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D E C I S I O N
of 19 December 2001

Case Number: T 0339/99 - 3.5.2

Application Number: 91311899.8

Publication Number: 0493948

IPC: G07B 17/02

Language of the proceedings: EN

Title of invention:
Franking machine

Patentee:
NEOPOST LIMITED

Opponent:
Pitney Bowes Inc.

Headword:
-

Relevant legal provisions:
EPC Art. 56

Keyword:
"Inventive step (no)"

Decisions cited:
-

Catchword:
-



Case Number: T 0339/99 - 3.5.2

D E C I S I O N
of the Technical Board of Appeal 3.5.2
of 19 December 2001

Appellant: Pitney Bowes, Inc.
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Respondent: Neopost Limited
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Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 27 January 1999
rejecting the opposition filed against European
patent No. 0 493 948 pursuant to Article 102(2)
EPC.

Composition of the Board:

Chairman: W. J. L. Wheeler
Members: J.-M. Cannard
J. H. P. Willems

Summary of Facts and Submissions

I. The opponent appealed against the decision of the opposition division rejecting the opposition filed against European patent No. 0 493 948.

II. The following prior art documents:

D1: GB-A-2 188 880

D2: EP-A-0 376 488

D7: US-A-3 692 988

D8: US-A-4 839 813

cited in support of the opposition remain relevant to the present appeal.

In addition document:

D10: US-A-4 933 706

was cited for the first time by the opponent with a letter dated 13 December 2001.

III. Independent Claim 1 of the patent in suit as granted reads as follows:

"A franking machine including a secure module; electronic control and accounting means (12) within the secure module; a plurality of registers (14, 15) within the secure module for storing accounting data relating to use of the machine in franking items; means (21) to input franking data to said electronic accounting and

control means to select a value of franking; printing means (11) operable by the electronic control and accounting means (12) to print a franking impression on an item to be franked; said electronic control and accounting means being operative in response to input of said franking data to control the printing means to print a franking impression corresponding to the selected value of franking and to update the accounting data stored in the set of registers (14, 15)

characterised in that the plurality of registers (14, 15) within the secure module includes a first set of registers (14, 15) for storing accounting data relating to use of the franking machine in respect of a first service and a second set of registers (14, 15) for storing accounting data relating to use of the franking machine in respect of a second service; in that the input means (21) is operable to select one said first and second services; in that the electronic accounting and control means (12) is operative in response to selection of said one of the services by the input means to control the printing means (11) to print a first franking impression and to update the accounting data in the first set of registers (14, 15) in response to selection of said first service and to print a second franking impression and to update the accounting data in the second set of registers in response to selection of said second service."

Claims 2 to 7 are dependent on claim 1.

IV. Oral proceedings were held on 19 December 2001.

V. The arguments of the appellant/opponent can be summarised as follows:

Claim 1 was not restricted to a franking machine for separately accounting different services of the same postal authority, but covered also a franking machine for use with different postal authorities (see the patent in suit, column 3, lines 4 to 9). In view of this, separating the revenues to be allocated to the different services provided by a postal authority (the patent, column 1, lines 32 to 41) could not be considered as the only problem solved by the invention.

Claim 1 lacked an inventive step. As starting point the skilled person could equally use the franking machine according to D2, the mailing server according to D1, or the postage metering system according to D7.

The franking machine according to D2 implicitly comprised a secure module since it was common ground that the registers of a franking machine were included in a secure housing and thus D2 disclosed the preamble of claim 1. The technical problem starting from the "standard" franking machine according to D2 was the problem mentioned at column 1 of the patent in suit. To solve this problem it was self-evident for the skilled person to separate the registers for separating the accounting data relating to different activities and to modify the control means to split these data. The problem could equally have been solved in an obvious way merely by dividing the existing registers in separate areas. The skilled person considering how to separate the different accounting data would not have envisaged duplicating the franking machine or the secure module because separating the registers was technically easier and cheaper than providing a second piece of equipment providing all the same functions as the first piece.

