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**Datasheet for the decision
of 4 October 2023**

Case Number: T 0367/20 - 3.2.03

Application Number: 11191755.5

Publication Number: 2461109

IPC: F24D17/02, F24D19/10, F24F5/00,
F25B25/00

Language of the proceedings: EN

Title of invention:
Cold/hot water supply apparatus

Patent Proprietor:
Panasonic Holdings Corporation

Opponent:
Robert Bosch GmbH

Headword:

Relevant legal provisions:
EPC Art. 69, 100(c), 111(1), 123(2)
RPBA 2020 Art. 11

Keyword:

Claim interpretation in the context of the description (yes)
Grounds for opposition - added subject-matter (no)
Remittal - (yes) - special reasons for remittal

Decisions cited:

G 0002/88, G 0002/10, G 0003/14, T 0874/97, T 0190/99,
T 0396/99, T 0556/02, T 1018/02, T 1408/04, T 0073/19,
T 1473/19, T 3097/19, T 0450/20

Catchword:

To assess whether an amended patent claim contains added subject-matter under Article 123(2) EPC, the claimed subject-matter must first be determined by interpreting the claim from the perspective of the person skilled in the art. In a second step, it must be assessed whether that subject-matter is disclosed in the application as filed (Reasons 1.3.8 to 1.3.10).



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Case Number: T 0367/20 - 3.2.03

D E C I S I O N
of Technical Board of Appeal 3.2.03
of 4 October 2023

Appellant: Panasonic Holdings Corporation
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Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted on 11 November
2019 revoking European patent No. 2461109
pursuant to Article 101(3)(b) EPC.

Composition of the Board:

Chairman N. Obrovski
Members: R. Baltanás y Jorge
B. Goers

Summary of Facts and Submissions

- I. European patent No. 2 461 109 B1 relates to a "*Cold/hot water supply apparatus*".
- II. An opposition was filed against the patent based on Articles 100(c) EPC and 100(a) EPC in conjunction with Articles 54 EPC and 56 EPC.
- III. The present appeal is against the decision of the opposition division to revoke the patent. The opposition division found that Article 100(c) EPC prejudiced the maintenance of the patent as granted, that the subject-matter of claim 1 of any of auxiliary requests 1 to 6 did not comply with Article 123(2) EPC, and that claim 1 of auxiliary requests 1a and 1b did not comply with Article 123(3) EPC.

This decision was appealed by the patent proprietor.

- IV. Oral proceedings and final requests

In the oral proceedings before the Board, the discussion focused on the ground for opposition under Article 100(c) EPC and the interpretation of the granted claims, including in the context of the description.

At the end of the oral proceedings before the Board, the appellant (patent proprietor) requested that the decision under appeal be set aside and the case be remitted to the opposition division for further prosecution.

The respondent (opponent) requested that the appeal be dismissed or, as an auxiliary measure, that the case be remitted to the opposition division for further prosecution.

V. Granted claim 1, including the numbering of its features as adopted by the parties, reads as follows (amendments compared to originally filed claim 1 are marked in bold):

- M1** A cold/hot water supply apparatus **(10)** comprising:
- M2** a refrigerant circuit **(2)** including a compressor **(21)**, a first heat exchanger **(22)**, expansion means **(23)** and a second heat exchanger **(24)** which are annularly connected to one another and through which refrigerant flows;
- M3** a fluid circuit **(5)** including the first heat exchanger **(22)** and a third heat exchanger **(53)** which are annularly connected to each other and through which fluid flows;
- M4** a heat accumulator tank **(55)** in which water is stored;
- M5.1** a first switching pipe **(62)** which is connected to **the fluid flows in parallel with** the third heat exchanger ~~in parallel~~ **(53)**,
- M5.2** and which exchanges heat between the fluid and water in the heat accumulator tank **(55)**;
- M6** and a control apparatus **(4)** which switches between a flow of the fluid to the third heat exchanger **(53)** and a flow of the fluid to the heat accumulator tank **(55)**;
- M7** in which the cold/hot water supply apparatus **(10)** has a heat-accumulation operation mode and a cooling operation mode,

