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**Datasheet for the decision
of 27 September 2010**

Case 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:

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Relevant legal provisions:
EPC Art. 123(2)

Relevant legal provisions (EPC 1973):

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Keyword:
"Added subject-matter (yes) (all requests)"

Decisions cited:
T 1067/97, T 0714/00, T 0025/03, T 1408/04, T 0461/05

Catchword:

-



Case Number: T 0219/09 - 3.2.04

DECISION
of the Technical Board of Appeal 3.2.04
of 27 September 2010

Appellant: GIPRON - GIUSEPPE PRONZATI S.p.A.
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Respondent: Zaltron, Renato
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Decision under appeal: Interlocutory decision of the Opposition
Division of the European Patent Office posted
19 November 2008 concerning maintenance of
European patent No. 1118363 in amended form.

Composition of the Board:

Chairman: M. Ceyte
Members: A. de Vries
C. Heath

Summary of Facts and Submissions

I. The Appellant (Opponent) lodged an appeal, received 16 January 2009, against the interlocutory decision of the Opposition Division posted 19 November 2008 on the amended form in which European Patent No. 1 118 363 can be maintained. He simultaneously paid the appeal fee. The statement setting out the grounds followed on 25 March 2009.

II. Opposition was filed against the patent as a whole and based among others on Article 100(c) for added subject-matter.

The Opposition Division held that the grounds for opposition under Article 100 EPC 1973 did not prejudice the maintenance of the patent as amended according to a main request.

III. Oral proceedings were held before this Board on 27 September 2010.

IV. The Appellant (Opponent) requests that the decision under appeal be set aside and the patent be revoked in its entirety.

The Respondent (Proprietor) requests that the appeal be dismissed and the patent therefore be maintained in the amended form held allowable by the opposition division (main request), or, in the alternative, that the patent be maintained in amended form on the basis of auxiliary requests 1 and 2 filed during the oral proceedings before the Board.

V. The wording of claim 1 of the requests is as follows:

Main request

"A stick provided with shock-absorber and comprising: an elongated stick member (5; 105), a grip member (2; 102) which is movably mounted at one end of said elongated stick member (5; 105), and adapted to be gripped by a user, a shock-absorbing member (4; 104) arranged to act on both said elongated stick member (5; 105) and said grip member (2; 102), an activation and deactivation means (9, 10, 12) for activating and deactivating said shock-absorbing member (4; 104) designed to determine a first shock-absorbing condition and a second condition in which shock-absorbing is disabled and including at least one slot (9, 10) formed in either said elongated member (5; 105) or said grip member (2; 102) and further including a pin member (12) rigidly coupled to said grip member (2; 102) or said elongated member (5; 105), respectively, said pin member (12) engaging with said at least one slot (9, 10), said shock-absorbing member (4; 104) and said activation and deactivation means (9, 10, 12) being arranged substantially at said grip member (2; 102), 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; 102) 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 a 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)."

Auxiliary Request 1

Claim 1 is as in the main request but replaces "a cam means" by "a cam".

Auxiliary Request 2

Claim 1 is as in auxiliary request 1 but adds the following wording at the end of the claim:
"by lowering and turning the grip with respect to the stick, the pin (12) is moveable beyond the cam (15) from the second region (12) to the first region (14) of the slot (9) and (10).

VI. As regards added subject-matter the Appellant argued as follows:

There is no literal basis in the original disclosure for the final feature pertaining to the cam means. Paragraph [0021] of the A-publication does not mention "means" or "narrowing". There is nothing in the claim on the location of the cam as described in paragraph [0021], which also mentions two slots, where claim 1 may have only one slot.

Most of these comments apply also to claim 1 of either auxiliary request. Claim 1 of the second auxiliary request is additionally unclear.

VII. The Respondent argued as follows:

Description and figures as filed give a clear idea of the general structure and function of the cam. Thus, the location of the cam follows from paragraph [0021] lines 44 to 46, and figures 3 to 5. Narrowing is also evident from figures 3 to 5. Figures 1 to 4 clearly show a narrowing of the slot at the cam, which can take any shape.

The particular structural context is identical for both embodiments. Their different shock absorbing members does not effect the structure or function of the activation/deactivation means. The cam feature thus has no technical relation to the other features and can be abstracted from that context.

