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**Datasheet for the decision
of 9 January 2018**

Case Number: T 0660/14 - 3.2.06

Application Number: 07023176.6

Publication Number: 2065298

IPC: B62M25/04

Language of the proceedings: EN

Title of invention:
Bicycle control device

Patent Proprietor:
SHIMANO INC.

Opponent:
SRAM, LLC

Headword:

Relevant legal provisions:

EPC Art. 123(2)
EPC 1973 Art. 54, 84
RPBA Art. 13(1)

Keyword:

Novelty - main request (no), auxiliary requests 1 to 3 (no)
Late-filed auxiliary requests - admitted (no)
Undisclosed disclaimer (yes), technical contribution and
qualitative change (yes), see Reasons 5.1.3 to 5.1.8

Decisions cited:

G 0001/16

Catchword:



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Case Number: T 0660/14 - 3.2.06

D E C I S I O N
of Technical Board of Appeal 3.2.06
of 9 January 2018

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Decision under appeal: **Interlocutory decision of the Opposition
Division of the European Patent Office posted on
17 February 2014 concerning maintenance of the
European Patent No. 2065298 in amended form.**

Composition of the Board:

Chairman	M. Harrison
Members:	M. Hannam
	J. Hoppe

Summary of Facts and Submissions

I. Appeals were filed by both the appellant (opponent) and the appellant (proprietor) against the interlocutory decision of the opposition division in which it found that European patent No. 2 065 298 in an amended form met the requirements of the EPC.

II. The appellant (opponent), hereafter simply 'opponent', requested that the decision be set aside and the patent be revoked.

The appellant (proprietor), hereafter simply 'proprietor', requested that the decision be set aside and the patent be maintained according to a main request or, in the alternative, that the patent be maintained according to one of auxiliary requests 1 to 4.

III. The following documents, referred to by the opponent in its grounds of appeal, are relevant to the present decision:

D1a US-A-2006/0207375
D3 EP-A-1 955 937

IV. With letter of 13 October 2017 the proprietor filed an auxiliary request 5.

V. Subsequent to its summons to oral proceedings, the Board issued a communication containing its provisional opinion, in which it indicated *inter alia* that the subject-matter of claim 1 of the main request appeared to lack novelty as did that of auxiliary requests 1 to 3. Also in its opinion, the subject-matter of claim 1 of auxiliary request 4 was considered not to meet the

requirement of Article 123(2) EPC.

VI. With letter of 7 December 2017 the proprietor filed auxiliary requests 4 to 7 replacing auxiliary requests 4 and 5 previously on file.

VII. Oral proceedings were held before the Board on 9 January 2018, during which the proprietor filed a replacement auxiliary request 4 and withdrew auxiliary requests 5 and 6.

At the end of the oral proceedings, the final requests of the parties were as follows:

The opponent requested that the decision under appeal be set aside and the European patent be revoked.

The proprietor requested that:

- the decision under appeal be set aside and the patent be maintained according to the main request filed with the grounds of appeal,

- auxiliarily that the patent be maintained based on the auxiliary requests 1 or 2 in the given order, filed with the grounds of appeal,

- as a third auxiliary request, to dismiss the appeal of the opponent,

- auxiliarily to maintain the patent based on auxiliary request 4 as filed during the oral proceedings,

- auxiliarily to maintain the patent based on auxiliary request 7 filed with letter dated 7 December 2017 or to

remit the case to the opposition division to continue examination of the opposition based on auxiliary request 7.

VIII. Claim 1 of the main request reads as follows:

"A bicycle control device (12) comprising:
a base member (36);
a shift control unit (SU) movable in a first direction and a second direction;
an operating member (41) operatively coupled to the shift control unit, the operating member (41) being movably coupled relative to the base member (36) to move along a shift operating path (SP) from a rest position (RP) to a first shift position for causing a movement of the shift control unit in the first direction,
the operating member (41) being further movably coupled relative to the base member to move along a brake operating path (BP) for performing a braking operation, the operating member being configured to perform a wire pulling operation, a wire release operation and a braking operation, the brake operating path being non-coincident with the shift operating path, and the operating member (41) having a finger contact portion (41b) configured and arranged for operating the operating member along said brake operating path, characterized in that
the operating member (41) is movably coupled relative to the base member (36) to move along the shift operating path from the rest position to a second shift position for causing a movement of the shift control unit in the second direction, wherein the first shift position is located between the rest position and the second shift position."

