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: -
Case Number: T 1726/09 - 3.5.01

DECISION of the Technical Board of Appeal 3.5.01 of 25 January 2013

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C9028.D
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 and

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,
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:

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 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,
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