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**Datasheet for the decision
of 18 June 2020**

Case Number: T 0289/16 - 3.5.02

Application Number: 09305638.0

Publication Number: 2144202

IPC: G07B17/00

Language of the proceedings: EN

Title of invention:

Postal indicia generating system and method

Patent Proprietor:

NEOPOST TECHNOLOGIES

Relevant legal provisions:

EPC Art. 100(a), 54, 56

Keyword:

Novelty - (yes)

Inventive step - (yes)

Continuation of the appeal procedure after withdrawal of the opposition



Beschwerdekammern

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Case Number: T 0289/16 - 3.5.02

D E C I S I O N
of Technical Board of Appeal 3.5.02
of 18 June 2020

Appellant: NEOPOST TECHNOLOGIES
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Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 24 November
2015 revoking European patent No. 2144202
pursuant to Article 101(3)(b) EPC.**

Composition of the Board:

Chairman R. Lord
Members: C.D. Vassoille
R. Cramer

Summary of Facts and Submissions

- I. This is an appeal of the patent proprietor (appellant) against the decision of the opposition division to revoke European patent no. 2 144 202.
- II. In the decision under appeal, the opposition division came to the conclusion that the subject-matter of claim 1 of the patent as granted (main request) was not new (Articles 100(a) and 54 EPC). For similar reasons, the auxiliary request was found not to be allowable.
- III. The following documents are relevant for the present decision:

E1: US 6,820,201 B1
E2: USPS-I-3196, United States Postal Service Specification, 4 February 2004, "Performance Criteria And Security Architecture For Closed IBI Postage Metering System"
E3: US 2002/0046183 A1
- IV. The parties were summoned to oral proceedings. In a communication under Article 15(1) RPBA 2007 annexed to the summons, the board set out their preliminary observations on the appeal, concluding *inter alia* that the subject-matter of claim 1 of the main request seemed to be new in view of E1.
- V. With letter of 28 May 2020, the respondent (former opponent) withdrew their opposition.
- VI. Given that the board's preliminary opinion was favourable to the appellant, the oral proceedings could

be cancelled and the decision issued in written procedure.

VII. The appellant has requested in writing that the decision under appeal be set aside and that the patent be maintained as granted (main request). The first and second auxiliary request filed with the statement setting out the grounds of appeal were withdrawn with letter of 4 May 2020.

VIII. Claim 1 of the patent as granted (i.e. according to the appellant's main request) reads as follows:

"A method for generating a postal indicia associated with a mailpiece, the method comprising:

generating an indicia data stream (100) having a postal information segment (102) and a security segment (104) based upon the postal information segment (102), modifying a portion of the security segment (104) to include additional information, thereby defining a modified indicia data stream (106) ; rendering the modified indicia data stream (106) as the postal indicia; and associating the postal indicia with the mailpiece."

Claims 2 to 12 are dependent on claim 1.

IX. Independent system claim 13 of the patent as granted reads as follows:

"A system for generating a postal indicia associated with a mailpiece, comprising:
a postal security device (52) productive of an indicia data stream (100) having a postal information segment

(102) and security segment (104) based upon the postal information segment; and a controller (68) in signal communication with the postal security device (52), the controller adapted to modify a portion of the security segment (104) to include additional information, thereby defining a modified indicia data stream (106), and to render the modified indicia data stream as the postal indicia and associate the postal indicia with the mailpiece."

Claims 14 to 18 are dependent on claim 13.

- X. The arguments of the appellant, in so far as they are relevant for the present decision, may be summarised as follows:

A modification of the encrypted security segment could not be derived from E1, column 9, lines 9 to 11. Rather, merely the possibility for the user to modify the date, which was however a component of the unencrypted information segment underlying the security segment, was derivable from that passage. The teaching of E1 was therefore limited to the possibility of modifying information contained in the postal information segment that must be encrypted to generate the "certificate". E1 therefore did not teach to modify part of the (already encrypted) security segment to include additional information.

Furthermore, the method of claim 1 was restricted only to four steps, and a second generation of the security segment neither formed part of claim 1 nor was it necessary in the context of the present invention because the postal information segment was not modified. To the contrary, generating a new security

segment would overwrite the modified security segment, which was not desirable.

