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D E C I S I O N
of 15 January 2002

Case Number: T 0825/99 - 3.5.2

Application Number: 92309430.4

Publication Number: 0538043

IPC: B07C 1/00

Language of the proceedings: EN

Title of invention:

Apparatus for variable weight mail processing

Patentee:

PITNEY BOWES INC.

Opponent:

NEOPOST LTD
Soci t  SECAP

Headword:

-

Relevant legal provisions:

EPC Art. 100(b), 56

Keyword:

"Disclosure - sufficiency (yes)"

"Inventive step (yes)"

"Technical feature arising from business considerations not to be disregarded"

Decisions cited:

-

Catchword:

-



Case Number: T 0825/99 - 3.5.2

D E C I S I O N
of the Technical Board of Appeal 3.5.2
of 15 January 2002

Appellant:
(Opponent 01)

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Decision under appeal:

**Decision of the Opposition Division of the
European Patent Office posted 6 July 1999
rejecting the opposition filed against European
patent No. 0 538 043 pursuant to Article 102(2)
EPC.**

Composition of the Board:

Chairman: W. J. L. Wheeler

Members: M. Ruggiu
P. Mühlens

Summary of Facts and Submissions

- I. Both opponents appealed the decision of the opposition division rejecting the oppositions filed against European patent 0 538 043. Subsequently, opponent O2 withdrew its opposition and its appeal.
- II. The patent in suit as granted includes two claims which read as follows:

"1. A system for providing an easy, fast opportunity to the Post Office to determine the accuracy of postage paid for a batch of mail, comprising:

a mail processing unit (12) for assembling mail pieces and identifying assembled mail pieces in accordance with their zip codes,

a scale (14) located downstream from said mail processing unit (12) for weighing each mail piece,

a data processor (16) in communication with said mail processing unit (12) and said scale (14) for receiving zip code information from said mail processing unit and weight information from said scale, characterised by a traying station (18) for receiving mail pieces after they have been weighed by said scale, the traying station (18) being arranged to place mail pieces into trays, and a printer (22) in communication with said data processor (16) for printing a statement concerning the number and weight of the mail pieces in a tray at the traying station (18); wherein said traying station (18), under control of data received from the data processor (16) places a fixed weight batch of mail in

the tray."

"2. A system for providing an easy, fast opportunity to the Post Office to determine the accuracy of postage paid for a batch of mail, comprising:

a mail processing unit (12) for assembling mail pieces and identifying assembled mail pieces in accordance with their zip codes,

a scale (14) located downstream from said mail processing unit (12) for weighing each mail piece,

a data processor (16) in communication with said mail processing unit (12) and said scale (14) for receiving zip code information from said mail processing unit and weight information from said scale, characterised by a traying station (18) for receiving mail pieces after they have been weighed by said scale, the traying station (18) being arranged to place mail pieces into trays, and a printer (22) in communication with said data processor (16) for printing a statement concerning the number and weight of the mail pieces in a tray at the traying station (18); wherein the data processor (16) determines the thickness of the mail pieces based upon the weights thereof; under the control of the data processor (16) causes a fixed stack dimension of mail pieces to be placed in a tray; and wherein the weight of the resulting stack of mail in said tray is determined by the said data processor (16)."

III. The following prior art documents were referred to in the course of the appeal:

D2: GB-A-2 226 525;

D3: GB-A-2 208 021; and

D6: US-A-4 690 283.

IV. Oral proceedings were held on 15 January 2002.

The appellant (opponent O1) requested that the decision under appeal be set aside and the patent be revoked.

The respondent (patentee) requested that the appeal be dismissed and that the patent be maintained (main request) or, as an auxiliary request, that the patent be maintained in amended form on the basis of the auxiliary request filed by fax on 14 December 2001.

V. The appellant essentially argued as follows:

The patent did not disclose in a manner sufficiently clear and complete how to detect salting, i.e. the addition of mail pieces for which no postage had been paid, without referring to the weight printed in the statement, by mutually comparing the weights of the mail pieces or the dimensions of the stacks of mail pieces placed in different trays. In particular, since the mail pieces had different weights and thus different dimensions, it was not possible to systematically form batches of mail having a predetermined fixed weight or a predetermined fixed stack dimension which could be compared to that of another batch. Additionally, it would not be possible to detect replacement of a relatively heavy mail piece in a batch by a plurality of lighter mail pieces (for which more postage had to be paid) if the weight of the batch thereby remained unchanged.

