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**Datasheet for the decision  
of 28 September 2020**

**Case Number:** T 1836/15 - 3.5.02

**Application Number:** 07010082.1

**Publication Number:** 1860755

**IPC:** H02K1/27

**Language of the proceedings:** EN

**Title of invention:**  
Magnet retaining arrangement

**Patent Proprietor:**  
GE Energy Power Conversion UK Limited

**Opponents:**  
Siemens Aktiengesellschaft  
Siemens Aktiengesellschaft  
Siemens Gamesa Renewable Energy A/S

**Relevant legal provisions:**

RPBA Art. 12(4)  
EPC Art. 56, 123(2)

**Keyword:**

Late-filed evidence - admitted (no)  
Inventive step - (yes)  
Amendments - added subject-matter (no)



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Case Number: T 1836/15 - 3.5.02

**D E C I S I O N**  
**of Technical Board of Appeal 3.5.02**  
**of 28 September 2020**

**Appellant:** Siemens Gamesa Renewable Energy A/S  
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**Respondent:** GE Energy Power Conversion UK Limited  
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**Representative:** Serjeants LLP  
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**Party as of right:** Siemens Aktiengesellschaft  
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**Representative:** Siemens AG  
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**Decision under appeal:** **Interlocutory decision of the Opposition  
Division of the European Patent Office posted on  
17 June 2015 concerning maintenance of the  
European Patent No. 1860755 in amended form.**

**Composition of the Board:**

**Chairman**            R. Lord  
**Members:**            G. Flyng  
                             R. Cramer

## Summary of Facts and Submissions

I. The contested decision is the interlocutory decision of the opposition division, taken during oral proceedings on 27 April 2015, that taking into consideration the amendments according to the fourth auxiliary request the European Patent EP 1 860 755 and the invention to which it relates meet the requirements of the EPC.

In the contested decision the opposition division referred to the three oppositions that had been filed as follows:

- Opposition 1: **Siemens AG**, on 13.06.2012;
- Opposition 2: **Siemens AG**, on 25.06.2012;
- Opposition 3: **Siemens Wind Power A/S**, on 28.06.2012.

In the contested decision (see reasons, section 1) the opposition division rejected the Opposition 2 as inadmissible, there being a lack of legitimate interest for a single opponent to file two oppositions. Oppositions 1 and 3 were held to be admissible.

Considering the patent proprietor's fourth auxiliary request the opposition division held that it fulfilled the requirements of Article 123(2) EPC and that the subject-matter of its claim 1 involved an inventive step, Article 56 EPC.

II. The appeal was filed in the name of the opponent **Siemens Wind Power A/S**. As from 12 March 2019 the name of the opponent **Siemens Wind Power A/S** was registered as **Siemens Gamesa Renewable Energy A/S**. They are referred to hereinafter as "**the appellant**".

The patent proprietor, **GE Energy Power Conversion UK Limited**, is respondent to the appeal and they are referred to hereinafter as "**the respondent**".

An appeal that was filed in the name of the opponent **Siemens AG** was subsequently withdrawn (letter dated 7 September 2020, see below). **Siemens AG** remain a party to the proceedings as of right because their oppositions have not been withdrawn.

- III. With their statement of grounds of appeal the appellant cited the following additional prior art document for the first time in the proceedings:

D11/D11': JP2001-119878A & its machine translation

The appellant requested that the decision under appeal be set aside (see notice of appeal) and that the patent be revoked in its entirety.

- IV. The respondent filed claim sets of a main request and first to fourth auxiliary requests and requested *inter alia* that D11 and D11' not be admitted into the appeal proceedings and that the patent be maintained on the basis of the main request which corresponded directly to the fourth auxiliary request that was upheld by the opposition division. This main request is thus equivalent to a request to dismiss the appeal.
- V. In the grounds for appeal the appellant submitted that the document D11/D11' is an admissible late-filed prior art document. They submitted that the features concerning "... a series of axially spaced screws (14) that extend radially through apertures..." were originally disclosed only in the description (see EP

1 860 755 A2, paragraph [0017]) and were only introduced into the claims with the auxiliary request 9 filed on 23 March 2015 (which was renumbered as auxiliary request 4 during the oral proceedings). In the short period of about 4 weeks between the filing of the auxiliary request and the oral proceedings, it was not possible for the appellant to execute a profound additional search in order to find prior art documents showing the additional features. Additionally, the high number of auxiliary requests filed by the patent proprietor impeded the search strategy.

