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**Datasheet for the decision
of 20 January 2022**

Case Number: T 0794/19 - 3.2.03

Application Number: 06850040.4

Publication Number: 2102568

IPC: F24F11/30, F24F110/10,
F24F110/70, F24F11/00

Language of the proceedings: EN

Title of invention:

AIR-CONDITIONING ALGORITHM FOR WATER TERMINAL FREE COOLING

Patent Proprietor:

Carrier Corporation

Opponent:

Siemens Schweiz AG

Headword:

Relevant legal provisions:

EPC Art. 123(2), 123(3), 69(1), 100(c)

Keyword:

Amendments - added subject-matter (yes) - inescapable trap
(yes)

Decisions cited:

G 0001/93, T 0177/08

Catchword:



Beschwerdekammern

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Chambres de recours

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Case Number: T 0794/19 - 3.2.03

D E C I S I O N
of Technical Board of Appeal 3.2.03
of 20 January 2022

Appellant: Carrier Corporation
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Decision under appeal: **Interlocutory decision of the Opposition
Division of the European Patent Office posted on
7 January 2019 concerning maintenance of the
European Patent No. 2102568 in amended form.**

Composition of the Board:

Chairman C. Herberhold
Members: B. Goers
E. Kossonakou

Summary of Facts and Submissions

- I. European patent No. 2 102 568 (hereinafter: "the patent") relates to a method for creating energy savings in a local zone water terminal of an air-conditioning system that obtains a signal from a building management system enabling a free cooling mode of operation.
- II. With its decision posted on 7 January 2019, the opposition division decided that the patent as amended on the basis of the second auxiliary request complied with the requirements of the EPC. Both the patent proprietor and the opponent appealed against this decision. Since both parties appealed, they will be referred to as "patent proprietor" and "opponent" in this decision.
- III. With the parties' consent, oral proceedings before the Board were held on 20 January 2022 by videoconference using the Zoom platform.
- IV. At the end of the oral proceedings, the patent proprietor confirmed the following requests:
- that the decision be set aside
 - that the patent be maintained:
 - as granted (main request)
 - or, alternatively, on the basis of one of the first or second auxiliary requests considered in the contested decision and filed again with the statement setting out the grounds of appeal
 - or as a further alternative on the basis of one of the fourth to twelfth auxiliary requests filed by letter dated 13 July 2021

The opponent requested that the decision under appeal be set aside and that the patent be revoked.

V. In the following, the application documents on which the patent is based will be referred to as A1:

A1: WO 2008/082398 A1

VI. Independent claim 1 of the main request (patent as granted) reads as follows (feature numbering added in "[]"; amendments with respect to claim 1 as filed highlighted in bold).

"[1] A method to create energy savings
[2] in a local zone water terminal (10) of an air-conditioning system (5)
[3] of the type having **an air handling unit** (60) and a building management system (54)
comprising: obtaining
[4] a signal from said building management system
[5] to enable a free cooling mode of operation,
[6] **where outside air is of a temperature to satisfy the air-conditioning demand of a zone with no thermal pre-treatment of the outside air by said air handling unit;**
[7] responsively opening a fresh air damper (21) of said local zone water terminal to a fully open position,
[8] **said local zone water terminal including a coil (32) for conditioning supply air to a local zone (14) and**
[9] **a cooling fan (20) for moving air over said coil; and**
[10] **controlling opening of said fresh air damper and**
[11] **a speed of said cooling fan in response to a local temperature error point signal, (210),**

[12] **which is the resultant value of the combination of a zone temperature (206) and a zone temperature setpoint (208), during free cooling mode.**"

VII. Claim 1 of the first auxiliary request has the following amendments compared with features [10] to [12] of claim 1 of the main request (feature numbering added in "[]"; amendments with respect to claim 1 of the main request highlighted in bold and strike-through).

