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Datasheet for the decision of 3 December 2019

Case Number: T 0141/16 - 3.2.06

Application Number: 05291019.7

Publication Number: 1642822

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Language of the proceedings: EN

Title of invention:
Bicycle shift operating device

Patent Proprietor:
SHIMANO INC.

Opponent:
SRAM Deutschland GmbH

Headword:

Relevant legal provisions:
EPC Art. 100(a), 56, 123(2)

Keyword:
Admissibility of appeal - appeal sufficiently substantiated (yes)
Inventive step - main request (no)
Late-filed request - admitted (yes)
Amendments - intermediate generalisation - extension beyond the content of the application as filed (yes)

Decisions cited:
T 2052/14, G 0002/10

Catchword:

Europäisches Patentamt
European Patent Office
Office européen des brevets

Beschwerdekammern

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Case Number: T 0141/16 - 3.2.06

D E C I S I O N
of Technical Board of Appeal 3.2.06
of 3 December 2019

Appellant: (Opponent)	SRAM Deutschland GmbH Romstr. 1 97424 Schweinfurt (DE)
Representative:	Feller, Frank Weickmann & Weickmann Patent- und Rechtsanwälte PartmbB Postfach 860 820 81635 München (DE)
Respondent: (Patent Proprietor)	SHIMANO INC. 3-77, Oimatsu-cho Sakai-ku, Sakai City Osaka 590-8577 (JP)
Representative:	Cabinet Beau de Loménie 158, rue de l'Université 75340 Paris Cedex 07 (FR)
Decision under appeal:	**Decision of the Opposition Division of the European Patent Office posted on 26 November 2015 rejecting the opposition filed against European patent No. 1642822 pursuant to Article 101(2) EPC.**

Composition of the Board:

Chairman	M. Harrison
Members:	M. Dorfstätter
	W. Ungler

Summary of Facts and Submissions

I. An appeal was filed by the appellant (opponent) against the decision of the opposition division rejecting the opposition to European patent No. 1 642 822.

II. The appellant requested that the decision be set aside and the patent be revoked.

III. In its letter of response, the respondent (proprietor) requested that the appeal be rejected as inadmissible or dismissed as unallowable, or that the patent be maintained according to one of auxiliary requests 1 to 7 as filed on the same day.

IV. The Board issued a summons to oral proceedings.

V. In its response to the respondent's filing of auxiliary requests, the appellant objected that in claim 1 in both country versions of all auxiliary requests a feature had been omitted when compared to the granted claims.

VI. With letter of 9 July 2019 the respondent presented replacement first to seventh auxiliary requests.

VII. The Board issued a communication containing its provisional opinion, in which it indicated *inter alia* that the ground for opposition under Article 100(a) EPC appeared to prejudice maintenance of the patent as granted and that the subject-matter of claim 1 in both country versions appeared to lack novelty and/or inventive step. It further indicated that none of the auxiliary requests fulfilled the requirement of Article 123(2) EPC, particularly in view

of the fact that several features had been taken out of their context and inserted in the claims.

VIII. Oral proceedings were held before the Board, at the end of which the parties maintained their respective requests as stated above.

IX. All requests but the seventh auxiliary request include different country versions, one for Germany and France and one for Italy. Claim 1 of all requests in their version for Italy does not contain the features concerning the direction of movement of the first and second shift operating members marked in bold below.

X. Claim 1 of the main request (patent as granted) in the country version for Germany and France reads as follows:

"A bicycle shift operating device comprising:
a first shift operating member (60) pivotally coupled to a first pivot axle (40) for rotation about a first pivot axis (X) to move along a first shifting plane (P1) that is perpendicular to the first pivot axis (X), **wherein the first shift operating member (60) is moved forwardly when the first shift operating member (60) is moved from a first rest position to a first shift position;**
a second shift operating member (62) pivotally coupled to a second pivot axle (42) for rotation about a second pivot axis (Y) to move along a second shifting plane (P2) that is perpendicular to the second pivot axis (Y) and intersects the first shifting plane (P1) to form an angle equal to or less than about thirty degrees and more than zero degrees therebetween, **wherein the second shift operating member (62) is moved backwardly when**

the second shift operating member is moved from a second rest position to a second shift position; and a transmission control mechanism (26) configured to control a bicycle transmission, the transmission control mechanism (26) being operatively coupled to the first (60) and second (62) shift operating members."