Document E1 therefore did not disclose the step of "modifying a portion of the security segment (104) to include additional information, thereby defining a modified indicia data stream" of claim 1.

XI. The arguments of the former opponent, submitted in writing during the appeal procedure and in so far as relevant for the present decision, may be summarised as follows:

Claim 1 did not specify how the security segment was created. Neither did it specify whether all or part of the postal information was used to generate the security segment, whether the security segment, if created by encryption, consisted of an encrypted section only or also contained plain-text parts, or at which point in time the modification of a portion of the security segment addressed in claim 1 was to be carried out.

In the granted claim 1, the security segment was exclusively defined by the fact that it was created on the basis of the postal information segment. There was further no definition present in claim 1 as regards the meaning of "additional information".

Due to its general formulation, claim 1 also included the solution disclosed in E1, in particular column 9, lines 5 to 11, according to which a previously created digital certificate (=security segment) could be subsequently modified by inserting a new date in the date field of the certificate.

Reasons for the Decision

1. The appeal is admissible.

2. *Procedural matters*

As mentioned above (point V), the sole opponent withdrew their opposition and consequently is no longer a party to the proceedings.

It is established case law of the boards of appeal that a withdrawal of the opposition in appeal proceedings has no immediate procedural significance if the opposition division has revoked the European patent. The board must then re-examine the substance of the opposition division's decision of its own motion, setting it aside and maintaining the patent only if the latter meets the requirements of the EPC. In the present case, the board has consequently reviewed the decision in the light of the arguments and evidence which had been submitted by the former opponent before the opposition was withdrawn (see the Case Law of the Boards of Appeal, 9th edition 2019, III.Q.3.3).

3. *Main request - Distinguishing feature, novelty (Articles 100(a) and 54 EPC)*

3.1 It is undisputed that document E1 discloses a method for generating a postal indicia associated with a mailpiece comprising the step of generating an indicia data stream having a postal information segment ("nonce") and a security segment ("certificate") based upon the postal information segment.

The appellant has, however, disputed that document E1 discloses the step of "modifying a portion of the

security segment to include additional information, thereby defining a modified indicia data stream" of claim 1.

- 3.2 The opposition division based their conclusion that E1 discloses the feature in question substantially on the following passage in column 9, lines 6 to 11 of E1:

"... a vendor of nonce digital certificates can, if requested by a user and if legitimate exchanges are allowed, transmit an extra copy of a previously purchased digital certificate but with a new date (or can disseminate to users electronic certificates and software making the date filed very easily modifiable)..."

The board agrees with the appellant that from this passage alone it cannot be directly and unambiguously derived that the certificate is modified such that a portion of the certificate includes additional information, thereby defining a modified indicia data stream in the sense of claim 1.

- 3.3 Claim 1 is clearly limited by the order of the steps denoted therein, meaning that a possible regeneration of the security segment after modification of a portion thereof is neither derivable from the wording of the claim nor technically sensible. As has been argued by the appellant, regeneration of the security segment, after modification of a portion thereof, would result in overwriting the modified security segment, which renders a modification of the security segment such that a portion of it includes additional information useless.

Furthermore, according to claim 1, the modified indicia data stream is rendered as postal indicia, and the skilled person would understand this as implying that the security segment is not regenerated after it has been modified to include additional information.

- 3.4 The board further observes that E1 in column 9, lines 9 to 11 indeed discloses the provision of an "extra copy of a previously purchased digital certificate but with a new date" or alternatively the provision of "electronic certificates and software "making the date field very easily modifiable" for a user. However, the board is not convinced that the skilled person would directly and unambiguously infer from this disclosure that a portion of a security segment ("certificate") is modified, which thereafter together with the information segment ("nonce") forms a modified indicia data stream in the sense of claim 1.

While there cannot be any doubt that date information may be encoded in the certificate, it is not directly and unambiguously derivable from E1 that the "date field" mentioned in column 9 of E1 forms part of the electronic certificate to constitute a "modified indicia data stream" according to claim 1. It is further noted that E1 neither specifies the function of the "software" nor the "date field" in more detail.

