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D E C I S I O N
of 6 September 1999

Case Number: T 0943/97 - 3.5.2

Application Number: 89308561.3

Publication Number: 0356228

IPC: B07C 1/00

Language of the proceedings: EN

Title of invention:

Method and apparatus for categorizing and certifying mail

Patentee:

Pitney Bowes, Inc.

Opponent:

Neopost Ltd

Headword:

-

Relevant legal provisions:

EPC Art. 122, 108, 56

EPC R. 65(1)

Keyword:

"Restitution in integrum (yes; granted notice of appeal deemed to have been filed in due time)"

"Inventive step (yes)"

Decisions cited:

G 0001/86, J 0005/80, J 0016/82

Catchword:

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Boards of Appeal

Chambres de recours

Case Number: T 0943/97 - 3.5.2

D E C I S I O N
of the Technical Board of Appeal 3.5.2
of 6 September 1999

Appellant: Neopost Ltd
(Opponent) South Street
Romford, Essex, RM1 2AR (GB)

Representative: Weinmiller, Jürgen, Dipl.-Ing.
Spott & Weinmiller
Lennéstrasse 9
82340 Feldafing (DE)

Respondent: Pitney Bowes, Inc.
(Proprietor of the patent) World Headquarters
One Elmcroft
Stamford
Connecticut 06926-0700 (US)

Representative: Görg, Klaus, Dipl.-Ing.
Hoffmann Eitle
Patent- und Rechtsanwälte
Postfach 81 04 20
81904 München (DE)

Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 25 July 1997
rejecting the opposition filed against European
patent No. 0 356 228 pursuant to Article 102(2)
EPC.

Composition of the Board:

Chairman: W. J. L. Wheeler
Members: M. R. J. Villemin
B. J. Schachenmann

Summary of Facts and Submissions

I. The appellant filed an opposition against European patent No. 0 356 228 and now contests the decision of the opposition division posted on 25 July 1997 rejecting the opposition. The opposition ground invoked was that the subject-matter of claims 1 to 11 did not involve an inventive step (Article 100(a) EPC in conjunction with Articles 52(1) and 56 EPC) having regard to documents:

D1: US-A-4 136 780,

D2: US-A-4 516 264,

D3: Pamphlet "NORMALISATION DES OBJETS DE CORRESPONDANCE" edited by "DIRECTION GENERALE DES POSTES" in France in January 1978, pages 23 to 27,

D4: Document "Norme internationale ISO 1831"; "Spécifications d'impression des caractères pour reconnaissance optique"; first edition, 15 October 1980; pages i to iv and 1 to 42,

D5: US-A-4 167 476,

D6: FR-A-2 596 551.

II. The patent has not been amended. It has two independent claims 1 and 9.

Claim 1 reads as follows:

"Apparatus for categorising and certifying a batch of mail, the mail having an address, comprising:

(A) means (18, 26, 28) for scanning the mail pieces of said batch (14) of mail to produce data representative of the following parameters of each mail piece of the batch:

- (a) readability of the address on the mail piece,
- (b) deliverability of the mail piece,
- (c) weight of the mail piece,
- (d) dimensions of the mail piece,
- (e) the postage franking amount placed on the mail piece;

(B) means (20) for storing said data;

(C) means (21) for storing Post Office Regulations relating to acceptable values for address readability, deliverability, weight, dimensions of the mail pieces in said batch;

(D) means for comparing said stored data with said Post Office Regulations data; and

(E) means (24) for printing out a report which includes postage information for the batch of mail based upon information obtained from said mail pieces including size, weight, class and postage required for said mail pieces, said report serving to provide certification of the mail."

