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**Datasheet for the decision
of 25 September 2012**

Case Number: T 0810/09 - 3.2.06

Application Number: 04005647.5

Publication Number: 1426282

IPC: B62M 3/00

Language of the proceedings: EN

Title of invention:

Bicycle crank assembly and assembly tools

Patentee:

SHIMANO INC.

Opponent:

SRAM Deutschland GmbH

F.S.A. S.r.l.

Headword:

-

Relevant legal provisions:

EPC Art. 123(2), 123(3)

RPBA Art. 12(4), 13(1), 11

EPC R. 140, 106

Relevant legal provisions (EPC 1973):

EPC Art. 100(c), 76(1), 111(1)

Keyword:

"Main request and auxiliary requests of group I - added subject-matter (yes)"

"Auxiliary requests of group II - extension of scope of protection (yes)"

"Auxiliary requests III.2 and III.3 - could have been filed before first instance (yes)"

"Auxiliary request III.4 - not prima facie allowable objections to violation of right to be heard (rejected)"

Decisions cited:

G 0001/93

Catchword:

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Case Number: T 0810/09 - 3.2.06

D E C I S I O N
of the Technical Board of Appeal 3.2.06
of 25 September 2012

Appellant:
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Decision under appeal: Decision of the Opposition Division of the European Patent Office posted 3 February 2009 revoking European patent No. 1426282 pursuant to Article 101(3) (b) EPC.

Composition of the Board:

Chairman: M. Harrison
Members: T. Rosenblatt
W. Sekretaruk

Summary of Facts and Submissions

- I. The European patent No. 1 426 282 was granted on European patent application No. 04 005 647, which application was filed as a divisional application of the earlier European patent application No. 03 005 136.

In the following, all references to the earlier and divisional applications "as filed" are with respect to the published versions.

- II. An opposition was filed against this patent. In a communication, dated 1 September 2008, in preparation for oral proceedings, the opposition division expressed its preliminary view that *inter alia* the feature "*splines 370 are flush with the outer peripheral surface of 362 of axle body 348*" should have been defined in claim 1 of the patent to meet "the requirements of Article 76(1) EPC". It also indicated that and how this objection could be overcome. With the letter of 15 December 2008 the appellant (proprietor) submitted eight auxiliary requests, among which only claim 1 of the "2. auxiliary request" comprised also the before mentioned feature. During the oral proceedings, following half an hour of interruption requested by the appellant upon rejection of its main request, the appellant withdrew this "2. auxiliary request" and renumbered the remaining seven auxiliary requests accordingly.

The opposition division then revoked the European patent, because it considered that claim 1 of the main request, being identical to that of the granted claim 1, and of the auxiliary requests 1 to 7 did not

meet the requirements of Article 76(1) EPC *inter alia* for essentially the reason given in its preliminary opinion.

- III. The appellant filed an appeal against this decision. With the letter dated 15 June 2009 the appellant filed the grounds of appeal and requested *inter alia* that the patent be maintained as granted or alternatively according to the claims of one of the groups of auxiliary requests I to IV submitted therewith.
- IV. In a communication in preparation for oral proceedings, the Board informed the parties that it preliminarily agreed with the opposition division's finding. The Board further questioned whether the auxiliary requests of group IV, submitted with the grounds of appeal and seemingly based on the request withdrawn before the opposition division, should be admitted into the proceedings having regard to Article 12(4) of the Rules of Procedure of the Boards of Appeal (RPBA).
- V. With a letter received on 23 August 2012 the appellant replied to the Board's communication and submitted amended claims corresponding to a main request and to auxiliary requests of groups I, II and III, replacing all former requests.
- VI. Oral proceedings were held on 25 September 2012 during which the appellant withdrew the auxiliary request numbered III.1 of 23 August 2012.
- VII. The appellant requested that the decision under appeal be set aside and the European patent be maintained on the basis of the main request, filed as auxiliary

request Group II.1 on 15 June 2009, or on the basis of one of the auxiliary requests of Groups I, II or III.2-4 of 23 August 2012.

It further requested remittal and/or correction as specified in its written request of 25 September 2012. The Board translates this request filed in German language as follows (the original text in German language is found in the annex to the minutes to the oral proceedings before the Board):

"The proprietor and appellant subsidiarily requests beyond all requests submitted so far

that the case be remitted to the opposition division for continuation of the opposition proceedings on the question whether the claimed "bicycle crank axle" was originally disclosed in the earlier application EP 1 342 655 A2 as subject-matter which could be claimed separately

and, further subsidiarily,

that the case be remitted to the opposition division for continuation of the opposition division to clarify the basis for revocation of the patent in suit by the opposition division and/or that the decision be corrected in this respect."

The appellant further raised objections under Rule 106 EPC as specified in writing on 25 September 2012.

