

Internal distribution code:

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

**Datasheet for the decision
of 27 November 2023**

Case Number: T 2872/19 - 3.5.02

Application Number: 12712840.3

Publication Number: 2691967

IPC: H01H9/00, H01F29/04, H02K11/21

Language of the proceedings: EN

Title of invention:
Tap Changer with an Improved Drive System

Patent Proprietor:
Hitachi Energy Ltd

Opponent:
Maschinenfabrik Reinhausen GmbH

Relevant legal provisions:
EPC Art. 100(a), 56
RPBA Art. 12(2), 12(4)
EPC R. 106

Keyword:

Inventive step - obvious combination of known features
Complete appeal case (no) - submission of auxiliary requests
and substantiation by reference to specific submission in
first instance proceedings
Admittance (no) - first to sixth auxiliary requests
Objection under Rule 106 EPC - dismissed

Decisions cited:

T 0503/20, T 1041/21, T 2564/19, T 0308/17



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 2872/19 - 3.5.02

D E C I S I O N
of Technical Board of Appeal 3.5.02
of 27 November 2023

Appellant: Maschinenfabrik Reinhausen GmbH
(Opponent) Falkensteinstraße 8
93059 Regensburg (DE)

Representative: Reichert & Lindner
Partnerschaft Patentanwälte
Stromerstraße 2A
93049 Regensburg (DE)

Respondent: Hitachi Energy Ltd
(Patent Proprietor) Brown-Boveri-Strasse 5
8050 Zürich (CH)

Representative: Epping - Hermann - Fischer
Patentanwaltsgesellschaft mbH
Postfach 20 07 34
80007 München (DE)

Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 6 August 2019
rejecting the opposition filed against European
patent No. 2691967 pursuant to Article 101(2)
EPC.**

Composition of the Board:

Chairman R. Lord
Members: F. Giesen
R. Cramer

Summary of Facts and Submissions

- I. This appeal by the opponent (appellant) lies from the decision of the opposition division to reject the opposition against European patent No. 2 691 967.
- II. With a communication pursuant to Article 15(1) RPBA 2020, the board informed the parties of their preliminary opinion that it was not minded to order reimbursement of the appeal fee, that the subject-matter of claim 1 of the main request did not appear to involve an inventive step in view of the documents
- D3 EP 0 907 192 A2
D13 Weidauer, J.: "Elektrische Antriebstechnik", 1. Auflage, Publics Publishing, 2008,
- and that the board was minded not to admit the first to sixth auxiliary requests since no substantiation of the auxiliary requests was contained in the reply to the statement of grounds of appeal.
- III. With letter dated 5 July 2023 the patent proprietor (respondent) filed a seventh auxiliary request as well as a copy of the first to sixth auxiliary requests and of passages of the letter dated 16 May 2019 containing arguments with regard to the first to sixth auxiliary requests.
- IV. With letter dated 28 September 2023 the appellant announced that they would neither attend, nor be represented at, the oral proceedings.

- V. Oral proceedings before the board took place on 27 November 2023. The requests relevant for the present decision were as follows:

The appellant had requested in writing that

the decision under appeal be set aside and that the patent be revoked. Furthermore the appellant had requested a reimbursement of the appeal fee.

The respondent requested that

the appeal be dismissed, or alternatively

that the decision under appeal be set aside and that the patent be maintained in amended form on the basis of the claims of one of the first to sixth auxiliary requests filed with letter dated 16 May 2019 or

on the basis of the seventh auxiliary request filed with letter dated 5 July 2023.

- VI. Additionally, during the oral proceedings the respondent filed an objection under Rule 106 EPC in writing, which reads as follows:

"We see our right to be heard violated because of a fundamental procedural defect. The auxiliary requests 1-6 have not been admitted in the proceedings, not enabling a discussion of these auxiliary requests, only for the reason that the reference to the substantiation in a specific document of 1st instance proceedings has been made in the response to the grounds of appeal instead of a copy and paste action and/or that further

arguments are seen as required for the substantiation although neither the decision nor the grounds of appeal give rise to any further arguments. Therefore, the Board of Appeal has not correctly applied its discretion and one-sidedly disadvantages the party."

