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D E C I S I O N
of 18 October 2000

Case Number: T 1071/98 - 3.5.2

Application Number: 89313228.2

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IPC: B07C 1/00

Language of the proceedings: EN

Title of invention:
Communication system

Patentee:
PITNEY BOWES INC.

Opponent:
Francotyp-Postalia GmbH

Headword:
-

Relevant legal provisions:
EPC Art. 56

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

Decisions cited:
-

Catchword:
-



Case Number: T 1071/98 - 3.5.2

D E C I S I O N
of the Technical Board of Appeal 3.5.2
of 18 October 2000

Appellant: Francotyp-Postalia GmbH
(Opponent) Triftweg 21-26
D-16547 Birkenwerder (DE)

Representative: Thoenes, Dieter, Dr.
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: Avery, Stephen John
Hoffmann Eitle
Patent- und Rechtsanwälte
Arabellastrasse 4
D-81925 München (DE)

Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 15 October 1998
rejecting the opposition filed against European
patent No. 0 373 969 pursuant to Article 102(2)
EPC.

Composition of the Board:

Chairman: W. J. L. Wheeler
Members: F. Edlinger
P. H. Mühlens

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. 373 969.
- II. The following documents cited in the notice of opposition were referred to in the appeal proceedings:
- D1: GB-A-2 188 871 and
- D2: GB-A-2 178 880.
- III. Oral proceedings were held before the Board on 18 October 2000 during which the respondent (patentee) filed new claims 1 to 17 and columns 1 to 4 of the description.
- IV. Claim 1 now reads as follows:
- "A communication system for processing mailpieces requiring payment of postage for distribution, comprising:
- a central data station (18);
- a plurality of user stations (10,12,14), each of said user stations including a plurality of components (78,80,82,84,86,88,90,92,94) forming a path for the proper processing of said mailpieces, and communication link means (30,44), the link means (30,44) comprising a portion (44) interconnecting said user stations and the central data station (18);
- characterized in that:
- each of said user stations includes means for checking that all its components are operational and further includes as one of its components a certification means

(92) for applying a visual certification to each of said mailpieces when processed by said components certifying that its components are operational and that the postage applied is correct having regard to any presorting which has been performed; and the central data station (18) includes means (32) for periodically interrogating via said link means (30,44) each of the user stations for determining the operational status of each of its components."

Claims 2 to 17 are dependent on claim 1.

V. The appellant argued essentially as follows:

D1 disclosed the features of the preamble of claim 1 of the contested patent and dealt with the same problems as the contested patent, in particular that of making sure that processing and accounting of mailpieces were carried out correctly without the need for on-site inspections. To this end, the system of D1 printed a passport (D1, Figure 6) accompanying a batch of mail. The passport contained a visual indication of information enabling the postal services to verify whether the mail has been processed in conformity with the rate and regulation requirements. In this context, it was irrelevant whether malfunctioning of a mail processing component or an act of tampering caused the irregularity at the user station.

Also D2 aimed at eliminating on-site inspections in a system comprising the features of the preamble of claim 1 under consideration with the sole difference that D2 referred to components of postage meters forming a path for the proper processing of mailpieces. D2 further disclosed means for periodically checking

that all these components were operational because sensors (36) indicated that something was wrong in the processing of mail when an occurrence of tampering with the components was detected. In a first embodiment, the means for checking were electronically interrogated by the central data station and certified that the components worked properly. In a second embodiment, the user stations included means for applying a visual certification ("tells") to a mailpiece, which was periodically sent to the user stations. The mailpiece which was then sent back the central data station indicated whether the components were in proper working order.

The subject-matter of claim 1 of the contested patent did not involve an inventive step because, in view of the objectives disclosed in D1 and D2, it was obvious to extend the check to all the mail processing components and to apply a visual certification to each of the processed mailpieces in order to improve the security of the system. These measures merely followed the direction given by D1 and D2 that verification data should be provided at the user stations to prevent malfunction or manipulation of their components without the need for on-site inspections.

