

Internal distribution code:

- (A) [] Publication in OJ
(B) [] To Chairmen and Members
(C) [X] To Chairmen
(D) [] No distribution

D E C I S I O N
of 30 September 2004

Case Number: T 0929/01 - 3.2.5

Application Number: 95201876.0

Publication Number: 0679539

IPC: B43M 3/04

Language of the proceedings: EN

Title of invention:

Scanning documents in a method and in systems for assembling postal items

Patentee:

Hadewe B.V.

Opponents:

Böwe Systec AG
Pitney Bowes Inc.

Headword:

-

Relevant legal provisions:

EPC Art. 54, 111, 123

Keyword:

"Allowability of the amendments: main request and first to third auxiliary requests - no; fourth auxiliary request - yes"
"Novelty (fourth auxiliary request) - yes"
"Remittal to the first instance - yes"

Decisions cited:

G 0010/91

Catchword:

-



Case Number: T 0929/01 - 3.2.5

D E C I S I O N
of the Technical Board of Appeal 3.2.5
of 30 September 2004

Appellant: Hadewe B.V.
(Proprietor of the patent) De Tijen 3
NL-9201 BX Drachten (NL)

Representative: Smulders, Theodorus A.H.J., Ir.
Vereenigde
Postbus 87930
NL-2508 DH Den Haag (NL)

Respondent I: Böwe Systec AG
(Opponent 01) Werner-von-Siemens-Strasse 1
D-86159 Augsburg (DE)

Representative: Zimmermann, Tankred
Schoppe, Zimmermann, Stöckeler & Zinkler
Patentanwälte
Postfach 246
D-82043 Pullach (DE)

Respondent II: Pitney Bowes Inc.
(Opponent 02) World Headquarters,
One Elmcroft,
Stamford
Connecticut, 06926-0790 (US)

Representative: Avery, Stephen John
Hoffman Eitle,
Patent- und Rechtsanwälte
Arabellastrasse 4
D-81925 München (DE)

Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 28 May 2001
revoking European patent No. 0679539 pursuant
to Article 102(1) EPC.

Composition of the Board:

Chairman: W. Moser
Members: H. M. Schram
P. E. Michel

Summary of Facts and Submissions

I. The appellant (patentee) lodged an appeal against the decision of the Opposition Division revoking the European patent No. 0 679 539 on the grounds that all independent claims of the sole request of the appellant lacked novelty, Article 54 EPC. In particular, the Opposition Division held that the subject-matter of claims 1 and 15 lacked novelty with respect to document US-A 5 054 757 (D13) and that the subject-matter of claim 23 lacked novelty with respect to document US-A 4 972 655 (D1).

II. Oral proceedings were held before the Board of Appeal on 30 September 2004.

The representative of respondent I (opponent 01) had previously informed the Board by facsimile, received on 24 September 2004, that neither he, nor the respondent I himself, had the intention to be present at the oral proceedings. Based on Rule 71(2) EPC, the oral proceedings were held in the absence of respondent I and his representative.

III. At the end of the oral proceedings, the final requests of the parties were as follows:

The appellant requested that the decision under appeal be set aside and that the patent in suit be maintained on the basis of the following documents:

(i) main request: claims 1, 15 and 23 filed as main request on 30 August 2004, and claims 2 to 14, 16 to 22, and 24 as granted; or

- (ii) first auxiliary request: claims 1 and 15 filed as first auxiliary request and claim 23 filed as main request on 30 August 2004, and claims 2 to 14, 16 to 22, and 24 as granted; or
- (iii) second auxiliary request: claims 1 and 15 filed as main request and claim 23 filed as second auxiliary request on 30 August 2004, and claims 2 to 14, 16 to 22, and 24 as granted; or
- (iv) third auxiliary request: claims 1 and 15 filed as first auxiliary request and claim 23 filed as second auxiliary request on 30 August 2004, and claims 2 to 14, 16 to 22, and 24 as granted; or
- (v) fourth auxiliary request: claim 1 filed as main request on 30 August 2004 and claim 15 presented during oral proceedings as fourth auxiliary request, and claims 2 to 14, and 16 to 22 as granted; or
- (vi) fifth auxiliary request: claim 1 filed as first auxiliary request on 30 August 2004 and claim 15 presented during oral proceedings, and claims 2 to 14, and 16 to 22 as granted.

