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D E C I S I O N
of 7 July 2000

Case Number: T 0513/98 - 3.5.2

Application Number: 89313227.4

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Language of the proceedings: EN

Title of invention:
Centralized mail use database

Patentee:
PITNEY BOWES INC.

Opponent:
Francotyp-Postalia Aktiengesellschaft & Co.

Headword:

-

Relevant legal provisions:
EPC Art. 56, 52(2) and (3), 114(2)
EPC R. 29(1)

Keyword:

-

Decisions cited:
T 0769/92, T 1173/97

Catchword:

-



Case Number: T 0513/98 - 3.5.2

D E C I S I O N
of the Technical Board of Appeal 3.5.2
of 7 July 2000

Appellant: Francotyp-Postalia Aktiengesellschaft & Co.
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Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 28 November 1997
rejecting the opposition filed against European
patent No. 0 375 330 pursuant to Article 102(2)
EPC.

Composition of the Board:

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

Summary of Facts and Submissions

I. The opponent filed the appeal against the decision of the opposition division rejecting the opposition filed against European patent No. 375 330.

II. The following documents referred to in the notice of opposition were referred to in the appeal proceedings:

D1: Journal of Telecommunication Networks, vol. 2 (1983), No. 3; pages 295-304; Chu, W. W. et al

D2: US-A-4 752 950

D5: US-A-4 713 761.

With the statement setting out the grounds of appeal the appellant filed further documents:

D6: DUDEN "Informatik"; Dudenverlag, Mannheim, 1988; pages 134-143

D7: DE-A-3 539 545.

III. In response to a communication accompanying the summons to oral proceedings before the Board, the respondent submitted three sets of claims with a letter dated 26 April 2000 in respect of a main request and first and second auxiliary requests.

IV. Claims 1 and 5 of the main request are worded as follows:

"1. A mailing system for processing information relevant to mail handling for distribution to mailers,

comprising:

- (A) a computerized central data station;
- (B) a plurality of mailer stations each having a computer controllable database and associated with similar businesses;
- (C) a communication link interconnecting said computerized central data station with each of said mailer stations; said computerized central data station including:
 - (a) means for accessing each of selected ones of said mailer stations;
 - (b) means for accessing the database at each of said accessed mailer stations;
 - (c) means for dividing said database at each of said accessed mailer stations into a plurality of mail handling categories common to the databases of the selected mailer stations;
 - (d) a database storage area at the computerized central data station for storing each of said mail handling categories;
 - (e) means for augmenting each of said mail handling categories with mail handling data received from each mailer station database;
 - (f) means for accessing each of said mail handling categories in accordance with an authorized mailer station request; and
 - (g) means for transmitting information from said accessed mail handling category as requested by a requesting mailer station to said requesting mailer station in order for the requesting mailer station to handle its mail in a more efficient and economical manner."

"5. A method of enhancing the efficiency and economy of individual mailers associated with similar

businesses and located at separate mailer stations, comprising the steps of:

- (a) providing a computerized central data station with a database and providing at each of said mailer stations a computerized database;
- (b) establishing a communication link interconnecting said central data station and each of said mailer stations and allowing said central data station to access each of selected ones of the computerized database of said mailer stations;
- (c) at said central data station, dividing said computerized databases into a plurality of mail handling data categories common to selected mailer stations;
- (d) said central station periodically polling selected ones of said mailer stations for accessing said computerized database at each of said accessed mailer stations;
- (e) placing the accessed data from said computerized database into a respective common database storage area at said central data station for each of said mail handling data categories in order to augment each of said mail handling data categories with mail handling data from each of said accessed mailer databases;
- (f) upon receiving an authorized mailer request, accessing each of said augmented mail handling data categories in the central station database in accordance with said mailer's request; and
- (g) said central station transmitting augmented mail handling data from said accessed mail handling data category to said requesting mailer, said augmented mail handling data containing information obtained from multiple mailers and usable by the requesting mailer to improve the processing of mail at its location."

Claims 2 to 4 and 6 to 8 are dependent on claims 1 and 5 respectively.

V. In oral proceedings held before the Board on 6 June 2000, the respondent filed new sets of claims as first and second auxiliary requests, and filed amended columns 3 to 6 of the description for all the requests.

