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D E C I S I O N
of 10 January 2006

Case Number: T 0397/03 - 3.5.02

Application Number: 92119800.8

Publication Number: 0543395

IPC: G07B 17/00

Language of the proceedings: EN

Title of invention:

Automatic selection of postage meter print element based on
mail class selection

Patentee:

Pitney Bowes Inc.

Opponent:

Francotyp-Postalia Aktiengesellschaft & Co. KG

Headword:

-

Relevant legal provisions:

EPC Art. 52(2), 56

EPC R. 76(1)

Keyword:

"Patentable invention - business features disregarded"

"Inventive step - yes"

"Text of requests filed at oral proceedings not contained in
the minutes"

Decisions cited:

-

Catchword:

-



Case Number: T 0397/03 - 3.5.02

D E C I S I O N
of the Technical Board of Appeal 3.5.02
of 10 January 2006

Appellant: Pitney Bowes Inc.
(Proprietor of the patent) World Headquarters
One Elmcroft
Stamford, CT 06926-0700 (US)

Representative: von Fischern, Bernhard
Hoffmann Eitle,
Patent- und Rechtsanwälte
Postfach 81 04 20
D-81904 München (DE)

Respondent: Francotyp-Postalia Aktiengesellschaft & Co. KG
(Opponent) Triftweg 21-26
D-16547 Birkenweder (DE)

Representative: Schaumburg, Thoenes, Thurn, Landskron
Patentanwälte
Postfach 86 07 48
D-81634 München (DE)

Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 21 January 2003
revoking European patent No. 0543395 pursuant
to Article 102(1) EPC.

Composition of the Board:

Chairman: W. Wheeler
Members: M. Ruggiu
P. Mühlens

Summary of Facts and Submissions

- I. The proprietor of the patent filed an appeal against the decision of the opposition division to revoke European patent No. 0 543 395.
- II. The following documents of the state of the art have been cited in the appeal:
- D1: EP-A-0 333 043;
- D2: DE-A-2 916 811; and
- D3: US-A-4 326 460.
- III. The decision under appeal indicated that the patent proprietor had filed a main request and first, second and third auxiliary requests during the course of oral proceedings before the opposition division held on 28 November 2002. However, no claims or amended pages of description according to the requests were appended to the minutes of the oral proceedings or to the decision of the opposition division. Following enquiries made by the board, the department of first instance sent the claims and amended pages of description according to the requests filed during the oral proceedings of 28 November 2002 to the board. As both the appellant (proprietor) and the opponent (respondent) had requested oral proceedings, the board issued a summons, dated 6 June 2005, to attend oral proceedings. Copies of the claims and amended description pages according to the requests, as forwarded by the department of first instance, were annexed to the summons. With a letter dated 1 September

2005, the respondent confirmed that the documents annexed to the summons were in accordance with the requests filed at the oral proceedings before the opposition division. The respondent also withdrew its request for oral proceedings and announced that it would not take part in the oral proceedings. With a letter dated 29 September 2005, the appellant confirmed that the documents annexed to the summons were in accordance with the requests filed at the oral proceedings before the opposition division. The appellant also filed a fourth auxiliary request and announced that, in view of the developments in the case, it too would not participate in the oral proceedings. The oral proceedings before the board took place in the absence of the parties on 30 November 2005.

- IV. The appellant (patentee) requests that the decision under appeal be set aside and that the patent be maintained in amended form in accordance with the main request or first to third auxiliary requests filed in the oral proceedings held on 28 November 2002 before the opposition division; or the fourth auxiliary request filed with letter dated 29 September 2005.
- V. The respondent (opponent) requests that the appeal be dismissed.
- VI. The version of the patent in accordance with the main request is as follows:

Description:

pages 2 and 5 of the main request filed during the oral proceedings of 28 November 2002 (annexed to the summons dated 6 June 2005 to attend oral proceedings before the board);

pages 3 and 4 of the printed patent specification.

Claims:

No. 1 to 6 of the main request filed during the oral proceedings of 28 November 2002 (annexed to the summons dated 6 June 2005 to attend oral proceedings before the board).

Drawings:

Sheets 9 to 16 of the printed patent specification.

VII. Claims 1 and 6 of the main request read as follows:

1. "A mail processing system having:
a postage meter (22) for dispensing postage and having printing means (24, 26) for printing postage information on an envelope;
microcomputer means (20) for accounting for postage dispensed by said postage meter (22) and having means for providing departmental accounting of said dispensed postage and means for controlling said printing means;
data entry means (7) for providing operator data to said microcomputer means (20);
memory means for storing carrier and carrier fee information;
memory means for storing permitted carrier and carrier fee sets for each department; and
said microcomputer means (20) being programmed to cause said microcomputer means to enable permitted carrier

and carrier fee sets in response to operator data entry through said data entry means (7) in accordance with an operator selected department account;
said printing means (24, 26) including a postal inscription mechanism (70) having a plurality of printing surfaces (72, 74, 76) providing respective mail carrier class indicia; and
said microcomputer means (20) being further programmed to cause said postal inscription mechanism (70) to position said respective printing surface for printing corresponding to the carrier class selected by the operator."

