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**Datasheet for the decision
of 21 December 2016**

Case Number: T 2199/11 - 3.5.04

Application Number: 04711651.2

Publication Number: 1602072

IPC: G06T11/60

Language of the proceedings: EN

Title of invention:

Apparatus and method for manipulating images

Patent Proprietor:

Serverside Group Limited

Opponent:

European Oppositions Ltd

Headword:

Relevant legal provisions:

EPC Art. 123(2)
EPC 1973 Art. 56

Keyword:

Amendments - added subject-matter (no)
Inventive step (yes)

Decisions cited:

Catchword:



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Case Number: T 2199/11 - 3.5.04

D E C I S I O N
of Technical Board of Appeal 3.5.04
of 21 December 2016

Appellant: European Oppositions Ltd
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Respondent: Serverside Group Limited
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Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted on 28 July 2011
rejecting the opposition filed against European
patent No. 1602072 pursuant to Article 101(2)
EPC.

Composition of the Board:

Chairman C. Kunzelmann
Members: R. Gerdes
 B. Müller

Summary of Facts and Submissions

- I. The appeal is against the decision of the opposition division rejecting the opposition against European patent No. 1 602 072, which had been filed as application No. 04 711 651.2.
- II. The opposition was based on the grounds of lack of novelty and inventive step (Article 100(a) EPC in conjunction with Articles 54 and 56 EPC), insufficient disclosure (Article 100(b) EPC) and added subject-matter (Article 100(c) EPC). The opposition division rejected the opposition, holding that none of the grounds for opposition prejudiced maintenance of the patent as granted.
- III. The opponent 2 (appellant) filed an appeal against this decision. The appellant requested that the decision under appeal be set aside and that the patent be revoked in its entirety. In the statement of grounds of appeal it maintained only the grounds for opposition of added subject-matter and lack of inventive step. The appellant provided arguments regarding inventive step based on the following documents:
- A5: US 2001/0051876 A1
B1: US 2002/0025085 A1, and
B2/A6: EP 0 878 956 A1.
- IV. In its letter of reply dated 20 April 2012, the patent proprietor (respondent) requested that the appeal be dismissed. It also requested the board "to consider exercising their discretion in awarding an order for the Appellant to pay all of the Patentee's costs incurred unnecessarily by the Appellant's omissions"

pursuant to Article 16(1) of the Rules of Procedure of the Boards of Appeal (RPBA).

- V. In a communication annexed to a summons to oral proceedings, the board indicated that it would have to be discussed at the oral proceedings whether claim 1 contained added subject-matter (see the ground for opposition of Article 100(c) EPC 1973) and whether the claimed subject-matter involved an inventive step in view of documents B1, B2/A6 and A5. The board added that it was not minded to grant the request for apportionment of costs.
- VI. With a letter received on 22 November 2016 former opponent 1 (Gemalto SA) informed the board that it had acquired the opposed patent and would not be attending the oral proceedings. No supporting documents were attached to the letter or received thereafter on or before the date of the oral proceedings held before the board.
- VII. Those oral proceedings were held on 21 December 2016 in the absence of any parties. The Chairman noted that the appellant (opponent 2) had requested that the decision under appeal be set aside and that the European patent No. 1602072 be revoked in its entirety.

The Chairman also noted that the respondent (patent proprietor) had requested that the appeal be dismissed and that the board consider exercising its discretion in awarding an order for the appellant (opponent 2) to pay all of the respondent's costs incurred unnecessarily by the appellant's omissions per Article 16(1) of the Rules of Procedure of the Boards of Appeal.

VIII. The independent claims of the proprietor's sole request (patent as granted) read as follows:

"1. A computer system for the manipulation of images for application to personalised financial transaction cards, the computer system comprising:
an image store (114, 253);
an image processor (110, 256);
means for generating a browser-based user interface (105, 254) for displaying for manipulation on a remote terminal a graphical representation (111, 115) of at least a portion of an original image (107) held at the image store (114, 253), said browser-based user interface being capable of effecting a plurality of manipulations to the graphical representation;
an image resizer (255) arranged to generate a graphical representation of said original image, wherein said graphical representation comprises a resized version of the original image such that the graphical representation is displayable for manipulation at said remote terminal;
an Internet communications link arranged to couple the browser-based user interface to the image processor, wherein a user at said remote terminal can use said browser-based user interface to upload an original image such that it is transferred via said Internet communications link to said image store, and wherein the link is operable to receive information about said manipulations applied to the graphical representation and transfer said information between the browser-based user interface and the image processor, and said image processor is operable to access the original image held at the image store to apply manipulations emulating those applied to the graphical representation at the remote terminal; and

means for communicating a version of the original image comprising the applied manipulations to a financial transaction cards printing means (122, 257) maintained securely from the browser-based user interface."