VII. Claim 1 of the main request (i.e. as granted) reads as follows:

- M1 *"An on-load tap changer (10) for changing taps in a transformer winding,*
- M2 *the tap changer comprising: a tap change module (12) connected to the transformer winding*
- M2a *and comprising a bypass switch assembly (50),*
- M2b *a vacuum interrupter assembly (52) and*
- M2c *a selector switch assembly (48);*
- M3 *a servo motor (124) comprising:*
- M3a *a motor shaft (174) connected to the tap change module (12) and operable, upon rotation, to cause the tap change module to perform a sequence of operations that effectuate a tap change;*
- M3b *a feedback device (180) operable to generate a feedback signal containing information relating to the position of the motor shaft, and*
- M4 *a servo drive (126) connected to the servo motor (124) to receive the feedback signal,*
- M4a *the servo drive using the feedback signal to determine and store the total angular displacement of the motor shaft (174),*
- M4b *the servo drive (126) using the feedback signal and the total angular displacement of the motor shaft (174) to control the operation of the servo motor (124),*

M5 *characterized in that the feedback device (180) is a multi-turn absolute encoder."*

The board has adopted the feature labelling of the decision under appeal.

VIII. Claim 1 of the seventh auxiliary request has, in addition to the features of claim 1 of the main request, the feature

"wherein the motor shaft (174) is configured for rotating multiple times for each tap change"

at the end of the claim.

Given the decision taken by the board not to take into account the first to sixth auxiliary request, it is not necessary to cite their wording here.

IX. The arguments of the appellant that were relevant for the present decision can be summarised as follows:

The reimbursement of the appeal fee was justified because the opposition division had not demonstrably heard essential points of the reasoning concerning inventive step, because they had discussed neither decision T 0967/97 nor the cited passages from the Guidelines for Examination G-VII (Annexes concerning examples of obvious subject-matter).

The subject-matter of claim 1 of the main request does not involve an inventive step.

In essence, the subject matter of claim 1 as granted related to a tap changer with a tap change module of generally known configuration driven by a generally

known type of drive system of a well-known configuration, and there were no unexpected advantages from this combination.

Contrary to the reasons for the decision under appeal, D3 was a valid starting point. While D3 may not be concerned with servo drives, it disclosed a tap changer of the reactor type and stated that this tap changer could be driven by a single shaft and a motor.

The technical problem, when starting from D3 as closest prior art, was to find appropriate means to drive the shaft of the tap change module disclosed in D3. The problem as formulated in the decision under appeal was incorrect. The precision of the stored value of the position of the motor shaft depended on the detailed configuration of the feedback device to which claim 1 was not limited. An absolute value of the position of the motor shaft stored in the servo drive was lost in case of a power loss according to the opposed patent, column 18, lines 54 to 58, paragraphs 34 and 35 and figure 12. Feature M4a, allegedly missing from document D13, did not solve the problem formulated in the decision under appeal.

Document D13 was a book on electrical drive systems, showing various types of generally known electric drive systems. The opposition division concluded that the objection of lack of inventive step was based on an *ex post facto* analysis, as the skilled person would have had to select a multi-turn absolute encoder from the large number of possible encoders disclosed in D13. However, D13 showed various suitable drive systems, and the solution to the technical problem amounted merely to a choice out of several equally likely alternatives. Such a choice could not be inventive according to the

Guidelines, G-VII, Annex 3.1. A feedback device (M3b) was part of any servo system, as was a servo drive (M4). Features M4a and M4b just stated the principle of operation of a servo system and were anticipated by any servo system using position control. According to D13, Fig. 6.1. the servo drive was responsible for control and monitoring. In order to control the position of the motor shaft the servo drive had to store the current position of the motor shaft; position control of the motor shaft inevitably implied that the stored position of the motor shaft was used for the control, see also D13, section 6.2 and figure 6.3. A multi-turn encoder (M5) was also disclosed in D13, and was an obvious choice. Therefore, in order to arrive at the claimed subject-matter, a skilled person merely had to fill the gap in the teaching of D3 by selecting an appropriate known drive, which did not involve an inventive step as also stated in the Guidelines, G-VII, Annex 1.1. As far as the subject-matter of claim 1 was concerned, any potential advantages arising from the specific choices made (servo system, multi-turn absolute encoder as feedback device) were only advantages generally associated with a servo system and a multi-turn absolute encoder, independent of the use of the servo system with multi-turn absolute encoder in a tap changer. Such advantages, if any, were known from D13. Exploiting such generally known advantages was obvious, as also stated in the Guidelines G-VII, 4. A skilled person did not have to make two choices, as the opposition division argued, since D13 disclosed servo drives with multi-turn absolute encoders as one single solution. Even if two choices were required, they would both have been obvious choices.