Claim 1 of auxiliary request 1 reads as claim 1 of the main request with the following features appended:

"further comprising a control member (40) including a first portion (71) operatively coupled to the shift control unit (SU) and a second portion (72) engaged with the operating member (41), the second portion (72) of the control member being biased toward the operating member."

Claim 1 of auxiliary request 2 reads as claim 1 of auxiliary request 1 with the following features appended:

"wherein the operating member (41) and the control member (40) are arranged to be pivotable about parallel and/or offset axes along said brake operating path."

Claim 1 of auxiliary request 3 also reads as claim 1 of auxiliary request 1 with the following features appended:

"wherein the operating member (41) and the control member (40) are arranged to be pivotable about offset axes along said brake operating path."

Claim 1 of auxiliary request 4 further reads as claim 1 of auxiliary request 1 with the following features appended:

"wherein the operating member (41) and the control member (40) are arranged to be pivotable about non-common offset axes along said brake operating path, wherein the operating member and the control member are not pivotable commonly about either of said offset axes."

Claim 1 of auxiliary request 7 reads as follows:

" A bicycle control device (12) comprising:

a base member (36);

a shift control unit (SU) movable in a first direction and a second direction, , the shift control unit (SU) being pivotally mounted to the base member about an axle (44) defining an operational axis of the shift control unit;

an operating member (41) operatively coupled to the shift control unit, the operating member (41) being movably coupled relative to the base member (36) to move along a shift operating path (SP) from a rest position (RP) to a first shift position for causing a movement of the shift control unit in the first direction,

the operating member (41) being further movably coupled relative to the base member to move along a brake operating path (BP) for performing a braking operation, wherein the operating lever (41) pivots about a pivot pin (45) between the rest position and a braking position along the brake operating plane (BP), the operating member being configured to perform a wire pulling operation, a wire release operation and a braking operation, the brake operating path being non-coincident with the shift operating path, and the operating member (41) having a finger contact portion (41b) configured and arranged for operating the operating member along said brake operating path,

characterized in that

the operating member (41) is movably coupled relative to the base member (36) to move along the shift operating path from the rest position to a second shift position for causing a movement of the shift control unit in the second direction, wherein the first shift

position is located between the rest position and the second shift position,
further comprising a control member (40) including a first portion (71) operatively coupled to the shift control unit (SU) and a second portion (72) engaged with the operating member (41), the second portion (72) of the control member being biased toward the operating member,
wherein the operating member (41) and the control member (40) are arranged to be pivotable about offset axes along said brake operating path,
- the first portion (71) being pivotally connected to the shift control unit SU about the axle (44) to operate the shift control unit SU when the operating lever (41) is operated along the shift operating plane or path (P1),
- the second portion (72) being spaced from the first portion (71) and contacting a rear surface of the operating lever (41), wherein the operating lever is slidably engaged with the second portion (72) such that the second portion is moved when the operating lever is moved along the non-shift operating path BP with sliding contact therebetween and when the operating lever is moved along the shift operating path P1 with sliding contact therebetween,
- the movement of the operating lever (41) from the rest position to the braking position results in the second portion (72) of the control member (40) also being pivoted along the non-shift (brake) operating plane BP about a hinge (73),
wherein the hinge pin (73) pivotally interconnects the first and second portions (71, 72) together, and a biasing element (74) is mounted on the hinge pin (73) to urge the second portion (72) forwardly with respect to the first portion (71) to a rest position."

