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D E C I S I O N
of 13 November 2003

Case Number: T 0661/99 - 3.2.5

Application Number: 93470011.3

Publication Number: 0571308

IPC: B43M 7/02

Language of the proceedings: EN

Title of invention:

Apparatus and method for automated mail extraction and remittance processing

Patentee:

OPEX CORPORATION

Opponent:

NEOPOST LTD

Headword:

-

Relevant legal provisions:

EPC Art. 56, 123(2)

Keyword:

"Extension beyond the content of the application as filed, main request and first auxiliary request (yes)"

"Inventive step, second auxiliary request (no)"

Decisions cited:

-

Catchword:

-



Case Number: T 0661/99 - 3.2.5

D E C I S I O N
of the Technical Board of Appeal 3.2.5
of 13 November 2003

Appellant: NEOPOST LTD
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Decision under appeal: Interlocutory decision of the Opposition
Division of the European Patent Office posted
30 April 1999 concerning maintenance of
European patent No. 0571308 in amended form.

Composition of the Board:

Chairman: W. Moser
Members: W. R. Zellhuber
P. E. Michel

Summary of Facts and Submissions

- I. The appellant (opponent) lodged an appeal against the decision of the Opposition Division maintaining the European patent No. 0 571 308 in amended form.
- II. The Opposition Division held that the grounds for opposition submitted by the appellant under Article 100(a) EPC (lack of novelty, Article 54 EPC, and lack of inventive step, Article 56 EPC) and Article 100(c) EPC did not prejudice the maintenance of the patent in suit as amended.
- III. Oral proceedings were held before the Board of Appeal on 13 November 2003.

The respondent (patent proprietor) informed the Board on 10 October 2003 that he would not be represented at the oral proceedings.

- IV. The appellant requested that the decision under appeal be set aside and that the European patent No. 0 571 308 be revoked.

The respondent requested that the decision under appeal be set aside and that the patent be maintained on the basis of the following documents filed on 10 October 2003:

- (a) main request: claims 1 to 117 filed as main request; or
- (b) first auxiliary request: claims 1 to 117 filed as first auxiliary request; or

(c) second auxiliary request: claims 1 to 117 filed as second auxiliary request.

V. Claim 1 of the main request reads as follows:

"A document processing apparatus (1) for processing selected documents (42) contained within envelopes (40), comprising:

means for extracting the selected documents (42) from the envelopes (40);

a remittance processing device (2) for remittance processing the extracted documents, wherein the remittance processing device (2) has input means for receiving the extracted documents; and

means(45,84,115) for receiving the extracted documents from the extracting means and for automatically conveying the extracted documents to said input means in response to appropriate control signals."

Claim 1 of the first auxiliary request differs from claim 1 of the main request in that the expression "in response to appropriate control signals" is replaced by the expression "in response to appropriate signals".

Claim 1 of the second auxiliary request differs from claim 1 of the main request in that the expression "in response to appropriate control signals" appearing at the end of claim 1 of the main request is replaced by the expression "for introduction to the remittance processing device".

VI. In the course of the appeal procedure, the following documents have *inter alia* been referred to:

D2: US-A 3 266 626;

D3: US-A 3 363 783;

D6: Brochure of the firm Pitney Bowes, World Headquarters, "Unmatched remittance extraction productivity: Model 1290 Opener/Extractor specifications speak for themselves!", printed in U.S.A © 1988 Pitney Bowes, Inc.

VII. In the written procedure and during oral proceedings, the appellant argued essentially as follows:

The subject-matter of claim 1 of the main request extended beyond the content of the application as filed. As already pointed out by the Board in its communication of 30 July 2003, the feature of "for automatically conveying the extracted documents to said input means in response to appropriate control signals" was disclosed in the application as filed only in combination with a document processing apparatus wherein the apparatus for extracting documents was provided with a buffer mechanism 135 including a buffer bin 144 and a demand feed mechanism 155.

The same applied to claim 1 of the first auxiliary request.

Furthermore, the subject-matter of claim 1 of the second auxiliary request was not novel with regard to the prior art as disclosed in each of the documents D2, D3 and D6.

Document D6 disclosed an apparatus for extracting documents from the envelopes, wherein the apparatus might be used either as a stand alone unit or in-line as part of a larger remittance processing system. The expression "in-line" could only be construed as meaning that the documents were automatically conveyed to the remittance processing device.