VI. The respondent argued essentially as follows:

The concept of work sharing in systems as claimed in the contested patent included a transfer of certain preprocessing activities from the central postal facility to the user. The increased work load on the user was compensated by a reduction in postal rates. The amount of reduction should not exceed the serving costs for the postal facility providing such services

on its own and thus depended on the work sharing operation selected by the user, ie a maximum rate reduction could be offered if the mail presorted at a user station complied with all the criteria set under work sharing requirements. Whether an individual mailpiece was entitled to one of several potentially correct postage rates could only be decided on checking the batch as to its compliance with the selected work sharing operation. The contested patent provided a system wherein a user would select certain preprocessing facilities which were certified at the user station, and accepted as properly performed by the postal authorities.

Therefore, the subject-matter of claim 1 specified an add-on to the system known from D1 in that it included a two-part certification procedure as a further layer of security which consisted of a self-certification performed by the user station and a periodic interrogation, by the central data station via a communication link, of the operational status of each of the components of the user stations. The visual certification applied to each of the mailpieces when processed by the components of the user station certified that the checking means found all the components operational and that the postage applied to the individual mailpiece was correct taking account of the presorting criteria selected by the user (cf patent specification, column 13, line 51 to column 14, line 30). The periodic interrogation via the communication link ensured that the certification applied to each of the mailpieces could be relied upon.

The passport accompanying the batch of mailpieces in the system of D1 merely listed the group of

preprocessed documents but did not provide a certification that the preprocessing had been done correctly. D2 addressed the problem of detecting tampering of one component of a user station, ie that of the postage meter. D2 was not concerned with certification of correctly preprocessed mailpieces and therefore could not give any hint at the subject-matter of the contested patent.

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

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

Claims: 1 to 17 as filed in the oral proceedings;

Description: columns 1 to 4 as filed in the oral proceedings;
columns 5 to 18 of the patent specification; and

Drawings: Figures 1 to 5D, pages 16 to 25 of the patent specification.

Reasons for the Decision

1. The appeal is admissible.

2. *Amendments*

2.1 Claim 1 now specifies "a communication system for processing mailpieces requiring payment of postage for distribution" instead of "a communication system for processing information for distribution" in claim 1 as granted. The features "components (78, 80, 82, 84, 86, 88, 90, 92, 94) forming a path for the proper distribution of said information" and "means for applying a visual indication of said certification to said information when distributed" have been replaced by "components (78, 80, 82, 84, 86, 88, 90, 92, 94) forming a path for the proper processing of said mailpieces" and "means (92) for applying a visual certification to each of said mailpieces when processed by said components". Moreover, "means for checking that all its components are operational" are now specified in "each" of the user stations and the visual certification certifies "that its components are operational and that the postage applied is correct having regard to any presorting which has been performed". Claims 2, 5, 6 and 7 and the description, columns 1 and 3 have been adapted to the amended claim 1.

2.2 Applying a visual certification to mailpieces "when processed" (by the components along a path 78 of a user station which is involved in the distribution of mailpieces), as disclosed in the patent specification (eg column 12, line 49 to column 13, line 19; claim 6 and Figure 4), constitutes the only meaningful example disclosed in the patent of what was meant by "applying a visual indication of said certification to said information when distributed". On the one hand, the mailpieces constitute both specific pieces of information and the information carriers to which a "visual" certification is applied in the course of the

processing (preferably at the end of it, cf column 13, lines 7 to 19). On the other hand, the visual certification is applied when processed by said components so as to remain visible in the "system for processing information for distribution". Therefore, the amendments do not extend the protection conferred (Article 123(3) EPC).

- 2.3 The application as filed (see page 24, paragraph 2 to page 28, line 9; claims 10 or 21 and Figures 4 and 5A; cf column 12, line 49 to column 14, line 50 and claim 6 of the patent specification) discloses processing of mailpieces and applying a visual certification to each of the mailpieces certifying that the components are in proper working order and that the postage is correctly applied in accordance with requirements which include presorting as one of these requirements. The amendments thus do not introduce subject-matter which extends beyond the content of the application as filed (Article 123(2) EPC).

