

BESCHWERDEKAMMERN
DES EUROPÄISCHEN
PATENTAMTS

BOARDS OF APPEAL OF
THE EUROPEAN PATENT
OFFICE

CHAMBRES DE RECOURS
DE L'OFFICE EUROPEEN
DES BREVETS

Internal distribution code:

- (A) Publication in OJ
(B) To Chairmen and Members
(C) To Chairmen
(D) No distribution

**Datasheet for the decision
of 22 November 2011**

Case Number: T 1596/10 - 3.5.06

Application Number: 05256100.8

Publication Number: 1653321

IPC: G06F 1/00

Language of the proceedings: EN

Title of invention:

Method and apparatus for software integrity protection using
timed executable agents

Applicant:

LUCENT TECHNOLOGIES INC.

Headword:

Software Integrity/LUCENT

Relevant legal provisions (EPC 1973):

EPC Art. 54(1)(2), 89



Case Number: T 1596/10 - 3.5.06

D E C I S I O N
of the Technical Board of Appeal 3.5.06
of 22 November 2011

Appellant: LUCENT TECHNOLOGIES INC.
600 Mountain Avenue
Murray Hill
NJ 07974-0636 (US)

Representative: Sarup, David Alexander
Alcatel-Lucent Telecom Limited
Unit 18, Core 3, Workzone
Innova Business Park
Electric Avenue
Enfield EN3 7XU (GB)

Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 16 February 2010
refusing European patent application
No. 05256100.8 pursuant to Article 97(2) EPC.

Composition of the Board:

Chairman: D. H. Rees
Members: M. Müller
C. Heath

Summary of Facts and Submissions

I. The appeal lies against the decision of the examining division to refuse the European patent application 05256100.8 which was dispatched with letter of 16 February 2010.

II. The refusal refers *inter alia* to the documents

D5: M. Shaneck *et al.*, "Remote Software-Based Attestation for Wireless Sensors", European Workshop on Security and Privacy in Ad Hoc and Sensor Networks, Springer-Verlag, LNCS 3813, pp. 27-41, 2005

D6: R. Kennell *et al.*, "Establishing the Genuinity of Remote Computer Systems", Proc. 12th USENIX Security Symposium, The Usenix Association, pp. 295-310, 2003,

and comes to the conclusion that all claims lack novelty over D5. In a section entitled "further remarks" that is not part of the reasons for the decision, it is mentioned, without further detail, that claims 1-7 also appear not to meet the requirements of novelty and inventive step in view of D6.

III. A notice of appeal was received on 8 April 2010 and the appeal fee was paid on the same day. A statement of grounds of appeal was received on 16 June 2010. It was requested that the decision under appeal be set aside and (implicitly) that a patent be granted based on the description and the claims currently on file, arguing that the independent claims were novel over D5 as well as over the other prior art documents on file.

- IV. In a communication the board expressed its preliminary opinion on the substance of the appeal. In a response by telefax of 15 June 2011, the appellant filed amended claims 1-7 as an auxiliary request.

- V. With letter of 18 July 2011 the board informed the appellant that it had noticed that D5 did not constitute prior art for the present application and that therefore it intended to set aside the decision and remit the application to the examining division for further prosecution. By telefax of 1 September 2011, the appellant agreed to this course of action.

Reasons for the Decision

- 1. The application was filed on 29 September 2005 and claims the priority right of U.S. Patent Application No. 10/976,353 filed on 27 October 2004.

- 1.1 The validity of the claimed priority was neither disputed during the examination procedure, nor has the board occasion to doubt it, especially since the description and the drawings of the application as originally filed and those of the priority document are substantively identical and the claims of the application as originally filed are identical to claims of the priority document.

- 1.2 Thus according to Article 89 EPC 1973 the date of priority shall count as the date of filing for the purpose of Article 54(2) EPC 1973.

- 1.3 Document D5 is contained in volume 3813 of the Lecture Notes in Computer Science series (LNCS 3813) which was published in 2005. According to its title page, this book contains revised versions of selected papers presented at a workshop (ESAS 2005) which itself had taken place in July 2005.
- 1.4 Therefore D5 was not made available to the public before the date of priority, does not belong to the state of the art for the application, Article 54(2) and 89 EPC 1973, and cannot support the conclusion that the claims lack novelty, Article 54(1) EPC 1973.
2. The impugned decision cites six documents from the prior art but the body of the decision only mentions D5 and D6.
 - 2.1 Furthermore, the reasons for the decision rely exclusively on D5.
 - 2.2. The only reference to document D6 is made in a section entitled "Further remarks" which does not constitute part of the reasons for the decision. This section contains the statement (see point 2) that "[t]he subject-matter of claims 1-7 further appears not to meet the requirements of novelty and inventive step in view of D6" but no reasoning that would lead to this conclusion. The board adds that also the communications of the examining division are limited to similar brief statements without reasons (see the communication dated 13 February 2009, point 2.6, and the summons to oral proceedings dated 18 November 2009, point 1.8). The board has to conclude that D6 was never actually discussed with the applicant.

2.3 Hence the decision under appeal contains no reasons which could support the refusal of the application and thus has to be set aside.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The application is remitted to the examining division for further prosecution.

The registrar:

The Chairman:

B. Atienza Vivancos

D. H. Rees