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**Datasheet for the decision
of 12 November 2014**

Case Number: T 0395/13 - 3.5.02

Application Number: 98124247.2

Publication Number: 0927958

IPC: G07B17/02

Language of the proceedings: EN

Title of invention:

Postage metering network system with virtual meter mode

Patent Proprietor:

Pitney Bowes Inc.

Opponent:

Francotyp-Postalia GmbH

Relevant legal provisions:

EPC Art. 108, 111(1)
EPC R. 99(2), 103(1)(a), 111(2)
RPBA Art. 11

Keyword:

Admissibility of appeal -
appeal sufficiently substantiated (yes)
Appealed decision - sufficiently reasoned (no)
Substantial procedural violation - (yes)
Appeal decision -
remittal to the department of first instance (yes)
Reimbursement of appeal fee - (yes)



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Chambres de recours**

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Case Number: T 0395/13 - 3.5.02

D E C I S I O N
of Technical Board of Appeal 3.5.02
of 12 November 2014

Appellant: Francotyp-Postalia GmbH
(Opponent) Triftweg 21-26
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Representative: Schaumburg, Thoenes, Thurn, Landskron, Eckert
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Respondent: Pitney Bowes Inc.
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Representative: Hoffmann Eitle
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Decision under appeal: **Interlocutory decision of the Opposition
Division of the European Patent Office posted on
13 December 2012 concerning maintenance of the
European Patent No. 0927958 in amended form.**

Composition of the Board:

Chairman M. Ruggiu
Members: R. Lord
W. Ungler

Summary of Facts and Submissions

I. This is an appeal of the opponent against the decision of the opposition division concerning the European patent No. 0 927 958 that, account being taken of the amendments made by the patent proprietor during the opposition proceedings, the patent and the invention to which it relates met the requirements of the EPC. This decision was based on the main request filed during the oral proceedings of 10 October 2012 before the opposition division.

II. The following documents cited during the procedure before the opposition division are relevant for this decision:

E1: EP 0 780 809 A2,
E2: US 5 454 038 A, and
E2A: EP 0 775 988 A2.

The document numbering is as indicated by the board in the communication accompanying a summons to oral proceedings dated 11 July 2014.

III. In the communication accompanying the summons to oral proceedings the board indicated *inter alia* its preliminary opinion that the case should be remitted to the department of first instance and that the appeal fee should be reimbursed.

Oral proceedings before the board took place on 12 November 2014, at which, as indicated in a letter dated 10 October 2014, the respondent was not represented.

The appellant (opponent) requested that the decision under appeal be set aside and that the case be remitted to the department of first instance for further prosecution by holding further oral proceedings. Furthermore, reimbursement of the appeal fee was requested.

The respondent (patent proprietor) requested in writing (letter dated 10 October 2014) that the appeal be dismissed. In the event that the case is remitted to the department of first instance for further prosecution, the respondent requested that the decision only be corrected, without holding further oral proceedings.

- IV. The arguments of the appellant which are relevant for the present decision can be summarised as follows:

The arguments presented in the statement of grounds of appeal justified setting aside the decision under appeal.

Sections 11.4 and 11.5 of the decision under appeal did not relate to the present case, but could instead be seen to have been copied from the decision in one of the parallel cases involving the same parties and opposition division (specifically the opposition against European patent No. 0 927 961). The document referred to in those sections as E2 was clearly not that identified as E2 in the section "Facts and submissions" in the decision under appeal, but was instead the document now referred to as E2A. That these sections were not relevant to the present case was also apparent from the fact that it used terminology (specifically the expression "local client printer module") which appeared only in the parallel case, not

in this one. The objection of lack of inventive step discussed at the oral proceedings before the opposition division was based on documents E1 and E2, with E2A having been introduced only as providing additional evidence. Since the discussion of inventive step in the decision under appeal comprised only sections 11.2 and 11.3, which concerned only document E1, and sections 11.4 and 11.5, which did not in fact relate to the present case, the decision under appeal did not provide full reasoning as to why the opposition division considered that the subject-matter of the claim did involve an inventive step. The decision did not therefore meet the requirements of Rule 111(2) EPC, so that the case should be remitted to the department of first instance for further prosecution.

The respondent's argument, that the appellant would have been able to deduce the reasons for the decision from the annex to the summons to oral proceedings before the opposition division and the minutes of those oral proceedings, was irrelevant, because the case law of the boards of appeal was clear that failure to meet the requirements of Rule 111(2) EPC was sufficient to justify remittal. In any case it was apparent from paragraphs 2 and 3 on page 3 of the minutes of the oral proceedings that the opponent had presented arguments on which the division had not commented, so that the appellant had not known the position of the division with respect to those arguments.

