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**D E C I S I O N**  
of 8 July 1998

**Case Number:** T 0975/96 - 3.5.2

**Application Number:** 88302221.2

**Publication Number:** 0282357

**IPC:** B07C 3/00

**Language of the proceedings:** EN

**Title of invention:**  
Letter processing apparatus

**Patentee:**  
PITNEY BOWES, INC.

**Opponent:**  
Francotyp-Postalia Aktiengesellschaft & Co.

**Headword:**  
-

**Relevant legal provisions:**  
EPC Art. 56

**Keyword:**  
"Inventive step (yes)"  
"Determination of the problem to be solved on the basis of the  
closest prior art (problem-solution approach)"

**Decisions cited:**  
-

**Catchword:**



Case Number: T 0975/96 - 3.5.2

**D E C I S I O N**  
of the Technical Board of Appeal 3.5.2  
of 8 July 1998

**Appellant:** Francotyp-Postalia Aktiengesellschaft & Co.  
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**Representative:** Schaumburg, Thoenes, Thurn  
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**Respondent:** PITNEY BOWES, INC.  
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**Representative:** Avery, Stephen John  
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**Decision under appeal:** Decision of the Opposition Division of the  
European Patent Office posted 21 August 1996  
rejecting the opposition filed against European  
patent No. 0 282 357 pursuant to Article 102(2)  
EPC.

**Composition of the Board:**

**Chairman:** W. J. L. Wheeler  
**Members:** M. R. J. Villemin  
A. C. G. Lindqvist

## Summary of facts and submissions

- I. The Appellant filed an opposition against European patent No. 0 282 357 and now contests the decision of the Opposition Division rejecting the opposition.
- II. The opposed patent has not been amended during the appeal proceedings. Its claim 1 reads as follows:

"Letter processing apparatus comprising:

- a. means (10, 12, 60, 85, 100, 250) for preparing a letter (A, E, F) including a returnable stationery item (B, D, F) for sending to an addressee who may be located remotely of the apparatus, said returnable stationery item including a code (A3; E3; F3) identifying said addressee;
- b. means (130) for routing said returnable stationery item to a selected one of a plurality of locations (142), said routing means including means (140) for sensing said code;
- c. computer means (180; 250) including memory means for storing a dispositive data listing (204) for said code, said dispositive data listing (204) including data defining said selected location; and
- d. means (214, 216) for changing said dispositive data listing, whereby said selected location may be changed, said means (130) for routing being operable to route said stationery item automatically on return thereof as a result of the sensing means (140) sensing said code and said computer means (180; 250) associating said code with said data defining said selected location for said returned stationery item, said computer means (180, 250) being coupled to the routing means and including means for controlling the routing means to route said returned stationery item automatically to said selected location when said code is sensed; and

the means (214, 216) for changing the dispositive data listing being such that the programming of said computer means (180; 250) to associate said code with said data may be effected at a time and, if desired, at location distinct from the time and location of sending of the returnable stationery item."

III. In the statement of the grounds of appeal, the Appellant (Opponent) relied on document

D1: US-A-4 058 217,

already considered in the opposition procedure, and cited for the first time the following additional document:

D5: DE-B-2 409 999.

IV. Oral proceedings were held on 8 July 1998.

V. The Appellant argued essentially that the problem addressed by the patent in suit did not stem from the fact that a returnable stationery item was sent by a mailer to a selected one of a plurality of locations and returned by an addressee, but only related to properly rerouting an item when the selected location had been changed. The technical problem to be solved by the patent in suit rather consisted in the providing of means for rerouting an item to a selected location when this location had changed while the item was in transit between a sender and a receiver. Document D1 was very relevant to the claimed processing apparatus. In the article sorting system disclosed in D1, the airline company was acting as a mailer. An airline item of baggage should be somehow associated with its owner in

order that the owner could recover it at the destination airport. Hence the label attached to an item of baggage provided a link identifying the owner-addressee.

It was obvious that the list of the destination places of a transported parcel could be changed while the parcel was in transit in the sorting systems known from D1 or D5. D5 disclosed means which could be used to change the destination stored in the computer memory (see D5, column 3, line 44 ff). For these reasons, no inventive step could be seen in the subject-matter of claim 1.

- VI. The Respondent (Patent proprietor) argued that the prior art did not disclose returnable stationery items which included a code identifying the addressee, where that code was used to route a returnable stationery item when it returned from the addressee. The system known from D1 related to the sorting and rerouting of articles sent by an airport or a postal centre to different destination places and not to the automatic rerouting of a returnable stationery item attached to an article previously sent to an addressee. Neither D1 nor D5 suggested that the sorting system should maintain the link between particular items of luggage and particular passengers. The Appellant appeared to have ignored relevant features of claim 1 which were not disclosed in D1 or D5. The newly cited document D5 added nothing of significance to the disclosure of D1.
- VII. The Appellant requested that the decision under appeal be set aside and that the European patent No. 0 282 357 be revoked.