The feature added in the seventh auxiliary request was commonly used in tap changers, so did not render the claimed subject-matter obvious.

- X. The arguments of the respondent that were relevant for the present decision can be summarised as follows:

The subject-matter of claim 1 of the main request involved an inventive step in view of D3 and D13.

Document D3 could not be considered to represent the closest prior art, since it did not disclose a servo drive with a multi-turn encoder and was not concerned with the problem of controlling the motor. The case law had established the criteria for the choice of the closest prior art, and the choice of D3 did not meet these criteria. Decision T 967/97 was not pertinent for the present case.

Notwithstanding these considerations, the subject-matter of claim 1 of the main request was not obvious in view of the combination of documents D3 and D13. Document D3 neither disclosed the features relating to the servo motor and the servo drive (features M3, M3b, M4, M4a and M4b) nor the feature of a multi-turn absolute encoder (M5).

The technical effect associated with the distinguishing features was that the tap change, which was related to the total angular displacement, i.e. an angular displacement of more than one turn, of the shaft was precisely controlled, due to a multi-turn encoder, and stored not only in the servo drive but also in the multi-turn encoder. The latter was maintained even in case of power loss, see for example paragraph [0050] of the opposed patent. The technical problem solved was

therefore that of avoiding the loss of information on the tap changing process even in case of power loss. Document D3 did not deal with the tap change control and therefore the skilled person was not aware of the technical problem and had no reason to look for any servo system in D13.

Moreover, document D13 disclosed both single-turn and multi-turn encoders and the skilled person was not able to choose one of them without hindsight. The skilled person starting from D3 had to make at least two choices, first choosing a servo system even, since D3 only mentioned a motor rather than a servo motor, and second, choosing a multi-turn absolute encoder instead of for example a single turn absolute encoder. Even if the assertion were correct that a servo motor and a multi-turn absolute encoder could be considered to be a package, nothing in D3 prompted the skilled person to pick the claimed package rather than any other solution.

In any case, the skilled person would not have found the feature M4a in D13 because storing the detected motor shaft positions was not contemplated in D13. This was not an implicit feature of a servo system because not all servo system were configured for storing the acquired data. Moreover, it was also not an intrinsic feature of a servo system with absolute multi-turn encoder that the servo drive determined and stored the total angular position. A mere storing of the position in the absolute encoder due to its construction did not result in feature M4a. This feature specified that the servo drive determined and stored the total angular displacement by using the feedback signal, rather than storing the total angular displacement in the absolute encoder. By using the feedback signal and the total

angular displacement as determined and stored by the servo drive, the servo drive did not only control the basic operation of the servo motor by using the feedback signal, but also controlled further functionalities of the on-load tap changer. As an example, the position information obtained from the feedback signal could be stored in a feedback register. As examples, the determined and stored values could be used to implement an electronic hard stop or could be used for checking if the position of a side shaft measured by a further multi-turn absolute encoder and the position of the motor shaft determined by the feedback device match. As a result, the objective technical problem to be solved was to increase the safety in the operation of the on-load tap changer.

The first to sixth auxiliary requests should be admitted. Non-admission of the auxiliary requests for the sole reason that the auxiliary requests and the associated arguments were not explicitly reproduced in the reply to the statement of grounds would in the present case be disproportionate.

