

**Internal distribution code:**

- (A) [ - ] Publication in OJ  
(B) [ - ] To Chairmen and Members  
(C) [ - ] To Chairmen  
(D) [ X ] No distribution

**Datasheet for the decision  
of 21 February 2019**

**Case Number:** T 0217/14 - 3.5.02

**Application Number:** 07123676.4

**Publication Number:** 1939912

**IPC:** H01H71/10

**Language of the proceedings:** EN

**Title of invention:**

Activation for Switching Apparatus

**Patent Proprietor:**

ABB Schweiz AG

**Opponent:**

Siemens Aktiengesellschaft

**Relevant legal provisions:**

EPC Art. 100(a), 54(2), 123(2)

RPBA Art. 13(1)

**Keyword:**

Novelty - (no) - main and second auxiliary requests  
Amendments - added subject-matter (yes) - first and third  
auxiliary requests  
Late-filed auxiliary requests - fourth auxiliary request



**Beschwerdekammern**  
**Boards of Appeal**  
**Chambres de recours**

Boards of Appeal of the  
European Patent Office  
Richard-Reitzner-Allee 8  
85540 Haar  
GERMANY  
Tel. +49 (0)89 2399-0  
Fax +49 (0)89 2399-4465

Case Number: T 0217/14 - 3.5.02

**D E C I S I O N**  
**of Technical Board of Appeal 3.5.02**  
**of 21 February 2019**

**Appellant:** ABB Schweiz AG  
(Patent Proprietor) Brown Boveri Strasse 6  
5400 Baden (CH)

**Representative:** Aipex B.V.  
P.O. Box 30223  
3001 DE Rotterdam (NL)

**Respondent:** Siemens Aktiengesellschaft  
(Opponent) Werner-von-Siemens-Straße 1  
80333 München (DE)

**Representative:** Siemens AG  
Postfach 22 16 34  
80506 München (DE)

**Decision under appeal:** **Decision of the Opposition Division of the  
European Patent Office posted on 19 November  
2013 revoking European patent No. 1939912  
pursuant to Article 101(2) EPC.**

**Composition of the Board:**

**Chairman** R. Lord  
**Members:** F. Giesen  
W. Ungler

## Summary of Facts and Submissions

I. This appeal lies from the decision of the Opposition Division posted on 19 November 2013 revoking European patent No. 1939912 pursuant to Article 101(2) EPC. The reasons for the decision were that the circuit breaker of claim 1 as granted lacked novelty.

II. The following document of the state of the art is relevant for this decision:

D3: EP 1 618 580 B1.

III. The appellant (patent proprietor) requested that the decision under appeal be set aside and the patent be maintained as granted (main request), or as an auxiliary measure that the patent be maintained in amended form on the basis of one of the first to third auxiliary requests filed with the statement of grounds of appeal, or on the basis of the fourth auxiliary request filed with letter dated 20 February 2019.

The respondent (opponent) requested that the appeal be dismissed.

IV. Claim 1 as granted, with labels taken from the impugned decision, reads as follows:

M1.1 *"A circuit breaker (100) comprising:*

M1.2 *a single pole module housing (102) having envelope dimensions that are the same as standardized single-pole circuit breakers;*

M1.3 *a first conduction path (200) and a second conduction path disposed within the single pole module housing (102),*

- M1.4 *a first activation mechanism (112) in operable communication with the first conduction path; and*
- M1.5 *a second activation mechanism (111) in operable communication with the second conduction path;*
- M1.6 *wherein the first activation mechanism (112) is in operable communication with the first conduction path (200) independent of the second activation mechanism (111) and the second conduction path; and*
- M1.7 *wherein the second activation mechanism (111) is in operable communication with the second conduction path independent of the first activation mechanism (112) and the first conduction path (200), characterised in that*
- M1.8 *the first and second conduction paths (200) being electrically isolated from each other via an interior wall (125) of the single pole module housing (102) so that there is no electrical interconnection between the conduction paths within the circuit breaker (100)."*

Claim 1 of the **first auxiliary request** has in addition to the features of claim 1 of the main request the features

*"said interior wall (125) further serving as a central division of space within the circuit breaker (100), wherein a first pole (113) of the circuit breaker (100) includes the first activation mechanism (112) and an independent trip mechanism (115) and a second pole (114) of the circuit breaker (100) includes the second activation mechanism (111) and a second independent trip mechanism disposed behind the first pole (113),*

