

Internal distribution code:

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

**Datasheet for the decision
of 8 February 2023**

Case Number: T 0532/20 - 3.5.02

Application Number: 04704812.9

Publication Number: 1590567

IPC: F03D7/04, F03D9/00, F03D7/02

Language of the proceedings: EN

Title of invention:

Wind Turbine Generator with a Low Voltage Ride-Through
Controller and a Method for Controlling Wind Turbine
Components

Patent Proprietor:

GENERAL ELECTRIC COMPANY

Opponents:

Vestas Wind Systems A/S
Nordex Energy GmbH
Siemens Gamesa Renewable Energy GmbH & Co. KG
Siemens Gamesa Renewable Energy Ltd.

Relevant legal provisions:

EPC Art. 100(b), 100(c), 123(2), 84, 112(1)
EPC R. 106
RPBA 2020 Art. 13(2)

Keyword:

Intervention of the assumed infringer - admissible (yes)
Grounds for opposition - insufficiency of disclosure (no) -
added subject-matter (yes)
Added subject-matter (yes) - auxiliary requests 1 to 5
Clarity (no) - auxiliary request 6 to 9
Amendment after summons - taken into account (no)
Referral to the Enlarged Board of Appeal (no)
Objection under Rule 106 (dismissed)

Decisions cited:

T 1480/16, T 2638/16, T 0884/18, T 0914/18, T 0995/18,
T 1151/18, T 1857/19, T 0713/14, T 1224/15, T 2222/15,
T 1597/16, T 1439/16, T 1569/17, T 0853/17, T 0306/18,
T 0482/19, J 0014/19, T 2091/18, G 0003/14, R 0008/11,
R 0017/14

Catchword:

In general, an auxiliary request which is directed to a combination of granted dependent claims as new independent claim, and filed after the statement of grounds or the reply thereto, will be an amendment of the party's appeal case within the meaning of Article 13 RPBA 2020. See reasons 9.

A skilled person assessing the contents of the original application documents uses his technical skill. If they recognise that certain elements of the original application documents are essential for achieving a technical effect then adding that technical effect to a claim without also adding the essential elements can create fresh subject-matter even if the essential elements are originally portrayed as being optional. See reasons 3.6.3.



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 0532/20 - 3.5.02

D E C I S I O N
of Technical Board of Appeal 3.5.02
of 8 February 2023

Appellant: Nordex Energy GmbH
(Opponent 2) Langenhorner Chaussee 600
22419 Hamburg (DE)

Representative: Hauck Patentanwaltspartnerschaft mbB
Postfach 11 31 53
20431 Hamburg (DE)

Appellant: Siemens Gamesa Renewable Energy GmbH & Co. KG
(Opponent 3) Beim Strohhouse 17-31
20097 Hamburg (DE)

Representative: SGRE-Association
Siemens Gamesa Renewable
Energy GmbH & Co KG
Schlierseestraße 28
81539 München (DE)

Respondent: GENERAL ELECTRIC COMPANY
(Patent Proprietor) 1 River Road
Schenectady, NY 12345 (US)

Representative: Zimmermann & Partner
Patentanwälte mbB
Postfach 330 920
80069 München (DE)

Intervener: Siemens Gamesa Renewable Energy Ltd.
(Opponent 4) Faraday House, Sir William Siemens Square
Frimley, Surrey GU16 8QD (GB)

Representative: 2s-ip Schramm Schneider Bertagnoll
Patent- und Rechtsanwälte Part mbB
Postfach 86 02 67
81629 München (DE)

Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 14 January 2020
rejecting the opposition filed against European
patent No. 1590567 pursuant to Article 101(2)
EPC.**

Composition of the Board:

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

Summary of Facts and Submissions

- I. The present appeals by opponents 2 and 3 (appellants 1 and 2) lie from the decision of the opposition division posted on 14 January 2020 rejecting the oppositions filed against European patent No. 1590567 pursuant to Article 101(2) EPC.
- II. Opponent 1 had withdrawn their opposition before the decision under appeal was handed down. They are not a party to the present proceedings.
- III. A notice of intervention pursuant to Article 105 EPC was filed on 29 March 2021 by the assumed infringer (intervener) and the opposition fee was paid on the same day.
- IV. The board summoned the parties to oral proceedings and informed the parties of its preliminary opinion in a communication under Article 15(1) RPBA 2020.
- V. Oral proceedings before the board took place on 8 February 2023.

The final requests of the parties, were as follows:

The appellants 1 and 2 (opponents 2 and 3) and the intervener requested that
the decision under appeal be set aside and the patent be revoked.

Furthermore appellant 2 requested that the case not be remitted to the opposition division, whereas the intervener requested that the case be remitted to the

opposition division if the documents which had been newly-filed with the intervention were to be discussed.

The respondent (patent proprietor) requested that the appeals be dismissed and the intervention be rejected, or if that was not possible that

the decision under appeal be set aside and the patent be maintained in amended form on the basis of one of the auxiliary requests 1 to 9 filed with letter of 30 September 2022 as re-ordered during the oral proceedings before the board, or on the basis of auxiliary request A filed during the oral proceedings before the board, furthermore that

the question filed during the oral proceedings before the board be referred to the Enlarged Board of Appeal and that the objection under Rule 106 EPC be dealt with by the board.

Furthermore they requested that the case not be remitted to the opposition division.

VI. During the oral proceedings, the respondent filed auxiliary request A, and requested that the following question be referred to the Enlarged Board of Appeal:

"Does the cancellation of one or more granted claims, e.g. the maintenance of a single granted claim, constitute an 'amendment' in the sense of Art. 13 RPBA?"

After the board rejected the request for referral, the respondent filed the following objection under Rule 106 EPC:

"There exist [sic] diverging case law on whether a mere deletion of granted claims constitutes an amendment under Art. 13 RPBA 2020. A request for referral regarding this question was filed and dismissed. For this, we are prevented from presenting arguments in favour of request A on the merits despite case law supporting the admissibility of this request. This is a violation of Art. 113 EPC."

At the end of the oral proceedings the decision of the board was announced.

VII. By letters dated 5 April 2023, appellant 2 withdrew their opposition and appeal, and the intervener withdrew their intervention and all requests.

VIII. Claim 1 of the **main request** (i.e. claim 1 as granted) reads as follows:

"A wind turbine generator comprising:

a blade pitch control system (520) to vary a pitch of one or more blades (200);

a turbine controller (500) coupled with the blade pitch control system;

a generator (220) coupled with the turbine controller and the blade pitch control system to provide power during a first mode of operation; and characterised by:

an uninterruptible power supply (530) coupled to the turbine controller and with the blade pitch control system (520) to provide power during a low

voltage event, wherein a low voltage event exists when an output voltage of the generator is at a predetermined level with respect to a rated voltage for the generator for a predetermined time, and wherein the predetermined level is less than 50% of the rated voltage for the generator;

wherein the turbine controller (500) causes the blade pitch control system (520) to vary the pitch of the one or more blades (200) in response to detection of a transition from the first mode of operation to the low voltage event;

and wherein the generator (220) remains connected to and synchronized with a power grid during the low voltage event."

Claim 14 of the main request is a corresponding independent method claim.

IX. The **auxiliary request 1** corresponds to the main request with the method claims 14 to 16 deleted.

X. Claim 1 of the **auxiliary request 2** has been amended with respect to the main request by replacement of the feature

"wherein the predetermined level is less than 50% of the rated voltage for the generator"

by the feature

"wherein the predetermined level is between 15% and 50% of the rated voltage for the generator".

XI. **Auxiliary request 3** is identical to auxiliary request 2. The respondent indicated their intention to delete the method claims in this request, but they were not deleted.

