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**Datasheet for the decision
of 9 November 2016**

Case Number: T 0066/12 - 3.5.02

Application Number: 01972381.6

Publication Number: 1340276

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H01M10/42

Language of the proceedings: EN

Title of invention:
DC power source with fuel cell

Patent Proprietor:
Toyota Jidosha Kabushiki Kaisha

Opponent:
Linde Material Handling GmbH

Relevant legal provisions:
EPC Art. 54, 112
RPBA Art. 13(1), 13(3)

Keyword:
Novelty - selection from a range - (no)
Late-filed simulation results - admitted (no)
Late-filed requests - admitted (no)
Referral to the Enlarged Board of Appeal - (no)

Catchword:

Points 2.1, 4.1.1 and 7



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Case Number: T 0066/12 - 3.5.02

D E C I S I O N
of Technical Board of Appeal 3.5.02
of 9 November 2016

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Decision under appeal: **Interlocutory decision of the Opposition
Division of the European Patent Office posted on
27 December 2011 concerning maintenance of the
European Patent No. 1340276 in amended form.**

Composition of the Board:

Chairman R. Lord
Members: M. Léouffre
W. Ungler

Summary of Facts and Submissions

- I. The opponent appealed against the interlocutory decision of the opposition division, posted on 27 December 2011, concerning the maintenance of the European patent No. 1 340 276 in amended form.
- II. With a letter dated 20 September 2012 the patent proprietor requested that the patent be maintained on the basis of the pending first auxiliary request, which was retained as main request or, if that was not possible, on the basis of one of the first to fourth auxiliary requests, all filed with that letter.
- III. In the statement of grounds of appeal, the appellant referred, *inter alia*, to document:
E1 : DE 199 21 450 C1.
- IV. With a letter dated 7 October 2016, and in response to a communication accompanying the summons to oral proceedings before the board dated 6 June 2016, the respondent filed anew the main request, together with five new auxiliary requests, and accompanied by simulation results indexed as enclosures 1 and 2a to 2e.
- V. Oral proceedings before the board took place on 9 November 2016.

The appellant (opponent) requested that the decision under appeal be set aside and the European patent be revoked.

The respondent (patent proprietor) requested that the appeal be dismissed (main request), auxiliarily that

the patent be maintained in amended form on the basis of the claims of one of:

- the first and second auxiliary requests filed with letter dated 7 October 2016,
- the third and fourth auxiliary requests filed during the oral proceedings of 9 November 2016, or
- the fifth to seventh auxiliary requests (corresponding to the third to fifth auxiliary requests filed with letter dated 7 October 2016).

Auxiliarily, the patent proprietor requested that the case be remitted to the department of first instance for further prosecution and that a question be referred to the Enlarged Board of Appeal pursuant to Article 112 EPC.

VI. Claim 1 of the main request corresponds to claim 1 of the first auxiliary request underlying the decision under appeal, and reads as follows:

"A direct current power source comprising:
a pair of terminals that output electric power;
a fuel cell (40) connected to the terminals; and
an electric power storage device (20) connected to the terminals in parallel with the fuel cell,
characterized by
a DC-DC converter (30) connected between the electric power storage device (20) and the terminals,
wherein a ratio of a maximum output of the fuel cell to a maximum total output of the fuel cell and the electric power storage device is in a range of equal to or greater than 0.65 and equal to or less than 0.8."

Claim 1 of the first auxiliary request adds to claim 1 of the main request that the direct current power

source is "applicable to a hybrid vehicle", as well as replacing "characterized by" with "and".

Claim 1 of the second auxiliary request adds to claim 1 of the first auxiliary request that:

- a battery is used as the electric power storage device, and that the direct current power source further comprises:
- "a vehicle auxiliary (50) and a fuel cell auxiliary (51) that are connected between the battery (20) and the DC-DC converter (30), wherein the fuel cell auxiliary (51) is driven by the electric power from the battery (20) so as to warm-up and start the fuel-cell (40)".