"7. A method of operating a computer system for manipulation of images to be applied to personalised financial transaction cards, the method comprising:

providing an Internet communications link coupling a browser-based user interface (105, 254) operable at a remote terminal to an image processor (110, 256) of the computer system;

receiving an original image uploaded by a user at the browser-based user interface of the remote terminal and transferring said image to an image store (114, 253) of the computer system via said Internet communications link,

generating a graphical representation of at least a portion of said original image, said graphical representation comprising a resized version of the original image;

displaying said graphical representation for manipulation at the browser-based user interface, wherein a plurality of manipulations to the graphical representation are effected using said browser-based user interface;

transferring information about manipulations applied to the graphical representation at the remote terminal between the browser-based user interface and the image processor via said Internet communications link,

causing the image processor to access the image store and apply, to at least a portion of the original image held in the image store, manipulations emulating those applied to the graphical representation at the remote terminal; and

causing the image processor to communicate a version of the original image comprising the applied manipulations to a financial transaction cards printing means maintained securely from the browser-based user interface."

"13. A computer program product for the personalisation of an image to be applied to a financial transaction card comprising program code means, said program code means including:

first code means for providing an Internet communications link coupling a user interface of a remote terminal to an image processor (110, 256) of the computer system;

second code means for receiving an original image uploaded by a user at the remote terminal and transferring said image to an image store (114, 253) of the computer system via said Internet communications link;

third code means for generating a graphical representation of at least a portion of said image, said graphical representation comprising a resized version of the original image;

fourth code means for displaying said graphical representation for manipulation at a browser-based user interface, wherein said browser-based user interface is operable to allow a user to effect a plurality of manipulations to said graphical representation;

fifth code means for transferring information about manipulations applied to the graphical representation at the remote terminal between the browser-based user interface and the image processor via said Internet communications link;

sixth code means for causing the image processor to access the remote image store and apply, to at least a

portion of the original image held in the image store, manipulations emulating those applied to the graphical representation at the remote terminal; and seventh code means for causing the image processor to communicate a version of the original image comprising the applied manipulations to a financial transaction cards printing means maintained securely from the browser-based user interface."

Claims 2 to 6 and 14 to 21 are dependent on claim 1. Claims 8 to 12 are dependent on claim 7.

IX. In the decision under appeal the opposition division held that documents A5 and B1 were not relevant for the discussion of inventive step. In A5 the user interface and the image content displayed were both determined by the server. Also, according to B1 the actual image processing was performed at the server. A6 (which equalled B2) was chosen as the closest prior art, because the patent as granted and A6 shared at least the problems to "provide quick, pleasant and easy use, ... to use Internet bandwidth efficiently, ... and ... to secure the server from remote access" (see decision under appeal, points 41 to 43, 45).

The claimed subject-matter differed from A6 in that

- the manipulated image was printed on a financial transaction card, and
- the user uploaded the original image via the browser-based user interface and the Internet to said image store, which in A6 was found in the dealer branch shop,

which were two differences corresponding to two unrelated problems. The first difference - printing on

financial transaction cards - was considered to be the result of an arbitrary, non-functional modification of the closest prior art, which did "not provide an inventive step". The second difference related to the technical problem of increasing convenience for the user. Solving this problem in the way proposed by the patent in suit would require fundamental changes to the system architecture of A6. These changes would be discouraged by the teaching of A6 (see decision under appeal, points 48 to 50).

X. The appellant's arguments may be summarised as follows.

The patent in suit contained added subject-matter. The skilled person would not find direct and unambiguous disclosure of the use of an Internet communications link for transferring an original image to an image store. He would also not find direct and unambiguous disclosure of the use of "said" Internet communication link, where "said" was the link previously recited in the claims.

It was accepted that the skilled person would understand that specific means - such as the Internet communication link - for transferring data could be used, and that one of these could be via the Internet. However the test here was what was actually disclosed. Figure 1 of the original application showed a direct connection from the customer's hard drive 106 to the image compilation server 108. If the image from the customer's hard drive were sent via the front-end software, then it ought to flow via 101 and 105. There was no explicit disclosure of the image 107 passing via anything other than a direct path. Also, figure 2 of the original application taught the skilled person that the software 254 could play no part in the uploading of

the image, since it was only entered after the image had been uploaded (see statement of grounds, pages 2 to 5).

