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D E C I S I O N
of 22 October 1999

Case Number: T 1053/98 - 3.5.1

Application Number: 91303335.3

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Title of invention:
Data communication apparatus

Applicant:
CANON KABUSHIKI KAISHA

Opponent:
-

Headword:
-

Relevant legal provisions:
EPC Art. 56

Keyword:
"Inventive step - problem and solution"

Decisions cited:
-

Catchword:
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Boards of Appeal

Chambres de recours

Case Number: T 1053/98 - 3.5.1

D E C I S I O N
of the Technical Board of Appeal 3.5.1
of 22 October 1999

Appellant: CANON KABUSHIKI KAISHA
30-2, 3-chome, Shimomaruko
Ohta-ku
Tokyo (JP)

Representative: Beresford, Keith Denis Lewis
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Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 15 June 1998
refusing European patent application
No. 91 303 335.3 pursuant to Article 97(1) EPC.

Composition of the Board:

Chairman: P. K. J. van den Berg
Members: R. S. Wibergh
V. Di Cerbo

Summary of Facts and Submissions

- I. This appeal is against the decision of the Examining Division to refuse European patent application No. 91 303 335.3.
- II. The Examining Division argued that the subject-matter of claim 1 was obvious in view of the prior art known from EP-A-0 238 256 (D3). The decision also mentions the document
- D2: US-A-4 870 503,
- cited in the application.
- III. The applicant filed an appeal against this decision, arguing in particular that the closest prior art was not D3 but the one discussed in the introduction to the application.
- IV. In a communication by the Board the rapporteur expressed the preliminary opinion that claim 1 did not contain inventive subject-matter with respect to D2.
- V. On 22 July 1999 new claims were filed according to a main request and an auxiliary request.

Claim 1 of the *main request* read as follows (omitting the reference signs):

A facsimile apparatus comprising:

- reading means for reading document image data;

- registering means for registering a plurality of user names;
- display means for displaying a user name registered by said registering means;
- user-operable selection means for enabling a user to cause said display means to display the user name registered by said registering means for that user;
- means for transmitting as a facsimile communication data representing the read document image data;
characterised by
- store means for storing communication results for individual communications performed by the apparatus;
- processor means adapted to cause individual communication results each including at least the user name displayed by said display means for the performance of the corresponding communication to be stored in said store means;
- user-operable means for enabling a user to request a report of communication results;
- record means for outputting to the user a report of communication results; and
- control means operable, in response to operation of both said user-operable selection means and

said user operable means, to select all of the stored individual communication results for a user name displayed by said display means and to cause said record means to output to the user a report listing only all of said individual stored communication results for the user name displayed by said display means.

The *auxiliary request* differed from the main request in that a feature had been added to the preamble. According to this feature, the data to be transmitted identify "as the sender the user name displayed by the display means". The appellant explained that this feature, which had been contained in a previous version of the claim but was deleted in the present main request, only served to meet any objection the Board might have against the main request under Article 123(2) EPC.

- VI. The appellant argues that D2 neither mentions the problem to be solved by the invention, nor the means necessary for solving it.

- VII. The appellant requests that the decision under appeal be set aside and that a patent be granted on the basis of the main request or the auxiliary request respectively as submitted on 22 July 1999.

Reasons for the Decision

- 1. *The prior art*

The invention according to claim 1 of the main request relates to a facsimile (telefax) apparatus. Such devices are capable of scanning documents and transmitting them as data over a communication line. From D2, which in the Board's view describes the closest prior art, a telefax apparatus is known which is specifically designed to be shared between a number of people working in different departments of a firm. This device comprises means for selecting, among a number of pre-registered names, the name of the user (department) sending the fax. The name is automatically added to the message (column 6, lines 12 to 15).

This prior art corresponds to the preamble of claim 1.

2. *The invention*

Compared with D2, the present invention allows the telefax costs to be supervised. As is well known, a fax sent over the public telephone net incurs a fee. If a telefax apparatus is shared between several users, such as departments of a firm, it may be desirable for reasons of charge control to monitor or account for the respective usage (cf. column 5 of the published patent application). To achieve this, the facsimile apparatus according to the invention stores the user (department) name and costs ("results") for every transmission performed. Upon request the apparatus outputs a report listing all such results for a selected user.