Claim 1 of the third auxiliary request is amended with respect to claim 1 of the main request in that:

- the direct current power source is "for supplying power to a motor (61) as a power source running a vehicle";
- the fuel cell (40) "is used as main power source";
- the electrical power storage device "is used as an auxiliary power source";
- "characterized by" is deleted;

and adds the following features:

- "a control unit (10) controlling the operation of the fuel cell (40) and the DC-DC converter (30), and a vehicle auxiliary (50) and a fuel cell auxiliary (51) that are connected between the battery (20) and the DC-DC converter (30), wherein the fuel cell auxiliary (51) is driven by the electric power from the battery (20) so as to warm-up and start the fuel-cell (40),
- wherein the control unit (10) sets a required electric power (E_{req}) for the fuel cell (40), wherein the required electric power (E_{req}) is

determined as a sum of an electric power required for running (Ed), a charge/discharge electric power (Eb), and an auxiliary electric power (Es), the electric power required for running (Ed) is an electric power that needs to be supplied to the motor (61) to enable a vehicle to be run, the charge/discharge electric power (Eb) is electric power involved in charging/discharging of the electric power storage device (20), the auxiliary electric power (Es) is an electric power required for driving a vehicle auxiliary (50) and a fuel cell auxiliary (51), the control unit (10) sets the output voltage of the fuel cell (40) so as to output the required electric power (Ereq), wherein, on the one hand, the battery (20) is charged when the state of charge (SOC) falls below a predetermined lower limit, wherein the charge/discharge electric power (Eb) is a positive value according to the electric power required for charging and, consequently, the required electric power Ereq increases as the battery (20) is charged, wherein, on the other hand, the battery (20) is discharged when the SOC exceeds a predetermined upper limit, wherein the charge/discharge electric power Eb is a negative value according to the discharge electric power and wherein the required electric power Ereq decreases as the battery (20) is discharged".

Claim 1 of the fourth auxiliary request adds to claim 1 of the main request that:

- the ratio is "an output ratio" and that
- "the output ratio is set such that the sum of the maximum outputs of the fuel cell (40) and the electric power storage device (20) coincides with the maximum required electric power required for the direct current power source (1)."

Claim 1 of the fifth (former third) auxiliary request comprises (in a different order) the features of the third auxiliary request wherein the vehicle is "a hybrid vehicle", the direct power source is "applicable to the hybrid vehicle", and "a battery (is) used as an electric power storage device".

Claim 1 of the sixth (former fourth) auxiliary request adds to claim 1 of the fifth auxiliary request the feature "wherein the maximum total output of the fuel cell (40) and the electric power storage device (20) is equal to a maximum required electric power required from the output terminals".

Claim 1 of the seventh (former fifth) auxiliary request adds to claim 1 of the sixth auxiliary request the features:

- "wherein the fuel cell (40) and the battery (20) are connected in parallel to an inverter (40)";
and
- "wherein the DC-DC converter (30) is a direct current voltage converter, has a function of regulating the DC voltage input from the battery (20) and outputting it to the inverter (60), and a function of regulating the DC voltage input from either the fuel cell (40) or the motor (61) and outputting it to the battery (20), wherein the DC-DC converter (30) is connected to the battery side that outputs a relatively small amount of electrical energy".

VII. The appellant argued essentially as follows:

The simulations provided by the proprietor with the letter dated 7 October 2016 were late-filed and should

not be admitted into the procedure. They were prima facie not clear and irrelevant. No information was given about the indicated weights and the reader had to guess about the meaning of the reported tests. The depicted curves did not show any clear range providing improved fuel efficiency. An objection of arbitrary selection had already been raised seven years ago. Test measurements could and should have been filed much earlier. It appeared that the tests were carried out using current technology, so that their relevance to the situation at the filing date of the application was not clear.

Concerning the last feature of claim 1 of the main request, the range indicated there not only did not fulfil the 3rd criterion (arbitrary selection) but also not the second criterion necessary for rendering the subject-matter of claim 1 novel. No normal range was known, and before deciding if a range was sufficiently removed from a known range, a normal range should be determined.

The other features of claim 1 were known from E1, in particular from claim 1 and column 3, lines 42 to 55, which defined the elements referenced 7 and 8 shown in figure 1 as constituting a DC-DC converter, and from column 3, line 28 together with column 4, line 20 which specified that the main and supplementary power sources could respectively be a fuel cell and a battery.

