

Internal distribution code:

- (A) [-] Publication in OJ
- (B) [-] To Chairmen and Members
- (C) [-] To Chairmen
- (D) [X] No distribution

**Datasheet for the decision
of 7 June 2017**

Case Number: T 2582/12 - 3.5.02

Application Number: 03029883.0

Publication Number: 1439496

IPC: G07B17/00

Language of the proceedings: EN

Title of invention:
System for tracking mailpieces

Patent Proprietor:
Pitney Bowes Inc.

Opponent:
Neopost Technologies

Relevant legal provisions:
EPC Art. 123(3)

Keyword:
Amendments - shift of scope of protection (yes)



Beschwerdekammern
Boards of Appeal
Chambres de recours

European Patent Office
D-80298 MUNICH
GERMANY
Tel. +49 (0) 89 2399-0
Fax +49 (0) 89 2399-4465

Case Number: T 2582/12 - 3.5.02

D E C I S I O N
of Technical Board of Appeal 3.5.02
of 7 June 2017

Appellant: Pitney Bowes Inc.
(Patent Proprietor) One Elmcroft Road
Stamford, CT 06926-0700 (US)

Representative: Hoffmann Eitle
Patent- und Rechtsanwälte PartmbB
Arabellastraße 30
81925 München (DE)

Respondent: Neopost Technologies
(Opponent) 113, rue Jean-Marín Naudin
92220 Bagneux (FR)

Representative: CBDL Patentanwälte
Königstraße 57
47051 Duisburg (DE)

Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 8 October 2012
revoking European patent No. 1439496 pursuant to
Article 101(3) (b) EPC.**

Composition of the Board:

Chairman R. Lord
Members: M. Léouffre
J. Hoppe

Summary of Facts and Submissions

- I. The patent proprietor appealed against the decision of the opposition division to revoke the European patent No. 1 439 496.
- II. During the oral proceedings, which took place before the board on 7 June 2017, the appellant (patent proprietor) requested that the decision under appeal be set aside and that the patent be maintained in amended form:
on the basis of
- the set of claims of a main request filed with the statement of grounds of appeal,
- or if that is not possible,
- on the basis of the set of claims of a first auxiliary request filed with letter dated 15 July 2013,
 - or of a second auxiliary request filed as first auxiliary request with the statement of grounds of appeal,
 - or of a third auxiliary request filed with the letter dated 15 July 2013.

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

- III. Claim 1 of the main request reads as follows (the highlighted terms are terms which have been added to the wording of claim 1 as granted):

"A system for acquiring and storing mailpiece processing and tracking details in association with mailing details for a mailpiece, wherein said mailing details are received from a postal delivery system, said system comprising:

at least one mailpiece processing system (40, 50, 60, 70) **suitable** for generating a mailpiece **with a mailpiece tracking identifier thereon having a first part that is unique to a particular mailer and having a second part which identifies the mailpiece to that mailer**, said processing system configured to generate an electronic file containing processing details for generated mailpieces;

at least one imaging device (70) for acquiring images of the faces of said generated mailpieces;

a database (20) for storing said mailpiece processing details, **said mailpiece tracking identifiers**, said acquired images and tracking details for the mailpieces;

an electronic communication system (30) linking said database to a said postal delivery system for input of said tracking details, said at least one mailpiece processing system for input of **said mailpiece tracking identifiers and** said processing details and said imaging device for input of said acquired images;

a computer (10) coupled to said database configured to create a searchable electronic catalog whereby the respective **mailpiece tracking identifier**, mailpiece processing **details** and tracking details and said acquired image for each mailpiece are associated;

wherein:

said computer (10) is linked to a remote user computer (110) configured to enable a user to conduct a search for a mailpiece tracking details in said database (20); and

said computer (10) is configured to present to the user, in response to an electronic search request of the user defining **a search term being the first part of** a mailpiece tracking identifier that is unique to a particular mailer used on the mailpiece, a said acquired image of each mailpiece matching the search

term, and when a mailpiece image is selected by said user, present to the user said mail tracking details stored in association with said selected mailpiece image."

IV. Claim 1 of the first auxiliary request differs from claim 1 of the main request in that the term "suitable" is deleted, and claim 1 of each of the second and third auxiliary requests is based respectively on the main or first auxiliary request, with the addition that the second part of the mailpiece tracking identifier "is defined and assignable by the mailer to identify the mailpiece to that mailer".