Claim 9 reads as follows:

"A method of categorising and certifying mail having an address, comprising the steps of:

- (A) electronically scanning the mail pieces of said batch to produce data representative of the following parameters of each mail piece of the batch:
 - (a) readability of the address on the mail piece,
 - (b) deliverability of the mail piece,
 - (c) weight of the mail piece,
 - (d) dimensions of the mail piece,
 - (e) the postage franking amount placed on the mail piece;
- (B) storing the data generated by said scanning;
- (C) storing data embodied in Post Office Regulations relating to acceptable values for address readability, deliverability, weight, and dimensions of the mail pieces in said batch;
- (D) comparing the stored data obtained in step (B) with said Post Office Regulations data; and
- (E) printing out a report which includes postage information for the batch of mail based upon information obtained from said mail pieces including size, weight, class and postage required for said mail pieces, said report serving to provide certification of the mail."

III. The notice of appeal against the decision referred to above was received on 8 September 1997, i.e. within two months after notification of the decision under appeal and the appeal fee was paid on the same day. However, it was not until 10 February 1998 that the statement of grounds arrived at the EPO. At the same time the appellant filed an application for restitutio in integrum pursuant to Article 122 EPC with respect to the 4 months time limit for filing the statement of grounds (Article 108 EPC, last sentence) and paid the corresponding fee.

According to the submissions of the appellant's professional representative the failure to meet the time limit referred to above was due to a coincidence of his handling the monitoring system during the absence of the senior secretary normally responsible for this task and a later error on her part. The representative had entered only the time limit for filing the notice of appeal into the system assuming that, according to the normal practice, the secretary would enter the time limit for filing the statement of grounds into the system when sending out the letter informing the client of that second time limit. Unfortunately, she failed to do so. Thus, the non-observance of the time limit was due to an isolated error committed by an experienced secretary within a normally satisfactory system. Thus, the requirements of Article 122 EPC for granting restitutio were met and the appeal was admissible.

IV. The appellant's (opponent's) arguments as to the substance of the appeal may be summarised as follows:

Categorising and certifying operations were not performed by the mailer to serve his own interest but for enabling the Post Office to handle the mail with greater efficiency in its scheduling, equipment and manpower. Categorising and certifying of the mail were suggested by the Post Office administration and could not be regarded as features of a technical invention. Criteria of analysis as defined in part (A) of claim 1 were well known from document D3 and were also clearly imposed on the mailer by the Post Office administration because they depended on the availability of sorting machines in the Post Office. The arguments of the respondent that, if the invention was obvious, one would have expected apparatus for categorising and certifying to develop simultaneously with automatic sorting equipment, did not hold water because it was necessary for the Post Office to have automatic mail treatment machines at its disposal before it could invite large mailers to adapt their mail to the performances of these machines and propose categorising and certifying for a better use of sorting devices. Inventive activity cannot be proved by arguing that the invention should already have been disclosed in the past if it had been self-evident. The opposition division should have examined whether the claims of the contested patent involved a technical teaching which resulted in an obvious way from the suggestions of the Post Office. Technical means for satisfying the needs of large mailers were already available in the prior art as disclosed in D1 (sorting according to size), D2 (readability of the address) and D5 (analysing the zip code). The fact that no sorting was performed at a location close to the mailer could not justify an inventive step, even though the cited documents

concerned sorting machines. If a certain pre-processing without sorting was requested from the mailer, the machines used for performing it had to be modified, so that they would differ from conventional postal machines by the absence of sorting means and the provision of means for storing information and establishing a report upon the characteristics of the treated mail (see D6). However, to perform such a modification of existing machines was within the ability of the technician skilled in the art of sorting machines. Thus the subject-matter of the independent claims of the contested patent was obvious to the skilled person when large mailers were asked to do part of the work which would otherwise have to be done by the postal administration.

- V. The respondent argued that the invention was based on the concept of pre-processing a batch of mail and preparing a report which summarised the nature of the mail pieces in the batch on the basis of which report the Post Office could determine the extent to which the batch would be capable of being processed by automated equipment. The appellant's argument that the present invention followed from the nature of the problem could not be accepted because prior to the invention efforts were concentrated on developing postal sorting equipment and diverting from the mail flow those pieces which failed to pass through the sorting equipment satisfactorily.

