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Datasheet for the decision of 11 April 2017

Case Number: T 2384/13 - 3.2.05

Application Number: 02725957.1

Publication Number: 1392516

IPC: B41L47/46

Language of the proceedings: EN

Title of invention:
Loss of Funds Prevention for Postage Meters and Personal Computer Meters

Patent Proprietor:
Pitney Bowes Inc.

Opponent:
Francotyp-Postalia GmbH

Relevant legal provisions:
RPBA Art. 12(4)
EPC 1973 Art. 56

Keyword:
Late-filed evidence - document could have been filed in first instance proceedings (yes)
Inventive step - (yes)

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Case Number: T 2384/13 - 3.2.05

D E C I S I O N
of Technical Board of Appeal 3.2.05
of 11 April 2017

Appellant: (Opponent)	Francotyp-Postalia GmbH Prenzlauer Promenade 28 13089 Berlin (DE)
Representative:	Schaumburg und Partner Patentanwälte mbB Mauerkircherstraße 31 81679 München (DE)
Respondent: (Patent Proprietor)	Pitney Bowes Inc. One Elmcroft Road Stamford, CT 06926 (US)
Representative:	Hoffmann Eitle Patent- und Rechtsanwälte PartmbB Arabellastraße 30 81925 München (DE)
Decision under appeal:	**Decision of the Opposition Division of the European Patent Office posted on 29 October 2013 rejecting the opposition filed against European patent No. 1392516 pursuant to Article 101(2) EPC.**

Composition of the Board:

Chairman	H. Schram
Members:	S. Bridge
	G. Weiss

Summary of Facts and Submissions

I. The appeal was lodged by the opponent against the decision of the opposition division rejecting the opposition filed against the European patent No. 1 392 516.

II. The opposition was filed against the patent as a whole based on Article 100(a) EPC 1973 (lack of novelty, Article 54 EPC 1973 and lack of inventive step, Article 56 EPC 1973), Article 100(b) and 100(c) EPC 1973.

III. Oral proceedings were held before the board of appeal on 11 April 2017.

IV. The appellant (opponent) requested that the decision under appeal be set aside and that the European patent be revoked.

V. The respondent (patent proprietor) requested as sole request that the decision under appeal be set aside and the patent be maintained in amended form based on the set of claims filed as 4th auxiliary request under cover of a letter of 8 March 2017.

VI. Claim 1 of the sole request reads as follows:

"A method for generating and printing an indicium to a mailpiece comprising the steps of:

detecting a mailpiece (100) by a first sensor (13) located upstream of a printing mechanism (14);

generating an indicium for the mailpiece (101);

determining by a second sensor (18) located between the first sensor (13) and the printing mechanism (14) if the mailpiece is properly aligned with said printing mechanism to print the generated indicium (105);

providing a buffer (16) for holding indicium data coupled to the second sensor;

printing the generated indicium on the mailpiece if the mailpiece is properly aligned with the printing mechanism (106); and

automatically printing the generated indicium on a tape if the mailpiece is not properly aligned with the printing mechanism."

VII. The following documents are referred to in the present decision:

E1: EP 0 558 329 A;
E2: EP 0 782 109 A;
E5: US 6,111,951 A.

VIII. The arguments of the appellant in the written and oral proceedings can be summarised as follows:

The feature "*providing a buffer (16) for holding indicium data coupled to the second sensor*" of claim 1 of the sole request was not present in corresponding claim 8 as filed. This feature thus constitutes added subject-matter which was not originally disclosed.

Document E5 discloses a postage meter with an ink jet print head for which the postage print image has to be composed before printing. This document has been filed as a direct response to the opposition decision, namely, that document E1 concerns a drum printer which does not require an image to be composed for printing (grounds for appeal, page 5, first two paragraphs). For this reason, the filing of document E5 is caused by the contested decision and should thus be admitted into the proceedings.

