BESCHWERDEKAMMERN DES EUROPÄISCHEN PATENTAMTS

BOARDS OF APPEAL OF THE EUROPEAN PATENT OFFICE

CHAMBRES DE RECOURS DE L'OFFICE EUROPEEN DES BREVETS

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 14 July 2004

Case Number: T 0314/02 - 3.5.2

Application Number: 94308431.9

Publication Number: 0653249

IPC: B07C 1/00

Language of the proceedings: EN

Title of invention:
On-line sorting for an inserter system

Patentee:
PITNEY BOWES INC.

Opponent:
NEOPOST LTD

Headword:
-

Relevant legal provisions:
EPC Art. 54, 56

Keyword:
"Novelty (yes)"
"Inventive step (no)"

Decisions cited:
-

Catchword:
-

Europäisches Patentamt | European Patent Office | Office européen des brevets

Beschwerdekammern | Boards of Appeal | Chambres de recours

Case Number: T 0314/02 - 3.5.2

D E C I S I O N
of the Technical Board of Appeal 3.5.2
of 14 July 2004

Appellant: (Opponent)
NEOPOST LTD
South Street
Romford
Essex RM1 2AR (GB)

Representative:
Weinmiller, Jürgen, Dipl.-Ing.
SPOTT & WEINMILLER
Lennéstrasse 9
D-82340 Feldafing (DE)

Respondent: (Proprietor of the patent)
PITNEY BOWES INC.
World Headquarters
One Elmcroft
Stamford
Connecticut 06926-0700 (US)

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

Decision under appeal: **Decision of the Opposition Division of the European Patent Office posted 25 January 2002 rejecting the opposition filed against European patent No. 0653249 pursuant to Article 102(2) EPC.**

Composition of the Board:

Chairman: W. J. L. Wheeler
Members: J.-M. Cannard
B. J. Schachenmann

Summary of Facts and Submissions

I. The opponent appealed against the decision of the opposition division rejecting the opposition filed against European patent No. 0 653 249.

II. The following prior art documents:

D2: US-A-4 570 922, and

D3: EP-A-0 102 699,

cited in support of the opposition remain relevant to the present appeal.

III. Claim 1 of the patent in suit as granted reads as follows:

"An inserter based system for automated sorting of mailpieces in accordance with predetermined postal discount requirements, comprising:

an inserter (8) for assembling the mailpieces;

a sorter (110) coupled to said inserter, said sorter including a plurality of sorting bins (120);

a sorter controller (111); and

means for communicating mailpiece data and configuration data to said sorter controller, said sorter controller (111) being arranged to control the sorting of mailpieces received from said inserter (8)

into sort groups according to postal discount requirements;

characterised in that said sorting bins (120) are on-edge sorting bins, said sorter controller is included in said sorter and a scanner (22) in said inserter is arranged to scan codes printed on the mailpieces, said mailpiece data communicating means comprising an inserter controller (12) of said inserter arranged to send data obtained from said scanned codes to said sorter controller, said sorter controller being arranged to use data from said scanned codes for sorting the mailpieces to designated sort bins."

Claims 2 to 4 are dependent on claim 1.

IV. Oral proceedings were held on 14 July 2004.

V. The arguments of the appellant opponent can be summarised as follows:

The inserter based system according to claim 1 was not novel, or was obvious, having regard to the disclosure of document D3. The recipient's address, and thus the postal code or zip code, of the mailpieces processed by the system disclosed in D3 were printed on the control documents scanned in the inserter of this system. This followed from the fact that the control documents formed the cover sheets of the mailpieces and were stuffed into envelopes with the addresses showing through the windows of the envelopes. The zip codes on the control documents, which were necessary for the central processor of the system to control the printing of the postage on the envelopes of the mailpieces

through the accessory interface circuit, had to be scanned by the scanner of the inserter. The multi-level stackers according to D3 had different levels and formed a sorter which was arranged for sorting the mailpieces in response to an activation from the accessory interface circuit. The system recited in claim 1 differed from the system disclosed in D3 only in that it comprised on-edge sorting bins (instead of the stackers) and was arranged for sorting the mailpieces according to postal discount requirements. The idea of sorting mailpieces according to postal discount requirements was not novel and its implementation in the system of D3 did not require any modification of said system. The choice of on-edge sorting bins did not contribute to the solution of the technical problem and should not be considered when assessing inventive step.

