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) [X] No distribution

D E C I S I O N
of 15 September 2004

Case Number: T 0935/03 - 3.2.7

Application Number: 98934193.8

Publication Number: 0990059

IPC: C23C 16/00

Language of the proceedings: EN

Title of invention:
Low temperature chemical vapor deposition process for forming bismuth-containing ceramic thin films useful in ferroelectric memory devices

Applicant:
ADVANCED TECHNOLOGY MATERIALS, INC., et al

Opponent:
-

Headword:
-

Relevant legal provisions:
EPC Art. 109, 111(1)
EPC R. 67

Keyword:
"Interlocutory revision - reimbursement of appeal fee (no) - remittal to the first instance"

Decisions cited:
T 0794/95

Catchword:
-

Europäisches Patentamt | European Patent Office | Office européen des brevets

Beschwerdekammern | Boards of Appeal | Chambres de recours

Case Number: T 0935/03 - 3.2.7

D E C I S I O N
of the Technical Board of Appeal 3.2.7
of 15 September 2004

Appellant: (Applicant)
ADVANCED TECHNOLOGY MATERIALS, INC.
7 Commerce Drive
Danbury, CT 06810 (US)

Representative:
Castell, Klaus, Dr.
Gutenbergstrasse 12
D-52349 Düren (DE)

Decision under appeal:
Decision of the Examining Division of the European Patent Office posted 12 May 2003 refusing European application No. 98934193.8 pursuant to Article 97(1) EPC.

Composition of the Board:

Chairman: A. Burkhart
Members: H. E. Hahn
C. Holtz

Summary of Facts and Submissions

I. With their decision of 12 May 2003 the Examining Division refused the European patent application No. 98 934 193.8.

The Examining Division held that the independent claim 7 of the set of claims 1 to 32 dated 19 September 2002 did not meet the requirements of Article 123(2) EPC.

II. On 14 July 2003 the appellant (applicant) lodged an appeal against the decision of the Examining Division requesting to set aside the decision. As an auxiliary request, oral proceedings were requested for the case that the main request could not be allowed.

III. In its statement setting out the grounds of appeal of 21 July 2003, received by the EPO on 22 July 2002, the appellant requested rectification of the decision and reimbursement of the appeal fee, and made amendments to some claims.

IV. With a communication dated 29 August 2003 the appellant was informed by the Examining Division through the first examiner that further examination had revealed that the application did not meet the requirements of the European Patent Convention. The appellant was given a time limit of 2 months to remedy certain deficiencies in the claims. This period ended on 8 November 2003.

V. On 9 September 2003 the Examining Division signed EPO Form "2701 06.01" and stated by crossing the corresponding boxes that the appeal was allowable and

well-founded and that the decision under appeal was rectified under Article 109(1) EPC, but also that the reimbursement of the appeal fee could not be allowed, so that the case should be referred to the Board of Appeal using EPO Form "2703".

VI. On 11 September 2003 the formalities officer signed EPO Form "2703 10.98" on which the box "**no rectification ordered**" was crossed.

VII. With letter of 15 September 2003 the applicant submitted amended claims.

VIII. In a communication dated 6 May 2004 the Board stated that it could not conclude that any procedural error occurred before the decision was taken to refuse the application, and that, therefore, the Board intended to reject the request for reimbursement of the appeal fee. Furthermore, the Board stated that it intended to exercise its power under Article 111(1) EPC to remit the case to the Examining Division for further prosecution. The appellant was also asked whether under these circumstances it maintained its request for oral proceedings.

IX. With a fax of 7 July 2004 the appellant withdrew its requests for oral proceedings and for reimbursement of the appeal fee.

Reasons for the Decision

1. *Decision of the Examining Division to rectify its decision*

1.1 On 9 September 2003 the Examining Division signed EPO Form "2701 06.01" and stated by crossing the corresponding boxes that the appeal was allowable and well-founded and that the decision under appeal was rectified under Article 109(1) EPC, but also that the reimbursement of the appeal fee could not be allowed, so that the case should be referred to the Board of Appeal using EPO Form "2703".

1.2 However, on 11 September 2003 the formalities officer stated on EPO Form "2703 10.98" "Remittal: **no rectification ordered**". The file was then sent to Directorate General 3.

1.3 Since the appeal is against the decision of the Examining Division to refuse the application, only the members of that division were competent to rectify that decision. The formalities officer was not entitled to decide that no rectification had been ordered.

The Board notes that the formalities officer may have concluded from the invitation by the Examining Division of 29 August 2003 that rectification could not be ordered, since the three month term for rectification expired on 22 October 2003, whereas the appellant pursuant to the invitation could file observations until 8 November 2003. In this situation, the formalities officer should have checked with the Examining Division which action should stand before

filling out the form and arranging for the file to be sent to Directorate General 3. This would have made the Examining Division aware of the two seemingly contradictory actions.

It is further noted that the appellant on 15 September 2003 in response to the 29 August communication filed amended claims, which would not have been necessary, had the appellant been sent the rectification form. In a letter dated 19 April 2004, the appellant also expressed his surprise that rectification had not been decided by the Examining Division.

1.4 With regard to the technical substance of the appeal, the Board finds the claims as amended with the grounds of appeal to conform with Article 123(2) EPC.

2. *Reimbursement of the appeal fee*

The request for reimbursement has been withdrawn. Nevertheless, the Board would remark that the irregularities which occurred *after* the appeal had been filed are not relevant at this stage, but might become the subject of a subsequent appeal. Reference can be made to Case law of the Boards of Appeal of the European Patent Office, 4th edition, 2001, chapter VII.D.15.5, Interlocutory revision, p.563 f., and T 794/95.

3. *Further prosecution*

Given the circumstances as described above, the Board remits the case to the first instance for further

prosecution of the examining procedure as obviously intended by the Examining Division.

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:

G. Nachtigall A. Burkhart