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**Datasheet for the decision  
of 6 February 2017**

**Case Number:** T 1636/12 - 3.5.02

**Application Number:** 05020921.2

**Publication Number:** 1640076

**IPC:** B07C3/00

**Language of the proceedings:** EN

**Title of invention:**

Method and system of providing services at a mail delivery point

**Applicant:**

Pitney Bowes Inc.

**Relevant legal provisions:**

EPC Art. 111(1), 123(2)

EPC R. 137(5)

**Keyword:**

Appeal decision - remittal to the department of first instance  
(yes, after amendment)

Amendments - allowable (yes)



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Case Number: T 1636/12 - 3.5.02

**D E C I S I O N**  
**of Technical Board of Appeal 3.5.02**  
**of 6 February 2017**

**Appellant:** Pitney Bowes Inc.  
(Applicant) One Elmcroft Road  
Stamford, CT 06926-0700 (US)

**Representative:** Hoffmann Eitle  
Patent- und Rechtsanwälte PartmbB  
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**Decision under appeal:** **Decision of the Examining Division of the  
European Patent Office posted on 24 May 2012  
refusing European patent application No.  
05020921.2 pursuant to Article 97(2) EPC.**

**Composition of the Board:**

**Chairman** R. Lord  
**Members:** H. Bronold  
W. Ungler

## **Summary of Facts and Submissions**

- I. The appeal lies against the decision of the examining division to refuse the European patent application on the grounds that it contained amendments which were inadmissible under Article 123(2) EPC and Rule 137(5) EPC.
- II. The appellant requested that the decision under appeal be set aside and that a patent be granted on the basis of the claims of their main request, or on the basis of the claims of their first or second auxiliary requests, all filed together with the statement setting out the grounds of appeal.
- III. In a communication under Article 15(1) RPBA the Board informed the appellant that it had doubts as to whether the main request or the first and second auxiliary requests met the requirements of Rule 137(5) EPC, since not all features of the invention first mentioned in the claims, i.e. originally filed claims 1 to 3, were included in the subject-matter claimed in these requests.
- IV. With letter dated 13 December 2016, the appellant filed a new main request including the features of originally filed claims 1 to 3. The appellant further suggested that the oral proceedings be avoided if the Board agreed that the new main request overcame the objections raised in its communication.
- V. The Board informed the appellant informally that the Board considers the objections raised in the communication under Article 15(1) RPBA to be overcome and that the oral proceedings could be cancelled if the

appellant explicitly requested a remittal to the department of first instance.

VI. With letter dated 23 January 2017 the appellant requested that the oral proceedings scheduled for 14 February 2017 be cancelled and that the case be remitted to the examining division in the event that all objections of the Board had been overcome.

VII. Independent claim 1 of the main request reads:

"A method of providing services for a mail delivery point (106; 206), comprising:  
acquiring (505) a delivery point identifier from a tag (105) located at the mail delivery point, wherein the delivery point identifier of the tag is machine-readable;  
accessing (510) delivery point data corresponding to the delivery point identifier, said delivery point data being accessed from the tag and/or from an Internet site; and  
providing (515) at least one service that is at least partly in response to the delivery point data, wherein the delivery point data is at least partly modifiable (525) by a recipient who is able to receive physical mail at the delivery point, and wherein a portion of the delivery point data is modifiable (525) by the recipient via said Internet site."

VIII. Independent claim 17 of the main request relates to a system corresponding to the method of claim 1.

IX. Claims 2 to 16 are dependent on claim 1 and claims 18 and 19 are dependent on claim 17.

## Reasons for the Decision

### 1. Amendments - Article 123(2) EPC

- 1.1 Compared to originally filed claim 1, the following features were introduced in independent claim 1 of the main request in addition to the features of originally filed dependent claims 2 and 3:

F1: the term "device" was amended to "tag (105) located at the mail delivery point, wherein the delivery point identifier of the tag is machine-readable", and

F2: "said delivery point data being accessed from the tag and/or from an Internet site" was introduced.

Corresponding amendments were carried out with respect to independent system claim 17.

- 1.2 Features very similar to features F1 and F2 according to the main request also formed part of the main request on which the decision of the examining division was based. The examining division came to the conclusion that these features were taken out of context and therefore contravened Article 123(2) EPC. The board however does not agree with this finding of the examining division.

- 1.3 Paragraph [0019] of the originally filed description dealing with feature F1 starts on page 4, line 32 with a disclosure of examples of a delivery point identifier (DPI) tag as being a bar code, a character string, or a RFID tag. Paragraph [0019] then continues on page 5, lines 1 and 2 that "The tag can include the DPI in a

format that can be perceived only by machines and/or in a format that humans can perceive". This disclosure in the first part of paragraph [0019] is concerned with the format of the delivery point identifier and discloses three alternatives. The delivery point identifier can thus be in a format that can be perceived "only by machines", "by humans" or both. According to the disclosure, the details of the format of the delivery point identifier are neither functionally or structurally linked to the fixing or location of the tag at the delivery point nor to the accessing of delivery point data by a delivery person using the delivery point information. The Board therefore concludes that feature F1 is directly and unambiguously derivable from paragraph [0019] of the originally filed description.

- 1.4 Regarding feature F2, page 3, paragraph [0010] of the originally filed description discloses that "If a tag is used, then some or all of the delivery point data can be accessible from the tag instead of from an Internet site or from the delivery person memory unit (DPMU), but alternatively the tag may merely provide the DPI". Thus, the extent of accessing of the delivery point data can be "some" or "all", wherein in feature F2 the second alternative is chosen. Further, three alternatives are mentioned for the means for accessing the delivery point data, i.e. "from the tag", "from an Internet site" or "from a delivery person memory unit". The two alternatives first mentioned in the disclosure of paragraph [0010] being identical to the alternatives defined in feature F2. Since feature F2 is explicitly disclosed in paragraph [0010] of the originally filed description without any mandatory functional or structural links to other features, the Board concludes

that feature F2 is directly and unambiguously derivable from the originally filed description.

1.5 In addition, in the wording of claim 17 the term "device" has been clarified to "tag".

1.6 Consequently, the Board is satisfied, that claims 1 and 17 according to the main request filed with letter dated 13 December 2016 fulfil the requirement for clarity of Article 84 EPC and are directly and unambiguously derivable from the originally filed application, thus complying with Article 123(2) EPC.

2. Amendments and unity of invention - Rule 137(5) EPC

In its communication according to Article 15(1) RPBA the Board found that in order to comply with the requirements arising from Rule 137(5) EPC and the decision G 2/92, at least the features of the invention first mentioned in the claims, i.e. originally filed claims 1 to 3, needed to form part of any subject-matter claimed in the present European application.

Since the features of originally filed claims 1 to 3 now form part of the subject-matter of claims 1 and 17, the requirements of Rule 137(5) EPC are met.

3. Conclusion

As pointed out above, the Board is satisfied, that claims 1 and 17 of the new main request meet the requirements of Article 123(2) EPC and Rule 137(5) EPC.

Since the contested decision does not deal with patentability, the Board exercises its discretion under

Article 111(1) EPC and remits the case to the department of first instance for further prosecution.

4. The Board observes also that although compliance with the requirements relating to unity of invention has now been established for independent claims 1 and 17 of the present main request, these claims include technical features which seem not to have been covered by the original search, so that an additional search might be necessary in order to enable the examining division to properly examine the patentability of the subject-matter of this request.



## Order

### For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the department of first instance for further prosecution.

The Registrar:

The Chairman:



U. Bultmann

R. Lord

Decision electronically authenticated