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**Datasheet for the decision
of 29 April 2014**

Case Number: T 2354/12 - 3.5.07

Application Number: 00930525.1

Publication Number: 1194869

IPC: G06F17/30, H04L29/06, G07F17/00

Language of the proceedings: EN

Title of invention:
Technique for secure remote configuration of a system

Patent Proprietor:
Ascom Hasler Mailing Systems, Inc.

Opponent:
Francotyp-Postalia GmbH

Headword:
Remote configuration of franking systems/ASCOM HASLER

Relevant legal provisions:
EPC Art. 54(3), 56, 114(2), 123(2), 123(3)
RPBA Art. 12(4)

Keyword:
Admissibility of late-filed documents
Grounds for opposition - fresh ground for opposition (yes)
Inventive step - (yes) (auxiliary request)

Decisions cited:
G 0009/91, G 0010/91, G 0007/95

Catchword:



**Beschwerdekammern
Boards of Appeal
Chambres de recours**

European Patent Office
D-80298 MUNICH
GERMANY
Tel. +49 (0) 89 2399-0
Fax +49 (0) 89 2399-4465

Case Number: T 2354/12 - 3.5.07

D E C I S I O N
of Technical Board of Appeal 3.5.07
of 29 April 2014

Appellant: Francotyp-Postalia GmbH
(Opponent) Triftweg 21-26
D-16547 Birkenwerder (DE)

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

Respondent: Ascom Hasler Mailing Systems, Inc.
(Patent Proprietor) 19 Forest Parkway,
P.O. Box 858
Shelton, CT 06484-0904 (US)

Representative: Le Roux, Martine
Cabinet Beau de Loménie
158, rue de l'Université
75340 Paris Cedex 07 (FR)

Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 23 October 2012
rejecting the opposition filed against European
patent No. 1194869 pursuant to Article 101(2)
EPC.**

Composition of the Board:

Chairman: R. Moufang
Members: M. Rognoni
P. San-Bento Furtado

Summary of Facts and Submissions

I. The opponent (appellant) appealed against the decision of the opposition division rejecting the opposition against the European patent no. 1 194 869.

II. In the contested decision, the opposition division considered that the priority claim was not valid for any of the granted claims. Consequently, the following documents constituted prior art within the meaning of Article 54(2) EPC:

E2: US-A-6 029 155

E3: EP-A-0 953 901.

Furthermore, the opposition division came to the conclusion that the subject-matter of the granted claims involved an inventive step within the meaning of Article 56 EPC, having regard to E2, E3 and to the following documents:

E1: WO-A-98/26548

E4: US-A-5 715 164.

III. With the statement of grounds of appeal, the appellant filed the following additional document:

E6: US-A-5 852 722.

IV. With letter dated 27 June 2013, the patent proprietor (respondent) filed a new set of claims 1 to 20 by way of an auxiliary request and requested that document E6 not be admitted into the appeal proceedings as it was late-filed and not relevant to the present case.

V. In a communication dated 9 December 2013, summoning the parties to oral proceedings, the Board expressed the provisional opinion that the submission of document E6 with the statement of grounds of appeal could be regarded as a justifiable reaction of the appellant to the findings of the opposition division. Hence, the Board was inclined to admit E6 into the appeal proceedings.

VI. In reply to the Board's communication, the appellant filed the following document with letter dated 19 February 2014:

E7: EP-A-1 037 172.

The appellant maintained that document E7 was prejudicial to the novelty of the subject-matter of claims 1 and 13. Therefore, document E7 was highly relevant and should be admitted into the appeal proceedings despite its late filing.

VII. With letter dated 11 March 2014, the respondent requested that document E7 not be admitted into the appeal proceedings because of its very late filing. Furthermore, it was supposed to substantiate a lack of novelty objection which constituted a new and as such inadmissible ground of opposition.

VIII. On 29 April 2014, oral proceedings were held before the Board. In these oral proceedings, with respect to its auxiliary request, the respondent submitted amended claims 1 to 20 and an amended page 2 of the patent specification.

