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Datasheet for the decision of 23 May 2014

Case Number: T 2501/10 - 3.2.06

Application Number: 03000346.1

Publication Number: 1327576

IPC: B62M25/04, B62K23/06

Language of the proceedings: EN

Title of invention:
Bicycle shift operating device for bicycle transmission

Patent Proprietor:
SHIMANO INC.

Opponent:
SRAM Deutschland GmbH

Relevant legal provisions:
RPBA Art. 12(2), 13(1), 13(3)
EPC Art. 123(2)

Keyword:
Late-filed request (main request) -
justification for late filing (no) - (main request)
Amendments - allowable (no) - (first auxiliary request)
Late-filed request -
adjournment of oral proceedings would have been required (yes) - (second auxiliary request)

Decisions cited:
T 0253/06, T 2422/09

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Case Number: T 2501/10 - 3.2.06

D E C I S I O N
of Technical Board of Appeal 3.2.06
of 23 May 2014

Appellant: (Opponent)	SRAM Deutschland GmbH Romstr. 1 97424 Schweinfurt (DE)
Representative:	Prechtel, Jörg Weickmann & Weickmann Patentanwälte Postfach 86 08 20 81635 München (DE)
Respondent: (Patent Proprietor)	SHIMANO INC. 3-77 Oimatsu-cho Sakai-ku, Sakai City Osaka 590-8577 (JP)
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 19 October 2010 concerning maintenance of the European Patent No. 1327576 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. 1 327 576, on the basis of European patent application No. 03000346.1 filed as divisional application on 9 January 2003 and claiming a US-priority from 10 January 2002, was published on 8 October 2008.

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. During the opposition proceedings the opponent filed further documents E7, E8 (see below) and relied additionally on the ground for opposition according to Article 123 EPC.

By way of its decision posted on 19 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: US-A-5 222 412
E2: EP-B-0 671 317
E3: EP-B-0 790 175
E4: DE-C-44 09 251
E5: US-A-3 901 095
E6: EP-B-0 744 334
E7: EP-A-0 472 739
E8: EP-A-0 361 335

Claim 1 as found allowable by the opposition division reads:

"A bicycle shift operating device (20, 22), comprising:

a first operating member (60, 160) that is arranged to reciprocate in a first direction;
a cable winding mechanism (26, 126) mounted on a first pivot axle (40) at a first fixed location and configured to be selectively retained in one of a plurality of shift positions; and
an operating link (64, 164) having a first end coupled to said first operating member (60, 160), said operating link being operatively coupled to said cable winding mechanism (26, 126) to rotate said cable winding mechanism (26, 126) about a first pivot axle (40) between said shift positions in response to movement of said operating member (60, 160),
wherein the first end of the operating link (64, 164) is pivotally coupled to said first operating member (60, 160) and a second end is mounted on said first pivot axle (40) on a first fixed location, and the bicycle shift operating device (20, 22) further comprises a follower link (66, 166) having a first end pivotally coupled to said first operating member (60, 160) and a second end mounted on a second pivot axle (42) at a second fixed location,
characterized in that
said cable winding mechanism (26, 126) includes a cable winding member (52, 152) and a ratchet member (54, 154) mounted on said first pivot axle (40) and
a locking member (84, 184) is operatively engaged with said ratchet member (54, 154) to hold said cable winding member (52, 152) in one of said plurality of shift positions, and
a second operating member (62, 162) is arranged to disengage said locking member (84, 184) from said ratchet member (54, 154)."

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.

IV. With its reply to the appeal dated 17 August 2011 the respondent (patentee) filed an amended main request.

V. In a further submission dated 12 April 2012 the appellant objected to the respondent's new request, based on Articles 123(2), 84 and 56 EPC.

VI. With submissions dated 21 June 2012 (respondent) and 13 December 2012 (appellant) the parties filed further arguments.

VII. In a communication accompanying the summons to oral proceedings, the Board expressed its preliminary view that it did not agree with the appellant's objection under Article 84 EPC but that the new request seemingly gave rise to objections under Article 123(2) EPC.

