

Internal distribution code:

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

D E C I S I O N
of 13 November 2001

Case Number: T 0909/98 - 3.5.2

Application Number: 89102136.2

Publication Number: 0328059

IPC: G07B 17/02

Language of the proceedings: EN

Title of invention:
Postal charge accounting system

Patentee:
PITNEY BOWES, INC.

Opponent:
01: Société Secap
02: Francotyp-Postalia Aktiengesellschaft & Co.

Headword:
-

Relevant legal provisions:
EPC Art. 56

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

Decisions cited:
-

Catchword:
-



Case Number: T 0909/98 - 3.5.2

D E C I S I O N
of the Technical Board of Appeal 3.5.2
of 13 November 2001

Appellant: 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)

Respondent: Francotyp-Postalia Aktiengesellschaft & Co.
(Opponent 02) Triftweg 21-26
D-16547 Birkenwerder (DE)

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

Other party: Société Secap
(Former Opponent 01) 21, rue Alphonse le Gallo
F-92100 Boulogne Billancourt (FR)

Representative: Rinuy, Santarelli
14, avenue de la Grande Armée
F-75017 Paris (FR)

Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 16 July 1998
revoking European patent No. 0 328 059 pursuant
to Article 102(1) EPC.

Composition of the Board:

Chairman: W. J. L. Wheeler
Members: M. Ruggiu
B. J. Schachenmann

Summary of Facts and Submissions

- I. The proprietor appealed the decision of the opposition division revoking European patent No. 0 328 059.
- II. Former opponent O1 withdrew its opposition shortly before oral proceedings which were held on 13 November 2001.
- III. The appellant requested that the decision under appeal be set aside and that the patent be maintained in amended form in the following version:
- claims 1 to 26 and description, columns 1 and 2, as filed during the oral proceedings;
 - description, columns 3 to 16 and drawings, Figures 1 to 7 and 8A to 8D, of the patent specification.

The respondent (opponent O2) requested that the appeal be dismissed.

- IV. Amended claim 1 reads as follows:

"1. A postal accounting system for separate accounting of transactions by multiple accountable entities, the system comprising:

an electronic postage meter (12), having an external electrical connection, a postage printer and having accounting registers therein for storing postage funds and for accounting for postage printed by the printer said accounting registers including a descending register, and said postage meter (12) being operable to

debit said descending register by a debit amount for each transaction;

at least one user integrated circuit card means (18) for accessing said postage meter (12) for use and being provided to each of a plurality of accountable entities for controlling and monitoring use of said postage meter (12) by said accountable entities, each user card means (18) including a microprocessor and memory, said user card memory further including a header section and a transaction table; and

user terminal means (14) connected to the external electrical connection of said postage meter (12) for controlling said postage meter (12) and for receiving from the postage meter, storing and processing postage meter use information, said user terminal means (14) including an integrated circuit card read-write unit (16) for receiving and communicating with any one of said user card means (18), said user terminal means (14) being operable to activate said postage meter (12) for use when an authorized one of said user card means (18) is placed into said card read-write unit (16) and to disable the postage meter when no authorized integrated circuit card means (18) is present in said card read-write unit (16), and said user terminal means (14) being arranged to transmit said postage meter use information to said user card means (18) when present in said card read-write unit (16) for storage in said transaction table, wherein said postage meter use information relates to each transaction completed by said postage meter when said user card means (18) is present in said card read-write unit (16) and includes predetermined accounting information in addition to a debit amount for each transaction."

Claims 2 to 26 are dependent upon claim 1.

V. The following prior art documents have been considered in relation to claim 1:

C1/D3: EP-A-0 207 492; and

D2: EP-A-0 241 598.

VI. The arguments of the appellant can be summarised as follows:

The closest prior art was disclosed in document D2 describing a postal accounting system of the pre-payment type with a postage meter storing postage funds in a descending register. A user terminal connected to the postage meter accounted for postage expended on a departmental basis by storing separate account records for a plurality of departments, which records were updated on the basis of use information received from the postage meter. The invention differed from D2 essentially in that integrated circuit cards including a microprocessor and memory, i.e. smart cards, were used to activate the postage meter. Each smart card enabled the postage meter and stored postage meter use information relating to a particular accountable entity, i.e. a particular department. This made the accounting system more secure. Since D2 did not contain any reference to a smart card, the subject-matter of claim 1 could not be obvious in view of D2 alone.