In claim 1 of the first auxiliary request in both country versions the following features are appended to claim 1 of the main request:

"and comprising a cable take-up mechanism (52) configured to be retained in three or more shift positions, the cable take-up mechanism (52) being operatively coupled to the first (60) and second (62) shift operating members such that movement of the first (60) and second (62) operating members selectively moves the cable take-up mechanism (52) one shift position in one rotational direction and one shift position in an opposite rotational direction, respectively."

Claim 1 of the second auxiliary request in both country versions is further delimited over claim 1 of the main request by defining that the second pivot axle (42) "is fixed with respect to the first pivot axle (40)."

Claim 1 of the third auxiliary request in both country versions is further delimited over claim 1 of the main request by defining "a base plate (34) non-rotatably mounted on the first pivot axle (40)" and that "the second pivot axle (42) is non movably coupled to the base plate (34)."

Claim 1 of the fourth auxiliary request in both country versions is further delimited over claim 1 of the main

request by defining that "the first shift position is closer than the first rest position to the intersection between the first and second shifting planes (P1, P2) and the second rest position is closer than the second shift position to the intersection between the first and second shifting planes."

Claim 1 of the fifth auxiliary request in both country versions is further delimited over claim 1 of the main request by defining "an operating mechanism (28), a transmission control mechanism (26) and a retaining mechanism (30), wherein the operating mechanism (28) includes: a first ... and a second shift operating member ..., a transmission control mechanism *(these parts as such already being defined in claim 1 according to the main request, note added by the Board)*, a release member (64); and a pawl mechanism (66)." It is further delimited by defining that the transmission control mechanism "comprises a cable take-up mechanism configured to be retained in three or more shift positions, the cable take-up mechanism being operatively coupled to the first (60) and second (62) shift operating members such that movement of the first (60) and second (62) operating members selectively moves the cable take-up mechanism, and comprising a take-up member (52), a ratchet member (54) non-rotatably coupled to the take-up member(52) to rotate therewith, and a main biasing member (56) for biasing the take-up member (52) and the ratchet member (54) in a predetermined direction, wherein the pawl mechanism (66) is configured to engage the ratchet member (54) when the first shift operating member (60) is moved from the first rest position to the first shift position and rotate the ratchet member (54) and the take-up member (52) one shift position against the urging force of the biasing member (56), and the second

shift operating member (62) is operatively coupled to the retaining mechanism (30) via the release member (64) to selectively release the ratchet member (54) and the take-up member (52), wherein the retaining mechanism (30) is configured and arranged so that the ratchet member (54) engages the retaining mechanism (30) again after rotating one shift position."

Claim 1 of the sixth auxiliary request in both country versions is further delimited over claim 1 of the main request by defining "a base plate (34) non-rotatably mounted on the first pivot axle (40) and comprising a main plate section (34a), from which the first pivot axis (X) extends perpendicularly, and a secondary plate section (34b) which is inclined with respect to the main plate section (34a)" and that "the second pivot axle (42) is non movably coupled to the base plate (34) and the second pivot axis (Y) extends perpendicularly from the secondary plate section (34b)."

The seventh auxiliary request contains only a single country version for Germany, France and Italy. Claim 1 of this request is identical to claim 1 of the fourth auxiliary request in the country version for Germany and France.

XI. The appellant's arguments relevant to the decision may be summarised as follows:

The appeal was admissible; sufficient reason was given as to why the decision of the Opposition Division had to be set aside. The subject-matter of claim 1 according to the main request was not novel over E4 which disclosed in particular shift operating members with respective shift and rest positions. It also disclosed that the shifting planes intersected at an

angle between 0 and 90 degrees, albeit closer to 0. The claimed range did not fulfil the requirements for establishing novelty in connection with selection inventions. Additionally, E4 disclosed a particular embodiment in figure 3 which taught the person skilled in the art an angle within the claimed range. If the claimed angular range were considered not disclosed in E4, it would anyway not contribute to an inventive step as no proof nor explanation was provided for an advantage thereof. The technical effect of the claimed range was hence merely the provision of appropriate values of intersection angles between the shifting planes. The subject-matter of claim 1 of each of auxiliary requests 1 to 7 in all country versions included unallowable intermediate generalisations contrary to Article 123(2) EPC.

