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**Datasheet for the decision
of 23 July 2009**

Case Number: T 0893/06 - 3.5.02

Application Number: 93308512.8

Publication Number: 0596639

IPC: G07B 17/02

Language of the proceedings: EN

Title of invention:

Mail processing system having a meter activity log

Patentee:

PITNEY BOWES INC.

Opponent:

NEOPOST LTD

Headword:

-

Relevant legal provisions:

EPC Art. 56, 123(3)

Relevant legal provisions (EPC 1973):

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Keyword:

"Main request - Inventive step (no)"

"First and second auxiliary requests - Extension of protection (yes)"

"Third auxiliary request - Admission (yes) - Inventive step (no)"

"Fourth auxiliary request - Admission (yes) - Extension of protection (yes)"

Decisions cited:

-

Catchword:

see reasons, point 11



Case Number: T 0893/06 - 3.5.02

D E C I S I O N
of the Technical Board of Appeal 3.5.02
of 23 July 2009

Appellant: PITNEY BOWES INC.
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Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 4 April 2006
revoking European patent No. 0596639 pursuant
to Article 102(1) EPC 1973.

Composition of the Board:

Chairman: M. Rognoni
Members: J.-M. Cannard
H. Preglau

Summary of Facts and Submissions

- I. The proprietor appealed against the decision of the opposition division revoking European patent No. 0 596 639. The reasons given for the revocation were that the subject-matter of independent claims 1 and 9 of a main request filed with a letter dated 27 December 2005 lacked an inventive step and novelty, respectively, and that the subject-matter of claim 1 of both auxiliary requests filed with the letter dated 27 December 2005 represented matter extending beyond the content of the application as filed in violation of Article 123(2) EPC.
- II. The document:
- F1: US-A-4 752 950,
- considered during the proceedings before the opposition division, remains relevant to the present appeal.
- III. With a letter dated 31 July 2006, the appellant filed a statement of grounds of appeal and claims according to a main request and first and second auxiliary requests.
- IV. Oral proceedings before the Board were held on 23 July 2009 in the course of which the appellant filed claims in respect of third and fourth auxiliary requests.
- V. Independent claim 9 of the main request reads as follows:
- "A method for logging meter activity in a mail processing machine (1) adapted to receive any one of a plurality of postage meters (3), said method comprising the steps of installing a meter in the mail processing

machine (1), uniquely identifying said installed meter (3) in stored accounting information relating to said meter upon installation thereof, determining and storing accounting information relating to activity of the uniquely-identified meter which has occurred while the meter (3) was away from the mail processing machine and thereafter storing information relative to activity of the uniquely-identified meter upon the occurrence of each of a plurality of selected events which occur while the meter (3) is installed in the mail processing machine (1)."

Independent claim 9 of the first auxiliary request reads as follows:

"A method for logging meter activity in a mail processing machine (1) adapted to receive any one of a plurality of postage meters (3), said method comprising the steps of installing a meter in the mail processing machine (1), uniquely identifying said installed meter (3) in stored accounting information relating to said meter upon installation thereof, determining and storing a meter activity log including accounting information relating to activity of the uniquely-identified meter which has occurred while the meter (3) was away from the mail processing machine and thereafter storing a meter activity log relative to activity of the uniquely-identified meter upon the occurrence of each of a plurality of selected events which occur while the meter (3) is installed in the mail processing machine (1)."

Independent claim 8 of the second auxiliary request comprises all the features recited in claim 9 of the first auxiliary request followed by the additional

feature ", and checking whether a selected event of a same type as a current event has previously occurred and thereafter replacing the information if the current event is the same type of event."

Independent claim 8 of the third auxiliary request comprises all the features recited in claim 9 of the main request followed by the additional feature ", and checking whether a selected event of a same type as a current event has previously occurred and thereafter replacing the information if the current event is the same type of event."

