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**Datasheet for the decision
of 29 August 2011**

Case Number: T 0546/10 - 3.2.07

Application Number: 05012256.3

Publication Number: 1568796

IPC: C23C 14/34

Language of the proceedings: EN

Title of invention:

Manganese alloy sputtering target

Applicant:

JX Nippon Mining & Metals Corporation

Headword:

-

Relevant legal provisions:

EPC Art. 111(1)
EPC R. 111(2), 103(1) (a)

Relevant legal provisions (EPC 1973):

-

Keyword:

"Decision on the state of the file: reasoned (no)"
"Substantial procedural violations (yes)"
"Reimbursement of the appeal fee (yes)"
"Remittal to the department of first instance"

Decisions cited:

T 1309/05, T 1709/06

Catchword:

-



Case Number: T 0546/10 - 3.2.07

D E C I S I O N
of the Technical Board of Appeal 3.2.07
of 29 August 2011

Appellant: JX Nippon Mining & Metals Corporation
6-3, Otemachi 2-chome
Chiyoda-ku
Tokyo 100-8164 (JP)

Representative: Hoarton, Lloyd Douglas Charles
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Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 18 November 2009
refusing European patent application
No. 05012256.3 pursuant to Article 97(2) EPC.

Composition of the Board:

Chairman: H. Meinders
Members: H. Hahn
I. Beckedorf

Summary of Facts and Submissions

I. The applicant lodged an appeal against the decision of the Examining Division to refuse the European patent application No. 05 012 256.3 with a decision according to the state of the file.

II. With its grounds of appeal dated 2 March 2010 the appellant requested to set aside the decision and to grant a patent on the basis of the claims 1-6 of the single request filed in the examination proceedings with letter dated 9 October 2009. Furthermore, it requested a refund of the appeal fee since the Examining Division did not provide adequate reasoning in accordance with Rule 111(2) EPC so that a substantial procedural violation has occurred. As an auxiliary request oral proceedings were requested.

III. In the present decision the following documents of the examination proceedings are cited:

D1 = DE-A-198 34 437

D2 = PATENT ABSTRACTS OF JAPAN vol. 1999, no. 14,
22 December 1999 & JP 11 264070 A (JAPAN ENERGY CORP),
28 September 1999

D3 = US-A-4 131 457

Statement of Mr. Y. Nakamura dated 16 September 2009

Annex 1 = Optical micrograph of Mn-21at.%Ir alloy with
forging

Annex 2 = Optical micrograph of Mn-26at.%Ir alloy with
forging

Annex 3 = Optical micrograph of Mn-21at.%Ir alloy
without forging

Annex 4 = Optical micrograph of Mn-27at.%Ir alloy
without forging

IV. In the course of the examination proceedings the appellant, in response to the first substantive communication of the Examining Division dated 2 January 2008, filed with its letter dated 21 April 2008 an amended page 3, explained the amendment carried out and submitted arguments concerning novelty and inventive step supported by four optical micrographs of forged and cast manganese alloys (which correspond to those of annexes 1-4). It further submitted an English translation of the claims, examples and tables of the Japanese original D2. Finally, oral proceedings were requested in the event that the Examiner would be minded to refuse the application.

A summons dated 30 July 2009 to oral proceedings to be held on 12 November 2009 was issued by the Examining Division. In the second substantive communication that was annexed to that summons the Examining Division set out its opinion regarding the amended page 3 as filed with letter of 21 April 2008 and the claims 1-3 as originally filed.

With letter dated 9 October 2009 the appellant submitted replacement pages 4-6 and 14-16 of the description and an amended set of claims 1-6 and requested cancelling of pages 17 and 18 of the application. It quoted the basis for the amendment made to claim 1 and stated that the use claims 4-6 directed to the use of the forged manganese alloy sputtering target have been added. It argued in substance in favour of novelty for claim 1 and submitted as

supporting evidence a statement of a person skilled in the art (i.e. the statement of Mr. Nakamura) and four optical micrographs of cast and forged manganese alloys (i.e. annexes 1-4) in order to show that the skilled person is enabled to distinguish the microstructures of these two alternatives. In addition it asked for a telephone conversation in case that the Examiner would not be satisfied that the objections raised in the summons are overcome.