Document D2 disclosed the closest prior art, describing a system with zip code sorting, a scale, a microprocessor and a printer for printing a statement relating to a batch of mail. Furthermore, a system like the one described in D2 normally included a traying station. The statement indicated the number and weight of the mail pieces in a batch of mail. Thus, D2 disclosed technical means suitable for printing the number and weight of the mail pieces in a tray and it was obvious to provide this information on a tray by tray basis if the post office so required. Moreover, if a complete batch was accommodated in a single tray, the statement would actually indicate the number and weight of the mail pieces in a tray. It was apparent that an indication of weight on a tray by tray basis would rationalise work at the post office. Such an indication was therefore obvious and it was not necessary to provide evidence for it. Furthermore, there was a general trend in the art to give a mailer a rebate when a task, e.g. pre-sorting of the mail, was shifted from the post office to the mailer. Requiring the mailer to provide a statement indicating the weight of each tray would be in line with that trend.

The appellant further submitted that the feature of providing the number and weight of the mail pieces in a single tray was based on commercial considerations and thus on a method of doing business. This feature, being a commonplace implementation of a method of doing business, could not contribute to the inventiveness of the claimed subject-matter. This appeared to be in line with the policy of the European Patent Office since, according to a notice published in the Official Journal (OJ 2001, 482-483), the European Patent Office did not search or examine commonplace implementations of

methods of doing business.

The only remaining feature of claim 1 was that the traying station placed a fixed weight batch of mail in a tray and the remaining feature of claim 2 was that the system comprised means to place a fixed stack dimension of mail pieces in a tray. Subdivision of a batch of mail into trays had nothing to do with the detection of salting. It was known that the mail pieces processed by the system had all to be accommodated in the trays and the purpose of placing a fixed weight or a fixed batch dimension of mail pieces in a tray was simply to avoid overfilling the tray.

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

In reply to the objection of insufficient disclosure, the respondent submitted that the purpose of the invention was to provide a quick and easy opportunity to detect salting. This could be achieved not only by comparing the weight of the mail pieces in a tray with the weight printed in the statement but also, since different trays contained a fixed weight or a fixed stack dimension of mail pieces, by mutually comparing the weights or stack dimensions of the mail pieces in the different trays. Thus, the word "fixed" in the claims was important. It might be that mutual comparison of the weights or stack dimensions would not always be effective to detect salting, but it nevertheless provided a quick and easy, although rather rough, way of achieving this purpose. Furthermore it would be possible to detect salting even where a heavier mail piece had been replaced by a plurality of lighter ones because the printed statement indicated

the number of mail pieces.

The system of D2 was intended for bulk mailing and thus handled batches or runs that required a plurality of trays to be accommodated. Furthermore, the statement of D2 referred to "TRAYS" and therefore to a plurality of trays. Thus, the system of D2 was not concerned with a single tray and the total weight indicated in the statement of D2 was always for a plurality of trays. Furthermore, D2 did not disclose the reason for printing the total weight in the statement. The invention defined in the patent differed in two key aspects from the system of D2: a fixed weight or a fixed stack dimension of mail pieces was placed in a tray and the statement included a printed indication of the weight of a single tray.

No evidence had been provided that, at the priority date of the patent, the post office required tray by tray information. Thus, the submissions based on this allegation had to be disregarded.

The objection that the invention was based on a business method had been raised late. Furthermore, the claims of the patent did not define a business method.

Reasons for the Decision

1. The appeal is admissible.

2. *Sufficiency of disclosure*

2.1 In this respect, the dispute relates in particular to

the feature of claim 2 that a fixed stack dimension of mail pieces be placed in a tray under control of the data processor. This feature implies that the dimension of a stack of mail pieces be estimated and the patent discloses how to achieve this at column 5, line 46 to column 6, line 1: where all the mail pieces are identical, the dimension of the stack is determined on the basis of the number of mail pieces; where the mail pieces are different, the dimension of the stack is deduced from the weights of the mail pieces. In the view of the board, with these indications, the dimension of a stack of mail pieces can be determined with a precision adequate to ensure that the stack of mail pieces can be placed in a tray. Thus, the patent provides sufficient information to enable the skilled person to carry out the disputed feature of claim 2.

2.2 Similarly, claim 1 requires that a fixed weight batch of mail be placed in a tray under control of data received from the data processor. In this respect, the patent explains at column 5, lines 42 to 45 that the data processor, which is in communication with the scale, can determine when a predetermined weight of mail pieces has been reached and cause that quantity of mail to be placed in a tray. In the view of the board, this information is sufficient to enable the skilled person to carry out the corresponding feature of claim 1.

