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D E C I S I O N
of 13 May 1996

Case Number: T 0691/94 - 3.5.2

Application Number: 89310266.5

Publication Number: 0366294

IPC: H03K 19/0175

Language of the proceedings: EN

Title of invention:
TTL-ECL level converting circuit

Applicant:
NEC CORPORATION

Opponent:
-

Headword:
-

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

Keyword:
"Inventive step (not objectively assessed)"
"Appellant resiled from previous acknowledgement of "prior art"
in the application"

Decisions cited:
T 0248/85, T 0654/92

Headnote/Catchword:
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Boards of Appeal

Chambres de recours

Case Number: T 0691/94 - 3.5.2

D E C I S I O N
of the Technical Board of Appeal 3.5.2
of 13 May 1996

Appellant: NEC CORPORATION
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Minato-ku
Tokyo (JP)

Representative: Abnett, Richard Charles
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London WC1X 8PL (GB)

Decision under appeal: Decision of the Examining Division of the European
Patent Office posted 15 March 1994 refusing
European patent application No. 89 310 266.5
pursuant to Article 97(1) EPC.

Composition of the Board:

Chairman: W. J. L. Wheeler
Members: R. G. O'Connell
B. J. Schachenmann

Summary of Facts and Submissions

I. The appellant contests the decision of the examining division refusing European patent application No. 89 310 266.5. The reason given for the refusal was that the subject-matter of claim 1 did not involve an inventive step, having regard to matter designated in the application as "prior art" and common general knowledge in the art. As evidence of the latter the following documents were referred to in the decision under appeal:

D1: M. HERPY "Analoge Integrierte Schaltungen" 1979, Franzis Verlag, München, page 251;

D2: E. KÜHN "Handbuch TTL- und CMOS-Schaltkreise" 1985, VEB Verlag Technik, Berlin, pages 317 and 320.

II. The appellant argued essentially as follows:

It had not been established that the circuit of figure 1 of the present application was in fact prior art within the meaning of Article 54 EPC. The appellant wished to amend the description and figure heading to indicate that the circuit was neither "conventional" nor "prior art", but merely "proposed". On that basis the refusal would be entirely inappropriate.

The appellant also presented detailed arguments as to why the claimed circuit was inventive over the circuit of figure 1.

- III. The appellant requested that the decision under appeal be set aside and a patent granted on the basis of the application as refused, subject to amendment of the description and drawings to indicate the status of the figure 1 circuit as "proposed", rather than "prior art".

Reasons for the Decision

1. The appeal is admissible.
2. *State of the art*
 - 2.1 The issue in this appeal is inventive step. As always, a critical preliminary step in addressing this question is the determination of the relevant "state of the art", with a view to identifying a closest prior art. Following decisions T 248/85, OJ EPO 1986, 261 (points 9.1 and 9.2) and T 654/92 of 3 May 1994 (points 4.2 and 4.3), the board rules that the matter illustrated by and described in connection with figure 1 of the present application is not comprised in the state of the art for the purposes of Article 56 EPC since there is no evidence before the board that this art was made available to the public as required by Article 54(2) EPC.
 - 2.2 In its reasoning in the decision under appeal the examining division relied on the applicant's own acknowledgement as such evidence. Since, however, the applicant has now, in the statement of grounds of appeal, resiled from this acknowledgement, and since this internal prior art was the only "state of the art" considered in the impugned decision - apart from ancillary evidence of common general knowledge in the

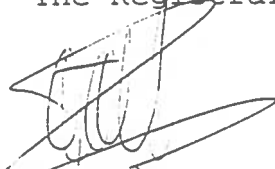
art - the first instance finding of lack of inventive step has been deprived of its essential basis. In effect the examination required by Article 94(1) EPC has not yet taken place as far as an objective assessment of novelty and inventive step is concerned. In these circumstances, in order to avoid loss of an instance, the case has to be remitted to the department of first instance for examination on the basis of the relevant state of the art within the meaning of Article 54 EPC.

Order

For these reasons it is decided that:

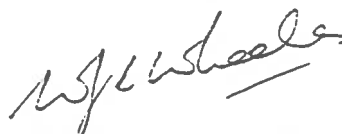
1. The decision under appeal is set aside.
2. The case is remitted to the department of first instance for further prosecution.

The Registrar:



M. Kiehl

The Chairman:



W. J. L. Wheeler