3. *The technical problem*

3.1 D2 is entirely silent on the issue of fax costs. The appellant has therefore argued that neither the

technical problem to be solved by the present invention nor its solution are suggested by this document. More specifically, the technical problem should in the appellant's view be seen as *adding functionalities to the known telefax machine such that the efficiency and cost effectiveness are increased.*

- 3.2 The Board cannot agree with the formulation of the technical problem as proposed by the appellant. The reasons are the following.
- 3.3 The overall aim of the present invention is an economic one, namely charge control. Usually such economic - ie non-technical - aims are not taken into account when formulating the technical problem. In the present case, however, it has nevertheless been argued that a part of the invention would reside in the idea of monitoring the fax costs for each department of a firm for reasons of cost effectiveness.
- 3.4 The appellant's formulation of the problem has a clearly non-technical component. In fact, the technical aspect in that formulation is limited to the reference to a telefax machine. Therefore, a complete solution to the problem would have to include the idea of monitoring the costs incurred by each user of the fax machine. It is this non-technical part of the solution which provides an incentive for the technical part, namely to adapt the known fax machine in such a way that it can be used by several departments while fulfilling the monitoring requirements. Consequently, in order to assess inventive step it would be necessary to consider in particular - and above all - the non-technical part of the solution.

3.5 It is exactly to avoid this situation that a technical problem has to be formulated in such a way that there is no possibility of an inventive step being involved by purely non-technical features. Such a formulation of the problem could refer to the non-technical aspect of the invention as a given framework within which the technical problem is posed. In the present case the technical problem could therefore be stated as *proposing means for monitoring the costs incurred by each user of the facsimile apparatus known from D2.*

This problem is directed to the "person skilled in the art" (Article 56 EPC), who is the expert for facsimile machines. He is not required to have any special non-technical skills.

3.6 The appellant has objected that the above problem formulation as proposed by the Board contains parts of the solution, namely the monitoring of the individual user costs, in contradiction to the caselaw of the Boards of appeal. Furthermore, a correctly posed problem should not include a reference to the telefax machine known from D2. The recognition that in particular facsimile machines cause costs which would be worth while accounting for is part of the invention.

3.7 The Board agrees that its formulation of the technical problem to be solved by the present invention indeed contains elements of a solution, namely a non-technical solution (monitoring costs) to a non-technical problem (charge control). However, for the reasons already stated, it appears that a more general wording of the technical problem to be solved is not possible in cases such as the present one. The formal starting point

should be the closest prior art, and this must be a technical document. Therefore the technical problem will relate to such technical prior art.

4. *Inventive step*

4.1 The technical problem is thus to provide means for monitoring the costs incurred by each user of a facsimile apparatus. Rephrasing this technical problem in terms of functional features of a solution, means should be provided for storing user name (department designation) and costs for every communication. Since only the telefax machine is able to deliver the names directly, it is the telefax machine which should contain these means (rather than, say, the telephone exchange). In order to monitor the results, means for outputting communication reports sorted according to user should also be added. All these means, which correspond to the characterising features of claim 1, are regarded as following in a straight-forward way from the technical problem posed.

4.2 The appellant has pointed out that it would have been possible to monitor the costs incurred by each telefax user without any technical modifications at all by installing in each department an apparatus of the known type. This is no doubt true. However, it is clear that the skilled person would not be satisfied with a solution which relies on installing a number of extra fax machines to do the work previously performed by a single machine. He would therefore concentrate on the use of a single machine and arrive at the present invention in the manner already indicated.

4.3 It follows that the subject-matter of claim 1 according to the main request does not involve an inventive step.

5. *The auxiliary request*

Claim 1 of the auxiliary request contains the additional feature that data are transmitted which identify "as the sender the user name displayed by the display means". This feature has been acknowledged as being known from D2. It has nothing to do with the technical problem of monitoring fax costs, nor has the appellant argued that it would have inventive merit in combination with the new features of claim 1. Thus, this request is refused for the same reasons as the main request.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:

M. Kiehl

P. K. J. van den Berg