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**Datasheet for the decision  
of 1 December 2016**

**Case Number:** T 2009/12 - 3.5.03

**Application Number:** 01939896.5

**Publication Number:** 1303971

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H04M3/50, H04M3/527, H04M3/53,  
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**Language of the proceedings:** EN

**Title of invention:**  
Recipient control over aspects of incoming messages

**Applicant:**  
Pitney Bowes Inc.

**Headword:**  
Recipient control of messages/PITNEY BOWES

**Relevant legal provisions:**  
RPBA Art. 12(4), 13(1)

**Keyword:**  
Late-filed requests - admitted (no)

**Decisions cited:**  
T 0641/00, T 0361/08, T 0144/09

**Catchword:**



**Beschwerdekammern**  
**Boards of Appeal**  
**Chambres de recours**

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Case Number: T 2009/12 - 3.5.03

**D E C I S I O N**  
**of Technical Board of Appeal 3.5.03**  
**of 1 December 2016**

**Appellant:** Pitney Bowes Inc.  
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**Representative:** Hoffmann Eitle  
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**Decision under appeal:** **Decision of the Examining Division of the  
European Patent Office posted on 10 May 2012  
refusing European patent application  
No. 01939896.5 pursuant to Article 97(2) EPC.**

**Composition of the Board:**

**Chairman** F. van der Voort  
**Members:** K. Schenkel  
O. Loizou

## **Summary of Facts and Submissions**

- I. This appeal is against the decision of the examining division refusing European patent application No. 01939896.5, publication number EP 1 303 971 A, which was originally filed as international application PCT/US01/18132 (publication number WO 01/95595 A).
- II. In its decision, the examining division noted that with a letter dated 3 May 2012 the applicant had requested a decision according to the state of the file. As to the grounds for the decision, reference was made to a communication dated 20 February 2012, in which the claimed subject-matter was considered to lack an inventive step (Articles 52(1) and 56 EPC).
- III. In the notice of appeal the appellant requested that the decision be set aside and that a patent be granted. With the statement of grounds of appeal, a new set of claims 1 to 18 was filed, replacing all previous claims on file. Oral proceedings were conditionally requested.
- IV. In a communication accompanying a summons to oral proceedings, the board, without prejudice to its final decision, expressed doubts as to the technical nature of some of the features of claim 1 and raised an objection under Article 52(1) EPC in conjunction with Article 56 EPC (lack of inventive step) in respect of the subject-matter of claim 1.
- V. In response to the board's communication, the appellant filed with a letter dated 17 October 2016 sets of claims of a main request and first and second auxiliary requests and submitted arguments in support of these requests.

VI. Oral proceedings were held on 1 December 2016.

The appellant requested that the decision under appeal be set aside and that a patent be granted on the basis of the claims of a main request or, in the alternative, of one of first and second auxiliary requests, all requests filed with the letter dated 17 October 2016.

At the end of the oral proceedings, after due deliberation, the chairman announced the board's decision.

VII. Claim 1 of the main request reads as follows:

"A system, comprising:  
a plurality of messaging systems comprising hardware and software for processing respective messages intended for recipients;  
a data center comprising hardware and software in operative communication with the plurality of messaging systems for storing a recipient preference profile associated with each respective recipient; and  
a control system comprising hardware and software for:  
accessing an intended recipient preference profile corresponding to an intended recipient of a message;  
and using the intended recipient preference profile to process the message;  
wherein  
the recipient preference profile includes no interest data pertaining to senders that the intended recipient does not wish to receive messages from;  
the recipient preference profile includes interest data indicating if the recipient has any desire to hear from particular types of senders;  
the control system is further for editing messages to the intended recipient to suit an interest of the

recipient if the messaging system is operated by a sender described by the no interest data."

VIII. Claim 1 of the first auxiliary request differs from claim 1 of the main request in that the wording starting from "wherein" has been amended to read as follows:

"wherein:  
the recipient preference profile provides a message hold instruction;  
the control system is further for not dispatching messages to the intended recipient while the message hold instruction is active; and  
the control system is further for collecting discrete messages directed to the intended recipient while the hold instruction is active and consolidating the collected discrete messages into a composite message for delivery to the intended recipient when the hold instruction is not active."

IX. Claim 1 of the second auxiliary request differs from claim 1 of the main request in that the wording starting from "wherein" has been amended to read as follows:

"wherein:  
the recipient preference profile provides an indication of a preferred format for messages; and  
the control system is further for dispatching messages to the intended recipient in the preferred format."