The appellant argued that following decision T 1045/08, the opponent must have the possibility of responding to new requests of the patent proprietor, including the filing of new prior art documents, particularly when some of the amendments to the claims of the requests are based on features taken from the description of the patent. In this situation the concept of "late filed" must be considered relatively since the documents could not have been filed earlier because the party could not know the content of future requests of the other party.

Additionally, they argued that according to "Case Law of the Boards of Appeal of the European Patent Office" (Seventh Edition September 2013), 1.4.5a "Consideration of late-filed submissions", second paragraph, a late-filed submission of new prior art documents is admissible under the following circumstances: "...in order not to deprive the other parties of their right to verify the new evidence or to prevent the board from ensuring that the proceedings are conducted expeditiously, such facts and evidence have to be submitted once they are available and once it has become clear that they were relevant". In the present case document D11/D11' was filed within the

time limit for filing an appeal according to Article 108 EPC, i.e. as soon as it was available and it became clear that it was relevant.

Furthermore, the appellant argued that D11 showed in figures 1 to 4 a radially extending bolt screwable into the threaded bore 52 (fig. 4) and fixing a magnet holder 42, 35 to the outside rim of the rotor 33, and that this is *prima facie* strongly related to the claimed feature concerning "screws (14) that extend radially through apertures ...".

Furthermore, the appellant submitted that starting from document D3 and seeking an alternative solution for fixing the magnet carriers the skilled person would use the solution of D11/D11' and thus come to the subject-matter of claim 1 as upheld by the opposition division without involving an inventive step, Article 56 EPC.

Finally, the appellant maintained the argument, submitted in the opposition proceedings, that the feature concerning a series of axially spaced screws was only disclosed in paragraph [0017] in combination with a recess in the rim, accommodating the magnet carrier. They argued that a person skilled in the art would not provide the series of axially spaced screws without providing such a recess, as a screwed mounting arrangement without a recess would not achieve the required mechanical stability and the respective exact positioning of the magnets on the rim. Thus, the inclusion of the above feature without the rim recess introduced fresh subject-matter through unallowable intermediate generalisation, contravening Article 123(2) EPC. Also, axially spaced screws were only disclosed in combination with an outer rotor rim.

VI. The respondent submitted in the reply to the appeal that document D11/D11' was not admissible in the appeal proceedings. The respondent submitted *inter alia* (reply to the appeal, paragraph 10) that the appellant was not correct to allege that the features concerning "... a series of axially spaced screws (14) that extend radially through apertures..." were introduced for the first time in the ninth and tenth auxiliary requests filed on 23 March 2015. A corresponding feature was already present in the eighth auxiliary request filed with their "Defence on 22 January 2013" and the opposition division identified this as feature (c) in paragraph 9 of their preliminary opinion dated 8 October 2014. Hence, the appellant actually had over two years to carry out a comprehensive search for the feature concerned. There was no reason why the new inventive step attack could not already have been made before the opposition division.

As regards the objections of added subject-matter, the respondent submitted that the features concerning the series of axially spaced screws and the features concerning the recess in the rotor rim that accommodated the magnet carrier were presented as two separate technical concepts that were in no way interrelated. The first concept could be identified in claims 10 and 11 and paragraph [0012], the second in claim 9 and paragraph [0011] of the application as filed. Furthermore, it was not the case that a screw mount arrangement alone, without such recesses, would not achieve the required mechanical stability and positioning as suggested by the appellants. Also, it was clear from paragraph [0005] that the application related to inner and outer rotors and the skilled person would understand that the screw arrangement could be used to secure magnet carriers to a radially



inner rim in just the same way as disclosed for an outer rim.

VII. In a communication pursuant to Rule 100(2) EPC dated 7 May 2020 the Board set out their preliminary observations on the appeal, stating in essence the following:

- (a) That the Board was minded to exercise its discretion under Article 114(2) EPC and Article 12(4) RPBA 2007 to disregard the late-filed document D11/D11'.
- (b) That all lines of argument for lack of inventive step set out in the grounds of appeal relied on the late-filed document D11/D11' and that in view of the Board's inclination not to admit this document, it seems that all of the inventive step objections raised must necessarily fail.
- (c) That the Board tended to the view that the amendments made according to the fourth auxiliary request considered in the contested opinion did not contravene Article 123(2) EPC.

