

**Internal distribution code:**

- (A) [ - ] Publication in OJ
- (B) [ - ] To Chairmen and Members
- (C) [ - ] To Chairmen
- (D) [ X ] No distribution

**Datasheet for the decision  
of 22 October 2020**

**Case Number:** T 2154/15 - 3.5.02

**Application Number:** 08008268.8

**Publication Number:** 1988623

**IPC:** H02M3/156

**Language of the proceedings:** EN

**Title of invention:**  
D. c. converter, speaker apparatus and d. c. converter control  
method

**Applicant:**  
YAMAHA CORPORATION

**Relevant legal provisions:**  
EPC Art. 112(1)(a), 123(2)

**Keyword:**  
Referral to the Enlarged Board of Appeal - (no)  
Amendments - extension beyond the content of the application  
as filed (yes)



**Beschwerdekammern**  
**Boards of Appeal**  
**Chambres de recours**

Boards of Appeal of the  
European Patent Office  
Richard-Reitzner-Allee 8  
85540 Haar  
GERMANY  
Tel. +49 (0)89 2399-0  
Fax +49 (0)89 2399-4465

Case Number: T 2154/15 - 3.5.02

**D E C I S I O N**  
**of Technical Board of Appeal 3.5.02**  
**of 22 October 2020**

**Appellant:** YAMAHA CORPORATION  
(Applicant) 10-1 Nakazawa-cho  
Naka-ku  
Hamamatsu-shi  
Shizuoka-ken (JP)

**Representative:** Emde, Eric  
Wagner & Geyer Partnerschaft mbB  
Patent- und Rechtsanwälte  
Gewürzmühlstrasse 5  
80538 München (DE)

**Decision under appeal:** **Decision of the Examining Division of the  
European Patent Office posted on 29 June 2015  
refusing European patent application No.  
08008268.8 pursuant to Article 97(2) EPC.**

**Composition of the Board:**

**Chairman** R. Lord  
**Members:** H. Bronold  
W. Ungler

## **Summary of Facts and Submissions**

- I. The appeal lies from the decision of the examining division to refuse European patent application No. 08 008268.8. The examining division had reached the conclusion that the subject-matter according to the main request and according to the auxiliary request pending before it lacked an inventive step over the disclosure of document D1.
- II. The appellant requested that the decision under appeal be set aside and that a patent be granted on the basis of the claims of their main request or one of the first and second auxiliary requests, all filed together with the statement setting out the grounds of appeal. The main request and the first auxiliary request correspond to the requests underlying the contested decision.
- III. In a communication under Article 15(1) RPBA 2020 the board informed the appellant of its preliminary opinion that the main request and first and second auxiliary requests contravened Article 123(2) EPC, were unclear in the sense of Article 84 EPC and further did not involve an inventive step in the sense of Article 56 EPC.
- IV. With a letter dated 27 February 2020 the appellant additionally requested that three questions be referred to the Enlarged Board of Appeal.
- V. Oral proceedings before the board were held on 22 October 2020.

VI. Independent claim 1 according to each of the requests on file comprises the following feature:

"wherein the feedback voltage ( $V_{fb}$ ) increases due to the influence of the voltage ( $V_{USB}$ ) of the power supplied".

VII. The appellant's arguments, as far as they are relevant for the appeal, can be summarised as follows:

According to Article 111(1) EPC the board of appeal may either exercise any power within the competence of the department which was responsible for the decision appealed or remit the case to that department for further prosecution. In contrast, Article 12(2) RPBA 2020 defined the nature and scope of the appeal proceedings as a review of the decision under appeal in a judicial manner. Since the present decision under appeal did not mention, discuss or find any violations of Article 123(2) or 84 EPC, it was considered ultra vires that the board raised such objections. Since the board of appeal was the final judicial instance, the appellant had no possibility of review of the new objections by a further instance. In view of this, the appellant requested that the following questions should be referred to the Enlarged Board of Appeal under Article 112(1)(a) EPC:

"1. Do the Rules of Procedure of the Boards of Appeal of the European Patent Office (RPBA) as in force from January 1, 2020 impose any limitations on the scope of examination of the case at hand for the board of appeal in the appeal proceedings?

2. If the answer to question 1 is yes, does the board of appeal conducting those proceedings have inherent

competence to raise new objections that had not been the subject of the examining division's decision?

3. If the answer to question 2 is yes, can the board of appeal conducting those proceedings directly decide on any such new objections in view of Art. 11 RPBA, or is the board of appeal obliged in such cases to remit the application to the department whose decision was appealed for a further prosecution in accordance with the second alternative of Art. 111(1) EPC?"

The appellant argued further that the restrictions imposed by the RPBA 2020 on the parties should in a corresponding manner also apply to the boards of appeal.

The amendments to the independent claims of the main request and the first and second auxiliary requests complied with Article 123(2) EPC. The respective wording was taken from originally filed paragraph [0023]. While it was true that paragraph [0023] described the technical context of the added feature in more detail, it was clear for a person skilled in the art that the added feature represented a general concept of the described invention. Consequently, the added feature could be isolated from paragraph [0023] without resulting in an intermediate generalisation.

## **Reasons for the Decision**

### 1. Admissibility of the appeal

The appeal was filed in due time and form and sufficiently substantiated. Thus, the appeal is admissible.

### 2. Request for referral - Article 112(1) (a) EPC

The request for referral of three questions to the Enlarged Board of Appeal is refused.

