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Datasheet for the decision of 4 July 2007

Case Number: T 1159/05 - 3.2.05

Application Number: 96938524.4

Publication Number: 0820387

IPC: B43M 5/04

Language of the proceedings: EN

Title of invention:
Mailing system controlled by computer software

Patentees:
Prinserter Corporation and ISHIKAWA, Yuji

Opponents:
01. NEOPOST LTD
02. Pitney Bowes, Inc.

Headword:
-

Relevant legal provisions:
EPC Art. 54, 56
EPC R. 80

Keyword:
"Novelty - yes"
"Inventive step - no"

Decisions cited:
-

Catchword:
-

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Case Number: T 1159/05 - 3.2.05

D E C I S I O N
of the Technical Board of Appeal 3.2.05
of 4 July 2007

Appellant: (Opponent 02)	Pitney Bowes, Inc. World Headquarters, One Elmcroft Road Stamford, CT 06926 0700 (US)
Representative:	Avery, Stephen John Hoffman Eitle, Patent- und Rechtsanwälte Arabellastraße 4 D-81925 München (DE)
Respondents: (Patent Proprietors)	Prinserter Corporation Sandringham House 83 Shirley Street Nassau, New Providence (BS) ISHIKAWA, Yuji Osterather Straße 6 D-40547 Düsseldorf (DE)
Representative:	-
Other Party: (Opponent 01)	NEOPOST LTD South Street Romford, Essex, RM1 2AR (GB)
Representative:	Weinmiller, Jürgen Spott, Weinmiller & Böhm Patentanwälte Lennéstraße 9 D-82340 Feldafing (DE)
Decision under appeal:	**Decision of the Opposition Division of the European Patent Office posted 7 July 2005 rejecting the opposition filed against European patent No. 0820387 pursuant to Article 102(2) EPC.**

Composition of the Board:

Chairman: W. Zellhuber
Members: H. Schram
M. J. Vogel

Summary of Facts and Submissions

I. The appellant (opponent 02) lodged an appeal against the decision of the Opposition Division posted on 7 July 2005 rejecting its opposition against European patent No. 0 820 387 as a whole, based on Article 100(a) EPC (lack of novelty, Article 54 EPC, lack of inventive step, Article 56 EPC) and Article 100(b) EPC (insufficiency of disclosure, Article 83 EPC).

II. The appellant requested that the decision under appeal be set aside and that the patent be revoked.

III. With letter of 10 March 2006 the professional representative of the respondents (joint patent proprietors, Prinserter Corporation having its place of business in New Providence, Bahamas, and Yuji Ishikawa having his place of residence in Düsseldorf, Germany) laid down the representation. The European Patent Office sent an invitation to give notice of appointment of a professional representative on 23 March 2006 to the first mentioned patent proprietor, which letter came back as undeliverable. A copy of said invitation was sent for information only to the second mentioned patent proprietor on 17 July 2006, which letter also came back as undeliverable. A second attempt to deliver the letter dated 23 March 2006 to the first mentioned patent proprietor made on 3 August 2006 was unsuccessful.

Public notification pursuant to Rule 80 EPC was effected by means of publication in the European Patent Bulletin No. 41 of 11 October 2006 of the following text "Undeliverable Mail, addressee unknown -

Prinserter Corporation, Sandringham House, 83 Shirley Street, Nassau, New Providence, BS - EPO Munich".

IV. Neither the respondents nor the party to the appeal proceedings as of right (opponent 01) filed any submission or request in the appeal proceedings.

V. Claim 1 as granted reads as follows:

"1. An integrated on-line printing and post-processing system comprising the following components:

a) a printer (12) associated through a controller unit (32) with the computer unit (10) for selectively printing a sheet to be mailed;

b) a transfer unit (14) connected to the printer (12) and a manual tray (68) for transferring the sheet to a folding station under actuation with a first sensing means (70);

c) a folding unit (16) connected in series to the transfer unit (14) for accumulating, folding and feeding the sheet under actuation with a second sensing means (78);

d) a conveyor unit (18) arranged in association with the folding unit (16) for conveying the folded sheet with a selectively added enclosure to an insertion station;

e) an enclosure supplying unit (28) associated with the conveyor unit (18) for selectively supplying an enclosure to the conveyor unit (18) for addition to the sheet under actuation with a third sensing means (214);

