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**Datasheet for the decision
of 29 November 2006**

Case Number: T 1323/04 - 3.5.02

Application Number: 95117959.7

Publication Number: 0712098

IPC: G07B 17/00

Language of the proceedings: EN

Title of invention:

Apparatus and method for detecting the position of an envelope
in a mailing machine

Patentee:

Pitney Bowes, Inc.

Opponent:

NEOPOST LTD

Headword:

-

Relevant legal provisions:

EPC Art. 56, 57, 123(2)

Keyword:

"Main request - reformatio in peius - (refused)"
"First auxiliary request - extension - (inadmissible
amendment)"
"Second auxiliary request - inventive step (yes)"
"Lack of industrial application - (no)"

Decisions cited:

G 0001/99, T 0284/94

Catchword:

-



Case Number: T 1323/04 - 3.5.02

D E C I S I O N
of the Technical Board of Appeal 3.5.02
of 29 November 2006

Appellant: NEOPOST LTD
(Opponent 01) South Street
Romford, Essex, RM1 2AR (GB)

Representative: Weinmiller, Jürgen
Spott, Weinmiller & Böhm
Patentanwälte
Lennéstraße 9
D-82340 Feldafing (DE)

Respondent: Pitney Bowes, Inc.
(Patent Proprietor) World Headquarters
One Elmcroft
Stamford, CT 06926-0700 (US)

Representative: Avery, Stephen John
Hoffman Eitle,
Patent- und Rechtsanwälte
Arabellastraße 4
D-81925 München (DE)

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

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

Decision under appeal: Interlocutory decision of the Opposition
Division of the European Patent Office posted
12 October 2004 concerning maintenance of
European patent No. 0712098 in amended form.

Composition of the Board:

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

Summary of Facts and Submissions

I. Opponent 01 appealed against the decision of the opposition division concerning the maintenance of European patent No. 0 712 098 in amended form in accordance with the proprietor's auxiliary request filed on 8 June 2004 during oral proceedings before the opposition division.

II. Prior art documents:

D1: EP-A-0 558 329, and

D4: GB-A-2 272 401,

considered during the proceedings before the opposition division remain relevant to the present appeal.

III. With a letter dated 26 October 2006, the proprietor requested that the patent be maintained as granted (main request) and filed claims in respect of three auxiliary requests.

IV. Oral proceedings were held on 29 November 2006 in the course of which the proprietor filed a new second auxiliary request (based on the claims of the previous third auxiliary request).

V. Claim 1 of the patent in suit as granted (main request) reads as follows:

"A mailing machine for printing an image on an envelope fed in a feed path, the mailing machine comprising:

means (28) for printing the image on the envelope (E),

means (50) for feeding the envelope along the feed path,

first sensing means (72) located a predetermined distance upstream in the feed path from the printing means for detecting the presence of the envelope,

control means (84, 86, 94) in communication with the printing means (28) and the first sensing means (72),

the control means being arranged for:

initiating a printing operation to print the image on the envelope (E),

monitoring an amount of the image remaining to be printed by the print means (28) during an active printing operation, and

terminating printing by the printing means (28) before completion of the printing operation if, at the time when the first sensing means detects (72) the trailing edge of the envelope (E), the amount of the image remaining to be printed will not fit on the length of the envelope between the printing means (28) and the first sensing means (72)."

Claim 1 of the first auxiliary request is identical to claim 1 of the main request except that the feature "initiating a printing operation to print the image on the envelope (E)" is replaced by "initiating a printing operation, thereby commencing to print the image on the envelope (E)".

Claim 1 of the second auxiliary request is identical to claim 1 of the first auxiliary request except that "means (28) for printing the image on the envelope (E)" is replaced by "thermal printing means (28) for printing the image on the envelope (E)".

Claim 7 of the second auxiliary request reads as follows:

"A method of controlling thermal print means for printing an image of an envelope fed in a feed path through a mailing machine, the mailing machine including first sensing means located a predetermined distance upstream in the feed path from the printing means for detecting the presence of the envelope, the method comprising the steps of:

- a. initiating a printing operation, thereby commencing to print the image of the envelope,
- b. monitoring an amount of the image remaining to be printed by the print means during an active printing operation, and
- c. terminating printing by the print means before completion of the printing operation if, at the time when the first sensing means detects the trailing edge of the envelope, the amount of the image remaining to be printed will not fit on the length of the envelope between the printing means and the first sensing means."

