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**Datasheet for the decision
of 8 January 2024**

Case Number: T 1591/23 - 3.2.07

Application Number: 18150553.8

Publication Number: 3385031

IPC: B24B23/02, B24B23/04, H02P6/00,
H02P29/00, H02M1/42

Language of the proceedings: EN

Title of invention:
CONTROL METHOD FOR AN ELECTRIC SANDING MACHINE

Applicant:
Mirka Oy

Headword:

Relevant legal provisions:

EPC Art. 84, 111(1), 113(1), 116
EPC R. 103(1)(a), 137(3)
RPBA 2020 Art. 11, 12(2), 12(8)

Keyword:

Claims - clarity (yes)

Appealed decision - substantial procedural violation (yes)

Remittal to the department of first instance - (yes)

Reimbursement of appeal fee - equitable by reason of a
substantial procedural violation - (no)

Decisions cited:

T 0756/18, R 0010/18

Catchword:



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Case Number: T 1591/23 - 3.2.07

D E C I S I O N
of Technical Board of Appeal 3.2.07
of 8 January 2024

Appellant: Mirka Oy
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Representative: Hoffmann Eitle
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Decision under appeal: **Decision of the Examining Division of the
European Patent Office posted on 24 April 2023
refusing European patent application No.
18150553.8 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chairman G. Patton
Members: V. Bevilacqua
Y. Podbielski

Summary of Facts and Submissions

- I. The present appeal, which was filed within the prescribed period and in the prescribed form, lies from the decision of the Examining Division to refuse European patent application No. 18 150 553.8
- II. The appealed decision rejected the main request finding that independent claims 1 and 9 thereof contravened the requirements of Article 84 EPC.
- III. With the statement of grounds of appeal, the appellant requests, as its main request in the appeal proceedings,
that the decision be set aside and
that the case be remitted to the Examining Division with the instruction to grant a patent on the basis of the main request discussed in the appealed decision (main request), alternatively
that the case be remitted to the Examining Division with the instruction to grant a patent on the basis of one of
auxiliary requests 1 to 13, also discussed in the appealed decision, or
auxiliary requests 14 to 33, filed with the statement setting out the grounds of appeal.

The appellant also requests
that the appeal fee be reimbursed and
acceleration of the proceedings under Article 10(3) RPBA 2020.

Oral proceedings were requested in case that the main request is not allowed.

IV. In preparation for oral proceedings the Board gave its preliminary assessment of the case by means of a communication pursuant to Article 15(1) RPBA 2020 dated 12 October 2023.

In this communication the Board indicated that:

- the request of acceleration of the proceedings was granted,
- the appellant convincingly demonstrated that the decision's findings on lack of clarity of the main request are not correct,
- the appellant also convincingly demonstrated that a procedural violation was incurred,
- the request for reimbursement of the appeal fee was however to be refused,
- the Board considered it appropriate to remit the case to the Examining Division for further prosecution.

V. In response to the Board's communication by letter of 30 October 2023, the appellant withdrew their request for oral proceedings on the condition that the Board maintained its preliminary opinion.

VI. Claim 1 of the main request discussed in the appealed decision reads as follows (feature **f1**, which was considered as unclear in the appealed decision, is in bold, emphasis added by the Board):

"A method for controlling an electric sanding machine comprising an electric drive motor that is a brushless direct current motor, which method comprises rectification of the mains voltage and switched control of the motor,

wherein the motor is dimensioned in such a way that the nominal voltage of the motor is lower than the top value of the rectified mains voltage."

Claim 9 of the main request reads as follows (feature **f1** again in bold, emphasis added by the Board):

"An electric sanding machine comprising a brushless direct current motor and a control unit configured for rectification of a mains voltage and switched motor control,
wherein the motor is dimensioned in such a way that the nominal voltage of the motor is lower than the top value of the rectified mains voltage."