D1 described a system for separating, only on the basis of their sizes, mixed mail pieces into discrete categories. Printing out a report including postage information for a batch of these mail pieces was not

suggested in D1.

D2 disclosed a system for sorting mail pieces into two categories, printed or typed addresses on the one hand and hand-written addresses on the other. Since the system of D1 diverted mail pieces on the basis of their sizes, combining D2 with D1 would not lead to the invention because it was only possible to subject **each** piece of a batch to both sizing and address readability checks if no sorting was performed.

The appellant had not provided evidence that D3 was available to the public before the priority date of the patent. Therefore, D3 should be disregarded.

Sections 5.4.6.2 to 5.4.6.8 of Standard ISO 1831 provided as document D4 defined nothing more than various parameters relating to printed characters.

D5 related to a system for sorting of mail according to zip code and since such a sorting was not performed by the invention, D5 should be left out of account. D6 contained no suggestion of scanning all the mail pieces of a batch to determine the parameters set out in claims 1 and 9 in order to prepare a report serving to provide certification.

The appellant had not shown that the subject-matter of the contested patent was obvious with regard to the cited prior art.

VI. The appellant requested that the decision under appeal be set aside and that European Patent No. 0 356 228 be revoked.

VII. The respondent requested that the appeal be dismissed.

Reasons for the Decision

1. *Admissibility of the appeal*

1.1 An appeal that does not comply with Article 106 to 108 and with Rules 1(1) and 64(b) EPC must be rejected as inadmissible unless the deficiencies have been remedied in time (Rule 65(1) EPC). It is undisputed that, in the present case, the time limit for filing the statement of grounds (Article 108 EPC, third sentence) was not complied with, so that the admissibility of the appeal depends on the issue of whether or not the appellant's application for restitutio in integrum pursuant to Article 122 EPC can be granted.

1.2 According to the decision G 1/86 (OJ EPO 1987, 447) Article 122 EPC is to be interpreted as being applicable to an opponent who filed a notice of appeal but did not comply with the time limit for filing the statement of grounds, which is presently the case. Hence, the appellant could validly file an application for restitutio with respect to the time limit referred to above.

The cause of non-compliance with this time limit was removed by the EPO-communication pursuant to Article 108 and Rule 65(1) EPC posted on 29 January 1998 and received by the appellant on 30 January 1998. The application for restitutio was filed on 10 February 1998, i.e. within two months from the date of removing

the cause of non-compliance with the time limit, and is admissible pursuant to Article 122(2) and (3) EPC.

1.3 However, restitutio in integrum can only be granted if the responsible person, in spite of all due care required by the circumstances having been taken, was unable to observe the time limit in question (Article 122(1) EPC). According to the established jurisprudence of the Boards of Appeal, where an assistant has been entrusted with carrying out routine tasks such as noting time limits, the same strict standard of care is not expected as is demanded of the representative himself. (J 16/82, OJ EPO 1983, 262). However, it is incumbent on the representative to choose for the work a suitable person, properly instructed, and to exercise reasonable supervision over this person's work (J 5/80, OJ EPO 1981, 343).

1.4 Considering first the representative's conduct, he had entered only the first of the two time limits pursuant to Article 108 EPC into the monitoring system when processing the incoming mail in the absence of the senior secretary, (see point III., supra). This fact may have contributed to the failure referred to above. However, as follows from his credible explanation of the normal operation of the monitoring system, it was sufficient for him, at that time, to do so, since he could expect that the senior secretary would in any case enter the second time limit into the system when it was communicated to the client. Had she handled the system accordingly, the failure to meet the second time limit would not have occurred. Thus, the representative has demonstrated to the satisfaction of the Board that he had taken all due care required by the

circumstances.

1.5 As concerns the secretary, it was credibly submitted that it was one of her jobs for more than 20 years to note the time limits apparent from the incoming and the outgoing mail and that she had not committed any error of particular note during this period. Thus, she was obviously sufficiently experienced and familiar with the tasks she was entrusted with. The isolated error on her part which she committed shortly after her return from leave cannot therefore be imputed to the representative.

