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**Datasheet for the decision
of 30 January 2012**

Case Number: T 1843/08 - 3.5.02

Application Number: 00301114.5

Publication Number: 1035514

IPC: G07B 17/00

Language of the proceedings: EN

Title of invention:
Accounting for postal charges

Applicant:
NEOPOST LIMITED

Headword:
-

Relevant legal provisions:
EPC Art. 56

Keyword:
"Inventive step - no (all requests)"

Decisions cited:
-

Catchword:
-



Case Number: T 1843/08 - 3.5.02

D E C I S I O N
of the Technical Board of Appeal 3.5.02
of 30 January 2012

Appellant:
(Applicant)

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Decision under appeal:

Decision of the Examining Division of the
European Patent Office posted 5 May 2008
refusing European patent application
No. 00301114.5 pursuant to Article 97(2) EPC.

Composition of the Board:

Chairman: M. Ruggiu
Members: R. Lord
R. Moufang

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. 00 301 114.5. The reason given for the refusal was that the subject-matter of the claims then on file lacked novelty (Article 54 EPC).

II. The following documents of the state of the art have been cited during the procedure before the first instance:

D1: US 4 760 532 A; and

D2: US 4 802 117 A.

III. In a communication accompanying a summons to oral proceedings, dated 22 August 2011, the board informed the appellant *inter alia* of its preliminary opinion that the subject-matter of the claims addressed in the decision under appeal lacked an inventive step in the light of D2.

Oral proceedings before the board took place on 30 January 2012. The appellant requested that the decision under appeal be set aside and that a patent be granted on the basis of claims 1 to 12 filed with the letter of 7 December 2011, or on the basis of claims 1 to 12 of the first auxiliary request filed at the oral proceedings, or on the basis of claims 1 to 11 of the second auxiliary request filed at the oral proceedings.

IV. Claim 1 of the appellant's main request reads as follows:

"An apparatus implemented method of accounting for postage charges in respect of batches of mail items, including the steps of:
storing in a first memory (21) an accumulated aggregate value of postage dispensed in applying postage charges to mail items;
storing in a second memory (25), as an accumulated pending value, an accumulated value of postage dispensed in applying postage charges to mail items, for the mail item [sic] of each respective uncompleted batch of mail items;
in response to completion of one batch of mail items, decrementing by an accounting means (12) the accumulated pending value by a value of postage relating to the one completed batch of mail items, characterised in that
the step of storing the accumulated pending value includes the step of storing an accumulated pending value of postage dispensed in applying postage charges to mail items of the one uncompleted batch of mail items and postage charges to further mail items of at least one further uncompleted batch of mail items."

Claim 9 of the appellant's main request reads as follows:

"Apparatus for accounting for postage charges in respect of batches of mail items and configured to implement the method of anyone of claims 1 to 8, said apparatus including:
a first memory (21) storing an accumulated aggregate

value of postage dispensed in applying postage charges to mail items;
a second memory (25) storing, as an accumulated pending value, an accumulated value of postage dispensed in applying postage charges to mail items, for the mail item [sic] of each respective uncompleted batch of mail items, said storing including storing an accumulated pending value of postage dispensed in applying postage charges to mail items of the one uncompleted batch of mail items and postage charges to further mail items of at least one further uncompleted batch of mail items, and
accounting means (12) operable, in response to completion of one batch of mail items, to decrement the accumulated pending value by a value of postage relating to the one completed batch of mail items."

Claim 1 of the appellant's first auxiliary request differs from that of the main request in that the following text is inserted before the paragraph beginning "decrementing...":

"generating by the accounting means (12) a submission message containing the accumulated mailing data relating to the mail items in the batch of mail items, transmitting the submission message to the postal authority (26),".

Claim 9 of the appellant's first auxiliary request differs from that of the main request in that the following text is inserted before the word "decrement":

"generate a submission message containing the accumulated mailing data relating to the mail items in the batch of mail items, to transmit the submission message to the postal authority and to".