Document C1/D3 essentially described a post-payment postal accounting system using smart cards to transmit postage meter use information to a control center for billing purposes. Although C1/D3 also referred to

systems of the pre-payment type and mentioned pre-payment cards, it did not give any clear indication as to how the post-payment system described therein could be adapted to operate as a pre-payment system. C1/D3 also mentioned key cards allowing the splitting of usage and franking costs between several users of the same franking machine. However C1/D3 did not provide any further detail as to how this could be achieved. In particular C1/D3 did not disclose a common pool of credit, i.e. a common descending register for all users of the franking machine, which was split at a purely local level between different users.

A skilled person aiming to solve a problem of a pre-payment system as described in D2 would not consider C1/D3 which in its substance described a system for transmitting to a control center, such as a postal authority, information required for billing in a post-payment system. By contrast, the invention and the system described in D2 concerned the allocation of expenses between different users of the same postage meter and not payment of printed postage to a postal authority. Thus, the skilled person seeking to modify the system described in D2 had no reason to consider C1/D3. Furthermore, the smart cards described in C1/D3 stored information needed for accounting for all postage printed, while the cards of the present invention only stored information relating to a single accountable entity. Thus, documents D2 and C1/D3 could only be combined with the benefit of an impermissible *ex post facto* analysis.

VII. Essentially, the following arguments have been put forward against the patentability of the subject-matter of claim 1:

Document C1/D3 did not only concern a post-payment system but also a pre-payment system. It was clear that, in the case of a pre-payment system, the postage meter of the franking machine would include a descending register which would be debited by the debit amount of each transaction. Although the control center did not need to receive information to calculate the sum due for payment in the case of a pre-payment system, it was apparent from C1/D3 that, in such a case, postage meter use information would nevertheless be transmitted by means of smart cards from the franking machine to the control center to monitor usage of the postage meter. The smart cards of C1/D3 included a header section and a transaction table storing postage meter information relating to transactions completed by the postage meter. It was logical to include the debit amounts of the transactions in the information stored on the smart cards. The franking machine of C1/D3 stored in its memories a copy of each register of the smart cards, and thereby securely stored a common credit pool, which could be known by adding the values stored in the individual registers. Furthermore, according to C1/D3, a smart card had to be present in the card read-write unit of the franking machine to authorize operation of the postage meter, which implied that the postage meter was disabled when no smart card was present. C1/D3 also envisaged transmission of postage meter use information to a smart card at preset times or even, in a test mode, at every franking operation or every start of the franking machine. Amended claim 1 of the patent in suit only defined a system comprising a postage meter, a user terminal connected to the postage meter and smart cards in which the terminal stored postage meter use information and did not specify how the information

stored on the smart cards was used, so that possible differences in this respect with the system of C1/D3 were irrelevant.

Document D2 disclosed a system comprising a postage meter with a descending register and a user terminal storing information for separate accounting of transactions performed by different departments and it was obvious in view of C1/D3 to use smart cards for splitting costs between different users of the same franking machine.

Reasons for the Decision

1. The appeal is admissible.
2. Basis for the amendments made to claim 1 with respect to the granted version thereof can be found at the following passages of the application as originally filed:

the first two paragraphs of page 1 disclose that the postage meter includes a printer and a vault having a descending register charged for any use of the printer to print postage;

the paragraph bridging pages 3 and 4 and the one bridging pages 11 and 12 indicate that the invention aims at an accounting system providing separate accounting of multiple accountable entities such as departments;

the paragraph bridging pages 11 and 12 and the one bridging pages 15 and 16 show that at least one smart

card is provided to each of the accountable entities for controlling use of the postage meter by the entities;

the second paragraphs of pages 6 and 18 indicate that the postage meter is disabled when no smart card is present in the read-write unit and that the card receives postage meter use information relating to the value and quantity of all items of postage processed during a session when the card is present in the card read-write unit; and

the first sentence of the paragraph bridging pages 10 and 11 discloses that the postage meter is electronically connected to the user terminal and the second paragraph of page 27 explicitly mentions an external electrical connection.

Thus the amendments to claim 1 do not introduce subject-matter which extends beyond the content of the application as filed. The amendments to claim 1 also do not extend the scope of protection. The amendments to the description and the dependent claims are consistent with those made to independent claim 1. Therefore the conditions set out in Article 123(2) and 123(3) EPC are satisfied.