IX. The proprietor's arguments may be summarised as follows:

Regarding the main request, the subject-matter of claim 1 was novel. In D3, the shift control unit was to be considered as part 45. The movement of the operating member (i.e. the brake lever) from the rest position to a first shift location did not cause a movement of the shift control unit in the first direction, this only occurring on release of the lever back to the rest position. In order to anticipate claim 1, D3 would have to disclose a first shift position which was a clearly identifiable, single position, which was not the case. The first shift position was furthermore not disclosed in D3 since the combined braking and shifting movement of the lever 9 described a sphere, thus defining a range of possible first shift positions rather than the claimed single first shift position. Claim 1 was therefore also a selection invention since the claimed first shift position was a sub-range of the continuum of positions adoptable by the lever 9 of D3.

As regards auxiliary request 1, D3 failed to disclose the second portion of the control member being engaged with and biased toward the operating member. The claimed expression required a continual contact between the second portion and the operating member, which was not the case in D3.

Regarding auxiliary request 2, the expression 'parallel along said brake operating path' should be interpreted as the two axes being parallel and passing perpendicularly through the plane in which the brake lever moved when operated. Claim 1 clearly required the operating member and the control member to be individually pivotable only about their separate,

albeit parallel or offset, axes. As regards the alleged pivoting about pin 32, this was only the case for the rocker arm 54 if the referential system were different to that of rotation of the lever 9 about the axis X1, which was not possible with the wording of claim 1. The same arguments applied to auxiliary request 3.

The subject-matter of claim 1 of auxiliary request 4 found basis in a combination of claims 1, 2 and 7 with paragraphs [0012], [0013] and [0041] of the description. An alternative basis could be found by considering the alleged undisclosed features as either one or two undisclosed disclaimers. The disclaimed feature/features provided no technical contribution to the claimed device, and had no real meaning apart from excluding an incorrect interpretation of claim 1, such that the requirements for disclaimers to be allowed under Article 123(2) EPC as mentioned in G1/16 were fulfilled.

Auxiliary request 7 should be admitted. The features added to claim 1 were taken from paragraph [0037]. All structurally and functionally related features were included. The projection 72a, aimed at reducing frictional forces, presented a solution to its own technical problem and thus did not need to be included in claim 1.

X. The opponent's arguments may be summarised as follows:

The subject-matter of claim 1 of the main request lacked novelty with respect to D3. With reference to paras. [0087] to [0089] it was evident that the lever 9 had to be moved into a position between the rest and second position in order to instigate the cable release rotation of the gear wheel 45. As to whether a brake

operation was being performed when the lever was being moved to a first shift position, this did not change the way in which the gear wheel 45 moved in the first and second directions. Also, there was no requirement in the claim that the gear changing operation had a movement which was fully independent of the braking operation movement. The gear shift of the patent was also detailed in D1a and functioned identically to that in D3, such that novelty had to be lacking.

As regards auxiliary request 1, the terms 'engaged with' and 'biased toward' did not imply permanent contact, such that novelty of the subject-matter of claim 1 was also lacking here.

Regarding auxiliary request 2, taking the proprietor's interpretation of 'parallel ... along said brake operating path', axes X1 and 32 of D3 anticipated the feature added to claim 1. The same was true for the expression 'offset ... along said brake operating path' in claim 1 of auxiliary request 3.

Auxiliary request 4 should not be admitted. Claim 1 *prima facie* lacked basis (Article 123(2) EPC), since the application as filed failed to disclose non-common offset axes. An undisclosed disclaimer could also not be used since the disclaimed feature provided a technical contribution in the application as filed. G1/16 stated that under such circumstances, use of a non-disclosed disclaimer was not allowed.

Auxiliary request 7 should not be admitted since the subject-matter of claim 1 did not meet the requirement of Article 123(2) EPC, at least the projection 72a being structurally and functionally disclosed in combination with those features adopted into claim 1.

Dependent claims 3 and 4 were also unclear (Article 84 EPC) since they included features related to claim 1 without a clear antecedent for them in claim 1.