XII. Claim 1 of **auxiliary request 4** reads as follows:

"A wind turbine generator comprising:

a blade pitch control system (520) to vary a pitch of one or more blades (200);

a turbine controller (500) coupled with the blade pitch control system;

a generator (220) coupled with the turbine controller and the blade pitch control system to provide power during a first mode of operation;

a power converter comprising a converter controller and a protective circuit, the converter controller being configured to selectively activate and deactivate the protective circuit;

an uninterruptible power supply (530) coupled to the power converter, the turbine controller and with the blade pitch control system (520) to provide power during a low voltage event, wherein a low voltage event exists when an output voltage of the generator is at a predetermined level with respect to a rated voltage for the generator for a predetermined time, and wherein the predetermined level is ~~less than~~ between 15% and 50% of the rated voltage for the generator;

wherein the turbine controller (500) causes the blade pitch control system (520) to vary the pitch of the one

or more blades (200) in response to detection of a transition from the first mode of operation to the low voltage event;

and wherein the generator (220) remains connected to and synchronized with a power grid during the low voltage event."

Here, and in the following, underlining and strike-through was added by the board to indicate added and deleted features compared to the claim 1 of the main request.

Claim 13 is a corresponding independent method claim.

XIII. **Auxiliary request 5** corresponds to auxiliary request 4 with the method claims 13 to 15 deleted.

Auxiliary requests 8 and 9 were promoted in rank to come after auxiliary request 5. The auxiliary requests are presented here in the order of their rank.

XIV. Claim 1 of **auxiliary request 8** reads as follows:

"A wind turbine generator comprising:

a blade pitch control system (520) to vary a pitch of one or more blades (200);

a turbine controller (500) coupled with the blade pitch control system;

a generator (220) coupled with the turbine controller and the blade pitch control system to provide power during a first mode of operation;~~and characterised by:~~

a power converter including a converter controller;

an uninterruptible power supply (530) coupled to the power converter, the turbine controller and with the blade pitch control system (520) to provide power during a low voltage event, wherein a low voltage event exists when an output voltage of the generator is at a predetermined level with respect to a rated voltage for the generator for a predetermined time, and wherein the predetermined level is ~~less than~~ between 15% and 50% of the rated voltage for the generator;

wherein the power converter (315, 400) includes a protective circuit for maintaining currents within an allowable range, the converter controller being adapted for selectively activating and deactivating the protective circuit to maintain the current flow within the allowable range;

wherein the turbine controller (500) causes the blade pitch control system (520) to vary the pitch of the one or more blades (200) in response to detection of a transition from the first mode of operation to the low voltage event;

and wherein the generator (220) remains connected to and synchronized with a power grid during the low voltage event."

Claim 12 is a corresponding independent method claim.

- XV. **Auxiliary request 9** corresponds to auxiliary request 8 with method claims 12 to 14 deleted.

XVI. Claim 1 of the **auxiliary request 6** reads as follows

"A wind turbine generator comprising:

a blade pitch control system (520) to vary a pitch of one or more blades (200);

a turbine controller (500) coupled with the blade pitch control system;

a generator (220) coupled with the turbine controller and the blade pitch control system to provide power during a first mode of operation; ~~and characterised by:~~

a power converter;

an uninterruptible power supply (530) coupled to the power converter, the turbine controller and with the blade pitch control system (520) to provide power during a low voltage event, wherein a low voltage event exists when an output voltage of the generator is at a predetermined level with respect to a rated voltage for the generator for a predetermined time, and wherein the predetermined level is between less than 50% 15% and 50% of the rated voltage for the generator;

wherein the power converter includes a protective circuit for maintaining currents within an allowable range;

wherein the turbine controller (500) causes the blade pitch control system (520) to vary the pitch of the one or more blades (200) in response to detection of a transition from the first mode of operation to the low voltage event;

and wherein the generator (220) remains connected to and synchronized with a power grid during the low voltage event."

Claim 12 is a corresponding independent method claim.

- XVII. **Auxiliary request 7** corresponds to auxiliary request 6 with method claims 12 to 14 deleted.
- XVIII. Claim 1 of **Auxiliary request A** is directed to the combination of granted claims 1, 4 and 8.
- XIX. The arguments of appellant 1 that are relevant for this decision can be summarised as follows:

Main Request

The opposed patent contained subject-matter that went beyond the content of the application documents as originally filed. The feature "*wherein the generator remains connected to and synchronized with a power grid during the low voltage event*" was isolated from an originally disclosed combination of features although it was inextricably linked to further features. This concerned in particular a protective or crowbar circuit, which was disclosed in combination with the feature added to claim 1 in paragraphs [0023] to [0026] and with regard to figure 4. Some of the aforementioned passages attempted to portray a protective circuit as optional. However, such portrayal could not justify the isolation of a feature from its context since it was inconsistent with paragraph [0026]. The opposition division erred in their assessment that further options would have been at the disposal of the skilled person to achieve a continued connection and synchronisation. A capacity increase, as alluded to in the decision

under appeal, was explicitly disclosed as insufficient below 70% of rated voltage in paragraph [0007] of the original description. Moreover, the opposition division erred in their assessment that a protective circuit was not essential for solving the problem of remaining connected and synchronised. While the original description disclosed that four different problems were solved, the entirety of the original disclosure clearly indicated that a protective circuit was a necessary feature for remaining connected and synchronised. Furthermore, the opposition division erroneously argued that the independent claims as originally filed already implied that the generator remained connected and synchronised. This was clearly not the case. All that the original independent claims specified was a definition of a low voltage event. As such they covered feathering the blades by the uninterruptible power supply (UPS) and therefore a generator disconnecting from the grid in a low voltage event.

Auxiliary request 4

Claim 1 of auxiliary request 4 contained subject-matter going beyond the original disclosure. It did not specify the purpose of activating and deactivating the protective circuit, which according to the original disclosure was to keep currents in an allowable range.

Auxiliary Request A

The admission of auxiliary request A required extraordinary circumstances justified by cogent reasons. There were no such extraordinary circumstances. Objections of lack of clarity had already been raised by the appellants before the summons. Moreover, when amendments were taken from the

description, it was inevitable that their clarity would have to be discussed. The respondent had filed a great number of auxiliary requests that followed a particular line of defence, namely narrowing the voltage range of the low voltage event. This line was now abandoned in favour of a further line of defence. This approach lacked convergence.

Referral of Question of Law

The situation in the present case differed from the case law. By virtue of the deletion a new independent claim was presented, which clearly went beyond the legal and factual framework of the proceedings up to that point. The legal situation concerning admission did not require clarification by the Enlarged Board of Appeal.

Objection under Rule 106 EPC

The way the objection is phrased does not correctly reflect the debate up to that point. After auxiliary request A was filed, its admission was discussed.

- XX. The arguments of appellant 2 that are relevant for this decision can be summarised as follows:

Main Request

The opposed patent contained subject-matter that went beyond the content of the application documents as originally filed.

The original application clearly disclosed that a crowbar circuit was needed as a protective circuit that

allows the generator to remain connected to and synchronised with the grid, in particular in paragraphs [0023] and [0026]. The latter feature was, however, taken out of its context and added to the claim in isolation. The repeated portrayal of a protective crowbar circuit in the description as optional was irrelevant. The corresponding argument by the respondent was purely formal and neglected the technical understanding of the skilled person. The skilled person understood that in order to remain connected and synchronised, the wind turbine had to remain in operation, which in turn meant that damage of the inverters could not be tolerated. The reasoning of the opposition division, according to which remaining connected to and synchronised with the grid and avoiding damage of components were two independent problems, was erroneous for the same reason. The same applied to the reasoning in the decision under appeal according to which further measures beyond a protective circuit, such as increasing component capacity, were at the disposal of a skilled person. Paragraph [0036], from which the feature concerning connection and synchronisation was taken, did not disclose that an uninterruptible power supply was sufficient to accommodate a low voltage ride through of below 50%.

