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**Datasheet for the decision
of 18 June 2009**

Case Number: T 0437/06 - 3.5.02

Application Number: 97309141.6

Publication Number: 0848354

IPC: G07B 17/02

Language of the proceedings: EN

Title of invention:

Postage meter and postage indicia printed thereby

Applicant:

NEOPOST LIMITED

Opponent:

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Headword:

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Relevant legal provisions:

EPC Art. 56, 84, 123(2)

Relevant legal provisions (EPC 1973):

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Keyword:

"Added subject-matter (yes)"
"Support by the description (no)"
"Inventive step (no)"

Decisions cited:

-

Catchword:

-



Case Number: T 0437/06 - 3.5.02

D E C I S I O N
of the Technical Board of Appeal 3.5.02
of 18 June 2009

Appellant:

NEOPOST LIMITED
South Street
Romford
Essex RM1 2AR (GB)

Representative:

David, Alain
Cabinet Beau de Loménie
158, rue de l'Université
F-75340 Paris Cedex 07 (FR)

Decision under appeal:

Decision of the Examining Division of the
European Patent Office posted 27 September 2005
refusing European application No. 97309141.6
pursuant to Article 97(1) EPC 1973.

Composition of the Board:

Chairman: M. Ruggiu
Members: R. Lord
E. Lachacinski

Summary of Facts and Submissions

- I. This is an appeal of the applicant against the decision of the examining division to refuse European patent application No. 97 309 141.6.
- II. In the decision under appeal the examining division held with respect to the claims filed with the applicant's letter of 7 February 2003, *inter alia*, that the independent claim 1 introduced subject-matter extending beyond the content of the application as originally filed, contrary to the requirements of Article 123(2) EPC, that the independent claims 1 and 5 did not meet the requirement of Article 84 EPC that they be supported by the description because they did not include all the essential technical features of the invention, and that the subject-matter of those two claims did not involve an inventive step within the meaning of Article 56 EPC.
- III. Of the documents cited during the procedure before the first instance, only the following is relevant for the present decision:
- D3: EP-A-0 647 924.
- IV. With the statement of grounds of appeal dated 7 February 2006 the appellant filed amended claims 1 to 8 and requested that the decision of the examining division be set aside and a patent be granted based on this enclosed set of claims.
- V. In a communication dated 10 February 2009, accompanying a summons to oral proceedings, the board informed the

appellant that it was of the preliminary opinion that the amended claims 1 to 5 contravened the requirements of Article 123(2) EPC, that the independent claims 1 and 5 did not meet the requirements of Article 84 EPC, and that it would be necessary to discuss at the oral proceedings whether the subject-matter of the independent claims 1 and 5 involves an inventive step according to Article 56 EPC in the light of the disclosure of document D3.

VI. The appellant did not make any substantive response to the board's communication. Nor, as previously advised by him in a letter dated 15 May 2009, did he attend the oral proceedings, which were held as scheduled on 18 June 2009.

VII. Claim 1 reads as follows:

"An apparatus for metering postage value and printing postage indicia on mail items, including:
electronic means (10, 11, 14, 15, 16) operative to represent numbered days of a calendar month by a repeated series of single digits, with any selected day of the calendar month being represented by a corresponding single digit from the repeating series of single digits, and being operable to operate printing means (19) for printing an indicium including the selected day of the calendar month represented by the corresponding single digit of the repeating series of single digits."

Claims 2 to 4 are dependent on claim 1.

Claim 5 reads as follows:

"A method of printing a postage indicium on a mail item, including the steps of:
generating a postage indicium including a numbered day of a calendar month represented by a single digit of a repeating series of single digits, with any selected day of the calendar month being represented by a corresponding single digit from the repeating series of single digits; and
printing the indicium on a mail item using a print head."

Claims 6 to 8 are dependent on claim 5.

VIII. The appellant's written submissions which are relevant to the present decision may be summarised as follows:

The independent claims 1 and 5 were based on claims 1 and 9 as originally filed, which clearly defined all of the essential features of the invention. These did not define the inclusion of authenticating information in the indicia. The independent claims were also clearly supported by the counterpart statements in the original description (page 2, lines 19 to 25 of the published application).

