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**Datasheet for the decision
of 5 February 2020**

Case Number: T 0418/15 - 3.5.02

Application Number: 07150496.3

Publication Number: 1970131

IPC: B07C3/08

Language of the proceedings: EN

Title of invention:

Mail sorting and sequencing system

Patent Proprietor:

ELSAG DATAMAT S.p.A.

Opponent:

Siemens Aktiengesellschaft

Relevant legal provisions:

EPC Art. 56

Keyword:

Inventive step - seventh auxiliary request (yes)
New ground for opposition in appeal proceedings - no consent
of the patent proprietor

Decisions cited:

G 0009/91, G 0010/91, G 0001/95



Beschwerdekammern

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Case Number: T 0418/15 - 3.5.02

D E C I S I O N
of Technical Board of Appeal 3.5.02
of 5 February 2020

Appellant: Siemens Aktiengesellschaft
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Respondent: ELSAG DATAMAT S.p.A.
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Decision under appeal: **Decision of the Opposition Division of the European Patent Office posted on 14 January 2015 rejecting the opposition filed against European patent No. 1970131 pursuant to Article 101(2) EPC.**

Composition of the Board:

Chairman R. Lord
Members: C.D. Vassoille
J. Hoppe

Summary of Facts and Submissions

I. The appeal of the opponent lies against the decision of the opposition division rejecting the opposition against European patent no. 1 970 131.

II. The following documents are relevant for the present decision:

D10 US 4,971,513

D13 US 2003/0038065 A1

D18 US 4,244,672

D21 US 6,595,346 B1

III. In the statement setting out the grounds of appeal the appellant (opponent) requested that the patent be revoked. In their letter of reply to the appeal the respondent (proprietor) requested as main request that the appeal be dismissed and additionally filed eight auxiliary requests, which corresponded to those submitted during the proceedings before the opposition division.

IV. Oral proceedings before the board took place on 5 February 2020. In the course of the oral proceedings the respondent withdrew their main request and several auxiliary requests. The parties' requests at the end of the oral proceedings were as follows:

The appellant (opponent) requested that the decision under appeal be set aside and that the European patent be revoked.

The respondent (patent proprietor) requested to set the decision aside and maintain the patent in amended form on the basis of the seventh auxiliary request or as an

auxiliary measure, on the basis of the eighth auxiliary request, both requests filed with letter dated 6 October 2015.

V. Claim 1 of the seventh auxiliary request reads as follows:

"A mail sorting and sequencing system (1), comprising at least one DPP unit (2) for forming groups of mail items and for sorting mail items of at least one of the following types of mail:

- a first type of mail (7a) comprising letters and postcards (regular mail)
- a second type of mail comprising flat mail items (7b) of dimensions larger than the corresponding dimensions of letters and postcards; and
- a third type of mail comprising oversized mail items (7c) whose characteristic dimensions make automated processing of the items difficult/impossible/unpractical;

said at least one DPP unit comprising:

a first conveyor system (9) where a number of trucks (11) travel along a path (13); at least one feed unit (15a, 15b, 15c) communicating with said first conveyor system (9), said feed unit receiving one of said first, second and third type of said mail items and loading one of said first, second and third type of said mail items into said trucks (11); and

at least one accumulating device (20) cooperating with said first conveyor system (9) to receive one of said first, second and third type of said mail items released by said trucks (11);

wherein:

said accumulating device (20) comprises a second conveyor system (55,150) located beneath an unloading

portion (13s) of said path of said first conveyor system;
one of said trucks (11) engages said unloading portion to run over said accumulating device (20); and
said one truck (11) has an unloading hatch mechanism enabling release of one of said first, second and third type of said mail items from said one of said trucks and enabling one of said first, second and third type of said mail items to fall by force of gravity into said accumulating device (20),
said accumulating device (20) further comprising:
a number of trap units (161) located between said second conveyor system (55,150) and said unloading portion (13s) of said first conveyor system (9), and for receiving the mail items unloaded by force of gravity from said trucks (11);
each trap unit (161) being movable between a closed position, in which it retains the mail items unloaded into it by truck (11), and an unloading position, in which the mail items inside trap unit (161) are released by trap unit (161) into a respective accumulating unit (159) of said second conveyor system (55,150),
wherein switches (43) are located along said path (13) for allowing formed/forming trains of trucks (11) to travel along said path, each train being characterized by a first parameter n representing the progressive location of a batch of mail items along a delivery route; and first control means activated by the arrival of two trains at the same switch (43), said first control means comparing said first parameters n of said two trains to activate said switch (43) to let through said batch of mail items having the lower progressive location along said delivery route."

Claims 2 to 17 as granted and claim 19 as granted renumbered as claim 18 are dependent from claim 1.