VII. The lines of argument of the appellant are dealt with in detail in the reasons for the decision.

Reasons for the Decision

1. Decision in writing, Article 12(8) RPBA 2020
- 1.1 The present case is ready for decision, which is taken in written proceedings without holding oral proceedings in accordance with Article 12(8) RPBA 2020 and with Articles 113 and 116 EPC.
- 1.2 In reaction to the Board's communication pursuant to Article 15(1) RPBA 2020, explaining that the case could be remitted for further prosecution, the appellant wrote:

"Conditional upon the Board of Appeal confirming the preliminary opinion provided with the Communication

dated October 12, 2023, to remit the case to the first instance for further prosecution, and an order to consider the requirements of Article 84 EPC satisfied by the claims of the Main Request currently on file, we hereby withdraw our request for oral proceedings and kindly request a decision on the merits confirming the above.

Purely for the avoidance of any doubt, should the Board of Appeal consider departing from the preliminary opinion, either by not remitting the case to the first instance or not to order the requirement of Article 84 EPC deemed to be satisfied, we maintain our request for oral proceeding" (letter dated 30 October 2023).

- 1.3 The Board considers that with this statement the appellant withdrew their request for oral proceedings in case a final decision on the appeal, confirming that the appellant convincingly demonstrated that the decision's findings on lack of clarity of the main request are incorrect and remitting the case to the Examining Division for further prosecution, is issued.
- 1.4 The appellant has been informed of the Board's preliminary assessment of the case with a communication under Article 15(1) RPBA 2020 taking the appellant's submissions fully into account.

Thus, the grounds and evidence upon which the present decision is based were known to the appellant, and have neither been commented upon nor been contested by them.

Accordingly, the principle of the right to be heard (Article 113(1) EPC) has been observed since that provision only affords the opportunity to be heard, and the party's submissions have been fully taken into

account (see Case Law of the Boards of Appeal, 10th edition 2022, identified as "CLB" in the following, III.B.2.7.3).

- 1.5 In view of the fact that the case is ready for decision on the basis of the appellants' written submissions the Board issues the present decision in written proceedings in accordance with Article 12(8) RPBA.
2. Review of the appealed decision on the main request - clarity of feature f1 (see point VI above)
 - 2.1 Reasons for the appealed decision, point 1.1
 - 2.1.1 According to the Examining Division, feature f1 renders the subject-matter of claim 1 of the main request unclear, because it concerns the dimensioning of the motor of the sanding machine and not a method step of the claimed method for controlling an electric sanding machine. It is therefore unclear whether this feature is part of the claimed subject matter.
 - 2.1.2 The appellant criticizes the above findings arguing substantially that feature f1 defines a relationship between the mains voltage (that the method requires to be rectified) and the nominal voltage of the motor that is part of the electric sanding machine being controlled (statement of grounds, 4.2.2.1).
 - 2.1.3 The Board concurs with the appellant, for the following reasons.

The control method of claim 1 is to be seen as a method for controlling. According to the established case law (CLB, I.C.8.1.3.c) in the formulation method for "controlling" the "for controlling" is to be understood

as a functional feature of the claimed method, defining one of the steps in the claimed process.

Feature f1 clearly imposes a restriction on the claimed method, because with it this particular functional feature (controlling) is limited to a particular type of electric sanding machines, namely those dimensioned in such a way that the nominal voltage of the motor is lower than the top value of the rectified mains voltage. This can be seen as a selection step. Furthermore, a method which includes a product is not unclear per se.

As a consequence of the above, and contrary to the findings of the appealed decision, feature f1 is a clear limitation of the claimed method for controlling an electric sanding machine.

2.2 Reasons for the appealed decision, points 1.2 to 1.4

2.2.1 According to the Examining Division, after considering the application as a whole, feature f1 does not clearly define the subject-matter for which protection is sought. This feature should be defined as a method step according to which only that part of the rectified mains alternating voltage which is higher than the nominal voltage of the motor is applied to the motor of the sanding machine.

