

**Internal distribution code:**

- (A) [ ] Publication in OJ  
(B) [ ] To Chairmen and Members  
(C) [X] To Chairmen  
(D) [ ] No distribution

**D E C I S I O N**  
**of 29 September 2004**

**Case Number:** T 0095/04 - 3.4.3

**Application Number:** 98913144.6

**Publication Number:** 0983612

**IPC:** H01L 27/108

**Language of the proceedings:** EN

**Title of invention:**

A thermal conducting trench in a semiconductor structure and method for forming the same

**Applicant:**

INTEL CORPORATION

**Opponent:**

-

**Headword:**

-

**Relevant legal provisions:**

EPC Art. 96(2), 113(1), 116(1)

EPC R. 67

**Keyword:**

"Request for an opportunity of being heard"

"Refund of the appeal fee"

**Decisions cited:**

T 0084/82, T 0161/82, T 0162/82, T 0283/88, T 0300/89,  
G 0005/91

**Catchword:**

-



Case Number: T 0095/04 - 3.4.3

**D E C I S I O N**  
of the Technical Board of Appeal 3.4.3  
of 29 September 2004

**Appellant:** INTEL CORPORATION  
2200 Mission College Boulevard  
P.O. Box 58119  
Santa Clara  
CA 95052-8119 (US)

**Representative:** Molyneaux, Martyn William  
Harrison Goddard Foote  
40-43 Chancery Lane  
London WC2A 1JA (GB)

**Decision under appeal:** Decision of the Examining Division of the  
European Patent Office posted 22 October 2003  
refusing European application No. 98913144.6  
pursuant to Article 97(1) EPC.

**Composition of the Board:**

**Chairman:** R. K. Shukla  
**Members:** V. L. P. Frank  
J. P. B. Seitz

## Summary of Facts and Submissions

- I. The appeal lies against the decision of the Examining Division dated 22 October 2003 to refuse the European patent application No. 98 913 144.6.
- II. The Examining Division objected in the first and sole communication pursuant to Article 96(2) and Rule 51(2) EPC *inter alia* that the subject-matter of all claims was not new (Article 52(1) and 54 EPC) and stated that there appeared to be no possibility of overcoming this objection by amendments to the claims.

With his response the applicant submitted amended claims and, after presenting his arguments on the objections raised by the Examining Division, stated that:

"It is believed that we have responded to each and every one of the Examiner's objections as we understand them. If the Examiner is of the view that there remains an outstanding matter then the Examiner is requested to telephone the undersigned. **It is, in any event, requested that no adverse dispositions be taken to this application without providing the applicant with an opportunity of being heard.**" (Emphasis added by the Board)

The Examining Division did not issue a further communication or contact the applicant before issuing the decision under appeal. In the decision it is stated under the point titled "Procedural Matters":

"Regarding the applicant's request in the letter of 04.12.2002 for a telephone call from the examiner or a further opportunity to be heard, the examining division notes that the examining division shall exercise its discretion in deciding whether to invite the applicant to file further observations before issuing a decision (Article 96(2) EPC). According to decision T 162/82 of the Board of Appeal such discretion should be exercised in favour of inviting the applicant to file further observations if there is a reasonable prospect that such an invitation could lead to the grant of a patent. In the present case no patentable subject-matter is contained in the claims or is apparent from the application documents as a whole. Thus, in the opinion of the examining division, there is no reasonable prospect for the grant of a patent. Consequently, the applicant's request is refused.

In this respect, reference is made also to the decisions T 84/82, T 161/82, T 300/89 of the Board of Appeal according to which the refusal of an application after the first communication is justified, if, as in the present case, after the applicant's reply decisive objections against patentability remain valid."

- III. The appellant (applicant) lodged an appeal against the above decision on 17 December 2003 together with the statement setting out the grounds of appeal. The appeal fee was paid on the same day.

The appellant requested that the decision under appeal be set aside and that a patent be granted on the basis of a main, first or second auxiliary request, which were filed together with the statement of grounds of appeal.

He further requested the reimbursement of the appeal fee, as the decision to refuse the application in suit was given without providing the applicant with an opportunity of being heard at oral proceedings, this amounting to a substantial procedural violation.

In view of the substantial procedural violation by the Examining Division, and bearing in mind the rapidity in which developments are made in the particular field of the application, an accelerated appeal procedure was further requested.

- IV. In a communication the Board expressed its view that a substantial procedural violation had been committed and invited the appellant to indicate whether the Board should remit the case to the first instance department for further prosecution or should itself decide on the substantive issues of the appeal.
  