The auxiliary requests and also the respective arguments had been filed in the response to the grounds of appeal by referring back to a single and clearly specified document (the letter of 16 May 2019). The discussion of the auxiliary requests in the specified letter was clearly marked as such and complete in itself. Accordingly, the content of the response together with the referenced documents put the board and the appellant immediately in a position to understand why the features added to the claims of the auxiliary requests would overcome the objections. It was not necessary to peruse all documents filed in the first instance proceedings or search for the concerned

passages in the document. This was clearly different from cases where only a general reference to first instance proceedings was made or where no reference to any substantiation is made. Furthermore, the auxiliary requests had not been discussed at all in the appealed decision or in the appellant's grounds of appeal. Any substantiation of the auxiliary requests therefore would not have addressed any part of the decision under appeal. Therefore, an explicit discussion of the auxiliary requests with the response to the grounds of appeal would not have contributed to the basic task of the appeal proceedings of "reviewing the decision under appeal in a judicial manner". Instead, a reference to a document in first instance was made, where the substantiation of the auxiliary requests, which did not require any change in view of the decision, was provided. It would constitute a disproportionate disadvantage for the patent proprietor if a patent were revoked in appeal without having discussed any of the clearly identifiable auxiliary requests only for the formal reason that the auxiliary requests and their substantiation had not been filed expressly but by reference to a specific document of the first instance proceedings. Not admitting the auxiliary requests merely for this formal reason seemed to violate the right to be heard. The present case was different from the cases underlying the decisions cited by the board in the preliminary opinion.

The seventh auxiliary request should be admitted since there were exceptional circumstances. According to the preliminary opinion of the board, the feature of "a multi-turn encoder" did not cause a technical effect over the whole scope of the claim, because claim 1 was not limited to having a gear such that several turns of the motor shaft were required for a full rotation of

the contact arms. This objection was new and unexpected in the proceedings and had neither been discussed in the decision under appeal nor in the grounds of appeal. Therefore, filing a new auxiliary request in this phase of the proceedings was justified by exceptional circumstances. Only very minor amendments were made in claim 1, which were clearly suitable for overcoming the objection and did not give rise to further objections. The technical effect of using a multi-turn absolute encoder to generate a feedback signal containing information about a motor shaft which is configured for rotating multiple times for each tap change is that the total angular displacement of the motor shaft can be determined and stored with high resolution. This allows the servo drive to exactly control the operation of the servo motor.

The respondent raised an objection under Rule 106 EPC because, when not admitting the first to sixth auxiliary requests, the board had not exercised their discretion in the correct manner, thereby one-sidedly disadvantaging the respondent. The wording of the objection is reproduced above.

Reasons for the Decision

1. Admissibility of the Appeal

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

2. *Reimbursement of the Appeal Fee*

2.1 The appeal fee is not reimbursed because the conditions in Rule 103(1)(a) EPC are not fulfilled. The reimbursement would not be equitable because no substantial procedural violation occurred.

2.2 The appellant's first complaint is that the opposition division did not address the decision T 0967/97 cited by the appellant in order to support the argument that their inventive step objection starting from document D3 as starting point should be considered.

It was not necessary for the opposition division to address this particular argument since the opposition division explained in the first paragraph on page 8 of the impugned decision that even when starting from document D3 they did not find the then opponent's argument convincing. The opposition division needed to address only those arguments that are relevant for the final decision. This was done here implicitly by also examining document D3 as starting point.

2.3 The appellant's second complaint is that the opposition division did not address the passages of the Guidelines G-VII, Annexes 1.1 and 3.1 in the impugned decision.

The above Guidelines passages only establish principles that are normally to be applied when examining inventive step. They can neither replace the case-dependent exercise of judgement of an opposition division nor prescribe which conclusion is to be reached. It is apparent that the opposition division in the present case was not convinced that the particular circumstances of the above Guidelines passages applied to the case at hand. This is apparent from the reasons

in point II, 6.1 of the decision under appeal, in which the opposition division considers that D13 does not disclose a part of feature M4a.

3. *Main request - Inventive Step*

3.1 The subject-matter of claim 1 according to the main request does not involve an inventive step, when starting from D3 in view with D13. The ground for opposition pursuant to Article 100(a) EPC in combination with Article 56 EPC therefore prejudices the maintenance of the patent as granted.

