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**Datasheet for the decision
of 3 December 2024**

Case Number: T 0927/21 - 3.4.02

Application Number: 15713727.4

Publication Number: 3127232

IPC: H02P6/00, H02P6/14

Language of the proceedings: EN

Title of invention:

A high efficiency commutation circuit

Applicant:

ABB Schweiz AG

Relevant legal provisions:

EPC Art. 111(1)

EPC R. 71(3)

Keyword:

Appeal decision - Remittal to the department of first instance
(yes)



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Case Number: T 0927/21 - 3.4.02

D E C I S I O N
of Technical Board of Appeal 3.4.02
of 3 December 2024

Appellant: ABB Schweiz AG
(Applicant) Brown Boveri Strasse 6
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Decision under appeal: **Decision of the Examining Division of the
European Patent Office posted on 25 February
2021 refusing European patent application No.
15713727.4 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chairman G. Flyng
Members: C.D. Vassoille
P. Guntz

Summary of Facts and Submissions

- I. The applicant filed an appeal against the decision of the examining division with which the European patent application No. 15 713 727.4 was refused.
- II. In the contested decision the examining division concluded that claims 1 and 11 of the main request as well as the corresponding independent claims of auxiliary requests 1 to 6 lacked clarity under Article 84 EPC. The specific objections were related to independent claims attempting to define the subject-matter in terms of the result to be achieved.

The auxiliary request 7 filed during the oral proceedings before the examining division had previously been considered to be allowable, leading to the issue of a communication under Rule 71(3) EPC.

In response to that communication the applicant had maintained the main request and auxiliary requests 1 to 6, seeking an appealable decision.

- III. With the statement of grounds of appeal the appellant requested that the decision under appeal be set aside and:
- as main request that a patent be granted on the basis of the claims of the international publication no. WO 2015/150349 A1,
 - alternatively, that a patent be granted on the basis of one of the auxiliary requests 1 to 6 filed on 28 August 2020,
 - alternatively, that a patent be granted on the basis of the auxiliary request 7 filed during the

oral proceedings before the examining division and found to be allowable by the examining division.

- IV. In a communication under Article 15(1) RPBA annexed to the summons to oral proceedings, the board informed the applicant of its preliminary opinion according to which none of the main request and auxiliary requests 1 to 6 met the requirements of Article 84 EPC, but that the board would be inclined to remit the auxiliary request 7 found to be allowable by the examining division for grant.
- V. Oral proceedings before the board took place on 3 December 2024 in the format of a videoconference as requested by the appellant.

At the end of the oral proceedings, the appellant (applicant), having withdrawn the higher ranking main and auxiliary requests, requested as a sole request that the decision under appeal be set aside and that the case be remitted to the examining division with the order to grant a patent in the version of auxiliary request 7 as set out in the communication under Rule 71(3) EPC dated 4 November 2020 with the amendments proposed therein.

Reasons for the Decision

1. Auxiliary request 7 - Remittal (Article 111(1) EPC)

- 1.1 The sole request maintained by the appellant corresponds to auxiliary request 7 in the version held allowable by the examining division according to the communication issued under Rule 71(3) EPC.
- 1.2 The auxiliary request 7 introduces specific structural limitations in the claims, which were found by the examining division to overcome the clarity objections raised against the main request and auxiliary requests 1 to 6. As set out in sections 10 to 12 of the "Summary of Facts and Submissions" of the contested decision, the chair of the examining division declared auxiliary request 7 allowable during the oral proceedings, leading to the issuance of a communication under Rule 71(3) EPC, and in response the applicant maintained the main request and auxiliary requests 1 to 6, seeking an appealable decision.
- 1.3 In particular, in response to the Rule 71(3) EPC communication, the appellant stated in their submission of 10 February 2021:

"... the Applicant maintains the Main Request and Auxiliary Requests 1-6, and requests an appealable decision on the state of the file."

With this approach, both the applicant and the examining division essentially followed the corresponding instructions in the then valid version of the Guidelines for Examination in the European Patent

Office (November 2019, hereinafter "Guidelines"), see in particular chapters E-X, 2.9, C-V, 1.1, penultimate paragraph and C-V, 4.7.1.1.

- 1.4 Nevertheless, the question arises for the present board whether the explicit maintenance of the higher-ranking requests, i.e. the main request and auxiliary requests 1 to 6, and the associated waiver of the grant of a patent on the basis of auxiliary request 7, implies a withdrawal of auxiliary request 7. Regrettably, the Guidelines do not contain any meaningful instructions for the applicant to the effect that the auxiliary request deemed allowable in the Rule 71(3) EPC communication in a particular case might need to be explicitly maintained by the applicant in view of any subsequent appeal proceedings.
- 1.5 In the present case, at least no explicit withdrawal of auxiliary request 7 is apparent from the file. To avoid the lack of instructions in the Guidelines being detrimental to the appellant in the present case, the present board holds that the benefit of doubt should go in favour of the applicant who might well have only chosen to give a declaration as suggested by the guidelines. It, thus, cannot be established with sufficient certainty that their declaration to maintain the main request and auxiliary requests 1 to 6 should imply that the not-mentioned auxiliary request was intended to be withdrawn.
- 1.6 This is consistent with the practice of the Boards of Appeal in similar cases where the version considered allowable by the examining division was deemed to have been maintained in the first instance proceedings and, if further requested in the appeal proceedings, was accepted by a board as an appropriate basis for the

grant of a patent (see for example T 1101/20, T 2090/11 and T 1863/20).

Hence, auxiliary request 7 can be deemed to have been maintained in the first instance proceedings and thus considered under Article 12(2) and (4) RPBA in the appeal proceedings.

2. Furthermore, the board does not see any reason to deviate from the examination division's favourable assessment of auxiliary request 7.
3. Thus, the case is to be remitted to the examining division with the order to grant a patent on the basis of the claims, decision and drawings of this request in the form considered allowable by the examining division allowable.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the examining division with the order to grant a patent in the version of auxiliary request 7 as set out in the communication under Rule 71(3) EPC dated 4 November 2020 with the amendments proposed therein.

The Registrar:

The Chairman:



D. Meyfarth

G. Flyng

Decision electronically authenticated