IX. The appellant requested that the decision under appeal be set aside and the patent be revoked.

The respondent requested that the appeal be dismissed or, as an auxiliary request, that the decision under appeal be set aside and the patent be maintained in amended form on the basis of the following documents:

- claims:
 - 1 to 20 submitted in the oral proceedings;
- description pages:
 - 3 and 4 of the patent specification;
 - 2 as submitted in the oral proceedings as amended page 2 of the patent specification;
- drawings:
 - Figures 1 to 3 of the patent specification.

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

"An apparatus (130) for serving a plurality of (105) franking systems through a communications network, (145) the apparatus comprising:

a memory (135) for storing a plurality of records (139) associated with the franking systems respectively;

an input element for receiving from a selected franking system a request that is automatically generated on an initial power up of the selected franking system for configuration of the selected from a generic configuration to a selected customized configuration through the communications network, the request including coded information;

a processor (133) responsive to the request for locating a record associated with the selected franking system and verifying an identity of the

selected franking system based on the coded information, the record including stored information concerning the selected customized configuration for the selected franking system the selected customized configuration corresponding to selected franking system information objects preselected by an [sic] user of the selected franking system, and an output element for providing through the communications network to the selected franking system information objects for modifying the generic configuration to the selected customized configuration based on the stored information when the identity of the selected franking system is verified."

Claims 2 to 7 are directly or indirectly dependent on claim 1.

Claim 8 of the patent in suit reads as follows:

"A franking system (105) configurable by a server (130) through a communications network (145) the franking system comprising:

storage (109) for storing a cryptographic element; a processor (107) for generating a request that is automatically generated on an initial power up of the franking system for configuration of the franking system from a generic configuration to a selected customized configuration which includes therein coded information for verification by the server of an identity of the franking system the coded information being generated using the cryptographic element;

an interface (113) for receiving information objects preselected by an [sic] user of the franking system for configuring the franking system from the server through the communications network when the identity of the franking system is verified by the server, the information objects modifying the generic configuration of the franking system,
a memory (111), and
a loader for directing the information objects to be loaded in the memory in accordance with a predetermined plan."

Claims 9 to 12 are dependent on claim 8.

Claim 13 of the patent in suit reads as follows:

"A method for use in an apparatus for serving a plurality of franking systems through a communications network, the method comprising:

storing a plurality of records associated with the franking systems, respectively;
receiving from a selected franking system a request that is automatically generated on an initial power up of the selected franking system for configuration of the selected franking system from a generic configuration to a selected customized configuration through the communications network, the request including coded information;
in response to the request, locating a record associated with the selected franking system
verifying an identity of the selected franking system based on the coded information, the record

including stored information concerning a selected configuration; and providing through the communications network to the selected franking system information objects for modifying the generic configuration to the selected customized configuration based on the stored information when the identity of the selected franking system is verified, the information objects being preselected by an [sic] user of the selected franking system."

Claims 14 to 19 are dependent on claim 13.

Claim 20 of the granted patent reads as follows:

"A method for use in a franking system configurable by a server through a communications network, the franking system including a memory, the method comprising:

storing a cryptographic element;
generating a request automatically on an initial power up of the franking system for configuration of the franking system from a generic configuration to a selected customized configuration which includes therein coded information for verification by the server of an identity of the franking system the coded information being generated using the cryptographic element;
receiving information objects preselected by an [sic] user of the franking system for modifying the generic configuration of the franking system to the selected customized configuration from the server through the communications network when the identity of the franking system is verified by the server; and

loading the information objects in the memory in accordance with a predetermined plan."

Claims 21 to 25 are dependent on claim 20.

Independent claims 1, 7, 11 and 17 according to the auxiliary request essentially differ from the corresponding independent claims 1, 8, 13 and 20 of the granted patent in that the term "*information objects*" has been replaced by the expression "*information objects including software components*".

The dependent claims of the auxiliary request differ from the dependent claims of the granted patent in that claims 6, 11, 18, 22 and 24 of the latter have been deleted, the remaining claims renumbered and their dependencies made consistent with the numbering of the corresponding independent claims.

XI. The appellant's arguments relevant to the Board's decision may be summarized as follows:

The filing of document E6 with the statement of grounds of appeal could be explained by the fact that the search for relevant prior art carried out within the time limit for filing an opposition had not led to this document and in fact the search for relevant prior art was normally stopped when it had already delivered documents which appeared prejudicial to the maintenance of a patent. After the decision of the opposition division to reject the opposition, the appellant felt compelled to carry out an additional search which led to E6. Due to its relevance and despite its late submission, E6 should be admitted into the appeal proceedings.