- M8** *in the heat-accumulation operation mode, the fluid flows to the first switching pipe (62), thereby heating the water in the heat accumulator tank (55),*
- M9** *and in the cooling operation mode, the fluid flows to the third heat exchanger (53), thereby absorbing heat in air,*
- M10** *wherein the cold/hot water supply apparatus (10) also includes: a temperature sensor (70) which detects temperature of the fluid;*
- M11** **and characterized by** *a second switching pipe (63) which is connected to the third heat exchanger (53) in parallel and which is connected to the first switching pipe (62) in parallel, the fluid flowing through the second switching pipe (63);*
- M12** *and when the heat-accumulation operation mode is changed to the cooling operation mode, the control apparatus (4) is configured to determine ~~determines~~ whether the fluid which flows out of the first heat exchanger (22) should be made to flow to the second switching pipe (63) or to the third heat exchanger (53) based on temperature of the fluid detected by the temperature sensor (70).*

Each of claims 2 and 3 as granted comprises - *inter alia* - the following features M13 and M14:

- M13** *wherein the control apparatus (4) is configured to receive a signal from the temperature sensor (70)*

M14 *and further configured to control the flow of the fluid which flows out of the first heat exchanger (22) based on the signal from the temperature sensor (70)*

VI. The appellant's arguments can be summarised as follows.

(a) Added subject-matter - Article 100(c) EPC

Examining the compliance of claim 1 with the requirements governing added subject-matter required first determining the subject-matter added by an amendment before examining whether there were embodiments not encompassed by the original disclosure.

Although the wording of feature M5.1 had been poorly chosen, the claim had to be interpreted from the perspective of a skilled person willing to understand and make sense of the technical terms, including by consulting the description. Accordingly, feature M5.1 had to be understood as requiring the first switching pipe to be in parallel with the third heat exchanger. This did not add subject-matter.

The skilled person understood claim 1 such that the first and third heat exchangers were annularly connected to each other forming a fluid circuit (feature M3) and that the second switching pipe was connected to the third heat exchanger and to the first switching pipe in parallel to each of these elements (feature M11). This required that the first switching pipe was connected in parallel to the third heat exchanger to ensure the parallel arrangement defined in feature M11.

Taking account of paragraphs [0015] and [0039] of the description of the patent when interpreting feature M5.1 also led the person skilled in the art to the understanding that the first switching pipe was connected to the fluid circuit (the "fluid flows" being the pipes that carry the fluid) and had to be in parallel to the third heat exchanger.

Features M8 (in the heat-accumulation operation mode, the fluid flows to the first switching pipe, thereby heating the water in the heat accumulator tank) and M9 (in the cooling operation mode, the fluid flows to the third heat exchanger, thereby absorbing heat in air) defined how the system worked. In the circuit proposed by the respondent (see figure filed during oral proceedings, "Figure OP"), the heat accumulator tank was connected in series to the third heat exchanger. This did not make technical sense since the hot fluid heating the water in the tank (55) would also flow through the third heat exchanger (53) used to absorb heat in the air.

Furthermore, feature M12 defined that the fluid which flowed out of the first heat exchanger needed to be supplied to the second switching pipe or to the third heat exchanger. This was not the case in the system according to Figure OP proposed by the respondent since the second switching pipe was always receiving fluid, including when fluid flowed to the third heat exchanger (53). Thus, both elements were connected in series, contrary to feature M11.

Moreover, Figure OP should not be admitted into the appeal proceedings for being late filed.

(b) Remittal - Article 111 EPC

If the Board set aside the contested decision, the case should be remitted to the opposition division to enable assessment of patentability at two levels of jurisdiction.

VII. The respondent's arguments can be summarised as follows.

(a) Added subject-matter - Article 100(c) EPC

Assessing added subject-matter required taking into account what was clearly and unambiguously disclosed in the patent. Considerations about what was implicitly disclosed should not be confused with considerations about what was obvious as the latter was only relevant for assessing inventive step.

