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**Datasheet for the decision
of 18 October 2007**

Case Number: T 1366/05 - 3.3.10

Application Number: 98945462.4

Publication Number: 0975710

IPC: C09K 11/06

Language of the proceedings: EN

Title of invention:

Polymer electroluminescent device

Patentee:

Koninklijke Philips Electronics N.V.

Opponent:

Merck KGaA

Headword:

Polymer electroluminescent device/PHILIPS

Relevant legal provisions:

EPC R. 67, 68(2)

Keyword:

"Decision reasoned in the sense of Rule 68(2) EPC (no) - absence of reasoning proper to the Opposition Division - sole statement of the conclusions of Division - mere summary of Party's submissions does not reason the decision"

"Substantial procedural violation (yes)"

"Reimbursement of appeal fee (yes)"

"Remittal to the first instance for further prosecution"

Decisions cited:

T 0278/00

Headnote:

1. A written decision of an Opposition Division revoking a patent for lack of novelty to be reasoned in the sense of Rule 68(2) EPC must contain a logical chain of reasoning starting with the identification of that portion of the prior art used to justify the conclusion that the claimed subject-matter lacks novelty. The sole statement of the conclusion reached does not constitute a reasoning within the meaning of Rule 68(2) EPC.
2. Any reasoning arriving at the conclusion that the subject-matter of a claim lacks novelty must be proper to the deciding body. The mere summary of a party's submission is not *per se* a reasoning proper to the deciding body.
3. A written decision which is based on such a deficient reasoning is not reasoned in the sense of Rule 68(2) EPC, which failure amounts to a substantial procedural violation.



Case Number: T 1366/05 - 3.3.10

D E C I S I O N
of the Technical Board of Appeal 3.3.10
of 18 October 2007

Appellant:
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Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 22 August 2005
revoking European Patent No. 0975710 pursuant
to Article 102(1) EPC.

Composition of the Board:

Chairman: R. Freimuth
Members: J.-C. Schmid
P. Schmitz

Summary of Facts and Submissions

- I. The Appellant (Proprietor of the patent) lodged an appeal on 24 October 2005 against the decision of the Opposition Division posted on 22 August 2005 revoking European patent No. 975 710 comprising independent claims 1, 5 and 6 directed to an electroluminescent device, a soluble poly(1,4-phenylenevinylene) and an intermediate compound suitable for the preparation of a poly(1,4-phenylenevinylene).
- II. Notice of opposition had been filed by the Respondent (opponent) requesting revocation of the patent in suit in its entirety on the grounds of lack of novelty and inventive step (Article 100(a) EPC), citing documents
 - (1) WO-98/25874,
 - (2) WO-98/27136 and
 - (3) US-A-5 558 904.
- III. The Opposition Division held that the subject-matter of claims 1 to 5 lacked novelty with respect to documents (2) and (3) and this of claim 6 with respect to document (1).

The decision under appeal, in its second part "Reasons for the Decision", comprised a point 4 headed "Articles 100(a) and 54 EPC" which was the only one dealing with the issue of novelty and which consisted of three different paragraphs. The two first paragraphs 4.1 and 4.2 thereof reproduced what "the opponent stated in his letter of opposition", as indicated in the decision under appeal. The third and last paragraph

thereof justified the finding of the Opposition Division having the following wording:

"4.3 According to the opinion of the opposition division, each of the cited documents D2 and D3 anticipates the subject matter of granted claims 1 to 5 of the patent in suit. Furthermore, the document D1 anticipates the subject matter of granted claim 6 of the patent in suit."

- IV. Besides the submissions as to the substantive issues, the Appellant in its statement of the grounds of appeal objected to that there was a procedural violation of the Opposition Division which failed *inter alia* to render a reasoned decision, since the decision under appeal only comprised a summary of the facts regarding the opponent's submissions and a statement that the subject-matter claimed lacked novelty.
- V. The Respondent did not submit any comment as to the issue of a procedural violation by the Opposition Division.
- VI. In a communication pursuant to Article 110(2) EPC, the Board informed the Parties that it may consider the contested decision to be inadequately reasoned constituting a substantial procedural violation such that the reimbursement of the appeal fee would be equitable and the case would have to be remitted to the first instance for further prosecution. The Parties were asked to redefine their requests for oral proceedings.

VII. On 25 May 2007, the Respondent withdrew its request for oral proceedings should the case be remitted to the department of first instance.

On 4 June 2007, the Appellant withdrew its request for oral proceedings should the Board remit the case to the department of first instance and order the reimbursement of the appeal fee.

VIII. The Appellant requested that the decision under appeal be set aside, that the patent be maintained as granted and that the appeal fee be reimbursed.

The Respondent requested that the appeal be dismissed.

