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**Datasheet for the decision
of 1 December 2017**

Case Number: T 2101/14 - 3.4.03

Application Number: 02090385.2

Publication Number: 1315209

IPC: H01L27/00

Language of the proceedings: EN

Title of invention:

Organic EL display device and method of manufacturing the same

Applicant:

Samsung Display Co., Ltd.

Headword:

Relevant legal provisions:

EPC 1973 Art. 56, 113(1)
EPC Art. 52(1), 108, 123(2)
RPBA Art. 13(3), 15(1)

Keyword:

Late-filed auxiliary requests - adjournment of oral proceedings would have been required (yes) - admitted (no)
Right to be heard - appeal procedure - opportunity to comment (yes)

Decisions cited:

G 0010/93, T 0253/06, T 1732/10, T 1134/11

Catchword:



Beschwerdekammern
Boards of Appeal
Chambres de recours

Boards of Appeal of the
European Patent Office
Richard-Reitzner-Allee 8
85540 Haar
GERMANY
Tel. +49 (0)89 2399-0
Fax +49 (0)89 2399-4465

Case Number: T 2101/14 - 3.4.03

D E C I S I O N
of Technical Board of Appeal 3.4.03
of 1 December 2017

Appellant: Samsung Display Co., Ltd.
(Applicant) 17113, 1, Samsung-ro
Giheung-Gu
Yongin-si
Gyeonggi-do (KR)

Representative: Gulde & Partner
Patent- und Rechtsanwaltskanzlei mbB
Wallstraße 58/59
10179 Berlin (DE)

Decision under appeal: **Decision of the Examining Division of the
European Patent Office posted on 14 April 2014
refusing European patent application No.
02090385.2 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. 02 090 385 on the grounds that the main and auxiliary requests did not comply with Article 123(2) EPC, and that the subject-matter of claim 1 of the main request did not involve an inventive step within the meaning of Article 56 EPC in the light of the combination of documents D1 (EP 1 096 303 A2) and D2 (US 6 140 009).
- II. At the oral proceedings held before the Board the appellant requested that the decision under appeal be set aside and that a patent be granted based on claims 1-9 filed with the letter of 6 September 2017.
- III. The history of the case before the Board may be summarised as follows:

(a) With the statement of grounds of appeal the appellant forwarded "a new set of claims on which the appeal shall be based". New claim 1 differed from claim 1 of the previous main request at least in the following:

"with a transfer film (30; 50) having a thickness of 50 nm to 100 nm and being in contact with an array substrate."

An indication was given of the basis for this request in the application as originally filed. The correctness of the Examining Division's decision was not challenged, but it was argued that the new feature cited above rendered the claimed subject-matter

inventive over D1, D2 and any of sixteen documents cited in the application.

(b) The appellant was summoned to oral proceedings scheduled to take place on 6 October 2017. In a communication pursuant to Article 15(1) RPBA the Board gave its provisional assessment of the case, which was essentially as follows:

The feature considered to confer an inventive step had not been included in any of claims 1-37 as originally filed, nor in any claim subsequently filed during the examination procedure. It was therefore doubtful whether it had ever been searched, either when the European search report was drawn up, or subsequently during examination. It would therefore be impossible to reliably judge the significance of the new feature on the basis of the prior art on file, leaving the Board with the options of either remitting the case to the department of first instance under Article 111(1) EPC for further prosecution, including an additional search, or refusing to admit the amendment using its discretion under Article 12(4) RPBA.

The appellant was invited to provide reasons why the new request had not been submitted in proceedings before the department of first instance. In the absence of any convincing reasons, the Board was likely to refuse to admit it into the appeal proceedings pursuant to Article 12(4) RPBA.

The arguments in the statement of grounds of appeal focused entirely on the amended feature added on appeal. The appellant had not called into question the conclusions of the Examining Division in relation to

inventive step. The Board also saw no reason to question these conclusions.

The appellant was reminded of the provisions of Articles 13(1), 13(3) and 15 RPBA. Further written submissions, if any, were to reach the Board at least one month before the date of the oral proceedings.

