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**Datasheet for the decision
of 16 March 2023**

Case Number: T 1009/21 - 3.5.05

Application Number: 14781732.4

Publication Number: 3195132

IPC: G06F13/38, G06F13/40

Language of the proceedings: EN

Title of invention:

A METHOD AND APPARATUS TO CONTROL A MODE OF A DEVICE

Applicant:

Micro Motion, Inc.

Headword:

Negotiating the USB role of a USB device / Micro Motion

Relevant legal provisions:

RPBA 2020 Art. 12(4), 12(6) sentence 2, 13(2)

Keyword:

Late-filed request - circumstances of appeal case justify
admittance (no) - admitted in first-instance proceedings (no)
- error in use of discretion at first instance (no) - admitted
(no)



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Case Number: T 1009/21 - 3.5.05

D E C I S I O N
of Technical Board of Appeal 3.5.05
of 16 March 2023

Appellant: Micro Motion, Inc.
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Boulder, CO 80301 (US)

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Decision under appeal: **Decision of the Examining Division of the
European Patent Office posted on 22 February
2021 refusing European patent application No.
14781732.4 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chairman E. Konak
Members: P. Tabery
K. Kerber-Zubrzycka

Summary of Facts and Submissions

- I. The appeal is directed against the examining division's decision to refuse the European patent application.
- II. The examining division did not admit the main request and the auxiliary request submitted at the oral proceedings on 12 November 2020 and decided that there was no text agreed to by the applicant within the meaning of Article 113(2) EPC.
- III. With its statement of grounds of appeal, the appellant submitted a new second and a new third auxiliary request.
- IV. The board issued a summons to oral proceedings. It also set out its preliminary opinion on the case (Article 15(1) RPBA 2020). The board indicated that it did not intend to admit any of the requests into the appeal proceedings.
- V. Oral proceedings were held before the board. At the oral proceedings, the appellant withdrew some of its requests. The appellant's final requests were that the decision under appeal be set aside and the case be remitted to the examining division for further prosecution on the basis of the main request and the auxiliary request not admitted by the examining division or, alternatively, that a patent be granted on the basis of the claims of the first auxiliary request, submitted on 12 November 2020, or the third auxiliary request, submitted with the statement setting out the grounds of appeal.
- VI. **Claim 1** of the **first auxiliary request** reads as follows:

"A method of controlling a mode of a device, the method comprising:

determining if the device is applying a voltage to the Vbus pin; and

if the device is applying a voltage to the Vbus pin, determine if a USB connector of the device is receiving a response, and if a response is received at the USB connector, configuring the device as a host,

if the device is not applying a voltage to the Vbus pin, compare the Vbus voltage and a threshold and determine if a USB connector of the device is receiving a response, and if the Vbus voltage is greater than the threshold, then configuring the device as a slave, and if the Vbus voltage is less than the threshold and a response is received at the USB connector then configuring the device as a host."

Independent **claim 8 is** directed to a corresponding apparatus.

VII. **Claim 1** of the **third auxiliary request** reads as follows:

"A method of controlling a mode of a device, the method comprising:

determining if the device is applying a voltage to the Vbus pin;

if the device is applying a voltage to the Vbus pin, determining if a USB connector of the device is receiving a response, and if a response is received at the USB connector, configuring the device as a host,

if the device is not applying a voltage to the Vbus pin, measuring a Vbus voltage on a Vbus pin in a USB connector on the device and comparing the Vbus voltage and a threshold and determining if a USB connector of the device is receiving a response, and if the Vbus

voltage is greater than the threshold, then configuring the device as a slave, and if the Vbus voltage is less than the threshold and a response is received at the USB connector then configuring the device as a host."

Reasons for the Decision

1. Request for remittal
 - 1.1 The appellant requested that the case be remitted to the examining division for further prosecution on the basis of the main request and the auxiliary request not admitted by the examining division. It argued that in the summons the examining division limited itself to recognising the difference over the disclosure of document **D1**, thus effectively shifting the discussion on inventive step from the written procedure into the oral proceedings. In the end, though, inventive step of the difference was never discussed as the examining division decided not to admit the appellant's requests into the examination proceedings. However, the appellant emphasised that it should have been given the opportunity to amend the claims in front of the examining division following a discussion on inventive step. Finally, the appellant argued that the examining division's decision not to admit the appellant's requests was based on an incorrect assessment of what was claimed, this amounting to a substantial procedural violation.
 - 1.2 The board notes that a remittal was requested for the first time in the appellant's letter dated 17 January 2023 and thus after the notification of the summons to oral proceedings. The allegation that a substantial procedural violation had happened was only presented during the oral proceedings before the board,

i.e. the substantiation for the request was provided even later. The request for remittal thus constitutes an amendment of the appeal case not to be taken into account unless there are exceptional circumstances justified with cogent reasons by the party concerned (Article 13(2) RPBA). In the current case, the board holds that no such exceptional circumstances exist, and the appellant did not present any. For the sake of completeness, the board notes that the decision under appeal does not suffer from a procedural violation (see section 2.3 below).

- 1.3 In view of the above, the board decides not to admit the request for remittal into the proceedings (Article 13(2) RPBA).

2. First auxiliary request
 - 2.1 Under Article 12(6) RPBA, the board shall not admit requests which were not admitted in the proceedings leading to the decision under appeal, unless the decision not to admit them suffered from an error in the use of discretion.
 - 2.2 The appellant argued that the examining division's decision not to admit this request suffered from an error in the use of discretion since the decision was based on an incorrect set of claims. Section 7.3 of the decision under appeal mentioned the requests of 12 October 2020 rather than those submitted during the oral proceedings to replace them. Claim 1 of the first auxiliary request did not have a step of measuring the voltage.
 - 2.3 The board is not convinced by these arguments. The first auxiliary request was filed during the oral proceedings before the examining division and thus

constituted a late-filed request. In such a case, admissibility is to be assessed *prima facie* by the examining division. In the decision under appeal, the examining division held in section 7.3 that the first auxiliary request did not fulfil the criterion of "*clear allowability*" since the effect (not requiring measurement of the voltage) could only be achieved in one case. The board notes that, on the one hand, the criterion of "*clear allowability*" amounts to a *prima facie* assessment of inventive step, i.e. the examining division used the correct test. On the other hand, claim 1 of the first auxiliary request mentions a comparison of the Vbus voltage, this implying a measurement. Consequently, the decision not to admit is based on the actually claimed features. The fact that section 7.3 additionally makes reference to the requests that were previously withdrawn does not invalidate this finding. Thus, the board holds that the examining division's decision not to admit the first auxiliary request into the proceedings was taken in accordance with the right principles.

2.4 Consequently, the board decides not to admit the first auxiliary request into the appeal proceedings (Article 12(6), first sentence, RPBA).

3. Third auxiliary request

3.1 This request was not raised in the proceedings leading to the decision under appeal. Therefore, it is an amendment within the meaning of Article 12(4) RPBA and thus may be admitted only at the discretion of the board. As for reasons for submitting it in the appeal proceedings, the appellant argued that this request was filed in response to the reasoning of the decision

under appeal which was based on considerations not communicated earlier to the appellant.

3.2 At the oral proceedings, the board asked the appellant which point of the reasoning of the decision had not been communicated earlier. The appellant could not give any example. Hence, the appellant could have reacted to the examining division's objections in the examination proceedings.

3.3 Consequently, the board exercises its discretion and decides not to admit the third auxiliary request into the appeal proceedings (Article 12(4) RPBA).

4. In view of the above, the appeal is not allowable.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:



K. Götz-Wein

E. Konak

Decision electronically authenticated