As the opposition division had correctly decided, the amended feature defined a connection of the first switching pipe to a plurality of fluid flows which were in parallel with the third exchanger. Feature M5.1 thus no longer required the first switching pipe but the fluid flows to be in parallel with the third heat exchanger. This added subject-matter. In the oral proceedings before the Board, the respondent also submitted that feature M5.1 was in any case unclear and thus at least allowed both interpretations as to which parallelism was required by that feature. This was sufficient for a lack of compliance with Article 123(2) EPC.

The amendment of feature M5.1 had no basis in the originally filed application since the wording "fluid flows" was only used as a verb to define an action. It

was not used as a noun. The originally filed description disclosed a single fluid to be used, whereas amended feature M5.1 added completely new information concerning a plurality of fluid flows. This new information was ambiguous and unclear and allowed an interpretation of the feature according to which multiple "fluid flows" were arranged in parallel to the third heat exchanger, contrary to what was originally disclosed.

The added wording "the fluid flows" in feature M5.1 implied that multiple flows existed in the device to such an extent that it rendered the parallelisms defined in feature M11 meaningless.

Figure OP filed during oral proceedings was only a refinement of Figure 2 of the reply to the statement setting out the grounds of appeal and should be admitted into the appeal proceedings.

If the parallelisms defined in feature M11 were not considered to have been rendered meaningless by the amendments to feature M5.1, Figure OP showed that it was possible to set up a second switching pipe which was connected to the third heat exchanger and the first switching pipe in parallel - as defined in feature M11 - while the first switching pipe was not connected in parallel to the third heat exchanger. Claim 1 did not define a second switching pipe which had to be straight or that had to be parallel to the other elements along its whole length. Understood this way, Figure OP showed all parallelisms required by claim 1. Consequently, the skilled person reading claim 1 would consider an arrangement as in Figure OP when trying to reproduce the invention since this figure complied with all the limitations of claim 1. Such an arrangement was not

encompassed by the original disclosure. Therefore, granted claim 1 extended beyond the content of the application as filed.

Furthermore, there was no basis for the amended feature "configured to determine" (M12) in the originally filed application. Amended feature M12 only defined the suitability of the system to carry out the claimed action (i.e. determining whether the fluid which flows out of the first heat exchanger should be made to flow to the second switching pipe or to the third heat exchanger based on the temperature of the fluid detected by the temperature sensor), contrary to originally filed claim 1, which defined that the control apparatus carried out this action.

The same applied to the amendments made to features M13 (the control apparatus is configured to receive a signal from the temperature sensor) and M14 (configured to control the flow of the fluid which flows out of the first heat exchanger based on the signal from the temperature sensor).

(b) Remittal - Article 111 EPC

The case had to be remitted to the opposition division if the contested decision was set aside.

Reasons for the Decision

1. Added subject-matter of granted claims - Article 100(c) EPC
- 1.1 Under Article 123(2) EPC, the European patent application or the European patent may not be amended to contain subject-matter which extends beyond the content of the application as filed. Subject-matter implicitly disclosed to the skilled person, using common general knowledge, is part of the content of the application as filed. Implicitly disclosed subject-matter must be a clear and unambiguous consequence of what is explicitly mentioned (Case Law of the Boards of Appeal, 10th edition 2022, II.E.1.3.3).
- 1.2 The respondent submitted that the subject-matter of the claims of the patent as granted extended beyond the content of the application as filed. The objections of added subject-matter concern the following amended claim features:
 - feature M5.1 in claim 1
 - features M12, M13 and M14 in claims 1 to 3
- 1.3 Claim 1, feature M5.1
- 1.3.1 The parties submitted the following two alternative interpretations of feature M5.1 ("a first switching pipe which is connected to the fluid flows in parallel with the third heat exchanger"):
 - (a) the **fluid flows** are in **parallel** with the third heat exchanger (which would add subject-matter and would

lead to an inescapable trap under Article 123(2) and (3) EPC)

- (b) the **first switching pipe** is in **parallel** with the third heat exchanger (which is undisputedly disclosed in the application as filed)

The wording of claim 1 as granted is arguably unclear. Having said this, the requirements of Article 84 EPC play no role in the present opposition appeal proceedings (G 3/14, Reasons 55), and claim 1 as granted must be interpreted as it stands (see T 874/97, Reasons 2.1).