Claim 13 of the second auxiliary request reads as follows:

"A printing arrangement for a mailing machine, said printing arrangement being for printing an image on an envelope fed in a feed path and comprising:
thermal printing means (28) for printing the image on the envelope (E),
means (50) for feeding the envelope along the feed path,
first sensing means (72) located a predetermined distance upstream in the feed path from the printing means for detecting the presence of the envelope,
control means (84, 86, 94) in communication with the printing means (28) and the first sensing means (72), the control means being arranged for:
initiating a printing operation, thereby commencing to print the image on the envelope (E),
monitoring an amount of the image remaining to be printed by the print means (28) during an active printing operation, and
terminating printing by the printing means (28) before completion of the printing operation if, at the time when the first sensing means detects (72) the trailing edge of the envelope (E), the amount of the image remaining to be printed will not fit on the length of the envelope between the printing means (28) and the first sensing means (72)."

Claims 2 to 6 and 8 to 12 of the second auxiliary request are respectively dependent on claim 1 and claim 7.

VI. The arguments of the appellant opponent 01 can be summarized as follows:

The objection under Article 57 EPC was not late-filed because it had been raised at the earliest opportunity

after the auxiliary request had been filed during the oral proceedings before the opposition division. The mailing machine according to the second auxiliary request would not complete printing of the postage information image if the envelope was too short, although the postage would still have to be paid. Since the Post Office required a full and readable impression of the official part of the postage indicia, the mailing machine of the invention could not be sold and thus was not susceptible of industrial application as required by Article 57 EPC.

The mailing machine disclosed in document D1 did not comprise thermal printing means. But it would have been obvious for the skilled person to replace the drum printer of the prior art mailing machine by thermal printing means which could allow printing of an image to be terminated before completion of a printing operation. The mailing machine of claim 1 of the second auxiliary request did not involve an inventive step also because it did not satisfy the requirements of the Post Office.

VII. The arguments of the non-appealing opponent 02 can be summarized as follows:

Claim 1 of the main request covered a mailing machine in which printing of postage information was prevented if the envelope was too short for the postage image to be printed, as specified in paragraphs [0013] and [0025] of the patent in suit. Claim 1 of the main request, whose scope thus extended beyond that of claim 1 maintained in the opposition proceedings, was not admissible because it worsened the sole appellant's situation.

The mailing machine according to claim 1 of the first auxiliary request did not comprise a thermal printer. However, all the examples of the mailing machine described in the patent in suit which could terminate printing after inking the envelope had commenced comprised a thermal printer. According to the patent specification, such a mailing machine needed a thermal printer. Claim 1 of the first auxiliary request did not provide a complete solution to the technical problem recognisable from the application, and, following decision T 284/94 (OJ 1999, 464), contravened Article 123(2) EPC.

The mailing machine according to the second auxiliary request did not involve an inventive step. This machine differed from the mailing machine disclosed in D1 only in that it comprised thermal printing means controlled in such a manner that the printing of an image could be terminated before completion of the printing operation, if the envelope was too short. The mailing machine disclosed in D1 comprised means for detecting if an envelope was too short for the postage image to be printed, and it was obvious for the skilled person to replace the drum printer of D1 by a thermal printer controlled to terminate the printing of the image before its completion, if desired. The mailing machine of claim 1 lacked an inventive step having regard to the combination of D1 with document D4, which disclosed an apparatus comprising an ink jet printer for printing a message across a region of an envelope which might extend to the full length of the envelope.

VIII. The arguments of the respondent proprietor can be summarized as follows:

Claim 1 of the main request had the same effective scope as claim 1 maintained by the opposition division. The terms "printing operation" and "printing" in the claims had the same meaning and clearly meant "applying ink on an envelope", which followed from the use of the term "printing" in claim 4 and in the description, column 13, line 57, column 14, line 57 and column 16, line 41, of the patent in suit. It was clear from paragraphs [0039] and [0040] of the patent that "initiating a printing operation" included "commencing to print", i.e. an action of applying ink on an envelope. The wording of claim 1 of the main request specified that printing could be terminated before completion of the printing operation, which implied that printing had commenced. The mailing machine of claim 1 did not simply prevent any printing if an envelope was too short or skewed. Claim 1 of the main request would not have put the sole appellant in a situation worse than if it had not appealed and was admissible.

Neither claim 1 of the first auxiliary request, which had the same wording as claim 1 maintained by the opposition division, nor granted claim 1, could be open to an objection under Article 123(2) and (3) EPC. Claim 1 of the first auxiliary request did not include subject-matter extending beyond the content of the originally filed application or extend the scope of protection, because the application as filed was not limited to a mailing machine having thermal printing means. The originally filed application disclosed a mailing machine comprising any printer which could be

stopped, after printing had commenced, for instance an inkjet printer.

