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**Datasheet for the decision  
of 22 November 2007**

**Case Number:** T 0883/07 - 3.4.03

**Application Number:** 00926042.3

**Publication Number:** 1208592

**IPC:** H01L 21/66

**Language of the proceedings:** EN

**Title of invention:**

Method and apparatus for run-to-run controlling of overlay registration

**Applicant:**

ADVANCED MICRO DEVICES, INC.

**Opponent:**

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**Headword:**

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**Relevant legal provisions:**

EPC Art. 82

EPC R. 67

**Keyword:**

"Unity of invention"

"Reimbursement of appeal fee (yes)"

**Decisions cited:**

G 0002/92

**Catchword:**

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Case Number: T 0883/07 - 3.4.03

**D E C I S I O N**  
of the Technical Board of Appeal 3.4.03  
of 22 November 2007

**Appellant:** ADVANCED MICRO DEVICES, INC.  
One AMD Place  
Mail Stop 68  
Sunnyvale, CA 94088-3453 (US)

**Representative:** Brookes Batchellor LLP  
102-108 Clerkenwell Road  
London EC1M 5SA (GB)

**Decision under appeal:** Decision of the Examining Division of the  
European Patent Office posted 11 January 2007  
refusing European application No. 00926042.3  
pursuant to Article 97(1) EPC.

**Composition of the Board:**

**Chairman:** R. G. O'Connell  
**Members:** V. L. P. Frank  
U. Tronser

## Summary of Facts and Submissions

- I. This is an appeal from the refusal of application 00 926 042 for lack of clarity (main request).

The reason given for refusing the other requests was that "claims 1 of the first to third auxiliary requests lack unity with respect to claim 1 of the primary (main) request".

- II. In the decision under appeal the examining division found that the term "control thread" employed in claim 1 of the main request was not clear, as the application did not describe in detail what was meant by this term.

The examining division also noted that in its first communication it had objected that none of the claims of the then main request, which did not include the "control thread" feature, involved an inventive step and that this had been implicitly accepted by the applicant by amending the claims. This implied that none of the features of the claims of the main request provided a single general inventive concept linking the group of inventions formed by the primary (main) and the first to third auxiliary requests (Article 82 EPC).

It referred in this context to G 2/92 (OJ 193, 591) which states "At the examination stage, having regard to the requirement of unity of invention and the fact that only one examination fee can be paid for each application, clearly only one invention in each application is to be examined for conformity with the patentability and other requirements of the EPC."

III. The appellant applicant argued essentially as follows:

- The refusal was based on a misunderstanding of the role of auxiliary claim requests. The purpose of auxiliary claim requests was to set out fall-back positions. In the present case the examining division had not properly examined these separate fall-back positions on their merits, an error which entitled the appellant to reimbursement of the appeal fee.
  
- If the examiner's interpretation of the unity of invention requirement were correct, no amendment would be permissible after an inventive step objection was raised against a set of claims.

IV. The appellant applicant requests that the decision under appeal be set aside and that a patent be granted on the basis of the first to third auxiliary requests filed before and disregarded by the examining division. He further requests reimbursement of the appeal fee.

### **Reasons for the Decision**

1. The appeal is admissible.
  
2. The appellant applicant has not contested the finding of lack of clarity of claim 1 of the main request as refused. Moreover, the contested expression "control threads" does not appear in the auxiliary claim requests. Hence the sole issue in this appeal is the

manner in which the auxiliary requests have been dealt with.

3. In examining the first auxiliary request the examining division erred in comparing it with the main request. In fact, in examining an amended application, which is what an "auxiliary claim request" is, the comparison to be made for examining permissibility of the amendment for the purposes of Article 123(2) EPC and Rule 86 EPC is with the **application as originally filed** - in this case at the PCT receiving office and as published pursuant to Rule 48 PCT - which formed the basis for the International Search Report. This is more than a terminological inexactitude, since in the present case the claims were amended on entry into the regional phase, these **amended** claims constituting the main claim request as refused in the decision under appeal.
4. Given that the examination of the first auxiliary request started with such a procedural misstep it is almost irrelevant that the error was compounded by an excessively literal interpretation of a sentence of G 2/92, taken out of context, which, as the appellant applicant correctly pointed out, would render nugatory not only auxiliary requests but even dependent claims in the event of an inventive step objection to the main claim.
5. Considering further the erroneous unity reasoning of the examining division, it appears to the board necessary to emphasize that the requirement of unity of invention, ie Article 82 EPC, applies only to the (currently valid) European application, which is formed according to Article 78(1) EPC by a request for grant,

description, claims, drawings and an abstract; and does not apply to any relationship between successive claim requests, since only one of these claim requests may form the patent application. The requirement of unity of invention requires that different inventions **within the same claim request** be linked by a single general inventive concept, without regard to whether they are claimed in separate claims or as alternatives within a single claim (Rule 30(2) EPC). The purpose of auxiliary claim requests is to speed up the proceedings before the department dealing with the application or the patent, as each request can be successively examined until an allowable request is found. These claim requests, however, do not coexist in parallel, but form a stack which has to be considered - each one independently of all the others - in the sequence indicated by the applicant or patent proprietor (Guidelines C-VI.4.1 and E-X 3), as it is impossible to grant a European patent on two different claim requests for the same contracting state.

6. As a procedurally proper examination of the first to third auxiliary requests has not yet commenced, it is appropriate to remit the case to the department of first instance for further prosecution on the basis of these claim requests (Article 111(1) EPC).

7. *Reimbursement of the appeal fee (Rule 67 EPC)*

In accordance with generally recognised procedural requirements, albeit not codified specifically in the EPC, once a higher order request is refused that request is off the table and the next request in the order chosen by the requester has to be considered as

if it were the sole request. In the present case, the failure to examine the auxiliary requests independently of the main request, which main request did not correspond to the application as originally filed, amounted to a substantial procedural violation within the meaning of Rule 67 EPC. Reimbursement of the appeal fee is equitable given that the appellant had to file this appeal to have his auxiliary claim requests properly examined.

**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.
3. The appeal fee is reimbursed.

Registrar

Chair

S. Sánchez Chiquero

R. G. O'Connell