Reasons for the Decision

1. *Main request*

1.1 *Novelty (Article 54 EPC 1973)*

The subject-matter of claim 1 lacks novelty with respect to D3.

- 1.1.1 The sole feature of claim 1 held by the proprietor not to be known from D3 is the existence of a first shift position of the operating member for causing a movement of the shift control unit in the first direction.

In this regard, the proprietor's argument that in D3 the movement of the operating member from the rest position to the first shift position fails to cause a movement of the shift control unit in the first direction is not accepted. Firstly it is noted that the Board finds, and the proprietor concurred, the claimed shift control unit to be the gear wheel 45 in D3. With reference to paragraphs [0089] to [0098] and Figures 5 to 10 of D3, when the lever 9 is 'pushed softly' by the cyclist (see paragraph [0090]) and subsequently released to return to its rest position (see paragraph [0095]), the gear wheel 45 undergoes movement in a first direction (a clockwise rotation in Figures 5 to 10) corresponding to a release of the traction cable 20. The consequence of the lever 9 being 'pushed softly', i.e. into a first shift position, is thus

that, upon its release, the shift control unit 45 moves in a first direction. The movement of the lever 9 to this first shift position thus has the causal effect of the gear wheel 45 moving in the first direction such that the claimed feature of the 'operating member ... being movably coupled ... to move along a shift operating path from a rest position to a first shift position for causing a movement of the shift control unit in the first direction' is disclosed in D3.

1.1.2 The proprietor's argument that the first shift position must be a clearly identifiable, single position in D3 in order to anticipate claim 1 is also not accepted. Claim 1 simply defines, in its last lines, that the first shift position is located between the rest position and the second shift position. Movement to the first position is also defined in relation to its 'causing a movement of the shift control unit in the first direction'. The first shift position can thus be any position provided that it lies between the rest and second shift positions and causes the movement of the shift control unit. This is evidently the case in D3 which depicts the first shift position of lever 9 in Fig. 7, this lying between the rest position of Fig. 5 and the second shift position of Fig. 14, at which first position the gear wheel 45 is also caused to move in a first direction.

1.1.3 The further argument of the proprietor that the first shift position is not disclosed in D3 since the combined braking and shifting movement of the lever 9 described a sphere, thus defining a range of possible first shift positions, does not alter the Board's finding that the first shift position is known in D3. In this regard it is noted that claim 1 does not require the first shift position to be determined under

braking; the first shift position merely needs to reflect the position reached by the operating member for causing a movement of the shift control unit in the first direction. As a consequence, the first shift position in D3 is anticipated by a single position of the lever 9, when not performing a braking operation, at which the gear wheel is caused to move in a first direction.

1.1.4 The proprietor's suggestion that claim 1 presented a novel selection invention, with the claimed first shift position being a sub-range of the full sphere of possible positions of the lever 9 of D3, is also not accepted. As found above, the Board does not see a sphere of possible first shift positions defined by the lever 9 of D3. It is simply a single position between the rest position and the second shift position at which the gear wheel is caused to move in a first direction. The claiming of such a single position is thus simply not a selection invention, this requiring the selection and claiming of a sub-range from a broader numerical range in the prior art. The selection invention argument of the proprietor is thus not convincing for the first shift position to be found as a novel feature with respect to the disclosure in D3. In fact, no actual selection has been made; instead, the first position can be located anywhere in the entire range of movement from the rest position to the second position.

1.1.5 In summary, therefore, none of the proprietor's arguments to establish novelty of the subject-matter of claim 1 is persuasive. The main request is thus not allowable.

2. *Auxiliary request 1*

2.1 *Novelty*

The subject-matter of claim 1 lacks novelty with respect to D3.

2.1.1 As regards the features added to claim 1 relative to claim 1 of the main request, these are disclosed in D3 as follows (see e.g. Fig. 5, references to D3 being within parentheses):

- a control member (rocker arm 54) including a first portion (driven arm 54a) operatively coupled to the shift control unit (gear wheel 45) and a second portion (driving arm 54b) engaged with the operating member (driven arm 9b), the second portion (54b) of the control member (54) being biased (by way of spring 58) toward the operating member (9b).