The passage of the description (page 3, lines 36 to 42 of the published application) on which the examining division relied in their objection under Article 84 EPC related to one specific embodiment given by way of example, as was clear from page 2, line 30. More particularly, the examining division had improperly read this passage in isolation, as followed from the

immediately preceding passage (page 3, lines 34 to 36) which states clearly that additional security may (that is, optionally) be provided by the data included in the indicia.

The analogy between the representation of a numbered day of a calendar month by a single digit and the representation of a calendar year by the last two digits used by the examining division in their assessment of inventive step to establish the motivation to modify the known apparatus and methods represented an impermissible *ex post facto* analysis of the prior art. Moreover the formulation of the technical problem adopted by the examining division was such as to contain a pointer towards the solution, contrary to the case law of, for example, T 229/85 (OJ 1987, 237) and T 99/85 (OJ 1987, 413).

The examining division failed to cite any prior art disclosing the feature of representing numbered days of a calendar month by a repeating series of single digits in the manner required by the claimed invention.

Reasons for the Decision

1. The appeal is admissible.
2. *Inadmissibility of amendments*
 - 2.1 Each of the present claims 2 and 3 defines that "*the printing means (19) is configured to include*" the specified data item in the indicium, whereas the corresponding claims as originally filed (i.e. claims 6 and 7) defined that "*the electronic means (10, 11, 14, 15, 16) is[/includes means] operative*" to operate the printing means to print the specified indicium. However, the application as originally filed contained no disclosure that this function of the printing means could be provided by any other element than by the defined electronic means, i.e. by those means which are responsible for representing the multi-digit data by fewer digits (see in the published application page 2, line 20; page 2, lines 36 and 37 in combination with page 2, line 58 to page 3, line 1 and with page 3, lines 9 and 10). Thus by defining that the inclusion of the specified data item in the indicium is carried out by the printing means itself, and not by the electronic means operating the printing means, the amendment of these claims results in them defining subject-matter extending beyond the content of the application as originally filed.
 - 2.2 The present independent claims 1 and 5, and dependent claim 4, refer to a "selected day of the calendar month". However, neither the original claims 5 and 12, on which the definition in the present claims of the representation of the date is assumed to be based, nor

the corresponding sections of the description, provide any basis for a selection of the day concerned. On the contrary, the skilled person reading the original application would assume that, as is conventional in systems of this type, the metering apparatus automatically sets the date to be the current date, so that the user has no choice concerning the date to be printed on the mailpiece and entered in the manifest. The definition of a selection of the date therefore introduces subject-matter extending beyond the content of the application as originally filed.

2.3 Thus, these amendments to the application contravene Article 123(2) EPC.

3. *Absence of support in the description*

3.1 The description of the application as originally filed indicates that it is an essential feature of the invention that encrypted information is included in the indicium printed on the mail item. This technical feature is however not defined in the present independent claims, so that they do not meet the requirement of Article 84 EPC that they should be supported by the description. The reasons for this objection are as follows.

3.1.1 In the independent claims 1 and 9 as originally filed the technical feature defined in the characterising portion relates to the representation of multi-digit data by a reduced number of digits. The present independent claims 1 and 5 relate to a specific embodiment of that concept. In the description this concept is described in general terms on page 4,

lines 15 to 23 (of the published application). Moreover, the passage from the last line of page 3 to line 3 of page 4 indicates that the technical problem addressed relates specifically to the need for the printed bars or code to be reliably read by the reading means, given the space available and the printing resolution. This requirement for reliable reading is in turn related to the use of machine-reading for verification purposes, as described in particular at page 3, lines 53 and 54 (*"To facilitate verification of the validity of the indicia it is desirable that the data and encrypted information or digital signature in the indicia is of a form which is machine readable."*). These passages of the application thus indicate that the inclusion of encrypted information in the indicia is an essential feature of the claimed invention.

