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**Datasheet for the decision
of 11 September 2020**

Case Number: T 0801/18 - 3.2.01

Application Number: 11153607.4

Publication Number: 2357098

IPC: B60G17/018, B62K25/00,
B62K25/04

Language of the proceedings: EN

Title of invention:

Method and apparatus for suspension adjustment

Patent Proprietor:

Fox Factory, Inc.

Opponent:

Öhlins Racing AB

Headword:

Relevant legal provisions:

EPC Art. 54(1), 56, 100(a), 100(c), 111(1)
RPBA 2020 Art. 11, 13(1)

Keyword:

Novelty - main request (no) - auxiliary request 2 (no) -
auxiliary request 4 (yes)
Late-filed auxiliary requests 1 and 3 - admitted (no)
Inventive step - auxiliary request 4 (yes)
Remittal to the department of first instance - adaption of
description (yes)

Decisions cited:

T 0634/16, T 0032/16

Catchword:



Beschwerdekammern

Boards of Appeal

Chambres de recours

Boards of Appeal of the
European Patent Office
Richard-Reitzner-Allee 8
85540 Haar
GERMANY
Tel. +49 (0)89 2399-0
Fax +49 (0)89 2399-4465

Case Number: T 0801/18 - 3.2.01

D E C I S I O N
of Technical Board of Appeal 3.2.01
of 11 September 2020

Appellant: Fox Factory, Inc.
(Patent Proprietor) 915 Disc Drive
Scotts Valley, CA 95066 (US)

Representative: Casbon, Paul Richard
Lucas & Co
135 Westhall Road
GB-Warlingham, Surrey CR6 9HJ (GB)

Appellant: Öhlins Racing AB
(Opponent) Box 722
194 27 Upplands Väsby (SE)

Representative: Thum, Bernhard
Wuesthoff & Wuesthoff
Patentanwälte PartG mbB
Schweigerstraße 2
81541 München (DE)

Decision under appeal: **Interlocutory decision of the Opposition
Division of the European Patent Office posted on
18 January 2018 concerning maintenance of the
European Patent No. 2357098 in amended form.**

Composition of the Board:

Chairman W. Marx
Members: V. Vinci
A. Jimenez

Summary of Facts and Submissions

- I. The appeals by the opponent (appellant I) and the patent proprietor (appellant II) are directed against the decision of the opposition division to maintain European patent No. 2 357 098 in amended form on the basis of the first auxiliary request filed during the oral proceedings.
- II. In its decision the opposition division held, *inter alia*, that the subject-matter of claim 1 of the main request filed with letter dated 13 October 2017 did not extend beyond the content of the application as filed but was not new over document **D2** (US 2003/0216845 A1). The subject-matter of claim 1 according to the first auxiliary request as filed during the oral proceedings was found admissible (Articles 84 and 123(2) EPC), new over the disclosure of documents **D1** (EP 2 103 512 A2) and **D2** and inventive starting from **D1** as the closest prior art.
- III. Together with its grounds of appeal dated 28 May 2018 the appellant II (patent proprietor) filed auxiliary requests 1 to 8 and maintained auxiliary requests 1 to 3 as filed on 13 October 2017, which were renumbered as auxiliary requests 9 to 11, respectively. Together with its reply to the opponent's appeal the appellant II filed auxiliary requests 12 and 13 with letter dated 11 October 2018, and with letter of 24 June 2020 further auxiliary requests 14 to 27.
- IV. Oral proceedings before the board took place on 11 September 2020.

The **appellant II (patent proprietor)** requested that the decision under appeal be set aside and the patent be maintained on the basis of the main request filed with letter of 13 October 2017, or in the alternative, that the patent be maintained in amended form based on:

- auxiliary request 1, filed as auxiliary request 15 with letter of 24 June 2020, or
- auxiliary request 2, filed as auxiliary request 6 with the grounds of appeal dated 28 May 2018, or
- auxiliary request 3, filed as auxiliary request 20 with letter of 24 June 2020, or
- auxiliary request 4, filed as auxiliary request 7 with the grounds of appeal dated 28 May 2018.

The appellant I (opponent) requested that the patentee's appeal be dismissed, and that the decision under appeal be set aside and the patent be revoked.

V. Claim 1 according to the **main request** corresponds to claim 1 as granted and reads, broken into a feature analysis adopted by the parties, as follows:

Feature 1 A system (1000) for a vehicle (100), comprising:

Feature 2 a vehicle suspension (25; 80) having a user-adjustable feature for adjusting performance of the vehicle suspension;

Feature 3 a sensor (5, 5b, 5c, 35; 200) operable to measure an operational characteristic of the vehicle suspension (25; 80) and to output a signal representative of said operational characteristic; and

Feature 4 a processor (65; 300) in communication with the sensor (5, 5b, 5c, 35; 200) and operable to receive and process said signal;

characterized in that

Feature 5 said processor (65; 300) is operable to generate a suggested adjustment (370) of the user-adjustable feature based on the processing of said signal, which suggested adjustment would change the performance of the vehicle suspension (25; 80),

Feature 6 and to output said suggested adjustment for indication to the user.

Claim 1 according to **auxiliary request 1** was amended, in comparison to the main request, by adding the following features:

Feature 7 wherein the system further comprises a communication device (500) operable to communicate with the processor (35; 300) and display data corresponding to the operational characteristic measured by the sensor (5, 5b, 5c, 35; 200);

Feature 8 characterized in that the communication device (500) is operable by the user to make the suggested adjustment (370) to the user-adjustable feature of the vehicle suspension (25; 80).

