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**Datasheet for the decision
of 6 November 2023**

Case Number: T 2073/19 - 3.5.02

Application Number: 09748912.4

Publication Number: 2342822

IPC: H03K3/356, H03K19/00

Language of the proceedings: EN

Title of invention:

Systems and Methods Using Improved Clock Gating Cells

Applicant:

QUALCOMM Incorporated

Relevant legal provisions:

RPBA Art. 12(2), 12(4)

RPBA 2020 Art. 12(3)

Keyword:

Statement of grounds of appeal - party's complete case (no)
Late-filed request - request could have been filed in first
instance proceedings (yes)



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Case Number: T 2073/19 - 3.5.02

D E C I S I O N
of Technical Board of Appeal 3.5.02
of 6 November 2023

Appellant: QUALCOMM Incorporated
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Decision under appeal: **Decision of the Examining Division of the
European Patent Office posted on 29 January 2019
refusing European patent application No.
09748912.4 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chairman G. Flyng
Members: F. Giesen
A. Bacchin

Summary of Facts and Submissions

- I. The present appeal by the applicant (appellant) lies from the decision of the examining division refusing European patent application No. 09 748 912.4 pursuant to Article 97(2) EPC.

The reasons for the decision were that the requests then on file did not meet the requirements of Articles 123(2) EPC and 84 EPC.

- II. In the statement of grounds of appeal the appellant requested that the decision under appeal be set aside and a patent be granted on the basis of the following documents:

Description: as published

Drawings: as published

Claims: claims 1 to 7 as filed with the statement of grounds of appeal,

or as an auxiliary measure,

on the basis of claims 1 to 7 of the first or second auxiliary request filed with the statement of grounds of appeal.

- III. With a summons dated 21 April 2023, the board summoned the appellant for oral proceedings. In a communication pursuant to Article 15(1) RPBA 2020 accompanying the summons the board informed the appellant of its intention not to admit the main request and first and second auxiliary requests.

- IV. In a letter dated 1 August 2023, the appellant informed the board that they would not attend the oral

proceedings. They withdrew their request for oral proceedings and requested a decision according to the state of the file.

V. Consequently, the board cancelled the oral proceedings.

Reasons for the Decision

1. *Admissibility of the Appeal*

The appeal complies with the requirements of Articles 106 to 108 EPC as well as Rule 99 EPC. It is therefore admissible.

2. *Admittance of the Requests*

2.1 Article 12(4) RPBA 2007, which is applicable to the present case by virtue of Article 25(2) RPBA 2020, confers on the board the discretionary power to hold inadmissible facts, evidence and requests which could (and should) have been presented, or were not admitted, in the first instance proceedings.

2.2 The main request could (and should) have been filed in the first instance proceedings.

The appellant submitted a main, first and second auxiliary request on 16 November 2018 in preparation for the oral proceedings before the examining division.

The examining division informed the appellant in a communication dated 18 December 2018 of their

preliminary opinion according to which the independent claims of all requests did not meet the requirements of Article 123(2) EPC or Article 84 EPC. The examining division indicated (see section 4.1) that "when overcoming the A.123(2) and A.84 objections ... the additional features of the safeguarding circuit might form a promising basis of a new set of claims."

By letter dated 14 January 2019, the appellant (then applicant) informed the examining division that they would not attend the oral proceedings scheduled to take place on 16 January 2019. The oral proceedings took place as scheduled and at the end the application was refused.

With the statement of grounds, the appellant filed a new main, first and second auxiliary request in the appeal proceedings (see point II. above). In each of these requests the amendments *inter alia* define additional features of the safeguarding circuit.

- 2.3 The grounds for refusal in the decision under appeal are *verbatim* identical to the reasons contained in the preliminary opinion of the examining division. The statement of grounds of appeal does not contain any explanation, and the board cannot discern any reasons, as to why the amended requests could not have been submitted in the first instance proceedings, such as in response to the preliminary opinion of the examining division, which explicitly pointed to additional features of the safeguarding circuit as being a promising basis of a new set of claims, or during the oral proceedings before the examining division. The applicant instead even decided not to attend the oral proceedings.