With respect to novelty in view of B1, the appellant argued that the claimed subject-matter differed from B1 only in that claim 1 provided an output to financial transaction cards. The appellant interpreted the feature relating to the browser-based user interface being capable of effecting a plurality of manipulations to the graphical representation to mean that no "direct manipulation by the interface of the graphical representation without any other agent's intervention" was required, i.e. "intervention of the server in the provision of the manipulated image" was not precluded (see statement of grounds, page 8, first paragraph).

However, even if it were assumed that claim 1 recited that the manipulation of the image was carried out locally and without use of the Internet until the manipulations were complete, the claimed subject-matter lacked inventive step. In this case B1 should be the closest prior art. The technical problem was then how to provide a better user environment.

This problem was solved by A6, in which a low resolution image was sent to the user, who effected local editing and then sent only editorial information to the server, see A6, page 5, lines 5 to 17. The "problem of user environment" was addressed specifically in A6, for example on page 10, lines 8 to 14 (see statement of grounds, pages 9 and 10).

XI. As to the respondent's arguments, the board summarises those pertaining to its request for an apportionment of costs as follows:

The appellant's statement of grounds did not contain an adequate case for appeal and in fact did not set out clearly and concisely the reasons why it requested that the decision under appeal be reversed. It also did not specify expressly all the facts, arguments and evidence relied on, contrary to Article 12(2) RPBA. Therefore, the brevity of the statement of grounds of appeal and of the arguments presented therein had resulted in an undue burden for the proprietor. The appellant's failure to set out its complete case had prejudiced the timely and efficient conduct of the appeal proceedings (see point 42 of the respondent's letter dated 20 April 2012).

Reasons for the Decision

1. The appeal is admissible. The alleged acquisition of the opposed patent by former opponent 1 (Gemalto SA) (see point VI above) has no effect on the present appeal proceedings. Pursuant to Rule 20(3) in conjunction with Rule 61 EPC 1973 (now Rule 22(3) EPC and Rule 85 EPC, respectively), a transfer of a European patent made during opposition appeal proceedings shall have effect vis-à-vis the EPO only when and to the extent documents satisfying the EPO that the transfer has taken place have been produced. However, no documents in support of a transfer of the opposed patent to former opponent 1 (Gemalto SA) have been produced.

Added subject-matter, Articles 123(2) EPC and 100(c) EPC 1973

2. The appellant submitted that the following features of claim 1 of the patent in suit could not be derived from the application as filed:

(a) "a user at said remote terminal can use said browser-based user interface to upload an original image such that it is transferred via said Internet communications link to said image store" and

(b) "wherein the link is operable to receive information about said manipulations applied to the graphical representation and transfer said information between the browser-based user interface and the image processor."

2.1 The board finds that feature (a) is disclosed on page 14, lines 2 and 3 of the application as published, which states that "the front end will allow the upload of images from the user's computer to the server", and page 11, line 6, which discloses that the "front end software operates entirely within an Internet browser". It is also clear from figure 3 that the uploading of an image is effected inside a browser (in this case "Microsoft Internet Explorer").

Page 2, lines 29 and 30 of the application provides literal support for the second part of feature (b), whereas the first part of the feature is disclosed on page 11, lines 20 to 31. The fact that the user interface is "browser-based" is for example disclosed in figures 3 to 7.

2.2 With respect to the appellant's arguments based on figures 1 and 2 of the original application (see

point X above) it is noted that these figures illustrate the general operation and the main components of the computer system "in accordance with an embodiment of the invention" (see page 10, lines 14 to 17). Hence, these embodiments do not necessarily relate to the same embodiment as figures 3 to 7 and the further passages which were cited in support of the contested features. Furthermore, these figures consist of block diagrams which are not intended to be accurate in the sense of showing every interaction of the software components.

- 2.3 Hence, the board agrees with the decision under appeal, see points 21 and 22, that features (a) and (b) are disclosed in the application as originally filed.

Inventive step, Articles 56 and 100(a) EPC 1973

Claim construction

3. The board considers the construction of the independent claims as being essential for the assessment of inventive step.

