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**Datasheet for the decision
of 11 March 2016**

Case Number: T 0729/11 - 3.5.02

Application Number: 00959608.1

Publication Number: 1221143

IPC: G07B17/00, G06K15/02

Language of the proceedings: EN

Title of invention:

Virtual page printing of indicia, logos and graphics

Patent Proprietor:

Stamps.Com

Opponent:

PSI Systems, Inc.

Relevant legal provisions:

EPC Art. 123(2), 123(3)

Keyword:

Main request - extension beyond the content of the application
as filed (yes)

Auxiliary request - extension of the scope of protection of
the claim (yes)

Amendments - inescapable trap (yes)



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Case Number: T 0729/11 - 3.5.02

D E C I S I O N
of Technical Board of Appeal 3.5.02
of 11 March 2016

Appellant: Stamps.Com
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Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 20 January 2011
revoking European patent No. 1221143 pursuant to
Article 101(3) (b) EPC.**

Composition of the Board:

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

Summary of Facts and Submissions

- I. The patent proprietor appealed against the decision of the Opposition Division, dispatched on 20 January 2011, to revoke the European patent No. 1 221 143 B1.

- II. The Opposition Division held that the grounds of opposition mentioned in Article 100(c) EPC prejudiced the maintenance of the patent as granted. The feature which was alleged to extend beyond the content of the application as filed reads as follows:
"mapping an image of said postal indicia (116, 119) onto the virtualized sheet (92)" (see item 2.1 of the reasons for the decision).
The division also held inter alia that the auxiliary requests 3, 5 and 6 then on file contravened Article 123(3) EPC.

- III. With the statement of grounds of appeal which was received on 30 May 2011, the appellant (patent proprietor) requested that the contested decision be set aside and that the patent be maintained as granted.

- IV. With a letter dated 12 October 2011 the respondent (opponent) requested that the decision to revoke the patent be maintained (i.e. that the appeal be dismissed) or, in the event that the claims were considered to satisfy the requirements of Article 123(2) and (3) EPC, that the case be remitted to the department of first instance for assessment of novelty and inventive step.

- V. In an annex to the summons to oral proceedings dated 23 October 2015 the Board expressed the preliminary opinion that the subject-matter of claims 1 and 15 of the granted patent extended beyond the content of the application as filed, contrary to Article 123(2) EPC.

- VI. With a letter dated 9 February 2016 the respondent withdrew its opposition, and is therefore no longer party to the proceedings.
- VII. With a letter dated 10 February 2016 the appellant filed claims according to an auxiliary request.
- VIII. Oral proceedings before the Board were held on 11 March 2016.
- IX. The appellant requested that the decision under appeal be set aside and the patent be maintained as granted (main request), or that the patent be maintained on the basis of the claims of the auxiliary request filed with letter dated 10 February 2016.
- X. Claim 1 of the main request reads as follows:
- "A method of printing postal indicia (116, 119) onto a print media comprising:
- determining a printer offset as a function of how the print media is fed into a printer;
 - generating a virtualized sheet in accordance with the size of the print media;
 - mapping an image of said postal indicia (116, 119) onto the virtualized sheet (92);
 - performing a margin requirement test on the mapped image; and
 - generating a print job for the virtualized sheet (92) if the margin requirement test is satisfied, wherein the image of said postal indicia (116, 119) is located within a printable region of the virtualized sheet (92) as a function of said printer offset; and
- printing said postal indicia (116, 119)."

Claim 15 of the main request reads as follows:

"A system for printing postal indicia comprising:
 means for determining a printer offset as a function of how an envelope is fed for printing;
 means generating a virtualized sheet in accordance with the size of the envelope;
 means for mapping an image of said postal indicia (116, 119) onto the virtualized sheet (92);
 means for performing a margin requirement test on the mapped image; and
 means for generating a print job for the virtualized sheet (92) if the margin requirement test is satisfied, wherein an image of said postal indicia (116, 119) is located within a printable region of the virtualized sheet (92) as a function of said printer offset; and
 a printer for printing said postal indicia (116, 119) onto said envelope responsive to the print job."