The Respondent requested that the appeal be dismissed.

## Reasons for the decision

1. The appeal is admissible.
2. *Novelty*

The novelty of the subject-matter of claim 1 of the patent in suit has not been contested by the Appellant.

3. *Prior art closest to the invention*

3.1 According to the practice of the Boards of Appeal, the problem-solution approach generally has to be applied when examining inventive step. This practice involves first determining the closest prior art, then establishing the technical problem to be solved and, finally, considering whether or not the claimed invention, starting from the closest prior art and the technical problem, would have been obvious to the skilled person. In some cases, identification of the problem may contribute to an inventive step.

3.2 An objective definition of the problem to be solved by an invention should normally start from the problem described in the contested patent. Only if examination showed that the problem disclosed had not been solved or if inappropriate prior art had been used to define the problem, would it be necessary to consider what other problem objectively existed.

The claimed subject-matter concerns a letter processing apparatus comprising means for preparing a letter including a returnable stationery item for sending to an addressee who may be located remote from the apparatus, the returnable stationery item including a code identifying the addressee. As can be seen from the

description of the patent in suit (column 2, lines 10 to 34 and column 3, lines 29 to 40), a problem may arise in a prior art letter processing apparatus of the kind mentioned above and as known from document US-A-4 585 220, if the location of a business unit has changed while the returnable stationery item was in transit, because this returnable item may not be delivered directly to the appropriate business unit. It is clear to the person skilled in the art that the problem mentioned in the patent in suit is solved by the technical features recited in claim 1 of this patent, in particular in part d of this claim, namely by associating the code identifying the addressee with data of a dispositive data listing stored in a computer and defining selected locations for returning the stationery item. Since the dispositive data listing may be changed at any time, the claimed apparatus can be used to assure a prompt and safe routing of a returned stationery item to the appropriate business unit, even when the location of the above-mentioned specific business unit has changed while the returnable stationery item was in transit.

D1 describes a method and an apparatus for the automatic reading of labels attached to items of airline baggage for the automatic sorting and routing of the baggage, or for the automatic sorting of postal articles through the various sorting centres in a postal distribution system. D1 does not hint at apparatus for preparing a postal article including a returnable item identifying the addressee. An apparatus of the kind defined in claim 1 of the patent in suit is thus not disclosed or suggested in D1. This document bears no relationship to the problem to be solved as described in the patent in suit and cannot represent a better starting point than the prior art which is acknowledged in the patent in suit. Since the

statements relating to the problem and its solution to remove the drawbacks of the prior art apparatus disclosed in US-A-4 585 220 are unambiguously and correctly indicated in the patent in suit, there is no reason for reformulating the problem on the basis of D1.

4. *Inventive step*

- 4.1 Comparing the claimed apparatus and the apparatus known from D1 the Appellant has argued that the problem addressed by the patent in suit does not stem from the fact that the returnable stationery item is sent by a mailer and is returned by an addressee, but simply relates to sorting or rerouting an item when it is under the control of a mailer. The Appellant further argued that an item of airline baggage must be somehow associated with a passenger so that the passenger can recover his baggage.

The problem portrayed by the Appellant does not appear to reflect the true objective problem addressed by the patent in suit, and as defined in point 3.2 above. According to the description of the patent in suit a business letters mailer, linked to one or more business units, provides a code identifying an addressee on a returnable stationery item included in a letter mailed to the addressee and to be returned to a specific business unit.

- Only on the basis of an ex post facto analysis, is it possible to look for logical counterparts between the purpose of the apparatus disclosed in D1 for routing airline baggage and that of the claimed letter processing apparatus. In the Board's judgement, and for the following reasons, a skilled person would not find any incentive in

the teaching of D1 to arrive at the claimed apparatus without the exercise of inventive step:

- It is questionable to liken the departure airport to a letter mailer, because an airport does not deal with an item of baggage in a manner comparable with that in which a mailer deals with a postage article. An airport registers an item of airline baggage as an article owned by an airline passenger and accompanying him. The airport is not responsible for the contents of the baggage and does not intend to establish a business relationship with an addressee by means of this baggage item. It is the passenger, not the airport, who decides whether or not to take baggage with him when he travels. Furthermore, it is the passenger, not the departure airport, who has decided his destination place and that of his baggage before the time of baggage check-in and departure.

- If the departure airport involved in the apparatus according to D1 is nevertheless seen as being the mailer, who is the addressee? It cannot be the passenger, because the passenger, as the owner of the airline baggage, flies with his baggage. Therefore, this baggage has not to be sent to him. A particular factor which has no equivalent or corresponding part in the claimed apparatus is that the passenger is present in the airport with his baggage before departure. The passenger remains in contact with the air-line, accompanies the baggage, and has the information linking him to his baggage. The passenger has to provide the information which will allow the baggage to be rerouted if necessary. After arrival at the destination airport, it is still the passenger who

has to recover his baggage by recognizing it by sight and picking it out of a stream of baggage transported on a particular conveyor belt. The arrival airport cannot be the addressee either, because the baggage is not intended to establish a business relationship between the departure airport and the arrival airport. Furthermore, the baggage does not include an item to be returned to the departure airport by the arrival airport.