As to E7, this document, which was state of the art according to Article 54(3) EPC, could not have been submitted before because it was customary to restrict the preliminary search for relevant documents to prior art according to Article 54(2) EPC. However, despite its late filing, this document should be admitted into the appeal proceedings because it anticipated the subject-matter of claims 1 and 13 of the contested patent and was therefore highly relevant.

Document E4 was concerned with a communications system which exchanged data between a plurality of electronic postage meters and a data center. As acknowledged in the contested decision, the subject-matter of claim 1 differed from the system disclosed in E4 only in that:

- a) a configuration request was generated automatically on the initial power up of the franking machine;
- b) the selected customized configuration corresponded to franking system information objects preselected by the user.

Each one of features a) and b) solved a partial problem. In particular, feature a) was supposed to solve the problem of making the configuration of franking systems easy for non-technical users, whereas feature b) allowed user managed customization without requiring the exchange of user data, apart from user identification data.

As shown in document E6, it was known to the skilled person before the priority date of the contested patent to configure a processor-controlled device on power-up by connecting it to a remote server.

In the light of this background knowledge, as exemplified in E6, it would have been obvious to a person skilled in the art, starting from E4, to arrive at the subject-matter of claim 1 of the contested patent.

The same conclusion could be reached by combining E4 with the teaching of E1 or E3.

Claim 1 according to the auxiliary request differed from claim 1 of the main request only in that it specified that the information objects included software components.

Document E6 related to a system and a method for the automatic configuration of home computers connected in a network. As specified in E6 under the heading "Background of the invention", the configuration procedure of a computer necessarily involved the loading of software components. E6 also stressed that it was desirable to configure a computer according to the specifications of the user. E6 explicitly disclosed that the configuration procedure was started automatically on initial power up of the computers and that it involved computer data which included software features selected by the end user at the time the computer was purchased or selected (E6, column 4, lines 45 to 48).

In summary, E6 disclosed all the features of claim 1 with the sole exception that it related to general computer systems, such as PCs, whereas the contested invention was concerned with franking systems.

As the franking systems of the invention were evidently open franking systems, which comprised a PC and a

printer, and the specific characteristics of the franking system were irrelevant to the problem of automatically and remotely configuring a processor-controlled device upon activation, it would have been obvious to a skilled person to apply the teaching of E6 to a franking system based essentially on a PC configured to operate as a franking system.

Similarly, starting from E4, the skilled person would have realized that it was advantageous to configure a processor-controlled franking system to the user's specification by applying the teaching of E6, the more so as modern franking systems were essentially computers provided with specific software. In doing so, the skilled person would have arrived at the subject-matter of claim 1 according to the respondent's auxiliary request without involving any inventive skills.

- XII. As to claim 1 of the patent in suit, the respondent essentially argued that the term "*information objects*" in the context of the invention necessarily implied "*software components*". In fact, it was evident to the skilled reader that the customized configuration of a modern franking machine involved different hardware components (such as postal scale, feeder etc.) which required the download of corresponding software components.

As neither E4 nor any of the documents on file taught or suggested downloading software components to a franking system connected to a server via a communications network, claim 1 of the patent in suit involved an inventive step.

Concerning the document E7, the respondent declared that it did not give its consent to the introduction of the new ground of opposition (lack of novelty).

The auxiliary request clarified that "*information objects*" included software components and that the configuration of the franking machines taught in the contested patent went beyond the mere loading of some parameters.

Apart from objecting to the introduction of E6 into the appeal proceedings because of its late filing, the respondent argued with respect to the auxiliary request that the home computer configuration disclosed in this document was merely directed to establishing a connection with the server of a local service provider and clearly did not involve the download of any software. As to the "software features" mentioned in E6, column 4, lines 45 to 48, they were part of the configuration data to be transmitted to the local service provider and, in the context of the invention disclosed in E6, could not refer to customized software to be downloaded from the autoconfiguration server to the home computers.