Document D2 disclosed a document handling system wherein the documents, eg. proxy cards, were extracted and automatically conveyed to the next station for further processing, ie. sorting and tabulating. According to column 4, lines 51 to 54, the apparatus was equally applicable to the handling of other types of documents, such as bank deposits made through the mail. That application directly gave rise to an apparatus according to claim 1 of the second auxiliary request.

Document D3 concerned an apparatus wherein postal check vouchers, after having been removed from the envelopes, were stacked in such a way that further automatic processing could be carried out by removing individual vouchers in succession from the stack, cf. column 1, lines 38 to 45. This implied that the vouchers were conveyed automatically from the extracting means to the input means of a remittance processing apparatus as claimed in claim 1 of the second auxiliary request.

The arguments brought forward with respect to the issue of lack of novelty, in particular, those pertaining to document D6, would be the same with regard to the issue of lack of inventive step, if novelty of the subject-matter of claim 1 of the second auxiliary request were to be acknowledged by the Board.

VIII. In the written procedure, the respondent argued essentially as follows:

According to the application as filed, cf. column 22, lines 44 to 45 and column 23, lines 8 and 9, and lines 17 to 33 of the published version, the supply of documents to the input means of the remittance processing device was controlled automatically in response to appropriate signals. These signals could include signals derivable from the remittance processing station, a foot pedal associated with the remittance processing station or sensors. It was thereby believed that claim 1 of the main request was allowable with regard to the requirements of Article 123(2) EPC.

As far as claim 1 of the first auxiliary request was concerned, specific support for the term "appropriate signals" was provided at line 18 of column 23 of the application as filed (published version).

With regard to the novelty and inventive step objections, it was believed that no device in any of the cited references taught or suggested the features of the respondent's claims.

In particular, the appellant relied on a single vague reference ("in-line") taken out of context from document D6, and its interpretation of the reference ignored the actual structure of the device disclosed.

In the apparatus shown in document D6, the extracted documents were discharged into a stack in the output bin. From there, the stack of extracted documents was manually transported to the next area for further processing. That was what the document meant by being used "as a stand alone unit". The question became what did the document mean by "in-line". Although the intended meaning was unclear, document D6 did not suggest that the device could be interconnected with additional remittance processing machines. The device was not configured for that purpose and, due to the absence of any transport mechanism, it could not be used "in-line" in the manner suggested by the appellant. It would be a very complicated and quite expensive alteration to add a transport mechanism.

The "in-line" arrangement suggested in document D6 would only mean that the opener would be in a line of machines that preprocess mail to prepare it for remittance processing.

The appellant seemed to argue that the idea of automating the transfer of documents from extraction through to a remittance processing machine was so simplistic that it would be obvious to anyone of skill in the art. Such a simplistic analysis ignored the realities of document processing and the established practices for preparing documents for remittance processing.

Reasons for the Decision

1. *Main request, first auxiliary request*

According to claim 1 of the main request and the first auxiliary request, the apparatus comprises means for automatically conveying the extracted documents to input means of the remittance processing device in response to appropriate control signals (main request) and in response to appropriate signals (first auxiliary request), respectively.

This feature is disclosed in the application as filed only in connection with an apparatus wherein the means for extracting the documents are provided with a buffer mechanism including a buffer bin and a demand feed mechanism. The extracted documents are conveyed to and stacked in the buffer bin, from which they are then conveyed to the remittance processing device in response to appropriate control signals, cf. column 21, line 34 to column 23, line 33, in particular, column 22, lines 36 to 48 and column 23, lines 17 to 33 of the published version. Neither claim 1 of the main request nor claim 1 of the first auxiliary request, however, are directed to an apparatus comprising a buffer means or a demand feed mechanism.

In the Board's judgement, the feature of providing a buffer means and a demand feed mechanism is an essential feature for the correct functioning of the apparatus as claimed in claim 1 of the main request and the first auxiliary request. It allows intermediate

storing of the documents at the extraction station and thus gives the possibility of conveying the documents to the remittance processing device in response to appropriate signals associated with the remittance processing station. The transport of the documents can thus be carried out in accordance with the speed of the operator stationed at the remittance processing station as explained in column 23, lines 17 to 33 of the application as filed (published version). The application as filed does not disclose any alternative which allows the documents to be conveyed to the remittance processing device in response to appropriate control signals.