Document E1 constitutes the closest prior art, has a first sensor 97A and a second sensor 99 for detecting misaligned sheets and requires selecting the required amount of postage to be printed on the mail piece. The device of document E1 does not disclose a buffer for storing the image to be printed. However, the corresponding feature of claim 1 of the sole request - to provide a buffer (16) for holding indicium data coupled to the second sensor - is not related to the rest of the claim and does not appear to make any sense in the context of that claim.

Document E2 addresses the generally known "*typical problem*" for postage meters in general, namely that postage funds have already been debited from the secure accounting function even when the corresponding indicia have not been successfully printed on the mail piece (column 2, lines 41 to 46). Document E2 discloses all features of claim 1 of the sole request except for the sensors for skew detection. To avoid having to take mailpieces with misprinted indicia to the post office for a refund, the solution of document E2 is that, when an indicia generated from a digital token has not been successfully printed on a mailpiece, it is possible to reissue the digital token for printing the indicia on a label (column 4, lines 53 to 59). Thereby, the additional feature of claim 1 of the sole request, namely to automatically print the indicia onto a tape, does not require an inventive step by the skilled person. Thus the subject-matter of claim 1 of the sole request lacks an inventive step.

IX. The arguments of the respondent in the written and oral proceedings can be summarised as follows:

The subject-matter of claim 1 of the sole request is supported by the detailed description of the embodiment of figures 1 and 2, in which the operator has set a default "preferred method" for handling misaligned mail pieces to be printed automatically on a tape and which has a buffer for holding indicium data coupled to the second sensor.

The appellant's late filing of document E5 is not a reaction to the decision of the opposition division because the appellant, then opponent, already knew that document E1 concerns a drum printer which does not require that an image be composed: see the final paragraph on page 4 of their Grounds of Opposition where this is stated. The preliminary opinion annexed to the summons to oral proceedings sent by the opposition division was negative for the opponent for the same reason. Document E5 is cited in the international search report and belongs to the appellant who could thus have introduced it during the opposition proceedings. The appellant, then opponent, had reasons to introduce it, but chose not to do so. Late filed document E5 should not be admitted into the appeal proceedings.

In document E1, sheet skew is detected and the skew flag is set in step 317 of the flow chart of figure 6 before the operator selects to operate the mailing machine for printing a postage by actuating the print key 262 in step 320, 320B (column 19, line 15 to column 20, line 1). Similarly postage funds cannot be deducted before the operator actuates the print key, but the availability of funds must have been checked prior to

steps 338 and 340 in which the device is shut down because of insufficient funds (column 21, lines 8 to 45). Thus document E1 teaches away from printing on a tape, because the deduction of the funds for the postage from the secure accounting unit occurs after skew detection: the problem to be solved in the present invention cannot arise in the device of document E1 in which skew detection occurs first thereby preventing funds from being deducted when the sheet is misaligned.

In document E2, the problem of funds having been deducted even when the indicia are not correctly printed is solved by storing a digital token corresponding to the postage and allowing the token to be later reissued for printing. Document E2 does not disclose any sensors for skew detection.

The skilled person would not consider combining the teachings of these documents, because they concern different, incompatible kinds of systems: document E1 concerns a secured, analogue, closed postage meter and document E2 is an open digital system.

Even if the skilled person were to combine documents E1 and E2 he would not arrive at the subject-matter of claim 1 of the sole request, because neither document E1 nor document E2 discloses automatic printing on a tape when the sheet is misaligned. The argumentation of the appellant concerning document E1 and E2 thus appears to be *ex post facto*.

Therefore, subject-matter of claim 1 of the sole request involves an inventive step.

Reasons for the Decision

1. *Claim 1 (sole request) - Article 100(c) EPC*

The appellant raised an objection under Article 100(c) EPC with respect to the feature "*providing a buffer (16) for holding indicium data coupled to the second sensor*" of claim 1 of the sole request, said feature not having been present in the corresponding claim 8 as filed.

This objection is late filed since claim 1 of the sole request had not been objected to under Article 100(c) EPC in either the opposition procedure or in the appellant's statement of their grounds of appeal.

According to Article 13(1) of the Rules of Procedures of the Boards of Appeal (RPBA, Supplementary publication 1 - OJ EPO 2017, 41-51), any amendment to a party's case after it has filed its grounds of appeal (or reply) may be admitted and considered at the board's discretion.