### **Reasons for the Decision**

1. All requests - admissibility

- 1.1 The main request and the two auxiliary requests were filed less than seven weeks before the oral proceedings. Each of these requests therefore constitutes an amendment to a party's case within the meaning of Article 13(1) RPBA.
- 1.2 In accordance with Article 13(1) RPBA, any amendment to a party's case after it has filed its grounds of appeal may be admitted and considered at the board's discretion. The discretion shall be exercised in view of inter alia the complexity of the new subject-matter submitted, the current state of the proceedings and the need for procedural economy. In line with the established case law of the boards of appeal, in connection with the need for procedural economy the question of whether or not the claim is clearly allowable may be taken into account.
- 1.3 Further, following T 361/08 (reasons, point 13) and T 144/09 (reasons, point 1.17), in exercising its discretion under Article 13(1) RPBA, the board considers it appropriate to take into account the provision of Article 12(4) RPBA, which reads:

"Without prejudice to the power of the Board to hold inadmissible facts, evidence or requests which could have been presented or were not admitted in the first instance proceedings, everything presented by the parties under (1) shall be taken into account by the Board if and to the extent it relates to the case under appeal and meets the requirements in (2)."
- 1.4 For the reasons set out below, none of the requests was admitted to the appeal proceedings.

2. Article 13(1) RPBA - Inventive step

2.1 Technical character and starting point for examining inventive step

The board notes that, following T 641/00 "Two identities/COMVIK" (OJ EPO 2003, 352), claimed subject-matter consisting of a mixture of technical and non-technical features and having technical character as a whole is to be assessed with respect to the requirement of inventive step by taking account of all those features which contribute to the technical character, whereas features making no such contribution cannot support the presence of inventive step. Where a feature cannot be considered as contributing to the solution of any technical problem by providing a technical effect, it has no significance for the purpose of assessing inventive step.

In the present case, the board concurs with the appellant that the subject-matter of claim 1 of each of the requests has technical character as a whole, each claim 1 being directed to a system which includes messaging systems, a data center, and a control system, each of these including hardware and software (see points VII to IX above).

Starting point for examining inventive step in the present case is a post office and, more specifically, the various services offered by the postal authority (see the application as published, pages 1 and 2, "Background of the Invention").

2.2 Main request - claim 1

2.2.1 The system of claim 1 of the main request includes



a plurality of messaging systems comprising hardware and software for processing respective messages intended for recipients;  
a data center comprising hardware and software in operative communication with the plurality of messaging systems for storing a recipient preference profile associated with each respective recipient; and  
a control system comprising hardware and software for:  
accessing an intended recipient preference profile corresponding to an intended recipient of a message;  
and using the intended recipient preference profile to process the message.

Using a stored recipient preference profile to process messages is part of the mail forwarding service commonly offered by a post office when a recipient wishes to have his messages redirected to a different address. This well-known service is also described in the background section of the present application. It was further known at the priority date (6 June 2000) that post offices made use of computers for processing the messages, including mail forwarding services. This was not contested by the appellant. The board further notes that the messaging systems, the data center and the control system as claimed are, apart from comprising hardware and software, defined only in terms of their known functions.

The board therefore concludes that the above-mentioned features of claim 1 were known at the priority date of the present application.

2.2.2 Claim 1 further includes the features that the recipient preference profile includes no interest data pertaining to senders the intended recipient does not wish to receive messages from, that the recipient

preference profile includes interest data indicating if the recipient has any desire to hear from particular types of senders, and that the control system is further for editing messages to the intended recipient to suit an interest of the recipient if the messaging system is operated by a sender described by the no interest data.

The effect of these further features is that the recipient is given the possibility to distinguish between two groups of senders based on his personal preference, namely depending on whether or not he wants to receive messages, for example letters, from the respective senders. This distinction is a matter of the recipient's subjective choice and does not require the exercise of any technical skills. Further, the corresponding editing of messages referred to in the claim may be intended for the recipient's attention only and does not necessarily imply a technical function. For example, the messages of senders the recipient is not interested in may be marked accordingly. Technical considerations only come into play when implementing the editing of these messages. However, marking these messages, for example by marking the envelopes of senders the recipient is not interested in, is straightforward and, hence, does not contribute to an inventive step.

2.2.3 In view of the above, the board concludes that at least prima facie the subject-matter of claim 1 of the main request does not involve an inventive step (Articles 52(1) and 56 EPC).