Document D2 disclosed a sorting machine having on-edge sorting bins for sorting mailpieces according to postal discount requirements. The skilled man, using the sorter of D2 in the system of D3, would arrive at the system according to claim 1 in an obvious way.

VI. The arguments of the respondent proprietor can be summarised as follows:

The system according to claim 1 was distinguished over the prior art documents, and more particularly over the disclosure of document D3, in at least four different respects.

According to D3, the scanner in the inserter scanned control documents which were part of the documents

stuffed into the envelopes, but did not scan the mailpieces themselves.

In D3, the coded marks on the control documents contained information used by the inserter to assemble the mailpieces, but there was no indication of zip codes printed on the control documents. The use of windowed envelopes in D3 was only an alternative to the use of envelopes having addresses printed thereon and did not imply control documents having zip codes which should be scanned.

The multilevel stackers in D3 separated incomplete collations from complete collations by providing an offset in stacking, but they did not constitute a sorter having a plurality of on-edge bins nor were they controlled for sorting mailpieces according to any other criteria.

D3 did not disclose or suggest sorting the mailpieces according to their destination to benefit from postal discounts.

In the machine of D3, the control documents provided to the inserter were already organized according to their destination. A sorting of the mailpieces was not necessary, or might be made manually according to the instructions of an operator observing the zip markers printed on the mailpieces which indicated transitions from a given zip code to another one. If an automatic sorting of the mailpieces was found necessary, the skilled person would have used a scanner in the multi-level stackers as this is disclosed, for instance, in D2.

VII. The appellant (opponent) requested that the decision under appeal be set aside and the European patent No. 0 653 249 be revoked.

VIII. The respondent (patentee) requested that the appeal be dismissed and the patent be maintained.

Reasons for the Decision

1. The appeal is admissible.

2. Document D3 (see in particular Figures 1 and 2) discloses a system comprising an inserter (13) for assembling mailpieces, a postage meter (78) for applying the required postage thereon and multi-level power stackers (82, 84, 86, 88, 90, 92 and 94) for sorting various completed collations (page 5, lines 3 to 27).

2.1 A scanner (29) in the inserter is arranged to scan "coded marks" on control documents (27) (page 3, lines 15 to 18). The codes on the control documents read by the scanner may be used to select the appropriate feeders of the inserter as described by the code (page 9, lines 10 to 15). However, the control documents with the recipient's address printed thereon are placed on the top of the collated documents and stuffed into envelopes with the addresses showing through the windows of the envelopes (page 19, lines 10 to 19). Since windowed envelopes are used, the addresses printed on the control documents necessarily contain postal codes or zip codes, which, after the

documents have been stuffed into the envelopes, constitute codes printed on the resulting mailpieces. As argued by the appellant, the expression "coded marks" in D3, in the absence of any specific definition, has such a broad meaning that it would be understood by a skilled person as covering the zip codes printed on the control documents.

2.2 According to D3, the scanner interface circuit (160), the supervisory control circuit (100) and the accessory interface circuit (105) are linked together by a signal bus (96) (Figure 3). The scanned "coded marks" are transmitted by the scanner interface circuit (160) to the central processor or supervisory control circuit (100), also when the inserter is in a non-sequence run mode (page 9, lines 10 to 13; page 18, lines 17 to 20). The zip codes thus may be transmitted to the accessory interface circuit.