Claim 1 of the appellant's second auxiliary request differs from that of the first auxiliary request in that the inserted phrase "transmitting the submission message to the postal authority (26)," is replaced by:

"receiving an acceptance message from a postal authority in respect of the one completed batch of mail items".

Claim 8 of the appellant's second auxiliary request differs from claim 9 of the first auxiliary request in that the phrase "transmit the submission message to the" is replaced by "receive an acceptance message from a".

V. The appellant essentially argued as follows:

The fact that the motivation behind the claimed invention was primarily commercial or administrative and that the difference with respect to the prior art was relatively small did not automatically imply that the subject-matter of the claims lacked an inventive step.

The claimed invention addressed the problem of the delay caused by waiting for the acknowledgement message, during which time the apparatus might have had to remain idle, and did so in a non-obvious manner, since

the obvious solution would have been to accelerate the communication between the mailer and the postal authority.

The use of a single memory for the postal charges for all of the pending mail items addressed the technical problem of reducing the requirement for secure memory. It also provided information which was useful for stock control of paper, ink etc.

Reasons for the Decision

1. The appeal is admissible.
2. *Novelty - Main request (Article 54 EPC)*
 - 2.1 The document D2 discloses (see in particular column 6, lines 50 to 61 and Fig. 1) a method of accounting for postage charges in respect of batches of mail items, the method being implemented in an apparatus (electronic postage meter). The method includes the steps of storing in a first memory (ascending register) an accumulated aggregate value of postage dispensed in applying postage charges to mail items (column 6, lines 52, 53, 60 and 61: "total sum of the postage printed by the meter"), storing in a second memory (batch value register), as an accumulated pending value, an accumulated value of postage dispensed in applying postage charges to mail items for a current, uncompleted batch (column 6, lines 58 and 59: "the value of the postage printed in the particular batch"), and in response to completion of that one batch of mail items, decrementing by an accounting means (program

running on CPU) the accumulated pending value of postage dispensed in applying postage charges to mail items of that batch of mail items (it being implicit that the batch value register must be reset to zero before commencing the next batch). This known method thus includes all the features of the pre-characterising portion of claim 1 of the appellant's main request, and also discloses the corresponding apparatus features as defined in claim 9 of that request.

- 2.2 D2 contains no explicit disclosure relating to the treatment of multiple batches, and thus does not disclose the feature of the characterising portion of the present claim 1, which the board understands as defining that after the one batch has been processed, processing of at least one further batch is commenced, and the postage charges of at least some mail items of that further batch are stored in the second memory as part of the accumulated pending value before the step of decrementing that accumulated pending value by the postage value of the one (completed) batch. Similarly D2 does not disclose the corresponding apparatus feature of the present claim 9. Thus the subject-matter of each of these claims is new with respect to D2.

3. *Inventive step - Main request (Article 56 EPC)*

- 3.1 It is apparent, in particular from the discussion in paragraphs 3.3 and 3.5 below, that claims 1 and 9 of the appellant's main request each comprises, explicitly or implicitly, a combination of technical and non-technical features. It is established case law of the boards of appeal that in such circumstances, only those

features which contribute to the technical character of the claimed invention should be considered when assessing inventive step, and that those features which do not contribute to that technical character can be taken into account when formulating the technical problem (see Case Law of the Boards of Appeal of the European Patent Office, 6th Edition, I.D.8.1.5).

3.2 The characterising feature of the claimed invention, as indicated in paragraph 2.2 above, can be seen as comprising three distinct aspects. Firstly, the decrementing of the postage value of the one completed batch from the accumulated pending value does not occur immediately after the final mail item of the batch has been processed by the postage meter, but instead occurs only after a delay. Secondly, the processing of at least one further batch commences during that period of delay. Thirdly, the postage charges for the mail items of that further batch are added to the same memory as those of the one batch (i.e. the second memory in the wording of the claims).