For the reasons set out below, the Board adopts interpretation b). Interpretation a) could in the Board's view only be considered viable if feature M5.1 were to be interpreted in isolation, i.e. out of context.

- 1.3.2 A claim feature must, however, not be interpreted in isolation but in the context of the whole document it forms part of. The context to be considered for the interpretation of a feature in a claim does therefore not only include the other features in that claim and other claims but also the description and the drawings.
- 1.3.3 The general principle that the claims of a patent, being a part of a document as a whole, need to be construed in their context was recognised early in the case law and has also been understood to underlie Article 69 EPC (see T 556/02, Reasons 5.3, fourth paragraph and, more recently, T 3097/19, Reasons 29.2). Moreover, the principle that patent claims must be interpreted through the eyes of the person skilled in the art, who should try with synthetic propensity to arrive at an interpretation of the claim which is

technically sensible and takes into account the whole disclosure of the patent (established case law; see Case Law of the Boards of Appeal, 10th edition 2022, II.A.6.1, first paragraph) was formulated for the first time with reference to Article 69 EPC (see T 190/99, Reasons 2; see also T 396/99, Reasons 3.5, in which the same board examined the patentability of the claimed subject-matter with reference to Article 69 EPC).

1.3.4 Also the limitation on the weight which can be given to the description in relation to the claims was already in earlier case law derived from Article 69(1), first sentence, EPC (see T 1018/02, Reasons 3.8, concerning Article 123(2) EPC). This has been taken up recently and referred to as the primacy of the claims (see T 1473/19, Reasons 3.16.1; T 450/20, Reasons 2.15; T 73/19, Reasons 2.2), which in particular prohibits reading features into the claims which are only present in the description or the drawings.

1.3.5 It was set out in T 1473/19 (Reasons 3.11.3 and 3.11.4) that the first step in determining the extent of protection in accordance with Article 69 EPC consists in determining the claimed subject-matter under the "general principles" of claim interpretation under Article 1 of the Protocol on the Interpretation of Article 69 EPC (without taking account of equivalents under Article 2 of the Protocol on the Interpretation of Article 69 EPC at this stage; if required at all, this is only done in infringement proceedings as a second step following claim interpretation).

It was further set out in T 1473/19 (Reasons 3.12, 3.12.1 and 3.19) that the interpretation and determination of the subject-matter of the same claim in the same opposition (appeal) proceedings before the

EPO should be uniform and consistent, including for the purpose of Article 123(2) and (3) EPC (the application of Article 69 EPC being mandatory for the determination of the "technical subject-matter of the claims" under Article 123(3) EPC, in accordance with G 2/88, Reasons 4 and 4.1).

Moreover, it was stated in T 1473/19 (in Reasons 3.14 and 3.11.3, last sentence) that the EPO in opposition (appeal) proceedings and the national courts and the UPC in revocation proceedings have concurrent jurisdiction on (post-grant) patent validity and that national courts apply the rules for the interpretation of claims in Article 69 EPC also in revocation proceedings. The present Board additionally notes that the grounds for opposition under Article 100(a) to (c) EPC correspond literally - including in their reference to the "subject-matter" of the patent - to the grounds for revocation under Article 138(1)(a) to (c) EPC (see also Article 65(2) UPCA), and that Article 68 EPC regulates the effect of the revocation or limitation of a European patent in an identical manner for both opposition and revocation proceedings. As to examples of national case law on claim interpretation according to Article 69 EPC in respect of revocation proceedings see:

- Court of Appeal of England and Wales, 14.01.2022, [2022] EWCA Civ 20, Reasons 32, referring to Article 69 EPC and Article 1 of the Protocol on its interpretation in relation to novelty, inventive step and sufficiency of disclosure; High Court of England and Wales, 07.03.2013, [2013] EWHC 467 (Pat), Reasons 67, addressing the primacy of the claims according to Article 69 EPC;