Given the time which had elapsed since the oral proceedings before the opposition division, it could not be expected that the division would now be in a position to draft a revised decision without holding further oral proceedings, so that the order of the board should require that such proceedings be held.

Since failure to meet the requirements of Rule 111(2) EPC represented a substantial procedural violation, this also justified reimbursement of the appeal fee under Rule 103(1)(a) EPC.

V. The respondent argued essentially as follows:

The appellant's statement of grounds of appeal dated 17 April 2013 contained no arguments relating to the substantive grounds of the decision under appeal. Since the appellant had been in a position to present such arguments, the appeal was not admissible.

The reasoning in the decision under appeal was not fundamentally deficient, but rather merely contained a number of minor and correctable errors, in particular the incorrect document number citation, the reference to the opposition grounds instead of the opponent's oral presentations and the use of imprecise terminology.

The argumentation in the decision under appeal differed from that in the annex to the summons to oral proceedings because the appellant (then opponent) had changed its line of argumentation during the oral proceedings from one based on E1 and E2 to one based on E1 and E2A.

Even if the reasoning of the decision were seen as being deficient, the appellant would have been able to deduce the reasons for the decision from the arguments presented by the opposition division in the annex to the summons to oral proceedings and during the oral proceedings, so that there was no reason for the appeal

grounds not to have dealt with these substantive reasons.

In the light of this, and given the age of the case (filing date in 1998), it was not appropriate to remit the case to the department of first instance for further prosecution. For the same reasons, if the case were to be remitted, this should be done only for the opposition division to issue a completed decision, not to hold further oral proceedings.

Reasons for the Decision

1. *Admissibility (Article 108 EPC)*

The respondent argued in effect that the appeal was inadmissible because the statement of grounds of appeal (letter dated 17 April 2013) did not meet the requirements of Article 108 EPC in combination with Rule 99(2) EPC, since it contained no substantive arguments addressing the reasoning of the decision under appeal. The board does not find this argument convincing, because the main objection of the appellant in the grounds of appeal was that the decision under appeal did not contain sufficient reasoning to enable the appellant to file such arguments. The grounds of appeal do contain reasoning as to why the appellant considered the decision under appeal to be deficient in this manner, and hence as to why that decision should be set aside. Rule 99(2) EPC requires no more than this, and in particular does not specifically require that the statement of grounds of appeal addresses the

arguments in the decision under appeal. Therefore the board concludes that the appeal is admissible.

2. *Sufficiency of appealed decision (Rule 111(2) EPC)*

2.1 By inspection of the reasons in the decision under appeal and claim 1 of the main request addressed in that decision, it is apparent that sections 11.2 and 11.3 of those reasons address the document E1 in the context of that claim. However, by comparison of sections 11.4 and 11.5 of those reasons with that claim and with document E2, it is also apparent that those sections address neither that claim nor the document E2, even though they do use the document designation E2. This is most immediately clear from the fact that the citations from the document designated E2 in paragraph 11.4.2 are in French, whereas the document identified as E2 in the decision under appeal is in English. It is also clear that, as the appellant indicated in the letter dated 31 July 2013 (see paragraph spanning pages 2 and 3 of the letter), sections 11.4 and 11.5 are exact copies of the corresponding sections of the decision taken by the same opposition division in the parallel opposition procedure against the European patent No. 0 927 961, including even the repetition of mistakes (such as "The fist embodiment" in section 11.5.2). From further investigation it is also clear that the document referred to as E2 in sections 11.4 and 11.5 of the decision under appeal is not E2 as identified in that decision (i.e. US 5 454 038 A), but must in fact be that referred to here as E2A (i.e. EP 0 775 988 A2). The board is therefore of the opinion that sections 11.4 and 11.5 of the decision under appeal do not relate to the present case, so that the argumentation in the decision does not provide a complete reasoning

as to why the subject-matter of claim 1 as addressed in that decision involves an inventive step. As a consequence, the decision under appeal does not meet the requirements of Rule 111(2) EPC.

2.2 The respondent has argued that the reference in sections 11.4 and 11.5 of the decision under appeal to E2 instead of E2A is merely a clerical error, and that the change in the substance of the argumentation reflected a change in emphasis of the opponent's argumentation during the oral proceedings before the opposition division from the original objection based on E1 and E2 to a new objection based on E1 and E2A. On this basis the respondent has argued that the statement of grounds of appeal in the present case does not address the reasoning in the decision, so that the appeal should be dismissed.

