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**Datasheet for the decision
of 14 November 2018**

Case Number: T 1946/17 - 3.5.02

Application Number: 07811466.7

Publication Number: 2060155

IPC: H05B33/14

Language of the proceedings: EN

Title of invention:

Lighting Device and Lighting Method

Applicant:

Cree, Inc.

Relevant legal provisions:

EPC R. 111(2), 103(1) (a)
Guidelines for examination C-V, 15.2

Keyword:

Appealed decision - reasoned (no) - substantial procedural
violation (yes)
Reimbursement of appeal fee - (yes)



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Case Number: T 1946/17 - 3.5.02

D E C I S I O N
of Technical Board of Appeal 3.5.02
of 14 November 2018

Appellant: Cree, Inc.
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Representative: Dummett Copp LLP
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Decision under appeal: **Decision of the Examining Division of the
European Patent Office posted on 3 April 2017
refusing European patent application No.
07811466.7 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chairman R. Lord
Members: G. Flynn
R. Cramer

Summary of Facts and Submissions

I. The Appellant (Applicant) is contesting the Examining Division's decision dated 3 April 2017, with which the European patent application no. 07 811 466.7 was refused.

II. The contested decision is a decision according to the state of the file, taken by means of a standard form referring to previous communications. The grounds for the decision read as follows:

"In the communication(s) dated 26.02.2016, 11.05.2015, 17.02.2014 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 17.03.2017.

The application must therefore be refused."

III. The Appellant's **main request** is that the decision under appeal be set aside and that the patent application be remitted to the Examining Division for further prosecution (see statement of grounds of appeal, letter dated 8 August 2017).

As an auxiliary request, the Appellant requests that a patent be granted on the basis of the claims presently on file.

The Appellant further requests that the appeal fee be refunded.

In the event that the main request is granted, the Applicant requests that the Primary Examiner contact the undersigned by telephone with a view to progressing the prosecution.

Oral proceedings under Article 116 EPC are requested in the event that neither the main request nor the auxiliary request is granted.

IV. The Appellant argues that the contested decision does not contain substantive grounds for the decision. They submit that the statement that the "applicant filed no comments or amendments in reply to the latest communication" is not correct, as they filed comments on 3 March 2017, which was after the latest communication of 26 February 2016. Furthermore, they submit that the Examining Division's failure to give any indication as to why they found the applicant's arguments unconvincing is contrary to the requirements of Rule 111(2) EPC and constitutes a substantial procedural violation justifying reimbursement of the appeal fee.

V. The relevant facts leading to the contested decision may be summarised chronologically as follows:

(a) In a communication dated 17 February 2014 the Examining Division set out objections against the claims filed on entry to the regional phase *inter alia* for lack of clarity (Article 84 EPC), lack of support and disclosure (Articles 84 and 83 EPC), lack of novelty (Article 54 EPC) and lack of inventive step (Article 56 EPC).

- (b) In a reply dated 15 July 2014 the Applicant argued in essence the following:
- It was justified to define the invention in terms of the result to be achieved, i.e. in terms of a desired chromaticity area (see page 2, second and third paragraphs).
 - The skilled person would be able to carry out the invention (see page 2, fourth paragraph).
 - The skilled person would be able to discern whether a lighting device satisfied the claim restrictions (see page 2, last paragraph);
 - Concrete examples were described (see page 3, first paragraph).
 - The claims were novel and inventive over all cited documents.
- (c) In a communication dated 11 May 2015 the Examining Division set out the following:
- The reasons given for defining the invention in terms of a result to be achieved were "not credible - enough applications are filed concerning lighting devices correctly defined by specific technical features only".
 - The skilled person had to be able to determine where the limits of the scope of protection were to be found, which was not possible with claim 1.
 - There were no concrete examples disclosed - the references cited by the applicant were just a list of background prior art documents, and the references (2) to (8) were not publicly available as they were cited only by their US application number and attorney docket number.
 - The examination of novelty and inventive step was postponed, but the applicant was invited to take into account some comments that were made.

(d) In a reply dated 28 October 2015 the Applicant argued the following:

- The person skilled in the art was familiar with a wide variety of solid state emitters and a wide range of lumiphors and their chromaticities.
- The skilled person would be able to predict the chromaticity of light emitted by any such combination of one or more solid state emitter and one or more lumiphor.
- The skilled person was able to detect the chromaticity of emitted light to verify whether light emitted is within the chromaticity area defined in claim 1. Hence, the limits of the scope of protection were clear.
- The Examining Division's argument that "enough applications are filed (and state of the art is existing) concerning lighting devices correctly defined by specific technical features only", did not by any proper logic entail that in any other case a lighting device could be precisely defined, without unduly restricting the scope of the device, in terms other than those pertaining to the chromaticity area.
- In the present case it was justified to define the invention in terms of the chromaticity area because of the numerous ways the invention could be implemented with a wide variety of structures.
- In the present case chromaticity was a technical feature in which inventiveness resided.
- The documents listed as examples of suitable LEDs for use in the invention (page 16, line 13 to page 7, line 17) were publicly available, using the application numbers listed, for example at <http://portal.uspto.gov/pair/PublicPair>.

