

Internal distribution code:

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

**Datasheet for the decision
of 22 May 2014**

Case Number: T 2500/10 - 3.2.06

Application Number: 02005064.7

Publication Number: 1238899

IPC: B62K23/04

Language of the proceedings: EN

Title of invention:
Shift control device

Patent Proprietor:
Shimano (Singapore) Private Limited

Opponent:
SRAM Deutschland GmbH

Relevant legal provisions:
EPC Art. 123(2)
RPBA Art. 13(1)

Keyword:
Late-filed argument -
adjournment of oral proceedings would have been required (no)
Amendments - allowable (no)
Prohibition of reformatio in peius (yes)



**Beschwerdekammern
Boards of Appeal
Chambres de recours**

European Patent Office
D-80298 MUNICH
GERMANY
Tel. +49 (0) 89 2399-0
Fax +49 (0) 89 2399-4465

Case Number: T 2500/10 - 3.2.06

D E C I S I O N
of Technical Board of Appeal 3.2.06
of 22 May 2014

Appellant: SRAM Deutschland GmbH
(Opponent) Romstr. 1
97424 Schweinfurt (DE)

Representative: Prechtel, Jörg
Weickmann & Weickmann
Patentanwälte
Postfach 86 08 20
81635 München (DE)

Respondent: Shimano (Singapore) Private Limited
(Patent Proprietor) 20 Benoi Sector,
Jurong Town
Singapore 629852 (SG)

Representative: GROSSE SCHUMACHER KNAUER VON HIRSCHHAUSEN
Patent- und Rechtsanwälte
Nymphenburger Strasse 14
80335 München (DE)

Decision under appeal: **Interlocutory decision of the Opposition
Division of the European Patent Office posted on
22 October 2010 concerning maintenance of the
European Patent No. 1238899 in amended form.**

Composition of the Board:

Chairman M. Harrison
Members: G. Kadner
W. Ungler

Summary of Facts and Submissions

- I. The mention of grant of European patent No. 1 238 899, on the basis of European patent application No. 02005064.7 filed on 6 March 2002 and claiming a US-priority from 9 March 2001, was published on 5 December 2007.
- II. Notice of opposition, in which revocation of the patent on the grounds of Article 100(a) EPC was requested, was filed against the granted patent.

By way of its decision posted on 22 October 2010, the opposition division found that account being taken of the amendments made by the patent proprietor during the opposition proceedings, the patent and the invention to which it related met the requirements of the Convention. Reference was made in the decision to the following documents:

E1: DE-A-27 10 391
E2: FR-B-2 210 973
E3: DE-A-40 26 058
E4: DE-A-32 15 427
E5: US-A-3 633 437
E6: EP-B-0 669 249
E7: DE-A-32 15 426

Claim 1 as found allowable by the opposition division reads (numbered according to the analysis of features presented by the appellant):

- "A shift control device (10) for a bicycle having a handlebar (12), comprising:
- a) a cylindrical base member (50) configured to be fixedly secured on the handlebar (12) in a concentric relationship to the handlebar (12) (**);

- b) a control member (30) rotatable about the radially (*) outer peripheral surface of the base member (50);
 - c) an actuating member (60)
 - c1) rotatable about the radially (*) outer peripheral surface of the base member (50),
 - c2) the actuating member (60) configured to pull and release a transmission control element;
 - d) a planetary gear assembly (40)
 - d1) comprising a stationary sun gear (42), a ring gear (44) coaxial with the sun gear (42),
 - d2) and at least one planet gear (46) being configured to rotate the actuating member (60),
 - d3) said planetary gear assembly (40) being operatively connected to the control member (39) and to the actuating member (60),
 - d4) wherein the ring gear (44) and the at least one planet gear (46) being rotatable about the radially (*) outer peripheral surface of the base member (50);
- characterized in that
- e) the stationary sun gear (42) is integrally formed on the base member (50), and
 - f) the control member (30) is configured to rotate the ring gear (44)."

III. Notice of appeal was filed against this decision by the appellant (opponent) on 17 December 2010, and the appeal fee was paid on the same day. With its grounds of appeal dated 28 February 2011, the appellant pursued its request for revocation of the patent on the grounds of Articles 123(2), 54 and 56 EPC.