*and wherein the second pole (114) is a mirror image layout of the first pole (113)."*

Claim 1 of the **second auxiliary request** has in addition to the features of claim 1 of the main request the features

*"the first activation mechanism (112) is in operable communication with the first conduction path (200) without any mechanical link to the second activation mechanism, and without any mechanical link to the second conduction path (200); and*

*the second activation mechanism is in operable communication with the second conduction path without any mechanical link to the first activation mechanism (112), and without any mechanical link to the first conduction path (200)."*

Claim 1 of the **third auxiliary request** has in addition to the features of claim 1 of the main request the additional features according to the first and second auxiliary requests.

Claim 1 of the **fourth auxiliary request** has in addition to the features of claim 1 of the main request the additional features

*"said interior wall (125) of the single pole module housing (102) serving as a central division of space within the circuit breaker (100),*

*the second conductive path through the second pole (114) being a mirror image of the first conduction path (200), each of the first conduction path (200) and the second conduction path being independent of the other,*

*and operating exclusive of a status of the other, with each of the first conduction path (200) and the second conduction path being absent either a mechanical or an electrical link with the other circuit protection path."*

The main and first to third auxiliary requests contained a further independent claim directed to a circuit breaker. In view of the tenor of the present decision there is no need to examine these claims. Their wording is thus not reproduced here.

V. The appellant argued essentially as follows:

The circuit breaker according to claim 1 of the main request was new. Document D3 did not directly and unambiguously disclose features M1.6 and M1.7. Rather it was simply silent on the question of the independence of the first and second activation mechanisms. In column 5, lines 11 to 16, an embodiment was disclosed in which there was only one activation mechanism, which showed that independent activation mechanisms were not directly and unambiguously derivable from D3.

The amendments leading to claim 1 according to the first auxiliary request did not contravene Article 123(2) EPC. The amendments had a basis in column 3, lines 39 to 46 [of the application as published]. All features that the skilled person recognised as being essential for defining the invention were added to the claim. In particular the fact that the activation and trip mechanisms were in operable communication was nothing new for the skilled person and implicitly still present in the amended claim. Hence the claim did not need to specify it further.

Regarding novelty of the circuit breaker according to claim 1 of the second auxiliary request, reference was made to the submissions concerning the main request.

Regarding the compliance of the amendments contained in the third auxiliary request, reference was made to the submissions concerning the first auxiliary request.

The amendments leading to claim 1 of the fourth auxiliary request found a basis in the passages of the application corresponding to paragraphs [0009] and [0010] of the B-publication. The amended features referred to the first and second conduction paths in general, thereby not introducing specific features of the embodiments into the claim. Further, all features of paragraph [0010] had been added to claim 1 so that no features had been taken out of context. The aspect of the central division and mirror-image layout was already present in claim 1 according to the first auxiliary request and the aspect that the conduction paths were different was already contained in claim 1 as granted in the features M1.6, M1.7 and M1.8. The fact that the interior wall provided for electrical isolation as described in [0011] had already been present in claim 1 as granted, see feature M1.8.

Regarding the admissibility of the fourth auxiliary request, it was filed at a very late stage due to a transfer of rights and organisational friction associated with it, such as obtaining translations and appointment of the present representative shortly before the oral proceedings. Claim 1 was an attempt at addressing the preliminary opinion of the Board, in particular the issue of added subject-matter. The amended subject-matter was *prima facie* novel and

inventive. Also it did not change the appellant's case, because the aspects of a central division and independent current paths have been the subject of the proceedings all along. Therefore the new request was also not complex.

VI. The respondent argued essentially as follows:

The circuit breaker according to claim 1 of the main request lacked novelty over that known from document D3. The contentious features M1.6 and M1.7 were disclosed in paragraph [0016] of D3. The circuit breaker of D3 had a housing in which two conduction paths could be switched. To this end the housing was divided into two parts. Each part had a movable contact element (33, 34) and a fixed contact element (35, 36). Figure 1b showed that the movable contact elements were movable in opposite directions and could be manually actuated, see for example paragraph [0016] or Figures 1a or 3a.

Claim 1 according to the first auxiliary request contained added subject-matter. The application as filed contained only a disclosure of the trip mechanisms being in operable communication with the activation mechanisms but claim 1 was not amended to have this feature.

