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**Datasheet for the decision
of the Enlarged Board of Appeal
of 7 March 2011**

Case Number: R 0022/10
Appeal Number: T 0219/09 - 3.2.04
Application Number: 01100891.9
Publication Number: 1118363
IPC: A63C 11/22
Language of the proceedings: EN

Title of invention:
Stick with shock-absorber

Patentee:
Zaltron, Renato

Opponent:
GIPRON - GIUSEPPE PRONZATI S.p.A.

Headword:
Fundamental violation of Article 113 EPC/ZALTRON

Relevant legal provisions:
EPC Art. 112a(2)(c), 113(1)

Keyword:
"No denial of opportunity to be heard"
"No right to advance indication of reasons for decision"
"Had denial of opportunity to be heard been shown, no causal link to decision"
"Petition for review clearly unallowable"

Decisions cited:
G 0004/95, R 0001/08, R 0002/08, R 0004/08, R 0011/08,
R 0012/09, R 0015/09, R 0018/09, R 0019/09, R 0015/10



Case Number: R 0022/10

D E C I S I O N
of the Enlarged Board of Appeal
of 7 March 2011

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Decision under review: Decision of the Technical Board of Appeal
3.2.04 of the European Patent Office of
27 September 2010.

Composition of the Board:

Chairwoman: B. Günzel
Members: C. Rennie-Smith
A. G. Klein

Summary of Facts and Submissions

I. The petition for review concerns decision T 219/09 of the Technical Board of Appeal 3.2.04 of 27 September 2010 to set aside the decision of the Opposition Division and to revoke the European patent No. 1118363 entitled "Stick with shock-absorber". The petitioner and patent proprietor filed the petition by fax on 30 December 2010 and paid the petition fee on the same date. The petition is based on the ground in Article 112a(2)(c) EPC, namely that a fundamental violation of Article 113(1) EPC occurred in the appeal proceedings.

II. The previous proceedings, to the extent they are relevant for the purposes of the present petition proceedings, can be summarized as follows:

(a) The patent derived from European Patent Application No. 01100891.9 filed on 16 January 2001 and was granted on 31 August 2005. The characterizing part of claim 1 of the patent as granted, which defined a stick provided with a shock-absorber, read:

"...characterized in that each slot (9, 10) includes a first region (14) and a second region (13) and said pin member (12) is movable from an absorbing position in which said pin member (12) can freely slide in said first region (14) to accommodate relative motion of said elongated member (5; 105) and said grip member (2; 1 02) to a locking position in which sliding of said pin member (12) is limited in said second region (13)

and relative motion of said elongated member (5; 105) and said grip member (2; 102) is substantially prevented, and **in that** *at least one cam means (15) is provided in said at least one slot (9, 10) arranged to narrow said at least one slot between said first region (14) and said second region (13), thereby preventing said pin member (12) from freely sliding from said first region (14) to said second region (13).*" (Emphasis in original; italics added.)

The text italicized above relating to the cam feature was added by way of pre-grant amendment and was taken from paragraph [21] of the application which read:

"[0021] In the illustrated example, the stick 1 comprises two slots 9, 10 which are obtained by cutting the tube 5 in the region 11 below the disk 7. Each slot 9, 10 is shaped like an inverted L, with its upper ends shaped so as to form a cam 15. In this manner, each slot 9, 10 forms a first region 14 for the free sliding of the pin and a second region 13 for limited sliding; the regions are separated by the cam 15. When the pin 12 is arranged in the second region 13, as shown in Figure 1, which corresponds to the condition in which shock-absorbing is disabled, the tube 5 is prevented from sliding within the cavity 3 of the body 2 and the operation of the spring is thus disabled; the grip-stick assembly thus behaves like a single rigid system. By lowering and turning the grip with respect to the stick, as shown schematically in Figure 2, the pin 12 is

moved beyond the cam 15 from the second region 13 to the first region 14 of the slot 9 and 10; this position is shown in Figure 3. In this position, the pin 12 can slide freely along the first region 14, allowing a stroke of the tube 5 inside the cavity 3 of the body 2, such that the spring 4 can cushion the forces transmitted to the stick from the ground. Figure 4 illustrates the stroke limit position of the pin 12 in the first region 14. The sliding condition of the pin 12 in the first region 14 of the slot 9, shown in Figures 3 and 4, corresponds to the condition in which shock-absorbing is enabled. Whenever the user strikes the ground with the tip of the stick, the impact produces a sliding of the tube of the stick within the cavity of the grip and a consequent reaction of the spring, which tends to elongate and return the tube to the initial position. In order to deactivate the system it is sufficient to turn the knob so that the pin can move beyond the cam 15 (Figure 2) and be arranged again in the second region 13, as shown in Figure 1."