Independent claim 8 of the fourth auxiliary request reads as follows:

"A method for logging meter activity in a mail processing machine (1) adapted to receive any one of a plurality of postage meters (3), said method comprising the steps of installing a meter in the mail processing machine (1), uniquely identifying said installed meter (3) in stored accounting information relating to said meter upon installation thereof, determining and storing, as part of a meter activity log, accounting information relating to activity of the uniquely-identified meter which has occurred while the meter (3) was away from the mail processing machine and thereafter storing, as part of said meter activity log, information relative to activity of the uniquely-identified meter upon the occurrence of each of a plurality of selected events which occur while the meter (3) is installed in the mail processing machine (1), and checking whether a selected event of a same type as a current event has previously

occurred and thereafter replacing the information if the current event is the same type of event."

VI. The arguments of the appellant proprietor can be summarized as follows:

Document F1 contained no disclosure at all that the base 7 of a mail processing machine 1 should contain any form of logging means, or that the franking head 8 was involved in any form of an "off-line" activity when it was away from the machine. According to F1, the machine base simply copied the data required for remote meter reading, which were contained in registers of a franking head installed in the machine, and sent them to a central station 2 which produced a partial journal for each customer. A meter activity log was a record of information and not just a state of the registers of a mail processing machine. There was no disclosure in F1 that a particular franking head 8 might be removed from a first base and connected to another base. In fact, F1 did not envisage the possibility of involving a franking head in any activity whilst it was away from the base with which it was intended to work. Hence, the mail system of F1 had no need to distinguish between "on-line" activity and "off-line" activity of a franking head; all activity of a franking head took place "on-line" and was reported "as often as possible" to the connected machine base 7. The franking head changing operation mentioned in F1 only related to the possible use of a spare franking head. The system and the method recited in the main request were thus novel.

The system of F1 was fundamentally different from the system of the invention and operated in a completely

different way because it was of the remote meter-reading type in which the central station processed all the data relating to operation of the mailing machines in order to bill the franking performed and draw up the partial journals. In fact, the closest prior art was the document US 4 931 943 acknowledged in the patent in suit. Starting from this document, the problem consisted in keeping track of the postal expenditures at a given mail processing machine in order to match those expended from a particular meter which had been moved between different locations, as recited in the patent in suit. The problem was solved by determining and storing accounting information which had occurred while the postage meter was off-line, i.e. not connected to its "home machine". Since it did not distinguish between "off-line" and "on-line" activities, F1 did not suggest the claimed solution. The system and the method according to the main request were thus not obvious.

The incorporation of the words "a meter activity log including" into the independent claims of the first and second auxiliary requests acted as a further constraint and provided a further restriction on the scope of protection afforded by the claims of the main request. According to the first and second auxiliary requests, the logging means had to determine and store the same accounting information as in the main request. However, in said auxiliary requests, the accounting information formed part of a "meter activity log" and thus the scope of protection was narrower than that of the main request. Similar considerations applied to the fourth auxiliary request.

The "selected event" specified in claims 1 and 8 of the third auxiliary request meant the installation of a new meter in a mail processing machine. Checking, as claimed, whether a selected event of a same type as a current event had previously occurred and replacing the information in an associated memory slot if the events were of the same type was neither disclosed, nor suggested in the known prior art. In particular, there was no disclosure in F1 that a franking head could be removed from its home mailing machine and connected to another one. In the patent US 4 931 943, there was no suggestion at all to use different franking heads in a mailing machine, or to record activity of more than one franking head in a machine. These considerations applied also to the fourth auxiliary request.

VII. The arguments of the respondent opponent can be summarized as follows:

The subject-matter of claims 1 and 9 of the main request lacked novelty because all their features were disclosed in document F1. In F1, a mail processing machine 1 comprising a franking head and a base had a meter activity log because the contents of the registers of the franking head 8 were copied and stored in the memory 83 of the base. The mail processing machine of F1 could receive any one of a plurality of franking heads, for instance spare franking heads. In any case, claims 1 and 9 of the main request did not specify that the franking heads could be moved from one machine to another one. Moreover, in the system of F1, the user could remove the franking heads from the machines and convey them to the postal Administration for re-filling. Franking heads could thus be involved in "activity" when they were away

from the machines. A record of this activity was necessarily kept and stored in the machine when the contents of the registers of the franking heads were copied in the machine memory.