- The serial number of the label attached to the baggage item cannot be regarded as a code identifying the addressee. According to D1 (column 4, lines 54 to 57; column 7, lines 50 to 58) the data assigned to an item of airline baggage must include the airline, destination and flight number of all flights to be taken by the baggage. Even if, as contended by the Appellant (see grounds of appeal, page 4, last paragraph), a duplicate copy of these data is given to the passenger owner of this item of baggage, D1 neither discloses nor suggests that such data allow an identification of the passenger without his cooperation. If, as further contended by the Appellant, different passengers are allotted different serial numbers, it is not disclosed in D1 that each passenger is identified by the serial number(s) attached to his item(s) of baggage.

- In D1 it is stated: "At any point of time, any one serial number can only be attached to one baggage article still being within the airline system" (see D1, column 2, lines 66 to 68). This means that the usefulness of this serial number normally expires at the time the baggage article arrives at its final destination and is recovered by its owner. The serial number is of no use after this

time and it is only with hindsight that it could be argued that it could be employed as information for returning the label, or any article, back to the departure airport, whatever the reason for this could be, followed by returning the label or article to a selected location on its return to the departure airport. This contrasts strongly with the identification information included in the returnable item of the claimed apparatus, because this information is of long lasting significance and is specifically intended to be used at any time after the letter and its returnable stationery item have been sent to the addressee, in particular on return of the item to the mailer.

- Even if the departure airport were supposed, for the sake of argument, to be the mailer and the passenger to be the customer or addressee, there is absolutely no disclosure or implication in D1 of a returnable item as defined in claim 1 of the patent in suit. Such a returnable item would serve no purpose in the system of D1. An airline company does not code a label attached to the baggage item of a passenger in the expectation to get the label or the item back from the passenger. D1 does not in any way consider the return journey of a baggage item, or of the label attached to it.
  
- Although D1 discloses that the code attached to an item of baggage includes routing information fields for all destination and transfer points, it neither explicitly nor implicitly suggests that means are provided for amending the destination data and/or maintaining the link between the item of baggage and its owner, nor that this item of baggage can be identified as being returned to the

airline company by its owner. Since the itinerary of an aeroplane flying to its destination place obviously cannot be changed simply because a baggage item ought to be deplaned, it is clear that this item cannot be rerouted before it has arrived at the originally desired destination place (see D1, column 8, section "INPUT OF DATA FOR DEPLANING BAGS"). Rerouting the baggage would in any case require attaching a new label to the baggage, not just changing a list stored in the computer. In D1, there is no disclosure of or need for means for changing a dispositive data listing being such that the programming of computer means to associate a code identifying an addressee with said data may be effected at a time and, if desired, at a location distinct from the time and location of sending of a returnable item from this addressee to the departure airport, said returnable item having previously be included in an airline parcel sent by said departure airport to said addressee.

4.2 The observations made above also apply to the apparatus for sorting postal parcels as described in D1. The idea of amending the destination data of a return item sent by an addressee on receipt of a postal parcel including this item cannot be derived from D1.

4.3 To support the argument that the subject-matter of claim 1 of the patent in suit was not inventive, the Appellant has formulated an oversimplified, artificial technical problem not reflecting the true objective problem to be solved. No tenable reason has been offered as to why a person skilled in the art would have considered the teaching of D1 which does not relate to the true objective problem addressed by the patent in suit. Nor have any arguments been submitted

showing that this subject-matter was obvious with regard to a combination of the disclosure of D1 and the prior art cited in the description of the patent in suit.

In the Board's judgement, the combination of features recited in claim 1 cannot be derived by a skilled person in an obvious way from the teaching of D1.

4.4 D5 has been cited by the Appellant for the first time in the grounds of appeal. This document concerns a method for conveying and routing baggage on pallets having designations identifying them as well as the destination places to which the individual baggage items have to be delivered. Nothing in D5 suggests that a particular baggage item on a particular pallet might be provided with any information identifying its owner, or to be returned by the owner. The Board considers this document to be of no relevance to the field to which the claimed letter processing apparatus belongs and thus not in any way prejudicial to the inventive step of the claimed invention.

The Board agrees with the Opposition Division that the prior art disclosed by documents D2, D3 and D4 does not go beyond the prior art already acknowledged in the patent in suit.


4.5 In conclusion, the subject-matter of claim 1 of the granted patent involves an inventive step within the meaning of Article 56 EPC and the patent in suit may be maintained with this claim. The same applies to claims 2 to 16, which are properly dependent on claim 1.

**Order**

**For these reasons it is decided that:**

The appeal is dismissed.

The Registrar:



M. Kiehl

The Chairman:



W. J. L. Wheeler