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**Datasheet for the decision  
of 18 June 2009**

**Case Number:** T 1479/06 - 3.5.02

**Application Number:** 00910182.5

**Publication Number:** 1072078

**IPC:** H02J 7/00

**Language of the proceedings:** EN

**Title of invention:**

Microcontroller with integral switch mode power supply controller

**Patentee:**

MICROCHIP TECHNOLOGY INC.

**Opponent:**

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**Headword:**

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**Relevant legal provisions:**

EPC Art. 113(2)

EPC R. 103

**Relevant legal provisions (EPC 1973):**

EPC R. 68(2), 67

**Keyword:**

"Substantial procedural violation (yes)"

"Reimbursement of appeal fee (yes)"

**Decisions cited:**

T 0278/00

**Catchword:**

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Case Number: T 1479/06 - 3.5.02

**D E C I S I O N**  
of the Technical Board of Appeal 3.5.02  
of 18 June 2009

**Appellant:** MICROCHIP TECHNOLOGY INC.  
2355 West Chandler Boulevard  
Chandler, AZ 85224-6199 (US)

**Representative:** Grubert, Andreas  
King & Spalding  
125 Old Broad Street  
London EC2N 1AR (GB)

**Decision under appeal:** Decision of the Examining Division of the  
European Patent Office posted 6 April 2006  
refusing European application No. 00910182.5  
pursuant to Article 97(1) EPC 1973.

**Composition of the Board:**

**Chairman:** M. Ruggiu  
**Members:** M. Rognoni  
P. Mühlens

## Summary of Facts and Submissions

I. The appellant (applicant) appealed against the decision of the examining division refusing European application No. 00910182.5.

II. The reasons for the decision under appeal read as follows:

"In the communication(s) dated 24.03.2006, 08.03.2006, 17.11.2005 the applicant was informed that the application does not meet the requirements of the European Patent Convention. The applicant was also informed of the reasons therein.

The applicant filed no comments or amendments in reply to the latest communication but requested a decision according to the state of the file by a letter received in due time on 24.03.2006.

The application must therefore be refused."

III. The relevant first instance file history can be summarised as follows:

- In the communication dated 17 November 2005, the examining division referred to documents D1 and D2. The objections raised against the claims as filed with a letter dated 12 September 2005 were lack of novelty and lack of inventive step.
- With a letter dated 25 January 2006, the appellant replied to the communication dated 17 November 2005. No new claims were filed. The applicant

requested to cancel the oral proceedings and to return to the written proceedings.

- The communication dated 8 March 2006 referred to the consultation by telephone with the applicant which had taken place on 7 March 2006. It stated the following (item 5.): "*Since, the subject matter for which protection is sought and the objections raised by the examining [sic] haven't changed in substance, the preliminary opinion expressed in the communication accompanying the summons to attend oral proceedings are maintain [sic]. The request to cancel the oral proceedings is not allowed*".
  
- With a letter dated 9 March 2006, the applicant replied to the communication of 8 March 2006 and filed a new main request and a new auxiliary request. The applicant requested that a European patent be granted according to the main request. "*Should the Examination Division reject this request, the grant of a European Patent according to the auxiliary request is respectfully requested*" (see page 6, last sentence).
  
- With a letter dated 23 March 2006, the applicant informed the examining division that they would not attend the oral proceedings scheduled for 28 March 2006. They further requested "*that the Examining Division make their decision based on the arguments and amendments set out in our last submission dated 9 March 2006*".

- In response to the applicant's letter dated 23 March 2006 the examining division issued a "brief communication" dated 24 March 2006 containing, *inter alia*, objections under Articles 84 and 123 (2) EPC. It stated that the oral proceedings would not be cancelled and asked the applicant to clarify the final request made in the letter dated 23 March 2006.
  
- With a letter dated 24 March 2006 submitted in response to the examining division's "brief communication", the applicant filed amended claims according to a main request and amended claims according to an auxiliary request. It further replied to the Article 123 (2) EPC objections raised by the examining division. The applicant's requests were worded as follows: "*Applicant corrected the main request by replacing the term "converter" in line 21 of claim 1 with the correct term "controller." Applicant amended the Auxiliary Request to now include the exact language as used in the specification. Should the Examiner deny the main request, Applicant requests then alternatively the grant of a European Patent based on the Auxiliary Request*".
  
- In a brief communication dated 27 March 2006, which referred to the letter of 24 March 2006, the examining division informed the applicant that the summons to attend oral proceedings on 28 March 2006 had been cancelled and that the procedure would be continued in writing.