Auxiliary Request 4

The original application documents only disclosed an activation and deactivation of the protective circuit with the additional limitation that the current flow is maintained within an acceptable range. Hence, auxiliary request 4 was based on an inadmissible intermediate generalisation. It covered also protective circuits for voltage or power or other undefined protective

functions. This went beyond the content of the original disclosure.

Auxiliary Request 8

Claim 1 was not clear because it was not clear what "for maintaining currents in an allowable range" meant. At best, it defined the result to be achieved but not the technical measure of how to achieve it.

XXI. The arguments of the intervener that are relevant for this decision can be summarised as follows:

Main Request

The opposed patent contained subject-matter that went beyond the content of the application documents as originally filed. There was no original disclosure of the combination of all features of claim 1. The stance of the respondent that remaining connected and synchronised was merely a statement of a technical effect that was also implicitly contained in original claim 1 was incorrect. It was also incorrect to argue that the protective circuit only solved a partial problem. All embodiments dealt with this problem. Paragraphs [0021] and [0022] only described the consequences of a voltage drop without specifying that the generator remained connected and synchronised. Claim 1 covered wind turbines with overspeed tripping. The respondent applied the wrong yardstick when arguing that remaining connected and synchronised was disclosed in isolation. What would be required is a disclosure of the combination of all features of claim 1.

Auxiliary Request 4

There was no original disclosure of an activation/deactivation of the protective circuit without the additional limitation that the current flow was maintained within an acceptable range.

Admission Auxiliary Request A

No exceptional circumstances justified the admission of auxiliary request A. The board's preliminary opinion indicated that none of the claim requests was allowable. The fact that the preliminary opinion was confirmed during the oral proceedings was an entirely normal procedural development. Auxiliary request A did not correspond directly to auxiliary request 8 of the first instance proceedings. It differed for example in the voltage range. The auxiliary requests prosecuted in opposition are not part of the appeal proceedings. On the contrary, by superseding them with other requests, the respondent indicated that they would no longer have to be examined.

Referral of Question to Enlarged Board of Appeal

The question to the Enlarged Board of Appeal was not relevant for deciding the present case.

- XXII. The arguments of the respondent that are relevant for this decision can be summarised as follows:

Main Request

The patent did not contain added subject-matter going beyond the content of the original application documents.

There was no inextricable link between the continued connection and synchronisation and a protective circuit. The reasoning in the decision under appeal had been correct, according to which synchronisation and connection did not necessarily imply overcurrents. The synchronisation of a generator with the power grid and the avoidance of damage of some of its components were two independent problems. Paragraph [0003] and [0008] disclosed a turbine which remained connected and synchronised to the grid without mentioning any protective circuits. In the latter paragraph four independent problems which the invention solved were proposed. One was the provision of continued connection and synchronisation and another one was the protection of the converter. The view of appellant 1 that a protective circuit was required for both partial problems was incorrect in view of paragraph [0036]. Paragraph [0036] also mentioned connection and synchronisation without a protective circuit. Original paragraph [0014] established a connection between overvoltage damage and the action of the pitch blade control system keeping the turbine below the overspeed limit. Where a protective or crowbar circuit was disclosed it was within the framework of specific preferred embodiments. This applied in particular to paragraphs [0024] and [0026]. There was also no contradiction with paragraph [0007], which again described prior art systems using a UPS to power sensitive components rather than the blade pitch control system. Increasing component capacity was a viable option. The basis for the amendment was original claims 1, 3 and 8, which did not contain a protective circuit. The opposition division was correct in arguing that these originally filed claim already contained the effect of continued connection and synchronisation

without requiring a protective circuit. It was not important for the assessment of Articles 123(2) or 100(c) EPC what was literally covered by the claim, but how a skilled reader understood the claim. The board's analysis in the preliminary opinion implied that even originally filed claims 1 and 8 were not originally disclosed, which was logically impossible. The board's and the appellants' analysis was one concerning essential features, not added subject-matter. The original independent claims already implicitly contained the continued connection and synchronisation without requiring a protective circuit. Already the title of the application mentioned a "low-voltage ride through", which in view of paragraph [0003] clearly implied continued connection and synchronisation. The skilled person would also have construed original claim 1 in this manner in view of paragraphs [0007] and [0009]. The assumption that original claims 1 and 3 also covered turbines that did not remain connected and synchronised was not a technically meaningful reading. If and when a protective circuit had to be activated depended on the specific components used in a given turbine. For some low voltage situations it might be sufficient to control the blade pitch without activating a protective circuit. If the application disclosed features as only belonging to an embodiment, the skilled person could not ignore this. Rather, this was still an original disclosure. Increased capacity of some components was not a mandatory feature, but optional for continued synchronisation and connection.

Auxiliary Request 4

The amendment of claim 1 in auxiliary request 4 was supported by paragraph [0023] of the original description. Even when assuming *arguendo* that

protection of electric and electronic equipment was essential and had to be present in claim 1, the notion of a crowbar circuit was far too limiting. What was added to the claim in this amendment were the structural features, *i.e.* a protective circuit that is selectively activated and deactivated. There was no requirement to add the technical effect of maintaining currents within an allowable range. The effect of maintaining currents in an allowable range was merely redundant information. The circuit had the purpose to protect, therefore it did not allow any values beyond allowable ranges. Original paragraph [0023] was addressed to the skilled person and dealt with power electronics, which came with data sheet specifications. The protective circuit was also claimed to be part of a turbine. A skilled person knew therefore what the circuit had to look like. It was also not correct that the application as originally filed related exclusively to overcurrents. The partial problems in paragraph [0008] also included overvoltages. This would therefore also cover excess power protection. A protective circuit covering all these situations was therefore originally disclosed.

Auxiliary Request 8

Claim 1 of auxiliary request 8 was clear. The skilled person was the reader. The expression "protective circuit" had the functionality of protecting. It was further specified to be "for maintaining currents in an allowable range". That is a range that "did the job", *viz.* a range that allowed the turbine overall to ride through low voltage events. There could exist very detailed values of what is the allowable range for each specific wind turbine model. The engineers that design the turbines determined and specified the allowable

ranges. According to claim 1 of auxiliary request 8 the protective circuit was part of the power converter, which was a power electronics component. These components all had operational ranges. The allowable range simply referred to the operating range of the power converter. Paragraph [0018] of the patent contained further explanations.

Admission Auxiliary Request A

There is diverging case law in this respect, since a large number of decisions considered the deletion of claims not to be an amendment to the appeal case. Therefore, Article 13(2) RPBA 2020 did not apply to auxiliary request A, which was merely the result of the deletion of all claims except granted dependent claim 8 as dependent on claims 1 and 4.

If a deletion of claims were to be considered an amendment, it played a role to what extent the factual and legal situation changed after the amendment. Even if it were to be considered an amendment of the respondent's appeal case, the request was just a combination of granted claims. All opponents should have examined them and raised objections already. None of the opponents raised the clarity objection in the opposition proceedings. However, auxiliary request 8, which was now considered unclear, had already been filed as request D in the reply to the statements of grounds of appeal and maintained in response to the intervention. Appellant 2 merely filed a very short objection, and the board's preliminary opinion did not go into further detail concerning Article 84 EPC. This gave the impression that clarity was not an important issue. The preliminary opinion of the board discussed unallowable amendments in claim 14. It was the

respondent's understanding that Article 84 EPC was normally examined before Article 123(2). Therefore, the respondent was taken by surprise during the oral proceedings that auxiliary request 8 was considered to be unclear. Auxiliary request A did not represent a "change of course". Technically, it was the same as the other auxiliary requests on file. The respondent did not see any objections against the combination now claimed. The respondent faced more than 30 inventive step objections. At some point, this was just overwhelming. If a certain matter was not even addressed in the preliminary opinion, it was justified to assume it was not going to be a problem. The request also reduced the patent claims.

