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D E C I S I O N
of 22 November 2001

Case Number: T 0526/99 - 3.5.2

Application Number: 92400079.7

Publication Number: 0495702

IPC: G07B 17/02

Language of the proceedings: EN

Title of invention:
Multimode postage scale

Patentee:
NEOPOST INDUSTRIE

Opponent:
Pitney Bowes, Inc.

Headword:

-

Relevant legal provisions:
EPC Art. 52(2)(c), 54, 56

Keyword:
"Alleged public prior use - not proved"
"Novelty (yes)"
"Inventive step (yes)"
"Dependent claim, method of doing business (no)"

Decisions cited:
T 0328/87, T 0093/89, T 0472/92, T 0782/92

Catchword:

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Case Number: T 0526/99 - 3.5.2

D E C I S I O N
of the Technical Board of Appeal 3.5.2
of 22 November 2001

Appellant: Pitney Bowes, Inc.
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Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 16 March 1999
rejecting the opposition filed against European
patent No. 0 495 702 pursuant to Article 102(2)
EPC.

Composition of the Board:

Chairman: W. J. L. Wheeler
Members: M. Ruggiu
P. Muehlens

Summary of Facts and Submissions

I. The opponent appealed the decision of the opposition division rejecting the opposition filed against European patent No. 0 495 702.

II. The appellant referred to the following prior art documents:

D1: US-A-4 864 521 and

D3: US-A-4 742 878,

and to an alleged prior use.

In order to prove that prior use had taken place publicly, the appellant relied on an affidavit dated 30 August 2001 subscribed by a manager of the appellant, to which the following exhibits were attached:

exhibit 1, graphs showing the number of LMS-70 electronic mailing scales sold in the period from 1986 up to 1990, and their value in dollars;

exhibit 2, listing of customers that bought and received LMS-70 electronic mailing scales in the periods September to December 1986 and November to December 1990;

exhibit 3, fax of 27 September 1989 sent by the Toledo Scale Corporation to the appellant and relating to LMS product specifications for new manual ranging enhancements;

exhibit 4, certificate of conformance issued on 2 October 1990 to the appellant for a postal weight classifier model A 610 and optional models A570 and A530; and

exhibit 5, customer operating guide for an LMS-70 Model A570 scale.

III. Oral proceedings were held on 22 November 2001.

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

The respondent requested that the appeal be dismissed, or that the patent be maintained in amended form on the basis of first, second or third auxiliary requests that had been filed with a letter of 10 October 2001.

IV. The patent in suit as granted includes two independent claims which read as follows:

"1. A system for determining a weight of an article to be mailed within a plurality of weight ranges comprising a scale (16) and processing means (10) having an output indicating said weight of an article to be mailed and connected to an output of said scale, said processing means having at least a first and a second mode of operation, characterized in that the system further comprises input means (12) to select by the user, for each of the plurality of weight ranges, a first variation in weight, i.e. a first weight increment or a first tolerance in the first mode of operation or a second variation in weight, i.e. a second weight increment or a second tolerance, which is more precise than the first variation in weight, in the

second mode of operation."

"11. A method of indicating the weight of an article within a plurality of weight ranges in a postage system comprising the steps of:

(a) weighing an article to be mailed;

(b) inputting, for each of the plurality of weight ranges, a desired mode from a selection of at least a first mode corresponding to a first variation in weight, i.e. a first weight increment or a first tolerance and a second mode corresponding to a second variation in weight, i.e. a second weight increment or a second tolerance, which is more precise than the first variation in weight;

(c) outputting said weight from a processing means in said selected variation in weight for issuance of postage."

Claims 2 to 10 and 12 to 20 of the patent in suit as granted are dependent on claim 1 or 11 respectively.

V. The arguments of the appellant can be summarised as follows:

Exhibit 3 showed that, before the priority date of the patent in suit, the appellant envisaged providing the LMS-70 scales described in exhibit 5 with an enhancement including dual manual ranging. It was in the interest of the appellant to introduce this option as soon as possible. As soon as the certificate of conformance (exhibit 4) had been obtained, urgent steps were taken to incorporate the enhancement in the

subsequently manufactured units, so that from or shortly after the date of the certificate newly manufactured LMS-70 units were provided with the enhancement described in exhibit 3. Exhibit 2 showed that over 100 units were installed at customers' premises between 15 November 1990 and 31 December 1990 and it was the recollection and belief of the manager of the appellant that had subscribed and sworn the affidavit that at least a proportion of these units would have been provided with the enhancement. Furthermore, once the certificate of conformance had been issued, owners of LMS-70 scales were provided with an up-dated set-up calibration PROM card along with a "change range" decal to enable their mailing scales to be modified to incorporate the enhancement. Thus, much circumstantial evidence of prior use was available and, on the balance of probabilities, it had to be accepted that public prior use had taken place.

