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D E C I S I O N
of 17 January 2002

Case Number: T 0156/98 - 3.2.5

Application Number: 92309861.0

Publication Number: 0540305

IPC: B43K 3/04

Language of the proceedings: EN

Title of invention:

Method and template device for adjusting an inserting machine

Patentee:

PITNEY BOWES, INC.

Opponent:

NEOPOST LTD
Francotyp-Postalia Aktiengesellschaft & Co.

Headword:

-

Relevant legal provisions:

EPC Art. 56

Keyword:

"Inventive step (yes)"

Decisions cited:

-

Catchword:

-



Case Number: T 0156/98 - 3.2.5

D E C I S I O N
of the Technical Board of Appeal 3.2.5
of 17 January 2002

Appellant: NEOPOST LTD
(Opponent 01) South Street
Romford, Essex, RM1 2AR (GB)

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

Party as of right: Francotyp-Postalia Aktiengesellschaft & Co.
(Opponent 02) Triftweg 21-26
D-16547 Birkenwerder (DE)

Representative: Schaumburg, Karl-Heinz
Patentanwälte
Schaumburg, Thoenes, Thurn
Postfach 86 07 48
D-81634 München (DE)

Respondent: PITNEY BOWES, INC.
(Proprietor of the patent) World Headquarters
One Elmcroft
Stamford
Connecticut 06926-0700 (US)

Representative: Ritter und Edler von Fischern, Bernhard
Dipl.-Ing.
Hoffmann Eitle
Patent- und Rechtsanwälte
Postfach 81 04 20
D-81904 München (DE)

Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 9 December 1997
rejecting the opposition filed against European
patent No. 0 540 305 pursuant to Article 102(2)
EPC.

Composition of the Board:

Chairman: W. Moser

Members: P. E. Michel
A. Burkhart

Summary of Facts and Submissions

I. The appellant (opponent 01) lodged an appeal against the decision of the opposition division rejecting the oppositions against patent No. 0 540 305.

Opositions had been filed against the patent as a whole based on Article 100(a) EPC (lack of inventive step).

II. Oral proceedings, attended by the respondent (patentee) and the appellant, were held before the Board of Appeal on 17 January 2002. With a letter dated 8 August 2001, the party as of right (opponent 02) indicated that they would not attend the oral proceedings.

(i) The appellant requested that the decision under appeal be set aside and that the patent be revoked in its entirety.

(ii) The respondent requested as a main request that the appeal be dismissed, or as first and second auxiliary requests, that the decision under appeal be set aside and the patent be maintained in amended form on the basis of sets of claims filed on 13 December 2001 as first and second auxiliary requests.

(iii) The party as of right refrained from submitting requests.

III. The following documents have been referred to in the appeal procedure:

D1 US-A-4 548 400

FD2 US-A-2 914 895

FD3 DE-U-69 49 616

ND3 US-A-4 558 519

D8 Grundlagen für Meß- und Regeltechniker

D11 DE-A-39 18 392

D12 DE-A-39 29 034

IV. The claims of the patent as granted include two independent claims reading as follows:

"1. A method of adjusting inserting apparatus (10) capable of inserting a plurality of documents into envelopes (12) of varying size, comprising:

a. locating an envelope with an open flap (30) at a locating guide (60) on a template (52) having a plurality of scales (66,68,70) thereon for determining whether or not the inserting apparatus can accommodate the size of the envelope placed on the template and for adjusting a plurality of adjustable mechanical elements of the inserting apparatus in order to process the envelope placed on the template;

b. determining adjustment settings for said plurality of adjustable mechanical elements by reading each of said adjustment settings from said plurality of scales with the envelope kept at said locating guide on said template; and

c. adjusting said mechanical elements in accordance with the adjustment settings read on said scales."