- V. In his reply to the communication, the appellant requested that the case be remitted to the Examining Division for further prosecution on the basis of the requests submitted with the letter of 17 December 2003 and repeated his request for refund of the appeal fee.

## Reasons for the Decision

1. The appeal is admissible.

2. *Procedural matters*

2.1 It follows from the facts of the case set out in item II above that in his reply to the communication of the Examining Division the appellant had requested a telephone call from the examiner in the event that there was outstanding matter, and in any event an opportunity to be heard before an adverse disposition was taken to the application.

According to the appellant this last request was a request for oral proceedings under Article 116 EPC which should not have been dismissed by the Examining Division, as oral proceedings are mandatory and not discretionary. Moreover, if there remained any doubts as to whether or not oral proceedings were requested, clarification should have been sought from the applicant (cf. T 283/88).

2.2 In the decision under appeal the Examining Division dismissed the request for a telephone call to the applicant and, in connection with the request for a further opportunity of being heard, pointed out its discretionary power under Article 96(2) EPC to issue a further communication, referring to several decisions of the Boards of Appeal according to which the refusal of an application after the first communication was justified if decisive objections against patentability remained (cf. T 84/82, T 161/82, T 300/89).

2.3 The Board does not concur, for the following reasons, with the appellant that a request for an opportunity of being heard is an unambiguous request for oral proceedings according to Article 116(1) EPC.

Article 113(1) EPC stipulates that the decisions of the EPO shall only be based on grounds or evidence on which the parties concerned have had an opportunity to present their comments. This principle is often quoted as the right to be heard. The opportunity for the party to present comments or for being heard by the competent EPO department, however, does not necessarily require in ex-parte proceedings the appointment of oral proceedings according to Article 116(1) EPC, as this opportunity may also be provided, after a first written communication under Article 96(2) EPC has been issued, by a further written communication, a telephone conversation or an informal interview with the examiner.

2.4 In the present case, the applicant's request for a telephone call from the examiner was followed by a further request "in any event" for an opportunity to be heard before an adverse decision was taken. In the Board's view, the expression "in any event" in its context clearly implied that in the event that the examiner was to exercise its discretion and not to communicate further with the applicant, eg by way of a telephone call, an interview or a written communication, then the applicant wished to have a further opportunity to be heard which under the circumstances could only be provided by appointing oral proceedings.

- The Examining Division construed the applicant's request for an opportunity to be heard out of its context and interpreted it to mean a request for a further communication, and exercised its discretion against issuing such a communication (cf. item 8, "Procedural matters" of the decision under appeal).
- 2.5 The Board concludes, for these reasons, that the above mentioned request of the applicant included on its proper interpretation a request for appointment of oral proceedings under Article 116(1) EPC. The failure to appoint oral proceedings once such a request was presented is, according to the established case law of the Boards of Appeal, a substantial procedural violation. The decision under appeal is therefore void *ab initio* and has to be set aside. The case, moreover, has to be remitted to the first instance department without the Board considering the substantive issues of the case (Article 10 RPBA) (cf. Case Law of the Boards of Appeal, 4<sup>th</sup> edition 2001, VI.C.1). This corresponds, moreover, to the request of the appellant.
- 2.6 The Board considers that, under the present circumstances, the reimbursement of the appeal fee is equitable, since a substantial procedural violation has occurred. As the appeal is allowed, all the requirements of Rule 67 EPC are fulfilled.
3. The Board wishes to point out that the applicant could and should have prevented the misinterpretation of his request had he made a clear and specific request for oral proceedings.



Also, the Examining Division, if in doubt, should have contacted the applicant for clarification of his request relating to an unqualified procedural right.

4. The Examining Division has decided in the decision under appeal that the subject-matter of the claims is not new and further expressed its view that the application does not contain any patentable subject-matter.

It is a general principle of law that nobody should decide a case in respect of which a party may have good reasons to assume partiality. This principle applies not only to the members of the Boards of Appeal according to Article 24(1) EPC, but also to the members of the departments of the first instance of the EPO taking part in decision-making activities affecting the rights of any party (cf. G 5/91, OJ 1992, 617).

Consequently, the Board considers it appropriate under the present circumstances that an Examining Division in a different composition with three new members, from the one which issued the decision under appeal, is appointed for the further prosecution of the case.

**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 on the basis of the requests submitted with letter of 17 December 2003.
3. The case shall be prosecuted by an Examining Division in a different composition with three new members, from the one which issued the decision under appeal.
4. The appeal fee shall be reimbursed.

The Registrar:

The Chairman:

D. Meyfarth

R. K. Shukla