2.1.2 The appellant's argument that the expressions 'engaged with' and 'biased toward' implied a continuous contact between the second portion of the control member and the operating member is not accepted. The expression 'engaged with', as used in the claim, does not imply continuous contact; two elements in temporary contact are still considered 'engaged with' one another in the period that they are in contact. A permanent or continuous contact between the second portion of the control member and the operating member is also not required for the former to be considered 'biased toward' the latter. An element can be 'biased toward' another even without contact between that one element and another. In the present case, the return spring 58 biases the rocker arm 54 in a clockwise direction about its pivot 55, such that the driving arm 54b of the rocker arm 54 is always 'biased toward' the end 9b of

lever 9, even when these have lost contact with one another as depicted in Figs. 12 to 15.

2.1.3 The added features of claim 1 are thus known from D3 such that the subject-matter of claim 1 lacks novelty (Article 54 EPC 1973). Auxiliary request 1 is thus not allowable.

3. *Auxiliary request 2*

3.1 *Novelty*

The subject-matter of claim 1 lacks novelty with respect to D3.

3.1.1 The features added to claim 1 in this request were present in claim 8 as granted. As regards the expression 'parallel axes along said brake operating path', the proprietor argued that this should be interpreted as the two axes being parallel and passing perpendicularly through the plane in which the brake lever moves when operated.

3.1.2 Accepting this interpretation for the purpose of a novelty analysis, the features added to claim 1 relative to claim 1 of auxiliary request 1 are disclosed in D3 as follows (see Figs. 2 and 3, references to D3 being within parentheses):

the operating member (lever 9) and the control member (rocker arm 54) are arranged to be pivotable about parallel axes (X1; 32) along said brake operating path (the plane of the paper of Figs. 2 and 3).

3.1.3 Regarding the proprietor's argument that claim 1 requires the operating member and the control member to

be individually pivotable only about their separate axes, this is not accepted. No such limitation can be found in the wording of claim 1, a 'compound rotation' (i.e. of one of the members being pivotable about both axes) equally falling under the scope of the claim. In D3, therefore, the rocker arm being pivotable about X1 (see Figs. 2 and 3) does not prohibit the rocker arm also being pivotable about the Hooke's joint 32.

3.1.4 The proprietor's argument that a change of the reference system is not possible when considering the wording of claim 1 is not accepted. The rocker arm 54 is pivotable about the Hooke's joint 32, this joint defining one of the parallel axes along the brake operating path. Whilst the Hooke's joint itself indeed moves with the rotation of lever 9 about axis X1 (the second parallel axis along the brake operating path), and thus the rocker arm's pivoting has a different reference system to that of the lever 9, this does not negate the Hooke's joint being an axis about which the rocker arm 54 rotates. Claim 1 is neither worded in such a way as to prohibit the axes X1 and 32 of D3 from anticipating the feature added to claim 1 in this request, nor does it in any way suggest that a change of referential system for the pivoting about the different axes is not acceptable.

3.1.5 The added features of claim 1 are thus known from D3 such that the subject-matter of claim 1 lacks novelty (Article 54 EPC 1973). Auxiliary request 2 is thus not allowable.

4. *Auxiliary request 3*

4.1 *Novelty*

The subject-matter of claim 1 lacks novelty with respect to D3.

4.1.1 Whilst claim 1 of auxiliary request 2 uses the expressions 'parallel and/or offset axes', claim 1 of the present request is limited to solely 'offset axes'. The description does not present an explicit definition for 'offset axes'. The Board does not concur with the proprietor that 'offset' must be interpreted to mean non-parallel axes, not least because the claimed 'parallel and offset' option of claim 1 of auxiliary request 2 would then be contradictory. However, contrarily to the opposition division, the Board also sees parallel lines, from a technical understanding of the expression, as not being coincident. In the context of the present patent, therefore, and the claiming of simultaneously parallel and offset axes, the Board can only interpret the combination of the terms 'parallel' and 'offset' as meaning non-coincident, parallel axes. Consequently, at least in the context of the present patent, the Board finds that parallel axes must be offset from each other such that the claimed 'offset axes' in the present claim 1 are also anticipated by the axes X1 and 32 of D3. To this finding the proprietor also presented no counter argument.

