

**Internal distribution code:**

- (A) [ ] Publication in OJ  
(B) [ ] To Chairmen and Members  
(C) [X] To Chairmen  
(D) [ ] No distribution

**D E C I S I O N**  
**of 6 November 2001**

**Case Number:** T 0714/98 - 3.5.2

**Application Number:** 89313230.8

**Publication Number:** 0373970

**IPC:** G07B 17/02

**Language of the proceedings:** EN

**Title of invention:**

Flexible billing rate for mail communication systems

**Applicant/Patentee:**

PITNEY BOWES INC.

**Opponent:**

Francotyp-Postalia Aktiengesellschaft & Co.

**Headword:**

-

**Relevant legal provisions:**

EPC Art. 56, 123(2), (3)

**Keyword:**

-

**Decisions cited:**

G 0001/99

**Catchword:**

-



**Europäisches  
Patentamt**

**European  
Patent Office**

**Office européen  
des brevets**

Beschwerdekammern

Boards of Appeal

Chambres de recours

**Case Number:** T 0714/98 - 3.5.2

**D E C I S I O N**  
**of the Technical Board of Appeal 3.5.2**  
**of 6 November 2001**

**Appellant:** Francotyp-Postalia Aktiengesellschaft & Co.  
(Opponent) Triftweg 21-26  
D-16547 Birkenwerder (DE)

**Representative:** Schaumburg, Thoenes, Thurn  
Patentanwälte  
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:** Frank, Veit Peter, Dipl.-Ing.  
Hoffmann Eitle  
Patent- und Rechtsanwälte  
Arabellastraße 4  
D-81925 München (DE)

**Decision under appeal:** Interlocutory decision of the Opposition Division  
of the European Patent Office posted 8 May 1998  
concerning maintenance of European patent  
No. 0 373 970 in amended form.

**Composition of the Board:**

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

## Summary of Facts and Submissions

- I. The opponent and sole appellant filed this appeal against the interlocutory decision of the opposition division maintaining European patent No. 373 970 in amended form according to the patentee's first auxiliary request.
- II. The statement of grounds of appeal, *inter alia*, set out that the decision under appeal was based on an incorrect construction of the terms of claim 1 and that one of the features which played an essential role in the reasoning for acknowledging an inventive step (storing of past data and projected use data in a user data base) was not disclosed in the application as filed.
- III. The respondent's reply to the statement of grounds of appeal emphasized that the decision under appeal considered the special technical features for carrying the idea into effect to be inventive, in particular the transmission of past and projected usage data under automatic control of, or prompting by, the central data station.
- IV. In a communication sent with the summons to oral proceedings in accordance with Article 11(2) RPBA, the Board observed that the feature of storing projected usage data in a user data base did not seem to be disclosed in the application as filed and that the storage and transmission of projected usage data under automatic control of the central data station seemed to be of great importance in the assessment of inventive step.

V. Oral proceedings were held before the Board on 6 November 2001.

(i) At the beginning of the oral proceedings the respondent observed that the rapporteur of the Board had participated in the opposition proceedings leading to the decision under appeal in that he had signed, as a chairman, the summons to the oral proceedings before the opposition division. The accompanying communication had expressed the provisional opinion that the patent could not be maintained as granted and that the dependent claims did not appear to contain inventive matter.

(ii) The chairman of the Board pointed out that the rapporteur had not participated in the decision under appeal (Article 24(1) EPC), which maintained the patent in a form amended after the summons had been issued and which was now appealed by the opponent. The general remark on dependent claims in the provisional opinion of the opposition division referred to above did not appear to indicate that the rapporteur could be suspected of partiality (Article 24(3) EPC), nor did the rapporteur consider that he should not take part in this appeal (Article 24(2) EPC). Although, for these reasons, there was no legal obligation to exclude the rapporteur pursuant to Article 24(1) EPC, the chairman observed that the Board would normally have chosen a different composition and explained why this was not done in this case.

(iii) The respondent declared that his observation was

in any case not intended to be a formal objection under Article 24 EPC and did not pursue this point further.