The mailing machine according to claim 1 of the second auxiliary request differed from the prior art mailing machine disclosed in D1 by thermal printing means and by the last two features of the claim, i.e. monitoring an amount of the remaining image to be printed and, if necessary, terminating printing before completion of the printing operation. It might have been possible to use a thermal printer in the prior art mailing machine of D1, but this machine, which simply printed all the image or nothing, did not suggest commencing to print an image and terminating the printing before its completion if the envelope was too short. The claimed mailing machine secured advantages over the known prior art because undesired printing on any component of the machine was avoided, and, in most practical situations, a part of the postage indicia sufficient to meet the Post Office requirements would however be printed. Document D4 was an old document which used an inkjet printer simply to print a message across a given region of an envelope and did not show how to terminate printing of an image before its completion.

The objection of lack of industrial application raised for the first time in the opposition oral proceedings was late-filed and inadmissible. The mailing machine according to the patent in suit did not fail to meet the minimum standard of the Post Office and could be sold. The invention secured an advantage over the prior art because printing a sufficient proportion of the postage indicia enabled the Post Office to determine key data, even on a too short envelope.

- IX. The appellant (opponent 01) requested that the decision under appeal be set aside and that the patent be revoked. Opponent 02 supported this request.
- X. The respondent (patentee) requested that the patent be maintained as granted (main request) or on the basis of claims 1 to 13 of the first auxiliary request filed with letter dated 26 October 2006 or on the basis of claims 1 to 13 of the second auxiliary request filed in the oral proceedings.

Reasons for the Decision

1. The appeal is admissible.

Inadmissibility of the main request

2. The Board does not share the proprietor's view according to which the scope of claim 1 of the main request (which is identical to claim 1 as granted) and that of claim 1 as maintained by the opposition division are identical, and judges that claim 1 of the main request is broader in scope than claim 1 maintained in the opposition proceedings.
- 2.1 The terms "printing operation" and "printing" in these claims cannot be construed to have the same meaning simply because the action of printing by the printing means can be terminated before completion of the printing operation. In the context of the patent in suit as a whole and with due regard to the meaning of the word "operation", "printing operation" has to be

understood as identifying collectively the various actions to be performed by the printing means (26) for setting an image on an envelope. More specifically, according to the description (for instance column 13, lines 32 to 58), the printing operation, initiated when both sensors (70, 72) detect an envelope, comprises the first steps of energizing the crank and drive motors to rock the frame (54) and command rotation of the feed roller (52), raising the stop element (82) of the printing means and sending "a signal to the printer controller 94 which **in turn** actuates the print head 28 to commence **printing**" (emphasis added by the Board). Thus, the **initiation** of the printing operation in claim 1 of the main request precedes the step of "commencing to print the image", although the printing operation would normally include such a step. The term "printing" means "depositing ink on an envelope".

- 2.2 According to the description (column 11, lines 11 to 21, the control means "is operable to initiate a printing operation... and is operable to terminate a printing operation... in the event that a short envelope... on which there is insufficient space to accept the **full length** of the postage information image" (emphasis added by the Board). According to column 14, lines 7 to 19, "after initiation of the printing operation, several things occur simultaneously", in particular the CPU monitors the first sensor means (72), before the print head is caused to print a column and the counters (108) and (110) are decreased. The printing operation could then be terminated at **an appropriate time**, depending on whether or not the **full postage information image** to be printed does not fit on the length of the envelope between the printing means and the first sensing means,

as explained in column 6, lines 48 to 58 of the patent specification. Under these circumstances, the phrase "monitoring an amount of the image remaining to be printed by the print means (28) during an active printing operation" in claim 1 of the main request has to be given a meaning so broad as to cover a monitoring of the length of the full image to be printed during a subsequent printing by the print head, i.e. performed before the print of the first column of a postage image has commenced. Accordingly, claim 1 of the main request covers an action of "monitoring an amount of the image remaining to be printed" which is performed after the initiation of the printing operation and before commencing to print an image on the envelope.

2.3 Claim 1 in the version maintained by the opposition division differs from claim 1 of the present main request in that it comprises the additional expression "thereby commencing". This added expression restricts the scope of the claim to control means which are arranged for commencing to print an image on the envelope as a consequence of the initiation of the printing operation before "monitoring the amount of the image remaining to be printed". Accordingly, the scope of claim 1 according to the present main request is broader than the scope of claim 1 maintained by the opposition division.