4.1.2 Auxiliary request 3 is thus also not allowable.

5. *Auxiliary request 4*

5.1 *Admittance (Article 13(1) Rules of Procedure of the Boards of Appeal, RPBA)*

5.1.1 This request was filed during the oral proceedings before the Board and thus represents an amendment to the proprietor's complete case (Article 12(2) RPBA). Under Article 13(1) EPC such amendment to a party's case may be admitted and considered at the Board's discretion (Article 13(1) RPBA), such discretion being exercised *inter alia* in view of the need for procedural economy. As is established case law of the Boards of Appeal, such procedural economy implies that amended requests should at least be *prima facie* allowable in order to be admitted.

5.1.2 As a first basis for claim 1, the proprietor suggested a combination of claims 1, 2 and 7 together with paragraphs [0012], [0013] and [0041] of the description as originally filed. This is however not accepted, as not one of these sections of the filed application discloses either:

- the operating member and the control member being arranged to be pivotable about non-common offset axes along said brake operating path; or
- the operating member and the control member not being pivotable commonly about either of said offset axes.

Whilst claim 7 discloses the option of pivoting about offset axes, paragraph [0041], which is alleged to provide the basis for these 'non-common offset axes', discloses solely the distinct wording that these two axes are 'different but parallel'. At least on a *prima facie* basis therefore, the added features are not directly and unambiguously disclosed to the skilled

reader.

- 5.1.3 As regards the proprietor's alternative basis for the subject-matter of claim 1 meeting the requirement of Article 123(2) EPC, that the subject-matter of claim 1 includes an undisclosed disclaimer, this is also not accepted. According to the Enlarged Board of Appeal decision G1/16 (see e.g. Headnote), to be allowable under Article 123(2) EPC, the introduction of an undisclosed disclaimer may not provide a technical contribution to the subject-matter disclosed in the application as filed. In particular it may not become relevant for the assessment of inventive step (G 1/16 Reasons, point 49.1).
- 5.1.4 In the present case, two undisclosed disclaimers have been introduced:
The first concerns the operating and control members being pivotable about non-common axes, while the second concerns the operating member and the control member not being pivotable commonly about either of the offset axes. The question to be answered is thus whether the introduction of these disclaimers can be considered as providing a technical contribution to the content of the application as filed.
- 5.1.5 In this regard, it is noted that claims 7 and 8 as filed (mirrored in paragraphs [0013] and [0014] of the granted patent) address the operating member and the control member being arranged to be pivotable about parallel and/or offset axes. This may be seen as providing ergonomic advantages for the user of the bicycle control device as also indicated in col. 3, lines 5 to 6 of the application as filed. It follows that the pivotability of the operating member and the control member about the offset axes is of a technical

nature.

5.1.6 As originally filed, the operating member and control member were disclosed to be pivotable about parallel and/or offset axes along the brake operating path (for example, see claim 8 as filed). By way of the introduced disclaimers relating to the operating and control members being pivotable about non-common axes and not being pivotable commonly about either of the offset axes, a technical difference has been introduced to the amended claim when compared to the content of the originally filed application. Contrary to the proprietor's contention that the excluded features had no real meaning apart from excluding an incorrect interpretation of claim 1, as already identified in 5.1.5 above, the pivotable arrangement of the operating and control members about the axes is of a technical nature, not least through the disclosure of the ergonomic benefits for the user of the bicycle control device with the originally filed axes arrangement. With the above pivotable arrangement of the axes providing a technical contribution, so too must the disclaiming of this arrangement as well.