Since feature f1 does not contain these limitations derived from the description, there is a contradiction therebetween, resulting in a lack of clarity.

Feature f1 would, on the basis of this interpretation, be fulfilled in all (normal) cases in which there is no boost converter.

Hence, the requirements of Article 84 EPC were considered not to be fulfilled.

2.2.2 The appellant argues that the above findings of the appealed decision are not correct, because they are based on an interpretation of feature f1 which takes into account only "normal cases", without boost converter, and ignores the clear linguistic structure of the feature (statement of grounds, 4.2.2.2).

2.2.3 The Board also considers that the justification of lack of clarity given in points 1.2 and 1.4 of the appealed decision is not correct.

The Board in particular sees no reason for considering that the rather restrictive interpretation, on the basis of which the application was refused ("normal cases") would be the one chosen by a skilled reader of claim 1 of the main request.

In this respect, claim 1 does not comprise the limitation (see the reasons for the appealed decision, points 1.2 to 1.4) that

"only the part of the rectified mains alternating voltage being higher than the nominal voltage of the motor is applied to the motor of the sanding machine".

According to established case law (CLB, II.A.6.1), a broad claim is not to be construed narrowly, even if, as in the case at issue, the narrower interpretation would refer to a structure which is "normal", but not exclusive, in the technical field concerned.

Reading a broadly formulated claim only technically

illogical interpretations should be excluded.

The Board is also not convinced that, in the present case, a refusal of claim 1 of the main request because of lack of clarity may be justified on the basis of a discrepancy between the description and the claim.

This is because if a term used in a claim has a clear technical meaning, as it is the case presently (see point 2.1 above), the description cannot be used to interpret such a term in a different way. In case of a discrepancy between the claims and the description, the unambiguous claim wording must be interpreted as it would be understood by the person skilled in the art without the help of the description (CLB, II.A.6.3.1).

Furthermore, feature f1 makes a comparison between two different voltages, namely the rectified mains voltage, on the one hand, and the nominal voltage of the motor, on the other hand. The method of claim 1 comprises a step of rectifying the mains voltage, i.e. converting alternating current to direct current. As a result feature f1 enables to define the motor by providing a relationship between the nominal voltage of the brushless direct current motor and the rectified mains voltage.

The fact that feature f1 could be fulfilled in all (normal) cases in which there is no boost converter relates to the assessment of novelty with respect to the prior art, not to clarity.

2.3 Reasons for the appealed decision, point 2.1

2.3.1 The Examining Division also found that feature f1 renders the subject-matter of claim 9 of the main

request unclear, because it concerns a method step of dimensioning the motor of the sanding machine and not a structural feature of the claimed sanding machine. It is therefore unclear whether this feature is part of the claimed subject matter.

2.3.2 The Board fully concurs with the appellant, who argues that the above findings are not correct because the nominal voltage is a structural feature of the motor, which itself is part of the electric sanding machine, and therefore, feature f1, taken in the context of independent product claim 9, defines a structural feature of the claimed electric sanding machine (statement of grounds, 4.2.3.1).

2.4 Reasons for the appealed decision, points 2.2 to 2.4

2.4.1 The Examining Division also objected, explicitly referring to item 1.2 of the grounds for the appealed decision, that feature f1 does also not clearly define, once the content of the application as a whole is taken into consideration, the subject-matter for which claim 9 seeks protection (item 2.4 of the appealed decision).

2.4.2 The Board considers the above justification of lack of clarity as not being correct for the same reasons already discussed above in relation to items 1.2 and 1.4 of the grounds for the appealed decision (see point 2.2.3 above).

2.5 Based on the above, the Board concludes that the appellant convincingly demonstrated that the findings of the appealed decision on the basis of which the main request was not allowed are not correct.

3. Lack of clarity of the main request - further issues

3.1 According to section 4.2.1 of the appealed decision, the expression "*allowed values*", also used in claim 6 of the main request, lacks clarity, because the "*allowed values*" are not defined in the claim, such that the description has to be consulted to obtain a definition thereof.