2.3 The board does not find the respondent's arguments in this respect to be convincing, for the following reasons.

a) Firstly, the board considers that paragraph 3 on page 3 of the minutes of the oral proceedings before the opposition division is entirely consistent with the appellant's argument that they had maintained their objection based on E1 and E2, and merely added the reference to E2A as supplementary evidence.

b) Secondly, according to the respondent's arguments, it is necessary to assume not only that the first sentence of section 11.4.2 of the decision under appeal contained the erroneous document reference noted above, but also that the reference in that sentence to "his notice of opposition" was

incorrect, and should have been to "his oral arguments", and moreover that the expression "local client printer module" in section 11.5.1 represents a shorthand for the printer connected to the local one of the client computers in the present case. This combination of errors and changes seems to the board to be unlikely. Concerning the last of these points, the board notes in particular that on both occasions where the expression "local client printer module" appears in section 11.5.1 of the decision under appeal it is in quotation marks, although it does not appear in either claim 1 of the present case, or in any of the cited documents E1, E2 and E2A. It does however appear in claim 1 of the parallel case referred to by the appellant.

- c) Thirdly, the reference in the minutes of the oral proceedings before the opposition division to E2A is only to the "third paragraph" of that document, which does not correspond to any of the references to that document in the decision under appeal (which were to Figure 7 and passages in columns 11 and 12 of the description). In this context the board notes that it is not contested by the parties that the minutes correctly reflect the submissions made at the oral proceedings.

3. *Remittal (Article 111(1) EPC)*

- 3.1 The respondent additionally argued that, taking into account the age of the present case (the filing date being in 1998), remittal to the department of first instance should be avoided if at all possible. The respondent further expressed the opinion that, taking into account that the opposition division had expressed

its opinion concerning the combination of documents E1 and E2 both in the summons to oral proceedings (see section 9 of the annex to the summons of 13 February 2012) and during the oral proceedings of 10 October 2012 (see page 3, first paragraph of the minutes), the appellant was in a position to address the substantive aspects of the case, even though the written decision was not complete. Hence the case should not be remitted to the department of first instance, but instead prosecution of the substantive aspects of the case should continue before the board.

- 3.2 The board does not find these arguments convincing. The primary reason for this conclusion is that it is established case law of the Boards of Appeal that failure of a decision to meet the requirements of Rule 111(2) EPC represents a substantial procedural violation justifying remittal of the case to the department of first instance. Since, for the reasons indicated in paragraph 2.1 above, the decision under appeal does not meet the requirements of that rule, the consequence of remittal follows directly. Moreover, in the present case it is apparent that, although the appellant could probably have surmised the general nature of the grounds for the decision, sufficient doubts arise for the board to consider that it would not have been possible for the appellant to deduce the full reasoning of the opposition division from the information available. This conclusion arises in particular because, as the appellant pointed out, it is apparent from the second and third paragraphs of the minutes of the oral proceedings before the opposition division that the appellant (then opponent) had presented arguments relating to the combination of documents E1 and E2, as well as E2A, to which the division did not respond during the oral proceedings,

so that the appellant could not have known the opinion of the division with respect to those arguments.

3.3 The board is therefore of the opinion that there is no special reason within the meaning of Article 11 of the Rules of Procedure of the Boards of Appeal for not deciding to remit the present case. Thus the board concludes that it is appropriate that the case be remitted to the department of first instance for further prosecution, and also that the appeal fee be reimbursed under Rule 103(1)(a) EPC.

4. *Terms of the remittal order*

4.1 The remaining contentious issue between the parties as far as the present appeal is concerned is that of whether the board should instruct the opposition division to appoint further oral proceedings, as requested by the appellant, or to proceed directly to the issuing of a further decision without appointing oral proceedings, as requested by the respondent. At the present stage of the proceedings the board considers it to be inappropriate to restrict the options of the opposition division in this respect, in particular given that one or both of the parties might present amended requests after the procedure before the opposition division has been resumed. This could of course have an influence on the necessity for oral proceedings under Article 116(1) EPC, which the board is not in a position to predict.

4.2 The board therefore concludes that the question as to whether further oral proceedings should be appointed after the remittal should be left for the opposition division to decide.

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.
3. The request for reimbursement of the appeal fee is allowed.

The Registrar:

The Chairman:



U. Bultmann

M. Ruggiu

Decision electronically authenticated