Referral of Question to Enlarged Board of Appeal

The above mentioned question (section VI) should be referred to the Enlarged Board of Appeal. There was diverging case law concerning the question as to whether the mere deletion of claims was to be seen as an amendment of the appeal case or not. If claim deletions were not an amendment, then a board would not have a discretion to disregard them. Auxiliary request A only concerned a deletion of claims. This was because decision G 2/98 clearly stated that dependent claims were individual claims with back references instead of being written out in full. The respondent therefore did not combine claims in auxiliary request A, but only deleted all claims except for granted claim 8, as dependent on claims 4 and 1, which is an individual claim albeit in short-form notation. The divergence in case law concerned procedural law and as such it was very important for all parties to opposition appeal proceedings.

Objection under Rule 106 EPC

There was diverging case law as to whether a mere deletion of granted claims constituted an amendment within the meaning of Article 13 RPBA 2020. A request for referral regarding this question was filed and dismissed. The proprietor was therefore prevented from presenting arguments in favour of auxiliary request A on the merits despite case law supporting the admissibility of this request. This was a violation of Article 113 EPC.

Reasons for the Decision

1. *Admissibility*

The appeals satisfy the requirements of Articles 106 to 108 EPC, as well as Rule 99 EPC. They are therefore admissible.

The intervention of the assumed infringer satisfies the requirements of Article 105 EPC and Rule 89 EPC. It is therefore also admissible.

2. *Remittal*

The board did not remit the case. The respondent and appellant 2 requested that the case not be remitted. The intervener requested that the case be remitted if the documents filed with the intervention were to be

discussed. This condition did not materialise since the patent was revoked without a discussion of these documents.

3. *Main Request - Added Subject-Matter*

3.1 The ground for opposition pursuant to Article 100(c) EPC prejudices the maintenance of the patent as granted. Claim 1 as granted (main request) defines subject-matter that extends beyond the content of the application documents as originally filed. This concerns in essence the feature that the generator remains connected to and synchronised with the grid during a low voltage event of less than 50%.

3.2 Originally filed claim 1 specified a wind turbine with a blade pitch control system and an uninterruptible power supply. The wind turbine generator possesses two modes of operation. In the first (normal) mode the generator provides power. In the second mode, which is a low voltage event, the blade pitch control system is powered by the uninterruptible power supply, and the pitch of the blades is changed in an undefined way.

3.3 In the following section, paragraph numbers refer to the description as originally filed, if not otherwise indicated.

According to paragraph [0005], prior art wind turbines were allowed to trip offline in the case of a low voltage event, which entailed putting the blades in a feathered position by means of a battery powered blade pitch control system. This did not fulfil low voltage ride through requirements because the generator can not

remain synchronised and connected to the grid to support it.

According to paragraph [0007], low voltage events at 70% of rated voltage can be accommodated - i.e. the generator can remain connected to the grid and synchronised during them - through, for example, increased capacity in various components (motors, generators, converters, etc.) and by use of uninterruptible power supplies (UPSs) for sensitive control circuits. However, more severe voltage fluctuations, for example, voltages at 15% of rated voltage cannot be accommodated using these techniques.

According to paragraph [0015] and figure 4, use of a converter controller that monitors the current in one or both of the inverters to selectively enable a current limiting circuit can protect against damage that can be caused by high currents during a low voltage event. In one embodiment, a crowbar circuit is selectively enabled to shunt current away from the inverters and/or other components that can be damaged by excessive currents.

Paragraphs [0020] and [0021] describe the problem that power converters and generators are particularly susceptible to voltage fluctuations. Generators can store magnetic energy that can be converted to high currents when the generator terminal voltage decreases quickly, viz. during a low voltage event. Those currents can cause failure of the semiconductor devices of power converters coupled with the generators. The board notes that this information is technically consistent with the disclosure of E9/02 (Akhmatov, V.: "Variable-speed Wind Turbines with Doubly-fed Induction Generators Part 11: Power System Stability", Wind

Engineering Volume 26, No. 3, 2002 pages 171 to 188), page 173, first paragraph, which was cited by appellant 1 during the first instance proceedings and in appeal.

Paragraph [0022] discloses that during low voltage events the generator torque does not balance the mechanical rotor torque, which leads to the rotor speeding up, and which can eventually lead to overspeed tripping of the rotor.

Paragraph [0023] starts with the words "As described in greater detail below" and summarises three measures for accommodating a low voltage situation. As a first measure the power converter is powered by an uninterruptible power supply and includes a protective circuit that maintains currents within an allowable range. The converter controller selectively activates and deactivates the protective circuit to maintain current flow within an acceptable range. As a second measure, the turbine controller is also powered by an uninterruptible power supply and operates to prevent overspeed trips. As a third measure, one or more non-vital loads are de-energised during the low voltage event if necessary to protect those components from potential damage.

The following paragraphs [0024] to [0027] then elaborate the above measures. These paragraphs specify that the protective circuit keeps current levels in the converter, and more particularly in the inverters of the converter, within acceptable ranges in order to avoid damage of the semiconductor components. This description passage is contradictory. On the one hand, paragraph [0024] appears to describe inverters as part of the converter to be optional ("In one embodiment, power converter 400 includes inverters 410 and 420,

converter controller 430 and crowbar circuit 440."). On the other hand, the entire three paragraphs deal exclusively with converters having inverters, and the problem of overcurrent in inverters. However, these paragraphs do not contain any disclosure of other elements in which currents should be maintained at acceptable levels in order for a successful low-voltage ride-through, as the introductory paragraph [0023] states. Paragraph [0033] reaffirms that the converter controller is powered by a UPS to guard against excessive currents in the inverters.

Paragraphs [0034] to [0038] repeat in essence the previous information in the context of a process rather than a device. Paragraph [0036] deals with the behaviour of the blade pitch control system during a low voltage event. Paragraph [0037] reaffirms that certain non-essential components, such as the yaw-system, can be disabled if they are prone to damage from low voltage and high current situations. Paragraph [0038] finally reaffirms that inverters of a converter need to be guarded against excessive currents using a protective circuit, such as a crowbar circuit, in order to protect the semiconductor elements from damage.

3.4 Summarising the original disclosure, in the prior art, wind turbines were allowed to trip offline by changing the blade pitch to counter a speeding of the rotor if the torque of the generator ceases to balance the mechanical torque. Increasing robustness of certain components and powering certain loads can accommodate low voltage events down to about 70% of rated generator voltage.

If more severe voltage drops are to be accommodated, *i.e.* if the generator is not allowed to trip offline or

disconnect, but rather is required to remain connected to the grid and synchronised with it, a bundle of measures is necessary. Any fast drop in generator terminal voltage will induce excess current in the generator windings which in turn might damage the semiconductor elements in the inverters, which make up the converter. The skilled person realises that this is a severe problem with very high probability of occurrence. Furthermore, the patent very briefly discloses the possibility that blade pitch control can be used as a measure for low-voltage ride-through without this necessarily implying that the generator trips offline. Thirdly, the opposed patent discloses that non-vital loads, such as a yaw system can (also) be powered by a UPS for protection against damage due to low voltages and high currents.