A telephone conversation between the primary examiner and the applicant's representative took place on 19 October 2009 and its result was notified to the appellant with the (third) communication dated 26 October 2009, namely that the novelty objections with respect to claims 1-3 were maintained in view of D1-D3 and that use claims 4-6 lacked novelty over D1 and D2 and the oral proceedings were therefore maintained as scheduled.

With letter dated 27 October 2009 the applicant withdrew its request for oral proceedings and further requested a written decision on the current state of the file.

With communication dated 3 November 2009 the appellant was informed that the summons to attend oral proceedings on 12 November 2009 have been cancelled and that the procedure will be continued in writing.

V. The grounds of the decision of the Examining Division dated 18 November 2009 are as follows:

"In the communication(s) dated 30.07.2009, 26.10.2009 the applicant was informed that the application does not meet the requirements of the European Patent Convention. The applicant was also informed of the reasons therein.

The applicant filed no comments or amendments in reply to the latest communication but requested a decision according to the state of the file by a letter received in due time on 27.10.2009.

The application must therefore be refused."

VI. In the grounds of appeal dated 2 March 2010 the appellant stated that a substantial procedural violation occurred because the Examining Division has not given adequate reasoning to support their decision as can be derived from the communications issued by the Examining Division and the responses submitted thereto by the appellant. The reference to the earlier communications in the decision on the state of the file is insufficient because no adequate reasoning in accordance with Rule 111(2) EPC is provided therein. Particularly the Examining Division did not comment on the lengthy argumentation and evidence filed to support the appellant's position submitted with letter of 9 October 2009 concerning novelty and inventive step of the amended claims 1-6 filed with the same letter.

On 3 March 2010 the Examining Division decided not to rectify its decision (see EPO Form 2701), with the result that the appeal was submitted to the Board.

VII. With a communication dated 31 May 2011 the Board gave its preliminary and non-binding opinion and expressed the view that the decision of the Examining Division was deficient in that it was not reasoned as required by Rule 111(2) EPC and that it intended to remit the case to that department of first instance for further prosecution and to reimburse the appeal fee. The appellant was asked whether or not it maintains its request for oral proceedings.

VIII. With letter dated 23 June 2011 the appellant withdrew its auxiliary request for oral proceedings.

Reasons for the Decision

Lack of reasoning in the decision - substantial procedural violation

1. As pointed out by the appellant in its grounds of appeal, the Examining Division failed to explain in a comprehensible manner as to why the subject-matter claimed lacks novelty over the disclosures of D1-D3 and particularly, it did not take account of the appellant's arguments with respect to the amended claims 1-6 submitted with letter dated 9 October 2009 as response to its second communication dated 30 July 2009.

1.1 The first communication of the Examining Division dated 2 January 2008 was based on claims 1-3 as originally filed.

1.1.1 The single independent claim 1 as originally filed reads as follows:

"1. A manganese alloy sputtering target for forming an antiferromagnetic film, characterized in that:
the oxygen content of the target is 1000ppm or less;
the sulphur content of the target is 200ppm or less;
the target has a single phase equiaxed grain structure with the crystal grain diameter being 500µm or less;
and
the target is provided with a forged texture."

1.1.2 In points 4.1, 4.2 and 4.3 of this communication the Examining Division raised novelty objections with respect to claim 1 in view of D1, D2 and D3, respectively, by stating: "*D1 discloses a manganese alloy sputtering target containing less than 500 ppm oxygen and less than 100 ppm sulfur (see for instance D1, examples 1-9, from p. 3, l. 20 to p. 5, l. 39; tables 1-9 on p. 7-15; claims).*

D1 does not disclose explicitly a crystal grain diameter of 500 microns or less (0.5 mm or less). However, such limit is so broad that it encompasses the usual grain size of Mn alloys.