IV. With its reply dated 18 July 2011, the respondent (patentee) defended the patent in the version as found allowable by the opposition division.

- V. In a communication accompanying the summons to oral proceedings, the Board expressed its preliminary view about the objections under Article 123(2) EPC, noting that this was a matter to be discussed, and to Article 84 EPC, noting that the appellant's objection seemed to relate to the derivation of the amendment rather than to clarity. Further, the Board expressed its view on novelty and its doubts about the presence of an inventive step.
- VII. With its letter of 14 April 2014 the respondent filed four auxiliary requests based on the claims as found allowable by the opposition division.
- VIII. In its submission dated 15 May 2014, the appellant objected to the newly filed request as being late filed and containing amendments resulting in subject-matter contrary to Article 123(2) EPC.
- IX. Oral proceedings were held before the Board on 22 May 2014.
- X. The appellant (opponent) requested that the decision under appeal be set aside and the European patent No. 1 238 899 be revoked.

The respondent (patentee) requested that the appeal be dismissed (main request), or that the patent be maintained in amended form on the basis of one of the 1st or 2nd auxiliary requests filed during the oral proceedings of 22 May 2014, or on the basis of one of the 3rd to 6th auxiliary requests (former 1st to 4th) filed with letter of 14 April 2014.

- XI. The claims

- i. Claim 1 according to the 1st auxiliary request is the same as that of the main request, with the exception that the word "radially" before the words "outer peripheral surface" has been deleted at the locations marked (*).

- ii. Claim 1 according to the 2nd auxiliary request is based on that of the main request, whereby after the first feature at marking (**), the following has been inserted:

"... , the base member (50) having a radially outer peripheral surface formed by the outer peripheral surface of the base member (50) along the axial extension of the base member (50)"

- iii. All of the 3rd to 6th auxiliary requests include the wording of the main request into which the features of granted claims 2 or 2 and 34 or 7 or 7 and 14, respectively, have been added.

XII. The arguments of the appellant can be summarized as follows:

As already objected in its grounds of appeal, feature d4 relating to the revolving of the at least one planet gear had been inadmissibly amended when compared with the disclosure of original claim 4 from being revolvable about the sun gear to being rotatable about the outer peripheral surface of the base member. A radially outer peripheral surface of the base member was not originally disclosed. That feature was taken only from the drawing, and the base member shown in Figs. 2, 3, 4 had no defined radially outer peripheral surface. On the contrary, the outer surface of the base member was composed of several different radially outer peripheral

surfaces and stepped portions between them having only axial surfaces. No information was present to identify about which of the radially outer peripheral surfaces the control member, the actuating member and the at least one planet gear were rotatable, since they were situated at different positions in the axial direction of the base member and had different radial extensions. They were thus distinct radial outer peripheral surfaces separated by purely axially extending surface portions. Moreover, the at least one planet gear rotatable about the sun gear as disclosed in original claim 4 could not be identified as rotating about an outer peripheral surface because the sun gear did not have such a radially outer peripheral surface, for example due to the presence of its gear teeth. At least for these reasons claim 1 did not meet the requirement of Article 123(2) EPC.

The amendment to claim 1 of the 1st auxiliary request was not admissible as being contrary to the principle of prohibition of *reformatio in peius*, because the deletion of the word "outer" in connection with "peripheral surface of the base member" broadened the scope of the claim. The same objections under Article 123(2) EPC applicable to the main request applied equally to this request.

The reformulation of claim 1 according to the 2nd auxiliary request was an amendment to the respondent's case which should not be admitted because it was not convergent with the preceding request. Additionally, the main claim suffered from the same deficiencies as claim 1 of the main request.

The above objections also applied with respect to the 3rd to 6th auxiliary requests since claim 1 of all the

respective requests included the inadmissible amendment of claim 1 according to the main request.

XIII. The respondent argued that the arguments brought forward by the appellant against claim 1 in its grounds of appeal were different from those brought forward in the oral proceedings before the Board and that the appellant's case had been changed. The objection of the relation of at least one planet gear rotatable about the sun gear and the formation of its outer surface was in fact a newly introduced objection which should not be considered as well as the argument relating to the presence of axial surfaces between the radially outer peripheral surfaces. The skilled person reading the description (A-document par. [0023] and [0024]) would also clearly recognize that the base member having a basically cylindrical shape in any case had only one radially outer peripheral surface such that the claim was anyway not inadmissibly amended. The newly asserted objections were therefore not *prima facie* relevant and should be disregarded.