VIII. The respondents (opponents I and II) requested that the appeal be dismissed.

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

*"A bicycle crank axle (59) adapted to be rotatably supported within a bottom bracket (33) and to support a bicycle crank arm (60A), the crank axle (59) comprising:
an axle body (348) having a plurality of first splines (358) disposed at a first end portion (350) of the axle body (348) and a plurality of second splines (370) disposed at a second end portion (354) of the axle body (348), the plurality of first splines (358) being suitable for engaging a splined inner peripheral surface (312) of a mounting boss (308) of the bicycle crank arm (60A), and said second splines (370) do not extend radially outwardly relative to an outer peripheral surface (362) of the axle body (348), characterized in that, said first splines (358) extend radially outwardly from the outer peripheral surface (362) of the axle body (348), the crank axle (59) further comprises a flange (366) extending radially outwardly from the first end portion (350), wherein the flange (366) is adapted to abut against a lateral outer surface (304) of the bicycle crank arm (60A) to prevent the bicycle crank arm (60A) from moving axially outwardly."*

X. Claim 1 of the auxiliary requests comprise the following amendments (in bold):

- (a) Auxiliary request I.1, besides the deletion of "characterized in that", added to the end of claim 1 of the main request:

"... from moving axially outwardly, said second end portion (354) of the axle body (348) has a threaded inner peripheral surface (368) for screwing an axle bolt (380) therein."

- (b) Auxiliary request I.2, compared to claim 1 of the main request and in addition to the deletion of "characterized in that"

*"A bicycle crank axle (59) adapted to be rotatably supported within a bottom bracket (33) **with first and second adapter assemblies (124A, 124B)** and to support **first and second crank arms (60A, 60B)**, the crank axle (59) comprising:...*

*... the plurality of first splines (358) being suitable for engaging a splined inner peripheral surface (312, 333) of a mounting boss (304, 331) of **one of the crank arms (60A, 60B)**, and said second splines (370)...*

*... wherein the flange (366) is adapted to abut against a lateral outer surface (304) of **one of the crank arms (60A, 60B)** to prevent **one of the crank arms (60A, 60B)** from moving axially outwardly, **wherein the second end portion (354) is capable of passing through a mounting opening (308, 332) in the mounting boss (304, 331) of the one of the crank arms (60A, 60B) and through the first and second adapter assemblies (124A, 124B) so that the second end portion (354) of the axle (59) extends into a mounting opening (308, 332) in the mounting boss (304, 331) of the other of the crank arms***

(60A, 60B) and the flange (366) abuts against the one of the crank arms (60A, 60B)."

(c) Auxiliary request I.3: Claim 1 comprises in addition to the amendments of auxiliary request I.2 also the feature added in auxiliary request I.1

(d) Auxiliary request II.1: Compared to claim 1 of the main request the feature

"... said second splines (370) do not extend radially outwardly relative to an outer peripheral surface (362) of the axle body (348)"

is replaced by the feature

"said plurality of second splines (370) are flush with the outer peripheral surface (362) of the axle body (348), ..."

(e) Claim 1 of auxiliary requests II.2 to II.4 comprises in addition to the amendment in auxiliary request II.1 also the respective amendments of auxiliary requests I.1 to I.3.

(f) Claim 1 of auxiliary requests III.2 to III.4 comprises similar amendments as those of requests II.2 to II.4 where the "flush feature" does not replace but is defined in addition to the other feature (cf. item (d) above; an auxiliary request III.1 had been withdrawn during the oral proceedings before the Board).

XI. In the following the feature introduced in auxiliary request II.1 (see item X.(d) above) is referred to as the **flush feature**.

XII. The arguments of the appellant may be summarised as follows:

Main request

- (a) The subject-matter of claim 1 of the patent in suit had its basis in paragraph [0020] of the earlier application, in which the axle was disclosed as a separate component. The inventive axle should allow the axle to freely pass through all other components during the assembling while ensuring that in use forces applied to the crank arms were reliably transmitted to the axle, the second splines on the axle's end axially opposite the flange.

- (b) By the first sentence in the passage of column 7, lines 2 to 6 of the earlier application, starting with "[i]n this embodiment,...", two possibilities were implied: the splines being either flush with or radially inwardly of the outer peripheral surface of the axle body. In the following lines 6 to 14, a functional disclosure of how to design the second end portion of the crank axle body, namely so as to allow the crank axle to freely pass through other components of the bottom bracket during the assembly. The skilled person would have derived from this latter sentence that it was not required that the splines were necessarily flush with the outer peripheral

surface. The feature "*do not extend radially outwardly*" was all that was required to achieve the desired purpose. The skilled person therefore would not have attached any importance to the intermediate sentence starting with "*Instead,...*".

- (c) The "flush feature" and the feature "*do not extend radially outwardly*" had no close functional or structural connection with each other, so that it was not required to include both of them in the claim, the claimed feature could be isolated (in line with T 1067/97, T 25/03, T 724/11 and T 1408/04). Whether certain subject-matter was directly and unambiguously "derivable" did not mean that the skilled person was bound to the literal disclosure; rather it implied that the skilled person upon appreciation of the function to be achieved would consider and thereby derive (see T 461/05) which features were essential in this respect. Paragraphs [0020] and [0023] made clear that the axle which could be freely passed through other components was the core of the invention.
- (d) The hypothetical stance could be taken that the claim initially comprised the "flush feature". Applying the essentiality test (see T 331/87) to such a claim would then clearly have confirmed that the "flush feature" could have been removed. For the same reasons, the "flush feature" could then be omitted when the feature "*do not extend radially outwardly*" was included in the claim.