XII. The respondent's arguments relevant to the decision may be summarised as follows:

The appeal was inadmissible. The appellant had not addressed the reasons of the contested decision which it deemed to be incorrect, and it failed to provide sufficient substantiation as to why it considered the reasoning of the opposition division concerning inventive step to be flawed. The shift operating device of E4 did not show two shift operating members. Lever 52 was not disclosed as being suitable to operate the shift itself which was always carried out through control lever 4. Accordingly, lever 52 did not constitute a shift operating member. Furthermore, E4 merely mentioned that the shifting planes could be "slanted" with respect to each other but it did not disclose the claimed range of angles. In E4, the first and second positions of lever 4 corresponded to individual gear ratios. E4 hence failed to show that

control lever 4 was moved between a "shift position" and a "rest position". The claimed angle range provided the technical effect of better ergonomics and hence contributed to an inventive step. The amendments made in the respective independent claims of each auxiliary request for all country versions did not present the skilled person with information which was not directly and unambiguously derivable from the originally filed application. The skilled person could determine which features were presented in a more general context. Likewise, the skilled person understood which features were not inextricably linked to the basic elements of the device and which thus did not need to be inserted into the claims, such that the requirement of Article 123(2) EPC was fulfilled.

Reasons for the Decision

1. Admissibility of the appeal

The appeal is admissible.

The respondent's argument that the appeal was insufficiently substantiated because the appellant had failed to address any of the specific reasons given by the opposition division in items 8.3 to 8.9 of its decision, is not found persuasive.

In its communication sent prior to oral proceedings (see item 2, first paragraph), the Board informed the parties that it considered the appeal admissible and noted (see item 2, second paragraph) that there was no concept of partial admissibility of an appeal. The mere fact that the appellant has addressed several grounds as to why the patent should be revoked, together with

reasoned argument, makes the appeal as a whole admissible even if single issues had not been dealt with, or not dealt with in the same detail as others. For example, the appellant presented detailed arguments for an alleged lack of novelty and inventive step of the subject-matter defined in claim 1 of the main request in view of E4 (see grounds of appeal, items 1.1 and 1.2). This argumentation alone is sufficient to allow the Board to understand why the appellant considered the decision of the opposition division flawed and to be set aside.

The parties did not comment further on this issue after receipt of the Board's communication either in writing or during the oral proceedings before the Board. Thus, there was no reason for the Board to deviate from the provisional opinion set out in its communication which is hereby confirmed.

2. Main request - Inventive step (Article 56 EPC) - claim 1 in the country version for FR and DE

2.1 When starting from E4, the Board finds this discloses all features of claim 1 with the exception of the feature that the angle between the two intersecting shifting planes is equal to or less than 30 degrees. The arguments of the respondent that further features were not disclosed by E4 are not persuasive (see below).

2.2 As regards the respondent's argument that lever 52 of E4 was not a "shift operating member" this is not accepted. Contrary to the respondent's argument, the Board finds that a "shift operating member" is a member enabling a shift to be operated. The term is not limited in the sense that the member itself operates a

shift and moves without further action of the rider. In this sense, it is irrelevant whether the holding forces of the click plate are overcome by the pulling forces of the return spring. Even if it were accepted that the click plate inhibits movement of lever 4 to a certain degree to provide a haptic feedback to the rider, lever 52 of E4 would still constitute a "shift operating member" as a shift is enabled by operating it. Irrespective of whether lever 4 must additionally be moved forward by the rider when lever 52 is pushed, a shift operation is initiated and thus operation is enabled.

2.3 The Board also does not accept the respondent's argument that the claim as a whole is directed to a trigger shifter and excludes shifters in which the positions of the levers correspond to a particular gear. There is no basis in the contested patent upon which to conclude that a "shift position" would be a position in which a gear shift is operated and that in the shift position the lever had to have the same orientation for all shifts. Both in the contested patent and E4, a shift is performed upon movement of the respective lever from a first position to a second position. In E4, when the lever 4 is moved from the low speed position to the high speed position, this high speed position constitutes the "shift position" in the sense of the patent. When the lever 4 is moved from the high speed position to the low speed position, then the low speed position becomes the shift position. Both positions also constitute a "rest position" as the lever rests therein after the shift has been performed. No reason is apparent as to why the definitions of claim 1 should be read in a more restrictive way.

