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**D E C I S I O N**  
of 7 July 1997

**Case Number:** T 0069/96 - 3.4.1

**Application Number:** 92900037.0

**Publication Number:** 0564473

**IPC:** H01L 29/06

**Language of the proceedings:** EN

**Title of invention:**

Piso electrostatic discharge protection device

**Applicant:**

HARRIS CORPORATION

**Opponent:**

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**Headword:**

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**Relevant legal provisions:**

EPC Art. 56, 108, 111(1), 123(2)

EPC R. 65(1)

**Keyword:**

"Admissibility of the Appeal (yes)"

"Case remitted to the Examining Division for further prosecution"

**Decisions cited:**

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**Catchword:**

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Case Number: T 0069/96 - 3.4.1

**D E C I S I O N**  
of the Technical Board of Appeal 3.4.1  
of 7 July 1997

**Appellant:**

HARRIS CORPORATION  
1025 West NASA Boulevard  
Melbourne  
Florida 32912 (US)

**Representative:**

van Berlyn, Ronald Gilbert  
23, Centre Heights  
London NW3 6JG (GB)

**Decision under appeal:**

Decision of the Examining Division of the  
European Patent Office posted 18 August 1995  
refusing European patent application  
No. 92 900 037.0 pursuant to Article 97(1) EPC.

**Composition of the Board:**

**Chairman:** G. D. Paterson  
**Members:** U. G. O. Himmler  
R. K. Shukla

## Summary of Facts and Submissions

- I. European patent application No. 92 900 037.0 was refused in a decision of the Examining Division on the ground that the subject-matter of each of the independent claims 1, 9 and 10 filed with the letter dated 8 July 1995 did not involve an inventive step having regard to the prior art document D1.

According to the decision, however, a combination of the subject-matter of claims 12, subject to certain further amendments for clarity, would not be obvious having regard to the cited prior art documents (see paragraph).

- II. A notice of appeal was duly filed, which included the following statement:

"The Appellants request that the Decision to Refuse the application be withdrawn, and that the claims be held to be inventive and allowable. **In particular, the Examining Division has indicated that in their evaluation, a combination of claims 10 and 12 would be inventive.**"

(Emphasis added by the Board)

No separate written statement of the grounds of the appeal was filed within the time limit according to Article 108 EPC. The Board decided that the above cited statement in the notice of appeal contains sufficient matter to be considered as the grounds of appeal in accordance with Article 108 EPC. The Appellant was notified accordingly in a communication of the Board, dated 25 October 1996.

- III. The Appellant was invited by a communication of the Board to file an unambiguous request for the grant of a patent based upon an amended independent claim containing a combination of the features of claims 10 and 12 mentioned in the last sentence of the notice of appeal. Further, the Appellant's attention was drawn to the objections under Article 84 EPC which were raised in the decision under appeal against the wording of claim 10.
- IV. The Appellant duly filed a new set of Claims 1 and 2 taking into account the objections raised in the communication of the Board. Further the Appellant requested that the decision of the Examining Division be set aside and a patent be granted on the basis of the newly filed claims 1 and 2. Minor amendments to the text of claim 1 were agreed by the Appellant's representative during a telephone call with the rapporteur on 28 May 1997. The text of the amended claim 1 was sent to the Appellant with a communication on 9 June 1997.

### **Reasons for the Decision**

1. *Admissibility of the appeal*
- 1.1 The appeal complies with Articles 106 to 108 and Rule 64 EPC, and is admissible.
- 1.2 In particular, the Board is satisfied that a statement of grounds of appeal was filed in due time: It is clear from the statement in the notice of appeal referred to in section II above that the Applicant no longer wishes to apply for a European patent containing claims as previously examined and refused by the Examining Division; instead, as is evident from the notice of

appeal the Appellant requests the grant of a patent based on a main claim containing subject-matter which was considered by the Examining Division to be "not obvious with respect to D1 or the other available prior art documents"; see paragraph 7 of the "Grounds for the Decision".

Thus, the Appellant in effect has requested that the examination of the application should be continued on the basis of a new text of the claims which is intended to meet the objections of the Examining Division.

- 1.3 Therefore, in the Board's judgement a statement of grounds of appeal within the meaning of Article 108 EPC was filed in due time and the appeal is admissible.

2. *Amendments*

The subject-matter of the amended claims 1 and 2 clearly had been disclosed in the originally filed documents:

The only independent claim 1 is a combination of the subject-matter of original claims 20 and 22, the expression, "as utilised in the CMOS and CMOS 3.5 processes" from original claim 20 being deleted in the amended claim 1 so as to overcome the objection of lack of clarity mentioned in section III above. Claims 20 and 22 correspond respectively to claims 10 and 12 forming the basis of the decision. Amended claim 1 also contains reference numerals to comply with the requirement of Rule 29(7) EPC. Dependent claim 2 is based on original claim 21.

Consequently, the amended claims meet the requirements of Article 123(2) EPC.

3. It therefore follows from the above that claim 1 as amended contains subject-matter which was regarded by the Examining Division as involving an inventive step having regard to the cited prior art.
4. However, the description and the drawings presently on file do not meet the requirements of the EPC and should be adapted and restricted to the subject-matter of the allowable claim 1.
5. Under these circumstances, in the Board's judgement, it is appropriate to exercise its power under Article 111(1) EPC and to remit the case to the Examining Division for further prosecution in respect of the description and the drawings.

## Order

For these reasons it is decided that:

1. The decision of the Examining Division is set aside.
2. The case is remitted to the Examining Division with an order to grant a European patent on the basis of claim 1 as sent with the communication dated 9 June 1997 and claim 2 as filed on 11 February 1997, with the description and drawings to be adapted accordingly.

The Registrar:



M. Beer

The Chairman:



G. D. Paterson