3.3 From the application (see for instance the description in paragraph [0022] of the published application, referring to Fig. 3) it is apparent that the first of these differences, i.e. that there is a delay after processing of the final mail item of the batch before the postage value of that batch is decremented from the accumulated pending value, arises because of the requirement to wait for the receipt of the acceptance message from the postal authority (which is sent in response to the transmission of the submission message from the apparatus to the postal authority after processing of the final mail item of the batch). This

requirement corresponds to the selection of the third option for the meaning of the term "completed" as described in paragraph [0005] of the application. In contrast, selection of the first option described there (the batch being deemed completed when the last mail item is processed in the postage meter) would require no such delay, and selection of the second (the batch being deemed completed when it has been submitted, but not yet accepted) would require only a significantly shorter delay. The board understands however that the selection between these three options is based on purely commercial or administrative reasons, and does not in itself involve any technical considerations. This aspect of the characterising feature can therefore be taken into account when formulating the technical problem.

- 3.4 Given that there is to be a delay before completion of a processed mail batch (i.e. receipt of the acceptance message for that batch from the postal authority), as discussed in the previous paragraph, it would be immediately obvious to the skilled person that it would be desirable to commence processing of the next batch without waiting for completion of the batch which has just been processed. This would apply in particular to high-volume mail processing machines, for which even a delay of only a few minutes would correspond to the processing of hundreds or even thousands of mail items.
- 3.5 The application provides no explicit teaching as to the reason why the postage charges for the mail items of the further batch are added to the same memory as used for the processed batch, rather than being added into a separate memory provided for this purpose. However,

paragraph [0029] of the description, particularly when interpreted in the light of paragraph [0024], suggests that the intention is to provide information concerning the total charges relating to mail items which have been processed but not yet been completed, this information permitting a clear distinction between those postal charges for which payment is already due and those for which it can be expected to become due, but for which payment can be deferred. It is not clear from the description, nor was the appellant able to clarify, whether this requirement arises from the user of the apparatus or from the postal authority, but it is nonetheless clear that this is merely a question of commercial or administrative issues, and does not in itself involve any technical considerations. Thus, also this aspect of the characterising feature can be taken into account when formulating the technical problem.

3.6 In the light of the discussion of paragraphs 3.1 to 3.5 above, the technical problem addressed by the method of claim 1 and the apparatus of claim 9 of the appellant's main request reduces to that of how to implement a method and apparatus of the type known from D2 in such a manner that multiple batches can be treated with minimal delay between batches and in such a manner that a total of postage charges for all processed but pending mail items (as distinct from those mail items belonging to batches which have been accepted by the postal authority) is made available.

3.7 As indicated in paragraph 3.4 above, the board considers that it would be immediately obvious to the skilled person that it would be desirable to commence processing of the next batch without waiting for

completion of the batch which has just been processed, thus addressing the first part of the technical problem. Moreover, the board is of the opinion that it would be obvious to the skilled person to address the second part of the technical problem by using the existing batch value register of D2 as a "pending register", adding the postage charge for each mail item into this register as it is processed, and deducting each value only when the batch to which it belongs has been accepted, at which time the value of the whole batch would be deducted, because this is the arithmetic process which produces the desired information most directly. Claims 1 and 9 of the appellant's main request define nothing more than this. The board therefore concludes that the subject-matter of these claims does not involve an inventive step according to Article 56 EPC.