Reasons for the Decision

1. The appeal is admissible.

2. *Background*

The patent concerns a stick with grip member mounted on the end of an elongated stick member via a shock absorber. The shock absorbing mechanism can be turned on or off by means of a pin on one member engaging in at least one slot in the other. According to claim 1 in the amended version held allowable by the opposition division a cam means is provided to narrow said at least one slot between first and second regions to so prevent it from sliding freely from the first to the second regions.

3. *Added subject-matter*

3.1 Article 123(2) EPC stipulates that a European patent (application) may not be amended in such a way that it contains subject-matter extending beyond the content of the application as filed. According to established case law it will, for example, normally not be allowable to base an amended claim on the extraction of isolated features from a set of features originally disclosed only in combination, e.g. a specific embodiment in the description, see for example decisions T 1067/97, T 714/00 or T 25/03 cited in the Case Law of the Boards of Appeal, 6th edition, 2010, III.A.2. Such an amendment results in an *intermediate generalization*, in that it further limits the claimed subject-matter, but is nevertheless directed at in an undisclosed combination of features broader than that of its

originally disclosed context, see for example T 1408/04 and T 461/05. It is justified only in the absence of any clearly recognizable functional or structural relationship among the features of the specific combination, see T 1067/97, and if the extracted feature is thus not inextricably linked with those features, see T 714/00.

- 3.2 In the present case, the feature of "cam means" was added to claim 1 during the procedure up to grant. The originally filed claims were concerned foremost with the idea of integrating the activation/deactivation means in the grip member and that the cam played no role whatsoever. A cam is mentioned only in paragraph [0021] and shown in figures 1 to 5 at reference sign 15. The passage and the figures pertain to a specific example of a mechanism for turning the stick shock absorber on and off.

Thus, in paragraph [0021] "the stick comprises two slots 9,10..." (lines 42 to 43). "Each slot 9,10 is shaped like an inverted L, with its upper ends shaped to form a cam 15" (lines 44 to 46) and "has a first region 14 for the free sliding of the pin and a second region 13 for limited sliding ... separated by the cam" (lines 46 to 49). "By lowering and turning the grip ... ,as shown schematically in Figure 2, the pin 12 is moved beyond the cam 15 from the second ... to the first region..., this position is shown in Figure 3" (column 3, line 55, to column 4, line 1). "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" (column 4, lines 14 to 18).

The original disclosure contains no other examples of a (de)activating mechanism with a cam. Description paragraph [0024] states, without further comment, that in a further embodiment (that of figure 6) activation and deactivation is by means of a "guide system ... similar" to that of the first embodiment.

- 3.3 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. Nor is there any intimation, or is it immediately and unequivocally clear to the skilled person for other reasons, that the other features - two slots, inverted L-shape, upper end placement between the legs of the L - might somehow be incidental to the on/off mechanism's proper functioning and could therefore be omitted or modified without consequences for the cam and its arrangement.

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.

3.4 Turning to claim 1 of the main and auxiliary requests, none of these define the specific cam mechanism originally disclosed. Each claim version does require that the cam means (main request) or cam (auxiliary requests 1 and 2) narrows the slot between different regions, but none identifies the specific inverted L shape of the slot, with the cam separating its two legs, the placement of the cam at the upper end of the slot, or the fact that the mechanism includes two cams, one for each slot. Auxiliary request 2 does add to claim 1 (in somewhat ungrammatical terms) features of the operation of the stick ("by lowering and turning") that appear verbatim in paragraph [0021]. However, these features at best imply that the cam projects downwardly (when the stick is in use) but fail to identify slot shape, number of cams, and their exact placement.

3.5 With regard to claim 1 of the main request, the Board adds that the term "cam means" is equivocal and implies something broader than a mere cam. It could be read as encompassing also multiple cams, provided in the at least one slot of the claim, which might be T, Z or H shaped, for example.

3.6 As a result of the amendments to claim 1 of the main and both auxiliary requests these different versions now cover a wider variety of cam on/off mechanisms, with any number of slots of various shapes and with various cam locations, than contemplated by the

originally filed application, which disclosed only the single specific mechanism described above.

- 3.7 The Board concludes that claim 1 according to the main and first and second auxiliary requests has been amended in such a way that it contains subject-matter extending beyond the content of the application as filed, Article 123(2) or 100(c) EPC. Each of these requests must fail and the patent must therefore be revoked.

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

G. Magouliotis

M. Ceyte