Similarly, although forging is not disclosed in D1, it is not clear from claim 1 how much forging is performed so that this process feature cannot enable to distinguish the claimed product from the one known from D1.

Therefore, since the grain size is regarded as being implicitly disclosed in D1, the subject-matter of

claim 1 is not considered as being novel over D1 (Art. 54(1) EPC).

D2 discloses a manganese alloy sputtering target containing less than 1000 ppm oxygen and less than 300 ppm sulfur (D2, abstract).

D2 does not seem to disclose explicitly a crystal grain diameter of 500 microns or less (0.5 mm or less). However, such limit is so broad that it encompasses the usual grain size of Mn alloys.

Similarly, although forging does not seem to be disclosed in D2, it is not clear from claim 1 how much forging is performed so that this process feature cannot enable to distinguish the claimed product from the one known from D2.

Therefore, since the grain size is regarded as being implicitly disclosed in D2, the subject-matter of claim 1 is not considered as being novel over D2 (Art. 54(1) EPC).

D3 discloses a manganese alloy forged ingot containing 0.02 % S (D1 [sic], col. 2, l. 6-41; col. 4, l. 3-24; Table I).

D3 does not disclose explicitly an oxygen content of less than 1000 ppm (0.1 %) nor that the crystal grain diameter is 500 microns or less (0.5 mm or less).

However, such limits are so broad that they encompass the usual values obtained by usual process when forging is applied.

Therefore, they are regarded as being implicitly disclosed in D1 [sic] and, hence, the subject-matter of claim 1 is not considered as being novel over D1 [sic] (Art. 54(1) EPC).

It is noted that "a manganese alloy sputtering target", according to the wording used in claim 1, encompasses in fact all manganese alloy products since a sputtering target has no well admitted defined or specific features. Therefore, any manganese alloy part such as a forged ingot like the one of D3 may be regarded as a sputtering target."

In point 5 it further stated that "Dependent claims 2-3 do not appear to contain any additional features which, in combination with the features of any claim to which they refer, meet the requirements of the EPC with respect to novelty, the reasons being as follows:

*- the reasons given above under paragraph 4 against claim 1 also apply to claim 2 (Art. 54(1) EPC); and
- the additional features of claim 3 are known from either D1, D2 and/or D3 (Art. 54(1) EPC)."*

Finally it remarked in point 6 that at least some of the objections would be such that there appeared to be no possibility of overcoming them by amendment and that refusal of the application is to be expected but asked the applicant to supply a translation in one of the official languages of the Japanese document D2.

1.1.3 It is thus apparent from the first communication as such that all three documents D1 to D3 do **not**

explicitly disclose **all** the features of claim 1 as originally filed. Both D1 and D2 are silent with respect to forging and a single phase equiaxed grain structure and do not disclose a crystal grain diameter of 500 µm or less, while D3 likewise does not disclose this crystal grain diameter and does also not specify the oxygen content of the manganese alloy which is not used as a target but only for a different purpose. This first communication in this respect contains only allegations in points 4.1 to 4.3 but does not contain a comprehensible explanation as to why these features would be implicitly disclosed by D1 to D3.

The allegation additionally made in point 5 further does not give any references in the cited documents D1-D3 for the features of the dependent claims allegedly known therefrom.

- 1.2 As a response to the first communication the appellant submitted with its letter dated 21 April 2008 that claim 1 is novel and involves an inventive step over D1-D3 by stating: *"As the Examiner himself notes, D1 does not actually disclose forging. The same applies to D2. Whilst D3 discloses forging and hot rolling of the alloys disclosed therein, D3 appears to be primarily concerned with the production of material useful in temperature-responsive control elements such as bi-metallic strips and it is submitted that the man in the art of sputtering target manufacture would not look to prior art relating to the production of bi-metallic strips, etc, for a solution to problems in relation to sputtering targets. Furthermore, there appears to be nothing in D3 which would suggest that the products or processes disclosed therein would be advantageous in*

relation to the solution of problems existing in relation to sputtering target manufacture or use."