1.6 For these reasons the Board is satisfied that the requirements of Article 122 EPC for granting an application for restitutio in integrum (see point 1.3, supra) are met in the present circumstances.

Therefore, the appellant's request for restitutio in integrum can be granted. Accordingly, the appellant is re-established in his rights in respect of the time limit for filing the statement setting out the grounds of appeal. Since the appeal complies with all the provisions of Articles 106 to 108 EPC and with Rule 1(1) and Rule 64(b) EPC, it is admissible.

2. *Novelty*

The appellant did not dispute novelty of the subject-matter of claims 1 and 9. Therefore, the remaining issue to be considered is the appellant's contention that this subject-matter does not involve an inventive step within the meaning of Article 56 EPC with regard to the prior art disclosed in documents D1 to D6.

3. *Inventive step*

3.1 The board does not share the appellant's view that categorising and certifying of the mail in the manner defined in claims 1 and 9 could not be regarded as features of a technical invention because they were suggested by the Post Office administration.

3.1.1 When the patentability of the subject-matter of a claim is being assessed under the EPC, all the features recited in the claim have to be examined objectively, having regard to the prior art actually shown to have been made available to the public. As far as claims 1 and 9 of the contested patent are concerned, the means for, or the steps of, categorising and certifying a batch of mail by scanning the mail pieces to produce data representative of the parameters (a) to (e) of each mail piece, storing the data generated by said scanning as well as storing data embodied in post office regulations relating to acceptable values for address readability, deliverability, weight and dimensions of each mail piece in the batch, comparing the stored parameter data with said post office regulations data and printing out a report which includes postage information for the batch of mail in

order to provide its certification, are of technical character and, as such, are capable of contributing to an inventive step. The fact that post office regulations are stored does not detract from the technical character of the apparatus claimed in claim 1 or the method claimed in claim 9 (which specifies electronically scanning the mail pieces).

3.2 Document D1 describes an apparatus for categorising a batch of mail by measuring the dimensions (thickness, length and width) of the mail pieces. Based upon the measurements obtained for each mail piece, gates are controlled to divert from the mail stream machinable flat mail, machinable letter size mail and undersize letter mail. It is implied that the remaining mail pieces are non-machinable (see D1, column 2, lines 11 to 26).

3.2.1 Starting from D1 as the document representing the prior art closest to the claimed subject-matter, the problem addressed by the patent in suit is the provision of an apparatus and a method able to handle mail pieces in a batch in order to allow the Post Office to reduce its manual acceptance procedure and promote greater efficiencies in its scheduling and choice of both the most appropriate manpower and suitable equipment for further processing.

3.2.2 The claimed apparatus essentially differs from that disclosed in D1 by the following features:

- (1) it comprises means for producing and storing data representative of the following parameters of each mail piece of a batch: (a) readability of the

address, (b) deliverability, (c) weight, (e) postage franking amount,

(2) it comprises means for printing out a report which includes postage information for the batch of mail based upon information obtained from the above-mentioned stored data.

3.2.3 The apparatus known from D1 is not of the kind claimed because it is strictly limited to the detection of dimensions of pieces of mail and does not envisage certifying a batch of mail. Furthermore, the way of handling mail in this known apparatus conceptually teaches away from that of the claimed invention because a mail piece is diverted out of the batch - that is, separated from the other mail pieces of the same batch - as soon as its dimensions have been detected as belonging to a particular category, whereas neither the claimed apparatus nor the claimed method envisages separating the mail pieces into discrete categories. On the contrary, the entire batch is kept together.

3.2.4 In the board's judgement, there is nothing in D1 that would suggest to the notional non-inventive skilled person that he could modify the apparatus disclosed in this document in order to solve the problem addressed in the contested patent.