Reasons for the Decision

1. The appeal is admissible.
2. The Appellant has objected to the decision under appeal revoking the patent for lack of novelty *inter alia* as being insufficiently reasoned in violation of Rule 68(2) EPC. Therefore, before considering the substantive issue of novelty, it should first be examined whether the decision under appeal respects the requirement of that provision.
3. According to established jurisprudence of the Boards of Appeal, to satisfy the requirement of Rule 68(2) EPC a decision must contain, in logical sequence, those arguments which justify its tenor. The conclusions drawn by the deciding body from the facts and evidence must be made clear. Therefore all the facts, evidence

and arguments which are essential to the decision must be discussed in detail in the decision including all the decisive considerations in respect of the factual and legal aspects of the case. The purpose of the requirement to reason the decision is of course to enable the Appellant and, in case of an appeal, also the Board of Appeal to examine whether the decision could be considered to be justified or not (see T 278/00, OJ EPO, 2003, 546).

4. In the present case, the deciding body, here the Opposition Division, decided on the issue of novelty, namely that the claimed subject-matter of the patent in suit was not novel in view of the prior art (Article 54 EPC). Accordingly, the logical chain of reasoning of the Opposition Division starting with the identification of that portion of the prior art used to justify the final conclusion that the claimed subject-matter lacks novelty must be indicated in the decision under appeal.

The only part of the section "Reasons for the Decision" of the written decision under appeal dealing with the issue of novelty is to be found in point 4 comprising three paragraphs. The third and last paragraph thereof, i.e. paragraph 4.3, is the sole portion of the written decision under appeal which may reveal considerations and findings of the Opposition Division on the issue of novelty and, thus, is the sole portion of the decision which could justify the Opposition Division's conclusion of lack of novelty. However, there is no reasoning at all in that paragraph which is limited to the mere statement of the conclusion reached by the Opposition Division, namely that documents (2) and (3)

anticipate the subject-matter of claims 1 to 5 and that document (1) anticipates the subject-matter of claim 6. That paragraph 4.3 of the written decision under appeal nowhere indicates relevant passages of the documents cited, specific features disclosed therein and considerations why those features are disclosed in combination resulting necessarily in the conclusion of lack of novelty of the subject-matter claimed.

Accordingly, in the written decision there is no reasoning proper to the Opposition Division for its conclusion that the subject-matter of the claims lacks novelty. The sole statement of the conclusion reached does not constitute a reasoning within the meaning of Rule 68(2) EPC.

5. The two first paragraphs of that point 4, i.e. paragraphs 4.1 and 4.2 of the written decision under appeal, merely summarize the submissions of the opponent in respect of novelty generally citing pages and passages in documents (1), (2) and (3). Thus these two paragraphs in fact would rather belong to the section "Facts and Submissions" of the written decision under appeal and they do not reflect the Opposition Division's own considerations. The mere summary of a party's submission is not *per se* a reasoning proper to the deciding body. Consequently, both paragraphs 4.1 and 4.2 cannot reason the decision taken by the Opposition Division.

However, even if one were to assume that the Opposition Division adopted the summary of the opponent's submission as its own considerations and findings, this would still not render the decision reasoned in the

sense of Rule 68(2) EPC, since this summary consists of mere citations of passages of documents (1), (2) and (3) without specifying any detailed information or feature disclosed therein.

6. Hence, the decision under appeal fails to set out the factual and legal considerations supporting the decision taken by the Opposition Division.

Due to the above deficiencies of the decision under appeal the reasons for the revocation of the patent-in-suit are opaque as the Board is left in the dark as to how the first instance came to its negative conclusion in respect of the subject-matter claimed. Hence, it would be left to the Board to provide for itself some reasoning supporting that decision. This is just what Rule 68(2) EPC requiring a decision to be reasoned is designed to prevent.

7. For these reasons, in the Board's judgement, the decision under appeal which is based on such a deficient reasoning is not "reasoned" in the sense of Rule 68(2) EPC. This failure amounts to a substantial procedural violation requiring the decision under appeal to be set aside and the case to be remitted to the first instance. The appeal is thus deemed to be allowable and the Board considers it to be equitable by reason of that substantial procedural violation to reimburse the appeal fee in the present case (Rule 67 EPC).
8. In these circumstances, the Appellant's and Respondent's conditional requests for oral proceedings do not apply, since the requests for oral proceedings

were withdrawn by the Parties if the case was remitted to the first instance and the appeal fee was reimbursed.

9. When reconsidering the case, the Opposition Division will also have to consider the submissions filed during the appeal proceedings and to examine in particular the issue whether or not documents (1) and (2) are non-prejudicial disclosures within the meaning of Article 55 EPC.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the first instance for further prosecution.
3. The appeal fee is to be reimbursed.

The Registrar

The Chairman

P. Cremona

R. Freimuth