6. "A method of processing mail comprising the steps of:
dispensing postage and printing postage information on an envelope;
accounting for postage dispensed by said postage meter and providing departmental accounting of said dispensed postage;
storing carrier and carrier fee information;
storing permitted carrier and carrier fee sets for each department;
enabling permitted carrier and carrier fee sets in response to operator data entry in accordance with an operator selected department account; and
printing respective mail carrier class indicia corresponding to the carrier class selected by the operator by operating a postal inscription mechanism (70) having a plurality of printing surfaces (72, 74, 76) providing respective mail carrier class indicia, said postal inscription mechanism (70) positioning the respective printing surface for printing in

correspondence to the carrier class selected by the operator."

Claims 2 to 5 are dependent on claim 1.

VIII. The appellant essentially argued as follows:

D1 concerned a dispatch management system for processing parcels from different senders, routed to different recipients via different carriers. It was not obvious to adapt the system of D1, which related to parcels, to print postage information on an envelope. A franking machine 13 of the system of D1 was used solely for printing a franking impression for the national carrier, which was a single carrier. Additional printers of the system of D1 served for printing an indication of the carrier and the service selected for a particular parcel. Printings or indicia were technical features, in the same way that a standard franking indicia was a technical feature, so that differences in printings or indicia between D1 and claims 1 and 6 of the patent in suit were technical features and should not be disregarded. There was no justification for assuming that "service" as referred to in D1 corresponded with "class" as used in the patent in suit. The reason for entering the service in D1 was for calculating the franking amount, not for indicating the required postage class. Although D1 was very similar in structure to some features of claim 1 of the patent in suit, it differed in the functional inter-relationship between the recited integers. There was no explicit disclosure or suggestion in D2 that entering a particular class would cause not only the correct franking amount to be printed but also the

corresponding class indicia to be printed on the envelope. In other words, the device of D2 merely printed a mail type insignia ("Nachnahme", "Einschreiben", "Drucksache") independently of any franking impression to be printed. D2 and D3 disclosed a postage meter or franking machine capable of printing respective indicia indicative of different types of mail. However, a franking machine was used to print a franking impression pertaining to the national carrier and there was no suggestion in either reference for selectively printing such indicia for different carriers. Therefore, the skilled person would not be motivated by D2 or D3 to modify the system of D1 by adapting the franking machine printer for printing (carrier class) indicia for any other carrier than the national postal system, under microcomputer control.

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

A skilled person would not find any essential difference between the computer structure of the system of document D1 and the computer structure of the invention of the patent in suit. In particular, the meter unit 22 of the patent in suit was a peripheral unit of the microcomputer 20 in the same way as the franking machine 13 of D1 was a peripheral unit of the CPU 1. D1 disclosed all features of claim 1, except that the printing means included a postal inscription mechanism as specified in the claim and that the microcomputer means was programmed to cause this mechanism to position a respective printing surface for printing corresponding to the carrier class selected by the operator. The term "services" as used in D1

designated different possible types of mailing ("modes d'envois") and different possible mailing categories ("catégories d'envois") and therefore corresponded to the term "classes" as used in the patent in suit. Furthermore, the categories "printed matter" ("Drucksache") and "registered" ("Einschreiben") mentioned in document D2 attracted a special fee and were "classes" in the sense of the patent in suit. In a letter dated 22 July 2002, the respondent opponent had also submitted that it was known from D1 to select between different carriers associated with different fees and classes and it was not inventive to use the postal inscription mechanism known from D2 for printing data associated with different carriers. Nothing had to be changed in the known postal inscription mechanism. The microprocessor determined which data were printed. Whether these data were associated with a single carrier or with different carriers did not influence the structure of the postal inscription mechanism. In the case of different carriers, it was merely necessary to provide indicia identifying the different carriers on the printing surfaces of the mechanism.

Reasons for the Decision

1. The appeal is admissible.
2. As mentioned in paragraph III above, no claims or amended pages of description according to the requests filed by the patent proprietor on 28 November 2002, during the oral proceedings before the opposition division, were attached to the minutes of the oral proceedings, nor to the decision under appeal. Indeed,

they were not included in the European Patent Office file relating to the patent in suit at all. It is of course of utmost importance that the complete text of any request on which a decision is taken be properly included in the file of the application or patent in question. According to Rule 76(1) EPC, the minutes of oral proceedings should contain in particular the essentials of the oral proceedings and the relevant statements made by the parties. There is no doubt that the text of requests filed by a party at oral proceedings is an essential element that should be contained in the minutes. Thus, the minutes of the oral proceedings before the opposition division were not in conformity with Rule 76(1) EPC. However, since both parties have confirmed that the text obtained by the board and annexed to the summons is the one filed at the oral proceedings before the opposition division, there is no need to pursue the matter further.