2.4 Furthermore, despite filing new claim requests on appeal, the statement of grounds does not state the appellant's complete appeal case.

Article 12(4) RPBA 2007 confers on the board the discretionary power to hold inadmissible facts, evidence and requests which do not meet the requirements of Article 12(2) RPBA 2007 (in essence corresponding to Article 12(3) RPBA 2020), and according to which the statement of grounds of appeal shall contain a party's complete case. It shall set out clearly and concisely the reasons why it is requested that the decision under appeal be reversed, amended or upheld, and should specify expressly all the facts, arguments and evidence relied on.

The appellant's statement of grounds of appeal lists the grounds for refusal. But as for setting out the reasons for reversing or amending the decision under appeal, in the context of the objection of lack of clarity under Article 84 EPC, the appellant merely cites the amended claim wording. Thereby the appellant leaves it up to the board to investigate why the finding of lack of clarity in the decision under appeal should not be upheld. This is not the role of the board and is clearly in contravention of the requirements of substantiation of Article 12(2) RPBA 2007.

While the board appreciates conciseness, the mere reference to the amendments amounts to incompleteness in the present case since it is not immediately apparent that or how the amendments overcome the outstanding objections of lack of clarity.

In particular, the examining division objected with respect to the then pending main request that it was

not clear from the claim features how the technical effect of gating could be achieved (cf. point 16 of the decision under appeal). The amended claim of the pending main request now simply states that the enable logic enables the clock input (Clk_in) to be propagated through the clock gating cell. This appears to be an entirely functional feature that still does not define in a self-evident manner how the technical effect of gating is achieved, as the examining division required.

The examining division had also objected that it was not apparent from the claim wording how the functional blocks "enable logic", "latch circuit with first circuit", "output logic" and "safeguarding circuit" worked together (cf. point 16.1 of the decision under appeal). The amended claim contains a somewhat more detailed description of how the safeguarding circuit works and how it is connected with the first circuit, but this still leaves the interaction of the enable logic, the first circuit and the output circuit uncommented and unamended. Also this amendment can therefore not be considered to overcome the objections raised by the examining division in a self-explanatory manner.

The board therefore exercises the discretion pursuant to Article 12(4) RPBA 2007 so as not to admit the main request, since it could have been filed in the first instance proceedings and, especially, since it does not meet the requirements of Article 12(2) RPBA 2007.

- 2.5 The first auxiliary request further specifies that the safeguarding circuitry is placed between the enable logic and the first circuit. The only explanation given by the appellant for the amendment is that it is intended to improve clarity.

In the board's view this amendment still does not address the lack of clarity objections by the examining division of points 16 and 16.1 of the decision under appeal in a self-explanatory manner, since the interaction of the enable logic, output logic, and the first circuit is still not defined in more detail in the claim, which the decision under appeal reasoned would have been necessary. According to the appellant themselves, the scope of the claim is not intended to be changed by the amendments. Moreover, there are still no explanations by the appellant as to why the claim definition should be sufficient and the corresponding objection by the examining division should be overturned.

The board therefore exercises the discretion pursuant to Article 12(4) RPBA 2007 so as not to admit the first auxiliary request, since it could have been filed in the first instance proceedings, and especially, because it does not meet the requirements of Article 12(2) RPBA 2007.

- 2.6 The second auxiliary request is again merely a rewording of the claims according to the higher ranking request, which still does not specify in any more detail the interaction between the enable logic, the output logic and the latch with the first circuit.

The corresponding explanation of the appellant amounts to the mere statement of the intention to improve clarity and to overcome problems of added subject-matter. For the board it is not self-evident how this is to be achieved by the amendments of the second auxiliary request.

Therefore, the board does not admit the second auxiliary request pursuant to Article 12(4) RPBA 2007, since it could have been filed in the first instance proceedings and because it does not to meet the substantiation requirements of Article 12(2) RPBA 2007.

3. Since none of the requests on file are admitted, there is no allowable request on file, on which a patent could be granted.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:



A. Pinna

G. Flyng

Decision electronically authenticated