client server structure and
the use of common software required for authoring a
document and transmitting the document to a server-side
printer. Such type of document processing and print-on-
demand services had been intensively discussed long
before the priority date of the patent. Only the
feature of an authoring program provided from the
server (computer apparatus) and executable by a browser
in the client computer could have the potential to
provide a possibly inventive contribution to the prior
art. However, porting application programs to a Java
platform and offering such programs as applets for
download and execution in Web browsers was a popular
idea already at the priority date of the patent; many
software corporations then followed the trend to adapt
their software portfolio to the Java platform. This was
documented for example in documents E10 and E11.

Considerable efforts had also been made to overcome the
printing problem in Java on the basis of the client-
server model. Document E9 explicitly referred to a
backend document server for storing and printing
documents as part of Corel's Office suite for Java.

VIII. The appellant disagreed and argued that the claimed
invention was clearly inventive over the prior art.
Although the opposition division correctly identified,
in document E11, an authoring program executable by a
browser running on a client computer, it manifestly
misrepresented the disclosure content of document E11
and hence erred in its judgment on obviousness of the
present invention.

Document E11, an article in a computer magazine like
documents E9 and E10, provided only a rough outline of
Corel's office suite for Java, merely referring in
passing to a server component of the office suite,
software that had never been released or made public,
neither at the time these articles were written nor at
any later point in time. The Beta version of Corel
Office for Java on which E11 reported was incomplete
and seriously affected by software bugs. In this
respect, the appellant referred, inter alia, to exhibit
P7 filed earlier in first instance:

P7: Office for Java Readme. Retrieved from the
Internet:
<http://www.somis.dundee.ac.uk/coj2/coj/readme.htm>.

P7 was the kind of readme document that appeared to
have been enclosed with the published beta version of
Corel Office for Java and which was cited in E11,

page 62, left column, last sentence. It was the only
document on file with regard to Corel Office for Java
that had been issued by the makers of that software.
Therefore, P7 should be considered at least as relevant
as E11. It listed a large number of known problems and
missing functions, in particular with regard to screen
display and printing, showing that Java was too limited
and unreliable in 1997 to allow the skilled person to
extend the Office suite by the claimed server-side
document management and print functions. In respect of
these functions, the disclosure in E11 (and in
documents E9 and E10) was thus not enabling. The vague
allusions in E11 to such functions should not have been
taken into account in the assessment of inventive step.

Moreover, E11 disclosed neither the server-side storing
of the document in an internal format nor the
translation of the document from the internal format
into a prepress format for printing the document.
Without knowledge of the present invention the skilled
person would rather have chosen a client-side printing
solution since that was the general and widely accepted
form of connecting print services to a user computer.
Without hindsight, server-side printing would have been
considered inappropriate since it was expected to
produce a number of serious problems, for example
substantial configuration efforts where the client
network was connected to a large number of printers of
different type located on the network at previously
unknown sites.

Furthermore, because of the graphical limitations
inherent to Java in 1997, the skilled person would not
have considered it obvious to implement on a Java

platform a WYSIWYG functionality as defined in feature
M11(b) and to add such a functionality to the Corel
Office suite for Java. There was no other hint in the
prior art to WYSIWYG. In particular, the iterative
editing process described in document D7 producing
mock-ups of the document to be printed did not provide
an exact display of what would be printed.

Finally, the opposition division wrongly ignored the
strong interaction that involved all features of the
claimed method and that resulted in a unique
improvement of the prepress process. A correct
application of the problem and solution approach
required consideration of the claim as a whole and
would without doubt have led to a positive judgement on
inventive step.

Reasons for the Decision

1.   The admissible appeal is not allowable since none of
       the requests before the Board can be allowed on the
       merits for lack of inventive step, Article 52(1) EPC
       and Article 56 EPC 1973, in the respective claim 1 of
       all requests.

2.   The following statement of the reasons is confined to
       claim 1 of the second auxiliary request (see VI above),
       which includes all features of claim 1 of the higher-
       ranking requests.

2.1   The opposition division cited document E11 as the
       closest prior art and used the *Corel Office for Java
       Beta* described therein as starting point for assessing

inventive step. Although enablement of the disclosure
was contested, it was not disputed that document E11
discloses, using the terminology of the present claims,
a system (*NC* and *Serverteil*, see E11, section *Corel
Office for Java Beta* at page 61 f.) for facilitating
creation of an electronic document (*Textverarbeitung
und Tabellenkalkulation*).