As E6 did not disclose an essential aspect of the present invention, namely the remote customization of a franking system achieved by downloading the software component required by the hardware configuration selected by the user, its disclosure, taken in combination with the teaching of E4 or with the general knowledge of a person skilled in the field of franking machines, could not prejudice the maintenance of the patent according to the auxiliary request.

Reasons for the Decision

Admissibility of the appeal

1. The appeal is admissible.

Admissibility of documents E6 and E7

2. The teaching disclosed in document E6 seeks to make the configuration of a home network computer user friendly *"by eliminating the need for any type of user interaction during the configuration process"* and deals in particular with the automatic configuration of a computer.

Furthermore, as E6 appears, *prima facie*, to disclose a feature (*ie.* the automatic generation of a configuration request on the initial power-up) which according to the contested decision was not known from the documents then on file, its submission with the statement of grounds of appeal can be regarded as a justifiable reaction of the appellant to the findings of the opposition division.

- 2.1 Hence, despite the fact that E6 was filed only with the statement of grounds of appeal and thus had no part in the first instance proceedings, the Board, considering its relevance, has decided in favour of its admission into the appeal proceedings (Article 12(4) RPBA).

3. Document E7 is a European patent application which was filed before the filing date of the present application, but published after that date. As prior art within the meaning of Article 54(3) EPC, E7 can only be used to support a lack of novelty objection.

- 3.1 When filing the opposition, the opponent had indicated that the subject-matter of the patent in suit was not patentable under Article 100(a) EPC because of lack of novelty (Article 54 EPC) and lack of inventive step (Article 56 EPC). However, the lack of novelty objection was neither substantiated nor even referred to in the statement of grounds of opposition. This shows that the opponent had actually no reason to invoke Article 54 EPC as a ground for opposition. Lack of novelty was therefore never an issue before the opposition division and has to be regarded as a fresh ground for opposition raised only in the appeal proceedings.
- 3.2 As held by the Enlarged Board of Appeal in G 9/91 and G 10/91 (OJ EPO 1993, 408, 420), if the patentee does not agree to the introduction of a fresh ground for opposition, such ground may not be dealt with in substance in the decision of the Board of Appeal at all. This conclusion was confirmed by the Enlarged Board of Appeal in its decision G 7/95 (OJ EPO 1996, 626) in which it was furthermore held that when a patent had been opposed under Article 100(a) EPC on the ground that the claims lacked an inventive step, the ground of lack of novelty was a fresh ground for opposition and accordingly could not be introduced into the appeal proceedings without the consent of the patent proprietor.

In the present case, the respondent did not consent to an examination of the novelty of the claimed subject-matter, since this issue had never been substantiated in the opposition proceedings and was in fact a fresh ground for opposition.

- 3.3 As document E7 would only be relevant for the assessment of the novelty of the claimed subject-matter and a fresh ground for opposition may not be dealt with by the Board without the consent of the proprietor, there is no reason to admit this late-filed document into the appeal proceedings.

Main request

4. Claim 1 of the contested patent is directed to an *"apparatus for serving a plurality of franking systems through a communications network"*. The features of the claimed apparatus can be itemized as follows:
- (a) a memory for storing a plurality of records associated with the franking systems respectively;
 - (b) an input element for receiving from a selected franking system a request that is automatically generated on an initial power up of the selected franking system for configuration of the selected [franking system] from a generic configuration to a selected customized configuration through the communications network, the request including coded information;
 - (c) a processor responsive to the request for locating a record associated with the selected franking system and verifying an identity of the selected franking system based on the coded information,
 - (i) the record including stored information concerning the selected customized configuration for the selected franking system, the selected customized configuration corresponding to selected

franking system information objects
preselected by a user of the selected
franking system, and

(d) an output element for providing through the communications network to the selected franking system information objects for modifying the generic configuration to the selected customized configuration based on the stored information when the identity of the selected franking system is verified.

5. Document E4, which in the contested decision was considered to represent the closest prior art, relates, *inter alia*, to a "system for communications between a data center and postage meters" (see Figure 1).

As pointed out in E4, column 2, lines 10 to 13, communications between postage meters and a computerized central facility not only enable a postage meter user to have the meter reset with additional postage (Tele-Meter Setting: TMS), but also serve "*other administrative purposes*". For instance, each postage meter may be programmed to have charge classes defined by an upper limit and a lower limit of postage values and relating to corresponding postal classes (E4, column 4, lines 50 to 62).