- (e) Similarly, when applying the novelty test (see the recent decisions T 1825/09, T 1122/09, T 1617/07, T 153/07) it was clear that the subject-matter of claim 1 was not new compared to the earlier application, whereby this test also confirmed that the claimed subject-matter of the patent in suit did not extend beyond the content of the earlier application as filed.
- (f) Having regard to G 1/93, it was clear that the "flush feature" could be omitted without infringing Article 123(2) EPC. It did not provide any further technical teaching with respect to the purpose of enabling an axle to freely pass other components but simply constituted a further and unnecessary limitation to the claimed subject-matter.

Auxiliary requests of group I

- (g) The auxiliary requests of these groups were allowable for essentially the same reasons as given with respect to the main request. Furthermore, the features added in auxiliary request I.2 were based on paragraph [0024] of the earlier application and specified the function of the axle's second end to freely pass the cited components. The addition of the "flush feature" was therefore needless.

Auxiliary requests of group II

- (h) The deletion of the feature "*do not extend radially outwardly*" was necessary in order to

avoid any inconsistency arising from the introduction of the "flush feature" as literally disclosed in the earlier application. This deletion did not extend the scope of protection (Article 123(3) EPC) because the "flush feature" excluded that the splines extended radially outwardly relative to the outer peripheral surface along their entire axial extension, as could also be seen from Figure 2 of the earlier application.

Auxiliary requests III.2 and III.3

- (i) These requests were submitted in reaction to the objections raised for the first time in the oral proceedings. All outstanding objections raised so far in the opposition and opposition-appeal proceedings were removed, so that novelty and inventive step could be discussed. These requests had never been submitted before the opposition division, so that their discussion in the first instance would not have been possible. Applying Article 12(4) RPBA and not admitting these requests on the ground that a formally similar request had been withdrawn in the first instance proceedings deprived the appellant of its right to defend its case. That a similar request had been withdrawn before the opposition division was motivated by the conduct of the first instance proceedings. In the oral proceedings the opposition division announced their notion on inventiveness even though the discussion circled on the issue of inadmissible extension. This and the change of mind of the first examiner, who had been the first examiner also in the grant

procedure and thereby had already acknowledged that the subject-matter concerning this respective feature was not inadmissibly extended, motivated the proprietor to withdraw the 2nd auxiliary request as to move on to appeal proceedings without further discussions, as apparently, the opposition division was not willing to take any arguments of the proprietor into consideration.

Auxiliary requests III.4

- (j) Claim 1 of the request comprised amendments which related to the axle's function of "freely passing" other components added in the characterising portion. This amendment required also that references to some further features, like the adapter assemblies, were included. Already the granted claim comprised references to other features. The claim was thus clear, prima facie allowable and should be admitted.

Rule 106 EPC - violation of Article 113 EPC

- (k) The Board translates the reasons submitted by the appellant in its written objections under Rule 106 EPC as follows (the original text in German language is found in the annex to the minutes to the oral proceedings before the Board):

"The appellant objects to a violation of Article 113 EPC, because it was deprived of its right to be heard in view of the auxiliary requests of group III (requests III.2-III.4).

As justification the appellant points out that these requests (according to group III), taken individually or in their entirety, were not identical with the requests withdrawn before the opposition division. To the contrary, concerning the requests III.2 and III.4 the respective introduction of the feature

"said second end portion (354) of the axle body (348) has a threaded inner peripheral surface (368) for screwing an axle bolt (380) therein."

represented different requests, which were not prejudiced through the withdrawal of the auxiliary requests submitted in the first instance. In the case of the request III.3 also additional features have been added. It was neither obvious nor could it reasonably have been expected to submit these request with these additional combinations of features during the oral proceedings before the opposition division. There were no indications given by the division, nor did the course of the proceedings motivate such action. The Board's consideration that the request could have been combined relied only on a retrospective view on that oral proceedings in the Appeal but did not correspond to the objective position of the proprietor during the oral proceedings before the opposition division. Moreover, auxiliary requests III.2 and III.4 addressed

and removed objections which had been presented for the first time during the oral proceedings, in particular that the axle could not be claimed without the feature added to the claims in auxiliary requests III.2 and III.4 without contravening Article 123(2) EPC. By this course of action the appellant's right to be heard was violated because the exercise of the discretion according to Article 12(4) RPBA against the proprietor deprived him of the possibility to defend his patent with an otherwise prima facie admissible request. The same applied because the proprietor had no opportunity throughout the entire proceedings to comment on the patentability of the subject-matter of its patent application during oral proceedings."

XIII. The arguments of the respondents may be summarised as follows:

Main request

- (a) Irrespective of the question whether the axle, which was disclosed consistently in the claims and the description as part of an assembly, could be claimed as a separate invention, the axle did not comprise all the features disclosed in combination in paragraph [0020] and shown in Figure 2. The claimed subject-matter constituted an inadmissible intermediate generalisation of what was disclosed in the description. There was no disclosure in paragraph [0020] of the earlier application that

the "flush feature" could be omitted. The passage of paragraph [0020] in column 6, line 56 to column 7, line 6, had to be understood in its entirety and features disclosed therein could not be taken out of their context. The use of the term "*instead*" evidently emphasised the preceding statement and did not disclose the "flush feature" as an optional feature. It was irrelevant whether or not alternative embodiments would have the same effect. It was only decisive whether an embodiment was disclosed. Here, only a single embodiment was disclosed with flush splines.