3.1.2 The appellant argues that the passage on page 3, lines 34 to 36 of the published application makes clear that the use of encryption to provide additional security, as discussed in the passage which follows it (lines 36 to 42), is only optional, and thus not an essential feature of the claimed invention. This argument is not found convincing, because these cited passages relate not to the claimed invention, but to the technical background, so cannot be considered to contradict the conclusion indicated in section 3.1.1 above.

3.2 The general disclosure of the inventive concept at page 4, lines 15 to 23, as mentioned in section 3.1.1 above, also states that *"The present invention provides a manner of representing these other items of data having multi-digit values* [an expression which includes

the date] with a reduced number of digits in a manner which although not necessarily unique to each value of the data item is sufficient to provide distinction between indicia on mail items received at a postal receiving station." The present independent claims 1 and 5 do not however include all of the technical features which are required to achieve this effect, and which are thus essential to the invention as described. Specifically it is noted that the definitions in the present independent claims of the "repeating series of single digits" is not restricted to the case described in the application with reference to Table 1, in which the single digits are the least significant digits of the calendar date, but covers also shorter sequences, in the extreme case simply alternating digits representing odd and even numbered dates. Given the discussion in the paragraph on page 4, lines 37 to 47 of the published application, it is clear that such short sequences would not enable the "distinction between indicia" mentioned in the passage cited above. Claims 1 and 5 therefore do not meet the requirement of Article 84 EPC that they should be supported by the description.

4. *Lack of inventive step*

4.1 D3 discloses an apparatus and method for metering postage value and printing postage indicia on mail items. The apparatus comprises (see column 5, lines 25 to 49) electronic means operative to represent numbered days ("*the number of days from a predetermined starting date such as January 1*") by a repeating series of two digits (line 42), any particular day being represented by the corresponding two digits from the repeating

series (i.e. the last two digits of the day number), and being operable to operate printing means for printing an indicium including the two digits indicating the day. Moreover, the information is printed on the mail items in both plain text and in encrypted form.

- 4.2 The apparatus of the present claim 1 and the method of the present claim 5 are thus distinguished from those of D3 only in that, instead of printing the date indicium as the final two digits of the number of the day in the year, it is printed as a single digit from a repeating series of single digits. However, D3 already suggests that it is important to limit the number of digits in the overall indicium, since the passage from column 5, line 50 to column 6, line 5, implies that it is desired to encrypt the entire indicium in a single DES block, corresponding to about 20 decimal digits. Thus the listing of indicia and number of digits in column 5, lines 41 to 46 can be seen as an example of a suitable allocation of digits between the different items. Nonetheless from the wording used in that passage, and in particular also that from lines 52 to 56 in the same column, it is clearly envisaged that other arrangements can be used as appropriate. Thus for example if more digits were required for one of the other items, such as the meter ID, then it would be possible to accommodate this by reducing the number of digits used for the date to only one. The skilled person would recognise that such rearrangements involve trade-offs between the information content in each data item, but that in the case of the date, normal delivery times would mean that the reduction of the information content in changing from two digits to only one would

not result in significant ambiguity. In such a context, the question as to whether the single digit represents a day in a year or in a month would not appear to be of any technical significance, in particular since counting by month could actually lead to an increase in ambiguity (i.e. for months with 31 days, as described on page 4, lines 43 and 44 of the published application).

4.3 The above considerations would thus suggest to the skilled person to consider representing the date by only a single digit in the data block for encryption in D3. Furthermore, since that document states (see column 5, lines 56 to 58) that it is important that the *"information to be encrypted must be identical to that used in verification"*, it follows that when implementing this modification also the printed date would be in the form of the single digit, thus leading to an apparatus according to the present claim 1 and a method according to the present claim 5.

4.4 Therefore the subject-matter of the present independent claims 1 and 5 does not involve an inventive step, thus not meeting the requirements for patentability of Article 52(1) EPC in combination with Article 56 EPC.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:

M. Patin

M. Ruggiu