V. The appellant's arguments in so far as they are relevant for the present decision are as follows:

The electronic search request defined in claim 1 of the contested patent was amended to read "an electronic search request of the user defining **a** search term being **the first part of** a mailpiece tracking identifier" while the whole mailpiece tracking identifier was used in the granted claim 1.

The definition of the mailpiece tracking identifier remained however specified as comprising a first part unique to a particular mailer and a second part identifying the mailpiece, and a search based on a first part of the mailpiece identifier was limiting and restricted the scope of claim 1 with respect to the scope of claim 1 as granted. Article 123(3) EPC was therefore not infringed.

VI. According to the respondent the definition of the search term in the final paragraph of claim 1 of the main request changed the scope of protection. The respondent essentially argued as follows:

Paragraph [0046] of the published patent defined search possibilities comprising full term searches or partial term searches or searches based on a combination of either full terms or partial terms. In other words the computer searches disclosed in that paragraph were either searches based on full strings or partial strings or a combination of either full strings or partial strings.

The feature of granted claim 1 defining the search term was based on that paragraph [0046] but encompassed only searches based on full terms i.e. full strings.

Claim 1 of the main request and of each of the first to third auxiliary requests defined solely a search based on the first part of the mailpiece tracking identifier i.e. a search based on a partial string.

The amendment to claim 1 therefore shifted the scope of protection conferred by the patent in such a way that it contravened Article 123(3) EPC.

Reasons for the Decision

1. The appeal is admissible.
2. Article 123(3) EPC
 - 2.1 The search term was defined in granted claim 1 by the feature "said computer (10) is configured to present to the user, in response to an electronic search request of the user defining one or more search terms being a mailpiece tracking identifier that is unique to a

particular mailer used on the mailpiece, the recipients' zip code, the date the mailpiece was processed or sent, the recipients' name, the recipients' address, the postage amount applied, the serial number of the postage meter that applied postage to the mailpiece or the recipients' phone number".

2.2 The term "identifier" occurs in combination with the term "mailpiece" five times in the original application, in the passages corresponding to paragraphs [0007] and [0013] of the contested patent. None of these passages gives a clear definition of the "mailpiece tracking identifier".

In claim 1 of the granted patent the mailpiece tracking identifier was defined as an alternative to other search terms such as the zip code or the date the mailpiece was processed. These other search terms are defined in paragraph [0046] and figure 6 as search parameters. The board therefore concludes that the Planet CODE mentioned in paragraph [0046] as a further search parameter corresponds to the mailpiece tracking identifier. Thus, in the embodiment of the invention according to the granted patent the PLANET CODE as a whole, in other words as a full string, was used as a possible search term and referred to as "mailpiece tracking identifier" in claim 1 of the granted patent.

2.3 In claim 1 of the main request the other listed search terms have been deleted and the remaining search term is now defined as "being the first part of a mailpiece tracking identifier that is unique to a particular mailer". This first part corresponds to the first 5 digits of the PLANET CODE (see definition of the PLANET CODE in paragraph [0032] of the granted patent).

- 2.4 The board agrees with the respondent that the scope of the claim of the main request is now modified to a search based on a partial string, i.e. part of the PLANET CODE, rather than on a full string as in claim 1 of the granted patent, because the computers in the systems claimed in the granted claim 1 and in claim 1 of the main request would need to be configured differently.
- Furthermore a first part of a mailpiece tracking identifier as now claimed is a mailer identifier and not a mailpiece identifier as defined in claim 1 of the granted patent, so that the searches performed using these search terms would produce different results.
- 2.5 The scope of protection conferred by claim 1 of the main request has therefore been shifted with respect to that conferred by claim 1 of the granted patent, such that it covers systems which were not protected by the granted patent. Therefore the main request contravenes Article 123(3) EPC.
- 2.6 The feature defining the search term and infringing Article 123(3) EPC as discussed above is incorporated in the same terms in claim 1 of each of the first to third auxiliary requests, which therefore also contravene Article 123(3) EPC.
3. Thus none of the appellant's requests is allowable, so that the board has to accede to the respondent's request to dismiss the appeal.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:



U. Bultmann

R. Lord

Decision electronically authenticated