3. Claim 1 according to the main request, since it was filed during the appeal proceedings and has a scope broader than the scope of claim 1 maintained by the opposition division, would put the sole appellant (opponent 01) in a worse situation than if it had not appealed. Following the decision of the Enlarged Board

of Appeal G 1/99, OJ 2001, 381, the main request of the respondent proprietor must be refused.

First auxiliary request - Inadmissibility of the amendment

4. Claim 1 of the first auxiliary request (which is identical to claim 1 maintained by the opposition division) differs from claim 1 as granted by the additional terms "thereby commencing" (see *supra* paragraph 2.3) and thus relates to a mailing machine as granted in which, in addition, the control means are restricted to commencing to print an image before "monitoring of an amount of the image remaining to be printed". Claim 1 of the first auxiliary request contravenes Article 123(2) EPC and the first auxiliary request is not admissible.
- 4.1 It is not disputed that the application as originally filed (published application, figures 3, 4 and 7; column 12, line 57 to column 13, line 54) discloses a mailing machine which may be caused to print a first column of the image after the initiation of a printing operation and before monitoring of the remaining image to be printed. However, according to the application as filed, in its broadest aspects, the invention relates to a mailing machine which includes, and a method which uses, a thermal printing device (published application, column 4, lines 18 to 37; column 5, lines 51 to 56). The mailing machine incorporating the principles of the invention as shown in figures 1 to 5 and all the embodiments of realisation exemplified in the originally filed description include a thermal printing device (26). The principal object of the invention is to provide a mailing machine whose postage meter includes a thermal

printing device and another object of the invention is to prevent that the feed roller of the thermal printing device of a mailing machine is exposed to the ink ribbon (column 6, line 48 to column 7, line 2). Accordingly, thermal printing means are presented as an essential feature of the invention in the originally filed application, which does not provide any support for the mailing machine as recited in claim 1 of the first auxiliary request, whose printing means are not restricted to a thermal printing device.

- 4.2 Nor can the mailing machine of claim 1, which covers a drum printer whose drum could not be stopped after printing has started, meet the conditions specified in the last paragraph of the claim and provide a complete solution to the problem recognisable from the patent application (see T 284/94, OJ 1999, 464). Claim 1 of the first auxiliary request thus relates to a mailing machine which is an unsupported generalisation of the originally disclosed mailing machine and contravenes Article 123(2) CBE.

Admissibility of the second auxiliary request

5. The Board is satisfied that the amendments made to the claims and the description according to the second auxiliary request satisfy the requirements of Article 84 EPC and do not contravene Article 123(2) and (3) EPC. More specifically:

- 5.1 Claim 1 of the second auxiliary request is based on claim 1 as granted with the added restriction to thermal printing means and control means which are arranged for "initiating a printing operation, thereby commencing to

print the image on the envelope". Such a mailing machine is disclosed in the application as originally filed (see *supra* paragraphs 4.1 and 4.2). Corresponding considerations apply to the method of controlling thermal print means according to claim 7 and the printing arrangement for a mailing machine according to claim 13.

- 5.2 The amendments made to the independent claims limit the scope of protection conferred and are such that the reasons given above for refusing the main request and first auxiliary request no longer apply. In accordance with the above cited decision of the Enlarged Board of Appeal G 1/99, such amendments are allowable.
- 5.3 The amendments made to the description remove inconsistencies and bring the description into conformity with the amended claims.
6. The novelty of the subject-matter of independent claims 1, 7 and 13 of the second auxiliary request is not in dispute.

Second auxiliary request - Inventive step

7. Document D1, which relates to a mailing machine for printing an image on an envelope fed in a feed path, forms the undisputed closest prior art. The mailing machine disclosed in D1 comprises the following features of claim 1 of the second auxiliary request:

- means for printing the image on an envelope (figure 1; column 8, lines 13 to 18; printing drum 64; postage data, registration data or other selected indicia),

- means for feeding the envelope along the feed path (40),
 - first sensing means (99A) located a predetermined distance upstream in the feed path from the printing means for detecting the presence of the envelope (column 10, lines 35 to 42),
 - control means (microprocessor 122) in communication with the printing means and the first sensing means and arranged for:
 - initiating a printing operation, thereby commencing, to print the image on the envelope (figures 6A and 6B, 302 to 350; column 17, lines 6 to 37; column 19, line 37 to column 20, line 53),
 - monitoring an amount of the image remaining to be printed by the printing means during an active printing operation (column 22, line 50 to column 23, line 47).
8. However, the mailing machine disclosed in D1 has a printing device with a printing drum, and the printing operation is terminated before any actual printing by the printing means, if at the time the first sensing means detects the trailing edge of the envelope, the length of the envelope is detected to be less than a given value (figure 19; column 46, line 35 to column 37, line 43). The printing means of D1 thus prints the whole image or nothing. The length of the envelope between the printing means and the first sensing means is not determined in D1. Nor is the amount of the image remaining to be printed monitored for verifying, if, at

the time when the first sensing means detects the trailing edge of the envelope, the amount of image remaining to be printed will fit, or not, on the length of the envelope between the printing means and the first sensing means.