The board also notes that E1 in column 9, lines 11 to 15 emphasises the binding of the certificate's encrypted number to an irreproducible nonce stamp for authentication purposes. Modification of the security segment (certificate) however results in uncertainty regarding authenticity of data (see also paragraph [0056] of the contested patent) and this issue is not addressed anywhere in E1. The appellant's argument that

a modification of the "date field" mentioned in E1 referred to the unencrypted information segment, and not to a portion of the security segment according to claim 1, is therefore convincing.

- 3.5 The board has therefore come to the conclusion that document E1 does not disclose the step of "modifying a portion of the security segment to include additional information, thereby defining a modified indicia data stream" in the sense of claim 1.

This also applies to the independent system claim 13, which comprises a corresponding distinguishing feature: "modify a portion of the security segment (104) to include additional information, thereby defining a modified indicia data stream (106)".

- 3.6 The subject-matter of claims 1 and 13 is therefore new with regard to document E1 and the ground for opposition of Article 100(a) EPC in combination with Article 54 EPC consequently does not prejudice the maintenance of the patent as granted.

4. *Main request - Inventive step (Articles 100(a) and 56 EPC)*

- 4.1 In the statement of grounds for opposition of 24 July 2013 the former opponent submitted that the subject-matter of claim 1 did not involve an inventive step in the sense of Article 56 EPC in view of E1 in combination with E2 or E3.

- 4.2 While it might be true that document E1 in column 9, lines 20 to 21 discloses that a digital certificate may require a modification not affecting price, E1 in column 9, line 24, continues by saying that such a

certificate "can readily be replaced". The cited passage of E1 consequently does not suggest to the skilled person to modify the digital certificate without further regeneration and to use the modified certificate as a modified indicia data stream forming the postal indicia, which is to be associated with the mailpiece. Rather, E1 clearly teaches to replace the digital certificate in the sense that a new digital certificate is generated.

4.3 Similarly, the board is not convinced that the field labelled "Reserved" in Table B-4 of E2 or that labelled "Reserve Field" in column 1, line 34 of E1, forms part of the generated digital certificate, and which may be modified after generation of the certificate. Rather, as has been submitted by the former opponent themselves, the tables in E1 and E2 contain information used to generate the digital certificate. Consequently, this neither explicitly nor implicitly discloses or suggests adding information in the (already) generated digital certificate, which is then used as the modified indicia data stream.

4.4 The former opponent further referred to E3 on page 1, left column, line 66, to page 1, right column, line 3, and argued that E3 disclosed printing of additional information by means of a digital printer in a postal indicia comprising a postal information segment and a security segment in the sense of claim 1, and that the skilled person would therefore infer from E3 the possibility to modify the postal indicia (see page 6 of the statement of grounds for opposition).

The former opponent has not submitted any argument as to how the skilled person could possibly have been motivated by E3 to modify a portion of a security

segment of an indicia data stream to include additional information, thereby defining a modified indicia data stream, and the board does not see any such indication in E3. In any event, the mere fact that E3 discloses the printing of additional information on the postal indicia is not sufficient to prove the obviousness of a modification of the security segment to include additional information.

- 4.5 The board has therefore come to the conclusion that, in particular in light of the prior art submitted by the former opponent in the first instance proceedings, the subject-matter of claim 1 of the main request is not rendered obvious by E1 alone and in particular taking into account E2, or in combination with E3, and therefore involves an inventive step in the sense of Article 56 EPC. The same applies to the subject-matter of independent claim 13, which comprises corresponding features to that of claim 1.

5. *Final remarks*

For the above reasons, the grounds for opposition put forward by the former opponent, namely lack of novelty (Articles 100(a) and 54 EPC) and lack of inventive step (Articles 100(a) and 56 EPC), do not prejudice the maintenance of the patent as granted. The board therefore concludes that the patent and the invention to which it relates meet the requirements of the EPC. Consequently, the patent has to be maintained in accordance with the appellant's main request.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The patent is maintained as granted.

The Registrar:

The Chairman:



U. Bultmann

R. Lord

Decision electronically authenticated