It is not necessary for the patent to explicitly state this, but a skilled person clearly understands, that in order for a generator to remain connected to and synchronised with the grid during voltage drops to below 70%, it can neither be tolerated that excess currents damage the converter nor that the wind turbine blade pitch controller is allowed to trip offline. Contrary to that, the skilled person would understand that non-vital component damage might be tolerated. This is despite the - in the board's view - excessive use of expressions indicating optionality. This is also in spite of four different problems being formulated in original paragraph [0008]. Any partial solution to only a subset of these partial problems is simply not sufficient for the claimed objective of continued connection and synchronisation.

3.5 Turning now from the analysis of the original disclosure to a closer examination of the amendments,

in the course of the examination proceedings, claim 1 was amended to specify that the predetermined level defining a low voltage event is less than 50% of the rated voltage for the generator and that the generator remains connected to and synchronized with a power grid during the low voltage event.

No elements of the originally disclosed solutions, in particular no protective circuit for the inverters was added to claim 1 of the main request. A skilled person is therefore clearly faced with new information that a continuing connection and synchronisation of the generator with the power grid even at voltage drops to less than 50% of the rated voltage, could be achieved by a UPS powered blade pitch control system and turbine controller alone, as argued by the appellants and the intervener.

3.6 The respondent's counter-arguments did not convince the board.

3.6.1 The main underlying assertion on which most of the respondent's argument is built is that, due to the entirety of the original disclosure, a skilled person would have understood claims 1 and 3 as originally filed to be limited to wind turbines that were capable of a low-voltage ride-through. Moreover, the skilled person would have understood that a low-voltage ride-through capability implied the capability to remain connected and synchronised, because the application as originally filed contained a corresponding definition in paragraphs [0003] and [0009]. Furthermore, the voltage range 50% or less of rated voltage would in reality be understood by a skilled person to be 15% to 50%.

This premise is putting the cart before the horse. Rather than identifying a direct and unambiguous original disclosure, the respondent argues that precisely those amendments that were added to the subject-matter of original claims 1 and 3 had been implicitly part of these claims from the beginning. It is apparent that any amendment could be justified if that logic were to be accepted. Rather, on any objective reading neither claim 1 nor claim 3 as originally filed specified that the claimed generators were capable of low-voltage ride through or that they remained connected and synchronised during a low-voltage event of any size. Claim 1 as originally filed encompassed prior art wind turbines with a battery powered blade pitch control system that were allowed to trip offline by placing the blades in a feathered position, exactly as described in original paragraph [0005]. The repeated assertion that it was only important how a skilled person would have understood these claims turns the assessment of added subject-matter from an exercise of objective assessment into subjective, and to a large degree arbitrary, claim construction.

3.6.2 The respondent argued furthermore that the appellants and the board in reality raised an objection of missing essential features against claims 1 and 3 of the main request in the guise of an objection of added subject-matter. This is not correct. Claim 1 was amended so as to be limited - only after the amendment - to a generator that is capable of remaining connected and synchronised during low voltages of under 50% of rated voltage. However, the measures that were originally disclosed to be necessary to achieve that result, in particular a protective circuit for the inverters and a blade pitch system controlled so as not to trip the

generator, were not added to the amended claim. The fact that the claimed generator could achieve this technical effect without the originally disclosed corresponding measures clearly represents new information. Likewise, the board's analysis does not imply that claims 1 and 3 as originally filed already contained added subject-matter. This argument, like the previous one, is contingent on the same false premise that the originally filed claims were more limited than their actual wording.

- 3.6.3 The respondent also argued that a protective circuit, in particular in the form of a crowbar circuit, was originally disclosed only as an embodiment or an optional feature, referring to various passages, such as paragraphs [0024] to [0026] and claim 5 as originally filed, reasoning that if an applicant drafted an application by representing a protective circuit as optional, then this represented an original disclosure to the skilled person.

This argument does not convince the board. A skilled person does not read an application as a linguist would, but rather on the basis of their technical understanding. The application clearly teaches the skilled person that a severe voltage drop at the generator terminals causes high currents in the generator windings, which can damage the semiconductor switches in the inverter. If this happens, the generator cannot remain connected and synchronised. The original application does not contain a single technically useful piece of information as to how a severe voltage drop could be accommodated otherwise than with a protective circuit. It also does not contain a single piece of credible disclosure of conditions under which a low-voltage event did not

cause excess currents in the generator. In view of this, a skilled person sees beyond the respondent's strategic choice to represent most parts of the disclosure as optional. In this context, it is simply irrelevant how often the words "in one embodiment" are used correctly or not, contrary to what the respondent argued. This view applies in particular since the description has remained unamended despite the amendments made to claim 1. Claim 1 as originally filed was so broad as to encompass prior art turbines with battery (viz. UPS) powered blade pitch control that merely tripped offline during a low-voltage event according to original paragraph [0005]. In this original context, a skilled person easily understands that a protective circuit is not essential. However, this is not in contradiction to the fact that a protective circuit becomes essential once the generator is required to remain connected and synchronised with the grid during a low voltage event of a certain severity as is required by claim 1 as amended.

- 3.6.4 The respondent also adopted the opposition division's argument from the decision under appeal that generator synchronisation with the power grid and the damage of components were two different problems which were not inextricably linked to each other. A low voltage event could also be addressed by increasing the capacity in various components such as the motor, generator and/or converter.

The board is not convinced by this argument. The opposition division's stance concerning continued synchronisation and avoiding inverter damage by excess current being two different technical problems is very difficult to accept. The variable frequency current produced in the generator is transformed in the

converters to the stable grid frequency before being fed to the grid. Quite obviously, if the inverter is destroyed, the generator cannot remain connected and synchronised to the grid. Hence protecting the inverter is a prerequisite for, and hence inextricably linked with, the claimed technical effect expressed in claim 1 after the amendment.

Moreover, the logic of the argument of the respondent and opposition division is not correct. They appear to argue that the fact that there might be more than one solution to dealing with excess currents justified the conclusion that the respondent did not have to specify any solution in the amended claim. Regardless of the fact that the original disclosure does not contain a single further credible solution against excess currents, what is to be examined is whether the amended subject-matter was originally disclosed. The board fails to see how the existence of particular further solutions should justify not specifying any in the amended claim.

- 3.6.5 The respondent further argued in the context of the question of a protective circuit being presented as optional that presenting many examples in an application was helpful to the public and should not be held against them. This argument is largely irrelevant for the question as to what was originally disclosed. However, the board also disagrees with the respondent's characterisation of their own patent. In the board's view it contains exactly one example of how to deal with excess currents, and that is presented as optional, despite being obviously essential. Such a way of disclosing the invention is not helpful in understanding it.

- 3.6.6 The respondent also asserted that paragraphs [0007] and [0008] disclosed that a generator had to remain connected and synchronised with the grid without any mention of a protective circuit.

The board notes that original paragraph [0007] concerns prior art wind turbines. Original paragraph [0008] contains essentially assertions of achievements that do not specify the prescribed voltage levels to which claim 1 was amended and which cannot be viewed in isolation. The respondent's reference to paragraph [0036] is an attempt to read this paragraph in isolation from paragraph [0038], which refers to the same process. Moreover, the fact that parts of this process are again presented as optional is unpersuasive for the same reasons as mentioned above in the context of the device. By the same token, the argument that some low voltage situations might be conceivable in which a protective circuit did not have to be activated is not a replacement for a direct and unambiguous disclosure as to the details of those allegedly existing situations and a corresponding limitation in the claim to such situations.

Therefore, as argued by the appellants and the infringer, the above passages cannot serve as a basis for the amendments, and the ground for opposition pursuant to Article 100(c) EPC prejudices the maintenance of the opposed patent.

4. *Auxiliary Request 1 to 3 - Added Subject-Matter*

- 4.1 Claim 1 of the main request is present in unamended form in auxiliary request 1. Therefore, the conclusion

for the main request concerning added subject-matter applies correspondingly under Article 123(2) EPC.