As set out in the minutes, the late filed objection is not allowable, because, as explained by the chairman during the oral proceedings and accepted by the appellant, the detailed description relating to the method of figure 2 refers to "*data [being] stored in ASIC buffer 16*" (Figure 2, step 102; column 4, lines 45 to 47) and this buffer is furthermore coupled to the second sensor (column 4, lines 6 to 8: "*If sensor 18 determines that mailpiece 11 is not properly aligned along mail path 12 with print head 14, sensor 18 will inform ASIC 16 of this fact*").

The board thus exercises its discretion under under Article 13(1) RPBA, to not admit this late filed objection.

2. *Admissibility of Document E5*

Document E5 is a patent issued to the appellant and is cited in the international search report of the application underlying the patent in suit. The appellant, then opponent, acknowledged in the statement of their grounds for opposition that a limitation of their inventive step argumentation was that document E1 concerned a drum-printer which did not involve composing and storing an image of postal indicia for printing (grounds for opposition, page 4, last paragraph). In the annex to the summons to oral proceedings, the opposition division set out in their preliminary opinion that they considered that also for this reason the skilled person would not appear to seek to combine the teachings of documents E1 and E2 (Communication of 7 March 2013, page 3, last eleven lines).

Therefore, the appellant had had reasons to present document E5 during the opposition proceedings. Furthermore, the appellant had had several opportunities to do , but chose not use them. Instead, document E5 was only filed with their grounds of appeal.

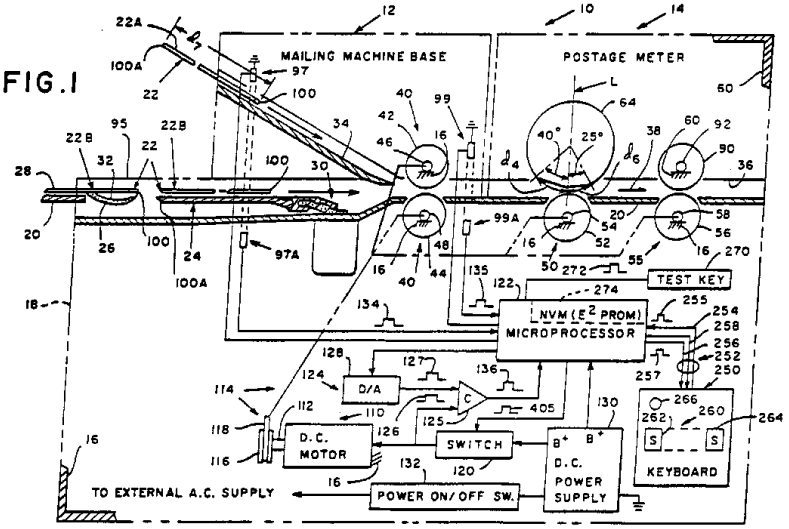
The only reason provided by the appellant for the late filing was the argumentation in the opposition decision concerning inventive step (point 2.3.2). However, this argumentation corresponds to the one which was already set out in the preliminary opinion issued by the opposition division with the summons to opposition oral proceedings.

Therefore, the board concludes that the appellant could and should have presented document E5 during the opposition procedure. In consequence, the board exercises its discretion under Article 12(4) RPBA to not admit document E5 into the appeal procedure.

3. *Inventive step (Articles 100(a) and 56 EPC)*

3.1 Both parties referred to document E1 as the staring point for considering the issue of the inventive step of the subject-matter of claim 1. Document E1 concerns a mailing machine 10 using a conventionally constructed rotary postage indicia printing drum 64 for printing postage indicia, registration data or other selected indicia on a sheet 22 in the path of travel (column 3, lines 28 to 31; column 8, lines 13 to 18) and, in consequence, does not disclose generating an indicium for the mailpiece.

FIG.1



The mailing machine has a (second) sheet feeding sensor 99A which is more gradually blocked when the sheet is fed in a skewed position (figures 14 to 17). This sensor can detect whether the sheet 22 is properly aligned for printing or not.