XI. Claim 1 of the auxiliary request reads as follows:

"A method of printing postal indicia (116, 119) onto an envelope comprising:
 determining a printer offset as a function of how the envelope is fed into a printer;
 generating a virtualized sheet in accordance with the size of the envelope;
 mapping an image of said envelope including said postal indicia (116, 119) onto the virtualized sheet (92);
 performing a margin requirement test on the mapped image; and
 generating a print job for the virtualized sheet (92) if the margin requirement test is satisfied, wherein the image of said postal indicia (116, 119) is

located within a printable region of the virtualized sheet (92) as a function of said printer offset; and printing said postal indicia (116, 119)."

Claim 15 of the auxiliary request reads as follows:

"A system for printing postal indicia comprising:
means for determining a printer offset as a function of how an envelope is fed into a printer;
means generating a virtualized sheet in accordance with the size of the envelope;
means for mapping an image of said envelope including said postal indicia (116, 119) onto the virtualized sheet (92);
means for performing a margin requirement test on the mapped image; and
means for generating a print job for the virtualized sheet (92) if the margin requirement test is satisfied, wherein an image of said postal indicia (116, 119) is located within a printable region of the virtualized sheet (92) as a function of said printer offset; and
a printer for printing said postal indicia (116, 119) onto said envelope responsive to the print job."

XII. The appellant argued essentially as follows:

The feature "mapping an image of said postal indicia (116, 119) onto the virtualised sheet (92)" was supported by figure 9 and the corresponding passage of the description. The steps referenced with numbers 85 and 87 in figure 9 were labelled "Locate envelope image in accordance with printer offset" and "Render envelope image". The image could not be rendered without the postal indicia. The envelope was only a rectangle and it would have made no sense to map and render or print a

rectangle onto an envelope. Original claim 1 further recited "wherein an image of said postal indicia is located within a printable region of the virtualized sheet as a function of said printer offset". It was thus clear that the postal indicia was mapped. It was also clear from figures 20 to 22 that the term "envelope" was synonymous with "postal indicia". Furthermore page 2, lines 15 to 20 defined the margin requirements to be applied to the postal indicia and page 14, lines 2 to 10 in combination with figures 11 and 20A and page 18, last paragraph clearly demonstrated that the margin test was done on the postal indicia. Thus the postal indicia was mapped onto the virtualised sheet.

In claim 1 of the auxiliary request the above feature was amended to read "mapping an image of said envelope including said postal indicia (116, 119) onto the virtualized sheet (92)". This feature, interpreted in the light of the description according to Article 69 EPC, satisfied the requirements following from Article 123(2) and (3) EPC because both the envelope and the postal indicia were mapped. A person with a mind willing to understand would not have interpreted the patent differently, so that the scope of protection was not changed by the amendment.

XIII. In a reply to the statement of grounds of appeal dated 12 October 2011 the then respondent argued that the conclusion in the decision under appeal regarding the granted patent was correct.

Reasons for the Decision

1. The appeal is admissible.
2. *Main request / Article 123(2) EPC*
 - 2.1 The Opposition Division considered that with the introduction of the feature "mapping an image of said postal indicia (116, 119) onto the virtualized sheet (92)" the subject-matter of claims 1 and 15 of the granted patent had been extended beyond the content of the application as filed, contrary to Article 123(2) EPC.
 - 2.2 The Board notes that a mapping mode is mentioned at page 17, lines 23 to 28 of the published International application (WO 01/16889 A1). The proposed mapping mode is HiEnglish. HiEnglish is defined as a mapping mode in which "each unit in the page-space coordinates is mapped to 0.001" in device-space coordinates and the value of X increases to the right and Y increases up from the bottom". Other mapping modes can be found e.g. on the Microsoft internet site at <https://msdn.microsoft.com/en-us/library/windows/desktop/dd162980%28v=vs.85%29.aspx>. A mapping mode like HiEnglish can thus be seen as a kind of translation factor or magnifying factor. Hence the appellant is right when he submits that "mapping an image of an envelope clearly and unambiguously implies that also postal indicia which are present in the envelope are mapped onto the virtualised sheet".
 - 2.3 This however does not imply that the original application discloses the mapping of a postal indicia per se onto a virtualised sheet as now defined in claim 1 of the main request.