It further submitted an amended page 3 of the description and, together with a partial English translation of the claims, the examples and tables of the Japanese patent D2, additional comments provided by the instructing principals which included photographs showing the difference of a cast structure and a forged structure of two manganese alloys having identical or almost identical compositions. As a precaution oral proceedings were requested in the event that the Examiner would be minded to refuse the application.

1.3 The second communication dated 30 July 2009 dealt again with claims 1-3 as originally filed.

1.3.1 The Examining Division stated in point 2 that "*All applicant's arguments were carefully considered but were not found convincing for the reasons given below. As a result, present application still does not meet the requirements of Art. 52(1), 54(1) EPC*".

It submitted in points 3 and 4: "*With respect to D1 and D2, the applicant argues that, since forging is not disclosed in said prior art documents, the Mn alloy targets of D1 and D2 will not exhibit a forged structure with single phase equiaxed crystal structure.*

However, as already mentioned in previous communication dated 02.01.08, it is not clear from claim 1 how much forging is performed so that neither this process feature, nor the broadly worded resulting microstructure, i.e. a forged texture with single phase

equiaxed grain structure, enable to distinguish the claimed product unambiguously from the known ones.

Consequently, the subject-matter of present claim 1 is still considered to be lacking novelty over each document D1 and D2 (Art. 52(1), 54(1) EPC).

It is emphasized that D2 explicitly discloses manganese alloy sputtering targets having oxygen and sulfur contents within the claimed ranges (see translation of D2 supplied by the applicant, example 1, [0019], table 1, Mn-lr alloy; example 2, [0022] table 2, Mn-lr alloy)."

In point 4 it stated: "With respect to D3, the applicant argues that the composition of present application and the one of D3 are "fundamentally different". However, there is no composition in present claim 1 and, hence, the applicant's argument cannot be followed.

The applicant further considers that "special forging" is performed in present application, which would not be the case in D3. It is not clear however what is meant by "special forging" as stated by the applicant. In any case, such a feature does not appear in present claim 1, which in fact relates to a product per se, and, hence, the applicant's argument cannot be followed either.

Finally, the applicant considers that D3 seeks to increase ductility while the Mn alloy of present application is "extremely brittle". However, there is no feature in present claim 1 relating to any limit in brittleness or ductility, which would enable to depart

the claimed product to the prior art. The applicant's argument can therefore not be considered as being relevant.

As already mentioned in previous communication dated 02.01.08, "a manganese alloy sputtering target", according to the wording used in claim 1, encompasses in fact all manganese alloy products since a sputtering target has no well admitted defined or specific features. Therefore, any manganese alloy part such as a forged ingot like the one of D3 may be regarded as a sputtering target, contrary to applicant's opinion. In fact, the feature "a manganese alloy sputtering target" is interpreted as a manganese alloy suitable for being used as a sputtering target, which is unambiguously the case for the alloy known from D3.

Consequently, the subject-matter of present claim 1 is still considered to be lacking novelty over D3 (Art. 52(1), 54(1) EPC)."

The Examining Division finally stated that oral proceedings are arranged, as requested by the applicant.

1.3.2 This second communication therefore also contains only allegations without giving any comprehensible reasoning as to why the disclosures of D1 to D3 would fulfil **all** the requirements as set out by the features of claim 1 as originally filed (see point 1.1.1 above).

1.4 In response to the second communication as annexed to the summons to oral proceedings the appellant submitted with its letter dated 9 October 2009 an amended set of claims 1-6, substitute pages 4-6, 8 and 14-16 and

requested cancelling of pages 17 and 18 as on file. It quoted the basis for the amendment made to claim 1 (e.g. page 4, lines 21-22 of the application as originally filed) and stated that the use claims 4-6 directed to the use of the forged manganese alloy sputtering target have been added.