VI. The appellant argued essentially as follows:

As set out in the statement of grounds of appeal, the contested decision did not take sufficient account of what would be obvious to a person skilled in the art, in view of his general knowledge, from the teaching of D1. It was evident that the teaching of D1, including the advantages of shared usage of databases, could be applied in any technical field independently of the contents of the data categories. Information sharing therefore constituted an obvious measure to make mailing systems more efficient and economical. In the system of D1, the data transferred from local stations to the central data station were already stored in files (and thus categorized) and would be stored in corresponding files (and thus categories) at the central data station. Sorting and storing of data in accordance with usage criteria was the essence of organizing data in databases and constituted general knowledge as evidenced by D6. Also the contested patent (column 6, lines 2 to 17 and column 12, lines 30 to 34) disclosed that the data were categorized at the mailer stations and transmitted in this form to the central data station. It was clear that they would be stored there in the same categorized form. The dividing of data into "mail handling categories" could not be derived as an essential difference from the application

as filed because it only specified "data categories".

D7 was introduced to show that this general knowledge was in fact put into practice in technical fields which were very close to mail handling systems. D7 only differed from the subject-matter of claims 1 and 5 in that the data processing system related to securities in an automated trading market.

In the oral proceedings the appellant did not expressly abandon the preceding line of attack, but started from D2 as closest state of the art and acknowledged that D7 was in fact not more relevant than D5. In the following, reference letters in parenthesis refer to the corresponding features of claim 1 of the main request.

D2 disclosed all the features of claim 1 of the main request except for feature (e). In particular, means for dividing (c) were disclosed at column 9, lines 30 to 41, of D2 since drawing up a partial journal for each customer implied that the database was divided into a plurality of mail handling categories. Features (f) and (g) were disclosed in D2, column 9, lines 21 to 26, because the means for sending data to the mailer stations were equally suitable for accessing each of the mail handling categories in accordance with an authorized mailer station request. Whether these means actually transmitted information or not was determined by considerations of how to do business. The required technical means, including those for achieving the function of feature (e), were disclosed in combination in D2. This was confirmed by the contested patent itself (column 13, lines 23 to 31) which acknowledged that it employed "existing equipment ... to provide

additional services and functions".

The problem of providing additional services and functions was within the competence of the person skilled in the art of shared databases. Its solution was obvious from the general knowledge in this technical field that sharing data stored at a central station with a plurality of local stations provided numerous advantages. D1, Figure 1, for example, disclosed a database system for achieving these advantages.

D5 (Figure 7 and column 10, lines 26 to 33) showed such sharing of information in mailing systems since the "rate shopping" function disclosed therein implied that mail handling data was collected at a central station and information was transmitted from the thus augmented mail handling categories to a mailer station requesting an offer. The subject-matter of claim 1 of the contested patent thus lacked an inventive step in view of the state of the art disclosed in D2 in combination with that of D1 or D5.

VII. The respondent argued essentially as follows:

The contested patent was based on a concept which was different from that of any of the cited prior art documents. It allowed individual users to benefit from information collected from other mailers working in similar businesses without sacrificing the confidential character of information provided from the mailers. This was achieved by dividing, at the central station, each database that had been accessed at each of the mailer stations. Feature (c) of claim 1 of the main request made clear that these databases were not yet

divided when accessed at the mailer stations. New categories accessible in accordance with an authorized mailer station request were created and augmented with mail handling data from each mailer station database (feature (e)), as shown in Figure 5B of the patent specification. A large scale series of data, in each of the common mail handling categories, was thereby made accessible to the mailer stations on a request basis.

Both claims 1 and 5 of the main request specified the technical features of this new concept of information distribution in a mailing system. Although the patent specification (column 13, lines 23 to 31) acknowledged that existing equipment was employed, the claimed system was programmed to operate in a new way. Since it was clear that these claims did not relate to subject-matter or activities for doing business as such which could be excluded from patentability under Article 52 (2) and (3) EPC, it had to be judged whether their subject-matter as a whole was obvious to a person skilled in the art or not. According to recent case law relating to computer program products, it did not matter which features were responsible for the claimed subject-matter being not obvious to a person skilled in the art, nor was there a new technical effect required.

D2, which reflected the closest prior art, dealt with remote inspection of mailer stations. Only "control information" (eg postage rates or the frequency of reporting back to the central station) was transmitted to the mailer stations (see eg claim 1). The central station collected mail handling data but did not divide and categorize it to make it available to other mailer stations because the information had private character. Therefore, features (c), (e) and (f) of present claim 1

were not disclosed in D2.

