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**Datasheet for the decision
of 9 October 2008**

Case Number: T 0429/06 - 3.5.02
Application Number: 95119106.3
Publication Number: 0716397
IPC: G07B 17/02
Language of the proceedings: EN

Title of invention:

A system for recording the initialization and re-initialization of an electronic postage meter

Applicant:

Pitney Bowes, Inc.

Opponent:

Francotyp-Postalia GmbH

Headword:

-

Relevant legal provisions:

EPC Art. 123(2)

Relevant legal provisions (EPC 1973):

-

Keyword:

"Added subject-matter (yes)"

Decisions cited:

-

Catchword:

-



Case Number: T 0429/06 - 3.5.02

DECISION
of the Technical Board of Appeal 3.5.02
of 9 October 2008

Appellant: Francotyp-Postalia GmbH
(Opponent) Triftweg 21-26
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Respondent: Pitney Bowes, Inc.
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Representative: Avery, Stephen John
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Decision under appeal: Interlocutory decision of the Opposition
Division of the European Patent Office posted
27 December 2005 concerning maintenance of
European patent No. 0716397 in amended form.

Composition of the Board:

Chairman: M. Ruggiu
Members: M. Rognoni
H. Preglau

Summary of Facts and Submissions

- I. The opponent appealed against the interlocutory decision of the opposition division concerning the maintenance of European patent No. 0 716 397 in amended form.
- II. In the decision under appeal, the opposition division held, *inter alia*, that claims 1 and 3 of the patent as granted did not violate Article 123(2) EPC.
- III. Oral proceedings were held before the Board on 9 October 2008.
- IV. The appellant (opponent) requested that the decision under appeal be set aside and that the patent be revoked.

The respondent (patent proprietor) requested that the appeal be dismissed.

- V. Claim 1 of the patent as granted and maintained by the opposition division reads as follows:

"An electronic meter for accounting for funding and transaction information having:

a micro control system (11) for controlling the operation of said meter in response to an operation program,
said micro control system having a microprocessor (15) in bus communication with a plurality of addressable memory units (17, 19, 21, 23) and

first input means (26) in bus communication with said microprocessor, said meter having a first mode of operation for performing transactions and accounting for said transactions by generating accounting information and storing said accounting information in said memory units and a second mode of operation for accessing said accounting information in response to a first security code, and said electronic meter comprising:

a first one of said memory units (21, 23) having a plurality of accounting registers for storing said accounting information when the meter is in said second mode of operation to provide a historical record of desired accounting information in predetermined categories, said meter having a third mode of operation for accessing said registers of said first memory unit and initializing said registers in response to input of a second security code, said accounting information including a REINIT table (38) for creating a selected number of records representative of said accounting information of said accounting register in said respective categories upon each initialization of said accounting registers, said operation program having means for preventing said record from being overwritten once said respective record has

been created and said meter is in said first, second or third mode."

Independent claim 3 differs from claim 1 in that it is directed to an electronic meter comprising "a plurality of said first memory units (21, 23), each of said first memory units having a plurality of accounting registers" and "said accounting registers are redundantly maintained in said respective first memory units".

Claim 2 is dependent on claim 1 and claims 4 to 7 are dependent on any preceding claim.

VI. The arguments of the appellant relevant to the present decision can be summarized as follows:

Claim 1 of the application as originally filed recited that the meter of the invention comprised accounting registers for storing accounting information to provide a historical record of desired frequency of desired accounting information in predetermined categories. In claim 1 of the patent as granted, however, the provision of a historical record was subjected to the condition that the meter was in the second mode of operation, *i.e.* it was recharged. As the original application documents did not disclose a postage meter which provided a historical record when it was in the second mode of operation, the subject-matter of claim 1 extended beyond the content of the application as originally filed (Article 123(2) EPC).

VII. The arguments of the respondent relevant to the present decision can be summarized as follows

Claim 1 of the application as filed specified that the meter of the invention comprised accounting registers for storing accounting information to provide a historical record but did not mention when such record was provided. It was, however, evident to the skilled person that the storing of accounting information referred to in the claim occurred in the standard modes of operation, *i.e.* when postage was dispensed (first mode of operation) and when postage funds were added (second mode of operation). As generally known in the art, the accounting information customarily stored in secure non-volatile memories was the ascending register, which was incremented by each transaction and thus provided a historical record of all postage dispensed by the postage meter since it was placed in service, the descending registers, which accounted for postage funds available for posting, and the piece count register. Hence, the reference to the second mode of operation in the claim of the contested patent merely clarified that the record of accounting information was provided in the normal course of operation of the meter.