3. D2 discloses a postal accounting system for separate accounting of transactions by multiple departments constituting accountable entities. The system of D2 comprises an electronic postage meter having an external connection, a postage printer and accounting registers, including a descending register, for storing postage funds. The descending register is decremented by a debit amount for each transaction.

A user terminal is connected to the external electrical connection of the postage meter and receives from the postage meter, stores and processes postage meter use information. In particular the user terminal stores account records for the different accountable entities. A user enters into the terminal an account number. After a postage meter transaction, in particular when the processing of a batch of mail has been completed, the user terminal receives the contents of the batch register and piece count register from the electronic postage meter and updates the records for the specified account by adding these values to current totals for the specified account.

4. Thus the subject-matter of claim 1 differs from the prior art disclosed in D2 in that:
- a user integrated circuit card means, including a microprocessor and a memory, is provided to each of the accountable entities;
 - the user terminal means is provided with a card read-write unit and is operable to activate the postage meter when an authorized user card means is placed in the read-write unit and disable it otherwise;
 - each user circuit card means includes a header section and a transaction table in its memory; and
 - the user terminal means is arranged to transmit to a user card means for storage in the transaction table predetermined accounting information and a debit amount for each transaction completed when the user card means is present in the card read-

write unit.

5. With respect to the prior art disclosed in D2, these novel features increase the security of the system.
6. Document C1/D3 describes a franking machine which is activated when an integrated circuit card, including a microprocessor and a memory, is placed in a card read-write unit of the franking machine. The card (3P) is specifically intended for transmitting information between the franking machine and a control center. For these purposes, the card includes a header section and a transaction table storing information to be transmitted to the control center to permit billing for usage of the franking machine. It is therefore apparent that the information stored in the transaction table must include predetermined accounting information, in particular information identifying the franking machine being accounted for, and information representing the amount of transactions completed by the franking machine. C1/D3 also mentions pre-payment cards and indicates that, instead of being charged subsequently, the postage value printed could be pre-paid. Further, according to C1/D3, other cards can be used with the franking machine, in particular cards (3C) permitting the splitting of costs between several users of the same franking machine.
7. The integrated circuit cards disclosed in C1/D3 are used to limit usage of the franking machine to those users physically possessing an authorized card. It is apparent that this makes tampering more difficult. Therefore, the board considers that the skilled person aiming to increase security of the system described in D2 might well consider the teaching provided by

document C1/D3 and provide each accountable entity with an integrated circuit card, include a read-write unit in the user terminal of D2, and arrange the terminal to activate the postage meter for use when an authorized card is placed in the read-write unit and disable it when no authorized card is present in the read-write unit. A header section would then have to be included in the memory of the card to allow the validity of the card to be checked in the interests of security.

8. Document C1/D3 does not indicate whether or not those cards (3C) which permit splitting costs between different customers also store information relating to the transactions completed by the postage meter while the card (3C) is present in the read-write unit. This does not appear to be necessary since C1/D3 discloses that another, separate card (3P) is used for transmission to the control center of the information necessary for billing for usage of the franking machine (see point 6 above).

9. Furthermore, the system of D2 is a pre-payment system, in which the debit amount for each transaction of the postage meter is debited from the value stored in a descending register of the postage meter. Therefore, contrary to the embodiment described in detail in document C1/D3, there is no need to transmit the debit amount to a control center for billing. Thus, no motivation is present which would induce the skilled person modifying the system of D2 to transmit the debit amount of a transaction to a card present in the terminal and store it in a transaction table of the card. Therefore, the mere combination of D2 and C1/D3 does not result in the subject-matter of claim 1. Also no indication can be found in the documents which would

render it obvious to take the further step necessary to arrive at the system of claim 1.

10. Starting from the prior art disclosed in C1/D3 and combining it with the teaching of D2 would not lead to a different result.
11. Thus, the board has come to the conclusion that the subject-matter of claim 1 is not obvious to the skilled person and has to be considered as involving an inventive step in the sense of 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 maintain the patent in amended form in the following version:
 - claims 1 to 26 and description, columns 1 and 2, as filed during the oral proceedings;
 - description, columns 3 to 16 and drawings, Figures 1 to 7 and 8A to 8D, of the patent specification.

The Registrar:

The Chairman:

M. Hörnell

W. J. L. Wheeler