- (iv) In the debate on the allowability under Article 123(2) EPC of claim 1 as maintained by the decision under appeal, the parties' attention was drawn to the principles governing the allowability of requests to file amendments in view of the prohibition of *reformatio in peius* developed by decision G 1/99 of the Enlarged Board of Appeal (OJ EPO 2001, 381). The respondent filed a new set of claims 1 to 6 and a replacement page 2 with an insert to column 1. The appellant did not object to the allowability of these amendments, neither in view of the principles set out in G 1/99 nor as regards the provisions of Article 123(2) and (3) EPC.

VI. Claim 1 is now worded as follows:

"Apparatus for providing a billing plan, that is a payment schedule for a customer based upon the customer's needs and financial situation, and possibly including a combination of sale, rental and click charges or service fees, resetting fees and sales, comprising:

a central data station (18),

a plurality of user stations (10, 12, 14) each having:

a user data base storing usage data including past data;

means for accessing the central data station to request a billing plan;

a communication link connecting each user station to the central station;

the central data station (18) having:

a data base of usage information and billing data;

means responsive to a user station request for a billing plan to access the data base of the user station to cause the user station to transmit said usage data from its database to the central data station and to access user input data on projected usage and to transmit the projected usage data to the central data station;

means for analyzing the usage data and projected usage data of the user station to establish past and projected usage patterns;

means (46) responsive to the usage patterns of the user to calculate billing data;

means for transmitting the billing data via said communication link to the user station; and

the billing data including a billing plan based on the usage patterns."

Claims 2 to 6 are dependent on claim 1.

VII. The appellant (opponent) requested that the decision under appeal be set aside and that the European patent

No. 373 970 be revoked.

VIII. The respondent (patentee) requested that the decision under appeal be set aside and the patent be maintained in amended form in the following version:

- claims 1 to 6 filed in the oral proceedings
- description, page 2 with insert to column 1 filed in the oral proceedings
- otherwise in the form approved by the opposition division.

IX. The appellant argued essentially as follows:

US-A-4713761 (document D1) disclosed an apparatus comprising all the technical means, in particular a communication link between a central data station and a plurality of user stations, for transmitting usage data and for providing a billing plan based on the usage patterns. This apparatus had a "rate shopping" function (D1, column 10, lines 26 to 33) which would be initiated by a user station. A "hypothetical shipment" would then be rated by the central data station "without however accounting for or paying the costs determined". The central data station, responsive to a user station request, would return the costs "including any discounts" to the user station for comparison with the costs of other carriers. From the definition of the term "rates" given in D1 (column 1, lines 21 to 27), it was clear to the person skilled in the art that the rate shopping function contemplated the transmission of a billing plan which contained a payment schedule based on the customer's needs including rebates and credits

"against future services" (D1, column 5, lines 50 to 56). In the context of business transactions of this kind, it was usual to take past and future usage patterns of a potential customer into account when determining reductions in standard costs. D1 (column 11, lines 63 to 68) explicitly disclosed, as an example, special rates for off hour shipments in a time dependent rate schedule. An operator at the user station would thus have to input projected usage data (as implied by the term "hypothetical shipment") and access its usage data base where past data were already stored. The rate shopping function required that the usage data were transmitted to, and analysed by, the central data station before costs and discounts could be returned to the user station.

The fact that D1 did not explicitly mention how usage data were accessed and which usage data were transmitted to the central data station could not justify the presence of an inventive step. The apparatus of D1 had the technical means for accessing the user data base, eg as disclosed in the context of the rate change acknowledgement (D1, column 6, lines 10 to 19) and the considerations involved in calculating a billing plan which was based on usage patterns were obvious in business transactions. Moreover, claim 1 of the contested patent did not specify either that the usage data and a billing plan were automatically transmitted by the apparatus. The specification of the opposed patent (column 8, lines 13 to 15 and Figures 4A and 4B) made clear that the user and a data centre sales representative interactively accessed a system data base. Past data and projected usage data were obtained in separate and consecutive steps, the former through accessing the user station data base and the



latter by accessing the user input.