3.2 The Board disagrees, for the following reasons (see statement setting out the grounds of appeal, point 4.3.2.1).

The allegedly unclear feature of claim 6 reads "*such that harmonic components generated back to the electric network will be within allowed values*".

As correctly noted by the appellant, a person skilled in the art knows that for any electric device to be connected to the mains there is a limit to harmonic current components sent back to the mains, without having to consult the description. Standard EN61000-3-2 illustrates this common general knowledge (see in this respect also, page 1, lines 25-26 of the description as originally filed).

As a consequence of the above a skilled reader would not consider the expression "*allowed values*", taken in the context of claim 6, as unclear.

3.3 Section 4.3.1 of the reasons for the decision, related to claim 5 of the then auxiliary request II, contains a clarity objection raised against the expression "step-down topology" which is also used in claims 3 and 7 of the main request. According to the Examining Division, "*a switch alone cannot have a "step-down" topology and*

further elements connected in a particular way need to define a topology."

- 3.4 The Board does not consider that the feature containing this contested expression ("step down topology") is unclear (see statement setting out the grounds of appeal, point 4.3.2.2).

This feature relates to the control unit comprising an external inductance (L1) and a first switch (SW1) according to a "step-up" topology, to carry out power correction during the time when the voltage is lower than the nominal voltage of the motor, followed by a second switch (SW2) according to a step-down topology.

The Board concurs with the appellant that a person skilled in the art would clearly know how a switch can be configured according to both a step-up or a step down topology.

- 3.5 Based on the above, the Board concludes that the main request fulfills the requirements of Article 84 EPC and that the appealed decision has to be set aside.

4. Substantial procedural violation

- 4.1 The Examining Division decided not to admit the then auxiliary requests XV to XXVI (Reasons for the appealed decision, item 6).

This decision was not based on considerations related to these requests, because it was taken before the text thereof (the PDF's to which section 6.1 of the appealed decision refers) was submitted by the appellant.

According to section 6.2 of the appealed decision these not yet filed auxiliary requests were not admitted because none of the auxiliary requests filed and discussed beforehand "seriously addressed" the objections of lack of clarity and added subject-matter raised since the beginning of the proceedings (see the reference to the European Search Opinion, or ESOP), giving the impression that the applicant tried to shift to the Examining Division the burden of identifying EPC-compliant subject-matter.

Based on the above impression the Examining Division considered that refusing to admit these amendments in advance was within the limits of their discretion under Rules 116(2) and 137(3) EPC, and decided not to give consent to these further requests.

- 4.2 With their statement setting out the grounds of appeal (see point 6 at page 44) the appellant identifies a first procedural violation in the above refusal of the Examining Division to admit these auxiliary requests because it was decided without the necessary prima facie assessment.

The appellant then also identifies further procedural violations (statement of grounds, section 6) and requests the reimbursement of the appeal fee.

- 4.3 The Board concurs with the appellant that their right to be heard was violated (Article 113(1) EPC).

According to the established case law of the boards of appeal (CLB, IV.B.2.4.5, 4th paragraph) the power of the Examining Division to consent to amendments under Rule 137(3) EPC is a discretionary power that has to be exercised after considering all the relevant factors of

the specific case and balance in particular the applicant's interest in obtaining an adequate protection for its invention and the EPO's interest in bringing the examination to a close in an effective and speedy way.

It is however clearly not possible to do any such assessment as long as the amended set of claims whose admissibility has to be decided upon has not yet been filed (T 756/18).

In the present case, the Examining Division did not base their exercise of discretion on an assessment of the extent to which the then auxiliary requests XV to XXVI were suitable to overcome the existing objections, but decided on the basis of their negative findings in relation to the main request and auxiliary requests I to XIV.