- The decision to refuse the application was issued on 29 March 2006 and posted on 6 April 2006.
- IV. With the statement of grounds of appeal, the appellant essentially submitted that the decision of the examining division did not contain any reasoning with respect to the requests filed with the applicant's submission dated 24 March 2006.

Accordingly, the appellant requested reimbursement of the appeal fees pursuant to Rule 67 EPC (1973), corresponding to Rule 103 EPC (2000).

The appellant further requested the grant of a European patent according to the main request or to the auxiliary request filed with the statement of grounds of appeal.

- V. In a communication dated 31 March 2009, the Board informed the appellant that a decision to remit the case to the first instance would be issued, since the contested decision was not in compliance with Article 113(2) EPC and Rule 68(2) EPC (1973).

### **Reasons for the Decision**

1. The appeal is admissible.
2. According to Article 113 (2) EPC 1973, the European Patent Office shall consider and decide upon the European patent application or the European patent only in the text submitted to it, or agreed by the applicant or proprietor of the patent.

Furthermore, Rule 68 (2) EPC 1973 states that decisions of the European Patent Office which are open to appeal should be reasoned. According to the established jurisprudence of the boards of appeals this provision requires that the decision contain, in logical sequence, those arguments which justify its tenor. Moreover, the conclusions drawn from the facts and evidence must be made clear (see T 0278/00, OJ 2003, 546, point 2 of the reasons).

- 3.1 The last communication cited in the contested decision is based on claims 1 to 29 filed by the appellant with the letter dated 9 March 2006. Thus, the examining division seems to have ignored the last claims filed by the applicant on 24 March 2006.

If the main request of 24 March 2006 is essentially the same as the main request of 9 March 2006, the term "converter" having been replaced by the correct term "controller", the last feature of the new auxiliary request appears substantially different from the one of the previous request.

- 3.2 In particular, the following clause in the last paragraph of claim 1 according to the auxiliary request filed on 9 March 2006:

*"wherein **the pulse width** or the duty cycle of the pulse output signal (114) is increased when said at least one parameter signal is less than the setpoint and **the pulse characteristic** of the pulse output signal (114) is decreased when said at least one parameter signal is greater than the setpoint" (emphasis added)*

reads as follows in the auxiliary request of 24 March 2006:

*"wherein **the pulse repetition rate and/or the duty cycle of the pulse output signal (114) is increased when said at least one parameter signal is less than the setpoint and the **pulse repetition rate and/or the duty cycle of the pulse output signal (114) is decreased when said at least one parameter signal is greater than the setpoint**" (emphasis added).***

- 3.3 If the examining division believed that the last amendments filed by the applicant did not substantially change the subject-matter for which protection was sought and that the same objections raised against the requests of 9 March 2006 applied also to the requests of 24 March 2006, it should have explained in its decision why it had come to this conclusion. As the examining division did not refer to such amendments, it remains doubtful whether they were actually considered. In fact, this impression appears to be confirmed by the (incorrect) statement in the decision that the *"applicant filed no comments or amendments in reply to the latest communication"*.

Furthermore, it is not possible to determine whether, in the opinion of the examining division, the applicant's last requests had overcome the Article 84 and 123(2) EPC objections raised in the communication of 24 March 2009 and on which grounds these requests were actually refused.

- 3.4 In summary, in issuing the contested decision, the examining division did not comply with Article 113 (2)



EPC because it did not consider, at least explicitly, the text submitted by the applicant by way of auxiliary request and with Rule 68 (2) EPC (1973) because it did not explain why the European patent was to be refused on the basis of objections raised before the filing of the last amended requests.

- 3.5 For the above reasons and in accordance with the established jurisprudence of the boards of appeal, the case is remitted to the department of first instance for further prosecution.
4. The appeal is allowed insofar as the decision is set aside and the appeal fee is reimbursed pursuant to Rule 103 (1) (a) EPC 2000 by reason of the substantial procedural violation constituted by the non-compliance with Article 113 (2) EPC and Rule 68 (2) EPC 1973. The reimbursement is equitable since the appellant was obliged to file this appeal to obtain a reasoned decision based on his actual requests, to which he was entitled pursuant to Article 113 (2) EPC and Rule 68 (2) EPC 1973 and which will allow the Board to examine the factual and legal reasoning underlying the refusal.

Under these circumstances, there is no need to hold oral proceedings before the Board in accordance with the appellant's request.

**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 to be reimbursed.

The Registrar:

The Chairman:

U. Bultmann

M. Ruggiu