3.2 Starting Point

The board considers document D3 as a legitimate choice of the starting point for the assessment of inventive step. The board agrees with the implicit finding in T 0967/97 that the problem-solution approach can correctly be applied from several starting points.

The decisions cited by the respondent in the reply to the appeal are not relevant. They merely concern details of the choice of the closest prior art but they are silent on the question as to whether the correct application of the problem-solution approach requires determining a single piece of prior art as the starting point.

Document D3 discloses a motor for actuating the tap changing modules, see D3, column 4, lines 33 to 39 and column 6, line 13 to column 7, line 11. In the light of this disclosure it is readily apparent that a skilled person when starting from D3 will have to consider how to implement a motor control. It is readily apparent

from D3 that the tap module has to be moved such as to contact the taps and therefore requires position control. In view of this, the respondent's assertions that D3 was not concerned with motor control, did not suggest the technical problem and was not a legitimate choice of a starting point are unpersuasive. There is no explicit or implicit requirement in the problem solution approach that the starting point document necessarily has to contain an explicit suggestion of the problem as long as that problem is one that would realistically present itself. This is clearly the case with D3.

3.3 Distinguishing Features

As far as the distinguishing features are concerned, the parties agree that document D3 does not disclose features M3, M3b, M4, M4a, M4b and M5. The board agrees.

3.4 Technical Effect and Technical Problem

3.4.1 The appellant argued that starting from D3, the skilled person was necessarily faced with the technical problem of finding a suitable means to drive the shaft of the tap change module disclosed in D3.

3.4.2 The respondent argued that the technical effect associated with the distinguishing features was that the tap change, which was related to the total angular displacement, i.e. an angular displacement of more than one turn, of the shaft is precisely controlled, due to a multi-turn encoder, and stored not only in the servo drive but also in the the multi-turn encoder. The latter was maintained even in case of power loss, according to paragraph [0050] of the opposed patent.

The technical effect of separately determining and storing the total angular position in the servo drive enabled further control mechanisms. The technical problem solved was therefore avoiding the loss of information on the tap changing process even in case of power loss.

- 3.4.3 In the context of claim 1, a tap change requires rotating the tap change module by a set rotation angle. A servo motor is a motor with control of the angular position of its shaft. This requires a feedback device which measures the rotation angle of the shaft, either incrementally or in an absolute manner. Absolute encoders, as opposed to relative or incremental encoders, are constructed such as to encode the absolute angular position of the shaft in a unique way. Due to their construction, when the power is lost and then turned back on, the absolute position of a motor shaft is still available in an absolute encoder.

Moreover, there are single-turn encoders, which can only determine the angular displacement modulo 360° , i.e. within a single turn, and multi-turn encoders, which can determine angular displacements larger than 360° in an absolute manner. A multi-turn encoder allows to measure the absolute position in the case the shaft can rotate more than one turn, but since the claim is not limited in that respect, the fact that a multi-turn encoder is used, as opposed to a single-turn encoder, does not cause a technical effect over the whole scope of the claim.

Finally according to the respondent's arguments, feature M4a specifies that the servo drive determines and stores the total angular position from the feedback signal and feature M4b specifies that the servo motor

uses the total angular displacement and the feedback signal used in controlling the servo motor. Determining the total angular position from the feedback signal and storing it thus allows the servo controller to know which tap is currently contacted by the tap module. Using the feedback signal allows the servo motor to rotate the tap module by the appropriate set angle to contact another desired tap.

- 3.4.4 The board therefore concludes that the effect of using a servo motor with an absolute multi-turn encoder - and also the objective technical problem - is to be able to contact desired tap positions reliably and furthermore, not to lose information about the positions of the tap changing module during a loss of power.

The board is not persuaded by the respondent's proposed formulation of the objective technical problem. Claim 1 is not limited to any specific control of the operation of the shaft and hence also not to non-specified "further control mechanisms". Enabling non-specified control mechanisms to which the claim is not limited is not a technical problem that is solved across the entire scope of the claim.