The added feature "applicable to a hybrid vehicle" in claim 1 of the first auxiliary request was also known from E1, because E1 disclosed an electrical vehicle having two power sources, namely a fuel cell and a battery. Thus, the subject-matter of claim 1 of the first auxiliary request also did not fulfil the requirements of Article 54 EPC.

Claim 1 of the second auxiliary request comprised the following feature which changed the technical subject for which protection was sought, namely "a vehicle auxiliary (50) and a fuel cell auxiliary (51) that are connected between the battery (20) and the DC-DC converter (30), wherein the fuel cell auxiliary (51) is driven by the electric power from the battery (20) so as to warm-up and start the fuel-cell (40)". This feature was based only on paragraph [0046] of the description of the published patent and had never been searched. Moreover this feature concerned the initial start-up of the power source, which was an entirely different concept from that discussed by the respondent with respect to the main and first auxiliary requests, namely the use of the battery to provide power for extended periods of time. Hence this request should not be admitted into the proceedings.

The third and fifth to seventh auxiliary requests comprised this same feature and should therefore also not be admitted into the proceedings.

The new fourth auxiliary request had already been filed early on in the opposition procedure but had not been pursued since then. Thus this auxiliary request should also not be admitted into the proceedings.

The referral question assumed as a basis reasoning for the non-admittance of the requests which did not correspond to what had been discussed in that context, so that the referral was not justified.

VIII. The respondent argued essentially as follows:

The filing of the supplementary document attached to the letter dated 7 October 2016 was a direct reaction to the board's communication. In this document tests concerning a variety of vehicle types were reported and it was clear that the reported tests led directly to the range indicated in claim 1 and shown in figure 5 of the patent. The range did not therefore result from an arbitrary selection.

The range indicated in claim 1 was also narrow compared to the possible range for the device shown in figure 1 of E1.

The range had to be appreciated also in combination with feature 3 of claim 1 which recited: "an electric power storage device (20) connected to the terminals in parallel with the fuel cell". E1 did not show a battery in parallel with a fuel cell. A complete circuit comprising windings 11 and 12 was inserted between the battery and the power terminals. Claim 1 specified also that the DC-DC converter was on the side of the battery and not on the side of the fuel cell. This contributed to increasing the fuel efficiency as recited in paragraph [0044] of the published patent. No parallel circuit of a battery and a fuel cell could be derived from the circuit diagram shown in the figure of E1. Furthermore the circuit of E1 was designed for allowing a supplementary source, like a flywheel, to supply power during peak power requirements and to receive power during braking phases, as recited in column 2, lines 42 to 48. This was a different approach from the present invention which foresaw a constant power provided mainly by a fuel cell and for a reduced amount by a battery, which was nonetheless capable of

providing power for extended periods of time. For these reasons the power source of claim 1 of the main request differed from that disclosed in E1, so that the claim complied with the requirements of Article 54 EPC.

Claim 1 of the first auxiliary request added the feature that the direct power source was "applicable to a hybrid vehicle". This feature had been added in reaction to the comment in the annex to the summons which recited that the "subject-matter of claims 1 and 11 is not limited to a vehicle and even less to a particular type of vehicle cruising at a particular speed or driving particularly defined modes, such as urban driving mode". This feature was supported by paragraph [0016] whereby the two power sources used by the vehicle were defined in paragraph [0003] as being a fuel cell and an electric power storage device. The added claim 12 of this request was dependent on method claim 11 and comprised method features which corresponded to the device features mentioned in the dependent claims 2 to 4, grouped as alternative features in a same claim. Hence this request should be admitted into the procedure. The invention defined by this request operated with both power sources during constant operating mode while the device of E1 used the supplementary source only when peak power was required.

Claim 1 of the second auxiliary request specified the electric power storage device as being "a battery" and the direct current power source as comprising "a vehicle auxiliary (50) and a fuel cell auxiliary (51) that are connected between the battery (20) and the DC-DC converter (30), wherein the fuel cell auxiliary (51) is driven by the electric power from the battery (20) so as to warm-up and start the fuel-cell (40)". This latter feature had already been present in a request

filed on 20 September 2012 in reply to the statement of grounds of appeal, which request was in substance identical to the third auxiliary request filed during the opposition procedure with the letter dated 20 September 2011. The appellant/opponent had therefore had ample time to react to the introduction of this feature. The added feature was linked to the subject-matter of the previous requests in the sense that it contributed to improving the output efficiency of a direct power source as mentioned in paragraph [0003] of the published patent. This feature made clear that the vehicle auxiliary as well as the fuel cell auxiliary, which were defined in paragraph [0021], were connected between the battery and the DC-DC converter so as to avoid further DC-DC converter losses as mentioned in paragraph [0044], improving thereby the efficiency of the direct current power source.