The Board concluded that it appeared none of the objections gave cause to set aside the contested decision and it seemed both appeals should be dismissed. The Board noted that oral proceedings had not been requested in that eventuality by any party.

VIII. Neither the appellant nor the respondent responded to the communication pursuant to Rule 100(2) EPC within the period of time set. **Siemens AG** withdrew their appeal, thus becoming just a party to the appeal proceedings as of right, as set out above.

## **Reasons for the Decision**

### 1. *Document D11/D11' - admissibility*

1.1 Under Article 114(2) EPC the European Patent Office may disregard facts or evidence which are not submitted in due time by the parties concerned. Document D11/D11' and the objection of lack of inventive step based thereon were not filed in the first-instance proceedings and hence not submitted in due time. That is not disputed.

1.2 Furthermore, according to Article 12(4) RPBA 2007, which continues to apply in the present case (cf. Article 25(2) RPBA 2020), the Board has the power to hold inadmissible facts, evidence or requests which could have been presented in the first instance proceedings.

1.3 As submitted by the respondent, the earliest-filed requests that included features concerning "... a series of axially spaced screws (14) that extend radially through apertures..." in claim 1 were not the ninth and tenth auxiliary requests filed on 23 March 2015, one month before the oral proceedings, but the eighth auxiliary request filed with their "Defence" (i.e. reply to the oppositions). Specifically, claim 1 of the eighth auxiliary request comprised the feature:

"each magnet carrier being ..., and being secured to the rim (4) of the rotor (2) by axially spaced screws (14) that extend radially through apertures

in the rim (4) into screw-threaded apertures in the magnet carrier (12)".

- 1.4 The reply to the oppositions was dated 22 January 2013 but not received by the opposition division until 31 January 2013. It was forwarded to the opponents, together with the auxiliary requests, on 8 March 2013, more than 2 years before the oral proceedings before the opposition division took place.
  - 1.5 The question at issue is whether under these circumstances the opponent (now appellant) could have been expected to perform an additional search for these previously unclaimed features.
  - 1.6 The Board considers that this period of more than two years gave the opponent plenty of time in which to perform a comprehensive search for these additional features. It thus follows that there is no reason why document D11/D11' could not have been presented in the first instance proceedings. For these reasons the Board exercised its discretion under Article 114(2) EPC and Article 12(4) RPBA 2007 to not admit the late-filed document D11/D11'.
2. *Inventive step, Article 56 EPC*

All lines of argument for lack of inventive step set out in the appellant's grounds of appeal rely on the late-filed document D11/D11'. In view of the Board's decision not to admit this document, all of the inventive step objections raised there must necessarily fail.

3. *Amendments, Article 123(2) EPC*

3.1 The two objections raised by the appellant were already submitted in the first-instance proceedings and were addressed in section 6.1.2 of the contested decision, with reference to section 2.1.1.2.

3.2 Having considered the parties' additional arguments on these objections the Board finds the respondent's case more persuasive. The features concerning the series of axially spaced screws and the features concerning the recess in the rotor rim that accommodates the magnet carrier are indeed presented as two separate technical concepts that are not interrelated. The first concept can be identified in claims 10 and 11 and paragraph [0012], the second in claim 9 and paragraph [0011] of the application as filed. Furthermore, the Board concurs with the respondent that a screw mount arrangement alone, without such recesses, could be capable of achieving the necessary mechanical stability and positioning. Also, it is clear from paragraph [0005] that the application relates to inner and outer rotors and the Board can see no difficulty for the skilled person in taking the screw arrangement that is disclosed in figure 2 for fixing magnet carriers to the radially outer rim of an inner rotor (i.e. a rotor inside a stator) and applying it to fix magnet carriers to the radially inner rim of an outer rotor in just the same way. It would be a straight-forward matter of inserting the screw from the outside, rather than from the inside of the rotor. For these reasons the Board concludes that the amendments made according to the fourth auxiliary request considered in the contested decision do not contravene Article 123(2) EPC.

4. *Conclusion*

None of the appellant's objections give cause to set aside the contested decision. For this reason the appeal has to be dismissed.

**Order**

**For these reasons it is decided that:**

The appeal is dismissed

The Registrar:

The Chairman:



U. Bultmann

R. Lord

Decision electronically authenticated