- VI. During the appeal proceedings the appellant raised a new ground for opposition under Article 100(c) EPC. The respondent did not agree to the introduction of the new ground.
- VII. In their letter of 5 January 2020 the appellant with regard to the seventh auxiliary request merely referred to the statement setting out the grounds of appeal which in turn referred to sections 2.1 to 2.17 of the statement of grounds for opposition regarding the dependent claims of the patent as granted.
- VIII. The arguments of the appellant which are relevant for the present decision are as follows:

The subject-matter of claim 1 of the seventh auxiliary request did not involve an inventive step in the sense of Article 56 EPC in view of a combination of document D21 with document D13. Document D13 disclosed a mail sorting system for flat mail items. All mail items in D13 were transferred from a "delivery point" to a "slot 72" of a "mail case 70" (see paragraphs [0006] and [0046]). A large number of "robots 100" acted as trucks, which moved along a "track system 60" (see paragraph [0046] and figures 1 and 2).

A "bar code scanner 400" was capable of scanning a "bar code or other ID tag 118" on a truck (see paragraph [0046]). Each truck moved in such a way that it arrived at a certain "slot 72" of a "mail case 70". This "slot 72" was assigned to a specific "delivery point" and accepted all mail items for a specific "delivery point". In D13 the destination address of a postal item

functioned as a parameter in the sense of claim 1, which corresponded to the "delivery point".

The skilled person thus learned from D13 to use trucks having their own electric drive and to locate them along a first conveyor system, which comprised switches.

The skilled person would transfer the teaching of document D13 to document D21 to solve the objective technical problem of how to synchronise the "upper conveyor 3" with the "lower conveyor 2" of D21 by means of the "electric shaft" (see D21, figure 1 and column 2, lines 51 to 62).

The subject-matter of claim 1 of the seventh auxiliary request also did not involve an inventive step in the sense of Article 56 EPC in view of a combination of document D18 with document D10.

D18 described a sorting facility which transported a mail item per truck ("carrier 20"). The loaded trucks were placed along the "recirculation buffer subsystem 10" and the "secondary transport 12". Sequences of sorted mail items were formed in the "accumulation rack subsystem 14", namely one sequence per "accumulation rack 14". The trucks were discharged from the "buffer subsystem 10" and transferred to the "secondary transport 12" (see column 3, lines 47 to 52).

Information in a "memory 22" on a truck was previously read by a "read-write station 30, 32, 34" (see column 3, lines 49 to 52), to find the correct route. "Gates 46" would then forward a fully loaded truck into the correct "accumulation rack 14'" (see column 4, lines 20 to 31).

The mail items were sorted according to their delivery addresses and should be sorted into the correct "accumulation rack 14' ". The position of a truck in this rack corresponded to a parameter of each mail item to be sorted and therefore corresponded to parameters of each truck carrying a mail item in the sense of claim 1.

The sorting machine according to D18 had a control unit which was described in detail in column 6, lines 51 to column 7, line 43 and shown in figure 2. The remaining features of claim 1 were obvious in view of D18 and D10.

The appellant had further objected that claim 1 of the seventh auxiliary request was not drafted in the "two part form".

IX. The arguments of the respondent which are relevant for the present decision are as follows:

Document D21 did not disclose a "DPP unit" in the sense of claim 1. Furthermore, no trap units were disclosed in D21 and D13. Even when combining document D21 with D13, the skilled person would therefore not arrive at the subject-matter of claim 1.

No reference in D18 or D10 was made to switches and prioritisation of mail items in the sense of claim 1. Even when combining document D18 with D10, the person skilled in the art would therefore not arrive at the subject-matter of claim 1.

Reasons for the Decision

1. The appeal is admissible
2. *Fresh ground for opposition in the appeal proceedings*

The appellant has submitted a fresh ground for opposition according to Article 100(c) EPC with respect to all requests on file for the first time in the appeal proceedings. The respondent has not consented to the introduction of this fresh ground into the proceedings and it is therefore not to be considered (see G 10/91 and G 9/91, OJ 1993, 420; G 1/95, OJ 1996, 615).

3. *Claim 1 - seventh auxiliary request - inventive step (Article 56 EPC)*

3.1 Amendments (Article 123(2) EPC)

The basis for the amendments in claim 1 of the seventh auxiliary request is a combination of originally filed claims 1 and 18 and the amendment consequently complies with the requirement of Article 123(2) EPC.

3.2 Appellant's objections

- 3.2.1 As regards the respondent's seventh auxiliary request, reference was made by the appellant in the letter of 5 January 2019 to the reasoning in the statement setting out the grounds of appeal, which in turn referred to sections 2.1 to 2.17 of the statement of grounds of opposition of 8 June 2011, submitted as an annex with the grounds of appeal. The before-mentioned sections contain a discussion about the dependent

claims of the patent as granted. In particular, section 2.16 contains reasons with regard to a lack of inventive step of the subject-matter of the granted dependent claim 18, which corresponds to claim 1 of the seventh auxiliary request.