- 3.1 It is common ground between the parties that the last feature of claim 1 specifying

"means for communicating a version of the original image comprising the applied manipulations to a financial transaction cards printing means (122, 257) maintained securely from the browser-based user interface"

is not disclosed in any of documents A5, B1 and B2/A6. However, what is disputed is which restrictions to the claimed subject-matter are implied by the reference to a communication with a financial transaction cards

printing means (see statement of grounds, page 7, last two paragraphs and reply of the respondent, points 15 and 16).

3.2 The board agrees with the appellant that claim 1 is directed to a computer system for the manipulation of images. The financial transaction cards printing means is not part of this computer system. It is also accepted that the expression "maintained securely from the browser-based user interface" mainly characterises the financial transaction cards printing means. Nevertheless, this feature implies a restriction for the claimed computer system, in so far as it requires that the computer system provides an interface including appropriate software and hardware to communicate with the printing means. The connection to the printing means must also prevent access by unauthorised users to the external financial transaction cards printing means, be it by means of a firewall which may be interconnected between the computer system and the printing means or any other means for providing a secure connection (see page 6, line 39 to 41 and figure 1: 121 of the patent specification as published).

3.3 It was also contested whether the expression "browser-based user interface being capable of effecting a plurality of manipulations to the graphical representation" of claim 1 provided a limitation in the sense that a "direct manipulation by the interface of the graphical representation without any other agent's intervention" was required, i.e. whether an "intervention of the server in the provision of the manipulated image" was not precluded (see statement of grounds, page 8, first paragraph).

The appellant argued in addition that the skilled person would understand "manipulations" to be used in the sense of manipulations in general and would not consider it to mean that one manipulation was excluded. The plurality of manipulations referred to in claim 1 should therefore be understood to signify "one or more" or "at least one" (see page 9, first to fourth paragraph of the statement of grounds).

- 3.3.1 The board agrees with the respondent that claim 1 should be understood in the sense that the client is adapted to effect more than one manipulation. Corresponding information is subsequently transmitted via the link to the server, such that corresponding manipulations can be applied to the original image at the server.

This interpretation is required by claim 1, which refers to "means for ... displaying for manipulation on a remote terminal a graphical representation (111, 115) of ..., said browser-based user interface being capable of effecting a plurality of manipulations to the graphical representation", "the link is operable to receive information about said manipulations applied to the graphical representation" and "said image processor is operable to access the original image held at the image store to apply manipulations emulating those applied to the graphical representation at the remote terminal". The board holds that the specification of a user interface being capable of effecting a plurality of manipulations cannot be understood to mean that the manipulations might be effected indirectly by intervention from the server side. Furthermore, this interpretation would be contradictory to "emulating" the manipulations on the server side, which implies

that the manipulations have been carried out previously by the browser-based user interface.

3.3.2 The above interpretation of claim 1 is consistent with and supported by the description, see paragraphs [0014], [0017], [0018] and [0026] of the patent in suit. It is also noted that the invention intended to overcome the disadvantage associated with prior-art image manipulation software according to which "Each time the user uses the interface to make a manipulation to the image, a separate call is made to the server, the server software changes the image's position, and sends back the information to the client machine" (see paragraph [0005] of the patent publication).

3.3.3 The appellant did not convince the board that claim 1 should be given a different interpretation, since its arguments to that effect do not take into account the consistent disclosure of the patent specification as discussed in points 3.3.1 and 3.3.2.

Inventive step starting from document B1

4. The appellant argued that even if the above interpretation of claim 1 was adopted, the claimed subject-matter lacked inventive step. In this case B1 should be the closest prior art. The technical problem was how to provide a better user environment (see statement of grounds, page 9).

4.1 The board agrees with the appellant that document B1 constitutes the closest prior art with respect to the subject-matter of claim 1.

4.2 B1 discloses a client/server system connected through the Internet in which users at a client computer can upload images to be imprinted on fabricated items. The server generates a low-resolution image, called a WebImage, that is downloaded to the client computer so that it can be modified by the user. Every edit instruction invoked by the user at the client computer results in a command to the server system to perform the indicated operation. When the image processing completes at the server, the results are returned to the client. Preferably, the image editing interface at the client computer is implemented by a conventional HTTP client or web browser (see paragraphs [0005], [0008], [0041] to [0051] and [0058]).

Hence, the client/server system presented in B1 essentially corresponds to the one presented in the patent in suit as being part of the prior art, see paragraph [0005], i.e. it involves effecting all image manipulation operations at the server side.