The third auxiliary request was identical to the third auxiliary request filed with the reply to the grounds of appeal, which was in turn identical in substance to the third auxiliary request filed before the opposition division with letter dated 21 September 2011.

In the event that the board would not allow the proprietor to fall back on requests such as this or the second auxiliary request which had already been filed before the opposition division, the case should be remitted to the opposition division for further processing. If that was not possible, the following question should be referred to the Enlarged Board of Appeal, in accordance with Article 112 EPC:

"Ist es zulässig, dass im Beschwerdeverfahren Ansprüche nicht zum Verfahren zugelassen werden, die auf ursprünglich in der Beschreibung offenbarte Merkmale

gerichtet sind und die bereits in der Frist vor der mündlichen Verhandlung im Einspruchsverfahren rechtzeitig eingereicht wurden und sowohl der Erwiderung auf die Beschwerdebegründung als auch der Erwiderung auf die Ladung zur mündlichen Verhandlung im Beschwerdeverfahren beigelegt haben?"

In the present case a possible refusal of the requests which were filed during the opposition procedure but not discussed then had never been envisaged. The board in its annex to the summons even commented that this feature was not known from the available prior art. Not admitting into the appeal proceedings a request which had already been filed during the opposition procedure would mean that, during the opposition procedure and the subsequent appeal procedure, the respondent/ proprietor would have had only two possibilities to file amended requests, once in response to the grounds of opposition and once in response to the statement of grounds of appeal. This should not be the case since the respondent/proprietor should be in a position to take account of the preliminary opinions issued by the opposition division and/or the board of appeal, and to adapt his requests accordingly. A refusal to admit the requests by the board would unduly restrict the rights of the respondent.

The fourth auxiliary request had also been filed in response to the grounds of opposition and was based on original claims 1, 4 and 9 and page 13, lines 20 to 21 of the original application. It should therefore be admitted into the proceedings.

Reasons for the Decision

1. The appeal is admissible.

2. *Main request*

2.1 *Admissibility of the simulation results filed with the letter of 7 October 2016*

The simulations shown in enclosures 1 and 2a to 2e were carried out on five different vehicles. Characteristics of the vehicles are listed in enclosure 1 while each of enclosures 2a to 2e is dedicated to one of the vehicles and reveals a figure showing a fuel efficiency in km/kg versus an output ratio of a fuel cell to a battery, and a table showing different fuel cell output ratios with respect to vehicle weights. The figures show that the fuel efficiency is high for a certain range of fuel cell to battery output ratio. However, in each of the enclosures 2a to 2e the weight of the vehicle varies with the ratio, so that there is doubt as to whether the values reported in the figures of each of enclosures 2a to 2e relate to a vehicle of the same type and weight. The interpretation and explanation given by the respondent about the enclosures and in particular the tables did not convince the board that the simulations could be *prima facie* relevant for assessing if the range of output ratio defined in claim 1 was an arbitrary selection or not. In particular the graphs do not show clearly that the end points of the range (0.65 and 0.8) are significant, in particular since all the graphs show that the fuel efficiency varies little over a much broader range of output ratio. The results do not show that this range would apply generally, for instance when using different test cycles. Moreover, as noted by the appellant, the

simulations seem to relate to current vehicles, so that it cannot be excluded that they make use of technologies which were not available at the priority date of the application underlying the patent.

Hence, taking into account the insufficient information derivable from the enclosures 1 and 2a to 2e, combined with the late point in time of their filing, the board exercised its discretionary power under Article 13(1) of the RPBA (Rules of Procedure of the Boards of Appeal) not to admit these simulation results into the proceedings.