4.2 The amendments in auxiliary requests 2 and 3 concern only the introduction of a lower boundary of 15% for the prescribed level of the low voltage event. Thus they do not have any effect on the conclusions of the board concerning the main request.

4.3 Auxiliary requests 1 to 3 therefore do not meet the requirements of Article 123(2) EPC.

5. *Auxiliary request 4 - Added Subject-Matter*

5.1 Claim 1 of auxiliary request 4 was amended so as to contain subject-matter going beyond the application documents as originally filed, as argued by the appellants and the infringer. The amendments to the patent therefore do not meet the requirements of Article 123(2) EPC.

5.2 Claim 1 of auxiliary request 4 was amended *inter alia* by the addition of the feature

"a power converter comprising a converter controller and a protective circuit, the converter controller being configured to selectively activate and deactivate the protective circuit".

5.3 The detailed analysis of the original disclosure presented in point 3.3 above demonstrates that there is only an original disclosure of a protective circuit, which guards the inverters against excessive currents, but not of a general purpose protective circuit, e.g. one that guards against excessive temperatures. This

applies in particular to paragraphs [0015] ("shunt current away"), [0023] ("maintains currents within an allowable range", "maintain current flow within an acceptable range"), [0026] and [0027] ("shunt currents"), [0033] ("guard against excessive currents in the inverters") and [0038] ("current limiting circuit").

- 5.4 The respondent argued that they had added all structural features. Maintaining the current within acceptable limits was merely a technical effect, which itself did not have to be added to the claim.

That is, in the board's view, an unpersuasive stance. Clearly a protective circuit against excess currents is structurally very different from other protective circuits such as against excess temperatures. There is also no general rule that technical effects did not have to be added when amending a claim. The respondent's argument appears to conflate the requirements for the form and contents of a claim according to Rule 43 EPC with those of Article 123(2) EPC.

The respondent further argued that paragraph [0008] disclosed as third partial problem the protection of the generator and the power converter from high voltages and currents during the voltage fluctuation. The protective circuit was therefore not limited to excess currents.

This does not convince the board. This paragraph does not mention a protective circuit against overvoltages, and, technically speaking, it appears to use redundant language, rather than disclosing true alternatives. Even if protective circuits against excess current and

overvoltage were true alternatives, a disclosure of a single further alternative does not justify the complete abstraction to general protective circuits.

6. *Auxiliary Request 5 - Added Subject-Matter*

Claim 1 of auxiliary request 4 is present in unamended form in auxiliary request 5. Therefore, the same conclusion as for auxiliary request 4 applies.

7. *Auxiliary Request 8 - Clarity*

7.1 During the oral proceedings, the respondent requested to change the order of the auxiliary requests, promoting auxiliary request 8 in rank above that of auxiliary requests 6, 7 and 9. The requests were not renumbered. The board left the question of admission of the change of order of the requests open, since this promoted procedural efficiency without disadvantaging any of the parties.

7.2 Claim 1 of auxiliary request 8 does not meet the requirements of Article 84 EPC, as argued by the appellants and the infringer.

7.3 This claim was amended to contain the feature

"wherein the power converter (315, 400) includes a protective circuit for maintaining currents within an allowable range, the converter controller being adapted for selectively activating and deactivating the protective circuit to maintain the current flow within the allowable range"

This feature was taken from the description.

7.4 The respondent argued that a claim was directed at a skilled person. A protective circuit has the function to protect. The circuit protective function was further specified by the feature "for maintaining currents in an allowable range". That is a range that "did the job", *i.e.* a range that allowed the turbine to ride through low voltage events. The detailed values of what is an allowable range depended on the specific turbine model. Those values would be determined and specified in the data sheet accompanying the turbine components. Claim 1 specified that the protective circuit was part of the power converter, which was a power electronics component. Such components always had an operational range. The allowable range was just the operating range of a power converter. Moreover, further explanations were given in paragraph [0018] of the patent. The respondent further argued that claim 1 did not merely state a result to be achieved. A protective circuit was a structural element. The contention of a result to be achieved was in direct contradiction to the appellants' contention that limiting currents was argued to be a functional feature that needed to be in the claim in the context of auxiliary request 4.

7.5 The respondent overlooks in their argument that claim 1 of auxiliary request 8 merely specifies that the protective circuit is part of the power converter. This definition, in particular the location of the protective circuit within the power converter, does not contain any limitation as to which components the protective circuit functionally protects. The board could accept that for a given specific component, such as for example inverter switches, and a given use situation, like a defined low voltage situation, the

skilled person would probably be able determine what numerical current values would be allowable. However, claim 1 cannot be read to be more limiting than its actual wording expresses. The skilled person is therefore faced merely with a definition of a problem that some unspecified components are to be protected so as to keep the current in some corresponding allowable range. The chosen definition amounts to placing the burden of determining all potential components to be protected and corresponding allowable current ranges required to successfully ride through any low voltage event on the skilled person. This is, as the appellants and the infringer correctly argue, merely a statement of a result to be achieved which does not meet the requirements of Article 84 EPC. The claims must be clear by themselves, and recourse to the description is in principle not a convincing argument. Additionally, the further explanations in the description merely concern current limitation in the inverters and therefore they are not suitable to remedy the non-compliance with Article 84 EPC in claim 1. There is also no contradiction in the line of arguments of the appellants. They had argued in the context of auxiliary request 4 that a general protective circuit went beyond the original disclosure, if it were not specified that the protective circuit protects the inverters against excessive current. This argument can not be distorted into an acknowledgement that the added feature of auxiliary request 8 could not be considered a result to be achieved.

8. *Auxiliary Request 6, 7 and 9 - Clarity*

8.1 Claim 1 in the versions of auxiliary requests 6, 7 and 9 does not meet the requirements of Article 84 EPC.

8.2 These requests all employ similar expressions of "maintaining currents within an allowable range".

Compared to auxiliary request 8, claim 1 of auxiliary request 6 does not define that the protective circuit is selectively operated. Claim 1 of auxiliary request 7 merely amends the voltage range in the definition of the low voltage event. Claim 1 of auxiliary request 9 is identical to claim 1 of auxiliary request 8.

It is thus apparent that the amendments in auxiliary requests 6, 7 and 9 do not address the lack of clarity identified in auxiliary request 8.

The respondent did not present any counter-arguments in this respect.

9. *Auxiliary Request A - Admittance*

9.1 The board has decided not to take auxiliary request A, filed during the oral proceedings before the board, into account pursuant to Article 13(2) RPBA 2020.

9.2 Auxiliary request A represents an amendment to the respondent's appeal case. The sole and independent claim according to auxiliary request A is a combination of granted claims 1, 4 and 8.

9.3 The respondent argued in essence, that auxiliary request A was not an amendment to their appeal case. They reasoned that according to decision G 2/98, dependent claims were to be seen as individual claims containing back references as short-form notation. (The board notes that decision G 2/98 does not appear to

support this contention, but instead decision G 3/14 could be seen as potentially supporting it.) Auxiliary request A corresponded therefore merely to the cancellation of all claims save one granted dependent claim. According to a line of case law, cancelling granted claims was not an amendment within the meaning of Article 13 RPBA 2020. The board therefore did not have a discretion that allowed them not to take this claim request into account.

9.4 That view of the respondent is incorrect. Indeed, some decisions have considered

- the deletion of a claim category,
- of dependent claims or
- of alternatives within claims

not to be amendments to the appeal case within the meaning of Article 13 RPBA 2020 in the circumstances at issue, see T 1480/16, T 2638/16, T 884/18, T 914/18, T 995/18, T 1151/18 and T 1857/19.