- From the emitter wavelength indications in page 10, lines 6 to 8 and page 16, lines 8 to 10 as filed, the above list of exemplary LEDs, the phosphor particle sizes recited in claim 1 and the other qualities set out at page 17, line 18 to page 18, line 10 the skilled person would be able to make devices according to claim 1.

- (e) In a communication dated 26 February 2016, annexed to a summons to oral proceedings, the Examining Division stated that the "arguments were carefully considered", but that as "no new evidence" was provided, the Examining Division came to the conclusion to maintain the objections under Articles 84/84 [*sic*] EPC and Article 56 EPC as raised in the former communication of 11.05.2015 and, as far as concerned claims 1 -4, also former communication of 17.02.2014 in view of Articles 84, 54 and 56 EPC". No reasons were provided as to why the arguments set out in the reply dated 28 October 2015 were found not to be convincing.

- (f) In a reply dated 3 March 2017 the Applicant stated that they did not intend to submit new evidence or conduct comparative testing and noted that that the Examining Division had not cited any reference [*i.e. prior art*] against the pending claims. The Applicant made four statements as to what they considered the contentions presented by the Examining Division to include (see last four paragraphs of page 1). The Applicant maintained that the claims met the requirements of Articles 84, 83, 54 and 56 EPC.

- (g) In a further reply dated 17 March 2017 the Applicant requested a decision "on the basis of the

papers now on file, including [their] response filed on 3 March 2017".

Reasons for the Decision

1. The appeal is admissible.
2. Main Request, Rule 111(2) EPC
 - 2.1 At the time when the contested decision was issued, the requirements for issuing a refusal using a standard form referring to previous communications were set out in the Guidelines for Examination in the EPO, November 2016, C-V, 15.2.

According to the first paragraph of Guideline C-V, 15.2, in order to comply with the requirement that a decision be reasoned (Rule 111(2)), it is only possible to use this form of decision where the previous communication addresses all the arguments raised by the applicant.

The second paragraph of Guideline C-V, 15.2 states that it is possible by way of exception to refer to more than one communication in the standard form, but that the examiner should carefully consider the requirements of Rule 111(2) EPC. An example is given of a situation in which it might be not clear which of the reasons given by the Examining Division in its communications might be essential to the decision to refuse, and it is stated that in that situation a fully reasoned decision should be issued instead (see C-V, 15.3 "Issuing a self-contained decision").

2.2 In the present case, the applicant submitted some arguments in their reply dated 28 October 2015 that were not presented in their earlier submissions. The response to the Examining Division's argument that "enough applications are filed (and state of the art is existing) concerning lighting devices correctly defined by specific technical features only" and the indications about the public availability of the cited US Patent applications are but two examples.

The only subsequent communication of the Examining Division, that dated 26 February 2016, merely stated that the "arguments were carefully considered", but "no new evidence" was provided. Such blanket statements cannot be considered to address the arguments raised. Hence, the present "standard form" decision does not meet the requirements set out in the first paragraph of Guideline C-V, 15.2 and does not comply with the requirement of Rule 111(2) EPC that the decision be reasoned.

2.3 In addition to the above, the Examining Division stated in their communication dated 11 May 2015 that the examination in view of Article 54 and 56 EPC was deferred, but in the last communication dated 26 February 2016 they stated that the objections under Article 56 EPC as raised in the communication of 11 May 2015 and the objections under Articles 54 and 56 raised in the communication of 17 February 2014 were maintained. In view of these contradictory statements in the communications referred to in the present standard form decision, it is not clear which of the reasons given by the Examining Division under Articles 54 and 56 EPC, if any, might form part of the reasons for the decision to refuse. Hence, for reasons similar

to those set out in the example given in the second paragraph of Guideline C-V, 15.2, the decision does not comply with the requirement of Rule 111(2) EPC that the decision be reasoned.

2.4 Further to the above, the Board notes that the Examining Division's last communication before the contested decision was that dated 26 February 2016. The Applicant replied to that communication in a letter dated 3 March 2017 and made four comments as to what they considered the contentions presented by the Examining Division to include (see last four paragraphs of page 1). When the Applicant requested a "decision on the papers now on file" (letter of 17 March 2017, second paragraph), they expressly stated that this included their "response filed on 3 March 2017". Hence, the statement in the contested decision that the "applicant filed no comments ... in reply to the latest communication" is factually incorrect.

2.5 For the reasons set out above the Board considers that it was not appropriate in the circumstances for the Examining Division to use the "standard form" of decision referred to in Guideline C-V, 15.2. Either a self-contained decision (Guideline C-V, 15.3) or a further communication (Guideline C-V, 15.4) would have been appropriate. As a result the decision was not sufficiently reasoned to meet the requirement of Rule 111(2) EPC.

2.6 For these reasons the Board decided to accede to the Appellant's main request.

3. Request for Reimbursement of the Appeal Fee

In the present case the Board considers the failure to comply with the requirement of Rule 111(2) EPC to be a procedural violation that affects the entire basis of the appeal proceedings. Hence, the Board finds reimbursement of the appeal fee to be equitable by reason of a substantial procedural violation 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 request for reimbursement of the appeal fee is allowed.

The Registrar:

The Chairman:



U. Bultmann

R. Lord

Decision electronically authenticated