3. *Inventive step*

- 3.1 Novelty is not in dispute. The closest prior art is evidenced by D1 because it not only discloses the features of the preamble of claim 1 filed in the oral proceedings, as generally agreed, but also deals with visual indications applied to individual mailpieces and to a passport (or mailing statement 46) accompanying each batch of mailpieces. Each mailpiece (D1, Figure 7) may contain an indication of a transaction number, the run of the particular batch, date and time, the class of mail, the batch number and postage amount (D1, page 3, lines 30 to 36; page 4, lines 49 to 53). The information visually indicated on the passport (D1,

Figure 6) may contain the total postage for the batch of mail, the transaction number, the descending register amount, date and time, the class, the batch number, the run number and piece count for the batch, as well as identification numbers (page 3, lines 79 to 88). The information printed on the passport is transmitted to the central data station through the communication link means automatically after each batch (D1, page 3, lines 119 to 124). The visual indications enable the postal service to determine whether a batch of mail constitutes an authorized transmission of mail, ie whether the amount of postage has been paid for the batch, without requiring on-site inspections. A postal employee may contact the central data station to verify whether the information contained on the passport is authentic (D1, page 3, lines 76 to 78 and lines 105 to 111; page 4, lines 14 to 25 and lines 74 to 79; page 5, lines 97 to 113).

3.2 The subject-matter of claim 1 filed in the oral proceedings differs from the prior art disclosed in D1 by the features of its characterising portion, in short: means for checking the components, means for applying a visual certification to each of the mailpieces at each user station and means for periodically interrogating each of the user stations at the central data station. These features contribute to improve the system of D1 by providing verification that certain preprocessing procedures have been properly performed (cf patent specification, column 3, lines 30 to 37; column 4, lines 9 to 20; column 12, lines 49 to 56).

3.3 The system as specified in claim 1 filed in the oral

proceedings is suitable for applying to each mailpiece a certification which visually indicates that all the components of the mail processing path of the user station processing said mailpiece were operational when the certification was applied and that the postage applied is correct having regard to any presorting performed. The certification in this system is thus based on both the proper working of the components involved in the mail processing and a check for compliance with presorting requirements. Moreover, the means for periodically interrogating each of the user stations enable the central data station to check the reliability of each of the components of the interrogated user station, including the certification means. This is in no way suggested in D1 because there it is left to the postal services to check the authorization and the correctness of the amount of postage paid for the batch based on the information on the mailpieces and the passport accompanying the batch, to avoid the need for on-site inspections (D1, page 3, lines 105 to 111; page 4, lines 12 to 27 and lines 74 to 79; page 5, lines 91 to 113).

- 3.4 D2 (page 1, lines 17 to 29 and lines 46 to 49) has a similar object of reducing the need for on-site inspections to prevent tampering of postage meter components. D2 does not refer to processing of mail taking account of different classes, nor to applying visual verification information on each of the processed mailpieces. Therefore, the system disclosed in D2 is not as close as the prior art known from D1 to the contested patent. D2 (page 2, lines 37 to 48, lines 64 to 67 and lines 118 to 120; page 3, lines 28 to 31) discloses two alternative embodiments of periodic remote inspection of postage meters to check whether

any attempt of obtaining fraudulent postage, such as an occurrence of tampering, has been detected by sensors associated with components of the postage meters. Another check to be made relates to the sum of the ascending and descending registers. In the first embodiment, the sensors are electronically polled through a communication link. In the second embodiment, a visual indication containing information about the result of these checks is printed on a postcard which is periodically sent by the central data station. However, D2 does not suggest applying a certification to each mailpiece processed, nor do the periodic checks take account of the correctness of the postage applied. Since the visual indication printed on a postcard in the second embodiment does not constitute a certification in the meaning of the contested patent, even a combination of the two alternative embodiments disclosed in D2, or a combination of the teachings of D1 and D2, would not lead the person skilled in the art to the subject-matter of claim 1 filed in the oral proceedings.

- 3.5 The subject-matter of claim 1 thus shall be considered as involving an inventive step having regard to the state of the art disclosed in D1 and D2. The same applies to claims 2 to 17 which are dependent on claim 1.

4. In the result, the Board is of the opinion that the patent as amended and the invention to which it relates meet the requirements of the 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 as amended in the following version:

Claims: 1 to 17 as filed in the oral proceedings;

Description: columns 1 to 4 as filed in the oral proceedings;
columns 5 to 18 of the patent specification; and

Drawings: Figures 1 to 5D, pages 16 to 25 of the patent specification.

The Registrar:

The Chairman:

M. Hörnell

W. J. L. Wheeler