Auxiliary requests

- (b) The auxiliary requests of group I suffered the same defect as the main request.
- (c) The deletion of the feature in claim 1 of the auxiliary requests of group II extended the scope of protection (Article 123(3) EPC) because it was not anymore required that the splines did not extend radially outwardly relative to the outer peripheral surface of the axle body. It covered now embodiments where the splines were flush but could extend radially outwardly to said surface, for example if the ridges of the splines curved outwardly, joining said surface flush at one of their ends and extending outwardly at their opposite end coinciding with the axle's extreme end.
- (d) The auxiliary request III.2 should not be admitted into the proceedings because they only now

responded to objections which existed from the onset of the entire proceedings. The appellant-proprietor decided after half an hour of interruption of the oral proceedings before the opposition division on his own motion to withdraw the then pending "2. auxiliary request" which overcame the outstanding objection. As a consequence the proprietor avoided a discussion and a decision to be taken on patentability. The amendment introduced in addition to the "flush feature" also could have already been discussed before the opposition division if the proprietor had not withdrawn the corresponding request before the opposition division. The additional feature added in claim 1 of auxiliary request III.2 was anyway already present in the "5. auxiliary request" in the opposition proceedings. Moreover, the request was not motivated by the discussions in the oral proceedings before the Board.

- (e) Claim 1 of the auxiliary request III.4 lacked clarity because it referred to a number of features which were not features of the axle. It was not clear what limitation should be imposed to the axle if it was not clear how the features referred to were structurally constituted. It was not prima facie allowable and should not be admitted into the proceedings.

Reasons for the Decision

Procedural issues

1. The board understands the appellant's requests for remittal and/or correction under item VII above in the following way:
 - (a) the case be remitted for further prosecution concerning the question whether a "bicycle crank axle" was disclosed in the earlier application as subject-matter able to be claimed independently, or
 - (b) the case be remitted to the opposition division for further prosecution concerning the basis for revocation, and/or
 - (c) the decision be corrected concerning the basis for revocation.

- 1.1 Remittal of a case to the department of first instance lies in the Board's discretion under Article 111(1) EPC 1973 after having examined the allowability of the appeal.

According to Article 11 RPBA, a case may be remitted if in the proceedings before the first instance fundamental deficiencies are apparent.

In decisions of the European Patent Office, only linguistic errors, errors of transcription and obvious mistakes may be corrected (Rule 140 EPC).

- 1.2 Request a) may only be considered as a request under Article 111(1) EPC 1973, because a fundamental

deficiency in the first instance proceedings is not alleged in this context. However, since the appeal is anyway not allowed and does not even depend on the outcome of the formulated question, this request for remittal is rejected.

- 1.3 Having regard to the requests b) and c), both are based on the citation of a wrong Article in the impugned decision.
 - 1.3.1 The patent in suit was opposed *inter alia* on the ground that the subject-matter of the European patent extended beyond the content of the earlier application as filed (Article 100(c) EPC 1973). In the reasons of the impugned decision the opposition division held however that claim 1 of the main request, as well as that of the then pending auxiliary requests 1 to 7, did not meet the "requirements of Article 76(1) EPC" (see Reasons for the decision, end of items 2.1, 2.2 and 3.).
 - 1.3.2 Article 76(1) EPC 1973 sets out the conditions for filing a European divisional application. As a consequence arising from this provision, the Examining division is required to compare the content of the divisional application as filed and as amended during the procedure up to the grant of a patent with the content of the earlier application as filed (see also G 1/05, OJ EPO 5/2008, 271, item 3 of the Reasons).
 - 1.3.3 Article 100 EPC 1973 exhaustively sets out the grounds on which an opposition may be filed, and its paragraph (c) defines *inter alia* the ground that the subject-matter of the European patent extends, if the patent was granted on a divisional application, beyond the

content of the earlier application. It thus requires that the opposition division compares the subject-matter of the granted European patent (and not that of its underlying divisional application, see G 1/05, *ibid*, item 3.6), including claims, description and figures as granted, with the content of the earlier application as filed.

- 1.3.4 This Board finds that Article 100(c) EPC [1973] would have been the correct provision to be cited in the decision of the opposition division when the claims of the granted patent in suit were considered.

With respect to amendments made to the claims in the course of the opposition procedure, Article 101(3)a) and b) EPC sets out that the opposition division should form an opinion on whether or not the patent and the invention to which it relates meet the requirements of the Convention. Frequently Article 76(1) EPC is invoked in decisions of the opposition divisions, and is also referred to in some decisions in opposition-appeal proceedings by the Boards of Appeal, when the amended subject-matter is examined with respect to the content of the earlier applications as filed. Article 76(1) EPC relates however to a requirement for filing a divisional application, which is not a requirement of the Convention for an (amended) patent. This Board considers that the requirement of Article 123(2) EPC, which although not explicitly referring to the content of the "earlier application(s)", is the corresponding requirement of the Convention, in the sense of Article 101(3) EPC, to be met by the patent in relation to amendments made thereto, with respect to the content

of the earlier and of the divisional application(s) as filed.