VIII. With its letter dated 17 April 2014 the respondent filed three groups of amended requests, each of them based on the claims as found allowable by the opposition division and comprising a main request and auxiliary requests.

IX. In its facsimile dated 19 May 2014 the appellant again objected to the new requests as late-filed and not overcoming the existing problems of inadmissible extension.

X. With its facsimile dated 19 May 2014 the respondent requested, as a new main request, dismissal of the appeal such that the decision of the opposition division became final, and maintained the three groups of requests filed on 17 April 2014 as auxiliary requests.

XI. Oral proceedings were held before the Board on 23 May 2014.

The appellant (opponent) requested that the decision under appeal be set aside and the European patent No. 1 327 576 be revoked.

The respondent (patent proprietor) requested that the appeal be dismissed (main request), or that the patent be maintained in amended form on the basis of the 1st or 2nd auxiliary requests filed during the oral proceedings of 23 May 2014.

XII. The claims

i. Claim 1 according to the main request corresponds with that as found allowable during opposition proceedings (par. II above).

ii. Claim 1 according to the 1st auxiliary request is based on claim 1 of the main request, with the following amendments:

in the last pre-characterizing feature the underlined text has been inserted:

"... and a second end mounted on a second pivot axle <u>in the form of a secondary fixing bolt</u> (42) at a second fixed location"

and at the end of the claim, the following has been added:

"... wherein the second operating member (62) is slidably and pivotally mounted on the secondary fixing bolt (42)."

iii. Claim 1 according to the 2nd auxiliary request is based on claim 1 of the first auxiliary request (added features underlined) and reads:

"A bicycle shift operating device (20, 22), comprising:
a first operating member (60, 160) that is arranged to reciprocate in a first direction;
a cable winding mechanism (26, 126) mounted on a first pivot axle in the form of a main fixing bolt (40) at a first fixed location and configured to be selectively retained in one of a plurality of shift positions;
an operating link (64, 164) having a first end coupled to said first operating member (60, 160), said operating link being operatively coupled to said cable winding mechanism (26, 126) to rotate said cable winding mechanism (26, 126) about said first pivot axle (40) between said shift positions in response to movement of said operating member (60, 160), and
a mounting assembly (24) including a main mounting portion (32), a base plate (34), an intermediate plate (36) and a lever retaining plate (38),
wherein the first end of the operating link (64, 164) is pivotally coupled to said first operating member (60, 160) and a second end is mounted on said first pivot axle (40) on a first fixed location, and the bicycle shift operating device (20, 22) further comprises a follower link (66, 166) having a first end pivotally coupled to said first operating member (60, 160) and a second end mounted on a second pivot axle in the

form of a secondary fixing bolt (42) at a second fixed location,

wherein the base plate (34), the intermediate plate (36) and the lever retaining plate (38) are fixedly coupled to the main mounting portion (32) by the main fixing bolt (40) and the secondary fixing bolt (42) to form a shift operating device housing,

wherein said cable winding mechanism (26, 126) includes a cable winding member (52, 152) and a ratchet member (54, 154) mounted on said first pivot axle (40) and

a locking member (84, 184) is operatively engaged with said ratchet member (54, 154) to hold said cable winding member (52, 152) in one of said plurality of shift positions, and

a second operating member (62, 162) is arranged to disengage said locking member (84, 184) from said ratchet member (54, 154),

wherein the second operating member (62) is slidably and pivotally mounted on a spacer (63) that is mounted on the secondary fixing bolt (42) between the second operating member (62) and the follower link (66), in that the second operating member (62) includes an elongated opening (62a) which has an upper end of the spacer (63) received therein,

the second operating member (62) further includes an actuating flange (62b) and a release flange (62c),

wherein the release flange (62c) is received in a guide opening ($36a_4$) of the intermediate plate (36) to control movement of the second operating member (62) together with the spacer (63), the spacer (63) being fixed."