2.4 The Board does not concur with the appellant's assessment that E4 discloses a range of angles between the two intersecting shifting planes of more than 0 and less than 90 degrees. As already stated in the Board's communication (see item 3.2, first paragraph), figure 3 of E4 shows a single angle, albeit its exact value is not known. What is hence to be compared in the present case is a range of angles defined in the claim with a single, only vaguely known value in the prior art. The conditions regarding selection inventions where the claim defines a smaller range than the range disclosed in the prior art hence do not apply to the present case.

2.5 The Board does not accept the respondent's argument, which was presented for the first time during the oral proceedings before the Board (which was also contrary to what had previously been accepted and also confirmed as such by the respondent), that for several reasons no angle at all could be determined from the figures of E4. Whether this line of argument constitutes a change of the respondent's complete case to be considered under Article 13(1) RPBA can be left unanswered, as the Board considered this line of argument anyway.

2.5.1 In the respondent's view, the drawings of E4 were in part contradictory, as cross-sections through cylindrical bolts along a tilted cutting-plane would not be depicted as circles but as ellipses. Knowing that E4 was published in 1982, the Board accepts that its figures were produced manually and its inventor could not make use of modern CAD-techniques that would allow for the high precision seemingly necessary to illustrate such small ellipses with their correct proportions. The fact that lever shaft 31 is not depicted as an ellipse in figure 2 cannot hence deprive

the drawings of their credibility, in particular with regard to the information which is nevertheless directly and unambiguously derivable.

2.5.2 Furthermore, the argument that figure 3 of E4 showed a cross-section with a discontinuous, angled line along which the cutting plane through figure 1 was viewed and hence that the actual angles would be different, does not change the Board's finding that figure 3 still shows the actual relative orientation of the shifting *planes*. Although the apparent relative position of the lever shafts 31 and 53 changes by rotating their respective sectional view, this would not affect the relative angular position of the shifting planes. By theoretically turning the right half of the cutting plane out of the drawing plane in figure 3 and hence bringing both halves of lever 4 into their actual relationship, the axis through bolt 53 does not change its orientation. Nor does the associated shifting plane which is perpendicular thereto. It follows that, despite the cutting plane including an angled section, figure 3 does show the relative angular position of the shifting *planes*.

2.5.3 The respondent's argument that E4 only defines the base 32 as being slanted with respect to the handle bar such that no conclusion could be drawn as to whether the shifting planes were also slanted, is also not accepted. The statement that "the base 32 is slanted at its upper surface" (E4, column 2, line 28) refers to the shifting plane of lever 4. The further statement that "the control portion 43 is slanted downwardly with respect to the plane of boss 42 so as to be kept horizontal" clearly refers to the right half of lever 4 to which the shifting plane of lever 52 is parallel. It

hence defines the relative orientation of the two shifting planes as being "slanted".

2.5.4 The respondent referred to T2052/14 and argued that no relative measurements should be taken from schematic drawings, in particular when the text was focused on other things than those that are now being deduced from the drawings. This argument, however, does not alter the Board's finding that in this case certain information can indeed be derived from figure 3 of E4 by a skilled person. In the case underlying T2052/14 (in German, see Reasons 1.3.5) the Board concluded that *in that case a drawing did not constitute a direct disclosure for the skilled person because they knew that the figures of (prior art document) D1 were only schematic and that* ***without an indication in that respect*** *no concrete dimensions or proportions could be derived therefrom* (emphasis added by the Board). In the present case, however, the description of E4 is directed to the same information regarding the angle, when it defines the upper surface of the base being "slanted". Figure 3 is not incidentally showing just any angle. The inclined representation of several parts in figure 3 corresponds to the information given in the description and depicts the stated slanted arrangement. The Board thus concludes that figure 3 of E4 represents a clear and unambiguous disclosure of a particular angle, in the meaning that the components are shown "slanted".

2.6 Contrary to the argument of the appellant, however, the Board finds that E4 does not provide a direct and unambiguous teaching to provide an angle between the shifting planes equal to or less than 30 degrees. As set out above, although the figures of E4 are merely schematic and no measurements can therefore be directly

taken from such drawings, some information can be unambiguously derived therefrom. The skilled person well understands that the single angle shown in figure 3 lies below 45 degrees since it is depicted far closer to 0 than to 90 degrees. Together with the information that the base 32 is "slanted", figure 3 would be understood by a skilled observer to show only a gentle inclination, certainly of less than 45 degrees as an angle of anything close to 45° would imply evidently inappropriate dimensions, structure and angling of various components.

