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**D E C I S I O N**  
of 5 September 1995

**Case Number:** T 0371/93 - 3.4.1

**Application Number:** 83303628.8

**Publication Number:** 0098104

**IPC:** G07B 17/02

**Language of the proceedings:** EN

**Title of invention:**

Method and apparatus for individualized selection of special  
fee postage value computations

**Patentee:**

PITNEY BOWES, INC

**Opponent:**

Francotyp-Postalia GmbH

**Headword:**

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**Relevant legal provisions:**

EPC Art. 52, 84

**Keyword:**

"Clarity (yes, after amendment)"  
"Inventive step (yes)"

**Decisions cited:**

T 0153/85

**Catchword:**

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Case Number: T 0371/93 - 3.4.1

**D E C I S I O N**  
of the Technical Board of Appeal 3.4.1  
of 5 September 1995

**Appellant:**  
(Opponent) Francotyp-Postalia GmbH  
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**Representative:** Thoenes, Dieter, Dr  
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**Respondent:**  
(Proprietor of the patent) PITNEY BOWES, INC  
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**Representative:** Price, Paul Anthony King  
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**Decision under appeal:** Decision of the Opposition Division of the  
European Patent Office dated 15 February 1993  
rejecting the opposition filed against European  
patent No. 0 098 104 pursuant to Article 102(2)  
EPC.

**Composition of the Board:**

**Chairman:** G. D. Paterson  
**Members:** Y. J. F. van Henden  
H. J. Reich

**Summary of Facts and Submissions**

I. An opposition was filed against European patent No. 0 098 104 on the grounds mentioned in Article 100(a) and (b) EPC. Documents:

D1: US-A-4 286 325 and

D2: US-A-4 325 440,

were referred to in the Notice of Opposition.

II. The Opposition Division rejected the opposition.

According to the decision, the ground mentioned in Article 100(b) EPC does not prejudice the maintenance of the patent, since the description discloses at least one way of carrying out the invention.

III. The Opponent lodged an appeal against the decision of the Opposition Division. Besides documents D1 and D2, document

D4: US-A-4 320 461

was cited in the Statement of Grounds of Appeal.

IV. The Respondent requested that the patent be maintained in amended form based on a set of five claims filed with a letter dated 23 December 1993, the passage of the description which extends from the word "processor" in line 31 of column 1 to the line 61 of column 2 being replaced by the text on pages 2 to 4 of description jointly filed.

Claims 1 and 4 of this set are independent claims reading:

"1. An apparatus for the computation of a postage value, comprising: a system in which a processor (4) operated by a program (14) is used with independently physically replaceable rate and directory memories (6,12) wherein said rate memory (6) includes rate chart data used to compute postage values for articles to be mailed in various modes and under special conditions in response to actuations of a keyboard (10), said directory memory (12) stores vectors for directing said program in said processor to rate charts and special fee computations to which access is requested by actuations of said keyboard, and said rate memory (6) also includes a special fee rate screen byte (23) containing bits (24.1-24.8) which control access to said special fee computations, characterized in that said directory memory (12) incorporates at a predetermined location (30) a special fee control byte (28) containing bits (32.1-32.8) which control access to said special fee computations."

"4. A method for controlling access to the computation of special fees with a postage value computing system having a program operated processor (4), a physically replaceable rate memory (6) storing postage rate information, and a directory memory (12) storing vectors for directing the program in the processor to rate charts and special fee computations to which access is requested by actuations of a keyboard, the directory memory (12) being physically replaceable independently of the rate memory (6), the method comprising the steps of:  
storing in the rate memory (6) a special fee rate screen byte (23) which controls access to the special fee computations;

reading at a location (30) in the directory memory (12) a special fee control byte (28) which controls access to the special fee computations; combining the special fee rate screen byte (23) with the special fee control byte (28) to form a modified rate fee screen byte (38); and computing special fees in accordance with the modified rate fee screen byte (38)."

Claims 2 and 3 are appended to Claim 1 and Claim 5 is appended to Claim 4.

- V. In a communication pursuant to Article 11(2) RPBA, the Rapporteur of the Board expressed the preliminary view that the subject-matter of the amended claims seemed to involve an inventive step in view of the cited prior art documents.
- VI. Oral Proceedings were held on 5 September 1995.
- VII. During the oral proceedings, the Respondent filed a set of claims forming the basis of an auxiliary request, and pages 2 to 4 of description with text amended accordingly to replace the passage of the description already mentioned under point IV. Said set differs from that received with letter of 23 December 1993 in that the following feature has been added at the end of Claim 1:

"and said system further comprises means (36) for combining said special fee rate screen byte (23) with said special fee control byte (28) to form a modified rate fee screen byte (38) which controls access to said special fee computations",

and in that an amendment has been performed in Claim 3.

