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**Datasheet for the decision
of 24 October 2023**

Case Number: T 1103/21 - 3.5.02

Application Number: 12178574.5

Publication Number: 2565891

IPC: H01H3/40, H01H3/42, H01H33/36

Language of the proceedings: EN

Title of invention:
Driver for switch in gas insulated switchgear and gas insulated switchgear having the same

Patent Proprietor:
Hyundai Electric & Energy Systems Co., Ltd.

Opponent:
ABB Schweiz AG

Relevant legal provisions:
EPC Art. 107
RPBA 2020 Art. 12(6)

Keyword:
Appellant adversely affected by the contested decision (yes)
Late-filed main request and auxiliary request - should have been submitted in first-instance proceedings (yes)

Decisions cited:

T 0457/89, G 0001/88



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Case Number: T 1103/21 - 3.5.02

D E C I S I O N
of Technical Board of Appeal 3.5.02
of 24 October 2023

Appellant: Hyundai Electric & Energy Systems Co., Ltd.
(Patent Proprietor) 75, Yulgok-ro
Jongno-gu
Seoul 03058 (KR)

Representative: Cabinet Chaillot
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92703 Colombes Cedex (FR)

Respondent: ABB Schweiz AG
(Opponent) Bruggenstrasse 66
5400 Baden (CH)

Representative: Maiwald GmbH
Grünstraße 25
40212 Düsseldorf (DE)

Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 14 May 2021
revoking European patent No. 2565891 pursuant to
Article 101(2) EPC.**

Composition of the Board:

Chairman R. Lord
Members: C.D. Vassoille
W. Ungler

Summary of Facts and Submissions

- I. The appeal of the patent proprietor lies against the decision of the opposition division revoking European patent no. 2 565 891.
- II. In the opposition proceedings, the appellant did not respond to the invitation of the opposition division to file observations on the opposition (Rule 79(1) EPC). Against this background, the opposition division based their decision exclusively on the opponent's submissions and concluded that the ground for opposition under Article 100(a) EPC in connection with Article 54 EPC prejudiced the maintenance of the patent as granted.
- III. The board summoned the parties to oral proceedings. In a communication under Article 15(1) RPBA annexed to the summons to oral proceedings, the board informed the parties of their preliminary opinion on the case. It was stated *inter alia* that the board provisionally considered the appeal to be admissible but that none of the requests filed with the statement of grounds of appeal was likely to be allowed into the appeal proceedings.
- IV. Oral proceedings before the board took place on 24 October 2023 as a Zoom videoconference with the consent of the parties.

The appellant (patent proprietor) requested that the decision under appeal be set aside and that the patent be maintained in amended form on the basis of the main request, or if this was not possible on the basis of

the auxiliary request, both filed with the statement of grounds of appeal.

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

Reasons for the Decision

1. Admissibility of the appeal

1.1 The appeal is admissible.

1.2 As regards the admissibility of the present appeal, the board agrees with the findings that the board of appeal set out in T 0457/89. Accordingly, under Article 107, first sentence, EPC, the appeal is open to those who were parties to the proceedings which led to the contested decision, in so far as they are adversely affected by the decision.

1.3 In the present case, the appellant is the proprietor of the granted European patent no. 2 565 891 and was therefore a party to the opposition proceedings that had been initiated on the basis of the opposition filed by the respondent. Consequently, the appellant is also adversely affected by the decision of the opposition division by which it revoked the granted European patent under Article 101(2) EPC.

1.4 As the board of appeal pointed out in T 0457/89, by analogy with the decision of the Enlarged Board of Appeal G 1/88, the appeal by a party to the opposition proceedings is not inadmissible because that party failed to file observations within the time limit in response to the invitation by the opposition division

under Article 101(2) EPC. According to section 3.1 of the decision G 1/88, a possible loss of rights as a consequence of an omission is always explicitly mentioned in the EPC. Article 101(2) EPC does not provide for such a loss of rights.

Failure to respond to an invitation to do so by the opposition division in a communication, as was the case here, cannot therefore be considered as an implicit waiver of further participation or an implicit withdrawal of a request for oral proceedings.

- 1.5 The present appeal, which complies with the requirements under Article 108 EPC and Rule 99(2) EPC, is therefore admissible.
- 1.6 At the oral proceedings before the board, the respondent agreed with the above assessment, which had already been set out in essentially identical wording in the board's communication under Article 15(1) RPBA.
2. *Admittance of the main request and auxiliary request into the appeal proceedings (Article 12(6) RPBA)*
 - 2.1 As set out in paragraph II above, the appellant made no observations on the opposition in the proceedings before the opposition division on the merits. With the statement of grounds of appeal, the appellant then filed for the first time a new main request and a new auxiliary request, requesting that the patent be maintained in amended form.
 - 2.2 According to Article 12(6) RPBA, the board shall not admit requests, facts, objections or evidence which should have been submitted in the proceedings leading

to the decision under appeal, unless the circumstances of the appeal case justify their admittance.

- 2.3 In the present case, the reasons stated in the contested decision essentially corresponded to what was submitted by the respondent in the grounds for opposition and the appellant would thus have had reason and opportunity to file these requests already in the proceedings before the opposition division. By failing to do so, the appellant prevented the opposition division from taking a decision on these requests.

It is further to be noted that the appeal procedure is not a continuation of the first-instance procedure, but serves the primary purpose of judicial review of the contested decision (Article 12(2) RPBA).

- 2.4 Throughout the appeal proceedings, the appellant has not indicated any specific circumstances of the appeal case that could justify the admittance of the new requests into the appeal proceedings within the meaning of Article 12(6) RPBA. In its communication pursuant to Article 15(1) RPBA, the board had already announced the expected non-admittance of the main request and the auxiliary request (see paragraph III above and the respective communication of the board under point 11). However, the appellant did not provide any justification either in writing or at the oral proceedings.

- 2.5 In the absence of any arguments in this regard on the part of the appellant and as no justifying circumstances are apparent to the board either, it exercised its discretion under Article 12(6) RPBA not to admit the main request and the auxiliary request into the appeal proceedings.

3. *Result*

Since the appeal was admissible, but neither of the appellant's requests was admitted into the appeal proceedings, the board had to accede to the respondent's request.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:



K.Boelicke

R. Lord

Decision electronically authenticated