However, in agreement with the respondent, it cannot be ascertained, at least not directly and unambiguously, that the angle is "equal to or less than about 30 degrees" as defined in claim 1, merely because the angle is drawn at something about 15 to 25 degrees. Structural and functional considerations of the skilled person, which were suggested by the appellant, cannot compensate for this information lacking in E4.

2.7 Therefore, the subject-matter of claim 1 differs from E4 in that the angle of intersection between the two shifting planes is equal to or less than about 30 degrees, and is thus novel.

2.8 In regards to inventive step however, and contrary to the argument of the respondent, the provision of such an angle will not result in a "more ergonomic arrangement" than what is achieved by the angle derivable from E4.

2.8.1 According to established practice when judging inventive step, having determined the distinguishing feature(s) over the closest prior art, the effect that is attributable to this feature has to be defined. The

Board finds that no effect is plausible which is achieved at 30 degrees (or less) but not at the single angle of less than 45 degrees as is directly and unambiguously derivable from E4.

2.8.2 The respondent's argument that at bigger angles the rider has to bend their index finger(s) to a higher degree is not persuasive. The Board can only understand this comparison with reference to a prior art trigger shifter, but not with regard to E4. Starting from E4 and the "slanted" orientation proposed therein, a smaller angle has no effect on the degree to which the index finger need be bent.

2.8.3 The argument that E4 actually teaches against small angles to keep the lever 4 within reach does not alter the Board's conclusion that there is no discernible effect at e.g. 30 degrees as opposed to an angle smaller than 45 degrees. In E4, a higher angle of the shifting plane of lever 4 (and a corresponding higher angle at which its control portion 43 is slanted downwardly to keep it horizontal) will result in a closer distance of the lever during shifting. The ergonomic effect of keeping the handle close to the handle bar will occur both at an angle of 45 and 30 degrees. It cannot hence be attributed to the distinguishing feature.

2.9 As there is no other technical effect of selecting an angle equal to or smaller than 30 degrees which is apparent, the Board concludes that, for example, the value at the end of the range, i.e. 30° is nothing more than an arbitrary choice compared to the value of less than 45° derivable from E4. The objective technical problem is hence merely to provide a suitable angle,

when starting from E4 having an angle that is less than 45 degrees.

2.10 The respondent's argument that 30 degrees was not the only angle defined in the claim, and that angles down to just above zero were also claimed and that these latter angles were far from values for example just below 45 degrees, lacks relevance since the claimed subject-matter also includes the angle of 30 degrees, and inventive step, if present, must be established for the whole scope of the claim.

2.11 E4 already teaching to use an angle smaller than 45 degrees, bigger angles causing problems with the type of attachment in E4 and angles of 30 degrees or less being an arbitrary selection, the solution defined by the subject-matter of claim 1 does not involve an inventive step (Article 56 EPC). The ground of opposition under Article 100(a) EPC hence prejudices maintenance of the patent in the form of the main request, due to lack of an inventive step.

3. Main request - Inventive step (Article 56 EPC) - claim 1 in the country version for IT

Since claim 1 in the country version for Italy does not define the direction of movement of the levers but is otherwise identical to the country version for France and Germany, this request fails to involve an inventive step for the same reasons as set out above.

4. Admittance of the auxiliary requests

4.1 Claim 1 of the auxiliary requests filed with the reply to the grounds of appeal omitted the feature of granted claim 1 that the intersecting angle between the

shifting planes is more than zero degrees. This was objected to by the appellant in its reply of 3 April 2019, albeit its arguments were then directed to claims including the feature.

When filing replacement auxiliary requests including the previously omitted feature, the respondent declared that a clerical mistake had occurred and that it had always intended to further limit claim 1 as granted.

The Board sees no reason not to admit the requests. By presenting the replacement requests, the respondent merely filed what had been intended when presenting its initial requests. Since the appellant had already argued against requests including the previously omitted feature, the replacement auxiliary requests added no complexity to the case, they immediately resolved the specific issue of the omitted feature and were filed sufficiently early so as to be fully considered by the appellant and the Board without further negatively affecting the economy of procedure. The replacement auxiliary requests were thus admitted into the proceedings. During the oral proceedings before the Board, the appellant also raised no objection to admittance of the requests.