VIII. The Appellant maintained its former request that the patent be revoked since its subject-matter according to each of the Respondent's requests would lack an inventive step. Furthermore, the Appellant submitted that Claim 1 of the Respondent's main request would not meet the requirement of clarity according to Article 84 EPC. Moreover, the Appellant held that the deletion, in the Respondent's auxiliary request, of the second paragraph on page 4 of the originally filed description resulted in an unallowable extension of the subject-matter of the patent.

IX. In support of its request, the Appellant submitted essentially the following arguments.

(a) Clarity of Claim 1 of the main request

It is now stated in the claim both that the rate memory has a special fee rate screen byte and that the directory memory has a special fee control byte, which bytes control the access to special fee computations. It is however not clear from the claim how this access control works and which relation there is between the rate fee screen byte and the control byte. Consequently, the claim does not comprise all the features essential to the invention and is therefore not clear. The only disclosure in the application of how the access is controlled is that the two bytes are combined with an AND function to form a modified rate fee screen byte. This feature, which is specified in Claim 3 of the main request, should therefore be included in Claim 1 in order for the claim to be clear.

(b) Inventive step

Document D4 relates to an apparatus for the computation of a postage fee, said apparatus comprising a system having a processor and independently physically replaceable rate and directory memories. The rate memory includes rate chart data used to compute postage values and the directory memory stores vectors for directing the program to the processor rate charts. Furthermore, document D4 refers to document D1 concerning the description of the program and memory arrangement of the system. From document D1 it is clear that the rate memory comprises a special fee screen byte. Document D4 in combination with document D1 thus discloses all the features of the preamble of Claim 1. It is furthermore noteworthy that document D4 tackles the same problem as the patent in suit. An object of the invention disclosed there is indeed to provide a postage value calculating system which permits changes of stored data without having to reprogram the system.

The subject-matter of Claim 1 is therefore distinguished over the disclosure in document D4 in that the directory memory incorporates a special fee control byte, which thus in combination with the special fee rate screen byte controls the access to the special fee computations. The special fee control byte in the directory memory thus provides an additional layer of control of the special fee computation.

However, from document D1 (see column 24, lines 20 to 39) it is already known that the directory memory includes a byte for controlling which country codes are allowed. It is thus known from document D1 that the directory memory can perform a second level of control. It would therefore be obvious to the skilled person that the directory memory can be used to supply an additional

level of control also for special fee computation. The obvious way of doing this is to provide the directory memory with a special fee control byte which is combined with the special fee rate screen byte in the rate memory in order to perform the extra level of control. The subject-matter of Claim 1, both according to the main and the auxiliary request, is therefore obvious to the person skilled in the art.

The method of Claim 4 is distinguished over the one to be carried out according to document D1 only in the way the access to the rate charts is governed by the control byte. This is achieved in that the control byte stored in the directory memory is each time combined with the rate fee screen byte read from the rate memory, whereupon a modified rate screen byte is formed. The modified rate fee screen byte then controls the access to the individual rate charts and is processed in the computation of fees in the same way as the original, unchanged rate fee screen byte. This, however, is a programming measure which can be taken at the discretion of the skilled person and does not involve an inventive step.

- X. The Respondent maintained the request made in its Statement of Grounds of Appeal and, subsidiarily, requested that the patent be maintained on the basis of Claims 1 to 5 as filed during the oral proceedings, with corresponding amendments to the description.

In support of its requests, the Respondent argued in substance as follows:



(a) Clarity of Claim 1 of the main request

The essential idea of the invention is the double level of control of access to the special fee computations. This double level of control is achieved by having both a special rate fee screen byte in the rate memory and a special fee control byte in the directory memory. These features are mentioned in Claim 1, and therefore Claim 1 already comprises the features essential to the invention. The fact that the control can be done by combining the special fee rate screen byte with the special fee control byte to form a modified rate fee screen byte must be seen to constitute a specific solution which is not essential to the invention, and limiting the invention to this specific solution would constitute an unfair limitation of the scope of protection.