"... [10'] **during the free cooling mode, with**
~~controlling opening of said fresh air damper in the~~
fully open position, and
[11'] **controlling** a speed of said cooling fan in response to a local temperature error point signal, (210),
[12'] *which is the resultant value of the combination of a zone temperature (206) and a zone temperature setpoint (208),*~~during free cooling mode.~~"

VIII. Claim 1 of the second auxiliary request (patent as maintained as per the decision under appeal) reads as follows (feature numbering added in "[]"; amendments with respect to claim 1 of the main request highlighted in bold and strike-through).

"[101] *A method to create energy savings*
[102] *in a local zone water terminal (10)* **for a local zone (14)** *of an air-conditioning system (5)*
[103] *of the type having an air handling unit (60), a* **building fresh air duct network (113)**, *and a building management system (54), the method comprising,*
[103a] **using a water terminal controller (51) with a water terminal control algorithm (50):**

[104] obtaining a **free cooling enable** signal (200) from said building management system

[105] to enable a free cooling mode of operation **for the local zone water terminal (10)**,

[106] where outside air is of a temperature to satisfy the air-conditioning demand of ~~a~~ **the local zone (14)** with no thermal pre-treatment of the outside air by said air handling unit (60);

[107] responsively opening a fresh air damper (21) of said local zone water terminal to a fully open position,

[108] said local zone water terminal including a coil (32) for conditioning supply air to ~~a~~ **the local zone (14)** and

[109] a cooling fan (20) for moving air over said coil (32), and

[109b] **wherein during the free cooling mode, with the fresh air damper (21) fully open, the outside air passes directly through the air handling unit (60), through the building fresh air duct network (113) and through the fresh air damper (21);**

[110] **and during the free cooling mode, using the water terminal control algorithm (50) to control said fresh air damper to be fully open**

[111] ~~and to control controlling opening of said fresh air damper and a speed of said cooling fan (20) in response to~~ **via a fresh air damper and cooling fan signal (217), wherein the fresh air damper and cooling fan signal (217) is obtained by the water terminal control algorithm (50) by logically processing the free cooling enable signal (200), an occupancy status signal (202) of the local zone, a user programmable temperature error threshold signal (204) and a local temperature error point signal (210)**

[112] which is the resultant value of ~~the~~ **a** combination of a zone temperature (206) and a zone temperature setpoint (208), ~~during free cooling mode.~~"

IX. Claim 1 of any of the fourth to sixth, eighth and tenth auxiliary requests includes, *inter alia*, the following amendments with respect to features [109b], [110], [111] and [112] of claim 1 of auxiliary request 2 (marked in bold and strike-through).

"... [109b'] wherein during the free cooling mode, with the fresh air damper (21) fully open, the outside air passes directly through the air handling unit (60), through the building fresh air duct network (113) and through the fresh air damper (21);
[110'] and during the free cooling mode, using the water terminal control algorithm (50) to control **opening of** said fresh air damper ~~to be fully open~~
[111'] and ~~to control~~ a speed of said cooling fan (20) via a fresh air damper and cooling fan signal (217), **which is conditioned through a first PI block (218) to generate an** ~~wherein the fresh air damper~~ **percent opening signal (220) and separately conditioned through a second PI block (222) to generate** a cooling fan **percent speed** signal (224), wherein the fresh air damper and cooling fan signal (217) is obtained by the water terminal control algorithm (50) by logically processing the free cooling enable signal (200), an occupancy status signal (202) of the local zone, a user programmable temperature error threshold signal (204) and a local temperature error point signal (210),
[112'] which is the resultant value of a combination of a zone temperature (206) and a zone temperature setpoint (208), **wherein when the free cooling mode is enabled the water terminal control algorithm (50) controls said fresh air damper (21) to be fully open"**

X. Claim 1 of any of the seventh, ninth, eleventh and twelfth auxiliary requests includes the following further amendments with respect to features [110], [111] and [112] of claim 1 of auxiliary request 2 (marked in bold and strike-through).