- (b) An opposition was filed on 23 May 2006 requesting revocation on the grounds of *inter alia* Article 100(c) EPC arguing that the cam feature in claim 1 as granted contained text which was not present in the application as originally filed. In particular, nowhere in the application was it said that more than one cam could be provided in each slot. In response to this argument the petitioner proposed an auxiliary request with an amended claim 1 in which "at least one cam means" was replaced by "a cam means". At oral proceedings on

15 October 2008, the Opposition Division maintained the patent as amended according to that auxiliary request. The opponent appealed against the decision and again argued that the cam feature was not fully supported by the application as originally filed and added undisclosed subject-matter.

- (c) The Board of Appeal's provisional observations, contained in a communication issued on 15 June 2010, included:

"1. Turning first to the question of added subject-matter, the feature of the cam has been added from the description and figures. The relevant parts in the published application are paragraph [0021] (corresponding to paragraph [0022] of the patent specification) and figures 1 to 5. The parties will need to consider firstly whether the features and function of the cam added to claim 1 are directly and unambiguously clear to the skilled person from these relevant parts. Moreover, as a cam is described originally in those sections in a particular structural context, it will also be necessary to consider, whether lifting the feature of the cam out of that context to give it a broader, more abstract meaning has a clear basis in the original disclosure, cf. T 1067/97 or T 25/03."

In a letter in reply dated 27 August 2010 the petitioner stated, with two pages of supporting argument, that in its opinion the features of claim 1 which relate to the cam means were fully

supported by the description and drawings as originally filed. In response to the Board's observations about the "particular structural context" in which the cam is described and whether isolated features have been extracted from a particular preferred embodiment, the petitioner pointed out that the "particular structural context" was identical in both the embodiments described in the patent, which differed only as to the shock absorbing members - in one embodiment a progressive spring, and in the other a nitrogen-pressurized damper - which are totally equivalent from a functional point of view. Thus it was the proprietor's opinion that the cam feature introduced in claim 1 certainly had a broader and more abstract technical meaning than could be inferred by reading the description of the first embodiment.

- (d) During oral proceedings before the Board of Appeal on 27 September 2010, the petitioner filed two auxiliary requests, in both of which the word "means" after "cam" was removed and in the second of which a portion of the description of paragraph [0022] of the patent specification was added in order to specify the "particular context" in which the cam was described. After deliberation the Board decided to set aside the decision of the first instance, and to revoke the patent on the ground that claim 1 according to all the requests had been amended in such a way that it contained subject-matter extending beyond the content of the application as filed.

III. The petitioner's arguments can be summarized as follows. The written decision of the Board of Appeal stated (see point 3.3 of the reasons - the text below is as cited in the petition):

"...The original disclosure thus offers the skilled person a single specific example of an activation mechanism involving cams. It instructs him to provide each of two slots shaped as an inverted L with a cam in the upper end and separating the two parts of the inverted L so that the grip must be lowered and twisted to move the pin beyond the cam to activate the shock absorber. Each cam (there are two) clearly forms an inseparable structural and functional part of the mechanism, in that it delimits the slot and constrains movement between the slot's different regions. Apart from describing their function within their specific context the original disclosure does not give the cams any prominence... There is thus nothing in the original disclosure that might have led the skilled person to consider a cam-based mechanism - say, with one slot shaped as an L the right way up, or as a T or a Z, and a single cam, or with the cam located at the lower end - other than that explicitly described."