- 1.3.5 As is apparent from item 12 of the "Facts and Submissions" and for example from the beginning and the end of item 2.1 of the "Reasons" in the impugned decision, the opposition division consistently and correctly compared the subject-matter of the granted claim with the content of the earlier application as filed, and thereby correctly examined the ground of opposition raised by the opponent in the notice of opposition. The opposition division did not comment or take any decision on the legal status of the divisional application underlying the patent in suit. That the opposition division erroneously referred to Article 76(1) EPC [1973] has no impact on the substance of the decision and at most constitutes an error in the citation of the correct Article of the EPC. For the decision taken, in substance, there is however absolutely no difference, since the same principles were applied.

From the grounds of appeal and the subsequent submissions in the appeal proceedings, it is abundantly clear that the appellant understood the reasons why the decision revoking the patent had been taken and presented detailed arguments as to why the opposition division's conclusions in their substance were wrong.

- 1.4 A wrong citation of legal provisions alone, without any impact on the examination in substance (see 1.3.5), does not make an appeal allowable. Consequently Article 111(1) EPC 1973 cannot form a basis for the

appellant's request for remittal referred to under 1.b) above.

The appellant did not assert that the proceedings leading to the impugned decision had suffered from a fundamental deficiency of this nature. The Board itself is also unable to identify any procedural defect in the opposition proceedings (see above 1.3.5). Consequently, Article 11 RPBA also cannot form a basis for this request.

The request referred to under item 1.b) for remittal for further prosecution concerning the basis for revocation is thus rejected.

- 1.5 The request referred to under item 1.c) to correct the wrong reference to Article 76(1) EPC 1973 might only be considered to fall under the third category mentioned in Rule 140 EPC. The Board is not competent to decide on a request for correction of a written decision taken by the opposition division.

For this reason the appellant's request for correction under Rule 140 EPC is rejected.

It may be useful to add that it appears anyway that such correction might not have been possible at all, even if this request for correction had been made to the opposition division. Although the impugned decision contains an error in the citation of the relevant Article of law, there is no evidence upon which the conclusion could be reached that this is an obvious mistake within the meaning of Rule 140 EPC. In the opposition division's communication in the annex to the

summons to oral proceedings, as well as in the corresponding minutes, reference was made consistently to Article 76(1) EPC [1973]. It is therefore not clear that the opposition division intended anything else than what is stated in the impugned decision.

Main request - Article 123(2) EPC

2. The question to be decided is whether the earlier application as filed discloses a bicycle crank axle comprising second splines which, without being necessarily flush with the outer peripheral surface of the axle body, do not extend radially outwardly relative to said surface.
- 2.1 The combination of the features of the crank axle as defined in claim 1 of the main request, which was not the subject-matter of any claim in the earlier application, can only be seen to be based on the paragraph [0020] of the earlier application. This paragraph discloses in detail the sole embodiment of a bicycle crank axle. Lines 2 to 6 of column 7 thereof read: "*In this embodiment, splines 370 do not extend radially outwardly relative to the outer peripheral surface 362 of axle body 348. Instead, the splines 370 are flush with the outer peripheral surface of 362 of axle body 348.*". The expression "*instead*" in the second sentence establishes a direct link to the previous sentence. It more precisely limits the preceding statement, namely that in "*this embodiment*", which is the sole embodiment disclosed, the splines, which do not extend radially outwardly, are flush with the outer peripheral surface. Therefore the feature "*do not extend radially outwardly*" taken in isolation from this

passage constitutes a generalisation of the single embodiment with flush splines.

2.2 The appellant could not indicate any other passage in the earlier application as filed relating to the structure and function of the second splines from which this generalisation would have been directly and unambiguously derivable and the Board is also unable to find such basis.

2.3 Although the Board can agree with the appellant that the purpose mentioned in the lines 6 to 14 of column 7, which is to enable the second end portion of the axle body to pass freely through other components, could seemingly be obtained also with splines which are radially inwardly compared to the outer peripheral surface, this is nevertheless not sufficient to establish that the generalised feature, as present in the claim, is directly and unambiguously derivable from the earlier application. The skilled person is not supposed to apply common general knowledge in order to derive alternative embodiments (i.e. in this case, splines other than flush) or a general teaching ("*do not extend radially outwardly*") from a function attributed to a specific feature (flush splines in the single embodiment), unless there is a specific hint to do so, such as a clear statement to the effect that a certain function may be embodied differently by other known means or by the disclosure of other alternative embodiments. In the present case, there is no clear and unambiguous indication in the earlier application that would have led the skilled person to consider such alternative embodiments or the generalised feature in the claim 1.

Paragraph [0023] of the earlier application, to which the appellant referred to underline that the core of the invention was the axle and its ability to perform the above function, does not mention the configuration of the splines at all and can therefore not serve as a basis for the generalisation of the corresponding feature either.