3.3 D2 discloses an apparatus and a process for analysing destination addresses. An optical scan system is used for sorting mail pieces into two categories according to whether the address on a mail piece is machine imprinted or handwritten. As already emphasized above in the discussion concerning the prior art taught by

D1, no sorting is performed in the claimed apparatus, nor in the claimed method.

3.3.1 The board agrees with the respondent and the opposition division that, if the teachings of D2 and D1 were combined, this would result in an apparatus in which it would not be possible for **each** mail piece to be scanned for sizing (according to D1) and address readability (according to D2), since the sorting performed in D1 and D2 would preclude this.

3.4 Document D3 merely demonstrates that it was known to the French Post Office before the priority date of the contested patent to check the readability of an address. This document cannot pose any threat to the patent in suit because it nowhere discloses an apparatus for, or a method of, categorising or certifying a batch of pieces of mail. Since this document is not relevant to the claimed subject-matter, it is not necessary to ascertain whether it was available to the public before the priority date of the patent in suit.

3.5 D4 discloses international specifications concerning various parameters relating to printed characters to be read by an optical recognition system. Paragraphs 5.4.6.2 to 5.4.6.8 of D4, referred to by the appellant in the grounds of appeal, concern acceptance conditions for parameters, such as internal contrast factor, concerning the readability of characters, but this document does not disclose, or suggest, an apparatus or a method having the features specified in claim 1 or 9 of the patent in suit.

3.6 Document D5 relates to a system for stacking articles to be mailed under bulk mail rates which have the same zip code. This system also identifies stacks of articles with consecutive zip codes in which each stack is under the postal minimum for a stack and bundles them together if this will produce a combined stack over the minimum. There is no suggestion in D5 to provide certification of the mail. Since no such sorting and handling according to zip code are performed by the apparatus according to claim 1, or in the method according to claim 9, this document is of little relevance for the assessment of inventive step of the subject-matter of claims 1 and 9 of the patent in suit.

3.7 D6 is the sole document describing a method of pre-handling a batch of mail pieces by the mailer and aiming at reducing the burden of work to be performed by the Post Office. This method consists in checking the postage paid for every batch of mail and appending to this batch a printed report containing certification of the postage paid ("L'affranchissement d'un lot de courrier", see page 3, lines 19 to 22, and page 4, lines 22 to 25). However, document D6 contains no suggestion of scanning all the mail pieces in a batch to determine all the parameters (a) to (e) specified in claims 1 and 9 in order to prepare a report serving to provide certification of the batch, as set out in these claims.

3.8 Since the sorting system according to D1 only detects the dimensions of a mail piece and the system according to D6 only checks the postage paid, a combination of the teachings of D1 and D6 would not lead to the

claimed subject-matter.

- 3.9 The appellant's submissions, that the subject-matter of the independent claims of the contested patent was obviously within the reach of the skilled person when large mailers were asked to do part of the work otherwise done by the postal administration, amount only to mere allegations not supported by any cogent reasoning showing which of the documents D1 to D6 **would** have been combined, let alone **how** they would have been combined by the notional person skilled in the art, to arrive at the apparatus and method as defined in respective claims 1 and 9 of the contested patent.
4. Having reviewed the evidence and arguments adduced by the parties during the first instance proceedings and in the appeal proceedings, the board concludes that no combination of features mentioned in the cited documents D1 to D6 would have resulted in an apparatus or a method according to claim 1 or 9. In particular, the idea of scanning an entire batch of mail to determine the set of parameters (a) to (e) for **each** piece of mail in the batch in order to prepare a printed report to provide certification of the mail does not follow in an obvious manner from these documents. Neither the cited prior art nor the arguments brought forward by the appellant support the view that the notional knowledgeable but relatively unimaginative person skilled in the art **would** have thought of the above-mentioned idea. This person cannot be expected to envisage all this by himself without at least some hint to point him in the direction of the apparatus and method as claimed.

5. For these reasons, the appeal has to be dismissed.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:

M. Kiehl

W. J. L. Wheeler