The deletion of "radially" according to claim 1 of the 1st auxiliary request was not a broadening but a restriction to the definition of the outer peripheral surface and did not go against the principle of prohibition of *reformatio in peius*, since previously the claim was only restricted to the outer radial peripheral surface whereas now it was restricted to the entire surface.

Since new objections had been raised which had not been in the proceedings before, the respondent's request for continuation of the proceedings in writing should be allowed.

Although late-filed, the newly presented requests were caused by the new objections and the discussion during the oral proceedings. Thus there was no ground not to admit them into the proceedings. The 2nd auxiliary request defined more specifically the radially outer peripheral surface of the base member and was a restriction in reaction to the alleged violation of the principle of prohibition of *reformatio in peius*. At least this request should be admitted into the proceedings. The former 1st to 4th auxiliary requests were maintained as 3rd to 6th auxiliary requests.

Reasons for the Decision

1. The appeal is admissible.
2. *Request for continuation of the proceedings in writing*
 - 2.1 In support of its request for continuation of the proceedings in writing the respondent argued that the appellant had asserted new objections which were surprising for the respondent, and that it could not prepare arguments in respect of the alleged inadmissibility of feature d4. This was an amendment to the appellant's case which should not be admitted by the Board in accordance with Article 13(1) RPBA. The respondent submitted further that if the new arguments were admitted by the Board, in order to give the respondent the full right to be heard, the proceedings should be continued in writing.
 - 2.2 In its grounds of appeal the appellant had objected to the imprecise formulation of the amendment to features b), c1) and d4), and particularly relied on Article 123(2) EPC with respect to features b), c) and d) in

that a "radially outer peripheral surface" was not originally disclosed. In respect of the sun gear, the argument was that according to the originally filed claim 4 the at least one planet gear was rotatable about the sun gear whereas in claim 1 as granted the at least one planet gear was rotatable about the radially outer peripheral surface of the base member (feature d4)) which was an inadmissible amendment. In the oral proceedings before the Board the appellant argued additionally that the outside of the sun gear could not be defined as a "radially outer peripheral surface" since the tooth flanks did not have such a radially outer surface. Likewise, the appellant argued that a radially outer peripheral surface was not derivable from the application as filed because purely axial portions were present between the various outer surfaces of the member which formed the separate radial outer surfaces of the outer peripheral surface. Although these arguments were brought forward for the first time during the oral proceedings, the Board does not see any new objection being made, but merely a more detailed explanation of its objections by way of argument in respect of the objections made to multiple inadmissible amendments. The new arguments were asserted under the same Article 123(2) EPC as in the grounds of appeal, and can implicitly already be recognized therein, even if the objection was nominally placed within the context of a lack of clarity (see e.g. page 5 of the grounds of appeal). Indeed, in the Board's communication issued prior to oral proceedings under item 3, the Board had stated that the objection under lack of clarity appeared to relate to the derivation of the amendment.

2.3 Therefore the Board concludes that raising an additional argument under Article 123(2) EPC, which already formed the legal and factual framework of the appeal, did not

result in an amendment to the party's case in a way which violated the other party's right to be heard. Indeed, if not already from the grounds of appeal, at the latest upon receipt of the Board's communication, the respondent could have been expected to address the objection in oral proceedings even if new arguments were made in the oral proceedings to support and further explain the objection already made in this regard. For these reasons the respondent's request for adjournment and continuation of the proceedings in writing was rejected.

3. *Main request (Article 123(2) EPC)*

3.1 When compared with claim 1 as granted, claim 1 as found allowable by the opposition division includes the wording "the radially outer peripheral surface of (the base member)" which was inserted (at three positions in the claim) in relation to the control member (30), an actuating member (60) and the ring gear (44) and the at least one planet gear (46) being rotatable about this surface. No written disclosure of this amended feature is present in the patent as granted or in the application as filed, neither in the description nor in the claims. It was, according to the respondent, particularly to be derived from the embodiments shown in Figs. 2, 3 and 4.