FIG. 14

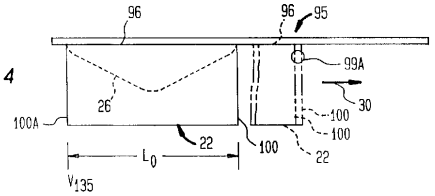


FIG. 15

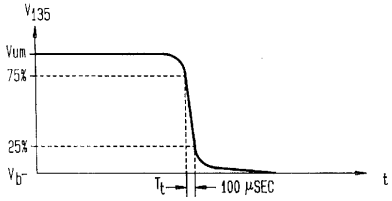


FIG. 16

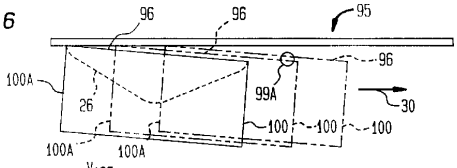
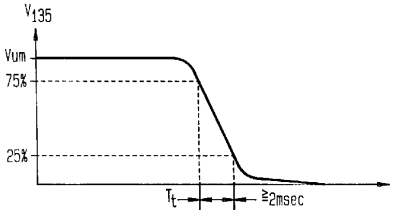


FIG. 17



If the mailpiece is not properly aligned with the printing mechanism, the skew flag is set in step 317 of the flow chart of figure 6, causing an error flag to be set, the service light to blink and to causes the device to perform a shutdown: thus, implicitly, the printing mechanism will not print on improperly aligned sheets (column 8, lines 26 to 34; column 41, lines 55 to 57; column 44, lines 42 to column 45, line 3, figure 6, step 340).