3.5 Assessment of the Solution

- 3.5.1 The appellant argued that servo motors in different varieties were part of the common general knowledge as for example demonstrated by document D13. They often came in packages, including an appropriate encoder, drive, motor and controller. A skilled person would therefore only have had to choose a suitable commercially available solution. The corresponding advantages and disadvantages were known to a skilled person as demonstrated by D13.

3.5.2 The respondent argued that document D3 did not deal with tap change control and therefore the skilled person was not aware of the technical problem and consequently had no reason to look for any servo system in D13. Moreover, document D13 disclosed both single-turn and multi-turn encoders and the skilled person was not able to choose one of them without knowledge of the claimed invention. A skilled person would have had to make two choices from D13 to arrive at the solution of claim 1. Even if servo motors came in "package solutions", there was no prompt in D13 to choose the package according to claim 1. The solutions known were by no means all equivalent. Lastly, D13 did not disclose that the angular displacement was stored in the servo drive.

3.5.3 The board is persuaded by the appellant's argument. In order to put the teaching of D3 into practice, a skilled person would have had to choose an appropriate control for the motor. Document D13 is a textbook that discloses various known motors.

Given the problem to be solved of contacting desired tap positions reliably and not to lose information about the positions of the tap changing module during a loss of power, a skilled person has an incentive to select those motor drives from D13 that achieve this goal. Moreover, document D13 already demonstrates that absolute encoders store their absolute position due to their construction, see the paragraph bridging pages 142 and 143. This disclosure is consistent with the disclosure of paragraph [0048] of the opposed patent itself ("unique code that represents an absolute position"). On supplying power the angular absolute position can be communicated via a serial interface.

Whether a multi-turn or a single-turn encoder is selected is dependent on whether the shaft is intended to rotate through several full rotations in operation, e.g. if it is a geared shaft, or not. A skilled person would therefore simply choose a suitable motor drive out of a great number of known motor drives, merely taking into account the advantages generally associated with this particular type of drive.

In selecting a servo motor with a multi-turn absolute encoder the state of the art suggests in an obvious manner to the skilled person to implement features M3 (a servo motor), M3b (a feedback device), M4 (a servo drive using signals from the feedback device) and M5 (a multi-turn absolute encoder as feedback device).

The respondent's argument that determining and storing the total angular displacement and using the stored value for controlling was not suggested by the prior art encoders is not persuasive. In order to control the angular position of the motor shaft, a servo motor needs a controller. In the wording of the claim, this controller is the servo drive. In order to control the angular position of the shaft, the controller needs to know the current position of the shaft and the set position to which it is desired that the shaft be rotated. It is readily apparent that the servo drive will have to receive and also interpret the signal from the encoder, which encodes the current shaft position e.g. in the form of a string or a byte. Merely for processing this information, in order to determine the current shaft position, the servo motor will have to store it, at least transiently. When moving the shaft to the desired tap position, the servo drive will have to use the the current position, i.e. the momentary total angular displacement, to calculate in which

direction and by which angle the shaft has to rotate to reach the set position. The feedback signals from the encoder will have to be used by the servo drive during rotation to know whether the shaft has reached the set position. Features M4a and M4b merely spell out the normal function of a position control of the servo motor. They may enable further functionalities, such as an electronic hard stop or a set rotation speed. However, since claim 1 is not limited to having these functionalities, the mere fact of enabling them is not a technical effect that can legitimately be invoked, as it is not realised across the entire scope of the claim.

The fact that D13 discloses various alternative motor drives does not make the choice of a particular variant non-obvious. The advantages and drawbacks of these choices are clearly disclosed in D13. The mere fact that a skilled person has to choose from a number of possibilities cannot logically support the conclusion that a particular choice would automatically be non-obvious. With this logic it could also be argued that using a slotted screw to hang a picture on a wall is not obvious simply because there exists a large number of other screw types, such as Phillips or Allen screws.

The respondent argued correctly that D3 itself did not suggest the technical problem of losing position information upon power loss. However, even without a specific suggestion in D3, a skilled person setting out to find an appropriate implementation of the motor control of D3 would have learned from D13 that absolute encoders had the advantage of not losing their position information. The realisation that this is also advantageous in an on-load tap changer according to D3

is therefore suggested by the state of the art and thus not the result of inventive activity.

