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D E C I S I O N
of 29 April 2003

Case Number: T 1096/00 - 3.4.3

Application Number: 94924580.7

Publication Number: 0674814

IPC: H01L 21/58

Language of the proceedings: EN

Title of invention:

Method of forming interface between die and chip carrier

Applicant:

TESSERA, INC.

Opponent:

-

Headword:

Chip carrier/TESSERA

Relevant legal provisions:

EPC Art. 113(1), 111(1)

EPC R. 67

Keyword:

"Substantial procedural violation (yes) - decision based on an objection which was not substantiated in a previous communication"

"Reimbursement of the appeal fee (yes)"

"Remittal (yes)"

Decisions cited:

T 0951/92

Catchword:

-



Case Number: T 1096/00 - 3.4.3

D E C I S I O N
of the Technical Board of Appeal 3.4.3
of 29 April 2003

Appellant: TESSERA, INC.
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San Jose
CA 95134 (US)

Representative: Harrison, Michael Charles
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Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 31 May 2000
refusing European patent application
No. 94 924 580.7 pursuant to Article 97(1) EPC.

Composition of the Board:

Chairman: R. K. Shukla
Members: G. L. Eliasson
M. J. Vogel

Summary of Facts and Submissions

I. European patent application No. 94 924 580.7 was refused in a decision of the examining division dated 31 May 2000. The ground for the refusal was that the application did not meet the requirements of novelty and unity of invention.

II. Claim 1 under consideration in the decision under appeal reads as follows:

"1, A method of forming a mounting structure for a semi-conductor chip (10) characterized by the steps of

providing a flexible chip carrier (26) having a top surface and a bottom surface, terminals (30) disposed on said top surface and leads (29) in electrical connection with said terminals,

placing said chip carrier (26) a given distance above said chip (10) to create a gap (34) between said chip carrier (26) and said chip (10), said bottom surface facing said chip;

bonding said leads to said chip; and

introducing a liquid (50) into said gap (34) such that said liquid is disposed between said chip carrier (26) and said chip (10)."

III. In the only official communication pursuant to Article 96(2) and Rule 51(2) EPC before the issue of the decision to refuse the application, objections were raised *inter alia* that the application in suit did not

meet the requirements of unity of invention within the meaning of Article 82 EPC and that the subject matter of claims 1 to 3, 12, 13, 18, 22 and 23 as published was not new having regard to the document

D1: JP-A-5-236 091 (published on 10 September 1993)
& Patent Abstracts of Japan vol. 17, no. 687
(E-1478) (published on 16 December 1993).

The only references made to document D1 in this communication were as follows:

"Independent claims 1 and 30 have essentially the common corresponding technical features of (i) providing a flexible chips carrier, (ii) placing the flexible chip carrier above a chip to create a gap there between, and (iii) filling the gap with a flowable material/liquid. This common subject matter is known from D1."

"The subject-matter of claims 1-3, 12, 13, 18, 22 and 23 is not novel with respect to D1 contrary to the requirements of Articles 52(1), 54(1) and (2) EPC."

IV. In response to this communication the applicant filed revised claims 20 to 22 and argued that claim 1 as published was novel having regard to document D1.

V. The examining division thereafter refused the application for lack of unity and lack of novelty having regard to document D1, and referred to Figures 2(A), 2(B), 1(C) and corresponding text of document D1 for the first time in its decision. Reference was also made for the first time in the decision to the disclosure of the family document US-A-5 350 947,

published after the priority date of the application in suit, as providing English translation of document D1.

- VI. The appellant (applicant) lodged an appeal on 28 July 2000, paying the appeal fee the same day. A statement of the grounds of appeal was filed on 10 October 2000 together with new claims.
- VII. In a communication accompanying summons for oral proceedings, the Board furnished an English translation of document D1 and gave its preliminary opinion regarding patentability of the appellant's requests.
- VIII. At the oral proceedings held on 29 April 2003, the appellant requested that the decision under appeal be set aside and that the appeal fee be reimbursed on the grounds that a substantial procedural violation was committed by the first instance in issuing the decision under appeal and the case be remitted to the first instance for further prosecution. Auxiliary, the appellant requested that a patent be granted on the basis of the main, first, second or third auxiliary request, all filed with the statement of the grounds of appeal.
- IX. The appellant's arguments relevant for the present appeal, can be summarized as follows:
- (i) The appellant's right to be heard under Article 113(1) EPC was violated, since the application was refused after the first communication which merely alleges lack of novelty without supporting reasoning. In the absence of a reasoned explanation which could substantiate the allegation of lack of novelty,

the communication lacks the legal and factual reasoning on which the decision to refuse is based.