The Board thus decided that, because of the specific example presented in paragraph [0022] of the patent, the provision of the cam in claim 1 should be linked with the shape of the slot. However, the requirement of shape of the slot had not been objected to by the opponent or the Board nor had the Board of Appeal, either in writing or during the oral proceedings, raised any direct question in respect to the shape of the slot. The passage in the Board's communication of

15 June 2010 "... a cam is described originally in those sections in a particular structural context..." was ambiguous and could not be considered as a request for the shape of the slot to be specified.

Therefore the decision was based on a new argument or aspect, i.e. a ground, on which the petitioner had no opportunity to present comments, which clearly contravened Article 113(1) EPC as appeared from decision G 4/95 (see point 10 of the reasons). Since this new ground was the basis of the Board's decision, it constituted a fundamental procedural violation.

The petitioner was unable to raise any objection during the appeal proceedings as required by Rule 106 EPC because the decision was based on a ground of which he was unaware.

The decision of the Board of Appeal was, even more surprisingly, based on wrong technical arguments. First, the shape of the slot was implicitly dictated by the features described in claim 1 (of all the requests). Second, the Board completely disregarded the drawings of the patent although referred to by the petitioner during the oral proceedings (see point VII of the decision) and although Article 69(1) EPC explicitly states that the description and drawings shall be used to interpret the claims. The shape of the slot is evident from the drawings. Third, the case-law referred to in the Board's decision (see point 3.1 of the reasons) confirms, contrary to the Board's view, that the presence of the cam was not linked to the shape of the slot.

- IV. In a communication of 25 January 2011 the Enlarged Board of Appeal informed the petitioner of its provisional view that the petition appeared not to be clearly inadmissible but appeared to be clearly unallowable. The petitioner responded by a further written submission dated and filed by fax on 7 February 2011.
- V. Oral proceedings were held on 7 March 2011 at the end of which the Enlarged Board of Appeal announced its decision.
- VI. The petitioner requested the Enlarged Board of Appeal to set aside the decision under review and re-open the proceedings before the Board of Appeal.

Reasons for the Decision

Admissibility

1. The petition was filed within two months of notification of the decision in question, the petitioner was adversely affected thereby, the prescribed fee was paid in time, and the petition identified grounds contained in Article 112a (2) EPC and complied with Rule 107(1) and (2) EPC.
2. As regards the requirement in Rule 106 EPC to object to a procedural defect during the appeal proceedings, since the petitioner's case is that he was not heard on a point which only first appeared from the Board of Appeal's written decision, it could be said that the exception in Rule 106 EPC applies.

3. Accordingly, the petition is not clearly inadmissible.

Allowability

4. The petitioner asserts that he had no opportunity to present comments on one of the grounds for its decision given by the Board of Appeal, namely the shape of the slot in the cam feature. While the petitioner may be correct in arguing that the opponent did not question the shape of the slot, and that the Board never raised any direct question about it, the opponent had challenged the entire cam feature during both the opposition and the appeal proceedings and the Board quite clearly raised questions about the entire cam feature in its communication (see section II(c) above). The communication first advised the parties (including the petitioner) to consider whether the features and function of the cam (all the features, including but not limited to the shape of the slot) are directly and unambiguously clear to the skilled person. Then the communication advised the parties to consider whether there was basis in the application for lifting the cam feature from the particular context in which it was disclosed (in one embodiment in paragraph [21] described as an "illustrated example" - see section II(a) above) and giving it a broader and more abstract meaning.
5. The petitioner viewed this passage of the communication as ambiguous and said it could not be considered as a request for the shape of the slot to be specified.

The Enlarged Board cannot see any ambiguity whatsoever in the Board of Appeal's observations which are a straightforward summary of the considerations to be taken into account in assessing objections to amendments under Article 123(2) EPC.

The Enlarged Board agrees with the petitioner that the communication was not a request to specify the shape of the slot and indeed such a request would have been wholly improper. The Board has a duty to maintain a neutral stance towards opposing parties and cannot advise one party how to conduct its case, still less advise a patentee how to amend his claims (see R 11/08 of 6 April 2009, point 14 of the reasons).

6. As the cam feature was in issue throughout the proceedings, the petitioner had ample opportunity to comment on it and actually did so in reply to the notice of opposition (see his letter of 5 November 2006, pages 1 to 2), in reply to the opposition division's communication (see his letter of 15 September 2008, page 1), in reply to the statement of grounds of appeal (see his letter of 14 August 2009, pages 5 to 6), in reply to the Board of Appeal's communication (see his letter of 27 August 2010, pages 1 to 4) and, apparently, during the oral proceedings before the Board (see the Board's decision, section VII).