The enhancement described in exhibit 3 took away the novelty of the independent claims of the patent in suit. User selection of weighing tolerance across the full range of the scale was a feature of the LMS-70 scale.

As regards prior art document D1, the system described therein included a scale, processing means and a switch for selection of either a high or a low range mode of operation. In the preferred embodiment of D1, the low range mode of operation extended from 0 to 10 pounds and the high range mode from 0 to 100 pounds. The weight of an article to be mailed had to be determined with an accuracy of 1/20 of an ounce between 0 and 50 ounces and with an accuracy of 1/10 of an ounce between 50 ounces and 10 pounds when operating in the

low range mode. On the other hand, in the high range mode of operation, weight had to be determined with an accuracy of 1/2 ounce below 500 ounces and with an accuracy of 1 ounce between 500 ounces and 100 pounds. Thus, between 0 and 10 pounds, the switch allowed a user to select a first tolerance or a second tolerance in a multiplicity of weight ranges. Although D1 indicated that, in the high range mode, the display of rate information and charge were inhibited when the output of the load cell was below a threshold such as 1 to 5% of the full range, it also indicated that in this case "raw" weight data might still be displayed. 1% of the full high range corresponded to 1 pound and, since the step in accuracy for the low range was located at 50 ounces, it was possible to select the accuracy in a plurality of ranges also in the case where the lower portion of the high range was inhibited. Since claim 1 of the patent in suit did not clearly require that accuracy be selectable in every range of the scale, its subject-matter lacked novelty. If claim 1 was construed as meaning that the input means permitted selection of the accuracy in every range of the scale, its subject-matter did not involve an inventive step because Figure 3A of D1 suggested extending the higher limit of the low range to the full range of the scale.

Claim 11 defined a method having features corresponding to those of claim 1. Therefore, the subject-matter of claim 11 also lacked novelty or did not involve an inventive step.

Dependent claims 2 and 12 were both fully anticipated by D1. Claims 3 and 13 were anticipated by mode 2 of the LMS-70 scale. The features of dependent claims 3

and 4, and 13 and 14, were also obvious in view of D3. Dependent claims 5 and 15 lacked novelty in view of exhibit 4. Further claims 5 and 15 were at least obvious because postage scales had in any case to conform to regulatory standards and conformance to such standards was anticipated by D1. Furthermore claims 5 and 15 were in contravention of Article 52(2)(c) EPC, reciting no more than a scheme, rule or method for doing business. Dependent claims 6 to 10 and 16 to 20 were also objectionable under Article 52(2)(c) EPC, as the specific values chosen for the first and second weight increments had no technical effect, being rules for doing business fully determined by commercial and regulatory considerations.

VI. The respondent essentially argued as follows:

No convincing evidence had been provided that the prior use had taken place before the priority date of the patent in suit. A strong probability was not sufficient in the circumstances. Furthermore, no clear evidence had been provided that the machine of the prior use had all the features of claim 1. In particular, the alleged prior use did not allow selection between two weight increments in the full weight range of the system and thus did not take away the novelty of claim 1.

Claim 1 of the patent in suit defined a system in which a first or a second variation in weight could be selected in every weight range of the system. The low and high ranges of D1 complemented each other to provide the full weight range of the system. Thus, the low and high ranges of D1 could not coincide and there was necessarily a zone where they did not overlap in which no user selection between two weight increments

was possible.

As the subject-matter of the independent claims was manifestly not excluded from patentability, the same had to be true for the subject-matter of the dependent claims, which incorporated the patentable features of the independent claims.

Reasons for the Decision

1. The appeal is admissible.
2. *Alleged prior use*
 - 2.1 According to established case law of the boards of appeal, an alleged public prior use is only adequately substantiated if specific details are given of what was made available to the public, where, when, how and by whom, see *inter alia* decisions T 328/87 (OJ 1992, 701) and T 93/89 (OJ 1992, 718). Once substantiated, the public prior use has to be proved beyond any reasonable doubt by the opponent, see *inter alia* decisions T 472/92 (OJ 1998,161) and T 782/92, T 97/94 (OJ 1998,467), for little, if any, evidence would be available to the patentee to show that no public prior use had taken place. If, as in the present case, only circumstantial facts and evidence are submitted, these must be proved and be such as to enable the board to regard the public prior use as established.
 - 2.2 In the present case, the appellant submits that LMS-70 mailing scales provided with a manual ranging function described in exhibit 3 were manufactured and sold before the priority date of the patent in suit.