On the other hand, the boards in the cases T 713/14, T 1224/15, T 2222/15, T 1597/16, T 1439/16, T 1569/17, T 853/17, T 306/18 and T 482/19 considered deletions of claims or of alternatives within claims to constitute an amendment of the appeal case.

9.5 A closer look at the first of these groups of decisions is required. (In the following any underlining and translation is by the board.)

According to reasons 2.3 of T 1480/16

"The deletion of the method claims in auxiliary request 5 compared to auxiliary request 3 filed

with the reply to the appeal is not considered an amendment to the appeal case, because it does not change the procedural situation. In particular, no new discussion concerning novelty or inventive step is necessary."

According to reasons 4 of T 2638/16

"This deletion [of an alternative within a claim] is not considered an amendment of the appeal case, since no new procedural situation concerning the remaining subject-matter was created, as this could be the case, if the deletion entailed a completely new weighting and hence a change of the subject of the proceedings. In the present case, the deletion simply sets aside one of the objections under discussion without shedding new light on the remaining subject-matter and without other consequences on the parties' respective appeal cases. It is thus comparable to the withdrawal of certain objections or lines of attack by an opponent, which has also never been seen as a change of case which was at the discretion of the board."

Reasons 2 of T 995/18 reads almost verbatim onto the above-cited passage.

According to reasons 4 of T 884/18

"[the deletion of dependent claim 8] does not affect claim 1, which is identical to the granted claim. Consequently, it is of no consequence for the case of either party, which is directed primarily at claim 1 as granted. It follows that this amendment does not represent a modification of

the factual and legal framework of the debate to date. The Board concludes that it does not represent a change of the respondent-proprietor's case within the meaning of Article 13(2) RPBA 2020."

According to reasons 4.1 of T 0914/18

"Provided the deletion of an alternative and the deletion of dependent claims do not lead to a fresh case, they have been considered in the case law of the boards to be mere restrictions of the subject-matter that do not constitute an amendment of a party's case within the meaning of Article 13(2) RPBA 2020 [...]"

According to reasons 2.1 of T 1151/18

"[Auxiliary Request 1] does not concern, compared to the main request, a change as to its substance but rather merely the deletion of an alternative, which does not lead to a completely new weighting of the subject of the proceedings or any other change of the factual situation. Already for this reasons it does not represent an amendment of the appeal case within the meaning of Article 13(2) RPBA 2020, but a restriction which is always to be taken into account."

According to reasons 1.1 in T 1857/19

"In comparison with this former first auxiliary request, all apparatus claims were deleted. The claims are thus limited to the method claims, i.e. to the claim category which was the principal subject of the discussion. The circumstances of the

case are therefore similar to those in T 1480/16, Reasons 2.3, and T 995/18, Reasons 2, in which the deletion of the claims did not change the factual and legal framework and was thus not considered an amendment to a party's appeal case. This distinguishes the case from those underlying decisions T 2222/15 (Reasons 29 to 30) and T 1569/17 (Reasons 4.3.4), where the deletion of a claim category shifted the case substantially, thereby giving rise to new issues to be decided upon. Even if the deletion of a claim category were always to be considered an amendment, the fact that it significantly enhances procedural economy by clearly overcoming existing objections without giving rise to any new issues could be seen as exceptional circumstances in the sense of Article 13(2) RPBA 2020."

9.6 Three conclusions are to be drawn from the preceding analysis.

First, whether the deleted claims or alternatives were granted claims did not play any role in reaching the conclusion that certain deletions did not represent an amendment to the appeal case.

Second, and more importantly, none of the above decisions contains the unreserved statement that certain claim deletions were *per se* not to be considered an amendment. What was clearly essential in the "not an amendment" line of case law was that the deletions did not shift the subject of the proceedings or did not lead to new issues to be examined, but that they represented mere restrictions of the subject of the proceedings.

Third, none of the above decisions even dealt with the deletion of an independent claim and simultaneous maintenance of a dependent claim at all, let alone came to the conclusion that this type of deletion was not an amendment to the appeal case.

9.7 Turning now to the respondent's argument in detail, the board wishes to express first that it has reservations concerning the approach of not considering certain deletions as amendments under certain conditions. It rather agrees with the analysis in reasons 1.1 to 1.5 of decision J 14/19, and reasons 4.1 and 4.2 of decision T 2091/18, according to which any change from the appeal case as defined in Article 12(2) RPBA 2020 represents an amendment.

The board cannot recognise anything in the wording of the Rules of Procedure that would limit the expression "amendment" in such a way as to exclude certain types of claim deletions if they only serve to limit the appeal case. Such deletions are still changes from the initial appeal case as presented in the statement of grounds of appeal or reply and hence are an amendment in the ordinary sense of that word.

In the board's view it is dogmatically more consistent to acknowledge that the above mentioned deletions of claims represent an amendment, but that, if this amendment merely has the effect to limit the issues to be examined, this should be a strong criterion in favour of admission, or represent special circumstances within the meaning of Article 13(2) RPBA 2020.

9.8 In the present case auxiliary request A clearly introduces new issues to be examined into the proceedings.

In the normal course of events, the discussion of a claim request can be limited to its independent claim, since this is (normally) the broadest claim. If an independent claim of a request turns out not to be allowable, there is no need to discuss all the dependent claims of a request, because a request has to be allowable as a whole and not just partially. In this context, it does not play a role whether the request is directed to the claims as granted. If the respondent's underlying assertion were correct, it would become necessary to discuss each and every granted dependent claim, irrespective of whether the independent claim is allowable. This is in clear contradiction to the established practice before the Boards of Appeal. The respondent's assertion that they relied on admission not being a point of discussion for auxiliary request A is therefore hardly reconcilable with the everyday practice of appeal proceedings. It is also not reconcilable with the above mentioned line of case law.

Auxiliary Request A is now directed to the subject-matter of the combination of claims 1, 4 and 8 as granted. Claim 4 contains features regarding an inverter and how this inverter is coupled to various other parts as well as a crowbar circuit. Those are clearly new issues that have not been discussed before in the appeal proceedings. The mere fact that those issues were part of a granted claim does not make them part of the appeal case of a party, see Article 12(2) RPBA 2020, and it clearly means that the case law the respondent relies on does not support the respondent's conclusions.

The respondent's further argument according to which they were taken by surprise by the board's decision

that claim 1 of auxiliary requests 6 to 9 lacked clarity, and that consequently auxiliary request A should have been admitted, is unpersuasive. Appellant 2 had raised the objection that the feature "*the power converter includes a protective circuit for maintaining currents within an allowable range*" was merely a result to be achieved in their letter dated 25 February 2022, point 4.9.1. This feature was present in auxiliary request 3D and now in auxiliary request 8. Neither the fact that the objection is short, nor that the board did not specifically discuss it in the preliminary opinion justifies any surprise on the part of the respondent. In particular, the board does not have to follow a particular order in their discussion of issues in their preliminary opinion. It is especially not justified to rely on Article 84 EPC not being a problem if a board only discusses Article 123(2) EPC. Nor is there an obligation at all on the board to discuss each and every argument by the parties. From an absence of a discussion of that particular clarity objection, the respondent could clearly not infer that the board did not agree with the objection, and since the opinion is clearly only preliminary, less so that this could never become an issue at the oral proceedings.

The respondent complained that they faced a shotgun approach by the appellants and the infringer. Yet they presented the appellants, infringer and the board with such a large number of auxiliary requests, some of them filed only in response to the preliminary opinion of the board and at the oral proceedings, that their approach deserves the same label.

