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REPRESENTATION AT OIIM - TRADEMARKS AND DESIGN

Ihr Zeichen/Your ref.

Ihr Schreiben/Your letter

Unser Zeichen/Our ref.

MENE30081

München,

November 20, 2013

Opposition appeal proceedings concerning EP 1 449 238

Dear Sean,

We make reference to earlier correspondence regarding the opposition appeal proceedings, and we understand that you wish to hear our views on these proceedings, especially with respect to the oral hearing that is scheduled for tomorrow and Friday, November 21 and 22, 2013, at the EPO's Board of Appeal.

The current status of these proceedings is that in the first instance, the EPO's Opposition Division has revoked the granted patent, thus effectively revoking all claims directed at an electro luminescence layer as such, but maintained amended claims directed at an organic light emitting device comprising a heterostructure containing an emissive layer that produces luminescent emission when a voltage is applied across the heterostructure wherein the emissive layer includes a molecule that is a phosphorescent organometallic iridium compound.

- 42.318 -

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The patentee has filed an appeal to request a patent corresponding to the originally granted patent. Likewise, the three opponents in this case, i.e. Sumation Company Ltd., Merck Patent GmbH and BASF AG have appealed the decision and have requested a revocation of this patent in its entirety.

In most cases, the decision by the Board of Appeal represents the final decision regarding the opposition. Generally, any party to appeal proceedings adversely affected by the decision of the Board of Appeal may file a petition for review of the decision by the Enlarged Board of Appeal. Yet, the petition may only be filed on specific grounds that are defined in the European Patent Convention. These are, on the one hand, fundamental procedural defects which may have occurred in appeal proceedings, and, on the other hand, the existence of a criminal act which may have had an impact on the decision.

The opponents state that the invention is insufficiently disclosed in the application and lacks novelty and an inventive step. Based thereon, the opponents request a revocation of the patent in its entirety. The opponents base their argumentation on a number of documents that have been introduced during the first instance and appeal proceedings.

The patentee has requested maintenance of the patent as originally granted and defends himself against the insufficiency of disclosure-attack by stating that the "invention" was sufficiently disclosed, because it was clear that the know-how regarding fluorescent OLEDs and materials and structures build up therefore could be routinely transferred to phosphorescent OLEDs without any hesitation. On the other hand, the patentee argues in favour of novelty and inventive step by alleging that the patented invention, i.e. the provision of OLEDs comprising organometallic iridium compounds as emitters constituted a technical breakthrough which opened a new field of OLED technology.

In adopting this argumentation, the patentee runs into the notorious Scylla-and Charybdis-type problem: On the one hand, he argues in favour of how easy it is for a person skilled in the art to arrive at the alleged invention, starting from fluorescent OLEDs (in order to support sufficiency of disclosure). On the other hand, he argues that it was not at all foreseeable or possible for a person skilled in the art to come up with the alleged invention (so as to argue in favour of an inventive step). This problematic argumentation seems to have also been perceived by the Opposition Division who found that the claims as granted were too broad to not conflict with the prior art, and therefore clearly ruled that the claims of the patent as granted had, in fact, been described in the prior art before and were therefore fully anticipated thereby:

"The Opposition Division was of the opinion that documents D6, D17 and D25 disclose the electroluminescent layer of claim 1 and the organic light emitting device of claim 16 of the main request. Therefore claims 1 and 16 of the main request are not novel under Article 54 (1) and (2) EPC" (see Decision by the Opposition Divisions of January 13, 2012).

If one looks at the claims as granted, it appears indeed that these claims are very broad, and essentially, they encompass an electroluminescent layer comprising an emissive layer includ-

ing any phosphorescent organometallic iridium or osmium compound as well as a corresponding organic light emitting device. In other words, these claims are not limited in terms of the type of emission or in terms of the phosphorescent organometallic iridium or osmium compounds. This is a view that is now also shared by the Board of Appeal which is now the competent body of jurisdiction to rule on the claims:

In its preliminary opinion of March 21, 2013, the Board of Appeal clearly states that questions that need to be discussed during the oral proceedings are “*whether every organometallic iridium compound is an emissive phosphorescent molecule*”, and “*whether the skilled person, in view of the opposed patent and the common general knowledge, would know which organometallic iridium compounds are emissive phosphorescent molecules*”. Likewise, in the same context, the Board articulates that a further question that needs to be discussed is “*whether every OLED wherein the emissive layer includes a phosphorescent organometallic iridium or osmium compound produces luminescent emission when a voltage is applied*”, and, if this is not the case, “*whether the opposed patent or common general knowledge provides sufficient guidance to the skilled person as to which further components/layers would have to be chosen in the OLED in order to produce luminescent emission when a voltage is applied.*”

From a fair inspection of the file it seems at least doubtful whether these very pertinent questions can be answered in favour of the patentee.

The Board of Appeal raises further questions with respect to the novelty and inventive step. With respect to the latter item, the Board outlines that it will have to be discussed what the distinguishing feature in view of the closest prior art is, and what the technical problem is that is credibly solved by this feature over the entire scope of the claims. In making these statements, the Board seems to insinuate that they have considerable doubts as to the whether there existed a technical problem at all, and, if so, whether such problem was solved in a credible manner over the entire scope of the claims. The Board also seems to identify various documents that are of particular relevance in this context.

With respect to the auxiliary requests, the Board articulates its doubts with respect to their admissibility under formal requirements of the European Patent Convention and points out that some of these claim requests are diverging in the sense that they do not seem to be focused to a more restricted combination of features which, as of recent, has become an important criteria when it comes to judging the admissibility of auxiliary claim requests at the EPO.

In summary, some of the issues mentioned in the preliminary opinion appear so severe that there is even a possibility that, at the end of the oral hearing, the patent may potentially be revoked in its entirety.

Hence, altogether we expect tomorrow’s hearing to be an uphill battle for the patentee on a mountain that may be very steep, and possibly too steep to overcome.

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Sincerely yours
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A handwritten signature in black ink, appearing to be 'Matthias Holz', written in a cursive style.

Matthias Holz