Respondents I and II (opponents 01 and 02) requested - respondent I in writing - that the appeal be dismissed.

IV. Independent claims 1, 15 and 23 of the main request read as follows:

"1. A method for assembling a postal item using a system comprising a first delivery station (1), at least one next delivery station (1, 2) and a folding station (32), in which documents (47) are delivered by said delivery stations (1, 2) to a supply track (44), the delivered documents are transported along the supply track (44), and at least some of the delivered documents are gathered and aligned into a stack having aligned document edges (46) on one side, wherein aligning the delivered documents is carried out by moving the documents relative to each other in an area downstream of said delivery stations (1, 2) until the document edges (46) on one side of the documents are in alignment, characterized in that at least some of the transported documents are scanned along said supply track, downstream of the delivery stations (1, 2), said scanning including scanning of characters, the length or the thickness from the scanned documents, and the stack is supplied from said area downstream of said delivery stations (1, 2) to the folding station (32)."

"15. A system for assembling postal items, comprising transport means (3, 4), including a supply track, for transporting delivered documents, a first and at least one next delivery station (1, 2) for delivering documents to the supply track, a gathering and aligning station (16) downstream of the delivery stations (1, 2) and the supply track, said gathering and aligning station (16) being arranged for gathering separately supplied documents into a stack and for displacing the documents of a set relative to each other until the document edges located on one side of the stack are aligned, and a folding station (32), characterized by scanning means (64) along said supply track, downstream

of said delivery stations (1, 2), for scanning characters, the length or the thickness of delivered documents in said supply track, the folding station (32) being arranged downstream of the aligning station (16, 116) for folding the stack of documents."

"23. A system for gathering and aligning supplied documents, comprising a supply track (44) for supplying documents delivered from a plurality of delivery stations (1, 2), said supply track having an upstream end in the form of an entry for receiving documents from said delivery stations, said entry being adapted for connection to a next upstream station including transport means for supplying documents, a gathering and aligning station (16) downstream of said supply track (44) for gathering and aligning documents supplied via said entry, and a discharge track (36, 136) downstream of said gathering and aligning station (16) for discharging documents gathered into a stack, characterized by scanning means (64) arranged along said supply track between said entry and said gathering and aligning station (16) for scanning supplied documents said scanning means being adapted for obtaining data regarding characters, the length or the thickness concerning these documents from said scanned documents."

Claim 15 according to the first auxiliary request differs from the corresponding claim according to the main request in that the expression "for scanning characters ..." has been replaced by the expression (underlining by the Board) "for scanning of and obtaining data regarding characters ...".

Claim 15 according to the fourth auxiliary request (presented during oral proceedings before the Board) reads as follows:

"15. A system for assembling postal items, comprising transport means (3, 4) for transporting delivered documents, a first and at least one next delivery station (1, 2) for delivering documents to a supply track, a gathering and aligning station (16) downstream of the delivery stations (1, 2), said gathering and aligning station (16) being arranged for gathering separately supplied documents into a stack and for displacing the documents of a set relative to each other until the document edges located on one side of the stack are aligned, and a folding station (32), characterized by scanning means (64) along said supply track, downstream of said delivery stations (1, 2), for scanning characters, the length or the thickness of delivered documents in said supply track, the folding station (32) being arranged downstream of the aligning station (16, 116) for folding the stack of documents."

