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**D E C I S I O N**  
**of 24 June 1996**

**Case Number:** T 0198/96 - 3.4.1

**Application Number:** 89123598.8

**Publication Number:** 0384031

**IPC:** H01L 21/28

**Language of the proceedings:** EN

**Title of invention:**

Semiconductor device and method for the production of an insulated film used in this device

**Applicant:**

MATSUSHITA ELECTRIC INDUSTRIAL CO., LTD.

**Opponent:**

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**Headword:**

Semiconductor device/MATSUSHITA

**Relevant legal provisions:**

EPC Art. 111(1)

**Keyword:**

"Substantial amendments filed with the statement of grounds of appeal"

"Remittal to the first instance"

**Decisions cited:**

T 0063/86

**Catchword:**

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Boards of Appeal

Chambres de recours

Case Number: T 0198/96 - 3.4.1

**D E C I S I O N**  
of the Technical Board of Appeal 3.4.1  
of 24 June 1996

**Appellant:** MATSUSHITA ELECTRIC INDUSTRIAL CO., LTD.  
1006, Ohaza Kadoma  
Kadoma-shi  
Osaka 571 (JP)

**Representative:** Schwabe - Sandmair - Marx  
Stuntzstrasse 16  
81677 München (DE)

**Decision under appeal:** Decision of the Examining Division of the European  
Patent Office posted 29 June 1993 refusing  
European patent application No. 89 123 598.8  
pursuant to Article 97(1) EPC.

**Composition of the Board:**

**Chairman:** G. D. Paterson  
**Members:** R. K. Shukla  
Y. J. F. van Henden

## Summary of Facts and Submissions

I. European patent application No. 89 123 598.8 was filed with a set of 8 claims, including two independent claims relating to a semiconductor device and two independent claims relating to a method for the production of a semiconductor device.

In a first communication dated 12 June 1991, the Examining Division indicated that the subject matter of each of the independent claims lacked novelty in view of a cited prior art document D1, and that the dependent claims appeared to lack an inventive step.

In its reply dated 16 December 1991, the Applicant filed a set of claims including two independent claims, one of which related to a semiconductor device as in the earlier claim 1 and the other to a method for the production of a semiconductor device as in the earlier claim 5, and submitted that these claims were new in relation to the cited prior art.

In a second communication dated 6 March 1992, the Examining Division maintained the objection of lack of novelty. An objection under Article 84 was also raised against the independent claims.

With its letters dated 2 July 1992 and 21 July 1992, the Applicant filed claims forming respectively a main request, a first auxiliary request and a second auxiliary request.

In a communication annexed to a summons to oral proceedings, the objection of lack of novelty was maintained against the independent claims of all the requests and a reference was made to a further prior art document D2.

During the oral proceedings before the Examining Division, the Applicant withdrew all the previous requests and instead requested the grant of a patent on the basis of two claims both relating to a method for the production of a semiconductor device.

- II. The Examining Division refused the application on the ground that the subject matter of both such claims lacked novelty in view of the cited prior art documents.
- III. The Applicant lodged an appeal against the decision and requested in the Statement of grounds of appeal that a patent be granted on the basis of an amended set of claims 1 to 13, including six independent claims directed to a method of operating a semiconductor device, two independent claims relating to a semiconductor device and two independent claims relating to a method of manufacturing a semiconductor device.

### Reasons for the Decision

- 1. It is apparent from paragraph III above that the Applicant now wishes the grant of a patent on the basis of an amended set of claims which includes for the first time a new category of claims, i.e. of a **method of operating a semiconductor device**. The claims in this new category include subject-matter which was not claimed in

any of the claims filed during the proceedings before the Examining Division, and the remaining claims also include features which were not previously considered by the Examining Division.

2. Under these circumstances, following the established jurisprudence of the Boards of Appeal (see T 63/86, OJ EPO 1988, 224, Headnote I and II and paragraph 2 of "Reasons for the Decision" ), the present Board has decided to exercise its power under Article 111(1) EPC to remit the case to the Examining Division for further examination of the admissibility and the allowability of the amended claims 1 to 13 filed with the Statement of grounds of appeal, having regard to the requirements of the EPC.

### **Order**

**For these reasons it is decided that:**

The case is remitted to the Examining Division for further Examination.

The Registrar:

The Chairman:

M. Beer

G. D. Paterson