From the above it follows that the Examining Division's refusal of consent to amendments made in advance of the amendment being submitted, not being a reasonable exercise of discretion pursuant to Rule 137(3) EPC, amounts to a substantial procedural violation.

5. Reimbursement of the appeal fee

5.1

The appellant argues that, in the present case, a reimbursement of the appeal fee would be equitable because at least one substantial procedural violation was incurred by the Examining Division (Rule 103(1) (a) EPC).

As discussed above, the appellant convinced the Board in that respect.

5.2 However, according to the established Case Law (see Case Law of the Boards of Appeal, 10th edition 2022, V.A.11.7.1) a reimbursement is not automatically equitable once a procedural violation has been established and the appeal is allowable, but there should also be a link between the procedural violation identified above and the part of the decision under appeal which has to be set aside.

As the appeal had to be filed on the basis of the main request, no such link can be identified, and there is no reason to reimburse the appeal fee on the basis of the procedural violation discussed above.

5.3 The only allegation of procedural violation of the appellant which is directly linked to the discussion of the clarity objection on the basis of which the main request was not allowed, is not convincing and does not justify the reimbursement of the appeal fee, for the following reasons.

5.3.1 This procedural violation (see point 6.2 of the statement of grounds), resides in an alleged lack of discussion, in the appealed decision, of an argument related to the clarity objection on the basis of which the main request was not allowed, which was provided in the response to the summons, at pages 4 to 6 (here the appellant refers to CLB, II.B.2.4.2, first paragraph).

According to the appellant, the Examining Division did not "address or even acknowledge" their argument that feature f1 is clear because it limits the method of control by specifying what electric sanding machine can be controlled, and excludes the method from being applied to control electric sanding machines having a

motor with a nominal voltage higher than the rectified mains voltage.

- 5.3.2 The Board is not convinced by the above argumentation. This is because the appellant did not argue that they were not heard on this particular argument, but only that this particular argument is not reflected in the written decision.

According to R 10/18 (see in particular the criteria summarised in the catchword of that decision), Article 113(1) EPC is not automatically infringed if a particular submission is not addressed in a written decision.

The above identified argument of the appellant is reflected under point 1.3 of the appealed decision. In this respect, the Examining Division explained that feature f1 would (normally) always be fulfilled for every motor connected to a voltage corresponding to its nominal voltage (reasons of decision under appeal, 1.2).

As a consequence of the above the request for reimbursement of the appeal fee is refused.

6. Remittal of the case to the Examining Division - Article 11 RPBA 2020
- 6.1 The Board is aware that, according to Article 11 RPBA 2020 a remittal for further prosecution should only be undertaken exceptionally, when special reasons apply.
- 6.2 The Board notes that not only the appealed decision is tainted with a procedural violation, but also that the

appealed decision, when dealing with the main request, is based only on objections of clarity.

Noting that the Examining Division has not addressed the issues relating to the other requirements of the EPC, in particular added subject-matter, novelty or inventive step of the claimed subject-matter, it is not possible, for the Board, to decide upon these requirements by reviewing the decision under appeal in a judicial manner as set out in Article 12(2) RPBA 2020.

According to established case law, since the main purpose of appeal proceedings is to give a losing party an opportunity to challenge a decision on its merits, remittal in accordance with Article 111(1) EPC is an option to be considered by the Boards where essential questions regarding the patentability of the claimed subject-matter have not yet been examined and decided on by the department of first instance (CLB, 10th edition 2022, V.A.9.3.2.a)).

Against this background, after considering all the relevant circumstances of the case at hand, the Board, noting that Article 11 RPBA 2020 cannot be seen as limiting the discretionary power provided by Article 111(1) EPC, considers it appropriate to remit the case to the Examining Division for further prosecution.

Order

For these reasons it is decided that:

The decision under appeal is set aside.

The case is remitted to the Examining Division for further prosecution.

The request for reimbursement of the appeal fee is refused.

The Registrar:

The Chairman:



G. Nachtigall

G. Patton

Decision electronically authenticated