D1 (Abstract) disclosed an integrated database system where local stations containing fragments of the integrated database and a central database together formed a union. The central station did not create a new database by dividing and categorizing accessed databases. D5 and D7 disclosed systems which dealt with information of a different nature to be distributed when offers were transmitted to local stations. D6 only disclosed specialist knowledge in the field of database systems. The person skilled in the art would not get any hint from these documents to make mail handling data accessible to a plurality of mailer stations since such data had confidential character. For similar reasons, D6 and D7 should be left out of account because they had no relevance to the contested patent.

VIII. The appellant (opponent) requested that the decision under appeal be set aside and that European patent No. 0 375 330 be revoked.

IX. The respondent (patentee) requested as main request that the patent be maintained in amended form in the following version:

claims 1 to 8 filed with letter dated 26 April 2000;

description, columns 3 to 6 filed in the oral proceedings;

description, columns 1, 2 and 7 to 13 and drawings of the patent specification.

Reasons for the Decision

1. The appeal is admissible.
2. *Amendments*
 - 2.1 The appellant did not raise any objections to the amendments, apart from questioning whether the term "mail handling categories" was disclosed in the application as filed. The Board notes that the term "mail handling categories", which was already present in the patent specification as granted, is directly derivable from claim 17 (feature (g)), claim 5 (first two lines), claim 6 and page 9, paragraph 2, of the application as filed.
 - 2.2 The Board is satisfied that the amendments made to the claims of the main request do not infringe Article 123(2) and (3) EPC. The same applies to the description which has been adapted to the amended claims.
3. *The subject-matter of claims 1 and 5 (main request)*
 - 3.1 Claim 1 of the main request specifies means for accessing the database at each of selected ones of the mailer stations (features (a) and (b)) and means for dividing said database into a plurality of mail handling categories which are common to the databases of the selected mailer stations (feature (c)) associated with similar businesses (see feature (B)). A storage area is provided for each of these categories (feature (d)) and means are included for augmenting the (contents of the) categories with mail handling data received from each mailer station database

(feature (e)). Means are further provided for accessing each of these categories in accordance with an authorized mailer station request and for transmitting information therefrom (features (f) and (g)).

3.2 Since all the means of features (a) to (g) are included in the central data station, the dividing of the database (the body of information accessed at the mailer station) into categories takes place at the central data station where they are stored. The dividing operation has to be seen in the context of creating categories which are made accessible to ("common to") the plurality of the selected mailer stations (associated with similar businesses; see feature (B)) in accordance with an authorized request. Features (a) to (g) thus all relate to means for creating, at the computerized central data station, commonly accessible storage areas comprising data in a plurality of mail handling categories which are arranged to be supplemented by data from each of the selected mailer station databases. This natural construction of claim 1 in accordance with the usual meaning of the words in the context of the claim considered as a whole is corroborated by the description of the patent specification (column 11, lines 29 to 49; column 12, lines 12 to 35; column 13, lines 3 to 31 and Figure 5B) which emphasizes the information sharing aspect disclosed in the contested patent leading to a large scale series of categorized databases accessible to selected mailer stations of similar businesses.

3.3 Claim 5 specifies the corresponding method steps of accessing each of the selected ones of the databases of the mailer stations (features (b) and (d)), dividing

these databases into commonly accessible categories (features (c) and (e)), augmenting the data of these categories (features (e) to (g)) and transmitting information therefrom in accordance with an authorized mailer request (features (f) and (g)). Claim 5, in addition, specifies "periodically polling" selected mailer stations (feature (d)), placing the data into "a respective common database storage area" for each category (feature (e)) and transmitting "augmented mail handling data ... containing information obtained from multiple mailers and usable by the requesting mailer".

4. *Novelty*

4.1 None of the cited documents relating to a mailing system or method, such as D2 or D5, where mail handling information is exchanged over a communication link between a central data station and a plurality of mailer stations discloses the creation of commonly accessible categories as specified in claims 1 and 5. The subject-matter of these claims is therefore novel with respect to this prior art. This was not contested by the appellant.

4.2 The cited documents relating to general purpose database systems, such as D1, which do not mention mailer stations and handling of mail, cannot be regarded as disclosing mailing systems, or methods of enhancing the efficiency and economy of individual mailers. That these systems relate to different technical fields cannot be obviated by a simple renaming of data categories of the databases disclosed in D1. The system and method of claims 1 and 5 imply programs for the computerized central data station and the computer controllable databases of the mailer

stations which are suitable for running the components of the system in the specified environment, as well as means for handling mail (eg letters and packages) at the mailer stations. Therefore, the subject-matter of claims 1 and 5 of the main request is not anticipated by this prior art.