That the petitioner did not, despite the Board's clear views in its communication, adopt the same approach as that subsequently used by the Board in its written decision, was entirely a matter for the petitioner himself and his representative. In the absence of any contention or indication that the Board actually

refused to hear the petitioner, it is sufficient for the purposes of Article 113(1) EPC that the petitioner was aware of an argument, as he was as a result of the Board's communication (see R 2/08 of 11 September 2008, point 8.2 of the reasons; R 4/08 of 20 March 2009, point 3.3 of the reasons). It follows that the Board of Appeal's written decision reflects the facts of the case and the arguments of the parties and does not contain any reasons which could not be objectively foreseen.

7. Hence, even if the shape of the slot *per se* had, in itself and on its own, been a reason for the Board's decision (and not part of the Board's overall view of the cam feature as an amendment to claim 1), the petitioner's complaint that the Board did not indicate, or invite comments on, that particular reason which it subsequently gave in writing for its conclusion, cannot be a denial of the right to be heard. As is clear from the Enlarged Board's jurisprudence, parties are not entitled to advance indications of the reason or reasons for a decision before it is taken. (See for example R 12/09 of 15 January 2010, point 11 of the reasons and the several other decisions there referred to; and see also subsequent decisions which apply the same principle including R 15/09 of 5 July 2010, point 4 of the reasons; R 18/09 of 27 September 2010, points 14 to 15 and 18 of the reasons; and R 15/10 of 25 November 2010, point 9 of the reasons.)

8. In fact, however, it is clear from the relevant passages of the Board of Appeal's decision (see points 3.2 to 3.4) that it was not just the shape of the slot but a number of features, including but not confined to

the shape of the slot, disclosed in combination in paragraph [21] of the patent application which the Board considered to be disclosed only in one context and not as a general disclosure. Thus, even if the shape of the slot had been set out in the amended claim, there would still have remained other features not set out which would have led to a decision adverse to the petitioner. Accordingly, even if the petitioner had established a procedural violation, there would have been no causal link between that violation and the decision and the violation would not therefore have been fundamental (see R 1/08 of 15 July 2008, point 3 of the reasons). As the Enlarged Board's jurisprudence shows, such a necessary causal link does not exist when, even if a procedural violation can be demonstrated, the same decision would have resulted for other reasons (see R 19/09 of 24 March 2010, points 6 to 9.2 of the reasons).

9. The petitioner cited in support of his arguments a passage from decision G 4/95 (OJ EPO 1996, 412, see point 10 of the reasons):

"In the context of inter partes proceedings it is a generally recognized principle of procedural law that each party to such proceedings should have a proper opportunity to reply to the case which is presented by an opposing party. This principle is reflected in Article 113(1) EPC, which emphasizes that a party should not be taken by surprise by grounds or evidence which are used as the basis of an adverse decision."

That statement is perfectly correct. However, it has no bearing on the present case since the petitioner did

have a proper opportunity to reply to the case presented by the opposing party and, additionally, to the preliminary observations of the Board of Appeal and used that opportunity. He may, if confident he had dealt with all the arguments against him, have been surprised by the reasons for the decision but he was not taken by surprise in the sense of discovering a ground for the first time in the written decision. The petitioner's subjective surprise cannot change the fact that he knew the arguments against him and had an opportunity to comment thereon (see R 12/09 of 15 January 2010, point 13 of the reasons; and R 15/10 of 25 November 2010, point 11 of the reasons).

10. The petitioner also argues that the Board of Appeal was wrong as to the merits of the technical question involved (see the petition, pages 5 to 6). However, those arguments directly address the substantive case decided by the Board and it is not open to the Enlarged Board in petition proceedings to review the correctness or otherwise of the Board's application of substantive law (see R 1/08 of 15 July 2008, point 2.1 of the reasons and the *travaux préparatoires* cited there).

Order

For these reasons it is decided that:

The petition is unanimously rejected as clearly unallowable.

The Registrar:

The Chairman:

P. Martorana

B. Günzel