- 2.4 The appellant was not able to indicate any passage of the description reciting this added feature and agreed in writing that the original application on page 13, lines 31 to 32 discloses only "to map an image of an envelope onto a virtualized sheet" (see statement of grounds of appeal at page 3, section II.3).
- 2.5 As described in the application, a postal indicia is only usable if positioned on an envelope according to the USPS regulations. Thus the postal indicia would not be mapped onto a virtualised sheet without taking account of its future position on an envelope at the end of the rendering process or printing process. Hence, the Board shares the view of the opposition division that "for mapping an image of a postal indicia only, it is necessary to locate the postal indicia within the print media (envelope) in order to get an image of it" (see item 2.2.1 of the reason for the decision), whereas this is not necessary when the whole envelope is mapped onto the virtualised sheet. The postal indicia is thus not a separate object but an information element embedded in the image of the envelope when the envelope is mapped onto the virtualised sheet.
- 2.6 The Board therefore shares the view of the former respondent and the Opposition Division that the two expressions "mapping an image of said postal indicia (116, 119) onto the virtualized sheet (92)" and "to map an image of an envelope onto a virtualized sheet" are not equivalent and that therefore the subject-matter of claims 1 and 15 of the granted patent extends beyond the content of the application as filed, contrary to the requirements of Article 123(2) EPC.

3. *Auxiliary request / Article 123(3) EPC*

In claim 1 of the auxiliary request, the feature of the main request which contravenes Article 123(2) EPC, namely "mapping an image of said postal indicia (116, 119) onto the virtualized sheet (92)", has been replaced by the feature "mapping an image of said envelope including said postal indicia (116, 119) onto the virtualized sheet (92)".

3.1 The Board does not agree with the appellant's argument that the term "including" can be used to interpret the claim as implicitly defining a step of mapping a postal indicia in addition to a step of mapping an envelope. Moreover, if claim 1 were to be interpreted as comprising a step of mapping a postal indicia separate from the step of mapping the envelope, then claim 1 of the auxiliary request would contravene Article 123(2) EPC for the same reasons as claims 1 and 15 of the main request.

3.2 The new feature of claim 1 of the auxiliary request has therefore to be interpreted in the sense that the image of the envelope includes a postal indicia as an image element, just as it includes for instance the name of an addressee, and that this image of the envelope is mapped onto the virtualised sheet. Following this interpretation, the Board considers that the scope of protection conferred by claim 1 has been shifted from mapping of a postal indicia per se, as in the patent as granted, to mapping of an envelope in the auxiliary request. The method steps for mapping a postal indicia alone onto a virtualised sheet are however not the same as those necessary for mapping an envelope comprising inter alia a postal indicia as image information.

For mapping an image of a postal indicia per se onto a virtualised sheet, it is necessary to know the position of the virtualised sheet with respect to the envelope and thereby the relative position of the postal indicia with respect to the envelope (see last paragraph of page 5 of the contested decision and item 2.5 above). When mapping an envelope onto the virtualised sheet, it is assumed that the virtual envelope comprises all the necessary information such as the addressee's name and address, as well as the postal indicia which would be positioned according to the USPS regulations. The Board therefore shares the opinion of the opposition division that for mapping an image of an envelope including a postal indicia onto a virtualised sheet it is not necessary to know the location of the postal indicia on the envelope. The Board concludes therefore that the replacement of the feature "mapping an image of said postal indicia (116, 119) onto the virtualised sheet (92)" in claim 1 of the auxiliary request extends the scope of the protection beyond that conferred by the granted patent, contrary to Article 123(3) EPC.

- 3.3 In the light of the above arguments, the Board is also not convinced by the appellant's arguments referring to Article 69 EPC. Given the extremely limited teaching of the application relating to the mapping step (as discussed in particular in points 2.2 and 2.4 above), the Board considers, contrary to the argument of the appellant, that the skilled person would not be able to draw any clear conclusions as to whether the wording of the granted claim was intended to have the same meaning as that of the auxiliary request, so that an application of Article 69 EPC in this case would not result in a different conclusion being reached concerning conformity with Article 123(3) EPC.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:



U. Bultmann

R. Lord

Decision electronically authenticated