V. The appellant argued essentially as follows:

*Main request - admissibility of the amendments
(Article 123(2) EPC)*

Claim 1 of the main request differed from claim 1 as granted only in that the claim now specified that the documents were scanned "along said supply track" downstream of the delivery stations. That documents were scanned along the supply track downstream of the delivery stations was disclosed in column 3, lines 8 to 10, in combination with Figures 1 and 2, of the

application as filed (published version). This amendment was also present in claim 15 of the main request. Claim 15 additionally required that the supply track was defined by, and hence included in, the transport means. The validity of the feature of claim 23, according to which the supply track had an upstream end in the form of an entry connected to a next upstream station for receiving documents, was already present in claim 23 as granted and could not be questioned under Article 123(2) EPC, neither by the respondents nor by the Board, without the consent of the appellant in view of G 10/91 (OJ EPO 1993, 420), since this would constitute a fresh ground of opposition. That the supply track had an upstream end in the form of an entry was clear from column 3, lines 1 to 2 and lines 8 to 10, of the application as filed (published version): because documents were transported along the supply track of the aligning station, this supply track must have an upstream "entry". That the entry was connected to a next upstream station was clear from the passage in column 7, lines 39 to 42, of the application as filed (published version), which stated that the aligning station could be "connected" to delivery stations. Whether or not the expressions "having an upstream end" and "entry" were mentioned *expressis verbis* in the application as filed was not the correct criterion to apply for deciding whether Article 123(2) EPC was complied with. The disclosure test was not a linguistic exercise, what mattered was the technical teaching to the person skilled in the art of the application as a whole.

Fourth auxiliary request - admissibility of the amendments (Articles 84 and 123(2) EPC and Rule 57a EPC)

The contested features of claim 15 of the main request were removed, so that claim 15 of the fourth auxiliary request met the requirements of Article 123(2) EPC. Claims 1 and 15 of the fourth auxiliary request were also clear and supported by the description and thus met the requirements of Article 84 EPC. Since the amendments were occasioned by grounds of opposition, the requirements of Rule 57a EPC were also met.

Fourth auxiliary request - novelty (Article 54 EPC)

The subject-matter of claims 1 and 15 of the fourth auxiliary request was novel with respect to document D13: this document did not disclose scanning means for scanning characters, the length or the thickness of documents, since the sensors known from this document were merely presence sensors incapable of detecting characters on documents, or measuring the length or the thickness of the documents passing the sensors.

VI. Respondents I and II argued essentially as follows:

Main request - admissibility of the amendments (Article 123(2) EPC)

Claim 15 defined the supply track as "included in" the transport means and downstream of the aligning station, whereas in the application as filed the supply track was described as part of the aligning station (see column 3, lines 1 and 2, of the application as filed,

published version). The application as filed was silent about the supply track having an upstream end in the form of an entry connected to a next upstream station. Hence, claims 15 and 23 contravened Article 123(2) EPC.

Fourth auxiliary request - admissibility of the amendments (Articles 84 and 123(2) EPC and Rule 57a EPC)

Respondent II argued that the term "along" conferred to the expression "scanning means (64) along said supply track" in claim 15 of the fourth auxiliary request at least three alternative meanings, namely that the scanning means were positioned along the supply track, or that distributed scanning took place along the supply track, or that the scanning means itself were passing along the supply track. Moreover, claim 15 failed to reiterate that all documents were scanned by the same scanning device. Lastly, claim 15 did not positively specify that the claimed system comprised a supply track. A crucial issue for assessing novelty was the meaning of the terms "scanning" and "scanning means", since it was not contested by the appellant that, apart from the features "scanning of characters, the length or the thickness from the scanned documents" and "scanning characters, the length or the thickness of the delivered documents", respectively, document D13 disclosed all the features of claims 1 and 15 of the fourth auxiliary request. In the English language, merely shining a beam of light on a passing document already constituted "scanning" of said document. Scanning was a passive act, which did not necessarily imply that information was obtained. Document D13 disclosed numerous optical sensors for detecting the

presence of passing documents, implying the use of light sources and photosensitive cells, just as the scanning means used in the patent in suit, cf. column 6, lines 15 to 18. If the speed of a passing document was known, the length of said document could be easily deducted from the on/off signal of a photosensitive cell. If the scanned document was semi-transparent, the amplitude of the signal of the photosensitive cell was a measure for the thickness of the document. It followed that document D13 disclosed "scanning of characters, the length or the thickness of documents" in the sense of the invention. The subject-matter of claims 1 and 15 was thus not novel.