3. Claim 1 of the main request corresponds to claim 1 as originally filed with editorial amendments. Claim 6 of the main request corresponds to claim 6 as originally filed with editorial amendments and the additional feature of operating a postal inscription mechanism having a plurality of printing surfaces providing respective mail carrier class indicia, said postal inscription mechanism positioning the respective printing surface for printing in correspondence to the carrier class selected by the operator. This additional feature was recited in claim 1 as filed. Claims 2 to 5 of the main request correspond to claims 2 to 5 as originally filed. The description has been amended for consistency with the claims and for acknowledging the background art known from document D1. Thus, the

amendments do not introduce subject-matter extending beyond the content of the application as filed (Article 123(2) EPC).

The protection conferred has not been extended (Article 123(3) EPC) because claims 1 and 6 of the main request differ from claims 1 and 6 as granted merely in that they are drafted in one-part form.

4. Document D1 relates to a system for processing the dispatch of parcels from various senders, whereby the parcels can be forwarded by different carriers, each of which may offer different services. The system of D1 includes programmed microcomputer means 3, 4, 5, data entry means 6 allowing an operator to enter data to the microcomputer means, memory means 21, 25, 26 storing carrier and carrier fee information, memory means 22 storing information identifying the carriers and the services permitted for each sender, and printing means 10, 11, 12 for printing various forms associated with the dispatch of the parcels, in particular labels and letters of transport ("lettres de transport"). The system of D1 may also include a postage meter 13 coupled to the microcomputer means, whereby the postage meter prints franking labels that represent postage value information, to be affixed on parcels forwarded by the national carrier ("la poste (transporteur public)") (see in particular column 3, lines 47 to 54 of D1). For each dispatch, the microcomputer means of D1 records an identification 65 of the sender, an identification 66 of the carrier and the total costs 80 for that dispatch in a file 20 (see in particular column 11, lines 29 to 33; column 12, lines 10 to 36; column 13, lines 2 to 10; and Figure 4 of D1). Thus, in

- a general sense, the system of D1 accounts for the costs incurred by each sender. It is implicit that these costs include the postage dispensed by the postage meter 13.
5. Claims 1 and 6 of the main request of the appellant specify providing departmental accounting of the dispensed postage. In the view of the board, there is no apparent reason why a "department" should not be considered as a "sender". In any case, the difference between providing accounting for each (individual) sender and providing departmental accounting lies in the present case entirely in the sphere of business organisation. Therefore, this difference relates to a scheme for doing business as such, which in accordance with Article 52(2) and (3) EPC is excluded from patentability and thus has to be disregarded when assessing whether the claimed subject-matter meets the patentability requirements specified in Article 52(1) EPC. In the judgment of the board, this also applies to the differences between the expressions "sender" and "service" as used in document D1 and "department" and "class", respectively, as used in claims 1 and 6 of the main request.
 6. It is apparent from the specification of the patent in suit, that the term "carrier class" is used in the patent in suit for identifying a carrier together with a class associated with that carrier. This may be deduced in particular from a passage at column 3, line 52, to column 4, line 3, where it is stated that: "Illustrated in Fig. 5 is a schematic of the carrier fee table structure which is preferably stored in the non-volatile memory (NUM) 21 of the microcomputer 20.

Represented within the enclosed area is the fee associated with the respective carrier (ABC through XYZ). Each carrier has a plurality of classes (e.g., Class A through AA). Each class has an associated range of fees (e.g., C1 through CN) associated with each class. As an example, Class BB may be assigned to a private carrier for two day service." Thus, the board construes the term "carrier class" as used in claims 1 and 6 of the main request as referring to both a particular carrier and a class associated with that carrier.

7. D1 discloses printing means 10, 11, 12 for printing various forms and a postage meter for printing franking labels, but not a postal inscription mechanism as specified in claims 1 and 6 of the main request.

The documents D2 and D3 relate to franking machines having postal inscription mechanisms with a plurality of printing surfaces carrying respective indicia. D2 and D3 do not disclose departmental accounting of the dispensed postage or memory means for storing permitted carrier and carrier fee sets for each department.

Thus, the subject-matter of claims 1 and 6 of the main request is considered to be new in the sense of Article 54(1) EPC.