"[109b'] wherein during the free cooling mode, with the fresh air damper (21) fully open, the outside air passes directly through the air handling unit (60), through the building fresh air duct network (113) and through the fresh air damper (21);

[110'] ~~and~~ **obtaining a zone temperature (206);**
obtaining a zone temperature setpoint (208);
comparing said zone temperature with said zone temperature setpoint to obtain a local temperature error point signal (210);

during the free cooling mode, using the water terminal control algorithm (50) to control **opening of** said fresh air damper ~~to be fully open~~

[111'] and ~~to control~~ a speed of said cooling fan (20) via a fresh air damper and cooling fan signal (217), **which is conditioned through a first PI block (218) to generate an** ~~wherein the fresh air damper~~ **percent opening signal (220) and separately conditioned through a second PI block (222) to generate** a cooling fan **percent speed** signal (224), wherein the fresh air damper and cooling fan signal (217) is obtained by the water terminal control algorithm (50) by logically processing the free cooling enable signal (200), an occupancy status signal (202) of the local zone, a user programmable temperature error threshold signal (204) and the local temperature error point signal (210), **and responsively operating a local zone proportional coolant fluid flow control valve (34) of the local zone water terminal in a proportional-integral control loop**

depending on said local temperature error point signal (210),

~~[112'] which is the resultant value of a combination of a zone temperature (206) and a zone temperature setpoint (208),~~

wherein when the free cooling mode is enabled the water terminal control algorithm (50) controls said fresh air damper (21) to be fully open."

XI. The patent proprietor's arguments relevant to the present decision may be summarised as follows:

(a) Main request - Article 100(c) EPC

The ground under Article 100(c) EPC did not prejudice the maintenance of the patent as granted. Interpreting claim 1 of the main request to encompass any state or control action of the fresh air damper in the free cooling mode other than "fully open" was incorrect and in obvious contradiction to what a skilled person derives from the patent as a whole. The term "in response to" still applied to the fresh air damper receiving the local temperature error point signal if, according to claim 1 and the embodiment described in Figure 2 and paragraph [0033] of A1, an additional requirement controlled the damper to the fully open position during the free cooling mode. Under this interpretation, no added subject-matter was created. Furthermore, omitting the water terminal controller and control algorithm did not lead to any unallowable intermediate generalisation since neither was essential to the invention defined in claim 1 or inextricably linked to the control of the damper and the cooling fan. The same applied to the omission of the PI control features.

(b) First and second auxiliary request - admittance

Auxiliary requests 1 and 2 corresponded to those considered in the decision under appeal and were therefore to be considered in the appeal procedure.

(c) First auxiliary request - Article 123(3) EPC

The amendments made to claim 1 of the first auxiliary request did not extend the protection conferred by the patent as granted. The amendment from "in response to" to "fully open" was a restriction in scope and therefore not in violation of Article 123(3) EPC. At most, the amendment addressed a clarity issue in the main request. Under Article 69(1), second sentence, EPC, the description is to be considered in determining the extent of protection. Doing so revealed that the intended meaning of the control of the damper opening was the same according to the wording of the main request and of the first auxiliary request (and also the further auxiliary requests). Thus, the patent proprietor's requests were directed to a free cooling mode in which the damper was fully open at all times.

(d) Second auxiliary request - Article 123(3) EPC

Owing to the amendments made to the second auxiliary request, the wording of the claim reflected the particular control algorithms disclosed in paragraph [0033] and Figure 2 even more closely. Claim 1 of auxiliary request 2 had been restricted versus the patent as granted since claim 1 as granted disclosed a generic control but this was now defined in the specific way in accordance with the embodiment.

(e) Fourth to twelfth auxiliary requests - admittance

The fourth to twelfth auxiliary requests were to be admitted into the proceedings since they were a reaction to a substantial change of the case due to the Board's preliminary opinion. In addition, they resolved all outstanding issues without giving rise to new objections.