"7. A template (52) device for determining adjustment settings for a plurality of adjustable mechanical elements relating to the processing of an envelope in an inserting apparatus comprising:

a. a backing support (54);

b. a transparent sheet (56) secured along one edge (58) to said backing support, said transparent sheet including a locating guide (60), and at least three scales (66,68,70) relating to adjustment settings for a plurality of adjustable mechanical elements of the inserting apparatus wherein all of said adjustment settings for an envelope are determined when an envelope is registered at said locating guide between said backing support and said transparent sheet."

V. In the written and oral procedure, the appellant argued essentially as follows in connection with the main request of the respondent:

The closest prior art is that acknowledged as prior art in document D1 at column 1, line 27 to column 2, line 57. This is considered to be more relevant than the disclosure of document FD2 insofar as it is stated that it is necessary for the operator to measure the materials and transpose the measurements to the machine. Moreover, the disadvantages of the system are recognised, that is the occurrence of mistakes on the part of the operator when transferring measurements to

the guides.

The problem to be solved was only known from the date of publication of document D1, that is, in 1985. The decision of the Opposition Division is thus incorrect insofar as it is stated that "the problem was known for more than 30 years".

The use of scales to measure lengths is generally well known. Reference is made in this connection to document D8. Measuring simultaneously in two dimensions is known from document D11. It therefore does not involve an inventive step to apply such techniques to the prior art method of adjusting inserting apparatus and thereby arrive at the subject-matter of claim 1.

Documents FD3, D11 and D12 demonstrate that it is generally well known in various technical fields to use two dimensional templates.

As regards claim 7, drawn to a template per se, it is not significant that the scales are carried on a transparent sheet. This only becomes necessary for the third scale of the preferred embodiment which otherwise could not be seen. Document ND3, whilst relating to a different technical field, shows that comparatively complicated templates are known. Therefore, the subject-matter of claim 7 also does not involve an inventive step.

VI. The party as of right refrained from making submissions.

VII. In the written and oral procedure, the respondent argued essentially as follows in connection with his

main request:

The closest prior art is represented by document FD2. As described in the passage of document D1 cited by the appellant, the adjustment of inserting apparatus is a complex operation which can give rise to operator error.

The object of the invention is thus to reduce the scope for operator error.

This problem is solved by the subject-matter of claim 1 which sets out a simple and quick way of adjusting inserting apparatus.

Document D1 discloses an apparatus involving a complicated, expensive linkage system which is subject to failure and which requires two separate measurements to be carried out on the envelope.

The apparatus of document ND3 is not a template and is not used to perform a measurement.

The prior art does not disclose a method involving measurement of an object in order to obtain appropriate machine settings.

Therefore, the subject-matter of claim 1 involves an inventive step. The subject-matter of claim 7 involves an inventive step for the same reasons.

The documents D8 and D11 cited by the appellant were late filed and should not be admitted into the procedure.

Reasons for the Decision

1. *Late filed documents*

Documents D8, D11 and D12 were filed in the opposition proceedings within one month of the oral proceedings before the Opposition Division and were not admitted into the opposition proceedings.

Document D8 was mentioned in the appeal procedure by the appellant for the first time at the oral proceedings. The respondent thus did not have an opportunity to properly assess the document. Since the relevance of the document is not immediately apparent, it is not admitted into the proceedings.

On the other hand, documents D11 and D12 were mentioned in the statement of grounds filed by the appellant on 16 March 1999 and are therefore admitted into the present proceedings.

Main Request

2. *Novelty*

The use of a template in a method of adjusting inserting apparatus capable of inserting a plurality of documents into envelopes of varying size is not mentioned in the cited prior art. The cited art also does not disclose a template device comprising a backing support and a transparent sheet secured along one edge to the backing support. The subject-matter of claims 1 and 7 is thus new. In addition, novelty of the claims has not been disputed in the present proceedings.