8. The subject-matter of claim 1 of the main request differs from the prior art disclosed in D1 in that:

the printing means of the postage meter is able to print postage information on an envelope;

said printing means includes a postal inscription mechanism having a plurality of printing surfaces providing mail carrier class indicia; and

the microcomputer means is programmed to cause said postal inscription mechanism to position said respective printing surface for printing corresponding to the carrier class selected by the operator.

These features are directed to the processing of mail contained in envelopes, which can be handled according to different carrier classes.

9. Since the system disclosed in D1 processes parcels, it is questionable whether the skilled person would consider processing mail contained in envelopes in such a system. However, the board has examined what would be the result of an adaptation of the system of D1 to the processing of mail contained in envelopes, i.e. letters, in a situation as envisaged in the patent in suit where the mail can be transported by different carriers.
10. In the system of D1, the postage meter 13 concerns a single, national carrier ("la poste (transporteur public)") and prints a franking label only when the national carrier has been selected. In the judgment of the board, it is not obvious to use that postage meter, which is reserved to the national carrier, to print an indication of another carrier selected by the operator. Documents D2 and D3 disclose printing mechanisms contained in postage meters and do not refer to different carriers. Taking into account that postage meters or franking machines are normally reserved for a single carrier, it is apparent that D2 and D3 do not

concern situations in which mail can be transported by different carriers. It follows that it is not obvious to include in the printing means of the postage meter of D1 a postal inscription mechanism relating to a plurality of carriers. Since claim 1 of the main request specifies a plurality of printing surfaces providing respective mail carrier class indicia, the board concludes that, on its proper construction and having regard to the cited state of the art, its subject-matter is not obvious to a person skilled in the art. The subject-matter of claim 1 of the main request is therefore considered as involving an inventive step in the sense of Article 56 EPC.

The subject-matter of claims 2 to 5 of the main request, which depend on claim 1, is also considered to be new and involve an inventive step.

11. Although claim 6 of the main request mentions a postage meter, it does not state that the postal inscription mechanism is included in the postage meter.

Claim 6 of the main request differs from the prior art disclosed in document D1 in that:

postage information is printed on an envelope, and

respective mail carrier class indicia corresponding to the carrier class selected by the operator is printed by operating a postal inscription mechanism having a plurality of printing surfaces providing respective mail carrier class indicia, said postal inscription mechanism positioning the respective printing surface

for printing in correspondence to the carrier class selected by the operator.

These features aim at processing mail contained in envelopes, which can be handled according to different carrier classes.

12. Starting from the prior art disclosed in D1, in order to arrive at the method defined in claim 6 of the main request, the skilled person would, as a first step, have to consider adapting the system of D1 to process mail contained in envelopes, i.e. letters. Then, as a second step, the skilled person would have to consider printing carrier mail indicia by operating a postal inscription mechanism as specified in claim 6. It is apparent from D1 that the printed forms, in particular labels and letters of transport, associated with a particular parcel must carry indications of the selected carrier and class for that parcel, so that the printing means 11, 12 that fill in the forms must be able to print carrier class indicia in the sense of the patent in suit. There seems therefore to be no need in the system of D1 for a specialised postal inscription mechanism printing an indication of a carrier class. The requirements for the printing means 11, 12 of D1 could be met by general-purpose printing means. D2 and D3 are not concerned with different carrier classes (in the sense of the patent in suit), but only with classes of a single carrier. The board therefore doubts whether it would be obvious to the skilled person to provide the system of D1 with a postal inscription mechanism of the type described in documents D2 and D3 and use this mechanism for printing carrier class indicia in the sense of the patent in suit.

As appears from Article 102 EPC, a granted European patent can only be revoked in opposition or appeal proceedings if the opposition division or the board of appeal is of the opinion that the grounds for opposition laid down in Article 100 EPC prejudice the maintenance of the European patent; otherwise the patent shall be maintained. Thus, a patent shall be revoked only if it is clearly and unambiguously established that one or more grounds for opposition prejudice its maintenance. Therefore, in a situation like the present one, in which there are unresolvable doubts as to whether the steps necessary to arrive at the invention would be obvious to the skilled person, the decision should be in favour of maintaining the patent. In view of this situation, the board concludes that the subject-matter of claim 6 of the main request can be considered as involving an inventive step in the sense of Article 56 EPC.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the first instance with the order to maintain the patent as amended in the following version:

Description:

pages 2 and 5 of the main request filed during the oral proceedings of 28 November 2002 (annexed to the summons dated 6 June 2005 to attend oral proceedings before the board);

pages 3 and 4 of the printed patent specification.

Claims:

No. 1 to 6 of the main request filed during the oral proceedings of 28 November 2002 (annexed to the summons dated 6 June 2005 to attend oral proceedings before the board).

Drawings:

Sheets 9 to 16 of the printed patent specification.

The Registrar:

The Chairman:

U. Bultmann

W. J. L. Wheeler