The claimed meter further comprised a REINIT table in the secure memory for creating a limited number of permanent records of the accounting registers upon each initialisation of the meter. When the wording of claim 1 of the patent was properly interpreted in the light of the original disclosure, there could be no doubt that the memory defined as REINIT table contained accounting information representing a "snapshot" of the

registers prior to the meter's initialization and that these "snapshots" were not the same as the "historical record of desired accounting information" referred to in connection with meter's normal operation.

As the electronic meter according to claim 1 of the patent did not contain any features extending beyond what the originally filed application documents disclosed to the skilled person, it complied with Article 123(2) EPC.

Reasons for the Decision

1. The appeal is admissible.

- 2.1 The essential question to be addressed in the present case is whether the application as originally filed discloses an electronic meter comprising, *inter alia*, the following feature recited in claim 1 of the patent:
 - (a) *"a first one of said memory units (21,23) having a plurality of accounting registers for storing said accounting information when the meter is in said second mode of operation to provide a historical record of desired accounting information in predetermined categories" (emphasis added).*

- 2.2 The first part of claim 1, which is common both to the application as originally filed and to the contested patent, specifies that the meter of the invention comprises *"a plurality of addressable memory units (17, 19, 21, 23)"* and has *"a first mode of operation for performing transactions and accounting for said*

transactions by generating accounting information" (emphasis added). The accounting information generated by a transaction is stored in the secure memories 21 and 23, in particular in the ascending register 30, which provides a record of all postage dispensed by the meter, in the descending register 32, which accounts for the postage funds available for posting, and in the piece count register 34 (see Figure 2).

It is furthermore recited in the first part of the claim that the meter has "a second mode of operation for accessing said accounting information in response to a first security code" (emphasis added). As acknowledged by the respondent, the second mode of operation relates to the accessing of the descending register when postage funds are added by the user.

2.3 The second part of claim 1 according to the application as originally filed does not contain any reference to the second mode of operation, but specifies that "*a first one of said memory units (21, 23)*" has "*a plurality of accounting registers for storing said accounting information to provide a historical record of desired frequency of desired accounting information in predetermined categories*".

2.4 According to the respondent, feature (a) was concerned with the updating of the meter's ascending, descending and piece count registers which was performed in the course of the meter's normal operation, *i.e.* when postage was dispensed ("*first mode of operation*") and new postage funds added ("*second mode of operation*"). The skilled person understood that qualifying the information stored in such registers as "*historical*

record" simply related to the fact that some registers, such as the ascending register and the piece count register, stored records indicative of all postage dispensed by the meter (see published application, column 1, lines 14 to 25). In other words, the "*historical record*" referred to in feature (a) was different from the records stored in the REINIT table which constituted a permanent snapshot of the registers' contents and were only created when the meter was initialised.

2.5 The Board agrees with the respondent that the information stored in the ascending register and in the piece count register can be defined as "*historical*" in the sense that it provides a record of the total postage dispensed by the meter and of the total number of postage operations. These records are updated in the first mode of operation. The second mode of operation, however, allows access only to the descending register which holds a record of the funds available for postage. As this record is not related to the total number of transactions or the total amount of postage dispensed, it cannot provide any information concerning the "history" of the electronic meter.

2.6 It is further recited in the second part of claim 1 of the patent that:

(b) the meter has "*a third mode of operation for accessing said registers of said first memory unit and initializing said registers in response to input of a second security code*" (emphasis added),

- (c) the accounting information includes "a *REINIT* table (38) for creating a selected number of records representative of said accounting information of said accounting register in said respective categories upon each initialization of said accounting registers",
- (d) the meter's operation program has "means for preventing said record from being overwritten once said respective record has been created and said meter is in said first, second or third mode".

2.7 The skilled person reading claim 1 of the patent and in particular features (a) to (d) understands that the electronic meter of the invention comprises the following functionalities:

- it provides a "historical record of desired accounting information in predetermined categories" when it is in the "second mode of operation";
- it creates, in a third mode of operation, "a selected number of records representative of said accounting information upon each initialization of said accounting registers", whereby such records are stored in a REINIT table;
- it prevents "said record", i.e. the record provided in the second mode of operation or created in the third mode of operation, "from being overwritten once said respective record has been created and said meter is in said first, second or third mode."

2.8 The application as originally filed discloses an electronic meter which provides a permanent record of accounting information only when it is initialized, *i.e.* in the "*third mode of operation*". Although the teaching of the application does not exclude the possibility that a permanent record of selected accounting information may also be provided when the meter is recharged ("*second mode of operation*"), the original disclosure does not suggest storing further permanent records of the accounting information in the secure memory of the electronic meter during the meter's normal operation.

2.9 As claim 1 of the patent comprises subject-matter which extends beyond the content of the application as originally filed, it violates Article 123(2) EPC.

3. Under these circumstances, the Board comes to the conclusion that the patent as maintained in opposition has to be revoked.

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:

U. Bultmann

M. Ruggiu