Reasons for the Decision

Main request and first, second and third auxiliary requests

1. *Allowability of the amendments*

- 1.1 The invention relates to a method and a system for assembling postal items, wherein documents from a plurality of delivery stations are transported to a location where the documents are gathered and aligned before being supplied to a folding station. The documents from the respective delivery stations are transported along respective pathways, which may be initially, i.e. upstream, different from one another, but which must finally, i.e. downstream, converge into a common path ("supply track 44") in order to gather and align the respective documents for assembling a postal item, cf. Figure 2 of the application as filed (published version).

- 1.2 Claim 1 of the main request has been amended with respect to claim 1 as granted such that the first characterizing feature now reads (amendment underlined): "*at least some of the transported documents are scanned along said supply track, downstream of the delivery stations (1, 2)*". The preamble of claim 1 makes clear that there is a (single) supply track. The amended claim specifically states where the documents are scanned. Since all documents are passed along the same supply track, an interpretation of the claim that documents delivered by different stations are scanned along different paths is excluded.

The amendment is disclosed in Figure 1 and 2 of the application as filed, and is a direct consequence of the statement in column 6, lines 41 to 43, of the application as filed (published version), that "*any of the documents can be individually scanned by the same scanning device*". In the judgement of the Board, this amendment, and also the subject-matter of claim 1 of the main request as a whole, meets the requirements of Article 123(2) EPC. The claim is also clear and supported by the description (Article 84 EPC). Since no features were deleted from claim 1 as granted, the requirements of Article 123(3) EPC are also met.

- 1.3 Claim 15 of the main request defines that the transport means include a supply track. The appellant has argued that a supply track was in fact a transport means, since both were employed for transporting documents. This cannot be accepted, because a supply track is what the name says, a track. To put it differently, a supply track is a path along which documents are carried and

supplied. As an exemplary embodiment of the invention, transport means comprising staggered conveyor belts are described in the application as filed, see column 2, lines 1 to 4, and 25 to 31, of the application as filed (published version). These conveyor belts define pathways for the delivered documents, and thus define "supply tracks" (plural) for the documents delivered by the respective delivery stations. However, the term "supply track" (singular) has a specific meaning in the application as filed, it is the common path along which the delivered documents are supplied to the aligning station and which extends into the (head station of the) aligning station, see column 3, lines 1 and 2, of the application as filed (published version). In the judgement of the Board, claim 15 of the main request attempts to claim subject-matter for which there is no basis in the application as filed.

Consequently, this claim does not meet the requirements of Article 123(2) EPC.

- 1.4 Claim 23 of the main request contains the feature "said supply track having an upstream end in the form of an entry for receiving documents from said delivery stations, said entry being adapted for connection to a next upstream station including transport means for supplying documents" (henceforth referred to as feature (a)). Claim 23 as granted already contains feature (a), which was added to the claim during the examination proceedings. The appellant has argued that since the ground of opposition under Article 100(c) was not raised during the opposition proceedings, this feature could not be objected to in view of G 10/91 (loc. cit.) without the consent of the appellant.

The Board cannot accept this argument. Claim 23 has been amended with respect to claim 23 as granted. The Enlarged Board has confirmed in point 19 of the Reasons of its Opinion G 10/91 (loc. cit.), that, in case of amendments, "*such amendments are to be fully examined as to their compatibility with the requirements of the EPC (e.g. with regard to the provisions of Article 123(2) and (3) EPC).*" In order to establish whether an amended claim meets the requirements of Article 123(2) EPC, it is not sufficient to show that the (isolated) amendment(s) is/are disclosed in the application as filed, rather it must be established that a European patent application or a European patent does not contain subject-matter which extends beyond the content of the application as filed. In other words, it must be established whether "such amendment", i.e. the subject-matter of the amended claim as a whole is disclosed in the application as filed.