3.2.2 Given the above circumstances, as well as the fact that the respondent with the letter of reply to the appeal did not give any reasons to explain how the seventh auxiliary request overcame the objections raised, the board has come to the conclusion that the appellant's reference to section 2.16 of the statement of grounds for opposition represents a timely and sufficiently substantiated objection with respect to the seventh auxiliary request.

3.2.3 This applies, however, exclusively to the explicit objections relating to dependent claim 18 in section 2.16 of the grounds for opposition. The board does not consider any further explicit or implicit (cross-)references within the statement of grounds for opposition to other sections of the same document to meet the requirements of a properly substantiated objection.

3.3 *Combination of documents D21 and D13*

3.3.1 The subject-matter of claim 1 involves an inventive step in view of the combination of documents D21 with D13.

3.3.2 The board agrees with the respondent that even if the person skilled in the art would have combined document D21 with D13, they would not have arrived at the subject-matter of claim 1.

3.3.3 As has been argued by the respondent, neither document document D21 nor document D13 discloses an accumulating device comprising trap units located between the second conveyor system and the unloading portion of the conveyor system in the sense of claim 1. In particular, the arrangement of buckets 3A and 2A as well as baskets 2B and 3B of document D21 has considerable differences compared to the arrangement as defined in claim 1.

3.3.4 The appellant relied on the written submissions only, which however did not address this issue in the relevant section 2.16.2 of the statement of grounds of opposition. It is thus not apparent on which basis the skilled person would have been motivated to further modify a system resulting from a combination of documents D21 and D13 to arrive at the subject-matter of claim 1. The only written arguments on file are incomplete in this respect and fail to convincingly establish that the subject-matter of claim 1 is rendered obvious by a combination of documents D21 and D13.

3.3.5 The board has therefore come to the conclusion that the subject-matter of claim 1 involves an inventive step in the sense of Article 56 EPC in view of a combination of documents D21 and D13.

3.4 *Combination of documents D18 and D10*

3.4.1 The subject-matter of claim 1 involves an inventive step in view of a combination of documents D18 and D10.

3.4.2 The board agrees with the respondent that even if the person skilled in the art would have combined document D18 with D10, they would not have arrived at the

subject-matter of claim 1 of the seventh auxiliary request.

- 3.4.3 As has been argued by the respondent, neither document D18 nor document D10 discloses switches, which in combination with control means function to prioritise trains of trucks arriving at the same switch. Document D18 merely discloses the provision of diverting gates, which are actuated at the proper time to intercept the carrier and divert it into the correct output accumulation rack (see in particular column 4, lines 20 to 31).
- 3.4.4 It is not apparent on which basis the skilled person would have been motivated to further modify a system resulting from a combination of documents D18 and D10, in order to arrive at the subject-matter of claim 1. The only written arguments on file (see section 2.16.3 of the statement of grounds for opposition) are incomplete in this respect and fail to convincingly establish that the subject-matter of claim 1 is rendered obvious by a combination of documents D18 and D10.
- 3.4.5 The board has therefore come to the conclusion that the subject-matter of claim 1 involves an inventive step in the sense of Article 56 EPC in view of a combination of document D18 with D10.
- 3.5 *Missing "two part form" (Rule 43(1)(b) EPC)*
- 3.5.1 The appellant has objected that claim 1 of the seventh auxiliary request is not drafted in the "two part form".

3.5.2 The board notes that Rule 43(1) EPC includes the wording "Wherever appropriate, claims shall contain ...". It is thus a question of "appropriateness" whether or not to provide a characterising portion according to Rule 43(1)(b) EPC in a claim. The appellant did not provide any argument as regards an alleged "appropriateness" of providing a characterising portion of claim 1 of the seventh auxiliary request. Therefore, the board considers the appellant's general statement that claim 1 was not in the "two part form" and thus contravened the Convention (see paragraph 9 of the letter dated 5 January 2020), to be an objection which is not sufficiently substantiated.

4. *Conclusion*

Since the subject-matter of claim 1 of the seventh auxiliary request involves an inventive step in the sense of Article 56 EPC, and since no further valid objections have been raised, the board had to accede to the respondent's seventh auxiliary request.

Order

For these reasons it is decided that:

1. The decision is set aside.
2. The case is remitted to the opposition division with the order to maintain the patent in amended form based on the claims of the seventh auxiliary request, filed with letter of 6 October 2015 and a description to be adapted as appropriate.

The Registrar:

The Chairman:



U. Bultmann

R. Lord

Decision electronically authenticated