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D E C I S I O N
of 11 November 2005

Case Number: T 0272/02 - 3.5.01

Application Number: 92116816.7

Publication Number: 0536640

IPC: G06K 17/00, B07C 3/18

Language of the proceedings: EN

Title of invention:
System for automatic printing of mail pieces

Patentee:
PITNEY BOWES INC.

Opponent:
NEOPOST LTD

Headword:
Automatic printing/PITNEY BOWES

Relevant legal provisions:
EPC Art. 56

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

Decisions cited:
-

Catchword:
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Beschwerdekammern | Boards of Appeal | Chambres de recours

Case Number: T 0272/02 - 3.5.01

D E C I S I O N
of the Technical Board of Appeal 3.5.01
of 11 November 2005

Appellant: (Opponent)
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Decision under appeal:
Decision of the Opposition Division of the European Patent Office posted 9 January 2002 rejecting the opposition filed against European patent No. 0536640 pursuant to Article 102(2) EPC.

Composition of the Board:

Chairman: S. Steinbrener
Members: W. Chandler
G. Weiss

Summary of Facts and Submissions

I. This appeal is against the decision of the opposition division to reject the opposition against European patent No. 0 536 640.

The opposition division held that claim 1 of the granted patent involved an inventive step having regard inter alia to document:

OD1: EP-A-0 282 359

II. The appellant (opponent) lodged an appeal against the decision and paid the prescribed fee. Following a communication from the Board setting out the issues to be discussed, the respondent (patent proprietor) filed claims for first to third auxiliary requests.

III. Oral proceedings, requested by both parties, were held on 11 November 2005. At the oral proceedings, the appellant requested that the decision under appeal be set aside and the patent revoked.

The respondent requested that the appeal be dismissed (main request), or alternatively that the decision under appeal be set aside and that the patent be maintained on the basis of the first auxiliary request filed with the letter dated 7 October 2005, or the second or third auxiliary request submitted at the oral proceedings.

At the end of the oral proceedings, the Chairman announced the Board's decision.

IV. Claim 1 of the main request reads as follows:

"A system for printing a sequence of mail pieces each including one or more pages and an envelope, said system comprising:

a printer (20) for printing text in response to input of signals, said printer having a capability to selectively print on either sheets (S) or envelopes (E); and
control means (40) for outputting a sequence of said signals representative of material to be printed on said sheets to form said pages, said sequence including subsets of signals representative of addresses for said mail pieces, said control means further comprising:

(i) means for scanning said sequence of signals for identifying said subsets from inherent characteristics of said subsets;

characterised in that said control means comprises further:

(ii) conversion means, responsive to said identifying means, for converting said subsets into new sequences representative of said addresses and automatically identifying subsequences of said signals corresponding to said pages of said mail pieces; and
(iii) means for inserting said new sequences into said sequence adjacent to corresponding subsequences to form an expanded sequence of signals and for outputting said expanded sequences to said printer to print said material on said sheets to form said pages and to print said addresses on said envelopes, said envelopes being

output adjacent to corresponding pages by said printer (20)."

Claim 1 of the first auxiliary request replaces, in feature (ii) of claim 1 of the main request, the words "representative of said addresses and" by "for causing the printer to print said addresses on said envelopes when the new signal sequences are applied to the printer, and for"

Claim 1 of the second auxiliary request adds to the second feature of claim 1 of the main request the words "to be stored in a page buffer," after the words "to form said pages,", and adds in feature (i) the words "stored in said page buffer," after the words "means for scanning said sequence of signals".

Claim 1 of the third auxiliary request adds to the main request the amendments of both the first and second auxiliary requests.

V. The appellant argued as follows:

OD1 disclosed a rather complicated system for preparing and processing letters. Nevertheless, it achieved in passing the object of the invention, namely printing envelopes adjacent to the corresponding mail pieces.

OD1 disclosed all the features of claim 1 of all requests. In particular, the claimed input sequence "representative of material to be printed", the new sequences "representative of said addresses", and the "expanded sequence" for outputting to the printer were all implicit from the function of OD1. If there were

any differences, they would be obvious matters of design in view of the function of the system.

VI. The respondent argued as follows:

The description in the patent at column 3, lines 30 to 40 meant that the starting point for the invention was the conventional "print job" comprising a number of mail pieces to be printed. Traditionally, each mail piece was printed and put in a window envelope such that the address was visible. The invention enabled automatic printing of envelopes with the address derived from the mail pieces without the need to input format information.

OD1 was complicated and difficult to understand. However it must be interpreted as the skilled person would have done, and not with a knowledge of the invention. The basic idea was to scan an incoming mail piece for the sender's address and to print out a letter of reply and an envelope with the corresponding address.