The expressions "upstream end", "entry" and "connection" in relation to the supply track are not disclosed in the application as filed. The supply track 44 is shown in Figure 2 by a dot-dash line, see column 10, lines 55 and 56, of the application as filed (published version). In the description pertaining to Figure 1 the supply track (not shown) is described as being part of the aligning station 16, see column 3, lines 1 to 10, of the application as filed (published version). The supply track is said to be formed by transport rollers 27, 28, 29, 30 and guides 61, 62. The next upstream station is delivery station 2 comprising transport unit 4 having conveyer belts 14, 15, see column 2, lines 37 to 39, of the application as filed

(published version). The application as filed is silent about the way the next upstream station and the supply track are connected.

The appellant has submitted that the expression "*said entry being adapted for connection*" merely meant that documents could be passed on from the next upstream station to the supply track. In this regard, the appellant referred to a statement in the description, which in his opinion elucidated the concept of connecting: "*Delivery stations, envelope stations and the like may be connected to this aligning station to obtain a system configuration which meets the user's requirements and can moreover be varied*", see column 7, lines 39 to 42, of the application as filed (published version). The appellant also submitted that any supply track necessarily had an upstream end which could be called an entry.

In the opinion of the Board, the submissions of the appellant are tantamount to saying that feature (a) is devoid of technical meaning over and above what is already stated in the claim, namely that the system comprises "a supply track (44) for supplying documents delivered from a plurality of delivery stations (1, 2)". In the judgment of the Board, however, feature (a) defines further, perhaps trivial, technical features of the supply track, for which there is no basis in the application as filed. It follows that claim 23 does not meet the requirements of Article 123(2) EPC.

1.5 Since both claim 15 and claim 23 of the main request do not meet the requirements of Article 123(2) EPC, the main request is rejected.

Claim 15 of the set of claims filed as first auxiliary request contains all the features of claim 15 according to the main request and therefore also contravenes the requirements of Article 123(2) EPC. The first auxiliary request is therefore rejected (Article 123(2) EPC)

Claim 23 of each of the sets of claims filed as second and third auxiliary request, respectively, comprises the feature (a') "*said supply track having an upstream end in the form of an entry for receiving documents from said delivery stations, said entry connected to a next upstream station including transport means for supplying documents*" (cf. feature (a), wherein the expression "being adapted for connection" is replaced by the term "connected"). Feature (a) has been found to contravene the requirements of Article 123(2) EPC, see point 1.4 above. For the same reasons feature (a') also contravenes the requirements of Article 123(2) EPC. Consequently, the second and third auxiliary requests are therefore rejected (Article 123(2) EPC)

Fourth auxiliary request

2. *Allowability of the amendments*

Claim 1 of the fourth auxiliary request is identical to claim 1 of the main request, which has been found to be formally allowable, see point 1.2 above.

Claim 15 of the fourth auxiliary request presented during oral proceedings differs from claim 15 as granted in that the expression to a supply track is added in the preamble after "a first and at least one next delivery station (1, 2) for delivering documents", and in that the first characterizing feature now reads: "scanning means (64) along said supply track, downstream of said delivery stations (1, 2), for scanning characters, the length or the thickness of delivered documents in said supply track" (the expressions along said supply track and in said supply track and a comma after "delivery stations (1, 2)" have been added, whereas the expression "at least" in front of "characters" has been deleted).

The expression "scanning means (64) along said supply track" is clear for the person skilled in the art, cf. Article 84 EPC. It means that the scanning means (for scanning documents in said supply track) are positioned along the supply track. In the judgement of the Board, the alternative interpretations suggested by respondent II (see point VI above) do not make technical sense, and are not in line with the disclosure of the invention in the patent in suit. It may be noted that this does not exclude that other scanning means may be provided elsewhere in the system (cf. column 6, lines 18 to 20, of the patent in suit).

The expression to a supply track is disclosed in claim 1 of the application as filed. The expression along said supply track is identical to the amendment in claim 1 of the main request. The expression [documents] in said supply track makes it clear that the scanning means positioned along the supply track

does indeed scan the documents located in the supply track. A basis for this is *inter alia* Figure 1 of the application as filed, which shows a light source 63 and a photosensitive cell 64 along the supply track.

Claim 15 of the fourth auxiliary request thus meets the requirements of Article 123(2) EPC.