The board wishes to add that according to their preliminary opinion in the communication under Article 15(1) RPBA none of the requests then on file was

allowable because independent claim 14, present in all requests then on file, appeared to contain added subject-matter. It is instead very clear that the board does not have to discuss all further objections, if there is one that appears to be sufficient to decide on all requests. Furthermore, the present case clearly illustrates that the deletion of a category of claims, here the method claims, may well lead to new issues having to be examined. If the appellant had not filed further requests after the board's communication, added subject-matter of claim 14 may well have been the only issue for which examination would have been necessary to decide the entire case. Deletion of these claims made it necessary to discuss issues like clarity under Article 84 EPC of auxiliary requests 6 to 9, which at the time of drafting the preliminary opinion had not been necessary. This example illustrates why even the "not an amendment" case law requires additionally, that a cancellation does not lead to new issues needing to be examined. It follows that not even this line of case law can in fact support the respondent's argument that auxiliary request A had to be admitted.

The respondent's argument that the objection had not been raised in the opposition proceedings is not persuasive since the request had not been present then.

10. *Request for Referral*

10.1 The board rejects the respondent's request to refer the following question to the Enlarged Board of Appeal:

"Does the cancellation of one or more granted claims, e.g. the maintenance of a single granted

claim, constitute an 'amendment' in the sense of Art. 13 RPBA?"

10.2 According to Article 112(1)(a) EPC, in order to ensure uniform application of the law, or if a point of law of fundamental importance arises, the board of appeal shall, during proceedings on a case and either of its own motion or following a request from a party to the appeal, refer any question to the Enlarged Board of Appeal if it considers that a decision is required for the above purposes. If the board of appeal rejects the request, it shall give the reasons in its final decision.

10.3 In the present case, a decision by the Enlarged Board of Appeal is not required for the purposes enumerated in Article 112 EPC.

The divergence in case law, which the respondent believes to have identified, does not have a bearing on the decision in the present appeal case.

While it is recognised that a divergence in case law may require a decision of the Enlarged Board of Appeal ("uniform application of the law"), a question referred to the Enlarged Board of Appeal must be required for a decision of the case at hand, and not merely be of general interest. The board explained in the above discussion on admittance of auxiliary request A that none of the cited decisions considered the particular situation of auxiliary request A, in particular the deletion of an independent claim and simultaneous maintenance of a combination of dependent claims as a new independent claim, even if that resulting claim were to be considered a granted individual claim in its own right written in short-form notation. Moreover, in

all of the adduced decisions it was essential in considering certain deletions not to be amendments to the appeal case, that the deletions did not introduce new issues to be examined. This is clearly not the case for auxiliary request A, as the board explained above. In order to justify a decision from the Enlarged Board of Appeal, any divergence in case law must actually be relevant to the decision of the appeal case at hand. This is not the case here.

- 10.4 The referral is also not necessary because it does not concern a fundamental point of law.

A detailed scrutiny of the case law has shown that whether some boards considered certain claim deletions as amendments was very dependent on the individual circumstances of the cases. A deletion of a claim category, for example, was held not to be an amendment if the remaining claim category had been exhaustively discussed in T 1857/19 and T 1480/16. However, where the remaining claim category had not been exhaustively discussed, it was considered an amendment in T 2222/15 and T 1569/17.

It is thus impossible to answer the question proposed by the respondent without specifying the individual circumstances of the case. This shows that it is not a question of fundamental importance.

Therefore, the board rejects the request for referral.

11. *Objection under Rule 106 EPC*

- 11.1 The board dismisses the objection under Rule 106 EPC raised during the oral proceedings before the board.

11.2 The respondent filed the following objection under Rule 106 EPC in writing during the oral proceedings before the board after the chairman had informed the parties of the rejection of the requested referral (cf. Minutes, page 5):

"There exist [sic] diverging case law on whether a mere deletion of granted claims constitutes an amendment under Art. 13 RPBA 2020. A request for referral regarding this question was filed and dismissed. For this, we are prevented from presenting arguments in favour of request A on the merits despite case law supporting the admissibility of this request. This is a violation of Art. 113 EPC."

11.3 The board gave all parties, in particular also the respondent, the opportunity for a debate on the question of admittance of auxiliary request A. After it decided not to admit the request, it gave all parties, in particular also the respondent, the opportunity for a debate on the request for referral of a question of law to the Enlarged Board of Appeal. It then decided to reject the request for referral.

11.4 The respondent argued that they were deprived of their right to comment on the merits of auxiliary request A under Article 113(1) EPC due to the fact that the board regarded auxiliary request A as an amendment of the respondent's appeal case and decided not to admit that request and because of the board's decision not to refer the above question to the Enlarged Board of Appeal.

11.5 Article 113(1) EPC provides that the decisions of the European Patent Office may only be based on grounds or evidence on which the parties concerned have had an opportunity to present their comments. The respondent has not explained why they were prevented from commenting on the grounds for the decisions the board has taken on the non-admittance of auxiliary request A and the rejection of the request for referral. Their objection is clearly not based on the fact that they did not have an opportunity to comment, but rather on the fact that they do not agree with the board's decision not to take into account auxiliary request A pursuant to Article 13(2) RPBA 2020.

Moreover, Article 113(1) EPC clearly does not confer an absolute right on parties to present comments as to the substance of a request even when such a request is not admitted. To safeguard the right to be heard, a party only has to be given the opportunity to comment on those grounds which are relevant for the decision to be taken. Thus, in the case of non-admittance of a request the parties have to be given the opportunity to present their arguments in relation to the topic of admittance of the request concerned. It is a very common procedural situation that a party can no longer present arguments as to the substance whenever requests or appeals have not been admitted or are found inadmissible, respectively. This, *per se*, is not a violation of the right to be heard.

11.6 Furthermore, as pointed out above, the parties were also given the opportunity to be heard on the requested referral to the Enlarged Board of Appeal. In that context it is to be noted that pursuant to Article 112(1)(a) EPC a board of appeal shall refer a question to the Enlarged Board of Appeal if *it considers* that a

decision *is required*, in order to ensure uniform application of the law or because a *point of law of fundamental importance* arises. Under above points 10.3. and 10.4 the board has given its reasons why it did not consider it necessary to refer the question to the Enlarged Board. In particular, it should be emphasised that the board could readily assess the question as to whether the filing of auxiliary request A constituted an amendment to the respondent's appeal case in the sense of Article 13(2) RPBA 2020 on the basis of the existing legal provisions. Moreover, in view of the discretionary character of the decision (cf. Article 112(1)(a) EPC: " [...] if it [the Board] considers that a decision is required [...]") it is clear that the provision does not give a party the absolute right to have a question of law referred to the Enlarged Board of Appeal. Rather, the board considers the decision to rule on the point itself instead of referring it to the Enlarged Board of Appeal to be a substantive discretionary decision of the board rather than a procedural one. (See also reasons 2.3 of R 8/11 and reasons 27 of R 17/14).

11.7 In view of the above the objection under Rule 106 EPC was dismissed.

12. *Withdrawals of Appeals and Reimbursement of Appeal Fees*

Appellant 2 withdrew their appeal and the intervener withdrew their intervention after the chairman announced the decision at the oral proceedings. Therefore the conditions of Rule 103(4)(a) EPC for partial reimbursement of the appeal fee are not met.

13. *Conclusions*

The ground for opposition under Article 100(c) EPC prejudices the maintenance of the main request. Auxiliary requests 1 to 5 do not meet the requirements of Article 123(2) EPC. Auxiliary requests 6 to 8 do not meet the requirements of Article 84 EPC. Auxiliary request A was not admitted. The board rejects the request for a referral of a question to the Enlarged Board of Appeal and dismisses the corresponding objection under Rule 106 EPC. The board therefore acceded to the substantive request of the appellants and intervener.

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 of a question to the Enlarged Board of Appeal is rejected.
4. The objection under Rule 106 EPC is dismissed.

The Registrar:

The Chairman:



U. Bultmann

R. Lord

Decision electronically authenticated