3.2 The respondent argued that the skilled person would clearly recognize in these Figures that the base member was of a generally cylindrical shape which had an inner radial surface and an outer radial surface, and that the elements 30, 60, 44 and 46 were arranged to be rotatable about that cylindrical outer surface. However, the Board notes that the skilled person does not only recognize a cylindrical body but a body which has specific

dimensions and which has an outer periphery composed of radial surfaces having different radial extents with stepped portions therebetween. In any case, no (single) "radially outer peripheral surface" is disclosed, but instead an outer peripheral surface with specific radial surface portions about which specific respective elements are rotatable. Therefore the amendment as formulated in the claim in such a general form is not clearly and unambiguously derivable from the Figures. Nor could any other part of the application as filed be identified from where this particular amendment could unambiguously be derived. The definitions in claim 1 are thus found to result in an inadmissible intermediate generalisation of a specific shape of the base member disclosed. The amendment thus results in subject-matter contravening the requirement of Article 123(2) EPC.

4. *First auxiliary request (reformatio in peius; Article 123(2) EPC, Article 13(1) RPBA)*
- 4.1 According to Article 114(2) EPC 1973 the European Patent Office may disregard facts or evidence which are not submitted in due time by the parties concerned. In Article 13(1) of the Rules of Procedure of the Boards of Appeal (RBPA) it is stated that it is within the Board's discretion to admit and consider any amendment to a party's case after it has filed its grounds of appeal or reply. The discretion shall be exercised inter alia in view of the complexity of the new subject-matter submitted, the current state of the proceedings and the need for procedural economy. According to the established case law of the Boards of Appeal a late filed request should, not least for reasons of procedural economy, normally only be admitted into the proceedings if it overcomes all deficiencies and appears *prima facie* allowable.

4.2 In claim 1 of the request, with respect to claim 1 of the main request, the word "radially" in connection with the term "outer peripheral surface of (the base member)" has been deleted. This does not mean a restriction of the scope of the claim as asserted by the respondent. On the contrary, the deletion of "radially" means an extension by removal of an existing restriction, since not only the radial arranged surfaces of the control member are claimed but the whole outer peripheral surface including surfaces in axial direction. Thus, the restriction concerning the specific location about which the parts are rotatable is no longer present. This request is at least not allowable for the reason of being contrary to the principle of prohibition of *reformatio in peius*.

4.3 Further, in respect of Article 123(2) EPC the same problem arises as with the main request because the "outer peripheral surface of the base member" is a still more generalized form of the functional specific shape of the base member which again is not clearly and unambiguously derivable from the Figures or any other part of the originally filed application, such that this request does not overcome the deficiencies of the main request.

4.4 Since this request was clearly not allowable, the Board exercised its discretion under Article 13(1) RPBA not to admit the request into the proceedings.

5. *Second auxiliary request (Article 123(2); Article 13(1) RPBA)*

5.1 The insertion of the term "the base member (50) having a radially outer peripheral surface formed by the outer peripheral surface of the base member (50) along the

axial extension of the base member (50)" into claim 1 of the main request does specify in more detail the radially outer peripheral surface of the base member. It is clear that a radially outer surface of a cylindrical body will extend along the axial extension as seen from one end or the other. However, no more detailed definition of the specific shape or functional arrangement of the base member in relation to the elements 30, 60, 44 and 46 being rotatable about that cylindrical outer surface is given by the inserted wording. The contravention in the main request against Article 123(2) EPC is therefore not removed.

5.2. Thus the Board again exercised its discretion under Article 13(1) RPBA not to admit the request into the proceedings.

6. *Third to sixth auxiliary requests (Article 123(2) EPC)*

6.1 All respective claims 1, although filed within the term before the oral proceedings set by the Board in its communication (albeit that some of the completely written out versions of the requests only reached the Board at a later date), include the wording of claim 1 of the main request, in particular the expression "radially outer peripheral surface of the (base member)". As explained above (point 3.2) the insertion of this feature results in subject-matter which does not meet the requirement of Article 123(2) EPC. None of the additional wording in these requests alters the aforementioned conclusion, nor was it argued by the respondent that it did.

6.2 Thus, none of these requests, regardless of a consideration as to whether they can be admitted into the proceedings, is allowable.

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:



M. H. A. Patin

M. Harrison

Decision electronically authenticated