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D E C I S I O N
of 18 September 2001

Case Number: T 0120/97 - 3.5.2

Application Number: 88306277.0

Publication Number: 0298775

IPC: G07B 17/02

Language of the proceedings: EN

Title of invention:
Franking machine

Applicant:
NEOPOST LIMITED

Opponent:
-

Headword:
-

Relevant legal provisions:
EPC Art. 56

Keyword:
"Inventive step - (yes) after amendment"

Decisions cited:
-

Catchword:
-



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Boards of Appeal

Chambres de recours

Case Number: T 0120/97 - 3.5.2

D E C I S I O N
of the Technical Board of Appeal 3.5.2
of 18 September 2001

Appellant: NEOPOST LIMITED
South Street
Romford
Essex RM1 2AR (GB)

Representative: Boden, Keith McMurray
Fry Heath & Spence
The Old College
53 High Street
Horley
Surrey RH6 7BN (GB)

Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 1 August 1996
refusing European patent application
No. 88 306 277.0 pursuant to Article 97(1) EPC.

Composition of the Board:

Chairman: W. J. L. Wheeler
Members: F. Edlinger
B. J. Schachenmann

Summary of Facts and Submissions

I. The appeal is against the decision of the examining division refusing European patent application No. 88 306 277.0 on the ground that its subject-matter lacked an inventive step in view of the state of the art disclosed in the following documents:

D1: GB-A-2 174 039 and

D2: EP-A-0 125 526.

II. In the oral proceedings before the Board held on 18 September 2001, the appellant filed amended claims 1 to 7 and pages 2, 2a and 2b of the description.

III. Claim 1 has the following wording:

"A printing and franking device (11) for operation by computer means (10), comprising: electronic means (19) operable to carry out accounting and control functions; register means (20,21) for storing a value of credit available for use in franking; input means (23) connected to said electronic means (19) for receiving data relating to franking and addressing of mail items (30) from computer means (10); and printing means (22); said electronic means (19) being operative in response to received data relating to a desired franking to interrogate said register means (20,21) to check if sufficient credit is available for said desired franking, and being further operative, if said check indicates sufficient credit, to route said received data relating to franking and addressing to said printer means (22) to cause said printer means (22) to print a franking (29) and an address (32)

on a mail item (30)."

Claims 2 to 7 are dependent on claim 1.

- IV. The reasons given in the decision under appeal, in so far as they are applicable to the present claim 1, may be summarized as follows:

D1 disclosed a franking machine system in which a postage printer was also used to print address information on a mail item. An accounting unit (14) comprising register means and electronic means was coupled to external computer means (user computer 28) which in turn controlled a printer (30). In the present application, a computer means (10) was coupled to electronic means (19) which in turn was connected to the printer means (22). The choice between these two system structures would be made dependent on whether the person skilled in the art preferred a system with an insecure printer and a secure (encrypted) communication link (D1), or a system with a secure printer and an insecure communication link between the accounting unit and the computer means (present application). In both systems, printing of postage which was not accounted for would be prevented.

D2 disclosed a franking machine system comprising a printer and an accounting circuitry in a common secure housing and thus suggested the different system structure of the present application. The fact that the printer in D1 was arranged to print both address and postage information did not discourage the skilled person from readily envisaging an alternative system structure as disclosed in D2. Therefore, the subject-matter of the claims under consideration did not

involve an inventive step.

V. The appellant argued essentially as follows:

Generally known franking machines were not capable of printing a destination address because these devices had rotary drum printers or flat bed printers. With these machines, the required postage value was input by means of a keyboard and the printer set to print a fixed pattern and the required variable postage value. D2 referred to such classical franking machines and aimed at reducing the number of components in the secure housing to substantially only a printer and an electronic accounting system.

The franking machine system of D1 constituted the closest prior art in that it disclosed a PC based system including, as peripheral devices, an accounting unit and a user printer which was capable of printing a destination address. However, the electronic means of the accounting unit, in response to information received from the computer means, generated encrypted information and returned it to the user computer which controlled the printing. Since postage information was transmitted via two insecure links, encryption derived from address information was utilized to prevent fraudulent use. Authentication was verified from the encrypted information and the address information printed as plain text in the address field.

D1 did not disclose a printing and franking device as a single peripheral unit with electronic means which was operative to route the received data to the printer means to cause the printer means to print the franking and address as specified in claim 1 of the present

application. "To cause said printer means (22) to print" required that the printer was directly controlled by the electronic means of the device. The device of claim 1 was much simpler and offered less opportunity for unauthorized interference since the received data were routed to the printer with no intervening equipment. The device did not pass postage information to a user computer and the printer was under the control of the electronic accounting means and not that of the user computer.

Although D1 was filed on behalf of the same applicant as that of D2, and filed later than D2, the inventors of D1 did not appreciate that the system of D2 could be adapted to print both postage charge information and address information, but took a different direction in that this information was encrypted and sent to a separate user computer which controlled the printer. Following the teaching of D1, there was no need to include the printer in a secure housing, as suggested in D2. Such a modification would thus be contrary to the teaching of D1. Nor would it be in line with the aim of D2 which was to reduce the number of secure components. The examining division's combination of the teachings of D1 and D2 was thus based on hindsight knowledge of the invention.