FIG. 6A

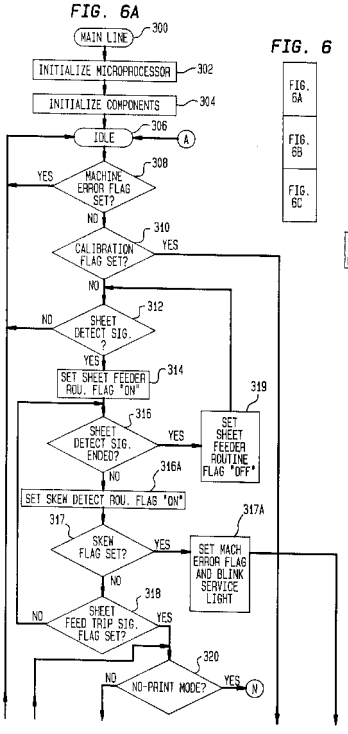


FIG. 6

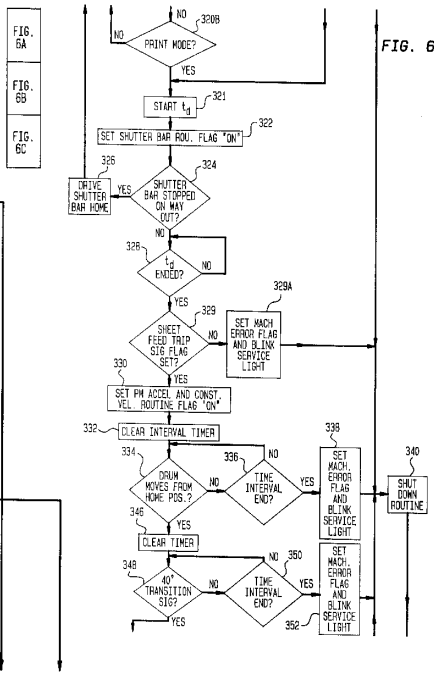


FIG. 6B

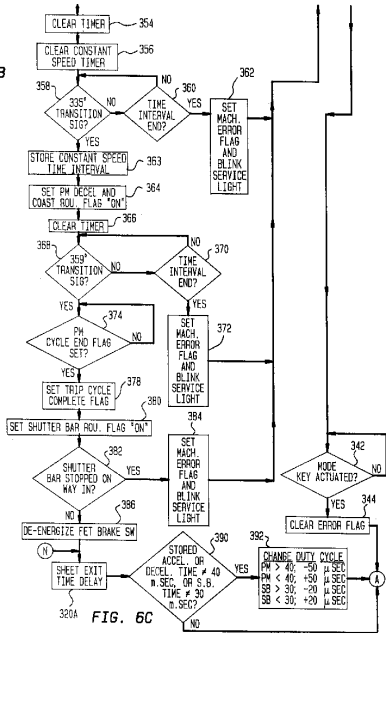


FIG. 6C

The point in time at which funds for the postage are deducted from the accounting unit is not explicitly disclosed in document E1. However, this time can only lie between the point in time at which the operator

selects to operate the mailing machine for printing a postage by actuating the print key 262 (Figure 6A, steps 320 and 320B; column 19, line 22 to column 20, line 1) and the time at which a shutdown may be caused due to insufficient funds (Figure 6B, steps 338 and 340; column 21, lines 8 to 45).

The flow chart of figure 6 thus further discloses that the sheet skew detection occurring in step 317 takes place before an operator can initiate printing of a postage indicium in steps 320B.

In consequence, the problem of the patent in suit (paragraph [0008]), that funds already deducted from the secure accounting unit were not printed correctly because of an improper alignment of the mailpiece with the printer, cannot arise in the mailing machine of document E1.

In addition, document E1 neither discloses a buffer for holding indicium data coupled to the second (skew detecting) sensor 99A nor automatically printing the generated indicium on a tape if the mailpiece is not properly aligned with the printing mechanism.

3.2 The subject-matter of claim 1 thus differs from the mailing machine of document E1, in that

- an indicium is generated for the mailpiece;
- a buffer is provided for holding indicium data coupled to the second sensor;
- the generated indicium is automatically printed on a tape if the mailpiece is not properly aligned with the printing mechanism.

The technical effect of the latter feature in particular is to solve the problem set out in the patent in

suit, namely, of having to return to the post mail pieces with improperly printed indicia due to improper alignment of the mailpiece with the printer (paragraph [0008]).

3.3 Document E2 concerns a method of reissuing digital tokens in an open system meter comprising the steps of:

- calculating a digital token using the predetermined postal information including addressee information, postage amount and piece count;
- debiting postal funds by the postage amount;
- issuing the digital token to be used in generating an indicia;
- storing the digital token and the predetermined postal information as part of a transaction record in a transaction record file indexed according to piece count;
- determining that the indicia generated from the digital token has not been successfully printed on a mailpiece for a particular addressee; and

reissuing the digital token from the transaction record in the transaction file to regenerate the indicia for the mailpiece (Document E2, claim 1).

Document E2 discloses that a buffer (DLL module 40) securely stores an indicia image and that a user interface (module 42) provides access to this indicia image for printing the postal revenue block on a document, such as an envelope or label (column 4, lines 53 to 59).

Although document E2 thereby suggests printing on a label, it does not disclose *automatically* printing the generated indicium on a tape if the mailpiece is not properly aligned with the printing mechanism. Instead

document E2 allows a digital token to be reissued for printing via a user interface.

3.4 Since neither document E1 nor document E2 disclose automatically printing the generated indicium on a tape if the mailpiece is not properly aligned with the printing mechanism, the combination of these documents cannot lead to the subject-matter of claim 1 of the sole request.
Furthermore, it is not clear why the skilled person would even have considered combining the teaching of these two documents, since the problem to be solved is structurally prevented from arising by the device of document E1.
The subject-matter of claim 1 of the sole request is not rendered obvious by the teachings of documents E1 and E2.
Therefore, the subject-matter of claim 1 of the sole request meets the requirements of Article 56 EPC 1973.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.

2. The case is remitted to the department of first instance with the order to maintain the patent in amended form on the basis of the following documents:
   - claims 1 to 3 of the sole request (former 4th auxiliary request) filed on 8 March 2017,
   - description and drawings as granted.

The Registrar: The Chairman:

D. Meyfarth H. Schram

Decision electronically authenticated