2.4 The appellant's argument that the feature "*do not extend radially outwardly*" has no close functional relationship with the "flush feature" or even with other features of the claim, is not persuasive. It is meaningless to consider whether a generalised feature interacts with itself in its more specific form. The decisions T 1067/97, T 25/03, T 724/11 and T 1408/04 referred to by the appellant in this respect (cf. item XII(c) above) are thus of no relevance.

2.5 The so called "essentiality test" relied on by the appellant, is occasionally applied by the Boards in cases where it has to be determined whether a feature originally comprised in an independent claim may be omitted from it. The present case is different from that situation in that the earlier application did not comprise any claim directed to the axle. Rather, the claimed subject-matter entirely relies on the disclosure of the single embodiment in the description. The appropriate test for such subject-matter is to establish whether the resulting combination of features is directly and unambiguously derivable from the earlier application as filed, here in particular, whether a bicycle crank axle with all the features of

claim 1 but without the "flush feature" is disclosed in the earlier application as filed.

2.6 Irrespective of whether the so-called "novelty test" is at all appropriate to decide on the disclosure of subject-matter resulting from the generalisation of some specific feature, the above conclusion on added subject-matter would not be changed. By simply extracting a part of the disclosure "do not extend radially outwardly" the resulting subject-matter concerns a bicycle crank axle with splines on the axle's second end portion which may be flush with or which may end radially inwardly of the outer peripheral surface. Only the first alternative is disclosed. The second alternative constitutes new technical content because there is no disclosure for splines ending radially inwardly.

2.7 The appellant also referred to G 1/93 (OJ EPO 1994, 541), alleging that the "flush feature" merely represented a further limitation without any further technical contribution. The questions answered in G 1/93 address a different point of law. It is concerned with the conditions for amending granted claims in which an originally undisclosed technical feature, limiting the scope of protection of the claims in comparison with the application as filed and published, had been added during examination without contravening the requirement of Article 123(3) EPC. Here, the question is whether the earlier application as filed discloses a crank axle without the "flush feature". This application did not comprise any claim directed to an axle, let alone a claim which comprised the "flush feature" as an originally undisclosed

feature. The "flush feature" provides anyway a clear technical contribution to the invention since it is a selection of embodiments with flush splines out of all possible spline configurations which do not extend outwardly compared to the outer peripheral surface. In this respect it is irrelevant whether or not this feature provides an additional technical function compared to that achieved by the more general feature of non-outwardly extending splines.

- 2.8 At least for the above reasons the Board concludes that the subject-matter of claim 1 according to the main request extends beyond the content of the earlier application as filed and therefore does not meet the requirement of Article 123(2) EPC.

Auxiliary requests of group I - Article 123(2) EPC

3. The appellant conceded that the auxiliary request I.1 does not comprise any amendments which are appropriate to overcome the foregoing objections with respect to the main request.

The appellant argued however that the feature added in auxiliary request I.2, which additionally defined the function to be achieved through the configuration of the second splines overcame this deficiency and resulted in subject-matter which did not extend beyond the content of the earlier application as filed. The Board finds this argument unconvincing, since the functional statement has been taken from the above cited passage of the description, ignoring thereby that it is disclosed only in the context of the previously disclosed features of the single embodiment of the

crank axle, which comprises the flush splines. The appellant saw in the statements in paragraph [0024] of the earlier application support that alternative embodiments to achieve disclosed functions were well within the ambit of the original disclosure and would have been considered by the skilled person. In the Board's view the statements made in paragraph [0024] are far too general. The skilled person does not unambiguously derive any further information with respect to the configuration of the second splines relative to the axle body's outer surface. The subject-matter of claim 1 of auxiliary request I.2 is consequently still more general than what is disclosed in the earlier application.

The amendments to claim 1 according to auxiliary request I.3 are a combination of the amendments in auxiliary requests I.1 and I.2. The above objections are not overcome by this combination.

Consequently, the amendments to claim 1 of the auxiliary request of group I do not meet the requirement of Article 123(2) EPC.

Auxiliary requests of group II - Article 123(3) EPC

4. The deletion of the feature that the "second splines do not extend radially outwardly relative to the outer peripheral surface of the axle body" in claims 1 of the auxiliary request of group II extends the scope of the claims beyond that of granted claim 1. Although the crank axle is now limited to flush splines, it covers embodiments in which the splines are flush at the position where they join said surface and extend

outwardly relative to it at some distance from that position in the axial direction to the extreme end of the axle's second end portion. The appellant contested that the amended claims allowed the second splines to extend radially outwardly since the term "flush" would be understood by the skilled person in the light of the description and in particular with reference to Figure 2 in the sense that the second splines maintain their radial height over their entire axial length. The Board considers that the wording of the claims is clear in respect to the meaning of the feature "second splines are flush", so that it does not require any (limiting) interpretation in view of the embodiments. The amended claims of the auxiliary requests of group II do not exclude that the second splines, while being flush, may have varying height along their extension in the axle's axial direction so that the scope of the claim is extended.

Thus, the amendments to claim 1 of the auxiliary requests of group II contravene the requirement of Article 123(3) EPC.

