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**D E C I S I O N**  
**of 2 September 2005**

**Case Number:** T 0373/03 - 3.4.01

**Application Number:** 96202805.6

**Publication Number:** 0768538

**IPC:** G01R 31/3185

**Language of the proceedings:** EN

**Title of invention:**

Method and tester for applying a pulse trigger to a unit to be triggered

**Patentee:**

Itag Technologies B.V.

**Opponent:**

Firma Göpel electronic GmbH

**Headword:**

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**Relevant legal provisions:**

EPC Art. 54(2), 111(1)

**Keyword:**

"Uncertain publication date of relevant document (yes) "  
"Remittal to first instance"

**Decisions cited:**

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**Catchword:**

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Case Number: T 0373/03 - 3.4.01

**D E C I S I O N**  
of the Technical Board of Appeal 3.4.01  
of 2 September 2005

**Appellant:** Itag Technologies B.V.  
(Proprietor of the patent) Boschdijk 50  
NL-5602 AN Eindhoven (NL)

**Representative:** Van kan, Johan Joseph Hubert, Jr.  
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**Respondent:** Firma Göpel electronic GmbH  
(Opponent) Göschwitzer Strasse 58/60  
D-07745 Jena (DE)

**Representative:** Boon, Stephan E.  
Müller, Boon, Dersch  
Rechtsanwälte  
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**Decision under appeal:** Interlocutory decision of the Opposition  
Division of the European Patent Office posted  
10 January 2003 concerning maintenance of  
European patent No. 0768538 in amended form.

**Composition of the Board:**

**Chairman:** B. Schachenmann  
**Members:** M. Rognoni  
G. Assi

## Summary of Facts and Submissions

- I. The appellant (patent proprietor) lodged an appeal against the decision of the opposition division, dispatched on 10 January 2003, maintaining the European patent No. 0 768 538 in amended form. The notice of appeal was received on 20 March 2003 and the appeal fee was paid on the same day. The statement setting out the grounds of appeal was received on 20 May 2003.
- II. The opposition, filed against the patent as a whole, was based on Article 100(a) EPC and substantiated on the grounds of lack of novelty and lack of inventive step (Articles 52(1), 54 and 56 EPC).

In the decision under appeal, the opposition division held, *inter alia*, that the subject-matter of claim 1 of the patent as granted was not new over the following document:

D18: Hays D. et al.: "*Programming Flash Memory through the Intel386™ EX Embedded Microprocessor JTAG Port*"  
Intel Application Note AP-720 dated 8 August 1995.

On the other hand, the subject matter of claim 1 of the first auxiliary request was considered not to involve an inventive step with respect to D18, while the second auxiliary request was not admitted into the opposition proceedings. The opposition division, however, decided that the patent amended according to the third auxiliary request met the requirements of the EPC.

III. In appeal proceedings, in reply to the appellant's contention that D18 had not been published before the priority date of the patent in suit, the respondent (opponent) submitted the following documents with a letter dated the 29 September 2003:

D22: About Search Adobe PDF Online  
<http://searchpdf.adobe.com/proxies/1/74/13/78.html>)

D23: Search Adobe PDF Online: AP-720  
<http://searchpdf.adobe.com/about/about.html>)

IV. Oral proceedings were held on 2 September 2005.

V. The appellant requested that the decision under appeal be set aside and the patent be maintained as granted, or that the decision under appeal be set aside and the patent be maintained in amended form in accordance with the first and second auxiliary requests, respectively, rejected in the decision under appeal.

VI. The respondent requested that the appeal be dismissed.

VII. The appellant's arguments can be summarised as follows:

The date, August 8, 1995, on the front page of application note D18 represented the date of completion of this document by the author, *i.e.* the "author date", and not the publication date. As the respondent failed to provide any evidence for the alleged publication of D18 before the priority date of the contested patent (13 October 1995), this document was not part of the state of the art within the meaning of Article 54(2) EPC and should thus be disregarded.

VIII. The respondent argued essentially as follows:

D23 showed that application note D18 had been converted into a PDF file on 10 August 1995 and was available for download from a website of the Intel Corporation. As there was no plausible reason for converting an application note directed to the users of a particular product into the PDF format long before making it publicly available as a downloadable file, there could be no reasonable doubt that this document had been available to the public on 10 August 1995, *i.e.* well before the priority date of the contested patent.