In any case, the invention claimed in the main request lacked an inventive step. As the central station 2 of F1 provided a meter activity log, it was obvious to keep such a log also in the mail processing machines for providing the double check required by the postal Administration, or in case that the communication between the central station and the machines was interrupted. For the same reasons, the skilled person would consider combining the teaching of F1 with that of the patent US 4 931 943 which disclosed a mail processing machine comprising a meter activity log.

The independent claims of the first and second auxiliary requests contravened Article 123(3) EPC because they had been amended in a way which extended the protection conferred by specifying an "off-line" meter activity log.

The third and fourth auxiliary requests should not be admitted into the proceedings because they were late filed. Moreover, the new feature incorporated in the independent claims of these requests merely specified an update of the stored information. Such a feature was known from F1 which disclosed an update of the image of the registers of a franking head in the machine base 7 and in the corresponding local station 4. This feature was also known from US 4 931 943 which described the organisation of the memories in a mailing machine. The invention claimed in the third and fourth auxiliary

requests was neither novel, nor involved an inventive step.

VIII. The appellant (patentee) requested that the decision under appeal be set aside and that the patent be maintained on the basis of one of the requests filed with the statement of grounds of appeal (main, first and second auxiliary requests) or on the basis of the further requests filed during the oral proceedings (third and fourth auxiliary requests).

IX. The respondent (opponent) requested that the appeal be dismissed.

Reasons for the Decision

1. The appeal is admissible.

Independent claim 9 of the main request - Lack of inventive step

2. The meaning of the term "accounting information" used in claim 9 is not defined precisely in the example of the invention described in the specification of the patent in suit. However, on the basis of the specification as a whole and more specifically the passage of column 1, lines 13 to 38, the Board understands that "accounting information" is information relating to the contents of the registers of a franking meter in which the funds associated with the printing of postal indicia and the refill operations are stored. On the other hand, according to column 6, lines 27 to 43 of the patent specification, a "Meter Activity Log contains a history

or archive of the activity taking place at a particular mailing machine in conjunction with each uniquely-identified meter that has been operated at that mailing machine", and the data stored in said Meter Activity Log include, *inter alia*, information such as the ascending and descending register values pertaining to each unique meter and the dates of postage expenditures or refills. Thus, the Board can share the proprietor's view that a meter activity log relates to a record of the meter's activity and not to a temporary state of the registers in the mail processing machine. In other words, the Board understands that a meter activity log according to the patent in suit is a record, i.e. **a piece of information or a description of events which is written on paper or stored on a computer**, organized as a function of time, and, as such, an entity different from accounting information per se, which represents the contents of franking registers.

3. Document F1, which forms the prior art to be regarded as the starting point of the invention recited in method claim 9 of the main request, discloses a mail processing system comprising mail processing machines (franking machines 1) which are remotely controlled from a central station 2 via a telephone network 3 and local stations 4. Each machine 1 is adapted to receive a postage meter (franking head 8) having a memory 83 in which an identification number for the head and contents of the meters required for managing the head are stored (figures 1 and 2; column 3, lines 41 to 50). A base 7 of the machine 1 copies as often as possible into a memory 71 those data required for remote meter reading which are stored in the memory 83 (column 4, lines 35 to 48). Each local station 4 permanently interrogates the

machines in order to update an image of the meters in the machines and to supply the central station 2 with up-to-date information comprising, in particular, the head identification numbers and the contents of the franking registers (column 2, lines 54 to 66; column 5, lines 16 to 32). The central station 2 stores and processes data relating to the machines 1 to bill the franking operation performed and draws up a journal indicating for each customer cumulative and daily values from the franking registers (column 2, lines 45 to 53; column 9, lines 30 to 41).