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

The new main request should not be admitted into the proceedings because it was not only filed very late – three days before the oral proceedings – but also surprising at this stage of the proceedings. It could have been filed already with the reply to the appeal in accordance with Article 12(2) of the Rules of Procedure of the Boards of Appeal (RPBA) but was not, and no reason was given for the late filing after already having filed three groups of requests in the form of a main and two auxiliary requests some weeks before the oral proceedings including ten new main claim variants. The appellant's arguments against patentability of the newly claimed subject-matter had already been presented together with the grounds of appeal and no counter-arguments of the respondent had been filed. The new request was anyway not *prima facie* allowable and should not be admitted under Article 13 RPBA.

Claim 1 according to the 1st auxiliary request was not allowable having regard to Article 123(2) EPC. The added features had been taken only from the description and were isolated out of their disclosed relationship to further features which were necessary to give a complete teaching. Particularly the last feature was only a functional feature, and the claim did not comprise the structural features in order to solve a technical problem.

The 2nd auxiliary request was also late-filed and contained additional features taken from the description. In order to deal thoroughly with the new request, an additional search was necessary. No explanation or reason had been given by the respondent as to whether the added features caused new technical effects or whether the original problem to be solved was still valid. Therefore this request was also not *prima*

facie allowable and should not be admitted under Article 13 RPBA. Moreover, the added features had been isolated out of their disclosed relationship to other features, particularly with respect to the elongated opening of the second operating member. An elongated opening 6a as such was anyway known from E3 (Fig. 4) and thus did not support the respondent's arguments on inventive step. Since a position of this opening was not defined, the omission of the path or movement of the second operating member to be achieved (A-document par. [0045]) led to an inadmissible intermediate generalisation compared to the content of the application as filed. Therefore the request did not meet the requirement of Article 123(2) EPC.

XIV. The respondent argued that the new main request, although filed late, should be admitted into the proceedings for reasons of procedural economy. The subject-matter claimed had already been in the proceedings during opposition so it was not complex, and this request would overcome all problems in respect of lack of original disclosure which had been recognized only after the Board's communication. Admissibility of the amendments and novelty of the subject-matter of claim 1 had already been acknowledged by the appellant during the oral proceedings in opposition. The only remaining issue was inventive step, and the appellant could reasonably be expected to deal with this question.

Claim 1 according to the 1st auxiliary request comprised the required features for the problem to be solved. The skilled person was well aware which features were necessary for a complete solution and would not need the unessential features in any detail since they formed part of the skilled person's common general knowledge.

Claim 1 according to the 2nd auxiliary request had been presented in reaction to the submissions during the oral proceedings, and therefore it could not have been filed earlier. The added features had already been known since the filing of the reply to the appeal dated 17 August 2011. It was evident to the skilled person that the problem to be solved had not been changed, this being the provision of a shift operating device where the operating direction was ergonomically adapted to the movement of the operator. The path of the second operating member was implicitly defined by the features disclosed in par. [0044], and was also sufficient to give a complete teaching. The device disclosed in E3 had no elongated opening but only a groove, and did not allow a slidable and pivotal movement of the respective lever. The claimed solution was therefore not rendered obvious by any prior art document on file.

Reasons for the Decision

1. The appeal is admissible.

2. *Main request (Articles 12(2) and 13(1) RPBA)*

2.1 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.

2.2 According to Article 12(2) RPBA the statement of grounds of appeal and the reply shall contain a party's complete case and should inter alia specify expressly all the facts, arguments and evidence relied on. In its reply of 17 August 2011 the respondent did not request dismissal of the appeal but instead requested, as its new main request, that the patent be maintained with amended

claims as annexed (claim set entitled GSKH-1). In that regard it is noted that the scope of the independent claim 1 of the amended main request was limited by addition of two features. Furthermore, the respondent's arguments dealt exclusively with the newly claimed subject-matter, i.e. without giving counterarguments to the comprehensive and detailed objections as regards novelty and inventive step contained in the statement of grounds of appeal.