- German Federal Court of Justice, 15.12.2020, X ZR 180/18, Reasons I.5.b), applying Article 69 EPC for determining the subject-matter of the patent ("Gegenstand [...] des Patents") in relation to novelty and inventive step; German Federal Court of Justice, 04.02.1997, X ZR 74/94, Reasons 6a, excluding equivalents from the assessment in revocation proceedings;
- Court of Appeal of Paris, 19.10.2021, N°2017/22624, applying Article 69 EPC for claim interpretation (also) in relation to inventive step; Court of Justice of Paris, 24.03.2023, N°20/03907, Reasons 44 and 52, applying Article 69 EPC for claim interpretation in relation to added subject-matter;
- Court of Appeal of The Hague, 27.10.2020, 200.261.833/01, Reasons 4.5 and 4.45.2 (penultimate sentence), referring to a two-step approach in determining the extent of protection under Article 69 EPC and stating that equivalents are not to be taken into account in the assessment of novelty, inventive step and sufficiency of disclosure;
- Federal Supreme Court of Switzerland, 15.12.2020, 4A_317/2020, Reasons 3.1. and 3.3.2, stating that the principles of claim interpretation according to Article 69 EPC are also applicable when assessing novelty;
- Higher Regional Court of Vienna, 08.06.2018, 133 R 21/18p, Reasons 1.8, referring to claim interpretation according to Article 69 EPC in relation to inventive step;
- Court of Appeal of Barcelona, 24.11.2016, ROJ: SAP B 9303/2016, Reasons 16 to 19, applying Article 69 EPC (also) for determining the claimed

invention ("el objeto de la invención") in relation to novelty and inventive step.

1.3.6 For the above reasons, the present Board considers that the principles of claim interpretation as set out in Article 69 EPC and Article 1 of the Protocol on its interpretation should be applied when establishing the meaning of the claimed features and determining the claimed subject-matter in the present proceedings. Accordingly, the description and the drawings must be considered when interpreting the claims, taking due account of the primacy of the claims.

1.3.7 The claims to be interpreted for assessing compliance with Article 123(2) EPC are the claims as granted. These must be interpreted in the context of the whole document they form part of, i.e. the whole disclosure of the patent as granted. Accordingly, it is the description and the drawings of the patent as granted which must be used for the interpretation of the claims as granted (see T 450/20, Reasons 2.16; see also the reference to the "description and drawings" and the "European patent" in the first sentence of Article 1 of the Protocol on the Interpretation of Article 69 EPC; moreover, if - as in the present case - an amended description was submitted for the set of claims which was then granted, only the description of the patent is part of the text of the "European patent" which may be examined pursuant to Article 113(2) EPC).

1.3.8 To assess whether an amended patent claim contains added subject-matter under Article 123(2) EPC, the claimed subject-matter must first be determined by interpreting the claim (i.e. establishing the meaning of the claimed features) from the perspective of the person skilled in the art. In a second step, it must be

assessed whether that subject-matter is disclosed in the application as filed. In other words, the claim interpretation adopted by the deciding body defines the subject-matter which must be disclosed in the application as filed. In the present Board's view, this approach reflects what the Enlarged Board of Appeal stated in G 2/10, Reasons 4.5.2: "Whether the skilled person is presented with new information **depends on how he or she would understand the amended claim**, i.e. the subject-matter remaining in the amended claim and on whether, using common general knowledge, he or she would regard **that subject-matter** as at least implicitly disclosed in the application as filed." (emphasis added).

- 1.3.9 In the case at hand, interpretation a) and interpretation b) of claim 1 as granted result in different claimed subject-matter and are mutually exclusive in that claim 1 either requires the first switching pipe or, alternatively, the fluid flows to be "in parallel with the third heat exchanger". Contrary to what was indicated by the respondent, it cannot be required of the patentee that the claimed subject-matter according to either of these mutually exclusive interpretations be disclosed in the application as filed. Only the subject-matter which is actually claimed - as opposed to subject-matter which is merely hypothetically claimed - must be disclosed in the application as filed. In this situation, the deciding body must not adopt two mutually exclusive claim interpretations simultaneously and must - if decisive for the outcome of the case - not leave the interpretation in that regard open either. Rather, the deciding body must consider which of the two claim interpretations is correct. As stated above, this

interpretation defines the claimed subject-matter which must be disclosed in the application as filed.