5. *Inventive step*

5.1 D2 discloses the nearest prior art because it relates to a mailing system and method which comprises a communication link (3, 5, 6) for bidirectional exchange of data between a central data station (2) and a plurality of mailer stations (local stations 4). The mailer stations receive control information from, and communicate operating information to, the central data station (D2, claims 1, 8 and 9). This data exchange is analogous to the generally known "post-payment" method where the user had to provide regular detailed statements of the franking performed to the central data station (postal administration) which performed book-keeping and checking work and took proper action if the required statements had not been transmitted (D2, column 1, lines 20 to 51; column 9, lines 30 to 41). The control information transmitted to local stations thus contains instructions from the central data station including the period and frequency of duties for each mailer station (D2, column 1, line 59 to column 2, line 2; column 8, lines 13 to 19). The mailer stations, in accordance with these instructions, call the central data station to communicate the collected operating information, including eg cumulative and daily values from the franking counters, and faults as detected (D2, column 9, lines 30 to 41; column 11, lines 24 to 35). When a machine is

initialized or when modifications are to be sent to the mailer stations, the call may, optionally, be made at the request of the central station (D2, column 9, lines 21 to 26). D2 thus discloses a mailing system comprising the features (A), (B), (a) and (b) of the present claim 1.

5.2 However, D2 does not disclose means for dividing, at the central data station, the database of selected mailer stations as specified in feature (c) of the present claim 1. The central data station "preprocesses" the data supplied by the mailer stations (D2, column 7, lines 60 to 64) and responds to these data by "drawing up a partial journal indicating, in particular, for each customer the type of surveillance performed as a function of its frequency, ... with optional carrying forward from the preceding journals" (D2, column 9, lines 30 to 41). The database comprising the operating information received from the mailer stations is thus divided, for each customer, into different categories. Each of these categories may be augmented for each customer ("optional carrying forward"), but these categories are not common to selected mailer stations, ie they do not constitute commonly accessible categories which are shared by a selected group of mailer stations. Moreover, none of these data of the collected operation information in D2 is intended for transmission to any of the mailer stations. Only control information is downloaded for initializing and instructing the mailer stations.

5.3 The features (c) to (g) of present claim 1 referring to dividing databases, storing commonly accessible mail handling categories and transmitting information from these categories, solve the problem of making it

possible to use the mailer stations in a more efficient and economical manner (see claim 1, feature (g) and column 3, lines 2 to 11, of the contested patent).

5.3.1 The Board is convinced that the above features contribute to solve this problem in that a large scale series of categorized databases may be created and shared in this way to provide, with existing equipment, additional services and functions (cf contested patent, column 13, lines 23 to 31). In particular, collecting mail handling data from each of a plurality of mailer stations, and transmitting such data to authorized requesting mailer stations, enables individual users of the stations to compare their mail handling data with categorized information derived from mailer stations associated with similar businesses (cf feature (B) of claim 1). Suitable measures can then be taken to further improve the mail handling at the mailer station concerned to get reductions in postal rates (cf contested patent, column 2, lines 43 to column 3, line 1; column 7, lines 14 to 33).

5.3.2 The above problem arises in the use of a system which is technical *per se* (mailer stations having computer controllable databases interconnected, by a communication link, with a computerized central data station) and thus not excluded from patentability (Article 52 (2) and (3) EPC). This has not been contested by the appellant, and the opposition by the appellant has not been based on this ground, neither in the opposition nor in the appeal proceedings. Even if the new features of the system specified in claim 1 did not change the hardware of the known system ("employs existing equipment"; cf contested patent, column 13, lines 23 to 31), the required software changes would

nevertheless cause the system to be technically different with respect to the dividing, storing and transmitting of mail handling data. Moreover, although these changes may be essentially inspired by methods for doing business, they nevertheless involve technical considerations relating to the field of mailing, such as the overall operation of the interconnected system, the provision of storage area for mail handling categories, the prevention of unauthorized access to the categories and the transmission of information from these categories. Therefore, these features have to be considered as technical features in the meaning of Rule 29(1) EPC which contribute to solve a problem arising in mailing systems and which for these reasons, cannot be disregarded when judging inventive step (see also T 769/92, OJ EPO 1995, 525, point 3.3 and T 1173/97, OJ EPO 1999, 609, points 7.4 and 8).