XII. The opponent's arguments relevant to the present decision may be summarised as follows:

(a) Main request - Article 100(c) EPC

The ground for opposition under Article 100(c) EPC prejudiced the maintenance of the patent as granted. The feature of controlling the damper opening in response to the local temperature error point signal during the free cooling mode was not originally disclosed. According to the application as filed, in particular paragraph [0033], the damper was fully open during the enablement of the free cooling mode, and so, contrary to what was defined in features [10] and [11] of claim 1 as granted, it was not controlled in response to that temperature signal. Furthermore, referring solely to the temperature error point signal omitted the further signal inputs into the water terminal controller 51 as shown in Figure 2, leading to an unallowable intermediate generalisation.

(b) First and second auxiliary requests - admittance

The first auxiliary request had not been defended at the oral proceedings before the opposition division and should thus not be admitted into the appeal procedure.

The patent proprietor's request for setting aside the decision was inconsistent with its submission of the second auxiliary request, which therefore should not be admitted either.

(c) First auxiliary request - Article 123(3) EPC

The amendments to claim 1 of the first auxiliary request extended the protection conferred by the patent as granted and were thus in violation of the requirements of Article 123(3) EPC. Since the claim specifies that the damper is fully open over the whole period of the free cooling mode, the control of the damper opening in response to the temperature error point signal was no longer the subject of the claim. This was thus not a restriction, but a claim directed to a different control scheme.

(d) Second auxiliary request - Article 123(3) EPC

The amendments to claim 1 of the second auxiliary request also extended violated the requirements of Article 123(3) EPC for the same reasons as for auxiliary request 1.

(e) Fourth to twelfth auxiliary requests - admittance

The amendments made to claim 1 of auxiliary requests 4 to 12 also extended the protection compared with the patent as granted, violating at least the requirements of Article 123(3) EPC for the same reasons as for auxiliary request 1. Since these requests were only filed in response to the summons to oral proceedings, they should not be admitted into the proceedings under Article 13(2) RPBA 2020.

Reasons for the Decision

Understanding of the feature "controlling ... in response to"

1. There was no common ground between the parties as to how the feature "the opening of said fresh air damper ... is controlled in response to a local temperature error point signal" (hereinafter: "LTEP signal") was to be construed. How this feature is understood is crucial for the present decision.
 - 1.1 The patent proprietor interpreted features [10] to [12] of the main request not only as a direct control loop. In its view the wording described the control of the damper opening in the most generic way. As per this generic interpretation, the feature was complied with as long as the LTEP signal was input into - and the damper opening control signal was output from - a common water terminal controller (51) with a water terminal control algorithm (50). This was irrespective of whether the signals were actually in a direct cause-and-effect relationship. Therefore, even when the free cooling enable signal disabled the air damper PI control cycle, the damper opening control would still be understood as acting in response to the LTEP signal.
 - 1.2 This interpretation of claim 1 is not persuasive and is in contradiction with the skilled person's technical understanding of the claim. The term "in response to" defines a direct cause-and-effect link between two operation parameters. In claim 1, the parameters are the LTEP signal, as the variable input signal, and the opening of the damper, as the responding output signal. Controlling the output in response to the input inherently follows an underlying control strategy (a feedback control according to a setpoint such as a

PI block, value tables, switching operations, etc.), which is not further defined in claim 1. The objective of this "response" is to control the zone temperature with respect to the zone temperature setpoint by means of the damper opening. The term "in response to" thus requires that the input influences the output. A control action in which an input - though possibly hard-wired to the control unit - is systematically blocked from having any influence on the output does not qualify as "in response to" that input parameter.

1.3 In the specific context of features [10] and [11] of claim 1, therefore, a control action in which the fresh air damper is (when in the free cooling mode) always fully open, without the local temperature error point signal having any influence on it, does not qualify as being "in response to" the LTEP signal.