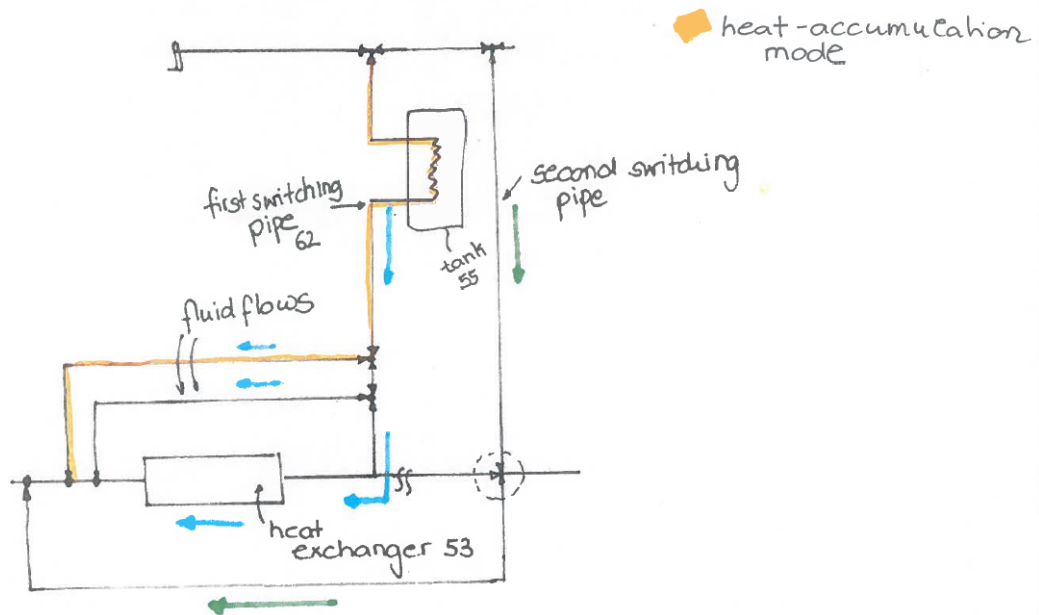
- 1.3.10 For the sake of completeness, the Board notes that whether or not two claim interpretations are in a given case mutually exclusive depends on the specific circumstances of the case which must be assessed by the deciding body. The present case concerning two mutually exclusive interpretations of a certain claim feature must in particular be distinguished from situations in which a claim feature can be interpreted in a broad manner to encompass "a multitude of possibilities" (see T 1408/04, Reasons 1). In such a case, these are different embodiments of the same, broad subject-matter.
- 1.3.11 Turning to the interpretation of Feature M5.1, the Board notes that this feature refers to a first switching pipe which is connected to "the fluid flows". Although a definite article is used, "the fluid flows" referred to in this feature are not previously introduced and defined in the claim.
- 1.3.12 As argued by the respondent, the phrase "fluid flows" in feature M3 ("a fluid circuit [...] through which fluid flows") cannot be understood as an antecedent of the "fluid flows" in feature M5.1 since the word "flows" is used as a verb in M3, contrary to the use as a noun in M5.1. Likewise, the phrase "the fluid flows" in features M8 and M9 also concerns an action and is therefore not decisive for ascertaining the meaning of feature M5.1 either.
- 1.3.13 Feature M11 defines "*a second switching pipe which is connected to the third heat exchanger in parallel and which is connected to the first switching pipe in*

parallel". The respondent argued that the parallel arrangement of the second switching pipe with respect to the third heat exchanger and to the first switching pipe would not necessarily mean that the first switching pipe was also arranged in parallel to the third heat exchanger. The respondent further submitted that feature M5.1 rendered the two parallelisms in feature M11 meaningless. The Board disagrees with the latter. Rather than construing feature M5.1 and feature M11 in isolation such that they contradict each other, the person skilled in the art would interpret them in a complementary manner. Hence, taking account of feature M11 when interpreting feature M5.1 speaks in favour of interpretation b) of feature M5.1 (i.e. that the first switching pipe is in parallel with the third heat exchanger).