(b) Inventive step

The person skilled in the art is taught by the cited documents that a special fee rate screen byte - called "special fee mask" in document D1 - may be stored in the rate memory of a postage meter and used to control access to special fee computations. Different special fee rate screen bytes are provided for different classes of service, because a particular special fee may be permitted for use with a particular class of service but prohibited for use with another class of service. The skilled person would also appreciate that the special fee rate screen bytes are dictated by the requirements of the postal authorities and thus would be the same for all purchasers of the postage meter.

According to Claim 1, the rate memory (6), which is frequently changed as postage rates are updated, continues to contain the special fee rate screen byte

(23) which is generic to all users, whereas customisation to suit the particular fee requirements of the purchaser is achieved by providing a special fee control byte (28) in the directory memory (12), which byte is also used to control access to the special fee computation. The special fee control byte (28) may be used to block access to a particular special fee even if the special fee rate screen byte (23) would allow access to that special fee. The special fee control byte (28) is accordingly set to override the special fee rate screen byte (23) when the user has no need for one or more particular special fee(s), whereby accidental depression of the corresponding key(s) has no consequence.

If a skilled person were to have thought of providing user customisation, he would probably have retained a single layer of access control by customising the special fee rate screen byte in the rate memory, or after having moved said byte to the directory memory. The first option, however, is complicated and expensive, since postage rate charts are frequently changed. The second option requires a change of directory memory when the postage authorities change the special fee regime. In contrast, a postage meter embodying the invention comprises an extra level of control of access to the special fee computations, and there is no suggestion in the prior art of providing such extra level of control. Even if document D1 discloses that some country codes may be excluded by the directory memory, there is no hint that the directory memory should control the access to special fee computations. Furthermore, the country code selection according to document D1 does not constitute a double level of control.

According to the present invention, if the special fee regime or the postage rate charts are changed the new rate memory may be the same for all users, and thus may be mass produced at low cost. The expense of producing a new user-customised directory memory occurs only when the user wishes to change his special fee control byte which is not liable to happen frequently.

- XI. At the conclusion of the oral proceedings, the decision was announced that the case is remitted to the first instance with the order to maintain the patent in accordance with the Respondent's auxiliary request.

#### Reasons for the Decision

1. In the appeal, the Appellant did not challenge the Opposition Division's decision as far as sufficiency of disclosure (Article 100(b) EPC) is concerned. Neither did the Appellant submit that the amendments to the claims introduced subject-matter extending beyond the content of the application as filed or extended the protection conferred.

Since the Board is satisfied that the amended claims meet the requirement of Articles 123(2) and (3) EPC and that also Article 83 EPC is complied with, the decision shall only be concerned with the question of the clarity of Claim 1 of the main request, inventive step and the objection against the deletion of a paragraph in the description.

2. *Deletion of a paragraph in the description*

The paragraph which is not included in the description according to the Respondent's auxiliary request had the following wording in the description as originally filed:

"The special fee control byte is stored in the directory memory. The directory includes suitable pseudo rate charts for controlling access to rate charts as described in the aforementioned patent application to Dlugos et al. The directory is thus preferably individualized for the particular user both as to rate charts and special fees."

The Appellant's objection to the deletion of this paragraph was not supported by any arguments or explanations as to why the deletion resulted in an unallowable extension.

The Board notes that the pseudo rate charts mentioned in this paragraph were never part of any claim, and except for the special fee control byte, which is specified in the independent claims, the content of this paragraph was never described as being essential to the invention. In the Board's judgement, therefore, the deletion of this paragraph does not offend against any of paragraphs (2) and (3) of Article 123 EPC.

3. *Main request*

Clarity of Claim 1

Claim 1 states that the rate memory includes a special fee rate screen byte which controls the access to special fee computations and that the directory memory includes a special fee control byte which also controls

the access to special fee computations. However, the functional relationship between these two independent controls of access is not stated in the claim. It is therefore not clear how the actual control of access is realised in the apparatus. Moreover, it is not clear by what technical means it is possible to achieve a user specific control of access, which is one of the aims of the invention, on which technical aim the Respondent bases its essential arguments for the existence of an inventive step.

Nevertheless, from the description and from Claim 4 it can be derived that the special fee rate screen byte is combined with the special fee control byte to form a modified rate fee screen byte which controls access to the special fee computations. This functional relationship specifies the connection between the rate memory control of access and the directory memory control of access unambiguously. Furthermore, since the mentioned bytes are combined, it is possible that by making the special fee control byte user specific, user specific control of the special fee computations may be achieved. In the Board's view, therefore, the above mentioned feature in Claim 4 (corresponding to the originally filed Claim 6), which has been added to Claim 1 of the auxiliary request, is essential to the invention.