2.3 First auxiliary request - claim 1

- 2.3.1 As to the first part of claim 1 concerning the messaging systems, the data center and the control system, the board refers to point 2.2.1 above.
- 2.3.2 Claim 1 further includes the features that the recipient preference profile provides a message hold instruction, that the control system is further for not dispatching messages to the intended recipient while the message hold instruction is active, and that the control system is further for collecting discrete messages directed to the intended recipient while the hold instruction is active and for consolidating the collected discrete messages into a composite message for delivery to the intended recipient when the hold instruction is not active.

These further features give the recipient the possibility of temporarily stopping the delivery of messages intended for him and of receiving these messages later on en bloc. This is a purely organisational or administrative concept of offering a service to a recipient, according to which he will not receive messages during a certain period of time and, instead, will receive these messages afterwards, which does not require the exercise of any technical skills.

With respect to the feature of consolidating discrete messages into one composite message, the board notes that the term "consolidating" is not further specified in the claim and may therefore be interpreted broadly. It may thus simply mean packing multiple envelopes together in one big envelope. This straightforward implementation of consolidating the messages thus does not contribute to an inventive step.

2.3.3 In view of the above, the board concludes that at least prima facie the subject-matter of claim 1 of the first auxiliary request does not involve an inventive step (Articles 52(1) and 56 EPC).

2.4 Second auxiliary request - claim 1

2.4.1 As to the first part of claim 1 concerning the messaging systems, the data center and the control system, the board refers to point 2.2.1 above.

2.4.2 Claim 1 further comprises the features that the recipient preference profile provides an indication of a preferred format for messages and that the control system is further for dispatching messages to the intended recipient in the preferred format.

The indication of a preferred format by the recipient is a purely administrative concept which as such does not require the exercise of any technical skills. Further, the board notes that the wording "preferred format" in connection with messages may be understood as relating to any physical or electronic property of the message, independent of the content or purpose of the message, for example, the image format of the message or the maximum envelope size of a physical message. The dispatching of the messages by the control system in accordance with the preferred format, i.e. without any specific technical features in connection with the dispatching having been defined in the claim, is then straightforward without contributing to an inventive step.

2.4.3 In view of the above, the board concludes that at least prima facie the subject-matter of claim 1 of the second auxiliary request does not involve an inventive step

(Articles 52(1) and 56 EPC).

- 2.5 The appellant argued that the features added to claim 1 of the main and the auxiliary requests involved using electronically stored data and affected the technical operation of the system.

The board concurs with the appellant that an implied use of electronically stored data and its affecting of the technical operation of the system make it clear that the claimed subject-matter has technical character. However, for the reasons set out above, which take into account all those features which contribute to the technical character, the features in question do not result in claimed subject-matter which involves an inventive step.

- 2.6 The board therefore concludes that the main request and the first and second auxiliary requests are not clearly allowable.

3. Article 12(4) RPBA

- 3.1 During the examination procedure, the examination division issued two communications, in which several aspects of the claims were considered to be non-technical and in which objections under Articles 52(1) and 56 EPC (lack of inventive step) against inter alia claim 1 were raised. Notwithstanding these objections, the applicant did not amend any of the claims in an attempt to overcome the objection.

Further, with the statement of grounds of appeal, only minor linguistic amendments were made to claims 7 to 12 as originally filed: in claim 7 the wording "step(s)" was replaced by "steps" and in claims 8 to 12 the

wording "step(s)" was replaced by "step", whereas claim 1 remained identical to claim 1 as originally filed.

The board concludes that the applicant deliberately chose not to make use of any of the several occasions during the examination procedure to file amended claims.

- 3.2 It was only in response to the board's communication, namely less than seven weeks before the oral proceedings, that the appellant filed new claims, including, for the first time, amendments to claim 1.
- 3.3 The board sees no reason why the requests currently on file could not have been presented by the applicant in the first instance proceedings. Neither did the appellant present any such reasons.
4. In view of the above, exercising its discretion pursuant to Articles 12(4) and 13(1) RPBA, the board did not admit the main request and the first and second auxiliary requests into the appeal proceedings.
5. There being no allowable request, it follows that the appeal is to be dismissed.

## **Order**

### **For these reasons it is decided that:**

The appeal is dismissed.

The Registrar:

The Chairman:



G. Rauh

F. van der Voort

Decision electronically authenticated