The circuit breaker according to claim 1 of the second auxiliary request lacked novelty over D3. From the passages referred to in connection with the main request and also Figure 1b it followed that also the added features of the second auxiliary request were disclosed.



The third auxiliary request contained the same added subject-matter as the first auxiliary request.

The fourth auxiliary request was late filed. The request *prima facie* did not meet the requirements of Article 123(2) EPC. The interior wall was originally disclosed to be a frame onto which a number of other components were disposed, see column 3, line 39 to 43. Furthermore, the wall was originally only disclosed as providing electrical isolation of the conduction paths. However claim 1 as amended did not include these features and was therefore an unallowable intermediate generalisation.

VII. Oral proceedings before the Board took place on 21 February 2019, at which the requests were discussed. At the end of the oral proceedings the chairman announced the Board's decision.

### **Reasons for the Decision**

1. The appeal is admissible.
2. *Main request - lack of novelty*
  - 2.1 The circuit breaker according to claim 1 of the main request is not new over that known from document D3.
  - 2.2 Document D3 discloses features M1.1 to M1.5 and M1.8, which was not contested by the parties.
  - 2.3 Document D3 discloses movable contacts (33, 34; "Bewegkontakte") for switching a current path.

According to an embodiment each housing half accommodates one movable contact, and these are actuated in opposite directions denoted as R1 and R2, see column 3, lines 55 to 57, column 4, lines 29 to 38 and Figures 1a and 1b. The movable contacts can be actuated manually with the aid of a toggle, see column 4, lines 23 to 29 and 36 to 38 and Figures 1a and 3a. A movable contact and its toggle is an activation mechanism in the sense of claim 1.

Document D3 discloses independent ("jewells") trip mechanisms in the paragraph at column 4, line 54 to column 5, line 9 and latching mechanisms ("Verklümmungsmechanismus"), see column 6, lines 37 to 41). Furthermore, the components in the housing halves according to the main embodiment are identical but mounted rotated 180°, see column 5, lines 3 and 4.

It is self-evident to the Board, that the trip mechanisms work independently of each other, mechanically as well as electrically. There would simply be no point in providing two identical trip mechanisms if they did not disconnect two respective current paths independently and there is nothing in D3 to suggest otherwise.

Document D3 further discloses at column 4, lines 26 to 29 that for switching **a respective** current path, a **respective** movable contact element is provided. ("zur Schaltung **jeweils** eines Strompfades **jeweils** ein bewegliches Kontaktelement 33, 34"). The term "switching" in the context of a circuit breaker means both disconnecting and re-connecting the current path, i.e. tripping and activating it. When the current paths are switched independently, and since they are tripped

independently, it follows they are also activated independently.

It is not apparent to the Board how a dependent activation mechanism could be consistent with this disclosure, in particular how a single toggle could actuate movable contacts in opposite directions when only one of them is tripped. It might be conceivable that a single toggle moves two movable contacts into opposite directions in a synchronised manner but then two independent trip mechanisms would appear technically pointless.

The skilled person when faced with the above disclosure of the main embodiment in which the two poles have the same components and the same layout, apart from the rotation, would realise that the technical purpose of this arrangement is to have two autonomous circuit breakers within one standard sized housing. The skilled person would therefore not understand the disclosure to comprise the possibility of mechanically or electrically dependent activation mechanisms, because this would not appear to serve any technical purpose, but rather go against the basic idea of having two autonomous circuit breakers. It is therefore clear that D3 does not have to expressly exclude a mechanical link between an activation mechanism and part of the neighbouring current path where a skilled person would not expect them to exist.

The appellant is correct in pointing out that the passage in column 5, lines 11 to 16 discloses only a single activation mechanism, but this passage refers to a different embodiment, in which the housing halves do not accommodate identical components, see column 5, lines 10 and 11. No conclusion can be drawn from this

about the main embodiment or about how the skilled person would understand the disclosure of the main embodiment.

2.4 For the above reasons, document D3 also discloses the contentious features M1.6 and M1.7. The ground for opposition pursuant to Article 100(a) EPC therefore prejudices the maintenance of the patent.

3. *First auxiliary request - added subject-matter*

3.1 Claim 1 of the first auxiliary request contains amendments which introduce subject-matter which goes beyond the content of the application as filed.