2.3 In reaction to the Board's communication accompanying the summons to oral proceedings, within the term set by the Board on 17 April 2014, the respondent filed new requests consisting of three groups. The first group was annexed to the letter; the obviously (by mistake) missing sets of claims for the second and third groups were received at the European Patent Office on 28 April 2014. With these new requests the respondent addressed a problem under Article 123(2) EPC raised in the Board's communication (in which it was indicated, with respect to the former main request, that the isolation of only one feature out of the context in which it was disclosed was likely to result in a finding of an inadmissible intermediate generalisation).

2.4 With its facsimile received at the EPO on 19 May 2014 at 17:51 h, i.e. three working days before the date of the oral proceedings, the respondent requested, for the first time, dismissal of the appeal. No ground was given supporting the late filing and no counterarguments defending the independent claim 1 against the appellant's comprehensive and detailed objections in particular as regards inventive step filed with its statement of grounds of appeal against the claims as found allowable by the opposition division were presented.

2.5 During the oral proceedings before the Board, the respondent argued that the claims had been known and available to the other party since the opposition proceedings and were the underlying claims for the decision under appeal, and therefore the request could be dealt with easily and in a time-efficient manner, so that the Board and the appellant could be expected to deal with the request in the oral proceedings before the Board.

2.6 Under Article 13(1) of the Rules of Procedure of the Boards of Appeal (RBPA) the Board has 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 request which is filed at a late stage of proceedings should as a rule only be admitted into the proceedings if it overcomes all deficiencies and appears *prima facie* allowable. Furthermore, it should be considered whether there is a proper justification for its late filing so as to forestall procedural abuse.

2.7 According to the case law of the Boards of Appeal such late filed requests should normally not be admitted into the proceedings if they are not substantiated, i.e. not accompanied by reasons explaining why the amendments had been made and how they are intended to overcome the objections raised in the course of the proceedings (cf. T 253/06, T 2422/09). Amended claims filed at such a late stage should also be clearly allowable in the sense that it can be quickly ascertained that they overcome

all outstanding issues. This approach holds true, all the more so, if such an unsubstantiated request is filed – as in the present case - only shortly before the oral proceedings.

2.8 As noted above, the new main request was filed at a very late stage of proceedings and was not substantiated in the sense that no explanation was given supporting the late filing and no counterarguments defending claim 1 against the appellant's detailed objections filed with its statement of grounds of appeal against the claims as found allowable by the opposition division were presented. In its submissions on inventive step in relation to this (new) main request, the respondent indeed did not deal with the specific objections and arguments raised by the appellant. Consequently the new request could not be regarded as *prima facie* allowable, at least in the sense that it could be quickly ascertained that it overcame the detailed inventive step objections as raised by the appellant in its statement of grounds. On the contrary, the Board was faced with an entirely new case shortly before the oral proceedings in defence of an amended form of patent which did not deal with the appellant's arguments.

2.9 Furthermore, in the oral proceedings, the respondent justified the filing of the request at such a late stage by stating that it had been filed in order to overcome the objections under Article 123(2) EPC raised by the appellant and contained in the Board's communication accompanying the summons to oral proceedings. However, the Board finds that the respondent's justification for the filing of the new request at such a late stage is not acceptable, because the Board's preliminary view – expressed in the aforementioned communication - that the claimed subject-matter had no basis in the application

as originally filed, corresponded in essence to the objections raised already by the appellant in its letters dated 12 April 2012 and 13 December 2012. Moreover, it cannot be overlooked that the respondent decided to react to the Board's communication by filing three groups of requests (received by the EPO on 17 April 2014 and 28 April 2014 respectively, i.e. within the term or - due to an obvious error - some days after the term fixed by the Board), and did not request dismissal of the appeal at that point in time.

2.10 Thus, in the absence of any sound reason for the filing of the new request at such a late stage, and also in view of the fact that the request was neither substantiated nor *prima facie* allowable the Board exercised its discretion under Article 13(1) RPBA not to admit the main request into the proceedings.