- 1.3.14 The description of the patent as granted, which must be taken into account for interpreting feature M5.1 of claim 1 as granted (see points 1.3.2 to 1.3.7 above), consistently discloses that the first switching pipe is "connected to the third heat exchanger in parallel".
- 1.3.15 Importantly, this is already the case in the general description of the invention (see paragraph [0015], lines 1 and 2 of column 3), as well as in all embodiments referred to in the description (see paragraph [0039], lines 54 and 55 of column 6; for the second embodiment, see paragraph [0076], lines 45 to 47 of column 10).
- 1.3.16 Hence, taking account of feature M11 and the description, the person skilled in the art would adopt interpretation b) of feature M5.1. This is the arrangement defined in the corresponding feature of originally filed claim 1 ("*a first switching pipe which*

is connected to the third heat exchanger in parallel") and therefore as originally disclosed.

- 1.3.17 As to "the fluid flows" in feature M5.1, the person skilled in the art knows that the connection of two elements in parallel in a hydraulic circuit requires the use of pipes. These pipes form the hydraulic circuit but are separate from the elements they connect. In view of their common general knowledge and taking account of feature M11 and the content of the description and the figures (see Figures 1, 2, 3 and 5), the person skilled in the art understands "the fluid flows" in feature M5.1 as the hydraulic lines (i.e. the pipe sections of the hydraulic circuit) to which the first switching pipe has to be connected to be arranged in parallel with the third heat exchanger. Such pipe sections are necessarily implied by originally filed claim 1 and thus form part of the subject-matter disclosed in that claim.
- 1.3.18 The respondent submitted Figure OP in the oral proceedings before the Board. Since Figure OP is, according to the analysis provided below, not relevant for the outcome of the case, the question raised by the appellant concerning its admittance under Article 13(2) RPBA 2020 does not need to be addressed.
- 1.3.19 In substance, the respondent argued that Figure OP demonstrated that an implementation of feature M5.1 according to interpretation a) was technically feasible. The respondent argued that feature M11 could be complied with even if the first switching pipe was not arranged in parallel with the third heat exchanger, providing Figure OP (reproduced below) in support of its arguments.



This is not convincing.

1.3.20 Firstly, the proposed circuit is not a device the skilled person would contemplate when implementing the invention of claim 1.

The respondent proposes a first switching pipe (62) running through a tank (55) and connected to the pipe feeding the third heat exchanger (53). Two "fluid flows" are connected to this first switching pipe (53) at a location between the tank (55) and the third heat exchanger (53).

Feature M6 defines "a control apparatus which **switches** between a **flow of the fluid** to the **third heat exchanger** and a **flow of the fluid** to the heat accumulator **tank**" (emphasis added).

Feature M7 defines two modes for the claimed device, namely "a heat-accumulation operation mode and a cooling operation mode".

Features M8 and M9 define how the device works in each mode, namely "*in the **heat-accumulation** operation mode, the **fluid flows to the first switching pipe**, thereby **heating the water** in the heat accumulator tank, and in the **cooling** operation mode, the **fluid flows to the third heat exchanger**, thereby **absorbing heat** in air"* (emphasis added).

As stated by the appellant, the skilled person understands from these features that the flow of the fluid is **either** directed towards the first switching pipe to heat the water in the tank **or** to the third heat exchanger to absorb heat in the air. The connection between the first switching pipe (62) and the pipe feeding the third heat exchanger (53) does not make technical sense since it would either feed a hot fluid into a heat exchanger intended to absorb heat in the air or a cold fluid intended to absorb heat in the tank intended for heating water. Thus, this embodiment would not be considered by the skilled person when implementing the subject-matter of claim 1 because it is technically unreasonable.

- 1.3.21 Secondly, the device proposed in Figure OP does not fall under the subject-matter of claim 1, even if interpretation a) were adopted.

The respondent proposes a "second switching pipe" comprising two portions: a first one arranged vertically between two three-way valves and a second one starting at the lower three-way valve and comprising a horizontal portion.

