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**Datasheet for the decision  
of 6 March 2014**

**Case Number:** T 1352/13 - 3.4.03  
**Application Number:** 07715034.0  
**Publication Number:** 1988568  
**IPC:** H01L21/687, H01L21/677  
**Language of the proceedings:** EN

**Title of invention:**

SUBSTRATE TREATING DEVICE, SUBSTRATE CONVEY DEVICE, SUBSTRATE GRASPING DEVICE, AND CHEMICAL SOLUTION TREATING DEVICE

**Applicant:**

EBARA CORPORATION

**Headword:**

**Relevant legal provisions:**

EPC Art. 123(2)  
EPC 1973 Art. 54(1), 54(2), 111, 111(1), 113(1)  
EPC 1973 R. 67  
RPBA Art. 11

**Keyword:**

Substantial procedural violation - opportunity to comment (no)  
Remittal to the department of first instance - fundamental deficiency in first instance proceedings (yes)  
Reimbursement of appeal fee - (yes)

**Decisions cited:**

J 0010/07

**Catchword:**



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Case Number: T 1352/13 - 3.4.03

**D E C I S I O N  
of Technical Board of Appeal 3.4.03  
of 6 March 2014**

**Appellant:** EBARA CORPORATION  
(Applicant) 11-1, Haneda Asahi-cho  
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Tokyo 144-8510 (JP)

**Representative:** Wagner, Karl H.  
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**Decision under appeal:** **Decision of the Examining Division of the  
European Patent Office posted on 10 January 2013  
refusing European patent application No.  
07715034.0 pursuant to Article 97(2) EPC.**

**Composition of the Board:**

**Chairman:** G. Eliasson  
**Members:** S. Ward  
T. Bokor

## Summary of Facts and Submissions

I. The appeal is against the decision of the Examining Division refusing European patent application No. 07 715 034 on the ground that the subject-matter of claim 1 lacked novelty having regard to the following prior art:

D1: US 5 605 487 A  
D2: US 6 313 469 B1  
D3: US 2005/159082 A1

The following document was also referred to in the procedure:

D4: KR 2002 0032057 A

II. In the letter stating the grounds of appeal the appellant-applicant maintained the claims on file as a main request and filed a further set of claims forming an auxiliary request.

III. In a letter dated 27 January 2014, the appellant stated its requests as follows:

"1. Set aside the decision under appeal;

2. Remit the case to the department of first instance for further examination;

3. (Auxiliary request) Remit the case to the department of first instance for further examination on the basis of amended claims entitled 'Claims auxiliary request' in combination with the specification and drawings on file;

4. Appoint Oral Proceedings in case requests under item 1 and 2 above cannot be allowed in the written proceedings;

5. Refund the appeal fee."

IV. The course of the proceedings before the department of first instance may be summarized as follows:

The application entered the European regional phase comprising claims 1-18. Claim 1 reads:

*"A substrate processing apparatus, comprising: plural processing sections each for performing predetermined processing on a substrate; and a substrate transfer mechanism for transferring the substrate between said plural processing sections, wherein said substrate transfer mechanism includes: a substrate clamp mechanism adapted to clamp the substrate; a vertically moving mechanism for vertically moving said substrate clamp mechanism along a frame of a casing of one of said plural processing sections; and a swing mechanism for swinging said substrate clamp mechanism about said frame or a shaft adjacent to said frame."*

A supplementary European search report was drawn up and a European search opinion issued based on claims "1-18 filed with entry into the regional phase before the EPO". The search opinion contained a formal objection to the plurality of independent apparatus claims, and the application was said not to "meet the requirements of Article 54(1,2) EPC, since the subject-matter of claim 1 is not new". A feature analysis was made of claim 1 to explain the Examining Division's position

that all claimed features were disclosed in the document D1. A brief indication was also given why documents D2, D3 and D4 were each considered to anticipate the subject-matter of claim 1.

The applicant subsequently filed a letter by fax on 13 April 2012 together with a new set of claims 1 to 5 and corresponding adaptations to the description. Arguments were submitted that the amendments to claim 1 rendered the claimed subject-matter novel over each of the documents D1 to D4, and inventive over any possible combination of them. In amended claim 1, the order of the final two features (the swing mechanism and the vertically moving mechanism) was reversed, and the wording amended as follows (emphasis added by the Board):

*"a swing mechanism for swinging said substrate clamp mechanism **so as to transfer the substrate between said plural processing sections**; and a vertically moving mechanism for vertically moving said substrate clamp mechanism **and said swing mechanism along a frame of a casing of one of said plural processing sections.**"*

In a communication pursuant to Article 94(3) EPC dated 28 June 2012, an objection was raised under Article 123(2) EPC against the amendments made to claim 1. It was also stated that "The objections raised in the previous communication under items 3.0-4.0 are therefore maintained in its entirety."