Claim 15 relates to a system for assembling postal items, comprising transport means, delivery stations, a gathering and aligning station, a folding station and scanning means. The claim refers three times to a supply track or said supply track. In the view of the Board, it is thus clear that a supply track is covered by the system as well. Even if this were not the case, it would not follow that the claim was unclear per se. In the judgement of the Board, the claim is clear and supported by the description (Article 84 EPC). The deletion of the expression "at least" does not contravene the requirements of Article 123(3) EPC. The amendments were filed by the appellant in response to objections raised by the respondents I and II under Article 100(a) EPC and thus comply with the provisions of Rule 57a EPC.

3. *Novelty*

- 3.1 Claims 1 and 15 of the fourth auxiliary request contain the phrases "said scanning including scanning of characters, the length or the thickness from the scanned documents" and "for scanning characters, the length or the thickness of delivered documents in said supply track", respectively.

In the judgement of the Board, these phrases imply that information is obtained, for example in the form of a signal or data, which information is representative of the "characters, the length or the thickness" of the document.

3.2 Novelty is only disputed with respect to document D13. This document discloses a method for accumulating and folding sheets for producing a sealed mail piece (see column 5, line 36, to column 7, line 3, and Figures 3, 6, 7A and 7B). Documents (sheets or envelope forms) are supplied from laser printer trays T1, T2 and/or trays T3, T4, and gathered/aligned in the nip of the accumulator folder 106 by urge rollers 104 and 128, respectively. If the gate G2 is opened, the (three-thirds) sheets are driven into the buckle chute 112 and are folded to a two-thirds length and exit the accumulator folder 106 through the nip of rollers 800, 806. The envelope form 10, which is normally the first item, is not folded by accumulator folder 106. The laser printed envelope form 10, the folded sheets of two-thirds length coming from accumulator folder 106 are (again) accumulated in the nip of accumulator folder assembly 140, possibly together with two- or one-third sheets coming from trays T3 or T4. In the accumulator folder assembly 140 the complete stack is folded again. If a laser printed envelope form 10 is not fed to the accumulator folder assembly 140, a business reply envelope may be supplied from tray T3 or T4 instead. After the folding step in accumulator folder assembly 140, the flaps of the envelope are moistened, folded and sealed, thus completing a sealed mail piece. Figure 6 is a schematic diagram of the sensors S1 to S13, motors and gates in a preferred

embodiment of the invention (see column 8, lines 3 to 37). The optical sensors S3, S4, S10 to S13 and the sensors S4 to S9 detect whether a document is present in the path of the sensor or not.

Document D13 does not disclose that any of the sensors S1 to S13 is capable of the scanning of characters, the length or the thickness from the scanned documents.

- 3.3 Respondent II submitted that the sensors S1 through S13 were scanning, or allowed the scanning of characters, the length or the thickness of documents, since scanning did not necessarily mean that data was obtained.

This argument cannot be accepted. In colloquial English the verb "to scan" may have other connotations, such as "to glance over quickly". However, the term "scanning" in claims 1 and 15 is not standing on its own, the term must be interpreted in the context of the phrase "scanning of characters, the length or the thickness from the scanned documents". Directing a beam of light on a passing document may be called "scanning said document", it cannot fairly be said that, by merely beaming light onto a document, characters are detected, or that the length or thickness of the document is measured.

- 3.4 It follows from the above, that the subject-matter of claims 1 and 15 of the fourth auxiliary request is novel within the meaning of Article 54 EPC with respect to document D13.

4. The sole reason for revoking the patent was that the Opposition Division was of the opinion that the grounds for opposition mentioned in Article 100(a) EPC (lack of novelty, Article 54 EPC) prejudiced the maintenance of the patent.

Since the other ground for opposition, lack of inventive step, Article 56 EPC, raised by the respondents I and II and mentioned in Article 100(a) EPC, was not examined by the Opposition Division, the Board considers it appropriate to make use of its discretionary powers under Article 111(1) EPC and to remit the case to the Opposition Division for further prosecution.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the Opposition Division for further prosecution.

The Registrar:

The Chairman:

M. Dainese

W. Moser