- 1.4.1 Independent claims 1 and 4 as filed with letter dated 9 October 2009 read as follows (amendments compared to claim 1 as originally filed are in bold; emphasis added by the Board):

"1. A **forged** manganese alloy sputtering target for forming an antiferromagnetic film, characterised in that:

the oxygen content of the target is 1000ppm or less;
the sulphur content of the target is 200ppm or less;
the target has a single phase equiaxed grain structure with the crystal grain diameter being 500µm or less;
and

the target is provided with a forged texture."

"**Use of a forged** manganese alloy sputtering target **to form** an antiferromagnetic film, characterised in that:

the oxygen content of the target is 1000ppm or less;
the sulphur content of the target is 200ppm or less;
the target has a single phase equiaxed grain structure with the crystal grain diameter being 500µm or less;
and

the target is provided with a forged texture."

- 1.4.2 Furthermore, with this response the applicant submitted the following arguments with respect to novelty:

"We attach a signed statement from a person skilled in the art which confirms that it would be immediately clear to the person skilled in the art whether or not a sputtering target has been formed by forging or by another technique, such as casting.

A person skilled in the art would only have to look at the surface of a sputtering target under a microscope to see whether the target had been formed by forging or casting. It would be easy for a person skilled in the art to distinguish between forged or cast sputtering targets, regardless of the conditions under which the target is forged or cast.

We attach annexes 1 and 2 which show photographs of the surface of sputtering targets which have been formed by forging. We also attach annexes 3 and 4 which show photographs of the surface of sputtering targets which have been formed by a different technique, such as casting.

It is clear that the sputtering targets shown in annexes 3 and 4 have a dendrite cast structure which is a characteristic of metal which has been formed by casting. It is possible to heat treat a target which has been formed by casting to try to remove the dendrite structure, but the required heat treatment must be performed for a long period of time which results in the crystal grains growing and becoming extremely coarse.

A forged structure, such as the structures shown in annexes 1 and 2, has a fine equiaxed crystal structure and does not have a dendrite structure. It is very easy

to distinguish this forged fine equiaxed crystal structure from a cast dendrite structure.

The actual conditions under which forging occurs are irrelevant because a person skilled in the art would be able to tell immediately whether a sputtering target had been formed by any kind of forging or by melting or casting. Nevertheless, if a person skilled in the art wanted to check the forging conditions that formed the sputtering target of claim 1, the person skilled in the art would refer to the description of the present application for guidance. The person skilled in the art would see the forging conditions which are described in detail on page 7 of the present application and would have no difficulty in understanding the forging conditions required to form the forged sputtering target of claim 1.

D1 and D2 only disclose structures which are formed by melting or casting. As noted by the examiner, neither D1 nor D2 disclose a forged manganese alloy sputtering target. The attached statement confirms that it would be easy for a person skilled in the art to distinguish between the sputtering target of the present invention and the sputtering target of D1 or D2.

The forged characteristic of the sputtering target of claim 1 is an essential feature which would be understood clearly by a person skilled in the art. The sputtering targets described in D1 and D2 do not possess the forged feature and so they do not incorporate all of the features of claim 1. Consequently, claim 1 is novel over D1 and D2.

D3 describes manganese alloys and methods of forming the same. The manganese alloys are suitable for use in bimetallic strips and in thermally responsive control devices (see column 1, lines 11-14). D3 does not disclose sputtering or anything which would be suitable for use as a sputtering target. Moreover, D3 does not disclose a sputtering target which has an oxygen content of less than 1000ppm or an equiaxed grain structure with the crystal grain diameter being 500µm or less. The essential features of claim 1 are not directly and unambiguously derivable from D3. We, therefore, submit that claim 1 is novel over D3.

The examiner asserts that the ingot described in D3 could be used as a sputtering target. This is, however, not enough to deny the novelty of claim 1 because D3 simply does not disclose all of the features of claim 1. We respectfully submit that any assumptions of what a person skilled in the art might do with prior art subject matter should be considered during the assessment of inventive step and not during the assessment of novelty."

Furthermore, the applicant asked for a telephone conversation in case that the Examiner would not be satisfied that the objections raised in the summons are overcome.