A further response was filed by the applicant on 8 November 2012 together with a new set of claims which differed from the previous set only in the addition of reference signs. The applicant explained in detail

where, in its view, a basis for the amendments to claim 1 could be found in the application as filed. In addition, the applicant stated that "Arguments in support of Novelty and Inventive Step were given in the previous response dated April 13, 2012. These were not disputed and they are still considered to be fully valid."

The next official action was the decision to refuse the application on the ground that claim 1 lacked novelty.

- V. Claim 1 of the main request (i.e. claim 1 upon which the contested decision was based) reads as follows:

*"A substrate processing apparatus, comprising:  
plural processing sections (3a, 3b, 4) each for performing predetermined processing on a substrate (W);  
and  
a substrate transfer mechanism (7) for transferring the substrate (W) between said plural processing sections (3a, 3b, 4),  
wherein said substrate transfer mechanism (7) includes:  
a substrate clamp mechanism (112) adapted to clamp the substrate (W);  
a swing mechanism (108, 110) for swinging said substrate clamp mechanism (112) so as to transfer the substrate (W) between said plural processing sections (3a, 3b, 4); and  
a vertically moving mechanism (104, 106) for vertically moving said substrate clamp mechanism (112) and said swing mechanism (108, 110) along a frame of a casing of one of said plural processing sections (3a, 3b, 4)."*

- VI. In relation to procedural matters, the arguments of the appellant may be summarized essentially as follows:

The appellant was "more than surprised about the rejection".

In the communication pursuant to Article 94(3) EPC dated 28 June 2012, the amended claims were objected to as contravening Article 123(2) EPC.

"No comments regarding novelty or inventive step were made with respect to the newly filed claims. The Communication only contained the statement that 'The objections raised in the previous communication under items 3.0-4.0 are therefore (emphasis added) maintained in its entirety.'" This had been understood to mean that there were "no objections regarding novelty and inventive step regarding the newly added features and if the basis for the features were shown or similar features which fulfil the requirements of Article 123(2) EPC were filed, the application could proceed to grant." The maintenance of the previous objections had been understood to indicate only that "the amended features were considered not to be disclosed in the application as filed."

In response, "the basis for the amendments was shown in some detail and indeed it was obviously shown in a proper manner, as the respective objection was no longer maintained." The applicant "was not confronted with any other objections (other than the Article 123(2) EPC objection) with respect to allowability of the claims".

Nevertheless, the decision to refuse the application was based solely on the ground that claim 1 lacked novelty. This "violates the provisions of the EPC as the application was refused without giving the



applicant-appellant a chance to respond to the reasons forming the decision to refuse."

Furthermore, "If the applicant had had any indication that the amended claims were also objected to in view of lack of novelty, Oral Proceeding would have been requested and the Appeal would have been superfluous. Already for this reason alone, the decision as such is considered to be erroneous and refund of the appeal fee is requested."

- VII. In relation to substantive matters, the appellant argued that there is a distinct difference between the subject-matter of claim 1 and document D1, resulting in a configuration which "can simplify the substrate transfer mechanism". As the distinguishing feature was neither disclosed or suggested, either in D1 or in any of the other cited documents, "claim 1 is also inventive over the art."

The subject matter of claim 1 according to the auxiliary request "adds an additional feature of distinction over the art."

## **Reasons for the Decision**

1. The appeal is admissible.
2. *Applicable Law*
  - 2.1 The appellant does not specify explicitly which provision of the EPC is considered not to have been respected during the procedure. However, the complaint

is that the decision of the Examining Division "violates the provisions of the EPC as the application was refused without giving the applicant a chance to respond to the reasons forming the decision to refuse". Hence (and having regard to Article 1 of the Decision of the Administrative Council of 28 June 2001 on the transitional provisions under Article 7 of the Act Revising the EPC of 29 November 2000), it is clear that a violation of Article 113(1) EPC 1973 is being alleged.

2.2 Although no article or rule of the EPC is cited in relation to the request for a refund of the appeal fee, the relevant provision is clearly Rule 67 EPC 1973, an implementing regulation of Article 111 EPC 1973 (see J 10/07, OJ EPO 2008, 567, point 1.3 of the Reasons and the transitional provisions mentioned in the previous paragraph).

### 3. *Procedure*

3.1 Article 113(1) EPC 1973 states the following:

- *"The decisions of the European Patent Office may only be based on grounds or evidence on which the parties concerned have had an opportunity to present their comments."*

A party cannot be considered to have had such an opportunity if it had not been made aware of the pertinent grounds or evidence before a decision based on them was taken.

The gist of the appellant's case is that, prior to the decision to refuse the application, it had never been made aware of any objection of lack of novelty in

relation to the subject-matter of claim 1 as refused. Hence, the decision to refuse the application based on precisely this objection "violates the provisions of the EPC", which the Board infers to mean Article 113(1) EPC 1973.

3.2 Prior to the decision, the applicant-appellant had been sent two communications relating to substantive matters from the EPO:

- a European search opinion based on claims 1-18 as filed on entry into the European phase; and
- a communication pursuant to Article 94(3) EPC dated 28 June 2012 which was based on claims 1-5 filed with the letter of 13 April 2012, the subject-matter of these claims being, apart from the absence of reference signs, identical to that of claims 1-5 on which the refusal was based.