According to Figure OP, to feed fluid to the third heat exchanger (53) for cooling, fluid must **always** flow to the first vertical portion of the second switching

valve. This is explicitly excluded by feature M12, which defines that "**when the heat-accumulation operation mode is changed to the *cooling operation mode*, the control apparatus is configured to determine whether the fluid which flows out of the first heat exchanger should be made to flow to the second switching pipe or to the third heat exchanger**" (emphasis added). Even if a second switching pipe formed by several portions is encompassed by the claim, feature M12 excludes that the fluid can be made to flow to **both** the second switching pipe and the third heat exchanger as would be necessary when feeding the third heat exchanger (53) of Figure OP.

Furthermore, the flow of fluid to the first portion of the second switching pipe of Figure OP and (subsequently) to the third heat exchanger (53) means that these two elements are connected in series, contrary to feature M11. The expression "connected in parallel" related to a hydraulic circuit has a well-defined meaning and involves parallelism in hydraulic terms. The skilled person reading claim 1 understands that connecting an element in parallel excludes a connection in series, and this applies for the whole of the element.

- 1.3.22 In view of the above, feature M5.1 does not contain added subject-matter.
- 1.4 Claim 1, feature M12 ("configured to determine")
 - 1.4.1 The respondent argues that there is no basis for the amendment of feature M12 from "the control apparatus determines" (application as filed) to "the control apparatus is configured to determine" in the originally filed application.

1.4.2 The Board agrees that the literal wording "configured to determine" was not used in the originally filed application. However, considered as a whole, the originally filed application discloses this feature.

In current device claim 1, the skilled person understands "configured to determine" as the control apparatus having **the capacity** to perform this function (e.g. by sensors, etc.), **not just the suitability** of being potentially configured to perform the defined action. This capacity is also disclosed in the originally filed application.

Originally filed claim 1 defined the following features (emphasis added):

M6 *a control apparatus which **switches** between a flow of the fluid to the third heat exchanger and a flow of the fluid to the heat accumulator tank*

M12' *and when the heat-accumulation operation mode is changed to the cooling operation mode, the control apparatus **determines** whether the fluid which flows out of the first heat exchanger should be made to flow to the second switching pipe or to the third heat exchanger based on temperature of the fluid detected by the temperature sensor*

Although the verbs "switches" and "determines" may at first appear to define an action, such an interpretation is not technically sensible for a device claim. A device can only enable an action by providing means (e.g. a control logic and sensors and actuators). The skilled person thus understands that feature M6

cannot be interpreted as if the control apparatus were continuously switching between a flow of the fluid to the third heat exchanger and a flow of the fluid to the heat accumulator tank. Instead, the skilled person interprets features M6 and M12' to mean that the control apparatus must be capable of performing these actions **whenever this is needed**.

Hence, amended feature M12 only explicitly defines what was implicitly disclosed in granted claim 1, namely that the control apparatus "is configured" to perform the action, and it does not extend the subject-matter of claim 1 compared to the originally filed application.

- 1.5 Claims 2 and 3, features M13 (the control apparatus is configured to receive a signal from the temperature sensor) and M14 (and further configured to control the flow)
- 1.5.1 The conclusion of the preceding point on feature M12 (configured to determine) applies *mutatis mutandis* to features M13 (control apparatus **configured to receive** a signal from the temperature sensor) and M14 (**configured to control** the flow of the fluid) in claims 2 and 3. The skilled person understands from the originally filed application (claim 2) that the invention concerns a control apparatus capable of performing the defined actions whenever needed.
- 2. Remittal - Article 111(1) EPC, Article 11 RPBA 2020

The contested decision concerns solely the ground for opposition based on Article 100(c) EPC and compliance of the auxiliary requests with Articles 123(2) and (3)

EPC. The grounds for opposition under Article 100(a) EPC were not addressed in the decision under appeal.

In accordance with Article 12(2) RPBA 2020, the primary object of appeal proceedings is to review the decision under appeal in a judicial manner. Lacking a decision to be reviewed on other patentability requirements and in view of the requests for remittal from both parties, special circumstances within the meaning of Article 11 RPBA 2020 exist, and the Board decides to remit the case to the opposition division for further prosecution (Article 111(1) EPC).

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the opposition division for further prosecution.

The Registrar:

The Chairman:



C. Spira

N. Obrovski

Decision electronically authenticated