Furthermore, according to E4 (column 5, first paragraph), the data center collects from time to time from each meter the class statistical data and may change the structure of the charge classes of the meter.

The data center may also communicate a postage amount limit, a time limit and a piece limit to each meter. Alternatively, a limit may be avoided by having the

data center set the corresponding limit to be unlimited (E4, column 5, lines 5 to 11).

5.1 The apparatus known from E4 shows or at least necessarily implies the following features recited in claim 1 of the main request:

- a memory for storing a plurality of records associated with the franking systems, respectively (see E4, column 7, lines 33 to 49; cf. feature (a) of claim 1);
- an input element for receiving from a selected franking system a request for configuration through the communications network, the request including coded information (see Figures 1, 5A and 5B; column 6, line 57; cf. feature (b) of claim 1);
- a processor responsive to the request for locating a record associated with the selected franking machine and verifying the identity of the selected franking system based on the coded information (see Figure 5B; cf. feature (c) of claim 1);
- the record including stored information for the selected franking system (see column 6, line 59 to column 7, line 12; cf. feature (c) (i) of claim 1);
- an output element for providing through the communications network to the selected franking machines data when the identity of the selected franking system is verified (see Figure 5B and column 7, lines 40 to 64; cf. feature (d) of claim 1).

5.2 According to the opinion of the opposition division, which was not challenged by the appellant, document E4 does not disclose the following features of claim 1 of the contested patent:

- a) a configuration is generated automatically on the initial power up of the franking machine;
- b) the selected customized configuration corresponds to franking system information objects preselected by the user.

The opposition division considered that feature a) solved the technical problem of easing configuration of franking systems for non-technical users, whereas feature b) allowed user customization without requiring the exchange of user data (beyond the user identification data) at the time of operating the franking system.

The Board concurs with the opposition division and the appellant that, taking document E4 as the starting point of the invention, two partial problems can be identified and that they are solved by features a) and b), respectively.

- 5.3 As to feature a) the Board observes that it relates to the timing of a request sent by a franking machine to the apparatus serving the franking machines. As claim 1 is directed to an apparatus comprising certain features which enable it to process requests from franking machines, it is questionable whether the timing of a request for configuration has any impact on the features of the apparatus which are actually responsible for receiving and processing this request.

Furthermore, in the Board's understanding, data relating to the available postage in the meter and the definition of charge classes, which as pointed out by the appellant depend on the country where the franking system is located, are required for the normal

operation of a franking system and thus have to be available to the franking system when it is first brought into service. Consequently, in the Board's view, it would be obvious to a skilled person to consider the possibility of applying the teaching of document E4, relating to the data exchange between a data center (*i.e.* a postal authority) and a franking system, to the download, on an initial power up, of data which are not only part of standard maintenance and servicing routines, but also essential for the franking system to become operational.

- 5.4 As to feature b) the parties essentially disagree on the interpretation to be given to the term "information objects".

In particular, the respondent has stressed that in the light of the disclosure "information objects" could only be software components, selected by the customer when purchasing the franking machine with a certain hardware configuration, and subsequently downloaded to the franking machine in order to make it operable with the selected hardware configuration.

On the contrary, for the appellant the term "information objects" would include any data relating to the operation of a franking machine.

- 5.5 The Board finds no support in the patent specification for the more restrictive interpretation of the term "information objects" given by the respondent. In fact, the description of the patent in suit (column 2, lines 23 to 25) specifies that information objects can be "software components and/or data" (underlining added). The same distinction is made in claims 6 and 7, 11 and

12, 18 and 19, 24 and 25, respectively dependent on claims 1, 8, 13 and 20 of the patent specification.

5.6 Thus, in the Board's opinion, the term "information objects" covers also mere data, e.g. those data which are downloaded from the data center of E4 to the franking machines, which are in particular data relating to TMS or to the operation of the franking machines.

6. As far as feature b) is concerned, it remains to be considered whether the data sent by the data center of E4 to the franking machines can be regarded as relating to "a selected customized configuration" for the franking machine and as being "preselected by the user".