The board also wishes to emphasize that the number of choices a skilled person has to make in order to arrive at the claimed subject-matter is rather an irrelevant criterion. A skilled person can make any number of obvious choices without making an inventive step. On the other hand a single non-obvious choice is sufficient to render the resulting subject-matter non-obvious.

3.6 To summarise the above reasoning, the subject-matter of claim 1 merely describes using a known motor drive to drive a known tap changer, relying merely on the advantages normally associated with that known motor drive. This cannot establish an inventive step.

4. *First to Sixth Auxiliary Requests - Admittance*

4.1 The board exercised its discretion pursuant to Article 12(4) RPBA 2007, first sentence, so as not to take into account the first to sixth auxiliary requests because the passage referring to them in the reply to the statement of grounds does not meet the requirements of Article 12(2) RPBA 2007.

4.2 These auxiliary requests were introduced by reference to auxiliary requests and arguments provided in a letter filed in the first-instance proceedings, see the respondent's reply to the appeal, page 1, fourth paragraph.

However, according to Article 12(2) RPBA 2007 (which according to Article 25(2) RPBA 2020 applies to the

statement of grounds filed in December 2019 and the timely reply)

"[t]he statement of grounds of appeal and the reply shall contain a party's complete case. They 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." (Underlining by the board)

A corresponding provision is to be found in Article 12(3) RPBA 2020, so that case law on Article 12(3) RPBA 2020 applies *mutatis mutandis* to the application of Article 12(2) RPBA 2007.

4.3 In the board's view the reference to the letter of 16 May 2019 cannot be considered to meet the above requirement.

The provision of Article 12(2) RPBA 2007 serves among other things the purpose of putting the board and the other party in a position to understand why the submitted amendments may be apt to overcome all the objections in the statement of grounds of appeal (T 2564/19, reasons 3.4). Providing a reference to submissions made in the opposition proceedings rather than expressly specifying all facts, arguments and evidence in a reply to the appeal requires the board at least to check which of the submissions might still apply in view of the decision of the opposition division and might still be relevant in view of the statement of grounds of appeal. This already exposes the board to the risk of making the respondent's case, which is inappropriate in *inter partes* proceedings.

In this context it was not the main issue that the board would have had to piece together passages from different submissions. This clearly would have aggravated the problem, but the main issue in the present case was that even specific passages of a single letter did not deal specifically with the issues raised in the statement of grounds of appeal, see also decision T 0503/20, reasons 2.1. The letter referred to only contained statements identifying the added features, without however substantiating whether these are distinguishing features over D3. Furthermore, the letter referred to only contained general assertions to the effect that none of the prior art documents disclosed the added features, without however, substantiating why the amended subject-matter was not obvious in light of the specific combination of document D3 and D13.

- 4.4 The respondent argued that neither the decision under appeal nor the appellant's statement of grounds of appeal dealt with the first to sixth auxiliary requests. Therefore, the respondent concluded they could not be expected to provide any argument going beyond those contained in the letter referred to.

However, this is not correct. A discussion of the auxiliary requests in appeal necessarily implies that auxiliary requests are on file in the appeal proceedings, which was not the case at the time the statement of grounds of appeal was filed. The auxiliary requests filed during first instance proceedings are not necessarily all maintained in appeal, so it cannot be expected of the opponent to address the auxiliary request filed in the first instance proceedings without knowing whether they are maintained in appeal. The respondent-patent proprietor is expected to present

reasons in the reply to the appeal as to why the auxiliary requests (either maintained requests from the first instance or new requests) overcome the specific objections raised in the statement of grounds of appeal against the main request. When the patent has to be amended, there is no longer a presumption of validity. The respondent therefore has to demonstrate that the auxiliary requests overcome the objections on file at the appeal stage. These do not necessarily correspond to objections presented in the first instance. This is consistent with the view expressed in decision T 1041/21, reasons 5.1.4.