D1 disclosed a server for a batch mailing system which included a secure module, electronic control and accounting means and registers for accounting data within the secure module and printer means for printing franking impressions. D1 which clearly contemplated equivalence between servers and franking machines (column 2, lines 84 to 88; column 3, lines 19 to 28) thus disclosed the features of the preamble of claim 1. To separate accounting data according to different services used it was self-evident for the skilled person to separate the accounting registers.

D7 disclosed the use of two electro-mechanical franking machines controlled to frank items in respect of the services provided by two different postal carriers. Implementing D7 in electronic postage meters, the skilled man would inevitably have made the choice of using a common printhead (a relatively expensive item) and seen that the need to keep the accounting function separate for the different postal carriers merely required the provision of respective sets of registers (relatively inexpensive items) within the same secure module as the control and accounting means.

VI. The arguments of the respondent/proprietor can be summarised as follows:

Document D2 which was merely cited in the statement of grounds of opposition and analysed by the opponent for the first time in the course of the appeal proceedings should not be further considered. If D2 were however considered as the closest prior art, the preamble of claim 1 should be amended because the franking machine according to D2 was not disclosed as having a secure housing.

D2 which did not contemplate or even suggest the use of the franking machine for different postal services did not provide any motivation for duplicating the accounting registers in the secure module of the franking machine. On the contrary D2 suggested using two separate franking machines or secure modules. The statement in column 1 of the patent that postal authorities required revenue to be allocated for the different services they offered was not correct and there was in the cited prior art or in the common knowledge no evidence of such a requirement. The opponent did not apply correctly the problem solution approach since he started from the preamble of claim 1 and not from a single prior art document. It was not proper to rely on nebulous common knowledge to modify a prior art teaching. For these reasons D2, alone or in combination with D7, did not render obvious the franking machine according to claim 1.

D1 did not disclose the preamble of claim 1 since it did not relate to a franking machine, but to a server for processing batch mail. To transform a server into a franking machine required the inclusion of an ascending register in the server, which was contrary to the teaching of D1. The registers in D1 were not updated after the handling of each mail piece, but after processing a batch of mail. Although D1 processed batches for different classes of mail, no separate accounting for different postal services was disclosed or suggested in D1. D7 was a twenty years old document relating to a postage mailing system which comprised two electro-mechanical franking machines, each being controlled to frank items for a different postal authority. Postal authorities, which had access to the inside of franking machines, would not wish other

postal authorities to have access to their accounting data. The skilled person thus would not have envisaged modifying the teaching of D1 or D7 to include respective accounting registers for different services or different postal authorities in the same secure module of a franking machine.

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

VIII. The respondent requested that the appeal be dismissed and the patent maintained unamended.

Reasons for the Decision

1. The appeal is admissible.

2. *Novelty*

The novelty of the subject-matter of the independent claim 1 of the patent in suit has not been disputed.

3. *Closest prior art - Problem*

3.1 D2, which was considered by the opponent as one of the possible starting points, forms the closest prior art. D2 (Figures 1 and 2; page 2, line 51 to page 3, line 32) discloses a franking machine (10) which includes electronic control and accounting means (CPU 50, decoder 56, drivers 80, 82, 84), a plurality of registers for storing accounting data relating to use of the machine in franking items (Figure 3: CMOS battery-backed RAM 104 and EEPROM 106; page 3, lines 48 to 55; page 5, lines 4 to 15; page 7, lines 53 to 58),

means to input franking data to said electronic accounting and control means to select a value of franking (keyboard display module 92), printing means operable by the electronic control and accounting means to print a franking impression on an item to be franked (print die 30; 83), whereby the electronic control and accounting means are operative in response to input of said franking data to control the printing means to print a franking impression corresponding to the selected value of franking and to update the accounting data stored in the set of registers (Figures 5 to 12; page 5, lines 18 to 24).

- 3.2 D2 does not disclose a secure module for housing the registers and the electronic control and accounting means. It is however part of the common general knowledge in the relevant field that a secure housing for preventing tampering is an essential, and even **unavoidable**, element of a franking machine. In this respect it is referred for instance to D1 which discloses a server (Figure 1; 25) for a batch mailing system. Such a server which is disclosed as having many characteristics of a franking machine, ie, security, a descending register and the like (page 2, lines 82 to 84; page 3, lines 9 to 28) discloses more specifically a secure accounting unit (25) which includes a descending register (26) and control and accounting means (24) of the server. Consequently, in the view of the Board, the registers and the control and accounting means disclosed in D2 are implicitly included in a secure module and a franking machine according to the preamble of claim 1 of the patent in suit is disclosed in D2. In any case, it would be obvious to the person skilled in the art to provide this feature.