- 1.4.3 It can thus be established that with that letter the appellant submitted more restricted claims 1-6 together with further arguments being supported by evidence, in the form of the annexes 1-4 and the statement of Mr. Nakamura filed with the same letter, and addressed in

substance all the novelty objections and allegations of the Examining Division based on documents D1 to D3.

- 1.5 A telephone conversation between the primary examiner and the applicant's representative took place on 19 October 2009 as a response to the appellant's letter dated 9 October 2009 of which the result was notified with the (third) communication dated 26 October 2009 as follows:

"The applicant was informed that the objections of lack of novelty raised in the summons for oral proceedings were maintained against the subject-matter of claims 1-3 filed with the letter of 9 October 2009, vis-à-vis each document D1-D3 (Art. 52(1), 54(1) EPC).

The applicant was further informed that the subject-matter of claims 4-6 filed with the letter of 9 October 2009 relates to a use of a product defined by its process (product-by-process). Since both D1 and D2 disclose [sic] the use, the subject-matter of claims 4-6 lacks novelty over each document D1 and D2 (Art. 52(1), 54(1) EPC)."

- 1.5.1 This (third) communication does **not** contain any reasoning at all, let alone a comprehensible one, as to why the novelty objections raised in the second communication annexed to the summons to oral proceedings with respect to the claims 1-3 as originally filed would likewise apply to the newly filed amended claims 1-6, which have been restricted to **forged** targets.

- 1.6 With letter dated 27 October 2009 the applicant withdrew its request for oral proceedings and remarked

therein: "the examiner stated that the division was not convinced by the evidence that the skilled person would be able to distinguish the claimed forged structure from the cast structures arrived at in D1 and D2". It further requested a written decision on the current state of the file.

- 1.7 The impugned decision according to the state of the file merely refers to "the communication(s) dated 30.07.2009, 26.10.2009" and states that "the applicant was informed that the application does not meet the requirements of the European Patent Convention. **The applicant was also informed of the reasons therein**" (emphasis added by the Board) and that the applicant filed no comments or amendments in reply to the latest communication (see point V above).
- 1.8 Since the Examining Division in its result of the telephone conversation, which is the (third) communication, did not deal with the appellant's response of 9 October 2009 the Board is not in a position to examine the reasons why it did not accept the arguments of the appellant. The decision of the Examining Division is therefore deficient in that it is not reasoned as required by Rule 111(2) EPC.
- 1.8.1 In the present case this becomes evident since the Examining Division **neither** in this (third) communication **nor** in its second communication - the impugned decision refers to both of them - has explained in a comprehensible manner (as elaborated in the Guidelines, Part E, Chapter X-5) as to why the **cast** manganese alloy sputtering targets according to D1 or D2 meet **all** the requirements of the features of

independent product claim 1 and use claim 4 of the single request, or why the forged manganese alloy article according to D3 fulfils **all** the requirements of product claim 1.

The lack of novelty objection with respect to D1 and D2 does **not** contain any specific reasons for this allegation, let alone give arguments in a logical chain referring to specific passages of the cited documents and particularly explaining as to why these **cast** targets would have the **forged** structure with single phase equiaxed crystal structure with the crystal grain diameter being 500 μm or less, as argued by the applicant in its letter of 9 October 2009.

Likewise it has not been explained as to why the forged manganese alloy article according to D3 inevitably would fulfil the **maximum oxygen level** requirement of **1000 ppm or less** as specified in claim 1 of the single request, taking account of the manganese starting material as e.g. disclosed in D2 which reveals an oxygen content of 1500 ppm (compare D2, examples). In this context it should also be considered that the oxygen content of the manganese alloy according to D3 does not appear to be critical for the intended use in bimetallic strips in thermally responsive control devices taking account of the upper limits of the other specified elements such as C, S, P, etc. which appear to be critical for this purpose (see D3, column 1, lines 13 and 14; and column 4, lines 3 to 10).