Auxiliary requests III.2 and III.3 - Article 12(4) RPBA

5. During the oral proceedings before the opposition division the appellant-proprietor withdrew the "2. auxiliary request", submitted on 15 December 2008, which as the only request then on file included the "flush feature" and thereby had the potential to overcome the outstanding objections raised before the opposition division on added subject-matter in view of the earlier application. A corresponding request submitted on 23 August 2012 as auxiliary request III.1

also has been withdrawn during the oral proceedings before the Board.

6. The subject-matter of the present auxiliary requests III.2 and III.3 differs from that of the withdrawn request(s) only by the respective features "inner thread" (III.2) and by the function attributed to the flush splines (III.3), which have been defined in addition to the "flush feature" (cf. respective auxiliary requests I.1 and I.2 without the "flush feature"). Essentially the same subject-matter comprising these two features except for the "flush feature" was defined in the 5. and 8. auxiliary request submitted by the proprietor on 15 December 2008, which, with different numbering, were subject to the impugned decision. The Board concedes that the very same subject-matter or combination of features as that underlying the auxiliary requests III.2 and III.3 has not been presented before the first instance.

7. The Board nevertheless finds that these requests could have been submitted already in the opposition proceedings. In a communication issued by the opposition division in preparation for the oral proceedings, dated 1 September 2008, the division gave a reasoned preliminary opinion on why it considered *inter alia* the omission of the "flush feature" to contravene the "requirement of Article 76(1) EPC" and literally pointed out how to overcome this objection. Also from the minutes of the oral proceedings it is apparent that the same issue had been discussed by the parties in detail. The reasons given in the communication in respect of the omission of the "flush feature" correspond essentially to those in the

impugned decision. Thus, the appellant was fully aware already in the proceedings before the opposition division that any amendment based on the embodiment in paragraph [0020] of the earlier application, including those of the then pending 5. and 8. auxiliary requests, would have required also the definition of the "flush feature" in order to overcome the objection on added subject-matter.

8. The appellant did not present any arguments why he could not have filed such requests already before the opposition division. Rather, the appellant argued (see also the letter of 23 August 2012, page 9, paragraphs before item II.3.2) that the conduct of the opposition division motivated him to withdraw the second auxiliary request in order "to move on to appeal proceedings without further discussions, as apparently, [the] opposition division was not willing to take any of the arguments of the proprietor into consideration, whereby at least the 1st examiner was formerly in conformity with [the] proprietor".

Besides being an argument why the appellant did not present the corresponding requests, instead of being an argument why he could not do so, the Board is unable to see any misconduct or lack of fairness of the opposition division throughout the proceedings which would have impeded the proprietor to submit the required amendments also in the respective auxiliary requests 5 and 8 of 15 December 2008 or in the corresponding request underlying the impugned decision. The division gave fair chance to the proprietor in pointing out prior to the oral proceedings, which amendments it considered appropriate. Also the minutes

of the oral proceedings, which were not contested by the appellant e.g. by filing a request for correction, do not throw any shadow on the division's conduct. After extensive discussions on the relevant issue, followed by half an hour deliberation which at least does not exclude that the division was willing to consider the proprietor's arguments, the division announced its opinion on the extension of subject-matter in the main request. It then granted the proprietor upon request another half an hour of adjournment to re-consider the remaining requests. That the opposition division was not willing to follow the proprietor's arguments on the issue of added subject-matter in view of the earlier application seems simply to mean that they were not convinced by these arguments. It is also not relevant in this respect that the first examiner in the grant and opposition proceedings was the same person. The first instance decided in both proceedings in a composition of three examiners and it was only the first examiner who acted in both proceedings. Whether or not the first examiner changed his mind on the issue of the "flush feature" is not substantiated by any fact, and even if this would have been the case, there is no provision in the EPC which would bind an individual examiner, let alone an entire opposition division, to a conclusion reached in the preceding grant procedure. The appellant could thus not expect from the outcome of the grant procedure that the opposition division would have followed the appellant's arguments. Such diverging conclusions on the question of added subject-matter may thus not be interpreted as unwillingness on behalf of the opposition division. The allusion of the appellant that the division had presented its "notion on inventive

step" at a moment where the inadmissible extension of the subject-matter was discussed remains vague and as such also does not prove that the division was not willing to take into account any of the appellant's arguments.

Even if the division would have had a pre-conceived opinion on patentability, which remains entirely unproven, it would nevertheless have been possible to discuss novelty and inventive step and to also reach a decision on these issues. The appellant thereby still would have been able to defend its patent in the appeal proceedings based on requests which did not include the relevant features and to have an allegedly pre-conceived and wrong decision of the opposition division on novelty and inventive step rectified.

But this is not what the appellant chose to do. The intention of the appellant by withdrawing the request was to obtain, "without further discussions" (see appellant's letter of 23 August 2012), an appealable decision on just the question of added subject-matter, although it was clear that a decision on novelty and inventive step could have been taken if the obviously required and indicated amendments would have been introduced. The proprietor deliberately chose to avoid any decision on patentability.

That the auxiliary request III.2 and III.3 have only "similarity" with the auxiliary requests 5 and 8 considered by the opposition division (filed 15 December 2008) is not an argument why the corresponding amendment could not have been carried out in the respective requests before the division.