- X. The respondent (proprietor) argued essentially as follows:

The user stations of the apparatus disclosed in D1 did not permanently store usage data in a user data base. The data were stored in the central data station (D1, column 3, line 66 to column 4, line 3). The central data station thus could not automatically access the data base of a local user station and cause the user station to transmit usage data. Carrying out the rate shopping function in accordance with the teaching of D1, an operator of a user station would input and transmit the data required for a particular shipment. These data would not be analysed at the central data station to establish past and projected usage patterns. Various other reasons for giving rebates and credits might be taken into account for setting up the terms of a quotation based on the data as transmitted. D1 (column 9, line 63 to column 10, line 1; column 10, lines 45 to 51) emphasized payment before any shipment was made. The hypothetical shipment referred to in D1 (column 10, lines 26 to 33) thus did not constitute a payment schedule based on the customer's needs and financial situation, but an offer for a particular transaction made for comparison with the costs of other carriers to find out the most economical way of shipping. Therefore, D1 did not suggest a central data station causing an automatic flow of usage data from the user station to the central data station. Nor did it suggest a central data station comprising means which, responsive to a user station request and under automatic control, or prompting by, the central data station, could analyse the usage data, predict the

customer's future behaviour, and transmit a billing plan as specified in claim 1 of the opposed patent.

## **Reasons for the Decision**

1. The appeal is admissible.

2. *Amendments*

2.1 The decision under appeal found that the patent as amended according to the first auxiliary request met the requirements of the Convention. Claim 1 in this version specified user stations each having "a user data base storing usage data including past data and projected use data". The phrase "and projected use data" has been deleted from this part of Claim 1 and replaced by additional features of the central data station specifying that it had means to access the data base of the user station "and to access user input data on projected usage and to transmit the projected usage data to the central data station" and that it had means for analysing the usage data "and projected usage data". These added features are disclosed in the application as filed (claims 1, 2 and claim 12, feature (d); page 17, line 17 to page 18, line 4; page 19, lines 8 to 14; Figures 4A and 4B) and similarly in claims 1 and 2 as well as in corresponding passages of the opposed patent (column 8, lines 40 to 55; column 9, lines 32 to 39; Figures 4A and 4B).

2.2 The opponent and sole appellant did not object to the filing of these amendments to the opposed patent (see point V, (iv) *supra*). The Board considers that these

amendments arise from the appeal and are appropriate and necessary because the deleted feature had been objected to as an inadmissible amendment. The principles of prohibition of *reformatio in peius* developed by the Enlarged Board of Appeal in G 1/99 (*supra*), and in previous decisions referred to therein, concern the question whether a contested decision may be amended "to the appellant's disadvantage", in particular "put the opponent and sole appellant in a worse situation than if it had not appealed" (see G 1/99, point 3.1 and Order). Since the respondent has not objected to the deletion of the above feature (*volenti non fit injuria*), the Board need not examine of its own motion whether other amendments in the meaning of the Order of G 1/99 were possible or not, as long as the amendments are within the limits of Article 123(3) EPC. Since the deleted feature "and projected use data" was not present in claim 1 as granted, but was introduced in the opposition proceedings, the protection conferred by the claims of the amended patent has not been extended.

2.3 The appellant did not raise any objection to the amendments made during the appeal proceedings, or to those amendments made in the opposition proceedings which have been retained in the present claim 1. The Board is satisfied that they do not infringe Article 123(2) and (3) EPC. The same applies to the amendments of dependent claims 2 to 6 and the description, which have been adapted to the present claim 1.

### 3. *Inventive step*

3.1 Novelty of the subject-matter of claim 1 has not been

contested. It is common ground that D1 represents the closest prior art.

