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**Datasheet for the decision
of 15 October 2015**

Case Number: T 0687/11 - 3.5.02

Application Number: 00984575.1

Publication Number: 1226555

IPC: G07B17/00

Language of the proceedings: EN

Title of invention:

Address Matching System and Method

Patent Proprietor:

Stamps.Com

Opponent:

PSI Systems, Inc.

Relevant legal provisions:

EPC Art. 54, 56, 100(a), 100(c)

Keyword:

Grounds for opposition - added subject-matter (no)
Novelty - (yes)
Inventive step - (yes)



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Case Number: T 0687/11 - 3.5.02

D E C I S I O N
of Technical Board of Appeal 3.5.02
of 15 October 2015

Appellant: PSI Systems, Inc.
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Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 17 January 2011
rejecting the opposition filed against European
patent No. 1226555 pursuant to Article 101(2)
EPC.**

Composition of the Board:

Chairman M. Ruggiu
Members: R. Lord
W. Ungler

Summary of Facts and Submissions

I. This is an appeal of the opponent against the decision of the opposition division to reject the opposition against European patent No. 1 226 555. The reason given for the decision was that the opposition grounds raised by the opponent under Article 100(a) and (c) EPC did not prejudice the maintenance of the patent as granted.

II. The following documents cited by the appellant are relevant for this decision:

D02: "A User's Guide to DSF (Delivery Sequence File) Processing at Database America", January 1996, and
D03: "Address Matching Guidelines", National Address Information Center, Draft July 1992.

III. With the statement of grounds of appeal dated 26 May 2011 the appellant (opponent) requested that the decision under appeal be set aside and that the patent be revoked. Oral proceedings were requested as an auxiliary measure.

With a reply dated 29 September 2011 the respondent (patent proprietor) requested that the appeal be dismissed and the patent be maintained as granted (main request), or that the patent be maintained on the basis of the claims according to one of the first, second and third auxiliary requests filed with that reply.

In a communication accompanying a summons to oral proceedings, dated 2 June 2015, the board indicated *inter alia* its preliminary opinion that the opposition ground under Article 100(c) EPC did not prejudice the maintenance of the patent as granted, and identified

issues to be discussed in the context of novelty and inventive step.

In a letter dated 11 September 2015 the appellant stated that they would not attend the oral proceedings scheduled for 21 October 2015.

In a communication dated 14 October 2015 the board cancelled the appointed oral proceedings.

IV. The independent claims 1 and 7 of the patent in suit read as follows:

"1. A system for comparing a received address with a set of validated addresses, the system comprising:

a remote device (16) that is operative to receive address data from a source; and
an address matching server (12) that maintains a database (14) containing the set of validated addresses,

wherein the address matching server (12) is capable of communication with the remote device (16) via a communication network (18),
the address matching server (12) being operative in response to receipt of the address data from the remote device (16) to process the address data using a plurality of query permuters to the address data to generate multiple data structures incorporating the address data, compare the processed data with the set of validated addresses, and transmit one or more matches to the remote device (16)."

"7. A method for validating address data entered by a user at a remote device, comprising:

receiving the address data from a source;

accessing a database (14) that contains one or more valid addresses;
comparing the address data from the user with the database (14) of valid addresses using a plurality of query permuters to the address data to generate multiple data structures incorporating the address data; and
if a match is found, transmitting the matched address to the remote device."

Claims 2 to 6 and 8 to 14 are dependent on claims 1 and 7 respectively.

V. The arguments of the appellant which are relevant for the present decision can be summarised as follows:

Claim 7 of the patent as granted defined subject-matter extending beyond the content of the application as originally filed, because, compared to the original claim 11, it defined the use of a plurality of query permuters to generate multiple data sets, but did not define that this occurred before the step of comparing the address data with the database.

Document D02 disclosed on page 20 in the context of the LINESTD field a step which represented applying a plurality of query permuters to the address data to generate multiple data structures. Since claim 7 of the patent as granted did not specify that the step of permuting occurred before the step of comparing, this step of D02 fell within the terms of the penultimate paragraph of that claim. The steps of receiving and transmitting address data were implicit in D02, so that the subject-matter of claim 7 of the patent as granted was not new. Alternatively, the steps of receiving and transmitting address data could be seen as being trivial

in the light of D02, so that the subject-matter of the claim would be obvious to the skilled person.

Document D03 described not only method steps corresponding to those of D02, but also a comparison using a phonetic database. The combination of these two comparisons represented a further form of permuting of address elements, so that the subject-matter of claim 7 as granted was not new or did not involve an inventive step with respect to that document also. That D03 did not disclose the specific permuters disclosed in the patent in suit was not relevant in this respect, because the claim was not restricted to the use of these permuters.

The additional restrictions in claim 1 of the granted were "not substantive enough" to establish an inventive step.

VI. The respondent argued essentially as follows:

The fact that claim 7 of the patent did not explicitly define the order of the permuting and comparing steps did not result in the claim defining added subject-matter, because for the skilled person it was unambiguously derivable from the wording of the claim that the permuting step must be carried out before the comparing step.

Neither D02 nor D03 disclosed a permuting step as defined in claim 7 which was carried out before the comparing step. Moreover, the step in D02 referred to by the appellant relating to the LINSTD field merely selected address elements to generate a single data output, not multiple data structures as required by the claim. The same applied to the parsing step described in

D03. The further teaching in D03 relating to the phonetic database did not disclose the permuting and comparing steps as claimed, because it described only the changing of characters in the data record, not permuting them.