6.1 In the Board's opinion, data sent to a franking machine for administrative purposes, such as time limits and charge classes, or to restrict use of the meter (cf. E4, column 4, lines 50 to 60, and column 2, lines 35 to 38) relate to the franking machine's configuration in the sense that they have an impact on the way the machine operates.

Although these data may also depend on the service which the user wishes to receive from the postal authority, there is no explicit hint in E4 that a certain "configuration" defined by data transferred from the data center to a franking machine can be selected by the user.

6.2 This aspect of the subject-matter of claim 1 cannot be regarded as a non-obvious contribution to the state of the art.

In fact, for the constitution of an apparatus for serving a plurality of franking machines, as specified in claim 1, it seems of little consequence whether the data required for customizing the operation of the franking system are preselected by the user or by the postal authority.

Besides, it would be obvious to a person skilled in the art, wishing to increase the user friendliness of the franking system known from E4, to give the user some possibility of customizing a franking machine at least by determining, in accordance with the postal authority, the time limits to be imposed on the machine and the postage to be added when resetting the postage meter.

7. Hence, the Board finds that in the light of general knowledge common in the field of postage meters, the skilled person, starting from E4, would have arrived at the subject-matter of claim 1 without exercising any inventive skill.

7.1 The subject-matter of claim 1, therefore, does not involve an inventive step within the meaning of Article 56 EPC.

Auxiliary request

8. Claims 1, 7, 11 and 17 according to the auxiliary request differ from claim 1, 8, 13 and 20 of the granted patent in that they specify that the *"information objects"* include *"software components"*.

This amendment finds support in the description, page 3, lines 4 to 6, and in dependent claims 6, 13, 24 and 30 of the published application (Article 123(2) EPC).

8.1 Furthermore, by specifying that the information objects to be downloaded include software components, amended claims 1, 7, 11 and 17 limit the protection conferred by the corresponding claims of the patent in suit (Article 123(3) EPC).

8.2 The independent claims amended according to the auxiliary request also clearly imply that the "configuration" of the franking machine performed according to the present invention goes beyond the determination of certain machine parameters, and involves functionalities which are linked to particular hardware configurations.

In fact, as explained in paragraph [0011] of the patent, the customization selected by the user may involve hardware and software options and the selected software options are realized by executing the downloaded software components (see also paragraph [0015]).

8.3 As acknowledged by the appellant, document E4 does not foresee the download of software components from the data center to the franking machines or a customized configuration of the franking machines by means of software components.

9. Document E6 relates to *"a system and method for the automatic configuration of home network computers"*. In column 1, lines 7 to 12, E6 specifies that it relates *"generally to configuration of home network computers, and particularly to a system and method for performing configuration automatically upon power on of the home network computer, without any user intervention, the configuration procedure being customized for that*

particular home network computer user's needs"
(underlining added).

Under the heading "BACKGROUND OF THE INVENTION", E6 points out that the *"most commonly used method for computer configuration entails shipping the configuration software media to the end user along with a User's Manual. The User's Manual usually contains detailed instructions the end user has to follow for completion of the configuration process. The problem with this method is that the end user has to read and comprehend the instructions in the User's Manual to successfully perform the configuration task. Many times this can be quite a tedious and non-user friendly task. Furthermore, the complexity is increased manyfold if the end user desires to customize the configuration for his or her particular needs"* (column 1, lines 47 to 58).

A further method mentioned is the shipping of a pre-configured computer to the end user.

However, according to E6, *"both of the methods mentioned above fail to achieve the simplicity and level of customization required of the configuration process. Furthermore, none of the methods discussed have the capability to automatically determine local service provider information for a given home network computer as part of the configuration process"* (E6, column 2, lines 5 to 10 - underlining added).

Thus, document E6 seeks to overcome *"the shortcomings of the above-mentioned methods by providing a completely automated system and method for configuring home network computers. The invention makes the configuration process user friendly by eliminating the*

need for any type of user interaction during the configuration process. Thus, the configuration of the home network computer is completely transparent to the end user. Furthermore, since the configuration system and method utilize end user information recorded by the vendor during the sale of the home network computer, the configuration can be customized to suit the end user's particular needs. As part of the configuration process, the invention is also able to automatically determine the local service provider information for a given home network computer" (E6, column 2, lines 11 to 25).