2.2 *Novelty - Article 54 EPC*

2.2.1 E1 discloses a drive for an electrical vehicle comprising a permanent synchronous machine 3 connected to a converter 2 supplied over a direct current power source (see the figure). The direct current power source comprises:

- a pair of terminals 4a, 4b that output electric power,
- a fuel cell 6 (see column 3, lines 22 to 29) connected to the terminals,
- an electric power storage device 9 connected to the terminals in parallel with the fuel cell, and
- a DC-DC converter 7, 8 (see column 3, lines 42 to 44 and claim 1) connected between the electric power storage device 9 and the terminals 4a, 4b.

E1 does not give any information about the ratio of a maximum output of the fuel cell to a maximum total output of the fuel cell and the electric power storage device.

- 2.2.2 According to claim 1 the ratio is in a range of equal to or greater than 0.65 and equal to or less than 0.8.
- 2.2.3 According to the established case law of the boards of appeal, a definition of a (sub-)range can render the subject-matter of a claim novel only if it meets the three criteria defined in the decisions T198/84 and T279/89, namely that:
- (a) the selected sub-range should be narrow;
 - (b) the selected sub-range should be sufficiently far removed from the known range illustrated by means of examples, and
 - (c) the selected area should not provide an arbitrary specimen from the prior art, i.e. not a mere embodiment of the prior description, but another invention (purposive selection).
- 2.2.4 In the light of the conclusion reached concerning the third of these criteria, the question as to whether the first two are satisfied can be left open.
- 2.2.5 The third of these criteria is not met, for the following reasons:
According to the respondent the claimed range of 0.65 to 0.80 was determined with the aim of improving fuel efficiency.
On page 5 of its reply to the grounds of appeal the respondent referred to paragraphs [0035] to [0042] of the patent specification to demonstrate that the results shown in figure 5 relating to a 10-15 mode and a vehicle of 2000kg were only examples and that "the output ratio of the fuel cell 40 and the battery 20 in view of the object of the present invention is independent on further values for obtaining the high energy efficiency."

However, further down the same page, the respondent acknowledges that "The lower limit of 0.65 for the output ratio of the present invention is set in accordance with passage 0037 [of the patent specification] in order to fulfill the requirement of outputting the required electric power for continuous cruising by the fuel cell".

Paragraph [0037] of the patent specification recites indeed that "a lower limit value and an upper limit value of the output ratio between the fuel cell 40 and the battery 20 are set based on a predetermined reference representative of the vehicle driving conditions."

According to paragraph [0037], it is calculated that a vehicle weighing 2000kg with a motor efficiency of 80% cruising at 120km/h on a gradient of 4.5% requires approximately 65kW, whereby if the maximum required electric power is assumed to be 100kW, the lower limit of the ratio should be 0.65. Hence the board agrees with the appellant that the lower limit of the claimed range is influenced by, among other criteria, both the driving conditions and the vehicle type.

Furthermore this passage can also be interpreted as defining a power minimum for a fuel cell independently of the fuel efficiency, the battery or a proportion of fuel cell power to battery power.

According to paragraph [0038] of the published patent the upper limit of the output ratio may be determined based on a regeneration capacity of the battery, whereby "For example, the maximum regenerative electric power during deceleration is calculated to be 20kW when driving a so-called 10-15 mode with a vehicle weight of 2000kg and a motor efficiency of 80%", and "If the maximum required electric power is assumed to be 100kW, the capacity of the battery 20 required for charging

this regenerative electric power is 20kW. Accordingly the upper limit value of the output is set to 0.8." The upper limit of the ratio is therefore also set taking account of both the driving conditions and the vehicle type, whereby the fuel efficiency does not appear to play any role.

Furthermore, according to paragraph [0041] and figure 5, the fuel efficiency can also be assessed dependent on driving modes referred as 10-15 mode (Japan) or L4A mode (which corresponds to the US FTP-72 mode).

Finally in paragraph [0041] the fuel efficiency is said to become significantly higher in an output range of 40% to 80%. This indicates that the value 0.65 is based on different assumptions and requirements.

The subject-matter of claim 1 is not limited to any particular vehicle type or particular driving conditions, and the appellant has not demonstrated that fuel efficiency was improved with the claimed ratio in any circumstances, so that the claimed ratio appears to be an arbitrary selection, in which no purpose behind the selection can be seen. The third criterion defined above is therefore not fulfilled, so that the subject-matter of claim 1 of the main request lacks novelty having regard to E1 (Article 54 EPC).