- 3.8 Concerning the points raised in paragraph 3.3 above relating to the communication between the apparatus and the postal authority (transmission of the submission message and receipt of the acceptance message), the board observes that D2 does not contain any teaching relating to this specific form of communication, although it does disclose the provision of communication means in the apparatus (block 58 of Fig. 1, as described in column 7, lines 33 to 35). Moreover, the document D1, which relates to a similar apparatus to that of D2, and has the same assignee, does disclose the creation of a batch submission message (referred to in D1 as a "passport") and its transmission to the postal authority over a communication line (see D1, column 7, lines 40 to 44). The board understands that in the approximately ten

year period between the publication dates of D1 and D2 and the priority date of the present application, such communication between mailing apparatus and postal authority had become conventional practice. Thus the fact that the delay forming part of the problem addressed by the present claims is based on such communication cannot contribute to the presence of an inventive step in the claimed subject-matter.

3.9 The appellant's counter-arguments are not found convincing, for the following reasons.

3.9.1 The appellant argued that the fact that the motivation for the claimed invention was of a commercial or administrative nature and that the difference with respect to the prior art was relatively small did not inevitably mean that it did not involve an inventive step. The board does not dispute this. What is argued in paragraph 3.7 above is that the claimed subject-matter does not involve an inventive step because the manner in which the objective technical problem is solved by the claimed invention would be obvious to the skilled person.

3.9.2 The appellant argued also that the claimed solution was not the obvious way to address the problem of delay in receiving the acceptance message, because the obvious approach would have been to try to reduce the delay by increasing the speed of the communication between the mailer and the postal authority, in which context he referred to column 6, lines 9 to 14 of the application. The board does not find this line of argumentation convincing, for a number of reasons. Firstly, the board notes that the cited passage of the application does

not concern communication between the mailer and the postal authority, but instead concerns the possible generation of a digital signature for the submission message. Thus, even though this passage might suggest that the submission message is a relatively large data file, it provides no suggestion that communication speed is a limiting factor in determining the delay before receipt of the acceptance. Secondly, the board observes that the procedure between finishing processing of a batch of mail items and receipt of the acceptance message involves several steps other than the actual communication of the submission message from the mailer to the postal authority and of the acceptance message in the opposite direction, in particular the generation of the submission message and the decision by the postal authority on the terms of acceptance of the batch, of which the latter would in many cases be expected to be the time-limiting factor. Thirdly, much of this procedure lies outside the control of the mailer (this applying entirely as regards the decision process mentioned above, and at least partially for the communication steps), so that he would not expect to be able to reduce the overall delay significantly. The skilled person making use of the apparatus of D2 would therefore be motivated to find a way of ensuring that the delay, to the extent that he could not prevent it, did not cause the apparatus to remain idle longer than necessary.

- 3.9.3 The appellant argued further that the use of a single pending register addressed a technical problem of reducing the requirement for secure memory. The board observes that the application contains no suggestion that the claimed invention is concerned with such a

problem. Moreover, to the extent that this problem could be considered to be addressed by the claimed method and apparatus, the solution would arise automatically from the obvious development described in paragraph 3.7 above (i.e. the solution of the problem suggested by paragraphs [0024] and [0029], as discussed in paragraphs 3.5 and 3.6 above), so can be considered to be merely a bonus effect of that obvious development, which would therefore not result in the presence of an inventive step.

3.9.4 Finally, the appellant argued that the pending value provided by the claimed invention was of use for purposes such as stock control for paper, ink, etc. The comments in the previous paragraph apply correspondingly to this argument.

4. *Auxiliary requests*

The amendments introduced in the independent claims of the appellant's first and second auxiliary requests merely serve to define the communication steps which result in the delay between finishing the processing of a mail batch and completion of that batch. Since those communication steps were taken into account in the assessment of inventive step in the subject-matter of the claims of the main request (see paragraphs 3.3 and 3.8 above), these amendments have no effect on the conclusion reached with respect to those claims. Therefore the board concludes that the subject-matter of claims 1 and 9 of the first auxiliary request and that of claims 1 and 8 of the second auxiliary request does not involve an inventive step according to Article 56 EPC.

5. The board therefore concludes that, since none of the appellant's requests provides a basis for an allowable set of claims, the appeal has to be dismissed.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:

C. Moser

M. Ruggiu