2.1 According to Article 112(1) (a) EPC, in order to ensure uniform application of law, or if a point of law of fundamental importance arises, the board of appeal shall refer any question to the Enlarged Board of Appeal if it considers that a decision is required for the above purposes. Thus, Article 112(1) (a) EPC provides the board with discretion to refer questions following a request from a party.

2.2 Article 111(1) EPC provides the Boards of Appeal with the discretion to either exercise any power within the competence of the department which was responsible for the decision appealed or to remit the case to that department for further prosecution. This provision defines the legal framework for the decision-making powers of the Boards. This legal framework - even as regards *ex parte* cases - was further interpreted by the

Enlarged Board of Appeal (EBA) in G 10/93, point 3 of the reasons, as follows:

*"In ex parte proceedings, therefore, the boards of appeal are restricted neither to examination of the grounds for the contested decision nor to the facts and evidence on which the decision is based, and can include new grounds in the proceedings. This applies to both the patentability requirements which the examining division did not take into consideration in the examination proceedings and those which it indicated in a communication or in a decision to refuse the application as having been met."*

The EBA stated further (cf. G 10/93, point 4 of the reasons):

*"Proceedings before the boards of appeal in ex parte cases are primarily concerned with examining the contested decision. If however there is reason to believe that a condition for patentability may not have been satisfied, the board either incorporates it into the appeal proceedings or ensures by way of referral to the examining division that it is included when examination is resumed."*

The appellant argued essentially that because the Rules of Procedure of the Boards of Appeal as in force from 1 January 2020 (RPBA 2020) impose limitations on the parties, corresponding limitations should result for the Boards of Appeal.

The board does not agree with that argument. The purpose of the RPBA 2020 is to harmonise the procedure before the boards and increase their efficiency. In particular, Articles 12 and 13 RPBA 2020 give direction

to the parties as regards the allowed scope of the appeal and amendments thereof. The board considers these Articles sufficiently clear in that they exclusively rule on the parties' procedural possibilities and not on the board's powers as defined by Article 111(1) EPC.

The appellant referred to the wording of Article 12(2) RPBA 2020 providing in particular that a judicial review is the "primary" object of the appeal proceedings. However, this formulation does not exclude that there are other important objects of the appeal proceedings, such as legal certainty for the public.

Article 12(2) RPBA 2020 continues to define that in view of this primary object, a party's appeal case shall be directed to the requests, facts, objections, arguments and evidence on which the decision under appeal was based. This defines the scope within which the party may file their appeal. However, Article 12(2) RPBA 2020 does not limit the board's powers of examination. The board further does not agree with the appellant in that the board's powers should be equally limited as the party's scope of appeal. No need for "equal" treatment of a party and the board is apparent, because the party and the board fulfil different roles in appeal proceedings.

- 2.3 Moreover, the Rules of Procedure of the Boards of Appeal constitute second degree subsidiary law and thus cannot remove powers attributed to the boards by an Article of the EPC. Article 111(1) EPC gives discretion to the boards. This discretion cannot be overruled by the RPBA, a point which is explicitly codified in the RPBA, see in particular Article 23 RPBA.



Further, Article 11 RPBA foresees that the board shall not remit a case unless special reasons present themselves for doing so. The board therefore does not agree to the appellant's suggestion in question 3 above that Article 11 RPBA can be interpreted as including an obligation for the board to remit the case at hand.

- 2.4 Consequently, the board concludes that the RPBA do not limit the powers of the boards as defined in Article 111 EPC.

As explained above, the Board is of the view that the questions raised by the appellant do not require a decision from the Enlarged Board of Appeal, since they can clearly be answered on the basis of the provisions of the EPC, the Rules of Procedure of the Boards of Appeal in force, and the case law of the Boards of Appeal. Hence, the board decided to refuse the request for referral to the Enlarged Board of Appeal.

3. Amendments - Article 123(2) EPC

The independent claims according to all pending requests contravene Article 123(2) EPC.

- 3.1 In the independent claims according to all requests, the expression "wherein the feedback voltage ( $V_{fb}$ ) increases due to the influence of the voltage ( $V_{USB}$ ) of the power supplied" had been introduced. This expression is originally disclosed only in the context of the embodiment which describes the topology of the voltage correction unit which gives rise to that effect. However, the remaining features of the voltage correction unit were omitted in the independent claims of all requests.

The appellant argued in this context that the amendment was disclosed in originally filed paragraph [0023]. The board is however not convinced by the appellant's arguments. The cited paragraph [0023] starts with a sentence defining the resistance values for two transistors. Further, the first half of the sentence from which the discussed amendment was taken, reads "Since the resistance values are set in this manner, when the transistor Q1 becomes the on state....". Thus the formulation at the beginning of the sentence from which the amendment was taken represents the prerequisite for the desired effect that "the feedback voltage ( $V_{fb}$ ) increases due to the influence of the voltage ( $V_{USB}$ ) of the power supplied". The board concludes that the omission of the technical features representing the prerequisite for a technical effect represents an intermediate generalisation of the original disclosure.

Consequently, the independent claims according to all requests contravene Article 123(2) EPC.

#### 4. Conclusion

Since none of the appellant's requests is allowable, the board cannot accede to any of the appellant's requests for grant of a patent.

## Order

### For these reasons it is decided that:

1. The request for referral to the Enlarged Board of Appeal is refused.
2. The appeal is dismissed.

The Registrar:

The Chairman:



U. Bultmann

R. Lord

Decision electronically authenticated