Claim 1 differed from OD1 in the following ways:

i) The use of a single printer. OD1 disclosed, at column 20, lines 38 to 46, the use of multiple printer modules. This could mean that one printer printed letters and the other printed envelopes.

ii) The control means outputted a sequence of the input signals that was "representative of material to be printed on said sheets to form said pages".

Firstly, this expression meant that the sequence of signals of the invention was different from the signals in OD1 because it was in a form ready for printing the letter, whereas in OD1 it originated from the scanning module (Figure 2a: 12) and needed further formatting. This also led to a further difference in that the "new sequences" of the invention were not disclosed in OD1. This was because the "new sequences" were "representative of said addresses", meaning that they were also in a form ready for printing on the envelope, and thus must have been formatted only once, whereas in OD1 the reformatting program shown in Figure 2b changed the position of the addresses and implied a double formatting of the address data.

Secondly, the input sequence was a single "print job" containing multiple mail pieces. This was supported by the fact that the patent disclosed, at column 1, line 58, that the system was suitable for generating mailings of a few to a few hundred mail pieces, and also, at column 3 lines 31 to 32, that the sequence of pages represented sheets in mail pieces in the plural. OD1 did not process, or even mention, such a sequence, but only processed individual mail pieces.

iii) The initial print run was converted into a final print run, the "expanded sequence", comprising mail piece, envelope, mail piece, envelope etc.
Firstly, it was not certain that the letters and envelopes in OD1 were printed in this order; they could be printed in some other order and selected in the correct order.

Secondly, as for difference ii) above, OD1 did not disclose a single print job containing multiple mail pieces.

iv) The addresses were identified from their inherent characteristics, whereas OD1 did not mention, at column 16, lines 20 to 62, or column 33, lines 17 to 48, how this was done.

v) The sequence of signals, namely what was to be printed, was scanned to identify the addresses. The system of OD1 scanned the incoming letters that were to be replied to and not the letters that were to be printed.

None of the auxiliary requests changed the intended substance of the claims, but contained clarifications in case the Board did not accept the respondent's interpretation of the features of the main request.

The amendment in claim 1 of the first auxiliary request was a response to point 6 of the Board's communication, and defined that the new signal sequences contained the formatting information necessary to print the addresses on the envelopes, making explicit difference ii), discussed above.

The amendment in claim 1 of the second auxiliary request was a response to point 9 of the Board's communication, and defined that the expanded sequence represented a single sequence (print job) containing multiple mail pieces and envelopes, also making explicit difference ii), discussed above.

Reasons for the Decision

1. The appeal complies with the requirements referred to in Rule 65(1) EPC and is, therefore, admissible.

2. The introductory part of the patent states that the invention relates to a system for printing mail pieces each including one or more pages and an envelope. Claim 1 defines that this is achieved essentially by scanning the sequence of signals representing the mail pieces to identify the (recipients') addresses. Data representing the addresses is then added adjacent to the corresponding mail pieces, so that the printer can print the envelopes next to the corresponding pages of the mail pieces.

Main request

3. It is common ground that claim 1 differs from OD1 at most by the five features mentioned by the respondent (see point VI, above).

4. Concerning alleged difference i), the Board cannot agree with the respondent's suggestion that OD1 might only disclose the use of a plurality of printers. The passage cited by the respondent (column 20, lines 38 to 46) states that the apparatus includes "one or more printing modules represented by the module 200" in Figure 2d of OD1. The "printing module 200" is described as a conventional standalone device. This clearly includes the possibility of having a single printer as claimed, especially since printers for printing both sheets and envelopes are disclosed as

conventional in the introductory part of the patent and in the embodiment of the invention.

5. Concerning alleged difference ii), as far as the formatting is concerned, the Board judges that the expression "representative of material to be printed …" could relate equally to content as well as format. Thus, it does not imply that the input signal necessarily has exactly the right form to be printed, but only that it has the correct information. This also applies to the expression "representative of said addresses".
Nevertheless, the Board also judges, firstly, that if the input sequence originates from the applications software module 80 in OD1 (Figure 2a), which can be a conventional word processor (see point 8, below), it would in fact be in a form ready for printing. Secondly, in connection with the reformatting, OD1 discloses at column 16, lines 36 to 39, that the input data, including data from the word processor, is reformatted "as needed". If the data from the word processor were already in the correct format, reformatting would not be needed and there would be no double formatting, contrary to the respondent's allegation.