5.1.7 This finding is furthermore confirmed by considering whether merely a quantitative change to the original technical teaching has occurred or indeed whether a qualitative change has resulted from the introduction of the undisclosed disclaimers (see also G1/16, Reasons point 46.4). By disclaiming both common offset axes and common pivoting about either of the offset axes, the ergonomic considerations identified in the application as filed have been modified resulting in a qualitative change to the originally disclosed technical teaching in the sense that the proprietor's position with regard

to inventive step would be changed.

5.1.8 As a consequence therefore, with the requirement for an undisclosed disclaimer not to provide a technical contribution to the subject-matter disclosed in the application as filed not being met, the undisclosed disclaimers in claim 1 do not, at least *prima facie*, meet the requirement of Article 123(2) EPC.

5.1.9 The subject-matter of claim 1 thus *prima facie* fails to meet the requirement of Article 123(2) EPC. Therefore, the subject-matter of claim 1 is not *prima facie* allowable, which would be necessary for fulfilling the need for procedural economy and consequently admitting the request into the proceedings. Accordingly, the Board exercised its discretion under Article 13(1) RPBA not to admit this request.

6. *Auxiliary request 7*

6.1 *Admittance (Article 13(1) RPBA)*

6.1.1 Having been filed with letter of 7 December 2017, the admittance of this request is also at the Board's discretion. Again, the requirement of procedural economy needs to be considered and as such implies (in accordance with established case law) that the amended request should at least be *prima facie* allowable in order to be admitted.

6.1.2 Regarding the subject-matter of claim 1 having a basis in the application as filed (Article 123(2) EPC), the proprietor's reference to paragraph [0037] for the features added to claim 1 relative to claim 1 of auxiliary request 4 is not accepted. In col. 7, lines 37 to 40, a projection 72a is disclosed as being

included on the second portion 72 of the control member 40. As also argued by the opponent, this projection is not disclosed as an optional feature: the description states that the second portion of the control member 'includes a projection 72a'. The projection is furthermore disclosed in a structural (see e.g. Figs. 3 to 6) and a functional relationship (reduction of a frictional force during sliding movement) with the further features of paragraph [0037] adopted into claim 1. It thus follows that the omission of the projection 72a from claim 1 presents the skilled person with subject-matter not originally disclosed in the application as filed. The proprietor's contention that the projection 72a presented a solution to its own technical problem is also not accepted. Frictional forces exist whenever two elements move in contact relative to one another. It thus follows that the second portion of the control member would also experience friction with the operating member in the absence of projection 72a, such that the technical problem of dealing with the friction between the two elements is not isolated from the presence of the projection 72a.

- 6.1.3 Regarding the clarity of the claims of auxiliary request 7, from particularly Figures 3 and 6 it is evident that the 'concave portion' of the operating member in claims 3 and 4 of the request is in fact structurally the same part as the 'rear surface of the operating lever' included in claim 1. However, there is no logical structural interrelationship defined for these identical but differently defined parts (i.e. the parts in claim 1 compared to the parts in claims 3 and 4), such that the structure of the operating member itself as defined in claims 3 and 4 lacks clarity

(Article 84 EPC 1973).

- 6.1.4 It thus follows that the claims are *prima facie* not allowable in view of Articles 84 and 123(2) EPC at least for the reasons given above. Accordingly, the Board exercised its discretion under Article 13(1) RPBA not to admit this request into the proceedings.
- 6.2 As regards the proprietor's request to alternatively remit the case to the opposition division to continue examination of the opposition based on auxiliary request 7, this is refused.
- 6.3 The proprietor chose the order of its requests on file. In the chosen order, auxiliary request 7 preceded the request for remittal of the case to the opposition division. Thereby the Board had necessarily to decide upon the admittance of auxiliary request 7 into the proceedings under Article 13(1) RPBA before considering the request for remittal. As the Board decided not to admit auxiliary request 7 into the proceedings, this request can consequently not be the basis for a remittal.

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