3.2 D1 (Figures 3 to 6) discloses apparatus comprising a central data station (data processing center 30), a plurality of user stations (shippers 10) and a communication link (35) connecting each user station to the central data station (Figures 3 and 4). The central data station has a data base of usage information and billing data (D1, column 7, lines 48 to 59; column 9, lines 46 to 63; Figure 6). Each user station (10) has a user data base storing usage data including past data (D1, column 5, lines 8 to 23; Figure 4) and means for accessing the central data station to request the costs for a hypothetical shipment. When the "rate shopping function" is used, a quotation which may include discounts would have to be transmitted via the communication link to the user station, although D1 does not give any details as to how, or when, this is done. Such discounts may take the form of immediate reductions in standard costs or issuance of credits or rebates from a seller (carrier) to a buyer (shipper), eg an allowance made by a carrier to a shipper against future services (D1, column 1, lines 21 to 30; column 5, lines 50 to 56; column 9, lines 46 to 53; column 10, lines 26 to 33). However, the rate shopping function contemplated in D1 as a beneficial use of the existing shipment rating function would merely return the costs for an individual "hypothetical" shipment in accordance with the applicable rates for a particular shipper (user station). The rates may be different for different shippers, or might change at predetermined times (D1, column 8, line 66 to column 9, line 1; column 11, lines 63 to 68).

- 3.3 The subject-matter of claim 1 of the opposed patent differs from this prior art in that the central data station has "means responsive to a user station request for a billing plan to access the data base of the user station to cause the user station to transmit said usage data from its database to the central data station and to access user input data on projected usage and to transmit the projected usage data to the central data station", means for analysing the usage data to establish past and projected usage patterns, and means for calculating and transmitting billing data including a billing plan, as specified in claim 1.
- 3.4 The problem solved by the apparatus of claim 1 may be seen as improving the known system regarding the automation of information processing between a plurality of user stations and the central data station (patent specification, column 3, lines 28 to 31; column 10, lines 20 to 37).
- 3.5 The general reference in D1 (column 10, lines 26 to 33) to a rate shopping function might suggest to a skilled person a certain automation of, for example, distinguishing an incoming "hypothetical shipment" from a real transaction (which will be accounted for). A quotation might also include conventional terms and conditions, such as costs, discounts, rebates and terms of payment, fixed in accordance with customer specific rates which are stored, at the central data station, in the data base for usage information and billing data. However, the central data station would only transmit a quotation which is determined by data which are input and transmitted by the user operator and by the rates stored at the central data station.

3.6 Therefore, D1 does not suggest the central data station could access the user data base ("responsive to a user station request") and "cause" the user station to access and transmit usage data, for analysing and establishing usage patterns on which the transmitted billing plan will be based. Thus, in accordance with the teaching of the opposed patent, the central data station is capable of controlling a billing plan session which is triggered by a user station request for a billing plan and (normally) ends with the transmission of a billing plan, ie a payment schedule for a customer based upon the customer's needs and financial situation (cf first part of claim 1). The means for analysing past and projected usage data and the means for calculating billing data, under control of the central data station, enable the central data station to automatically and flexibly respond to a user station request. For example, in the embodiment described in the opposed patent (column 8, lines 13 to 15; column 9, lines 7 to 9; column 10, lines 20 to 37; Figures 4A and 4B), control is exercised by the central data station in that a user may be led through various menu selections for the purpose of recalculating a billing plan based upon user input requirements and, in this context, the user and a data centre representative interactively access a comprehensive billing system data base.

3.7 Therefore, in the judgement of the Board, having regard to the state of the art cited by the appellant, the subject-matter of claim 1 as well as that of the dependent claims 2 to 6 is not obvious to a person skilled in the art and shall be considered as involving an inventive step (Article 56 EPC).

4. No other objections having been raised, the Board considers that the amended patent and the invention to which it relates meet the requirements of the Convention (Article 102(3) 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 in amended form in the following version:
  - claims 1 to 6 filed in the oral proceedings;
  - description, page 2 with insert to column 1, filed in the oral proceedings;
  - otherwise in the form approved by the opposition division.

The Registrar:

The Chairman:

M. Hörnell

W. J. L. Wheeler