3. *First auxiliary request*

3.1 *Admissibility*

The term "hybrid vehicle" is originally disclosed in paragraph [0016], and the original application discloses only two different power sources, namely a fuel cell and a battery. The term "hybrid" can thus

well be understood as defining in a general sense a vehicle that is powered by two different types of drive, e.g. with a fuel cell as a first power source and a battery as a second power source. Hence, the feature "applicable to a hybrid vehicle" added with respect to claim 1 of the main request is clear and does not infringe Article 123(2) EPC.

The dependent claim 12 added to this request comprises the alternatives in the original method claim (claim 19 as filed) which were deleted from claim 11 during the opposition procedure. Thus claim 12 also does not infringe Article 123(2) EPC.

The board decided therefore to admit the first auxiliary request into the proceedings.

3.2 *Novelty - Article 54 EPC*

The definition that the direct power source is "applicable to a hybrid vehicle" does not render the subject-matter of claim 1 of the first auxiliary request novel having regard to E1, because E1 discloses an electrical vehicle (see title of E1) operated with a fuel cell 6 and an electrical power storage device 9 which is considered as a hybrid vehicle in the sense of the invention, taking into account the interpretation of the term "hybrid" noted above in paragraph 3.1.

4. *Second, third and fifth to seventh auxiliary requests*

4.1 *Admissibility of these auxiliary requests*

4.1.1 Claim 1 of the second request comprises all the features of claim 1 of the first auxiliary request, together with a definition that the electric power storage device is a battery, and adds the following feature: "a vehicle auxiliary (50) and a fuel cell

auxiliary (51) that are connected between the battery (20) and the DC-DC converter (30), wherein the fuel cell auxiliary (51) is driven by the electric power from the battery (20) so as to warm-up and start the fuel-cell (40)".

This latter feature has a basis only in paragraph [0046], lines 34 to 36 of the published patent (and the corresponding passage on page 14 of the underlying application as originally filed). It can thus be assumed not to have been addressed in the search report. This feature might perhaps, as argued by the respondent, contribute to enhancing the overall fuel efficiency. It nevertheless constitutes a new measure to do so which is independent of any measure taken on the basis of the ratio of a maximum output of a fuel cell to a maximum total output of a fuel cell and an electric power storage device as previously claimed. It therefore represents a change in direction of the respondent's case. This is most evident from the fact that the respondent's main arguments concerning novelty and inventive step for the main and first auxiliary requests concerned the use of the battery to provide power for extended periods of time, whereas at least the second half of this added feature concerns only the start-up phase of operation.

The board notes also the following:

- that this feature was introduced into the claims only with the response to the opposition division's summons to oral proceedings (letter dated 21 September 2011),
- that it was introduced there only in the third (of three) auxiliary requests,
- that a similar constellation of requests was retained in the respondent's reply to the grounds of appeal,

- and that it was only in the set of requests filed with the letter date 7 October 2016 in the reply to the board's preliminary opinion that this feature was promoted to a higher request, and one in which it appeared without the additional features of the previous third auxiliary request noted above.

Taking into account all of the above considerations, the board decided to exercise its discretionary power according to Article 13(1) and (3) RPBA not to admit this request into the proceedings.

- 4.1.2 Claim 1 according to each of the fifth to seventh auxiliary requests comprises all of the features of claim 1 of the second auxiliary request, together with additional definitions relating to details of the control unit operation, the maximum power output and the DC-DC converter. Thus the points discussed above with respect to the second auxiliary request apply also to these requests, which were filed at the same time as that request. Hence, for the same reasons as the second auxiliary request, these requests are not admitted into the proceedings.
- 4.1.3 The present third auxiliary request was filed during the oral proceedings before the board, after the discussion relating to the main request and first and second auxiliary requests, and is identical to the third auxiliary request filed with the reply to the grounds of appeal, which was in turn identical in substance to the third auxiliary request filed before the opposition division with letter dated 21 September 2011. Thus, in terms of substance it differs from the third auxiliary request of 7 October 2106 (now the fifth auxiliary request) only by the absence of the reference to the hybrid vehicle and the definition that

a battery is used as the electric power storage device. These differences have no influence on the arguments above on admissibility of the second and fifth to seventh auxiliary requests. Moreover this request was filed even later in the proceedings. Therefore also in this case the board decided to exercise its discretionary power according to Article 13(1) and (3) RPBA not to admit this request into the proceedings.