9. Accordingly, D1 does not disclose a mailing machine which comprises the following features: thermal printing means and control means arranged for terminating printing by the printing means before completion of the printing operation, if the condition set out in claim 1, relating to the amount of the image remaining to be printed after commencing printing, is met. The mailing machine of claim 1 of the second auxiliary request differs from the mailing machine disclosed in D1 by these two features.
10. Starting from D1 and having regard to the effects provided by the claimed invention, the objective technical problem could be seen as providing a mailing machine which would prevent undesired printing on any components of the mailing machine caused if the printing operation could continue after the trailing edge of the envelope has moved clear of the printing means. This is in accordance with paragraphs [0013] and [0024] of the published patent specification.
11. In the judgement of the Board, the opponents have not proved that the subject-matter of claim 1 of the second auxiliary request does not involve an inventive step having regard to the prior art documents on file, and particularly to documents D1 and D4.

- 11.1 The problem addressed by the invention would not be solved by simply replacing the drum printer of D1 by thermal printing means, unless appropriate changes were made to the control system, because there would still be no printing at all if the image to be printed were too long to fit on the envelope.
- 11.2 Arranging the control means according to the claimed solution to verify that the condition set in claim 1 is met implies monitoring the amount of the image remaining to be printed by thermal printing means after printing has commenced, and, at the time the trailing edge of the envelope is detected by the first sensing means, comparing the amount remaining with the length of the envelope between the printing means and the first sensing means. None of this is either disclosed, or suggested in D1.
- 11.3 Document D4 is an old document which does not disclose a mailing machine, but concerns the cancellation of stamps and printing of pre-programmable messages on an envelope. The apparatus described in D4 comprises an inkjet printer simply to print the messages across a given region of an envelope which may extend to its full length. However, D4 neither discloses a monitoring of the amount of an image remaining to be printed, nor explains how to terminate printing of the image before its completion. A combination of the teachings of D1 and D4 would not result in the claimed mailing machine.
12. As may see from the foregoing, the subject-matter of claim 1 of the second auxiliary request is not obvious having regard to the prior art on file. The same considerations apply *mutatis mutandis* to the method of

controlling thermal print means according to claim 7 and the printing arrangement for a mailing machine according to claim 13.

Industrial application

13. Opponent 01 objected for the first time during the oral proceedings before the opposition division that the invention according to the then main and auxiliary requests lacked industrial application under Article 57 EPC because its subject-matter did not meet the requirements of the Post Office. The objection raised under Article 57 EPC against said auxiliary request, which was filed in said oral proceedings and limited to an amended mailing machine that no longer could print a whole postage indicia or nothing, was admissible because the alleged lack of industrial application resulted from the amendment. The objection under Article 57 EPC raised against the present second auxiliary request, which further restricts the patent as maintained (*supra* paragraph 5.1), is admissible for the same reason. The second auxiliary request however does not contravene Article 57 EPC.

13.1 The presently claimed machine, in which printing by thermal printing means can be terminated, after having commenced, before completion of the printing operation, can be manufactured and thus is susceptible industrial application. Whether or not it could be sold is an aspect of commercial success, not of industrial applicability.

14. Corresponding considerations apply to the method of controlling thermal print means according to claim 7 and the printing arrangement for a mailing machine according to claim 13.

15. The Board concludes that the appellant has not shown that the subject-matter of the claims according to the second auxiliary request does not involve an inventive step within the meaning of Article 56 EPC and that the requirement of industrial application according to Article 57 EPC is not met. The grounds for opposition mentioned in Article 100 EPC do not prejudice the maintenance of the patent in the presently amended form.

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 in amended form in the following version:

claims: 1 to 13 of the second auxiliary request filed in the oral proceedings;

description: pages 2, 5 and 10 filed in the oral proceedings; pages 3, 4, 6 to 9 of the version approved by the opposition division;
and

drawings: figures 1 to 15 of the patent specification.

The Registrar:

The Chairman:

U. Bultmann

W. J. L. Wheeler