1.4 This understanding of the term "response" is consistent with the use of the term throughout the application as filed. A1 does not disclose the exact wording "in response to". However, the claims as originally filed define a number of cause-and-effect chains using the term "responsively":

- Claim 1: opening a fresh air damper in response to a free cooling enable signal from the building management system
- Claim 2: disabling the heating mode in response to a signal from the building management system
- Claim 4: controlling the coolant fluid flow valve in response to a local temperature error
- Claims 5, 11 and 12: minimising or controlling the speed of the cooling fan in response to an occupancy status signal of the local zone or a local air temperature threshold comparison signal

- Claim 15: changing from cooling demand mode to cooling satisfied mode in response to a "zone temperature is being reduced" signal

1.5 Were these claims interpreted such that the actions defined above as being "in response" were fully decoupled from the input, this would deprive these claims of the technical meaning they convey. The skilled person would thus not understand the terms "responsively" or "in response to" in the generic way argued by the patent proprietor.

Main request - Article 100(c) EPC

2. The decision under appeal is correct in that the ground for opposition under Article 100(c) EPC prejudices the maintenance of the patent as granted. Claim 1 of the main request includes subject-matter extending beyond the application as filed.

2.1 According to the application as filed, the fresh air damper is always in the fully open position in the free cooling mode, i.e. at all times during this mode. This was not disputed by the patent proprietor and follows from paragraph [0033] of A1, according to which the time-variable fresh air damper opening percentage signal generated by the PI block controller is replaced by setting the damper to a fully open state when the free cooling mode is enabled. This implies that in this mode the PI controller is deactivated or its output is ignored. Thus, in the free cooling mode, the damper opening is not in response to the time-variable LTEP signal (see also point 1).

2.2 Contrary to the original disclosure discussed above, the operation of the fresh air damper in the free cooling mode as defined in claim 1 (see feature [7]) is not limited to the fully open state throughout the time period of this mode. Rather, in feature [10] claim 1 encompasses a method step in which, during the free cooling mode, the opening of the damper is controlled in response to the LTEP signal, which provides the time-variable difference between the local area temperature and a setpoint of this temperature. Feature [12] unambiguously specifies that the control actions defined in features [10] and [11] are part of the free cooling mode.

2.3 Furthermore, contrary to the proprietor's interpretation, feature groups [7] to [9] and [10] to [12] do not refer to two different options for the operation mode. They are linked by the expression "and" and are thus both compulsory steps of the free cooling mode as defined in claim 1. Consequently, the free cooling mode according to claim 1 of the main request can only be construed as encompassing two different (possibly consecutive; see below) sub-modes with respect to the opening of the fresh air damper. The two sub-modes are:

- fully opening the damper in direct response to the signal from the building management system but not in response to the LTEP signal (hereinafter "control action A")
- controlling the opening in response to the LTEP signal (hereinafter: "control action B")

Control action B can include states in which the damper is temporarily fully open if the underlying control strategy generates a corresponding response.

Nevertheless, this does not fall under control action A, which fully opens the damper without taking the LTEP signal into account in any way.

2.4 Control action B is not in obvious contradiction with control action A either, contrary to the patent proprietor's argument. Feature [7] solely requires that the fresh air damper is opened to a fully open position in response to the signal from the building management system which "enables" the free cooling mode (feature [5] of claim 1), i.e. at least at the point in time when the free cooling mode is triggered by the signal. This wording does not specify that the open position of the damper is maintained throughout the free cooling mode. The step of initially completely opening the damper according to control action A is a feasible starting point for the subsequent control of the opening in accordance with control action B (e.g. the starting point with the lowest air flow resistance). Since the wording of the claim is clear as such, there is no need to further rely on the description when construing the claimed subject-matter.