5. *Fourth auxiliary request*

This request was first filed on 5 March 2010 in response to the notice of opposition. It was subsequently withdrawn and replaced by three further auxiliary requests filed with the letter dated 21 September 2011.

Following the established case law of the boards of appeal and in accordance with Article 12(4) RPBA the Board decided not to admit into the proceedings the request which had been filed and subsequently withdrawn and on which, consequently, the department of first instance could not take any decision (see Case Law of the Boards of Appeal of the European Patent Office, 8th edition, chapter IV.E.4.3.2 d), page 1144).

6. *Remittal to the department of first instance*

With the filing of the third and fourth auxiliary requests during the oral proceedings, the respondent-proprietor requested the remittal of the case to the department of first instance.

The board having exercised its discretionary power under Articles 12(4) and 13(1) and (3) of the RPBA not to admit these requests into the proceedings, a

remittal to the department of first instance is not possible because there is no request to remit.

7. *Referral to the Enlarged Board of Appeal*

Following the non-admission of the second and third auxiliary requests, the respondent requested the board to refer under Article 112 EPC the question recorded under item VIII above, which the board translates into the language of the proceedings as follows:

- Is it legally correct, not to admit into the appeal proceedings, claims, which are based on features which were disclosed in the original description, and which had already been filed during the proceedings before the first instance on time before the oral proceedings in opposition, and which were attached to the response to the statement of grounds of appeal and also to the response to the summons to oral proceedings before the board?

7.1 Article 112(1) and (1)(a) EPC stipulate two separate requirements for a referral to the Enlarged Board. Firstly, it is to be made only in cases where either this is necessary to ensure uniform application of the law or for a point of law of fundamental importance. Secondly, a referral is to be made only if the board considers that a decision in this respect is required.

7.2 Concerning the first of these requirements, no non-uniformity of the application of law has been alleged, so that the referral could only be justified if it concerned a point of law of fundamental importance. The present question concerns a situation in which the board decides not to admit a request in circumstances in which the opposition division did not have the

opportunity to decide on the admissibility of a similar request already filed before the date fixed by them under Rule 116 EPC. The board observes however that Article 114(2) EPC gives the opposition division the discretionary power to decide whether or not to admit such a request, and that under Article 111(1) EPC the board may also exercise any power within the competence of the department responsible for the decision under appeal. It is thus beyond doubt that in the circumstances specified in the question, the board would in principle have the power to decide not to admit such a request, so that the only question which would remain open would be that of whether the board had exercised its discretionary power correctly. Such a question is however inherently dependent on the circumstances of the particular case, so cannot be considered to be a point of law of fundamental importance. The question proposed for referral therefore does not meet the requirements of the first paragraph of Article 112(1) EPC.

- 7.3 For the sake of completeness, and with reference to the second requirement indicated above, the board notes also that the proposed question identifies only three facts underlying the admissibility decision at issue, namely that the feature added was taken from the description, that a request containing it had been filed before the date set by the opposition division under Rule 116 EPC, and that a corresponding request had been filed with the response to the opponent's grounds of appeal. The answer to the question based on only those facts would however not be relevant to the decisions taken by the present board not to admit the second and third auxiliary requests, because as is apparent from sections 4.1.1 and 4.1.3 above, those decisions were based also on other circumstances of the

present case, most notably the technical relevance of the added feature in terms of novelty and inventive step, and the specific sequence and timing of the requests presented throughout the proceedings by the proprietor/respondent. An answer to the question as proposed is therefore not necessary in the present case, so that also the requirements of Article 112(1) (a) EPC are not satisfied.

8. The subject-matter of claim 1 of the main and first auxiliary requests being not novel and the other requests from the respondent not having been admitted into the proceedings, the board has to grant the request of the appellant to set aside the contested decision and revoke the patent.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The patent is revoked.
3. The request for referral to the Enlarged Board of Appeal is refused.

The Registrar:

The Chairman:



U. Bultmann

R. Lord

Decision electronically authenticated