2.3 The passage of the patent from column 3, line 55 to column 4, line 13 teaches to form batches not exceeding a predetermined weight limit and weighing close to the same amount, which is not inconsistent with placing a fixed weight batch of mail in a tray as specified in claim 1. This passage of the patent furthermore states

that if anyone were to add mail pieces to the batch for which postage had not been paid, subsequent inspection of the batch would reveal the same because of the discrepancy in weight. This does not concern the system itself which forms the batches, but rather the use of the weights of the batches to detect salting (apparently without need to refer to the printed statement as produced by the system of claim 1 or 2). In the view of the board, the uses that can be made of batches formed by the systems of claim 1 and 2 are irrelevant to the question of sufficient disclosure of the systems themselves, since the patent gives sufficient teaching to enable the skilled person to implement the systems of claims 1 and 2.

- 2.4 The board has therefore come to the conclusion that the patent discloses the subject-matter of the claims in a manner sufficiently clear and complete for it to be carried out by a skilled person. Therefore, the ground of opposition mentioned in Article 100(b) EPC does not prejudice the maintenance of the patent unamended.

3. *Inventive step*

- 3.1 Document D2 discloses a system for mailing large quantities of mail pieces, in which a printer is provided in communication with a data processor for printing a statement accompanying each batch of mail, which statement contains information relating to the mail and the amount of postage required. The batch of mail is pre-sorted and may include mail pieces of different weights which attract different postage fees. The statement is intended to facilitate inspection of the batch of mail by the post office and in particular

concerns the number of mail pieces in a batch, the total weight in the batch and the number of trays.

3.2 The system of D2 is intended for processing large quantities of mail pieces, which therefore will need more than one tray to be accommodated (note in particular the plural "TRAYS" in the statement shown in Figure 9 of D2). D2 does not disclose means for keeping track of the number and weight of the mail pieces placed in a particular tray. Thus, the system of D2 does not comprise means suitable for printing this number and this weight on the statement. Furthermore, D2 does not disclose any detail of the means which places the mail pieces in the trays.

3.3 Thus, the subject-matter of claim 1 of the patent in suit differs from the prior art disclosed in document D2 at least in that:

- (a) the printer in communication with the data processor is arranged for printing a statement concerning the number and weight of the mail pieces in a tray; and
- (b) a traying station under control of data received from the data processor places a fixed weight batch of mail in the tray.

The subject-matter of claim 2 of the patent in suit differs from the prior art disclosed in document D2 at least in that:

- (a) the printer in communication with the data processor is arranged for printing a statement concerning the number and weight of the mail

pieces in a tray; and

- (c) the data processor determines the thickness of the mail pieces based upon the weights thereof; under the control of the data processor causes a fixed stack dimension of mail pieces to be placed in a tray; and wherein the weight of the resulting stack of mail in said tray is determined by the said data processor.

Feature (a), which is common to both claims 1 and 2, provides the opportunity to detect a discrepancy, which could indicate salting, by checking that the weight reported in the statement corresponds to the actual weight of a tray.

3.4 Feature (a) implies that the system be arranged to determine the number and weight of the mail pieces in a tray and therefore constitutes a technical feature. In the view of the board, a technical feature of a claim should not be disregarded for the only reason that it arises from business considerations. Since no evidence is available that, at the relevant date, the post office required information concerning the number and weight of the mail pieces in a single tray, the board regards this as a purely hypothetical situation which cannot be given the value of a proven fact and, for this reason, the board does not take the arguments relying thereon into account in the examination of inventive step.

3.5 Document D3, like document D2, discloses a system for mailing large quantities of mail pieces, in which a printer is provided in communication with a data processor for printing a statement to be used by the

post office to determine the accuracy of postage paid for a batch of mail. However, D3 does not disclose any detail of the statement produced by the printer.

- 3.6 Document D6 discloses a system for sorting articles and distributing them into a plurality of receptacles. The system of D6 includes means for gauging the approximate volume of each article. A controller totalises the volumes of the parcels in each receptacle and, when a predetermined volume is reached for a particular receptacle, provide a "full" indication which signifies to an operator that the receptacle is to be replaced. However, the system of D6 does not determine the weight of the articles placed in a single receptacle.
- 3.7 It can be accepted that the post office is generally interested in obtaining information that facilitates detection of salting. However, the board has found no suggestion in documents D2, D3 and D6 to determine the number and weight of the mail pieces in a single tray. Furthermore, the documents do not contain any hint that the weight of a batch of mail pieces could be helpful to detect salting.
- 3.8 For these reasons, the board takes the view that feature (a), common to both claims 1 and 2, is not obvious to the person skilled in the art. Therefore, without having to consider feature (b) or (c) which do not modify feature (a), the board judges that the subject-matter of claims 1 and 2 can be considered as involving an inventive step in the sense of Article 56 EPC and that, therefore, the ground of opposition mentioned in Article 100(a) EPC does not prejudice the maintenance of the patent unamended.

4. Since the board is in a position to accept the main request of the respondent, there is no need to examine the auxiliary request.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:

M. Hörnell

W. J. L. Wheeler