(c) With a letter dated 6 September 2017 the appellant filed a further set of claims "which shall replace the previous set of claims". Claim 1 reads as follows:

*"A method of manufacturing a display device, comprising:
forming an underlying layer (370) over a substrate (300);
forming an insulating layer (380) over the substrate (300) to expose the underlying layer (370); and
forming an organic EL layer (390) on the exposed portion of the underlying layer (370),
wherein the insulating layer (380) has a taper angle on an edge portion thereof,
wherein a thickness of a portion of the insulating layer (380) formed on an edge of the underlying layer (370) is equal to or less than 250 nm, and
characterized in that
the taper angle of the insulating layer (380) is 15 degrees, and
the organic EL layer (390) is formed using a laser transfer technique."*

The letter included brief points on Article 123(2) EPC and clarity. Again, no assertion was made that the decision of the Examining Division was in any way wrong. The section entitled "Novelty and Inventive Step" comprised only the following text:

"Applicant assumes that the claims are now acknowledged to be novel and based on an inventive step. Claims and specification should further comply with all other requirements of the EPC."

(d) The original oral proceedings were cancelled due to the public transport system being badly affected by storms. A new date was set for 1 December 2017.

IV. At the oral proceedings, concerning the admissibility of the sole request, the appellant argued essentially as follows.

The new claims were submitted in response to the negative provisional opinion of the Board that the claims filed with the statement of grounds comprised unsearched subject-matter and might not be admissible. The new claims were based on originally-filed claims and therefore had been searched.

It was not considered necessary to file substantiating arguments in support of claim 1, as it corresponded to a suggestion for an allowable claim made by the Examining Division (communication dated 15 October 2010, Reasons, point 5.1).

The claims on file had been submitted in good time one month before the original date for oral proceedings, and approximately three months prior to the revised date for oral proceedings, giving the Board ample time to consider them. A telephone call from the Board might have been expected if it was considered that there was any formal deficiency in this respect. New claims were sometimes admitted even in oral proceedings.

The appellant's analysis concerning inventive step would essentially show that the claimed subject-matter provided the optimum conditions for avoiding the defects which can arise in an edge portion when employing a laser transfer technique on an etched, non-flat substrate. The full analysis in relation to the prior art could be presented in the oral proceedings and would take no more than an hour, which was not excessive and which would not require adjournment.

A failure to allow this request to be fully defended in oral proceedings would amount to a denial of the right to be heard.

Reasons for the Decision

1. *Admissibility of the appeal*
 - 1.1 Although the correctness of the appealed decision was not challenged in the statement of grounds of appeal, amended claims were filed, and reasons given why the subject-matter of the new claims was considered to involve an inventive step and to satisfy the requirements of Article 123(2) EPC (the grounds on which the application had been refused). The appeal is therefore considered to be sufficiently substantiated to satisfy the requirements of Article 108 EPC, third sentence (see *Case Law of the Boards of Appeal, 8th Edition 2016, IV.E.2.6.5(b)*).
 - 1.2 The fact that, after the four month time limit set out in Article 108 EPC, the appellant withdrew the request to which the reasoning given in the statement of

grounds applied has no bearing on the assessment of the admissibility of the appeal (see *Case Law of the Boards of Appeal, 8th Edition 2016, IV.E.2.6.3*)

1.3 The appeal is admissible.

2. *Admissibility of the sole request*

2.1 One of the grounds for refusal was a failure to meet the requirements of Articles 52(1) EPC and 56 EPC 1973, a conclusion which the Board provisionally endorsed in the communication pursuant to Article 15(1) RPBA. At no point in the written procedure did the appellant provide a single argument why the subject-matter of claim 1 of the present request is considered to involve an inventive step. The decision of the Examining Division was never challenged, nor was any written argument provided explaining why the amendments to claim 1 rendered the subject-matter inventive.

2.2 Furthermore, it has never been argued by the appellant that it is self-evident that claim 1 involves an inventive step. On the contrary, as explained below, the appellant wished to make submissions on this point which it was estimated would take no more than about an hour.

2.3 Hence, as far as the written procedure is concerned, the Board can see nothing which would justify any deviation from the position of the Boards that unsubstantiated requests (unless it was obvious how they overcame the outstanding objections) should not be admitted into the proceedings (see *Case Law of the Boards of Appeal, 8th Edition 2016, IV.E.4.2.4*).

- 2.4 At the oral proceedings the appellant asked to be allowed to present, for the first time, the case on inventive step in relation to its present request.

The question is therefore whether the conditions for admissibility of the request may be met by supplying the missing substantiation during the oral proceedings for the first time. The arguments of the appellant in this regard, and corresponding opinions of the Board, are examined in the following sections.