3. *First auxiliary request (Article 123(2) EPC)*

3.1 The first auxiliary request corresponds to the former main request filed together with the reply to the appeal. Therefore the Board finds no reason not to admit it into the proceedings merely due to its renumbering.

3.2 However, in its communication the Board had indicated, with respect to claim 1, that a "second operating member" or its function is not disclosed in the general portion of the description but only in the context of a preferred embodiment (paragraph [0044]).

Irrespective of the meaning of the word "basically" in its context, the elongated opening 62a might indeed be a necessary requirement for the slidably and pivotal movement of the second operating member on the secondary fixing bolt, and therefore it would appear that the

isolation of only one feature isolated out of the context as disclosed results in an inadmissible intermediate generalisation.

3.3 According to the description of a specific embodiment (A-document par. [0044]) "the second operating member 62 is slidably and pivotally mounted on the secondary fixing bolt 42". "The second operating member 62 basically includes an elongated opening 62a, an actuating flange 62b and a release flange 62c".

The first feature merely indicates a functional mounting without a complete reference to the structural interrelationship of the elements required, whereas the second one is a structural feature which is necessary to allow the desired function. By omitting this structural feature out of the context in which it is disclosed, subject-matter is claimed which is not disclosed in that general form. This intermediate generalisation of the originally disclosed subject-matter is therefore not admissible with respect to Article 123(2) EPC.

The respondent's argument that only the elements required for carrying out the invention had been included is not accepted. The disclosure in paragraph [0044], which is the disclosure upon which the respondent relies for the amendment, albeit that it is presented in a separate sentence, does not disclose unambiguously to a skilled person that the other features mentioned in the same context are not to be understood in combination therewith. Indeed, the features following the introduced features are (at least part of) those features which provide the desired movement. The respondent's reference to paragraph [0020] also does not alter the Board's finding on this matter, since this does not involve the same wording and is anyway itself merely a reference to

what is shown in the Figures and elucidated in [0044], i.e. requiring still further features.

The first auxiliary request is therefore not allowable.

4. *Second auxiliary request (Article 123(2) EPC; Articles 13(1), 13(3) RPBA)*

4.1 The second auxiliary request was filed during the oral proceedings. All the amendments made to claim 1 (see XII. iii. above) are taken from the description (A-document par. [0020], [0044]).

4.2 The appellant objected to claim 1, on the basis that although the second operating member was defined in more detail, the orientation and shape of the elongated opening 62a was not sufficiently clearly defined so as to solve a technical problem. An elongated opening alone would not give a teaching of its motion when operated in the desired ergonomic direction, because the desired effect was dependent on its position and its direction within the second operating member. By adding such a number of amended features it was not clear in which interrelation they co-acted with the former features and whether the original problem to be solved was even still correct. The number of amendments had led to such complexity that the request should not be admitted into the proceedings.

4.3 The Board notes that the filing of a new request at a late stage of proceedings as such is not necessarily a ground not to admit it into the proceedings. However, from the addition of all the new features which had not been searched before, it follows that the respondent has presented a new case with inherent high complexity. In view of the number of amendments, the Board, at that

stage of the proceedings, was not in a position to be able to compare the newly claimed subject-matter with the disclosure of the prior art documents on file and then provide the necessary analysis of the matter, not least because no complete argumentation in respect of inventive step had been presented, let alone regarding the presence of an elongated opening in the second operating member as claimed. Therefore the Board exercised its discretion not to admit this request into the proceedings with respect to Article 13(1) RPBA as it was not clearly allowable nor procedurally economic to do so.

4.4 Also under Article 13(3) RPBA, the new request could not be admitted into the proceedings because it could not reasonably be expected that the appellant could deal with such new subject-matter without first giving the appellant the opportunity to carry out an additional search, which was not possible without adjournment of the oral proceedings. Otherwise, the appellant's right to be heard would have been compromised.

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