5. Auxiliary requests - Article 123(2) EPC

5.1 The independent claims of all requests include *inter alia* features which have been extracted out of the context in which they are disclosed, namely from the description of specific embodiments. Whilst these embodiments are described and depicted in the figures in a very detailed manner, not all of these details have been inserted in the respective claim and no other basis exists for omitting such details. The scope of

the claims being more general than the embodiments but at the same time more restricted with regard to the general wording of the claims as originally filed, the amendments form an intermediate generalisation of the content of the application as originally filed as explained below.

5.2 Not only is there a lack of any explicit basis for the specific combination of features defined, but further the Board finds that there is also no implicit disclosure for the claimed subject-matter, such that the claimed subject-matter is an unallowable intermediate generalisation of the content of the application as originally filed. None of the auxiliary requests is therefore allowable as their respective independent claim 1 in both country versions (where applicable) defines subject-matter extending beyond the content of the application as originally filed and published as EP 1 642 822 A2 (in the following "the published application"), contrary to Article 123(2) EPC.

5.3 The Board does not agree with the respondent's argument that the skilled person would understand which parts of the description referred to the more general concept of the invention and which described the specific details of the embodiments. No plausible reason is apparent why, in the published application, paragraphs 0060, 0061 and 0067 were to be understood as "conclusive paragraphs" (as the respondent put it) and should hence be regarded as including more general statements which could be used as appropriate when defining the invention, as compared to other paragraphs directly before, between or after these paragraphs, which notably all relate to the same specific embodiment.

5.4 According to established case law of the Boards of Appeal and as summarised in the Case Law Book of the Boards of Appeal (CLBA), 9th edition, II.E.1.9, page 482ff, it is normally not allowable to base an amended claim on the extraction of isolated features from a set of features originally disclosed only in combination.

The basic principle when assessing whether the claimed subject-matter extends beyond the content of the application as originally filed can be found in the case law of the Enlarged Board of Appeal as summarised in G2/10 (see reasons 4.3). The question to be answered is hence what a skilled person can derive directly and unambiguously, using common general knowledge, and seen objectively and relative to the date of filing, from the whole of the documents as filed. This is known as the gold standard.

In order to be allowable under Article 123(2) EPC, any amendment must hence meet this standard.

5.5 First auxiliary request

Regarding the definition that "movement of the first and second operating members selectively moves the cable take-up mechanism one shift position in one rotational direction and one shift position in an opposite rotational direction, respectively", the respondent's argument that paragraphs 0060 and 0067 were a basis is not accepted. These two paragraphs refer to a specific embodiment with a particular structure, which structure causes only one shift per actuation of the levers. None of these structural features are defined in claim 1. There being neither an explicit nor an implicit disclosure for this intermediate generalisation the claimed subject-matter

extends beyond the disclosure of the original application. The respondent's argument that there is no "inextricable link" between these features is also plainly incorrect in the present case; the two embodiments described in the published application each show essentially a single mechanism where several interrelated parts act and react with each other to produce the desired movements in the device. It is thus not directly or unambiguously derivable for a skilled person that certain parts are to be understood as parts or connections which can be omitted. Nothing in the application as filed indicates this, even though at several locations, certain features, other than those in question however, are clearly disclosed as being merely preferred. This holds true for all auxiliary requests, and further details for each request are given below.

5.6 Second auxiliary request

The respondent argued that the feature added in claim 1 of this request, namely that "the second pivot axle ... is fixed with respect to the first pivot axle" was based on the last sentence of paragraph 0041. It further argued that the first sentence of this paragraph included general information and that the following sentences merely referred to details.

The Board does not accept this. The last sentence of paragraph 0041 refers to details that are presented in combination. Since claim 1 does not include all of these details, this sentence, taken alone, cannot form the basis for an explicit original disclosure of single features thereof.

The statement also does not provide more general information when read together with the first sentence of this paragraph, either. Other than stated by the respondent, the first sentence is not to be seen as a general statement but refers to figures 2 and 4 to 6. Absent any information to the contrary, the information given in paragraph 0041 is hence to be read in connection with what is presented in the referenced figures, to which these paragraphs specifically refer, and which show several non-claimed details in combination. Neither the text of paragraph 0041 nor figures 2 and 4 to 6 describe or show a second pivot axle fixed to a first pivot axle without a base plate, an intermediate plate, a lever retaining plate, a main fixing bolt and a fixing nut. The independent claims not including any of these features, their subject-matter extends beyond the original disclosure of the application as filed.