3. *The argument that the request was based on a suggestion of the Examining Division*

- 3.1 The appellant argued that the new claims did not need to be accompanied by reasoning in support of non-obviousness, since claim 1 corresponded to a suggestion for an allowable claim made by the Examining Division under point 5.1 of the Reasons in the communication dated 15 October 2010 (a similar suggestion was made under point 5.1 of the Reasons in the communication dated 23 October 2013).

- 3.2 Firstly, the Board notes that this argument was itself presented for the first time in the oral proceedings, with no reason given why this point could not have been made earlier. Secondly, the Board finds a lack of consistency in the appellant's position in this regard. It is a fact that the appellant's representative had prepared arguments that the subject-matter of claim 1 involved an inventive step, and wished to present these arguments at oral proceedings. The Board does not see how this is consistent with a belief that no arguments are necessary in the case of a claim suggested by the Examining Division.

- 3.3 The main point, however, is that any suggestion made by the Examining Division in a communication is merely an attempt to expedite the proceedings. It is not binding on the Boards of Appeal or even on the Examining Division itself. Any doubt on this point was dispelled by the Enlarged Board of Appeal in G 10/93 (OJ EPO 1995; 172; Reasons, point 7).

The fact that the subject-matter of a request filed in appeal proceedings corresponds to subject-matter which had been suggested by the Examining Division does not relieve the appellant of the responsibility to substantiate the request, nor does it justify the filing of such substantiation for the first time in oral proceedings.

4. *The argument that the request had been submitted in good time*

- 4.1 The current claims were filed one month before the original date for oral proceedings, and approximately three months prior to the revised date for oral proceedings. The Board accepts that this allowed ample time to read the new claims, and to consider the basis in the application as filed for these claims suggested by the appellant.

However, the Board did not have the opportunity during this period to consider the case in relation to inventive step, since no case had been made out for the Board to consider.

- 4.2 According to Article 13(3) RPBA:

"Amendments sought to be made after oral proceedings have been arranged shall not be admitted if they raise

issues which the Board ... cannot reasonably be expected to deal with without adjournment of the oral proceedings."

- 4.3 Where an appellant files new claims after oral proceedings have been arranged - even if within a period set by the Board - and chooses not to file any arguments on inventive step prior to the oral proceedings, the relevant question under Article 13(3) RPBA in determining whether these claims may be admitted, is whether the Board can reasonably be expected to deal with the appellant's case on inventive step being presented for the first time in oral proceedings.

In fact, unless the reasons why the new claims overcome the outstanding objections are self-evident (which is not the case here - see point 2.2, above), the effective date of filing of the claims is the date on which the substantiation is first provided (or offered in oral proceedings). This was stated in T 1732/10 as follows:

"For the Board, unsubstantiated requests normally become effective only at the date on which they are substantiated. Their filing in and of itself plays therefore no role, whether one, two (as in the present case) or three months before the oral proceedings" (T 1732/10, Reasons, point 1.5, fourth paragraph; see also "Catchword").

A similar point was made in T 1134/11 (see Reasons, point 10.6).

- 4.4 The Board concurs with these decisions, and hence the fact that the claims themselves were filed, without

substantiation, three months prior to the oral proceedings does not guarantee that they will be admitted.

5. *The argument that the Board could deal with the new submissions in the oral proceedings*

5.1 The appellant's representative asked to be allowed to present the case on inventive step in the oral proceedings, which, it was estimated, would take no more than about an hour. The Board could then deliberate and take a decision, with no adjournment being required.

5.2 The Board accepts that new submissions are not necessarily inadmissible for the sole reason that a party seeks to introduce them for the first time during oral proceedings. In particular, in the case of arguments, one of the purposes of oral proceedings is to allow the parties to develop, elaborate and add to their previous reasoning. Oral proceedings are not, however, intended to provide a means for an appellant to build the entire case on inventive step from scratch, especially where no good reason is given why these arguments were not previously submitted in writing.

5.3 In *ex parte* proceedings, before ordering the grant of a patent it is the responsibility of the Board to ensure that the conditions for patentability exist. This involves not only being informed of and understanding the arguments of the appellant, but also subjecting these arguments to a critical analysis.

It is for this reason that the Board requested that any new submissions should be made in writing well before

the date of the oral proceedings. In this way a Board of Appeal not only has the opportunity to familiarise itself with the arguments and arrive at an initial assessment well before the date of the oral proceedings, it also has the opportunity for further reflection in the period up until the date of oral proceedings. This further period of review and study may well throw up doubts about the Board's initial assessment, or reveal issues which were not initially apparent and which need to be clarified at oral proceedings.