f) an envelope tray means (20) associated with the conveyor unit (18) for stacking a plurality of empty envelopes and feeding the same by piece with

means for engaging with and turning over a flap of the envelope while leaving the tray (20);

g) an insertion unit (22) arranged between the conveyer unit (18) and the envelope tray means (20) for inserting the sheet into the envelope and subsequently transferring the enclosed envelope to a sealing station;

h) a sealing unit (24) associated with the insertion unit (22) for closing and sealing the flap;

i) a receiver unit (26) disposed in abutment with the sealing unit (24) and in association with the enclosure feeding unit (28) for receiving and storing the sealed envelopes; and

j) a computer unit (10) for instructing and commanding each component (a to i) of the system for selective and controlled operations of the whole system by use of software programs by previously inputting commands and parameters to operate each component (a to i) of the system;

k) a printer controller (32) for controlling the print job of the printer (12);

l) an inserter controller (34) for controlling the operation of each component (b to i); and

m) a host controller (30) to which each of the printer controller (32) and the inserter controller (34) is independently connected for interactive communitation with each of the printer controller (32) and the inserter controller (34), and which host controller (30) is connected to the computer unit (10)."

Independent claim 27 is directed to "A method of controlling an integrated on-line printing and post-

processing system according to any one of preceding claims ...".

VI. The following documents were *inter alia* referred to in the appeal proceedings:

D1 EP-A 0 406 976

D2 US-A 5,283,752

VII. The appellant argued in writing essentially as follows:

The subject-matter of claim 1 lacked novelty having regard to document D2. In the decision under appeal the Opposition Division held that the following features distinguished the integrated on-line printing and post-processing system according to claim 1 as granted from the system for preparing items to be mailed known from document D2: the system according to claim 1 comprised a separate printer controller, and independent connections between the host controller and each of the printer controller and the inserter controller for interactive communication with each other were provided. However, both features were already disclosed in document D2 as follows. It was implicit for the person skilled in the art that the printer used in the system for preparing items to be mailed shown in Figure 2 of document D2 had a controller. Whether or not the printer controller was shown as a separate unit or was subsumed within block 4 illustrating the printer as part of the mail preparation unit was irrelevant (see column 5, lines 43 to 51).

The subject-matter of claim 1 lacked novelty having regard to document D1 for substantially the same reasons, because the disclosure of document D1 was very similar to the disclosure of document D2.

The subject-matter of claim 1 did also not involve an inventive step having regard to document D1 or D2.

Reasons for the Decision

1. According to the EPO patent register the patent in suit had lapsed in the designated Contracting States AT, BE, DE, DK, ES, FI, FR, GB, IE, LU, NL, PT and SE on 31 December 2003. There is no information in the EPO patent register that the patent in suit has lapsed in the designated Contracting States CH, LI and IT however (position as of date of this decision). Since the Board was unable to establish that the patent in suit has lapsed in the Contracting State IT, it sees no basis for taking the steps pursuant to Rule 60(1) EPC in conjunction with Rule 66(1) EPC for terminating the appeal proceedings.

2. *Objection of lack of novelty (Article 54 EPC)*

Document D1 is cited in paragraph [0002] of the description of the patent in suit. According to said paragraph, this document discloses a system for preparing items to be mailed comprising components a) to i) of claim 1 as granted. The system according to document D1, which is an integrated on-line printing and post-processing system in the sense of claim 1 as granted, is responsive to instructions for controlling

the printer and the mail preparation stations, including the transport of envelopes and the inserter system 1 (see column 8, line 55, to column 9, line 10). The system is interactive in the sense that the course of envelopes and sheets can be monitored by means of signals applied to the control unit 18 (see column 9, lines 46 to 50).

Document D1 further discloses (see Figure 1) a control unit 18 ("host controller") functionally interposed between the data processing apparatus 17 ("computer unit") and the system components (printer, inserter, ...). The control unit 18, which is connected to the data processing apparatus 17, is *inter alia* used for operating the inserter system (see column 9, lines 4 to 10). It follows that the inserter controller is integrated in the control unit 18. The control unit 18 has also the function of giving printing instructions to, and thus of controlling, the printer, see the passage on column 8, line 57, to column 9, line 4): *For converting printing instructions coming from the data processing apparatus 17 into separate printing instructions for the two printers 6 and 7, a control unit 18 is interposed which is connected to those two printers by means of lines 19 and 20*. It may be noted that claim 1 of the patent in suit does not specify where the printer controller is physically located (e.g. it may be accommodated in the housing of the printer, or together with the host controller and the inserter controller in a common housing, or in its own housing). The preparation of items to be mailed can be entirely controlled by the data processing apparatus 17, see column 9, lines 54 to 56.