However, he has not provided details of the circumstances of the sales. The appellant, being unable to substantiate and prove the prior use as such, has provided circumstantial evidence relating to it. In this context, he submits that the LMS-70 mailing scale was marketed long before the priority date, that it had been enhanced by adding the dual manual ranging function, that this enhancement obtained regulatory approval on 2 October 1990 as shown in exhibit 4, and that the enhanced mailing scale was sold "from or shortly after" this date. To support these allegations, the appellant relies on the affidavit, according to which it is the "recollection and belief" of the manager subscribing the affidavit that "at least a portion" of the units sold before the priority date were provided with the enhancement.

2.3 In view of the affidavit, the board considers that it is possible that the enhancement described in exhibit 3 was incorporated as soon as possible in the mailing scales manufactured after 2 October 1990. However, there is no evidence of a sale to a customer before the priority date of the patent in suit, which was only about three months after the issue of the certificate of conformance. As three months is a rather short period in which to manufacture scales incorporating the enhancement, sell them and ship them to customers, the board is not satisfied beyond any reasonable doubt that a scale incorporating the enhancement reached a customer before the priority date of the patent in suit. Thus, the board has come to the conclusion that public prior use before the priority date is not established.

3. *Novelty and inventive step*

3.1 Document D1 discloses a system for determining the weight of an article to be mailed, comprising a scale and processing means connected to an output of said scale. The processing means has an output for indicating the weight of the article on a display. Input means in the form of a switch is provided to allow selection by a user of either a first, so-called high-range, mode of operation or a second, so-called low range, mode of operation. The low range mode of operation extends in the particular example described in D1 from 0 up to 10 pounds and the high range mode of operation from 1 to 5 pounds up to 100 pounds. In the low-range mode of operation, the weight of the article is indicated on the display with a first increment equal to 1/10 of an ounce. In the high-range mode of operation, the weight is indicated with a second increment equal to 1 ounce. Thus, the first increment is more precise than the second increment and, in the zone where the high and low ranges overlap, the user can select whether the weight of an article should be displayed with an accuracy corresponding to the first increment or the second increment. However, the system of D1 does not permit user selection between two different accuracies in all ranges in which the weight of an article to be mailed can be determined.

3.2 Claim 1 of the patent in suit as granted recites that the system claimed is "for determining a weight of an article to be mailed within a plurality of weight ranges". The board considers that this wording means that the "plurality of weight ranges" covers the full range for which the system is suitable for weighing an article. As a consequence, the feature of claim 1: "input means (12) to select by the user, for each of the plurality of weight ranges," a first or a second

variation in weight, means that the selection must be possible over the full weight range of the system. This feature is not present in the system of D1.

3.3 Figures 3A and 3B of D1 illustrate requirements on the accuracy of the weight indication that should be met by the system, but do not represent actual features of the system. In the system of D1, only one weight range (the overlap zone between the low and high ranges) can be found, in which the user can select to display the weight with the accuracy of the first or the second increment in weight. Thus, the feature of claim 1 that the selection is possible in each of a plurality of weight ranges is not present in the system of D1.

3.4 The high range mode of D1 is for weighing relatively heavy articles whereas the low range mode is for weighing relatively light articles. Therefore, no motivation exists for the skilled person to modify the system of D1 so that the low and high ranges are coextensive.

3.5 For the above reasons, the board has come to the conclusion that the subject-matter of claim 1 is to be considered to be new in the sense of Article 54(1) EPC and as involving an inventive step in the sense of Article 56 EPC.

3.6 The independent claim 11 is a method claim whose features correspond to those of claim 1. Thus the board considers that the subject-matter of claim 11 is to be considered as new and involving an inventive step for analogous reasons.

3.7 In view of the conclusion reached in respect of the

- independent claims, the subject-matter of the dependent claims must also be regarded as new and involving an inventive step.
4. Furthermore, the subject-matter of claims 5 to 10 and 15 to 20, which are dependent on independent claims 1 and 11 respectively, cannot be regarded as a scheme, rule or method of doing business as such according to Article 52(2)(c) and (3) EPC, because the subject-matter of the independent claims, which is included by reference in the dependent claims, is itself an invention within the meaning of Article 52(1) EPC, which is novel and involves an inventive step. This is not destroyed by an additional feature recited in the dependent claims, even if this additional feature, regarded in isolation, relates to a method of doing business.
 5. Since, for the above reasons, the board judges that the grounds for opposition do not prejudice the maintenance of the patent unamended and thus is in a position to accept the main request of the respondent, there is no need to examine the auxiliary requests.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:

M. Hörnell

W. J. L. Wheeler