Similarly, the argument that the other added features in these auxiliary requests III.2 and III.3 overcame further objections raised by the respondents during the oral proceedings before the Board, so that these requests were filed for different reasons as the respective requests before the opposition division, which at that time addressed novelty and inventive step, is not persuasive. These requests had been filed prior to such objections and the Board had not stated any opinion on such issue.

The Board therefore is not convinced by the reasons put forward by the appellant why the auxiliary requests III.2 and III.3 could not have been submitted before the opposition division and exercises its discretion according to Article 12(4) RPBA to not admit these requests into the proceedings.

Auxiliary request III.4 - Article 13(1) RPBA

9. Claim 1 of this request comprises in combination the features introduced individually in auxiliary requests III.2 and III.3, together with the "flush feature". Based on the description, the features added to the claim thereby define the crank axle by reference to a number of features which do not belong to the crank axle. For example, the adapter assemblies, through which the axle shall be rotatably supported, cannot be regarded as commonly known and standardised components of bicycle crank assemblies. It remains unclear what structural limitations would be imposed by these definitions to the crank axle itself. The amendments

introduced into the claim thus result in subject-matter which seemingly lacks clarity (Article 84 EPC).

It is of no relevance when considering these amendments that the original claim already comprised references to other features not being part of the crank axle. The added features refer to further components which were originally not defined in the claim, so that their introduction leads to this objection which cannot be overlooked for the simple reason that the claim may have lacked clarity also from the beginning. That the amendments were necessary in this particular form in order to avoid any further problem with respect to added subject-matter is also found unconvincing. It simply highlights the general difficulty that arises from the attempt to single out and claim the crank axle in a divisional application as a separate component of an assembly which was originally disclosed in combination in the earlier application, seemingly without any direct and unambiguous disclosure that the crank axle might constitute an invention on its own, for example in form of an independent claim or appropriate statements in the description.

The auxiliary request III.4 is thus not *prima facie* allowable in the sense that it overcomes the outstanding objections with respect to the former requests without introducing new problems. The request III.4 is, in view of at least procedural efficiency, thus not admitted into the proceedings according to Rule 13(1) RPBA.

10. In view of the foregoing conclusions, the Board wishes to note that although the right to file a divisional

application for an earlier European patent application is not limited by any other conditions as those set out in Article 76 EPC and in the corresponding Rules of the Implementing Regulations, not every European patent application has the potential for subsequently dividing out further inventions. Even in cases like the present where a number of separate, though interacting components are disclosed and which at first sight appear to constitute a pool of separate inventions, the way in which these components are disclosed in the earlier application may hamper in some cases their division and prosecution as subject-matter of a divisional application. Subject-matter which was not presented in an independent claim of the earlier application and which may only be derived from the description and the figures would generally appear to be more difficult to claim in a subsequent divisional, in particular if the earlier application disclosed only a single embodiment with little or no statements concerning possible alternatives or generalisations.

Objections under Rule 106 EPC

11. The Board is unable to see any violation of the appellant's right to be heard (Article 113 EPC) in not admitting the auxiliary requests III.2, III.3 and III.4. It is clear from the above (see items XII.(i) and (j) and items 8 and 9) that the appellant had had adequate opportunity, in writing in reply to the Board's communication and during the oral proceedings, to argue why these requests should have been admitted. The Board was not convinced by these arguments and decided to exercise the discretion under Articles 12(4) and 13(1) RPBA, respectively, to not admit them for the above

reasons. The arguments submitted with the written objection under Rule 106 EPC during the oral proceedings do not point to any procedural violation committed by the Board. Rather, by contradicting the Board's position according to which some requests (III.2 and III.3) could have been filed earlier, which allegedly relied on the Board's retrospective view on the first instance proceedings, the appellant merely expresses that he disagrees with the arguments on this issue. Contrary to what appears from the appellant's arguments suggesting that all requests had been rejected with reference to Article 12(4) RPBA, the Board made a clear distinction between auxiliary requests III.2 and III.3 on the one side, which were not admitted under Article 12(4) RPBA, and auxiliary request III.4 on the other side, which was not admitted under Article 13(1) RPBA. As has been set out above, the first set of requests could reasonably have been expected to be submitted earlier on an objective basis because essentially the same combinations of features except for the "flush feature" constituted subject-matter in first instance requests. The other request defined a combination of features which was never pending before the first instance. It was nevertheless not admitted because, in view of at least procedural efficiency, it was *prima facie* not allowable.

The Board notes that the appellant indeed had no opportunity to argue on the patentability of the subject-matter during the entire proceedings. This is however not the result of an inappropriate way in which the Board exercised its discretion to not admit certain requests. Rather, as far as auxiliary requests III.2 and III.3 are concerned, it is the consequence of the

appellant's deliberate choice to avoid such discussions before the opposition division. It is the purpose of Article 12(4) RPBA to assure an overall efficient procedure and to avoid that decisions in the first instance are taken on a piecemeal manner at the parties' will. With respect to auxiliary request III.4, it results from the presence of further deficiencies introduced by amendments filed after the end of the appeal period.

The objections under Rule 106 EPC are therefore dismissed.

Order

For these reasons it is decided that:

1. The objections under Rule 106 EPC are dismissed.
2. The appeal is dismissed.

The Registrar

The Chairman

M. Patin

M. Harrison