It follows that document D1 discloses components j), k), l) of claim 1 as granted as well as a host controller which is connected to the computer unit (cf. the last feature for component m) reiterated in claim 1 as granted).

The functional arrangement between the host-, printer- and inserter controller as claimed in claim 1 as granted (cf. the first feature for component m) in claim 1 as granted) is not disclosed in document D1.

The subject-matter of claim 1 is thus novel in the meaning of Article 54 EPC with respect to document D1.

3. *Objection of lack of inventive step (Article 56 EPC)*

3.1 Document D1 represents the closest state of the art. The subject-matter of claim 1 differs from the system for preparing items to be mailed known from document D1 in that the system according to claim 1 comprises "a host controller (30) to which each of the printer controller (32) and the inserter controller (34) is independently connected for interactive communication with each of the printer controller (32) and the inserter controller (34)" (cf. the first feature for component m) in claim 1 as granted).

3.2 This distinguishing feature describes in functional terms the "block diagram" of Figure 2 of the patent in suit showing a control system for the printing and insertion units according to the present invention. In particular, the host controller is connected to the computer unit and with each of the printer controller and the inserter controller. The double arrows between

the host controller 30, printer controller 32 and inserter controller 34 in Figure 2 indicate that the "host controller (30) is independently connected for interactive communication with each of the printer controller (32) and the inserter controller (34)".

The block diagram of Figure 2 of the patent in suit merely shows (see paragraph [0040] of the patent in suit) the connections between, not the physical locations of, the functional units shown therein, from whence the remark in point 2 above that claim 1 of the patent in suit does not specify where the printer controller is physically located. In this respect it may be noted that document D2 explicitly makes the point that the block units shown in the drawings of said document need not be seen as material units, see column 5, lines 43 to 51.

3.3 Document D2 discloses a system for preparing items to be mailed, whereby the interface 2 ("host controller") is connected to the data processor 1 ("computer unit"), see Figure 1. In the embodiment shown in Figure 1 the printing instructions are passed on from the interface 2 to the printing apparatus 4 and the instructions for controlling the mail preparation are passed on from the interface 2 to the mail preparation stations concerned. This functional arrangement of the embodiment shown in Figure 1 of document D2 is very similar to the functional arrangement shown in Figure 1 of document D1.

The embodiment shown in Figure 2 of document D2 is a variant of the apparatus according to Figure 1 of said document, whereby the instructions for controlling the mail preparation are passed on from the interface 2 to

a control unit 12 ("inserter controller"), which in turn feeds the mail preparation stations concerned (see column 4, lines 49 to 66). The embodiment shown in Figure 2 thus differs from the embodiment shown in Figure 1 in that the inserter controller, which is in the embodiment shown in Figure 1 integrated in the interface, has been made into a separate block unit interactively connected to the interface 2, precisely as claimed for the host controller (component m) in claim 1 of the patent in suit. It is stated in document D2 that such an embodiment "*may for instance be advantageous when a known apparatus is to be adapted in which the control unit 12 originally received its instructions from a reading apparatus which detected the markings provided on the documents by the printer*" (see column 4, line 67, to column 5, line 3).

In the judgement of the Board this is a clear teaching for the person skilled in the art seeking to increase the flexibility of the control unit 18 having the functions of controlling the printer and the mail preparation stations, to separate these functions out and to accommodate the printer controller function and the inserter controller function in separate block units distinct from the interface with the computer unit. It is thus obvious for the person skilled in the art to implement a functional arrangement between the host-, printer- and inserter controller for the control unit 18 of document D1 as claimed in claim 1 (cf. component m) as granted.

It follows from the above that the subject-matter of claim 1 does not involve an inventive step in the meaning of Article 56 EPC.

4. Since claim 1 as granted does not meet the requirements of Article 56 EPC, it follows that the patent cannot be maintained as granted, and thus, in the absence of any auxiliary request, has to 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:

D. Meyfarth W. Zellhuber