Document E11 relates to the beta version of Corel
Office, which does not include a server component and
is incomplete with respect to various functions.
Nevertheless, on the basis of the common technical
knowledge concerning networked workgroup computers and
office information systems, the skilled person will
derive various pieces of information from document E11
about the design and functionality of the planned
release version of Corel Office for Java. This office
suite is apparently based on a networked client-server
configuration including clients running on network
computers and a server component. The server supports
functions like accessing documents, searching, and
importing files having an external format (see E11,
page 62, first col.), i.e. all the resource-demanding
document management functions, which is also a
consequence of the low-cost concept of network
computers. Accordingly, storing and printing documents
are functions allocated to the server as indicated in
document E9, last column at page 18. Apparently this
solution avoids the known problems of Java printing.
Therefore, the appellant's argument that the skilled
person would normally only consider client-side
printing is not convincing.

If Word Perfect, Quattro Pro and Presentations of Corel Office for Java offers "the normal range of functions" (see E11, page 62, 2nd column), the server must be able to translate the document saved in an internal format, eg a WordPerfect document file, eg to a Postscript format. It should be noted here that exhibit P7 cited by the appellant as an important source for interpreting document E11 refers to the printing support of Corel Office for "Postscript printers".

Moreover, WordPerfect provides for tools to create and manipulate text and simple graphic elements while the document is being displayed. WordPerfect is known as a word processing program that is able to display an electronic document in the form in which it is to appear in the print output. How it is actually printed is a different question and also not the subject of the present invention since nothing in claim 1 nor any feature referred to in the patent specification warrants that the document as printed closely resembles the image displayed on the client computer.

In summary, document E11 discloses a system for facilitating creation of an electronic document to be output as a printed document which anticipates features M2 to M13 above.

2.2   The appellant's argument that the disclosure in documents E9 to E11 was non-enabling and the documents should be discarded for this reason is not accepted by the Board. The present patent itself apparently assumes that the implementation of an authoring program on a Java platform in a client-server configuration is feasible when it describes, for example in section 0007

of the specification, a Java embodiment of the
invention. Indeed, computer networks in client-server
configurations were common in the field of office
information systems in 1997. The skilled person would
have been able to develop, without undue effort, a
prototype of the system as a proof of concept,
demonstrating the technical feasibility of providing
document management and print services according to
Corel's concept disclosed in document E11. It is
irrelevant whether such a prototype was ever realised
or whether technical or economic problems stood in the
way of bringing such a product to market.

2.3   The remaining distinguishing features M14 to M17 in
        claim 1 (see VI above) define an iterative process of
        inputting a text string, sending it to the server
        (computer apparatus) that translates it into an image
        and sends it back for replacing the existing text in
        the displayed document. The claim wording might be
        construed to define a simple preview function of the
        document server. According to the specification,
        section 0031, however, the image is supposed to show
        exactly what will be printed, ensuring that the
        authoring program provides a WYSIWYG display even if
        the different computers have different font engines.

        This problem is not solved, as already indicated above,
        since nothing in the disclosed and claimed invention
        ensures that the image sent back shows exactly what the
        printer will print. A less ambitious objective problem
        that is consistent with the subject of the invention as
        described in the patent specification at page 2 could
        be seen in providing a cost-effective access to a high-

end workgroup printer from a plurality of low-cost
network computers.

The low-resolution editing process disclosed in
document E7 is a solution to this problem. It allows
the effective sharing of an expensive printer among
many network computers (see E7, col. 1 , line 21 ff).
The process (see E7, figure 1 in connection with col.2,
lines 28 to 60 and col. 4, line 64 to col. 5, line 22)
discloses the idea of inputting text (and possibly
images) in a comparatively "rough" manner (low
resolution) at the customer site, and to produce, at a
remote print centre, a high resolution version of the
document and to send back a low resolution image (mock-
up) of the document to the customer for approval or
further editing. This process is essentially the
content of features M14 to M17 above.

The appellant argued that the mock-up produced
according to document E7 did not show what is to be
printed. The Board disagrees with that view: feature
M11(b) only defines that the display output
"represents" the electronic document in a form in which
it is to appear in the printed document. This is such a
broad definition that it encompasses the low resolution
"mock-up" of document E7.

2.4   It follows from the above considerations that the
subject-matter of claim 1 of all requests lacks an
inventive step so that the requests cannot be allowed.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar: The Chairman:

T. Buschek   S. Wibergh

C9028.D