4. Hence, F1 discloses a method for logging meter activity **in a mail processing system** in which mail processing machines 1 are adapted to receive any one of a plurality of postage meters (8), the method comprising the steps of installing a meter in a mail processing machine 1, uniquely identifying said installed meter 8 in stored accounting information relating to said meter upon installation thereof, and storing information relative to activity of the uniquely-identified meter upon the occurrence of each of a plurality of selected events which occur while the meter 8 is installed in the mail processing machine 1.

5. According to column 4, lines 49 to 56 of F1, any franking head changing operation requires the machine to be initially switched off and a head communicates its identification number when the machine is switched on, the base of a machine being initialized upon reception of a signal from the head which it serves. As the term "initialize" in the relevant field means setting the numbers or amounts in a machine so that it is ready to start working, the initial values of the accounting

registers of the installed head are in F1 necessarily transmitted to the memory 71 of the machine so that the subsequent updates of the image of the meters in the machine, which are transmitted thereafter to a central station, are up-to-date information representative of the actual accounting activity of the machine. In other words, any activity of a franking head prior to its installation in a particular machine is necessarily accounted for when the machine is initialised. Thus, the method disclosed in F1 necessarily comprises a step of "determining and storing accounting information relating to activity of the uniquely-identified meter which has occurred while the meter was away from the mail processing machine", as recited in claim 9 of the main request.

6. The memory 71 of a machine 1 of F1 stores accounting information with the meaning that this term has in the patent in suit (point 2 *supra*) because it stores the data required for remote meter reading which are contained in the memory 83 of a franking head, i.e. the contents of the accounting registers of the head (column 3, lines 41 to 50 and column 4, lines 35 to 39). Thus, a mail processing machine in F1 has no logging of meter activity and the method disclosed in F1 differs in this respect from the method recited in claim 9 of the main request.

7. Starting from the system of F1 and having regard to the effects provided by the method according claim 9 of the main request, the technical problem addressed by the invention can be seen as providing an easy double check on the expending of funds for the customer of each mail processing machine in the system, in particular when a

franking head changing operation has occurred in a machine (cf. contested patent, column 1, lines 26 to 34).

8. To solve this technical problem and give each user the opportunity of a double check of the accounting activity of a mail processing machine, the skilled man starting from F1 would consider making a partial meter activity log available in each mail processing machine in the same way as a partial meter activity log is drawn up for each customer in the central station of F1. Accordingly, the subject matter of claim 9 of the main request does not involve an inventive step (Article 56 EPC).

First and second auxiliary requests - Inadmissibility of the amendments

9. Independent claim 9 of the first auxiliary request is amended, *inter alia*, to specify a step of "determining and storing a meter activity log including accounting information relating to activity of the uniquely-identified meter which has occurred while the meter (3) was away from the mail processing machine", whereas a step of "determining and storing accounting information" relating to said activity is specified in claim 9 of the granted patent. Claim 9 of the first auxiliary request does not meet the requirement of Article 123(3) EPC because the patent is amended in such a way as to extend the protection it confers.

- 9.1 In accordance with the proprietor's view that a meter activity log is essentially different from accounting information, which relates to a temporary state of the registers in a mail processing machine, the Board understands that a meter activity log is a record, i.e.

a piece of information or a description of events which is written on paper or stored on a computer as a function of time (*supra*, point 2). Therefore, the step of determining and storing accounting information relating to off-line activity specified in claim 9 of the patent in suit has to be understood as relating to accounting information per se and not to accounting information which after processing has become part of a meter activity log. This interpretation is supported by the patent specification, column 5, lines 44 to 46, according to which expenditures and refills while the meter was away of the machine, i.e. while the meter was off-line, are checked and a subroutine is called to enter the register values. Thus, the amendment made to claim 9 of the first auxiliary request may restrict the scope of the claim to "determining and storing a meter activity log including accounting information" relating to the meter's off-line activity, but it has deleted from the claim the step of determining and storing **accounting information per se** when the meter is off-line. This deletion extends the protection conferred by the patent and thus claim 9 of the first auxiliary request contravenes Article 123(3) EPC.