The same holds true for the objection to lack of unity, since this objection relies on the alleged disclosure of document D1 of the special technical features common to claims 1 and 30.

- (ii) Despite severe difficulties in understanding the basis for the objections raised in the first communication, the appellant provided a response which not only indicated the portions of document D1 at issue but also set out a credible interpretation of the disclosure of document D1.

- (iii) Furthermore, the refusal after a single communication violates the principle of good faith since the applicant made a bona fide attempt to address all issues raised in the communication, despite the severe difficulties in understanding the basis for the objections raised.

Reasons for the Decision

1. The appeal meets the requirements of Articles 106 to 108 and Rule 64 EPC and is therefore admissible.

2. *Substantial Procedural Violation and Reimbursement of the Appeal Fee*

The appellant's request for reimbursement of the appeal fee under Rule 67 EPC on the ground that a substantial

procedural violation was committed by the examining division is granted for the following reasons:

- 2.1 Article 113(1) EPC states that 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.

In the present case, the appellant argued that the provisions of Article 113(1) EPC were violated, since the first communication lacked a reasoned explanation which could substantiate the allegations of lack of novelty and lack of unity of invention, and the application in suit was refused immediately after the appellant's response to the first communication.

- 2.2 It was held in decision T 951/92 (OJ EPO 1996, 53) that one of the purposes of Article 113(1) EPC is to safeguard that before a decision refusing an application is issued, the applicant has been informed about the legal and factual reasons for the refusal. Therefore, if a communication under Article 96(2) and Rule 51(3) EPC does not satisfy the requirements of Article 113(1) EPC, in that it does not set out the essential legal and factual reasoning which would lead to a finding that a requirement of the EPC has not been met, then a decision based upon such a finding cannot be issued without contravening Article 113(1) EPC unless and until a communication has been issued which does contain such essential reasoning (cf. T 951/92, reasons, items 3(v) to (viii)). The failure of sending a further communication before issuing a decision was also found to constitute a violation of Article 96(2) EPC.

2.3 In the present case, the first communication of the examining division (in the following referred to as "the communication") merely asserted that all features of claim 1 as published were known from document D1 without referring to any relevant text passages or figures (cf. item III above). Therefore, the communication contained no factual reasoning at all, since it failed to inform the applicant where in document D1 the corresponding process steps of claim 1 were disclosed.

Even assuming that the communication made an implicit reference to the embodiment of Figures 1(A) to (C) which was reproduced in the corresponding abstract published in Patent Abstracts of Japan, and notwithstanding the fact that the abstract was published after the priority date of the application in suit, it is not derivable from the abstract alone whether or not document D1 discloses all the features of claim 1 as published, since the figures in the abstract merely disclose the assembled structure of a chip mounted to a flexible chip carrier, whereas claim 1 is directed to a method of forming such a structure.

2.4 In contrast to the lack of reasoning given in the first communication, the decision under appeal makes reference to Figures 2(A), 2(B), and 1(C) and corresponding text of JP-A-5-236 091 and provides a detailed discussion of the disclosure provided in the cited passage. Furthermore, the family document US-A-5 350 947 was cited for the first time in the decision as a translation.

Thus, the appellant was for the first time informed in

detail in the decision under appeal as to why the application was found not to meet the requirements of novelty and unity of invention.

2.5 It follows from T 951/92 referred to under item 2.2 above that the fact that the appellant provided a detailed analysis of document D1 in his response to the communication does not relieve the examining division from the duty under Article 113(1) EPC of communicating to the appellant a reasoned objection against patentability before issuing a decision to refuse the application. In the present case, the appellant in preparing his response to the communication was clearly left to guess on his own which passages of document D1 would be pertinent. It was therefore necessary to send a further communication before issuing a decision.

2.6 Thus, in the Board's judgement, the above violation is to be considered a substantial procedural violation within the meaning of Rule 67 EPC.

The appellant has requested that the case be remitted to the department of first instance. In view of the substantial procedural violation committed, the Board grants this request for remittal pursuant to Article 111(1) EPC.

Under these circumstances, it is equitable to reimburse the appeal fee.

3. The communication of the Board accompanying the summons to oral proceedings contained the provisional opinion of the Board regarding novelty and unity of invention of the claims on file. The examining division in its further prosecution of the application in suit not

bound in any manner by the opinions expressed in the above-mentioned communication of the Board.

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 the first instance for further prosecution.
3. The appeal fee is to be refunded.

The Registrar:

The Chairman:

P. Martorana

R. K. Shukla