It is not disputed that the search opinion contained a fully reasoned objection against the subject-matter of claim 1 as filed on entry into the European phase on the ground of lack of novelty. No objection of lack of novelty was raised in the search opinion against any other claims or any other subject-matter comprised in the application.

The communication pursuant to Article 94(3) EPC dated 28 June 2012 did not refer to any requirement of the EPC apart from Article 123(2) EPC in relation to the amendments made to claim 1. However, it also included the comment that:

- *"The objections raised in the previous communication under items 3.0-4.0 are therefore maintained in its entirety."*

The "previous communication" can only refer to the search opinion, under point 3 of which was raised the above-mentioned objection that claim 1 as filed on entry into the European phase lacked novelty.

3.3 The Board therefore considers that the only reasonable interpretation of the communication dated 28 June 2012 is that the Examining Division was informing the applicant that:

- the *amended* subject-matter of claim 1 was considered to contravene the requirements of Article 123(2) EPC; and
- the remaining *unamended* subject-matter of claim 1 was still considered to be anticipated by the prior art for the reasons set out in the search opinion.

There is nothing in the communication of 28 June 2012 that could reasonably be interpreted as an objection that the subject-matter of claim 1 *as amended* lacks novelty; the question of the novelty of this subject-matter is simply not discussed. Having taken the view that the amended features were not in compliance with the requirements of Article 123(2) EPC, the Examining Division presumably did not see any useful purpose at that point in discussing whether these features were anticipated by the prior art.

In the letter of 8 November 2012 the applicant provided counter-arguments against the objection under

Article 123(2) EPC which - given that this matter was not subsequently mentioned as a ground for refusal - must be presumed to have persuaded the Examining Division.

This being the case, the applicant was entitled to expect either to receive a communication pursuant to Rule 71(3) EPC, or to be informed of any further objections not yet raised in the procedure against the subject-matter of the claims as amended, and afforded the opportunity guaranteed by Article 113(1) EPC 1973 to comment on these objections. Instead, a decision to refuse the application was taken on the ground that the subject-matter of claim 1 as amended lacked novelty.

- 3.4 The Board acknowledges that there could be cases in which the claims on which a refusal is based comprise amendments of such a minor or trivial nature that an objection of lack of novelty previously raised against the version of the claims prior to amendment would undoubtedly still apply. In such a case, even if the complete subject-matter of the amended claims had not been formally objected to prior to the refusal, an applicant could not credibly claim to have been taken by surprise by the decision.

However, in the present case both the swing mechanism and the vertically moving mechanism are defined functionally, and in the amended version of claim 1 the respective functions of these mechanisms have been modified in a manner which introduces significant new technical content. Hence, the amendments cannot be described as minor or trivial in the above sense.

For the purposes of the present discussion of procedural issues, it is irrelevant whether the

amendments *actually* overcome the objection of lack of novelty against claim 1 as filed on entry into the European phase, and the Board takes no position on this matter.

What is important is that the amendments modified the technical content of claim 1 in a manner which represented at least a plausible attempt to overcome the objection of lack of novelty raised against the previous version. Hence, the applicant was entitled under Article 113(1) EPC 1973 to be informed that the Examining Division did not consider the amendments sufficient to overcome the objection, and to be given an opportunity to comment on this prior to a decision.

In conclusion, the decision to refuse the application was based on the finding that the subject-matter of claim 1 filed with the letter of 8 November 2012 "is not new in the sense of Article 54(1,2) EPC". This finding had neither been explicitly stated in, nor could it have been reasonably inferred from, the previous procedure. Hence, the decision does not meet the requirements of Article 113(1) EPC 1973.

4. *Further procedure*

In view of the above conclusion, the Board considers it appropriate to exercise its discretion under Article 111(1) EPC 1973 and Article 11 RPBA to remit the case to the department of first instance for further prosecution.

For the avoidance of doubt, the present decision deals with procedural issues only, and does not bind the Examining Division in any way in relation to the further substantive examination of the application. All

issues, including the question whether the subject-matter of claim 1 as refused is novel, remain to be decided in the remitted procedure, in which the applicant should be afforded sufficient opportunity to exercise its rights under Article 113(1) EPC 1973.

5. *Requested Refund of the Appeal fee*

Rule 67 EPC 1973 (first sentence) states the following:

- *"The reimbursement of appeal fees shall be ordered in the event of interlocutory revision or where the Board of Appeal deems an appeal to be allowable, if such reimbursement is equitable by reason of a substantial procedural violation."*

In the present case the appeal has been found to be allowable. Moreover, reimbursement of the appeal fee is equitable, as the appellant was forced to file an appeal and pay the appeal fee in order to assert its rights under Article 113(1) EPC 1973.

## 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.
3. The appeal fee shall be reimbursed.

The Registrar:

The Chairman:



S. Sánchez Chiquero

G. Eliasson

Decision electronically authenticated