5.4 To solve the above problem, the person skilled in the art would among other options consider transmitting additional control information to all or selected mailer stations via the existing communication means in D2. However, there is no hint in D2 to make the collected mail handling data (operating information) accessible to selected mailer stations because this information is confidential and not intended for use by other mailer stations.

5.5 D5 (column 1, lines 59 to 63; column 2, lines 62 to 65; column 4, line 44 to column 5, line 34 and Table 1 in column 12; Figures 3 and 4) discloses a data processing system for centrally handling the accounting and payment functions to simplify the flow of information and payments between shippers and carriers. The system may be embodied as a mailing system comprising a

computerized central data station (30) and a plurality of mailer stations (shippers 10) interconnected by a communication link (35). The mailer stations periodically transmit mail handling data to the central data station which handles the account and payment functions and which periodically transmits statements of accounts and management reports to the mailer stations. Carriers (20) selling transportation services to the mailer stations transmit the applicable rates and rebates to the central data station which may then carry out a "rate shopping" function (D5, column 1, lines 9 to 27; column 8, lines 53 to 65; column 10, lines 26 to 33). If, as the appellant suggested, the carrier rates are considered as mail handling categories, it may be said that the data of these categories would be augmented by data from each of the **carriers** and the categories made accessible, in accordance with an authorized mailer station request, to requesting **mailer** stations. There is, however, no hint in D5 to create commonly accessible categories by dividing, storing and augmenting data from a plurality of selected mailer stations and to transmit information therefrom to any of these selected mailer stations.

- 5.6 Combining the teachings of D2 and D5, the inclusion of accounting and payment functions in D2, or a periodic transmission of partial journals (or management reports) to the mailer station which these mail handling data came from might be envisaged by the skilled person. However, the combination of D2 and D5 does not suggest commonly accessible mail handling categories to permit individual mailers to access information which was not previously available to them. This idea may appear simple with the benefit of hindsight once the contested patent is known and poses

no insurmountable problem of implementation for the person skilled in the art of database systems, but it does not derive in an obvious manner from the teaching of the known mailing systems. The person skilled in the art starting from D2 would therefore not find a solution in D5 pointing towards the subject-matter specified in claim 1.

5.7 D1 is completely silent on the subject of efficiency and economy of mailing systems, and is only relevant in so far as it confirms the general knowledge that, in database systems, local stations may share and update information stored in commonly accessible categories of a central database (D1, page 295, section "1. Introduction" and Figures 1 and 2), but it does not disclose creating accessible categories by dividing data as specified in the present claim 1. Since the directory at the central data station combines all the dictionary information from the local stations, the data transferred from the local databases may rather be assumed to be stored in the same data categories in the central data station (D1, page 296, left-hand column; Figure 2).

5.8 Since D1 does not relate to the same technical field nor to achieving the same purpose and effect as the claimed invention, it does not qualify as a document reflecting the closest prior art. Therefore, the subject-matter of claim 1 does not derive from an obvious application of a database system as disclosed in D1 to mailing systems as known from D2. Such a concept could only be envisaged as a result of *ex-post facto* analysis.

- 5.9 D6 and D7 do not relate to mailing systems either. They are therefore not highly relevant, neither as a starting point nor as a reference for finding a solution to the problem of making a mailing system more efficient and economic, and may thus be disregarded as late filed documents (Article 114(2) EPC).
- 5.10 Basically the considerations in paragraphs 5.1 to 5.9 above also apply to the corresponding method steps of claim 5 because similar technical means as those specified in claim 1 are required for carrying out this "method of enhancing the efficiency and economy of individual mailers". Since claim 5 includes additional features, the presence of an inventive step follows from the preceding considerations.
- 5.11 The subject-matter of claims 1 and 5 of the main request shall therefore be considered as involving an inventive step within the meaning of Article 56 EPC. The same applies to the subject-matter of dependent claims 2 to 4 and 6 to 8.
6. In the result, the Board is of the opinion that the patent, as amended according to the respondent's main request, and the invention to which it relates meet the requirements of the EPC. The respondent's auxiliary requests need not be considered.

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 in amended form, in the following version:

claims 1 to 8 filed with letter dated 26 April 2000;

description, columns 3 to 6 filed in the oral proceedings;

description, columns 1, 2 and 7 to 13 and drawings of the patent specification.

The Registrar:

The Chairman:

M. Kiehl

W. J. L. Wheeler