3. *Inventive step*

3.1 The closest prior art is represented by document FD2. This document discloses a method of adjusting inserting apparatus capable of inserting a plurality of documents into envelopes of varying size, comprising adjusting a plurality of adjustable mechanical elements of the inserting apparatus in order to process the envelope, which involves determining adjustment settings for the plurality of adjustable mechanical elements and adjusting the mechanical elements in accordance with the adjustment settings. There is no disclosure in this document of how the operator is to determine the adjustment settings for the plurality of adjustable mechanical elements. According to document D1, in order to set up the Pitney Bowes Model 3320 inserter, the "operator was required to physically measure materials" (column 2, lines 38 and 39). This would also be the case for the inserter of document FD2 and the corresponding Model 3300 inserter. Such a procedure is open to operator error.

3.2 The object of the invention is to facilitate the setting of the adjustment settings.

According to the invention as defined in claim 1 of the patent in suit, this is achieved by means of the use of a template on which an envelope with an open flap is located at a locating guide on the template, which has a plurality of scales thereon for determining whether or not the inserting apparatus can accommodate the size of the envelope placed on the template and determining adjustment settings for the plurality of adjustable mechanical elements by reading each of the adjustment settings from the plurality of scales with the envelope

kept at the locating guide on the template.

- 3.3 As stated at paragraph 2 above, the use of a template in a method of adjusting inserting apparatus capable of inserting a plurality of documents into envelopes of varying size is not mentioned in the cited prior art. There is furthermore no incentive for the person skilled in the art to use a template in a method of adjusting inserting apparatus.
- 3.4 Document D1 teaches an alternative solution to the above problem, according to which, a gauging panel is provided on the inserting apparatus which, in addition to a slot for the enclosure, possesses a slot in which the envelope is inserted widthwise and a slot in which the envelope is inserted lengthwise. For each slot, rotation of a corresponding knob causes a pointer to contact an edge of the envelope and also causes the appropriate adjustments to be made to the plurality of adjustable mechanical elements. This is not, however, the solution forming the subject of the patent in suit. It may be regarded as reducing still further the necessity for skill on the part of the operator, but resulting in a more complex inserting apparatus.
- 3.5 The prior art shows a number of different applications for templates of various types. Those specifically mentioned in the present procedure include a device for selection of a desired portion of an image (document FD3), a carpenter's square (document D11) and a device for measuring models for use in dentistry (document D12). None of these technical fields can be regarded as being those in which a solution to the problem stated above would be sought.

Moreover, none of the known templates are used to determine machine settings on the basis of measurements carried out by means of the template on an object which is to be treated or handled by the machine. Thus, the template of document FD3 is used to select a portion of an image having desired proportions. The carpenter's square of document D11 is used to measure the dimensions of a piece of wood which is being worked on by the carpenter. The template of document D12 is used to determine the dimensions of a model of the teeth and jaws of a patient. Whilst the device of document ND3 is referred to as a template, it is not a template in the sense of a device for use in measuring dimensions. It is, in fact, an adjustable device for use as a pattern in dressmaking, the adjustments to the device being made on the basis of measurements carried out individually in the conventional manner on the body.

In these circumstances, the question of whether the above problem was first recognised as much as thirty years before the priority date of the patent in suit, or merely six years before, is a secondary consideration which is not considered to be relevant in view of the technical facts of the case.

3.6 The subject-matter of claim 1 thus involves an inventive step.

3.7 Claim 7 is directed to a template device for determining adjustment settings for a plurality of adjustable mechanical elements relating to the processing of an envelope in an inserting apparatus comprising a backing support and a transparent sheet secured along one edge to the backing support, the envelope being introduced between the backing support

and the transparent sheet when the measurement is carried out. None of the cited documents discloses or renders obvious templates having such a construction.

3.8 The subject-matter of claim 7 thus also involves an inventive step.

3.9 Claims 2 to 6 and 8 are directly or indirectly appendant to either claim 1 or claim 7 and relate to preferred embodiments of the method or device respectively. The subject-matter of the dependent claims thus also involves an inventive step.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:

M. Dainese

W. Moser