5.7 Third auxiliary request

The independent claims of this request include the base plate but still lack the other features presented in combination in paragraph 0041 and the figures. In this respect, the respondent additionally referred to paragraphs 0042 and 0043 and argued that the skilled person would derive therefrom that all that matters is the relative position of the two pivots. This was also allegedly apparent from paragraphs 0081 and 0082 which referred to the second embodiment including a modified base plate and was silent about any influence that this modification could have on other parts which were hence not affected.

The Board does not accept this. Paragraph 0081 clearly states that for the second embodiment not all parts

will be described again but that "the descriptions and illustrations of the first embodiment also apply to the second embodiment." This is to be understood that also the second embodiment includes the further features described with the first embodiment, among these an intermediate plate, a lever retaining plate, a main fixing bolt and a fixing nut, none of which is included in claim 1. Thus, again, the respondent's argument fails. The subject-matter of claim 1 of auxiliary request 3 thus contravenes Article 123(2) EPC.

5.8 Fourth auxiliary request

The respondent's argument that the relative positions included in the independent claims were directly and unambiguously derivable from paragraph 0027 and figure 16 in isolation is not accepted. Contrary to what is stated by the respondent, at least several further pieces of information are presented in figure 16 which are not reflected in the claims. In particular, even figure 16 includes specific orientations of the levers with respect to the handlebar. Furthermore, paragraph 0027 states that figure 16 is an "elevational view of the rear shift operating device illustrated in figures 11 and 13-15." This would only be understood by a skilled person to mean that what is shown in figure 16 is indeed not be taken in isolation and does not form a general disclosure. It would be interpreted to complement the information given for the specific embodiment depicted in figures 11 and 13 to 15. The relative positions shown in figure 16 are hence to be seen as positions of the levers with all its details as visible in the exploded view of figure 13. Thus, the features included in claim 1 are again an unallowable generalisation of the set of features that are disclosed only in combination in the content of the

application as filed thus contravening Article 123(2) EPC.

5.9 Fifth auxiliary request

The respondent's argument that the independent claims of this request were much more specific and all "essential" features were now included in the claim is again not accepted. There is nothing indicating that paragraph 0054 can be used to generalise the information given in paragraph 0058 as alleged by the respondent. Although paragraph 0054 defines what the operating mechanism 28 "basically" includes, it does so with reference to figures 4 to 10 (see first sentence of paragraph 0054). The pawl mechanism 66 defined in that paragraph would hence be understood by a skilled person as including all details described in paragraph 0058. There is simply no disclosure in the application, be it explicit or implicit, of a pawl mechanism without these details. For example, paragraph 0058 describes that the pawl mechanism 66 includes a pawl member 76 mounted on the upper end of the pawl pivot pin 72. None of these features is included in the independent claims. As there is no basis in the application as originally filed for a generalised pawl mechanism without a pawl member and its specific mounting structure, even these limited claims define subject-matter extending beyond the original disclosure, contrary to Article 123(2) EPC. The appellant's argument that the skilled person knew of other ways of implementing pawl mechanisms is entirely irrelevant to the only pawl mechanism that has been disclosed in the application as filed, which is a specific pawl mechanism having specific features.

5.10 Sixth auxiliary request

The independent claims of this request include the features added in the third auxiliary request and additional definitions regarding different sections of the base plate. As set out for the third auxiliary request above, the base plate was however only disclosed together with an intermediate plate, a lever retaining plate, a main fixing bolt and a fixing nut. As also the claims of the sixth auxiliary request do not contain any such feature, they do not fulfil the requirement of Article 123(2) EPC.

5.11 Seventh auxiliary request

The seventh auxiliary request includes only a single country version for Germany, France and Italy. Its independent claim is identical to the independent claim of the fourth auxiliary request in its country version for Germany and France. The Board hence concludes that the seventh auxiliary request does not fulfil the requirement of Article 123(2) EPC for the same reasons as set out for the fourth auxiliary request above.

5.12 Since the independent claims of all auxiliary requests (also in both country versions) contain subject-matter extending beyond the content of the application as originally filed, the requirement of Article 123(2) EPC is not met by any of these requests.

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