The appellant's request to be allowed to present the arguments on inventive step *in toto* in the oral proceedings, effectively invites the Board to short-circuit this procedure, and to deliver a final decision based on an initial assessment of an argument which it has just heard for the first time in the oral proceedings, thereby eliminating the possibility of further reflection and study (without any time constraint) which the filing of arguments in the written procedure provides. The Board does not see why it should reasonably be expected to accede to this request in a case where no valid reason has been given why these arguments were not filed earlier.

Where arguments are brought for the first time in oral proceedings, allowing a period of reflection comparable to that referred to above would inevitably require adjournment of the oral proceedings, which is excluded by Article 13(3) RPBA. For this reason, the Board informed the appellant that it would not hear the arguments on inventive step which the appellant sought to make at oral proceedings, and that the set of claims for which these arguments would have represented the

sole substantiation on inventive step was not admitted into the proceedings.

5.4 The sole request of the appellant is that the decision under appeal be set aside and that a patent be granted based on the set of claims filed with the letter of 6 September 2017. As this set of claims is not admitted into the proceedings, this request cannot be allowed, and the appeal must be dismissed.

6. *The jurisprudence of the Boards*

6.1 The above approach is in line with the jurisprudence of the Boards of Appeal.

6.2 In T 253/06, following a decision rejecting an opposition, the Board sent a communication in preparation for oral proceedings which drew attention inter alia to the requirements of Article 13 RPBA and set a time limit for filing new submissions. The patent proprietor filed new auxiliary requests shortly before the expiry of this time limit, but gave no indication why the amendments were made or how they were to overcome the Board's objection of lack of inventive step. Apart from those requests which had already been part of the proceedings and had merely been re-filed, the Board decided in oral proceedings that these new requests were unsubstantiated and were not admitted into the proceedings (Reasons, point 3).

The Board concluded that requests filed after the appointment of oral proceedings can be regarded as inadmissible in accordance with Article 13(3) RPBA, even if filed within a prescribed time limit, if they are not substantiated, i.e. if they were not accompanied by reasons explaining why the amendments

had been made and how they were intended to overcome the objections raised in the course of the proceedings (Catchword and Reasons, point 3).

7. *The allegation of a denial of the right to be heard*

7.1 According to Article 113(1) EPC ("*Right to be heard and basis of decisions*"):

"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."

7.2 The decision of the Board in this case is based on the non-admittance of the sole request (comprising claims 1-9 filed with the letter of 6 September 2017) into the proceedings pursuant to Article 13(3) EPC.

The admissibility of these claims and the question whether the substantiating arguments could be presented during the oral proceedings were fully discussed, and the views of the appellant, as summarised under point IV, above, were taken into account in reaching the present decision.

The requirements of Article 113(1) EPC were therefore met, and the arguments of the appellant set out below do not persuade the Board otherwise.

7.3 The appellant essentially argued that the right to be heard was not being respected as it was not allowed to present the arguments on inventive step during the oral proceedings.

7.4 The appellant's argument that there was a denial of the right to defend the claims on their substantive merits must clearly fail. Article 113(1) EPC guarantees a right to be heard on the grounds and evidence on which a decision is based. The present decision is not based on the ground of lack of inventive step, and so Article 113(1) EPC confers no right to be heard on this matter *per se*.

7.5 In the opinion of the Board, the only conceivable way in which Article 113(1) EPC could be invoked in the present case, would be to allege that the arguments on inventive step have a bearing on the question of the admissibility of the claims, and should be heard for this reason. Although the appellant did not raise this argument directly, the Board is nevertheless prepared to consider it.

Cases may conceivably arise in which a Board decides to hear new substantive arguments in oral proceedings in relation to the question of the admissibility of the request to which they relate. For example, if an appellant wished to demonstrate that the arguments substantiating the request do not deviate significantly from arguments previously filed in the written procedure, and if the Board considered this to be relevant, it could use its discretion to allow the new substantive arguments to be heard. In the present case, however, no arguments having any relevance to the question of inventive step of the present claims were filed in the written procedure, and so this reason for hearing the substantive arguments does not apply. Nor can the Board see any other reason (and no reason has been provided by the appellant) why, in the present case, hearing the appellant's arguments on inventive

step in the oral proceedings would have had any bearing on the admissibility of the request.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:



S. Sánchez Chiquero

G. Eliasson

Decision electronically authenticated