4.3 B1 does not disclose the last feature of claim 1 that the computer system is suitable for communicating the manipulated image to the financial transactions cards printing means maintained securely from the user interface.

In addition, B1 does not disclose that the browser-based user interface is capable of effecting a plurality of manipulations to the graphical representation. It also does not disclose that "the link is operable to receive information about said manipulations applied to the graphical representation and transfer said information between the browser-based user interface and the image processor, and said image processor is operable to access the original image held

at the image store to apply manipulations emulating those applied to the graphical representation at the remote terminal". Essentially, this means that B1 does not disclose effecting a plurality of manipulations to an image at the client computer with those manipulations being applied to a corresponding image at the server.

- 4.4 The board concurs with the decision under appeal, see section 49, that the first difference solves a different technical problem from the second difference and that it does not confer an inventive step on the subject-matter of claim 1.

The technical effect associated with the second difference is to reduce the system response time to "provide a pleasant user experience" (see paragraph [0005] of the patent in suit). The board agrees with the appellant that the corresponding partial technical problem can be formulated as how to provide a better user environment.

- 4.5 The board also agrees with the appellant that document B2/A6 is concerned with improving the user environment. It is also in the same technical field, i.e. printing of photographs. However, this document discloses a computer system in which images are only stored at reduced resolution in a dealer head shop after being digitised at a branch shop from analogue photographs. The dealer head shop acts as a server communicating to the client computer. The editorial information is sent from the client computer to the head shop and subsequently from the head shop to the branch shop to print the photographs (see figure 1 and page 5, lines 1 to 24). The respondent correctly characterised this architecture as a three-tiered architecture, which

stood in contrast to the client/server architecture of the patent in suit (see the respondent's reply dated 20 April 2012, points 37 and 38). The difference in architecture is caused by the use of a different technology (silver-salt photographs in B2/A6), and has several consequences for the functionality of the computer system. Inter alia, the server only stores a low-resolution image and it does not provide the interface to the printing means. Hence, the board holds that the combination of documents B1 with B2/A6 would have required several adaptations which would not have resulted in the claimed subject-matter in an obvious manner.

- 4.6 In conclusion, the combination of documents B1 and B2/A6 does not render the subject-matter of claim 1 and the corresponding independent claims 7 and 13 obvious. This also holds for B1 and the common general knowledge of the skilled person.

Inventive step starting from other documents

5. The appellant provided a reasoning of lack of inventive step based on A5. However, as conceded by the appellant, assuming the interpretation of claim 1 adopted under point 3 above, B1 should be considered as the closest prior art. The board agrees that A5 is not the most suitable starting point for the invention, essentially since it discloses neither effecting a plurality of manipulations at the client nor applying those manipulations to an image held at the server.
6. In addition, the appellant noted in its statement of grounds, see the passage bridging pages 1 and 2, that it maintained its position in respect of the other documents cited during the opposition proceedings.

However, the appellant did not substantiate this position, nor did it address the findings of the opposition division in respect of these documents (see decision under appeal, points 37 to 44). The board sees no reason to deviate from these findings.

Apportionment of costs

7. The respondent requested that the board consider exercising its discretion to order the appellant under Article 16(1) RPBA to pay all of the respondent's costs incurred unnecessarily by the appellant's omissions.
- 7.1 According to Article 16(1) RPBA, "Subject to Article 104, paragraph 1, EPC, the Board may on request order a party to pay some or all of another party's costs which shall, without limiting the Board's discretion, include those incurred by any ... acts or omissions prejudicing the timely and efficient conduct of oral proceedings".
- 7.2 The board cannot see how the filing of the statement of grounds, even if it were considered to be deficient due to brevity and/or ambiguity of the arguments presented therein (see point XI above), could have prejudiced the timely and efficient conduct of oral proceedings. The fact that the board had been in a position to issue a summons to oral proceedings drawing attention to matters which seemed to be of special significance for the oral proceedings (see Article 15(1) RPBA) runs counter to such a conclusion. The respondent advanced no other grounds for an award of costs in its favour, and the board is unable to identify such grounds, either.

7.3 Hence, the board declines to take a decision deviating from the principle embodied in Article 104(1) EPC according to which each party to the proceedings shall bear the costs it has incurred. The board thus refuses the respondent's request for an order of costs in its favour.

Order

For these reasons it is decided that:

1. The appeal is dismissed.
2. The request for apportionment of costs is refused.

The Registrar:

The Chairman:



K. Boelicke

C. Kunzelmann

Decision electronically authenticated