6. Concerning the nature of the "sequence of signals", the Board judges that claim 1 is not limited only to the respondent's interpretation of single "print jobs" containing multiple mail pieces.
Firstly on the wording alone, individual mail pieces each including one or more pages and an envelope would make up the "sequence of mail pieces" defined in the opening part of the claim and would also be one that is "representative of material to be printed on said

sheets to form said pages", as claimed in the second feature.

Secondly, the Board also doubts that the respondent's interpretation is supported by the originally filed description. The respondent relied on the fact that the description (e.g. column 3, lines 31 to 32) referred to "a sequence of pages representing printed sheets to be comprised in mail pieces", which specified mail pieces in the plural. However, the Board judges that the passage only defines that the sequence contains pages in the plural, such pages being present in mail pieces in general, i.e. in one or more mail pieces. Moreover, the sequence is mentioned in connection with a single mail piece at column 5, lines 56 to 58 of the patent. Thus although the description may cover a single sequence containing multiple mail pieces, such as the few hundred mail pieces described in the introductory part of the patent, the Board judges that it is not an unambiguous disclosure of exclusively such a print job.

7. Concerning alleged difference iii), namely the "expanded sequence", the relevant passages in OD1 at column 37, lines 8 to 16, and lines 46 to 49, cited in the decision under appeal, disclose that the envelope is "fed" followed by the letter sheets. Since the passage at column 20, line 63 to column 21, line 5 describes that the stationary items are fed directly to the printer, the Board judges, contrary to the respondent's view, that this requires that the letters and envelopes are printed in this same order. This in turn implies that printer receives a signal that falls under the definition of the "expanded signal" in the claim.

Moreover, for the same reasons as given in connection with the input sequence (see point 6, above), the Board judges that the "expanded sequence", containing the mail pieces and the envelopes, is also not limited to the respondent's definition of a print job, but also covers individual mail pieces.

8. Concerning alleged difference v), the Board cannot agree that OD1 does not disclose that the sequence of signals, namely what is to be printed, is scanned. Although much of the document deals with the case that the input to the computer 120 in Figure 2b originates from the scanning module 12 in Figure 2a, which scans the received letter, OD1 also discloses, at column 16, lines 31 to 47 that the computer analyses data from an applications software module 80, in particular for addresses. According to column 15, lines 1 to 3, this software module can be a conventional word processor.

9. Concerning alleged difference iv), even if the Board accepts the respondent's argument that the claim implies identifying the addresses from their inherent characteristics, although the claim only specifies identifying subsets (representative of addresses), and further accepts that although OD1 mentions, at column 16, lines 43 to 47, identifying addresses and identifying zip codes but not explicitly identifying the addresses from the zip codes, the claim only differs from OD1 in that the addresses are identified from their "inherent characteristics".

10. The Board judges that this sole difference between claim 1 and OD1 would solve the problem of identifying the addresses. However, the Board judges that faced

with the general problem of identifying something, the skilled person would obviously consider characteristics of the object itself, which fall under the claimed "inherent characteristics". Moreover, since OD1 mentions identifying "zip code parts", which are "inherent characteristics" of the address, it would be obvious to consider using these parts to identify the addresses. The Board therefore judges that this feature could not involve an inventive step.

11. The Board therefore judges that claim 1 of the main request does not involve an inventive step (Article 56 EPC).

Auxiliary requests

12. The Board judges that the amendments to claim 1 in the first to third auxiliary requests are all clarifications that correspond to the respondent's arguments in connection with the main request. The amendments therefore are all immediately understandable, and do not raise any new issues. Moreover, the appellant did not object to their filing. The Board accordingly uses its discretion to admit the new requests.

13. Claim 1 of the first auxiliary request aims, by specifying that the new sequences cause the printer to print the addresses on the envelopes when applied to the printer, to distinguish the nature of the sequences in the invention from OD1. However, as explained above (see point 5), the Board judges that there is no difference if the data originates from the word processor. The Board therefore judges that this feature

does not add anything new, so that this request is also not allowable (Article 56 EPC).

14. Claim 1 of the second auxiliary request aims, by specifying that the original input sequence is stored in a page buffer, to define that the input sequence is a single print run containing multiple mail pieces as described above. However, notwithstanding the fact that the Board doubts that this interpretation of the input signal is supported in the description (see point 6, above), the Board judges that the use of a page buffer to store data to be processed and/or printed is conventional and thus implicit in OD1. The Board therefore judges that this feature does not add anything new, so that he finding in respect of the preceding request again applies.

15. Claim 1 of the third auxiliary request contains the amendments of the first and second auxiliary requests. It is therefore not allowable for the reasons given in connection with those requests.

16. There being no other requests, it follows that the patent must be revoked.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.

2. The patent is revoked.

The Registrar: The Chairman:

P. Guidi S. Steinbrener