- 9.1 Relying in particular on the above passages (as well as on column 2, lines 59 to 62; Figure 3; column 4, lines 45 to 48; column 6, lines 39 to 43), the appellant has essentially argued that the autoconfiguration of home computers connected to a server taught by E6 involved the download of software applications selected by the customer at the time of purchase. Therefore the claimed subject-matter differed from E6 only in the application of a teaching disclosed in connection with general home computers to a specific computer performing the functions of a franking system.

However, according to the appellant the person skilled in the art was aware, at the filing date of the contested patent, that state-of-the-art franking machines were in fact computers running some dedicated software and connected to printers suitable for franking operations. It would have been evident to the skilled person provided with this background knowledge about the constitution of a modern franking machine to apply the teaching of E6 to a system comprising a plurality of franking machines. In doing so, the

skilled person would have arrived at the subject-matter of claim 1 without involving any inventive skills.

Furthermore, according to the appellant, the same conclusion could be drawn by starting from the franking system disclosed in E4 and applying the general teaching of E6.

9.2 According to the respondent, however, the autoconfiguration of home computers disclosed in E6 was merely directed to establishing an Internet connection with a local service provider and did not involve the download and installation of any software components.

9.3 The Board agrees with the appellant that, by drawing the reader's attention to the drawbacks of shipping a pre-configured computer or of supplying the software media required for the computer configuration to the end user, document E6 appears to be directed to a computer customization which would involve the installation of software media selected by the user.

However, further reading of E6 and in particular of the passages detailing the preferred embodiment of the invention does not confirm the impression given by the introduction.

9.4 In column 2, lines 35 to 48, E6 specifies that a home network client computer sends a request to an autoconfiguration server only if it has not access to the *"requisite configuration information needed to successfully configure itself"*, whereby this *"information consists of local server provider information and client computer specific data"*.

The *"client computer specific data"* is stored in a *"client computer information database which can also be accessed by the autoconfiguration server"* and *"is collected and stored in conjunction with the sale or acquisition of the home network client computer by the end user"*. It preferably includes *"client computer serial number, client computer model information, sales information identifying the end user or designated recipient of the home network client computer, and other end user specific configuration information such as customer configuration choices made when the customer purchased or ordered the computer"* (see E6, column 2, lines 56 to 67).

As to the information relating to the end user specific configuration, E6 further points out that it *"can include software features or service features selected by the end user at the time the end user's computer was purchased or ordered"* (column 4, lines 45 to 48).

E6 further specifies that *"the autoconfiguration server downloads the local service provider information and the client computer specific data gathered in step 310 to the requesting home network client computer"* (column 6, lines 52 to 55). The home network client computer then uses the configuration information received by the autoconfiguration server to configure itself and establish a connection with the local service provider. (E6, column 6, lines 51 to 55).

9.5 In summary, the configuration of home computers referred to in E6 in connection with the description of the preferred embodiment relates only to certain information which may already be available to the home client computer or may, according to the teaching of E6, be accessible to an autoconfiguration server, to

which the home computers are connected. In the latter case, this information is downloaded to the home computer so as to enable it to configure itself and establish a connection with a local service provider. There is no indication in E6 that the autoconfiguration server might also download configuration software media to the home computer.

9.6 Although it could be argued, as suggested by the appellant, that the skilled reader of E6 would arrive at the conclusion that its teaching evidently applied to computers requiring also some software components, such as mail client software, for their configuration, and that these software components could be provided by the autoconfiguration server, E6 does not explicitly disclose the download of software components from an autoconfiguration server to a home computer. In fact, software components could also be stored in the home computer and only be activated by the downloaded data.

9.7 Hence, the subject-matter of claim 1 differs from the apparatus disclosed in E6 in that it is *"for serving a plurality of franking systems"* and the configuration of the franking systems involves the provision of *"software components for modifying the generic configuration to the selected customized configuration"*.