2.5 The only disclosure of control action B, i.e. of the control of the damper opening in connection with the LTEP signal 210 is found in paragraph [0033] of A1, which states that the "water terminal control algorithm takes the aforementioned signals" (which include is the LTEP signal) and "logically processes them to yield" inter alia a damper percentage signal. However, as explained above, this control action is disclosed here as not being carried out during the free cooling mode. For this reason alone, the subject-matter of claim 1, which defines control action B as being active in the free cooling mode, is unallowably extended.

- 2.6 Apart from this, the control of the damper according to paragraph [0033] is only disclosed as part of a logical processing which uses further signals fed to the water terminal controller "to yield a fresh air damper signal". These signals include the occupancy status and the temperature error threshold. However, none of these further signals is present in features [10] to [12] of claim 1, and this omission constitutes an unallowable intermediate generalisation. Thus, there is no unambiguous disclosure of a cause-and-effect link ("in response to") only for the parameters LTEP signal and damper opening percentage.
- 2.7 To conclude, adding features [10] and [11] extends the subject-matter of claim 1 beyond the subject-matter of the application as filed.

First and second auxiliary requests - admittance

3. The first and second auxiliary requests correspond to the first and second auxiliary requests which were the subject of the decision under appeal. Furthermore, they were submitted with the statement of grounds of appeal. They are therefore part of the proceedings and the Board has no discretion to hold them inadmissible under Article 12(4) RPBA 2007.
- 3.1 The question of the extent to which the patent proprietor defended auxiliary request 1 in oral proceedings is irrelevant since this request was not withdrawn.
- 3.2 The patent proprietor's request to maintain the patent on the basis of the second auxiliary request corresponds to the patent as maintained in amended

form. This is equivalent to a request to dismiss the opponent's appeal and is a perfectly valid reaction to that appeal. It is not to be considered in the framework of the patentee's own appeal, where, if the patent proprietor were the sole appellant, it would serve no purpose, since the Board would have no jurisdiction in the matter. It follows that there is no inconsistency, contrary to the opponent's submission.

First auxiliary request - Article 123(3) EPC

4. The scope of protection is unallowably extended by the subject-matter of claim 1 of auxiliary request 1, in violation of the requirements of Article 123(3) EPC.
- 4.1 In the first auxiliary request, the control action B of controlling the damper in response to the LTEP signal is replaced with the statement "during the free cooling mode, with said fresh air damper in the fully open position", i.e. a "control action C" in which the damper is not controlled in response to the LTEP signal throughout the free cooling mode. The patent proprietor's argument that this constituted a restriction of scope versus the subject-matter of claim 1 of the main request is not convincing.

Control action C cannot be considered a special case of of the control "in response to the LTEP signal" (control action B) in which the LTEP signal is no longer used as an input. The fact that all the control signals are input and processed in the water terminal controller by means of an algorithm, as shown in Figure 2 of A1, is of no relevance since in the free cooling mode (according to paragraph [0033] of the application as filed) the LTEP signal 210 and the fresh

air damper signal 217 do not interact in this algorithm. Therefore, contrary to the conclusion in the decision under appeal, the control of the damper opening is not disclosed as always being at least dependent on (i.e. "in response to") the LTEP signal. Specifically, it is not disclosed as being dependent on the LTEP signal during the free cooling mode.

- 4.2 Thus, control action C is not a sub-mode with respect to control action B but a different operation mode. While deleting control action B is an extension of protection, introducing control action C is shifting the protection to different subject-matter. Thus, the amendment made to feature [10'] results in an *aliud* with respect to feature [10] of the main request and violates the requirements of Article 123(3) EPC (see Case Law of the Boards of Appeal, 9th edition, 2019, II.E.2.4.13).
- 4.3 Under these circumstances it is irrelevant whether control action C has a basis in the application as filed and complies with the requirements of Article 123(2) EPC. Deleting the added matter "control action B" inevitably results in an infringement of Article 123(3) EPC. On the other hand, as control action B was not originally disclosed for the free cooling mode, it cannot be defined in the claim without violating the requirements of Article 123(2) EPC. This situation is commonly described as an "inescapable trap" (see G 1/93, Reasons 13).
- 4.4 The patent proprietor argued that under Article 69(1) second sentence, EPC the description had to be considered when determining the extent of protection and that in doing so the skilled person would conclude that the now omitted feature "controlling the damper

opening in response to the LTEP signal" (control action B) was to be interpreted differently. In the process, the skilled person would have realised that the wording of the patent as granted was unclear and needed to be understood in consideration of the description.