4. It is true that no particular relevance was attached to D2 during the opposition proceedings and that the appellant presented arguments based on it for the first time in the letter dated 28 July 2000 in response to the respondent's comments on the grounds of appeal. However, D2 was cited in the European Search Report and in the appellant's notice of opposition and the arguments based on D2 were filed some sixteen months before the oral proceedings, so that the respondent had ample time to consider them and present counterarguments. Given these circumstances, the Board has come to the conclusion that D2 should not be disregarded as a late filed document. Indeed, in the judgement of the Board, D2 objectively forms the nearest prior art on the basis of a comparison between the features claimed in the opposed patent and those disclosed in the various pieces of prior art available on file.

5. Starting from D2, the objective problem underlying the present invention can be seen as providing means for accounting separately the revenues for the different services provided by a postal authority, as put forward by the appellant.

- 5.1 This corresponds to the technical problem identified in the application document of the patent in suit (see the patent, column 1, lines 38 to 41) resulting from the requirement of postal authorities: "It is becoming common for postal authorities to separate theirs letters and parcels activities and to require revenue to be allocated to the appropriate activity".

- 5.2 The respondent has alleged that this statement was incorrect and not proved by any document or the general

common knowledge. However, the same statement is to be found in the original application (see the application as published, column 1, lines 39 to 42) and the respondent has not convinced the Board of the correctness of his allegation that this statement was wrong. Moreover it is not important whether the problem has already been mentioned in a cited prior art document or forms part of the relevant common knowledge; what matters is: would it have been an obvious problem for the skilled person to want to solve and can it be objectively recognised as the problem when comparing the closest prior art D2 with the invention.

6. *Inventive step*

6.1 To solve the technical problem of providing means for accounting separately the revenues for the different services, for example letters and parcels, provided by a postal authority, which stems from a requirement of the postal authority, it is self-evident to provide a separate set of ascending and descending registers for storing the accounting data relating to each service for which separate accounting is required and to modify the control and accounting means in response to the input means to split the respective accounting data. This could be done by using separate physical registers or merely by dividing the existing registers in separate areas for respectively storing the different data. Each one of both these alternatives is obvious to the skilled person. Moreover different physical registers (hardware) or different virtual registers (software) both fall within the terms of claim 1. It is also self-evident that the control and accounting means should control the printing means in accordance with

the data in the appropriate registers to print the corresponding franking impression. Accordingly it is obvious to the skilled man starting from D2 and wishing to accommodate the requirement of the postal authorities to modify the prior art disclosed in D2 in the above manner and arrive at a franking machine according to claim 1 of the patent in suit.

- 6.2 According to the respondent, the skilled person starting from D2 would merely duplicate the secure module according to D2 in order to accommodate the requirement of the postal authorities.
- 6.3 The franking machine according to D2 is a general purpose machine which can be used for franking letters as well as parcels. It is thus technically not necessary to have a second similar piece of equipment implementing the same general functions as the first piece, in parallel, but economically more advantageous to only duplicate the parts of the equipment which are devoted to the different functions implied by the postal authority requirement. Moreover, since the problem is concerned with different services provided by the same postal authority, there is no need to consider separate secure modules for reasons of confidentiality. Under these circumstances the respondent has not convinced the Board that it would be so obvious to the skilled person to duplicate the secure module that he would not think of the claimed solution.
- 6.4 Hence, having regard to D2 and the common general knowledge in the art, the subject-matter of claim 1 of the patent in suit is not to be considered as involving an inventive step within the meaning of Article 56 EPC.

7. The Board concludes therefore that the grounds for opposition mentioned in Article 100 EPC prejudice the maintenance of the patent.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The patent is revoked.

The Registrar:

The Chairman:

M. Hörnell

W. J. L. Wheeler