VI. The appellant requested that the decision under appeal be set aside and that a patent be granted in the following version:

Claims: 1 to 7 as filed in the oral proceedings;

Description: page 1 filed with letter dated 5 December 1994;

pages 2, 2a, 2b filed in the oral proceedings;

pages 3 to 7 as originally filed;

Drawings: sheets 1 and 2 as in the published application.

Reasons for the Decision

1. The appeal is admissible.

2. *Amendments*

Claims 1 to 7 are based on claims 1 to 7 as originally filed, which have been amended to specify that the "franking machine" is a "printing and franking device (11) for operation by computer means (10)", and "to route said data" has been replaced by "to route said received data". Editorial amendments have also been made. The substantive amendments are directly derivable from page 3, lines 30 to 33, page 4, lines 6 to 8, and page 5, lines 21 to 30, of the application as filed. The description has been adapted to the amended claims and references to prior art have been included. These amendments do not infringe Article 123(2) EPC.

3. *Novelty and inventive step*

3.1 D1 (page 4, lines 1 to 31; Figures 1 and 5A) discloses an accounting unit (14) and printer means (30) for printing a franking and an address. Both the accounting unit and the printer means are connected to computer means (28). The accounting unit comprises electronic

means, register means and input means as specified in present claim 1. However, it does not route the received data to the printer means to cause it to print, but returns the data (and an encryption message) to the computer means. Upon a print command being given by the computer operator, an encrypted message and plain text comprising recipient address information are printed on the mail item (see D1, page 2, lines 73 to 83 and 103 to 108; page 3, lines 1 to 14; page 4, lines 19 to 31; page 4, line 125 to page 5, line 10; Figures 1 to 3, 5A and 5B).

- 3.2 D2 discloses a franking device with a conventional postage printer which is controlled by way of secure signals from an accounting unit located together with the printer in a secure housing (page 8, lines 19 to 26; Figures 1 to 3). There is no hint in D2 that address information could be printed by this franking machine, nor that this printer means would be actually capable of printing all the characters which would be needed for printing data relating to addressing of mail.
- 3.3 None of the documents cited in the search report discloses a device as specified in claim 1 where the data relating to franking and addressing, received from computer means, are routed by the electronic (accounting) means to the printer means to cause said printer means to print a franking and an address on a mail item. Therefore, the subject-matter of claim 1 is considered to be new (Article 54(1) EPC).
- 3.4 The Board, in agreement with the appellant, is of the opinion that D1 reflects the closest prior art because D1 (page 2, lines 26 to 35; Figures 1 and 2) relates to

a PC based system comprising a (dot matrix) printer for printing, in a single printing operation, both a franking and an address on a mail item. D1 is concerned throughout with the use of an insecure printer for printing postage value and encryption information derived from the recipient's mailing address to enable verification of its authentication. It is for this reason that the system of D1 is capable of printing both a franking and an address by a single printer operative in response to information from a PC which is also at the core of the present application (cf pages 1 and 2, bridging paragraph).

- 3.5 The Board considers that the objective problem solved by the subject-matter of claim 1 with respect to the franking machine system disclosed in D1 is to find a simple alternative computer operated arrangement for printing franking and address information in a single printing operation.
- 3.6 D1 (page 4, lines 36 to 50 and 89 to 97; claims 39, 42 and 43; Figure 6) envisages connecting a second printer to a public bus (94) interconnecting an accounting unit (80) and the user computer (28). However, the second printer would still be under the conventional control of a user printer by the user computer. In fact, neither the location of the printer nor the control of the printing process in the system of D1 appears of particular importance because the printer may be insecure and authentication is based on an encryption message derived from address information. Therefore, D1 does not give any hint at a closer control of the printer means by the electronic (accounting) means in a printing and franking device in which the electronic means routes the received data to

the printer means to cause said printer means to print a franking and an address.

- 3.7 Starting from D1, the person skilled in the art would not get any useful hint from D2 how to solve this problem since the printer of D2 would not be suitable for printing address information. The combination of the teachings of D1 and D2 would rather lead the person skilled in the art to keep the encryption method and the insecure printer of D1 because this would be in line with the aim of D2 (page 3, lines 11 to 18), ie to reduce the number of components provided within the secure housing.
- 3.8 The same would be true if, for the sake of argument, D2 were taken as a starting point. In view of the problem mentioned in the present application (pages 1 and 2, bridging paragraph), to reduce the number of times a mail item has to be handled for it to be franked and addressed, the person skilled in the art would find, in D1, a solution which is different from that of the present application, but which also fulfils the aim of D2. Without knowledge of the present invention, there would be no obvious reason for selecting a printer such as disclosed in D1 and adapting the franking machine of D2 to provide a printing and franking device as specified in present claim 1.
- 3.9 The subject-matter of claim 1 as well as that of dependent claims 2 to 7 is thus considered as involving an inventive step (Article 56 EPC).

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 grant a patent in the following version:

Claims: 1 to 7 as filed in the oral proceedings;

Description: page 1 filed with letter dated
5 December 1994;
pages 2, 2a, 2b filed in the oral
proceedings;
pages 3 to 7 as originally filed;

Drawings: sheets 1 and 2 as in the published
application.

The Registrar:

The Chairman:

M. Hörnell

W. J. L. Wheeler