- 4.5 This argument is not persuasive. Under Article 69(1) EPC, the extent of the protection conferred by a European patent shall be determined by the claims. It is true that the second sentence of Article 69(1) EPC states that the description and drawings are to be used to interpret the claims. However, as set out above (see point 1.), the term "in response to" as used in claim 1, has an unambiguous and generally accepted meaning for the skilled person. This understanding cannot be superseded by a different definition found in the description. If the intention was to give a new meaning to this clear wording, which was in no need of any interpretation, then a respective definition to that effect should have been included in the claim (see Case Law of the Boards of Appeal, 9th edition 2019, II.E.2.3.1 and also T 177/08, Reasons 3.3).

Second auxiliary request - Article 123(3) EPC

5. Since claim 1 no longer includes control action B but instead control actions A and C (see features [109b], [110] and [111]), this results in the same extension of protection as for the first auxiliary request (see point 4.). This cannot be resolved by the newly added details of the water terminal control algorithm. Control action B is still omitted compared with the patent as granted.

Therefore, also claim 1 of the second auxiliary request is not in line with the requirements of Article 123(3) EPC either.

Fourth to twelfth auxiliary requests - admittance

6. By letter dated 13 July 2021, the patent proprietor submitted new fourth to twelfth auxiliary requests to replace the fourth to ninth auxiliary requests as submitted with the statement of grounds of appeal.
- 6.1 Since the summons to oral proceedings was notified after the date of entry into force of the RPBA 2020, Article 13(2) RPBA 2020 applies (Articles 25(1) and (3) RPBA 2020).
- 6.2 The new fourth to twelfth auxiliary requests are an amendment to the patent proprietor's appeal case as per Article 13(2) RPBA 2020 and the admittance of these requests is at the Board's discretion. At the third level of the convergent approach (see document CA/3/19, page 43, explanatory remarks on Article 13(2) RPBA 2020) in exercising its discretion the Board may also rely on criteria applicable at the second level, which includes the question of whether the amendments *prima facie* overcome the issues raised (see Article 13(1) RPBA 2020).
- 6.3 For the fourth to twelfth auxiliary requests this is not the case. In claim 1 of the fourth to twelfth auxiliary requests, control action B is - as in the second auxiliary request - no longer present (see features [109b', 109b'''] to [112', 112''']).

- 6.4 Features [111', 111''] now recite the PI damper opening control loop as being part of the water terminal control algorithm as disclosed in paragraph [0033] of A1. However, all the details given in feature groups [111'] and [111''] cannot change the fact that feature groups [109b',109b''] imply that the damper is and remains fully open during the free cooling mode and that there is thus no control **in response to** the LTEP signal (i.e. control action B is still omitted). As such, even though different wording with more details of the control algorithm has been relied upon, the protection is still extended with respect to claim 1 as granted due to the omission of control action B and the shift to different subject-matter.
- 6.5 Due to this immediately apparent extension of protection in claim 1 of each of the fourth to twelfth auxiliary requests, none of these requests is taken into account in the appeal proceedings (Article 13(2) RPBA).
7. To conclude, the patent proprietor's claim requests do not comply with the requirements of either Article 123(2) EPC or Article 123(3) EPC, or are not admitted due to their *prima facie* unallowability. Therefore, the opponent's appeal is allowable and the patent proprietor's appeal is not.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The patent is revoked.

The Registrar:

The Chairman:



C. Spira

C. Herberhold

Decision electronically authenticated