2.3 At lines 20 to 23 on page 6 of D3 it is stated: "In response to signals from the supervisory control circuit 100, the accessory interface circuit 105 provides output signals to various accessories such as postage meters 78 and 80, and the multi-level power stackers 82, 84-94". At lines 7 to 11 on page 17 of D3 it is explained that the accessory interface circuit (105) also "provides output signals to **activate** various accessories, such as postage meters..., and power stackers". The control documents (27) are fed **continuously** to the input burster-folder (24) (page 3, lines 15 to 17). The operator may select continuous operation of the inserter (page 17, lines 13 to 16), which then automatically advances the stuffed envelopes to the postage meter. According to the appellant, the

skilled person will directly and unambiguously understand from these explicit technical disclosures that the accessory interface circuit (105) receives the zip codes of the mailpieces because these codes are necessary at least for automatically determining and controlling the printing of the required postage by the postage meter (78). The proprietor argued that the control documents (27) provided at the burster-folder station (24) are pre-sorted according to their destination and that an automated control of the postage meter and stackers was not necessary in D3. However, the proprietor could not show where in the disclosure of D3 such a pre-sorting of the control documents, or a manual control by instructions of an operator of the metering and sorting operations, are described. No other explicit technical information in the disclosure of D3 contradicts the above explained technical interpretation of the disclosure of D3. The Board thus considers that the skilled person would automatically deduce from the explicit disclosure in D3 that, in the continuous operation mode of the mailing system, the zip codes on the control documents (27) are scanned in the inserter, received in the central processor (100), and transmitted to the accessory interface circuit (105).

2.4 The multi-levels power stackers (82, 84 to 94) which are used for sorting various completed collations perform the function of a sorter (D3, page 5, lines 24 to 27); they are controlled by the accessory interface circuit (105) which performs the function of a sorter controller. The scanner interface circuit (160) forms an inserter controller comprised in communicating means (control circuit (100) and signal bus (96)) which send

data obtained from the scanned codes to the sorter controller.

3. From the foregoing, it can be concluded that the inserter based system according to claim 1 differs from the system disclosed in D3 by three different features: a sorter having on-edge sorting bins; a sorter controller included in the sorter; and the sorter controller is arranged to use data from the scanned codes for sorting the mailpieces to designated sort bins according to postal discount requirements.

4. Starting from the prior art known from D3, the objective problem addressed by the invention could be seen as providing an automated sorting of the mailpieces that meets the postal service requirements for postal discounts. This corresponds to the technical problem identified in the patent specification (see paragraphs [0006] and [0007]).

4.1 No inventive step is involved in recognizing this problem which results from a requirement of the postal authorities and is known from the prior art, as is acknowledged in the patent specification, column 1, lines 16 to 22.

5. Document D2 (Figures 1 and 2; column 1, lines 12 to 28; column 3, lines 12 to 31; column 3, line 43 to column 4, line 15)) discloses a mail sorting machine in which the envelopes are conveyed on edge and are directed into on-edge bins in accordance with the zip codes printed on the envelopes under the control of an electronic circuit of the machine.

5.1 To solve the technical problem addressed by the invention, it is obvious for the skilled person starting from D3 to replace the multi-level power stackers by the sorting machine disclosed in D2 and to control this machine by the zip codes imprinted on the mailpieces, since these zip codes may be made available from the accessory interface circuit (105). The obvious combination of the inserter based system described in D3 and the sorter disclosed in D2 results in a system in which the sorter has on-edge sorting bins, comprises a sorter controller included in the sorter, and which is arranged to use data from the codes printed on the mailpieces and scanned in a scanner of the inserter for sorting the mailpieces according to postal discounts requirements, according to the features recited in the characterizing part of claim 1. Accordingly, the subject-matter of claim 1 is not to be considered as involving an inventive step within the meaning of Article 56 EPC.

6. The Board concludes therefore that the grounds for opposition mentioned in Article 100 EPC prejudice the maintenance of the patent.

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:

D. Sauter W. J. L. Wheeler