Furthermore, it was evident that D18 contained information which was meant to be distributed to Intel clients as soon as it became available. In fact, D18 referred to the possibility of receiving application notes, documents relating to the same processor, and files of the source code, executable programs and schematics for a certain application of an Intel processor. Some of these files, attached to D18 as appendix A and appendix B, bore dates well before the priority date of the contested patent. There would have been no reason for the Intel Corporation to withhold such information from the users of its products. On the contrary, it was implicit that it would have been in the interest of the Intel Corporation to make such information accessible to all potential users as soon as it became available. Thus, in the light of both direct and circumstantial evidence, it could only be concluded that D18 had been made available to the public before the priority date of the contested patent

and thus was part of the state of the art relevant for assessing the patentability of the contested patent.

### **Reasons for the Decision**

1. The appeal is admissible.
  
- 2.1 Document D18, which was filed by the opponent after expiration of the opposition period (*i.e.* with a letter dated 15 March 2002), is an application note of the Intel Corporation. On its front page, it bears the date "August 8, 1995".
  
- 2.2 As set out in the contested decision, the patent proprietor questioned during the oral proceedings before the opposition division whether D18 had been made available to the public on the date indicated on its front page and presented copies from the Internet site of "ChipCentre QUESTLINK" showing that the date on the front page of three different Intel publications did not necessarily coincide with the dates on which these publications had been made available by "ChipCentre QUESTLINK". For document D18 "ChipCentre QUESTLINK" indicated 22 September 1997 as "*file data*", *i.e.* almost two years after the priority date (13 October 1995) of the contested patent.

As specified in the contested decision, the opponent stated that according to information obtained from an American company ("CORELIS"), with which they had cooperated since about 1989, D18 had indeed been available to the public as from the date indicated on its front page (8 August 1995), *i.e.* more than two

months before the priority date of the patent in suit. However, no written evidence was submitted by the opponent to the opposition division in order to substantiate this allegation.

2.3 The opposition division decided to refuse the patent proprietor's request to consider D18 as late published: "In view of the fact that the proprietor's argument to the publication date was raised at such a late stage at which his objection could not be investigated by the opposition division and in view of the opponent's assertion" (contested decision, page 6, item 4 c).

3.1 Document D23 is the only evidence submitted by the respondent in support of its allegation that D18 had been published before the priority date of the contested patent.

D23 is a copy of the result of a "Search Adobe PDF Online" made by the respondent on 25 August 2003. It relates to the Intel application note AP-720, corresponding to D18, and indicates a date ("1995-08-10"), a time ("15:27:37") and an Internet link of the Intel Corporation for downloading the application note AP-720 in PDF format.

3.2 According to the respondent, the date printed on the front page of D23 was the date on which the corresponding application note (*i.e.* D18) had been made available to the public by converting it into the PDF format and storing it on a server accessible via the provided link.

3.3 The Board agrees with the respondent that the date and time given in D23 are likely to indicate when the corresponding PDF file was created. The information provided by D23, however, is not sufficient to prove beyond reasonable doubt that, immediately after its creation, the corresponding PDF file was stored on an Intel server freely accessible to the general public. In fact, on the basis of the direct evidence provided by the parties it can only be concluded that a PDF file corresponding to D18 was made available by "ChipCentre QUESTLINK" on 22 September 1997.

In other words, it is only possible to infer from D23 that D18 is likely to have been converted into a PDF file on 10 August 1995 at 15h, 27m 37s, and that on 25 August 2003, the date of the respondent's online search, the Intel application note AP-720 could be downloaded as a PDF file from the Intel web site via the provided Internet link.

As to document D22, it is merely a short description of the service provided by "Search Adobe PDF Online" which, according to the copyright mark, appears to have been set up in 1999.

3.4 As to the respondent's further argument that, as an application note, D18 was a document essentially meant for any interested user and that, as such, it could be expected to have been published immediately after its completion by the author on 8 August 1995, the Board has no doubt that D18 was indeed meant for publication. However, there is no direct evidence that this document was actually made available to the public before the priority date of the contested patent which was just two months after the "author date".



3.5 In summary, the Board considers that the respondent has failed to provide any direct evidence as to the publication date of D18, and that doubts remain as to whether and in which form this document was actually available to the public before the priority date of the contested patent. Thus, D18 has not been proven to belong to the prior art within the meaning of Article 54(2) EPC, and all conclusions reached by the opposition division on the basis of this document must be set aside.

4. In reply to the appeal filed by the patent proprietor, the respondent maintained, *inter alia*, the lack of novelty objection with respect to documents D3 to D16 and D17 to D21 already raised in the opposition proceedings. These documents, however, were not considered in the contested decision. In order to give the parties the possibility of defending their case before two instances, the Board decides to exercise its discretion under Article 111(1) EPC and to refer the case back to the opposition division for further prosecution.

**Order**

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

1. The decision under appeal is set aside.
2. The case is remitted to the first instance for further prosecution.

The Registrar:

The Chairman:

R. Schumacher

B. J. Schachenmann