- 4.5 In this context, merely filing a copy of the passages of the letter referred to after notification of the summons did not change the situation. Irrespective of the question whether copying and pasting passages from first-instance submissions fulfils the substantiation requirement in Article 12(2) RPBA 2007, according to the case law of the boards of appeal, requests that are not self-explanatory are only deemed to have been filed on the date on which they were substantiated (Case Law of the Boards of Appeal, 10th Edition, V.A.5.12.6). In that case, the admittance would be governed by Article 13(2) RPBA 2020. The respondent argued in this respect that "exceptional circumstances" were present because "no amendment of the substantiation was required in view of the decision in first instance" and the respondent became aware only through the board's preliminary opinion that the board considered not to admit the auxiliary requests "only for formal reasons". It follows from the above considerations on the application of Article 12(2) RPBA 2007 and the relevant case law that these arguments are not convincing.

5. *Seventh Auxiliary Request - Inventive Step*

5.1 Regardless of the question of admittance, the subject-matter of claim 1 of the seventh auxiliary request does not involve an inventive step within the meaning of Article 56 EPC.

5.2 Claim 1 has been amended by specifying that the shaft can rotate multiple times. However, this is merely a well-known and obvious design choice in a tap changer, with the readily apparent advantage that the positioning accuracy is improved. Since document D13 already suggests servo drives with multi-turn absolute encoders, a shaft rotating multiple times is also suggested to the skilled person.

6. *Objection under Rule 106 EPC*

6.1 The objection under Rule 106 EPC is dismissed.

6.2 The respondent argued that the decision not to admit the first to sixth auxiliary requests violated their right to be heard because no discussion as to the substance of the first to sixth auxiliary requests could take place. Moreover, the respondent complained that the board exercised their discretion in an incorrect way and one-sidedly disadvantaged the respondent.

6.3 Article 113(1) EPC prescribes that decisions must not be based on grounds on which a party did not have a chance to comment.

The respondent was informed in the communication pursuant to Article 15(1) RPBA of the board's

preliminary negative opinion concerning the admissibility of the first to sixth auxiliary requests. At the oral proceedings, they were given ample room for debate on the issue of admittance. The respondent therefore had an opportunity to comment on the grounds for the decision not to admit the first to sixth auxiliary requests.

The respondent did not provide any arguments supporting their view that it amounted to a violation of the right to be heard if no discussion on the merits of these auxiliary requests takes place because of their non-admittance. Parties do not have an absolute right to a discussion of requests as to their substance as demonstrated by Article 114(2) EPC and Articles 12 and 13 RPBA, giving a board a discretion not to take into account requests (cf. T 308/17, reasons 38-42, T 1041/21, reasons 6.5).

- 6.4 The respondent complained further that the board exercised their discretion in an incorrect way and one-sidedly disadvantaged the respondent.
- 6.5 The board's decision not to take into account the first to sixth auxiliary requests is based on the fact that the submission of the respondent does not meet the requirement of Article 12(2) RPBA 2007, and is also in line with the exercise of the discretion by other boards in similar other cases, for example T 0503/20, and T 1041/21, as explained above.

The respondent bases the allegation of an incorrect exercise of discretion on the fact that the reference in the present case was to specific passages of a single letter. However, the board explained above that this was not the decisive issue and why this was the

case. Moreover the respondent considered the exercise of the discretion to be incorrect because of the, from the point of view of the respondent, disproportional result. The board cannot accept that the result is intolerably disproportional. In particular, the requirement of Article 12(2) RPBA 2007 is not merely a formality but, as the board pointed out above, a safeguard for the board's neutrality. Requiring a board to check whether, and if so which of, a party's arguments might still apply and be relevant in response to the appeal case, already forces the board to abandon its neutral position. The cause for the non-admission was that the respondent had not substantiated their requests properly despite the existence of an express legal provision that obliges a party to do so. For the same reason the board also cannot accept the accusation that it one-sidedly favoured the appellant by applying the Rules of Procedure.

7. *Conclusions*

Since the opposition ground under Article 100(a) EPC in combination with Article 56 EPC prejudices the maintenance of the patent as granted, the first to sixth auxiliary requests have not been taken into account, and the subject-matter of the seventh auxiliary request does not involve an inventive step, the board accedes to the request of the appellant.

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:



A. Voyé

R. Lord

Decision electronically authenticated