1.8.2 Furthermore, the primary examiner or the Examining Division in its telephone communication has never explicitly referred and responded to the applicant's

arguments based on the evidence as submitted in its reply dated 9 October 2009, i.e. the comparative optical micrographs of the two cast and two forged manganese alloys according to annexes 1-4 and the statement of Mr. Nakamura with respect to the distinguishability of cast and forged targets.

The impugned decision is therefore silent with respect to the applicant's main arguments submitted with the letter dated 9 October 2009, i.e. as to why from its point of view the subject-matter of claim 1 complies with Article 54 EPC, and does **not** give any reasoning as to why the applicant's arguments to the contrary cannot hold.

- 1.8.3 From the above analysis and discussion of the content of the two communications referred to, the Board can only establish that the Examining Division, when issuing the impugned decision, did **not** follow the Guidelines for Examination in the European Patent Office, according to which the reasoning must contain in logical sequence those arguments which justify the order. Furthermore, the reasoning should be complete and independently comprehensible and the reasoning should contain the important facts and arguments which speak against the decision (see the Guidelines, Chapter E-X, 5). The latter means that the decision should address the arguments of the losing party (not in the least to also comply with the right to be heard) and should make sure that it deals sufficiently with the counterarguments put forward and provides reasoned support for what it concludes.

1.8.4 Furthermore, there exist several decisions of the Boards of Appeal, e.g. T 1709/06 (see points 1.2 to 1.2.5 of the reasons; not published in OJ EPO) or T 1309/05 (see points 3 to 3.7 of the reasons; not published in OJ EPO), that such a decision "on the state of the file" which refers to several communications, leaving it up to the Board of appeal to construct the applicable reasons by "mosaicing" various arguments from the file, or which leaves in doubt as to which arguments apply to which claim version - in the present case the second communication deals with the claims 1-3 as originally filed whereas the third communication with the result of the telephone conversation deals with the more restricted claims 1-6 dated 9 October 2009 (compare points 1.1 and 1.5.1 above) - does **not** meet the requirement of sufficient reasoning of Rule 111(2) EPC.

1.9 This lack of reasoning represents a substantial procedural violation since it results in that the Board is unable to deal with the case and in the appellant being deprived of any reasoning on its latest submission, which it can address in appeal.

Interlocutory revision (Article 109(1) EPC)

2. As already considered by the Board, the impugned decision according to the state of the file does not contain a comprehensible reasoning with respect to the appellant's last submission (see point IV and points 1.4 to 1.6 above).

2.1 In its grounds of appeal the appellant mentions that a substantial procedural violation occurred since the

decision is silent with respect to its arguments and evidence filed with letter dated 9 October 2009 (see point VI above).

2.2 A simple comparison of appellant's statement in the grounds of appeal concerning a substantial procedural violation and the reference to its extensive comments and amended claims presented with its letter dated 9 October 2009 further should have taught the Examining Division that it had failed to consider the appellant's last submission. To avoid at least that procedural violation the Examining Division should have rectified its decision and continued the examination proceedings.

2.3 Since the Examining Division did not rectify its decision it also did **not** apply the practice indicated in the Guidelines for Examination in the European Patent Office which state that one example of a well founded appeal for which rectification must be given, is one where "the department failed to take due account of some of the material available to it at the time the decision was made" (see the Guidelines, Chapter E-XI, 7.1(i)).

Remittal to the department of first instance (Article 111(1) EPC)

3. In view of the aforesaid substantial procedural violations the Board considers that it is appropriate to set aside the decision under appeal for this reason alone, in application of Article 11 RPBA, and to remit the case to the department of first instance for further prosecution in accordance with Article 111(1) EPC.

As the request for oral proceedings was withdrawn with letter of 23 June 2011, the present decision could be taken in written proceedings.

Reimbursement of the appeal fee (Rule 103(1)(a) EPC)

For the above reasons it is also equitable to reimburse the appeal fee pursuant to Rule 103(1)(a) 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.
3. The appeal fee is to be reimbursed.

The Registrar:

The Chairman:

G. Nachtigall

H. Meinders