- 9.2 Moreover, according to claim 6, lines 42 and 43 of the granted patent, "additional information can be recorded" in the Meter Activity Log. This unspecified additional information covers any generalisation of the accounting information relating to an off-line activity of a meter specified in claim 9 of the main request. Thus, the feature "determining and storing a meter activity log including accounting information" incorporated in claim 9 of the first auxiliary request which, interpreted on the basis of the description of the

patent, covers a generalisation of a restrictive term of claim 9 of the granted patent, also extends the protection conferred (Article 123(3) EPC). The first auxiliary request has to be refused.

10. Claim 8 of the second auxiliary request merely differs from claim 9 of the first auxiliary request in that it includes the feature of dependent claim 12 of the patent. Accordingly, claim 8 of the second auxiliary request, which is amended in the same way as claim 9 of the first auxiliary request in respect of the off-line activity of the meter, contravenes Article 123(3) EPC for the same reasons. The second auxiliary request has to be refused.

Third and fourth auxiliary requests

11. Independent method claim 8 of both the third and fourth auxiliary requests differs from claim 8 of the second auxiliary request in that the feature "determining and storing a meter activity log including accounting information" has been replaced by "determining and storing accounting information" or amended, respectively, to respond to the objection raised pursuant to Article 123(3) EPC. The second auxiliary request was filed with the statement of grounds of appeal and the features added in claim 8 of said request are in substance matter recited in dependent claim 12 of the patent as granted (point 10, *supra*). In the circumstances, the Board considered that the respondent could not have been taken by surprise and that the amended claims of the third and fourth auxiliary requests could be dealt with without adjournment of the proceedings. Accordingly, the third and fourth auxiliary requests were admitted into the proceedings

(Article 13(3) of the Rules of Procedure of the Boards of Appeal, OJ EPO 2007, 536 to 547).

12. Claim 8 of the third auxiliary request differs from claim 9 of the main request in that it incorporates the additional feature "and checking whether a selected event of a same type as a current event has previously occurred and thereafter replacing the information if the current event is the same type of event."
- 12.1 The passage of column 5 of the patent specification, lines 19 to 54, with reference to figure 5 gives examples of events which can occur and be checked in the mail processing system. Such events are not restricted to the installation of new meters, but can also be any on-line expenses (figure 5, 570). Thus, the additional feature can be understood on the basis of the patent as a whole as covering the step of replacing information relating to a previous expense stored in the mail processing machine when an identified meter is installed in the machine and thereafter a new expense occurs. According to F1 (column 2, lines 61 to 66), a local station interrogates the franking machines in order to update an image of the meters in the machines to supply the central station 2 with up-to-date information. This simply means that, in F1, an image of the meters, i.e. accounting information, replaces an image, or accounting information, previously stored when a new expense occurs. According, the additional feature incorporated in claim 8 of the third auxiliary is disclosed in F1 and the subject-matter of said claim lacks an inventive step for the same reasons as claim 9 of the main request.

13. Claim 8 of the fourth auxiliary request differs from claim 8 of the second auxiliary request in that it specifies a step of "determining and storing, as part of a meter activity log, accounting information", instead of a step of "determining and storing a meter activity log including accounting information", while the meter was off-line. However, both claims have the same scope because the above steps have in substance the same meaning (point 9.1 *supra*). Accordingly, claim 8 of the fourth auxiliary request contravenes Article 123(3) EPC for the same reasons as claim 8 of the second auxiliary request (points 9 to 9.2 *supra*).
14. As none of the proprietor's requests is suitable for maintaining the patent, the appeal has to be dismissed.

Order

For these reasons it is decided that :

The appeal is dismissed.

The Registrar:

The Chairman:

U. Bultmann

M. Rognoni