According to the original disclosure in column 3, lines 28 to 53, in particular in lines 29 to 39 of the A-publication, the trip mechanisms are in operable communication with the respective activation mechanisms. Claim 1, not having been amended so as to reflect the operable communication, is now directed to fresh subject-matter.

The Board is not convinced by the argument that this feature was implicitly present in the amended claim. The claim wording is clearly not limited to an operable communication of trip and activation mechanisms. The argument that all circuit breakers had an operable communication between trip and activation mechanisms, and that hence the claim did not have to specify it does not convince the Board for two reasons. Firstly, the appellant has not provided evidence for his allegation and secondly such an allegation cannot logically replace the need for a basis in the application as filed.

The Board wishes to add that the amended features are taken out of context of a very detailed embodiment without there being any explanation as to why the above features could be isolated.

4. *Second auxiliary request - lack of novelty*

4.1 The circuit breaker according to claim 1 of the second auxiliary request is not new over that known from document D3.

4.2 The features added to claim 1 according to the second auxiliary request specify that the first and second activation mechanisms are in operable communication with their respective current paths without any mechanical link to the other activation mechanism and other conduction paths. This is in essence a mere paraphrasing of the fact that the activation mechanisms are independent by replacing the term "independent" by saying that there is no mechanical link. All other limitations were already expressed in claim 1 of the main request. These added features therefore do not add any limitation to the claim that would put into question the applicability of the conclusions drawn in connection with the main request, which therefore apply *mutatis mutandis*.

5. *Third auxiliary request - added subject-matter*

5.1 Claim 1 according to the third auxiliary request contains *inter alia* the same amendment as claim 1 of the first auxiliary request, i.e. trip and activation mechanisms which are not limited to being in operable communication. The conclusion that this amendment did not meet the requirements of Article 123(2) EPC applies *mutatis mutandis* to the third auxiliary request.

6. *Fourth auxiliary request - admissibility*

6.1 According to Article 13(1) of the Rules of Procedure of the Board of Appeal (RPBA), any amendment to a party's case after it has filed its grounds of appeal may be admitted and considered at the Board's discretion. The discretion shall be exercised in view of *inter alia* the complexity of the new subject-matter submitted, the current state of the proceedings and the need for procedural economy.

6.2 The Board is not convinced that the transfer of rights justifies the late filing of the fourth auxiliary request. The transfer and appointment of a new representative (AIPLEX B.V.) was communicated to the European patent office on 8 January 2019. The Board was not given any reason why no substantive reply could have been filed between that date and the date at which a further new representative (Prinz & Partner mbB) was appointed, one day before the oral proceedings. A change of representative is also normally not a justification for late filing. The late filing of the auxiliary request is therefore not justified.

6.3 Claim 1 according to the late filed auxiliary request contains the feature "said interior wall (125) of the single pole module housing (102) serving as a central division of space within the circuit breaker (100)". This feature is taken from the description of a specific embodiment in column 3, line 39 ff. of the A-publication. This passages discloses further, that the interior wall "serves as a frame onto which the following components will be disposed". What follows is a detailed description of essentially all components making up one of the poles in particular in column 3,

line 54 to column 4, line 19. Furthermore, in column 4, line 31 ff. the operable connection between the components is described. The amendment therefore takes one aspect, the interior wall serving as a central division of space, out of the larger context of the disclosure of a very specific embodiment. The Board cannot recognise any basis which allowed that feature to be extracted from the context of the embodiment.

While it is correct that the second added feature is in essence the entire paragraph in column 4, line 20 to 30 of the A-publication, this entire paragraph is still part of the single and detailed embodiment rather than a disclosure of isolated subject-matter.

Therefore, the amendments contained in the late filed fourth auxiliary request still do not appear to meet the requirements of Article 123(2) EPC. In view of this, it is immaterial, whether the newly submitted subject-matter was not particularly complex.

- 6.4 Taking into account these considerations, the Board exercised its discretion pursuant to Article 13(1) RPBA not to admit the fourth auxiliary request into the proceedings.
  
7. Since the ground for opposition under Article 100(a) EPC prejudices the maintenance of the patent and since none of the auxiliary requests on which this decision is based meets the requirements of the Convention, the Board has to accede to the request of the respondent.

**Order**

**For these reasons it is decided that:**

The appeal is dismissed.

The Registrar:

The Chairman:



U. Bultmann

R. Lord

Decision electronically authenticated