9.8 In the Board's view, the application of the teaching of E6 to franking systems could only be directed to establishing automatically a connection between the franking systems and the corresponding service provider (i. e. a postal authority) on the initial power up of the franking systems, since, as pointed out above, there is no indication in E6 of downloading and installing software components for modifying the

- generic configuration to a selected customized configuration.
10. As to a possible combination of the teachings of E4 and E6, the Board observes that it would still not cover all the features of the claimed apparatus, since none of these documents discloses the provision of software components for the customized configuration of a franking machine or of a generic computer on power up.
 - 10.1 In fact, even though E4 and E6 share some similarities, in the sense that both relate to a plurality of processor-controlled devices connected to a server through a communications network, in E4 the server is a data server, for instance of a postal authority, and thus comparable to the server of the local service provider mentioned in E6, whereas in E6 the communication established on power up with a special autoconfiguration server is meant to enable an Internet connection with the local service provider without any direct involvement on the part of the user.
 - 10.2 In summary, the Board considers that neither the teaching of E6, in combination with the skilled person's general knowledge, nor the combination of the teachings of E4 and E6 would have led the skilled person to the subject-matter of claim 1.
 11. Although at the oral proceedings the appellant relied only on E4 and E6, the statement of grounds of appeal also contained submissions relating to documents E1 and E3.
 - 11.1 As pointed out by the respondent, document E1 is concerned with the configuration of the Internet access of a computer device, such as a PC. It does not deal

with the configuration of the device itself. Furthermore, E1 requires the manual input of different parameters.

Document E3 is directed to the configuration of the user interface of portable devices such as cell phones, and not to the configuration of these devices at the time of their activation.

11.2 Apart from the fact that E1 and E3 do not disclose the automatic download of software components from a server to a processor controlled device for modifying the device's generic configuration, the Board shares the respondent's view that they deal with particular kinds of device configuration and that the skilled person in search for a solution to the problem of providing a franking machine configured according to the specifications of the end user would not have taken these documents into account.

11.3 Hence, the Board finds that the subject-matter of claim 1 according to the auxiliary request involves an inventive step within the meaning of Article 56 EPC.

Independent claims 7, 11 and 17

12. Claim 7 of the auxiliary request relates to a "*franking system*", configurable by a server and comprising features, such as an interface for receiving information objects including software component, which make it automatically configurable on an initial power up. Hence, claim 7 is based on features corresponding to the features which support the inventive step of claim 1.

- 12.1 Claim 11 relates to a method for use in an apparatus for serving a plurality of franking systems through a communications network.

Claim 17 is directed a method for use in a franking system configurable by a server through a communication network.

The subject-matter of claims 11 and 17 corresponds essentially to the subject-matter of claim 1 and 7 expressed in terms of method steps.

- 12.2 No specific objections were raised by the appellant against independent claims 7, 11 and 17.

The patentability of their subject-matter is supported by the same arguments given in favour of the inventive step of the subject-matter of claim 1.

Dependent claims

13. At the oral proceedings, the appellant drew the Board's attention to the fact that in the contested patent claims 6 and 7, both dependent on claim 1, specified that information objects included alternatively software components or data. According to the auxiliary request, the feature of claim 6 was incorporated into claim 1 and claim 7 renumbered as claim 6. However, through the dependency of the current claim 6 ("information objects further include data") on claim 1, according to the appellant, the auxiliary request now defined subject-matter which was not covered by claim 1 as granted.

- 13.1 In the Board's opinion, there is no doubt that in the granted patent the term "*information objects*" was

intended to cover also the combination of software components and data, as specified in column 2, lines 20 to 25 of the patent specification. Thus, making claim 7 of the patent in suit dependent on the combination of claims 1 and 6 does not constitute a violation of Article 123(3) EPC.

13.2 No further objections were raised against the remaining dependent claims.

13.3 The "Summary of the invention" of the patent specification has been amended to make it consistent with the claimed subject-matter.

14. In summary, the Board comes to the conclusion that the respondent's auxiliary request satisfies the requirements of the EPC and that the patent can be maintained on the basis thereof.

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 with the order to maintain the patent in amended form on the basis of the following documents:
 - claims:
 - 1 to 20 submitted in the oral proceedings;
 - description pages:
 - 3 and 4 of the patent specification;
 - 2 as submitted in the oral proceedings as amended page 2 of the patent specification;
 - drawings:
 - Figures 1 to 3 of the patent specification.

The Registrar:

The Chairman:



I. Aperribay

R. Moufang

Decision electronically authenticated