Reasons for the Decision

1. The appeal is admissible.
2. *Request for oral proceedings (Article 116 EPC)*

In accordance with the established case law of the Boards of Appeal, the appellant's statement in their letter of 11 September 2015 that they would not attend the oral proceedings appointed for 21 October 2015 is considered as an implicit withdrawal of their request for oral proceedings. Thus, since the board is in a position to decide against the appellant on the basis of the facts and submissions presently on file, that can be done without holding those oral proceedings.

3. *Added subject-matter (Article 100(c) EPC)*

The appellant has argued that the opposition ground under Article 100 (c) EPC prejudices the maintenance of the patent as granted because, unlike the corresponding disclosure in the application as originally filed, claim 7 of the patent did not specify that the step of comparing the address data from the user with the database occurred after the step of applying the query permuters to that data. The board does not however agree with the appellant's interpretation of the claim which underlies this objection. In the view of the board, the

appellant's interpretation would be plausible only if the claim were interpreted purely in grammatical terms. It is however established case law of the Boards of Appeal that a patent is addressed to a person skilled in the art, and that the claims must be interpreted accordingly. The board therefore agrees with the respondent that the definition in granted claim 7 of "comparing the address data ... using a plurality of query permuters to the address data" can only be understood as specifying that the query permuters are applied to the address data before the comparison. Any other interpretation would not make sense technically, because if the query permuters were applied only after the comparison, that comparison would not be one "using" those permuters, as clearly required by the wording of the claim. The board therefore interprets claim 7 as defining the same sequence of operations as defined explicitly in claim 1, so that its subject-matter does not extend beyond the content of the application as originally filed. Therefore the opposition ground under Article 100(c) EPC does not prejudice the maintenance of the patent as granted.

4. *Novelty (Article 100(a) EPC with Article 54 EPC)*

4.1 The appellant has argued in their grounds of appeal that the subject-matter of claim 7 of the patent as granted is not new over D02 or D03.

4.2 This objection was based in part on the appellant's interpretation of that claim as discussed in paragraph 3. above, i.e. that it did not exclude that the permutation could take place after the step of comparing, as was the case in D02. However, for the reasons indicated above, the board is of the opinion that claim 7 does define that the step of applying the

query permuters is carried out before the step of comparing. Thus at least this feature of claim 7 establishes novelty over D02.

4.3 Claim 7 of the granted patent further requires that the application of the multiple query permuters be such as generate multiple data structures. Two of the steps identified by the appellant in documents D02 and D03 in this respect however generate only a single data structure, so that these aspects of the disclosure of these documents do not anticipate this feature of the claim. In D02 the appellant has referred to the description on page 20 relating to the LINESTD field, but this merely describes the selection of elements from different address structures to produce a single standardised data output. A similar argument applies to the parsing operation described on page 12 of D03. Thus neither of these prior art procedures can be considered as using multiple query permuters to generate multiple data structures as required by claim 7.

4.4 Moreover, the board is of the opinion that none of the steps described in documents D02 and D03, which the appellant argues represent applying query permuters within the meaning of claims 1 and 7 of the patent in suit, can be considered as being a step of permuting in the normal sense of that term, i.e. a step of changing the order of the elements (in this case the elements of the address data received from the user). Thus the operation relating to the LINESTD field in D02 as discussed above involves only the selection of address elements from different potential address data, not the changing of the order of those elements. Parsing as also discussed above with respect to D03 also does not involve a change in the order of the elements. The alternative process of D03 involving the phonetic

database (section "Phonetic Matching" spanning pages 2 and 3 of D03) could potentially result in the generation of different data structures for comparison with the database. However, the process described there involves only the changing of one or more of the phonetic characters, not a change in their order. Thus neither D02 nor D03 describes the application of query permuters to the address data.

4.5 From paragraphs 4.2 to 4.4 above it follows that the subject-matter of claim 7 of the patent as granted is new with respect to both of the documents D02 and D03 which were cited by the appellant in the context of novelty. Since claim 1 is more restricted than claim 7, the subject-matter of that claim is also new over those documents.

5. *Inventive step (Article 100(a) EPC with Article 56 EPC)*

As far as claim 7 is concerned, the appellant's objections relating to inventive step in claim 7 were based on the assumption that the features discussed in paragraphs 4.2 to 4.4 above were disclosed in D02 and D03, since they concern only the question whether other features of the claim (those relating to the communication between the remote device and the server) were obvious in the light of the prior art. Given the conclusions concerning the disclosure of D02 and D03 in paragraphs 4.2 to 4.4 above, that assumption was not valid, so that those objections must fail. The appellant has presented no arguments as to why the introduction of these features into either of the prior art methods might have been obvious. Since in the circumstances of the present case the onus is on the appellant to establish why the decision of the opposition division that the subject-matter of the claim involved an

inventive step was incorrect, the board concludes that that decision was indeed correct and that the subject-matter of claim 7 as granted involves an inventive step. Given that the granted claim 1 is more restricted than claim 7 and that the remaining claims of the granted patent are dependent on one or other of these claims, their subject-matter also involves an inventive step. Thus the board concludes that the opposition ground under Article 100(a) EPC does not prejudice the maintenance of the patent as granted.

6. In the light of the above conclusions, it is not necessary for the board to enter into discussion as to whether the features of the independent claims of the patent relating to the communication between the remote device and the server are implied by or obvious from D02 and D03. Similarly, it is not necessary for the board to consider the respondent's auxiliary requests.

7. For the above reasons, the board has to accede to the request of the respondent to dismiss the appeal.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:



C. Moser

M. Ruggiu

Decision electronically authenticated