The Board notes that the passages (columns 22 and 23) referred to by the respondent as providing a support in the application as filed (published version) for the subject-matter of claim 1 of the main request and first auxiliary request concern the embodiment including a buffer means and a demand feed mechanism.

Accordingly, the subject-matter of claim 1 of the main request and the first auxiliary request is not supported by the application as filed. Consequently, these claims have been amended in such a way that they contain subject-matter which extends beyond the content of the application as filed (Article 123(2) EPC).

Therefore, the main request and the first auxiliary request are not allowable.

2. *Second auxiliary request*

2.1 Amendments

The subject-matter of claim 1 is disclosed in the printed version of the application as filed in claim 1, in connection with the passage in column 2, line 57 to column 3, line 13 of the description.

In the application as filed the expression "input means" is not used. However, it is directly and unambiguously derivable from the fact that the extracted documents are automatically conveyed to the remittance processing device that the latter must be provided with "input means".

In the Board's judgement, the amendments in claim 1 are in accordance with the requirements of Article 123(2) EPC.

Furthermore, the scope of protection conferred by independent claim 1 is more limited than that of the corresponding independent claim 1 of the patent in suit as granted.

Claim 1 of the second auxiliary request thus meets the requirements of Article 123(2) and (3) EPC.

2.2 Novelty/ inventive step

Document D6 concerns a document processing apparatus for processing documents contained within envelopes, wherein the apparatus comprises means for opening and

extracting the envelope contents of large volumes of incoming remittance mail.

The document makes mention of the relation between the extraction processing and the subsequent remittance processing, cf. page 3 "Breakthrough", first paragraph. It is suggested that the problem of "Extraction, once the fastest step, has become the bottleneck" can be solved by the Pitney Bowes, Model 1290 Opener/Extractor, which "can be used as a stand alone unit or in-line as part of a larger remittance processing system", cf. the sixth paragraph of page 3.

Whilst the drawings in document D6 show the apparatus as a stand alone unit, an apparatus intended for being used "in-line" is not explicitly shown. Furthermore, the term "in-line" is not further defined in the document. Thus, the term "in-line" may be open to more than one interpretation, and it is not unambiguously derivable from document D6 that the expression "in-line as part of a larger remittance processing system" has to be construed as meaning that in such a system the documents are automatically conveyed to the input means of a remittance processing device, and nothing else.

The subject-matter of claim 1, which specifies the means for conveying the extracted documents as means for **automatically** conveying them to the input means of the remittance processing device, is thus novel with regard to the prior art as disclosed in document D6.

However, document D6 refers on the one hand to the differences in time needed for opening and extracting documents from the envelopes and for reading, coding

and keying the documents, on the other, cf. page 3 (Headline "Breakthrough"), first paragraph, and suggests using the apparatus described therein "in-line" as part of larger remittance processing system. Thus, there is a clear indication of providing a document extraction apparatus in combination with a remittance processing device, which implies that the extracted documents have to be transported from the extraction apparatus to the remittance processing device.

Although it cannot be absolutely excluded that the term "in-line" may also indicate that the devices are only physically arranged in a line, the term "in-line", in general, is to be construed as meaning "constituting an integral part of a continuous sequence of operations or machines" (cf. The New Oxford Dictionary of English, Oxford University Press 1998).

In the Board's judgement, a person skilled in the art working in the technical field of large document processing systems inevitably takes into consideration the last mentioned meaning of the term "in-line", namely that the extraction apparatus forms an integral part of the remittance processing system. Consequently, for integrating such a device into the system, he has to consider providing transport means for conveying the documents from the extraction device to the input means of the remittance processing device.

Thus, the concept of automatically conveying the extracted documents to the remittance processing device is rendered obvious by the prior art. Accordingly, the subject-matter of claim 1 of the second auxiliary

request, which essentially differs from the prior art as disclosed in document D6 only in that respect, does not involve an inventive step within the meaning of Article 56 EPC.

Therefore, the second auxiliary request is also not allowable.

Since the subject-matter of claim 1 is not patentable with regard to the prior art as disclosed in document D6, a detailed examination of the question of whether or not the subject-matter of claim 1 is novel and involves an inventive step with regard to the remaining cited prior art can be dispensed with.

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:

R. Schumacher

W. Moser