Since Claim 1 of the main request does not include the above mentioned essential feature, the claim does not fulfil the requirement of clarity according to Article 84 EPC. Consequently, the main request does not meet the requirements of the EPC, and the patent cannot be maintained according to the main request.

4. *Auxiliary request*

4.1 Inventive step of Claim 1

4.1.1 Document D4 constitutes the closest prior art and discloses (see in particular the abstract, column 3, lines 45 to 51, column 4, lines 18 to 36 and Figures 1 and 2) an apparatus for the computation of postage values, comprising a system in which a processor operated by a program is used with rate and directory memories wherein said rate memory includes rate chart data used to compute postage values for articles to be mailed in various modes and under special conditions in response to actuation of a keyboard, and wherein said directory memory stores vectors for directing said program in said processor to rate charts and special fee computations to which access is requested by actuation of said keyboard. In column 4, lines 18 to 36, it is explained that the directory memory and the rate memories constitute separate PROMs which can be plugged in to a circuit board. It is therefore clear that these memories are independently physically replaceable.

In column 2, lines 35 to 44 document D4 directly refers to document D1 for a description of the memory and typical program implementing the system of document D4. Since document D4 explicitly refers to document D1 for a description of the memory and program, these parts of document D1 must be seen as part of the disclosure of document D4 (cf. T 153/85, OJ EPO 1988, page 1). From document D1, column 14, lines 32 to 49 and Figure 10 it is clear that the rate memory includes a special fee rate screen byte containing bits which control access to special fee computations. It therefore follows that document D4 discloses all the features of the

pre-characterizing portion of Claim 1. However, document D1 does not disclose the features of the second portion of the claim.

4.1.2 The claimed subject-matter is thus distinguished over the prior art disclosed in document D4 in that the directory memory incorporates at a predetermined location a special fee control byte containing bits which control access to the special fee computations, and in that the system further comprises means for combining the special fee rate screen byte with the special fee control byte to form a modified rate fee screen byte which controls access to the special fee computations.

By the claimed invention, the system is customized in that the access to special fee computations may be included or excluded by the special fee control byte in the directory memory, which has the advantage that when the postal rates are updated, the rate memory, which can be the same for all customers, is changed while the user specific control byte in the directory memory can be maintained.

4.1.3 The Board agrees with the Respondent that, if the skilled person were to make the system of document D4 more user specific, there are different possible options: it would be possible to customize the special fee rate screen byte in the rate memory, and it would be possible to move the special fee rate screen byte to the directory memory and make this memory user specific. However, in the Board's view there is no indication in the cited prior art which would lead the skilled person to provide a double level of control by maintaining the special fee rate screen byte in the rate memory by additionally providing a special fee rate control byte in the directory memory for the intended modifications

and by making the actual control dependent on the combination of both bytes. In particular, the Board does not share the Appellant's opinion that document D1 would teach a double level of control in view of the allowed country codes. In column 24 of document D1 it is disclosed that a byte in the directory table indicates the highest country code number used in the table. There is however no indication in document D1 that the rate memory includes a corresponding country code byte, hence no indication that two country code bytes would be combined to form a modified country code byte. Therefore, the Board cannot accept that document D1 teaches a double level of control of the country codes, and, consequently there is no indication which would lead the skilled person to provide a double level of control of the special fees, as claimed in Claim 1.

The Board is thus satisfied that the subject-matter of Claim 1 involves an inventive step in view of the cited documents.

4.2 Inventive step of Claim 4

The method claimed in Claim 4 comprises corresponding features to those of Claim 1. In particular, the method comprises the steps of combining a special fee rate screen byte stored in the rate memory with a special fee control byte stored in the directory memory to form a modified rate fee screen byte. The Board thus reaches the conclusion that the subject-matter of Claim 4 involves an inventive step for the same reasons as Claim 1.

5. For the foregoing reasons, in the Board's judgement, the amended patent according to the Respondent's auxiliary request meets the requirements of the EPC.



**Order**

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

1. The decision under appeal is set aside.
2. The case is remitted to the first instance with the order to maintain the patent with the following documents:

**Description:** amended columns 1 and 2, with pages 2,3 and 4 inserted, as filed on 5 September 1995;

Columns 3 and 4 to line 52 according to EP-B1-0 098 104;

**Claims:** 1 to 5 filed on 5 September 1995;

**Drawing:** according to EP-B1-0 098 104.

The Registrar:

The Chairman:

M. Beer

G. D. Paterson