Claim 1 according to **auxiliary request 2**, as compared to claim 1 of auxiliary request 1, reads as follows (features added are underlined; features deleted struck through):

Feature 1 A system (1000) for a vehicle (100), comprising:

Feature 2' a vehicle suspension (25; 80), wherein the vehicle suspension comprises a vehicle shock absorber, wherein the vehicle shock absorber is mounted between an unsprung portion of the vehicle and a sprung portion of the vehicle and having a user-adjustable feature for adjusting performance of the vehicle shock absorber suspension;

Feature 3' a sensor (5, 5b, 5c, 35; 200) operable to measure an operational characteristic of the vehicle shock absorber suspension ~~(25; 80)~~ and to output a signal representative of said operational characteristic; and

Feature 4 a processor (65; 300) in communication with the sensor (5, 5b, 5c, 35; 200) and operable to receive and process said signal;

characterized in that

Feature 5' said processor (65; 300) is operable to generate a suggested adjustment (370) of the user-adjustable feature based on the processing of said signal, which suggested adjustment would change the performance of

the vehicle shock absorber suspension (25; 80),

Feature 6 and to output said suggested adjustment for indication to the user;

Feature 7 wherein the system further comprises a communication device (500) operable to communicate with the processor (35; 300) and display data corresponding to the operational characteristic measured by the sensor (5, 5b, 5c, 35; 200);

Feature 8 characterized in that the communication device (500) is operable by the user to make the suggested adjustment (370) to the user-adjustable feature of the vehicle suspension (25; 80).

As compared to claim 1 of auxiliary request 2, claim 1 according to **auxiliary request 3** comprises the following additional features 4a and 6a inserted behind features 4 and 6.

Feature 4a wherein, the processor (65;300) is able to monitor the vehicle shock absorber movement;

Feature 6a and wherein the suggested adjustment of the user-adjustable feature is based on data from the monitoring of the vehicle shock absorber movement, rider input data, and vehicle shock absorber product data; and

As compared to claim 1 of auxiliary request 2, claim 1 according to **auxiliary request 4** comprises the following additional feature:

Feature 9 wherein the vehicle suspension includes a damper valve, and the operational characteristic is a position of the damper valve between a full open and a full closed setting.

Reasons for the Decision

1. The appeals of the opponent and of the patent proprietor are admissible. Requests for rejecting the respective appeals as inadmissible, as submitted in the written procedure, were no longer maintained.
2. *Main request - novelty (Article 54(1) EPC)*
 - 2.1 The subject-matter of claim 1 according to the main request is not new over the disclosure of D1.
 - 2.2 Document D1 discloses (see Figure 14) a system for a vehicle (as shown in Figure 13A), comprising a vehicle suspension comprising a vehicle shock absorber (135, see Figure 13C) having a user-adjustable feature (pressure in air piston 220; see paragraph [0093]) for adjusting performance of the vehicle suspension; a sensor (315) operable to measure an operational characteristic (sag) of the vehicle suspension and to output a signal representative of said operational characteristic; and a processor (600) in communication with the sensor (315) and operable to receive and

process said signal. So far, the board follows the analysis of the opposition division with respect to what is disclosed in D1, namely *features 1 to 4* of the preamble of claim 1.

2.3 The board finds that also the characterising *features 5 and 6* are known from D1. In this respect, it is referred to the setup process known from Figure 22 and described in paragraph [0094] of D1. The processor executes instructions

- to measure the actual sag or deflection in the suspension system through signals from sensor 315, i.e. based on measuring an operational characteristic, and
- to determine (when selecting enter button 960) the predicted or advised sag, which is the sag value expected if the rider entered the proper air pressure in air piston 220.

The advised sag and actual sag are presented to the rider on display 950. Based on the displayed data, the rider is invited to adjust the suspension settings, in case the actual sag deviates from the advised sag (which indicates an improper air pressure in air piston 220). Therewith, by providing both the advised sag and the actual sag on display 950, the processor of D1 generates a suggested adjustment of the user-adjustable feature "air piston pressure" to the user.

Admittedly, the processor does not recommend a quantitative value of an air pressure increment or decrement that has to be applied manually by the user. However, a deviation between the actual sag and the advised sag determined by the processor provides an indication whether the air pressure has to be increased or reduced. The board finds that such indication falls under the rather general wording of claim *feature 5*

which requires the processor "to generate a suggested adjustment of the user-adjustable feature based on the processing of said signal", i.e. based on the measured actual sag value.

The remaining part of *feature 5* ("*which suggested adjustment would change the performance of the vehicle*") describes the effect of performing the suggested adjustment and is considered to be not further limiting.

The advised sag and actual sag are presented to the rider on display 950, so the suggested adjustment (whether to increase or decrease the air pressure) is output in D1 for indication to the driver, as required by *feature 6*.

- 2.4 The appellant II argued that claim *features 5 and 6* imparted a clear credible technical teaching to the skilled reader: the vehicle suspension had a user-adjustable feature, and there was an output of a suggested adjustment of that feature. A "*suggested adjustment*" necessarily referred to a definitive instruction to the user. A suggestion allegedly corresponded to a concrete proposal and not just to a "mental process to influence a decision", as found by the opposition division, i.e. an "adjustment" deduced in mind of the user. The suggested adjustment of claim 1 necessarily contained a specific instruction of what to do to the user-adjustable feature. The presentation of a signal or data was not a suggestion to amend any setting, since the user had to interpret and analyse the data in order to decide if and how a user-adjustable feature should be adjusted. Nothing else could be derived from the passages cited by the appellant I in the patent specification.

Allegedly, when interpreting the wording of claim 1 and disputed *feature 5*, the preamble of claim 1 had to be taken into account which specified a sensor measuring an operational characteristic and outputting a signal representative thereof. The signal was processed by a processor, which then provided a recommendation ("*suggested adjustment*") to instruct the user (see paragraph [0096] of the contested patent: "*to instruct the user 600 on what adjustments to make*").

D1 showed two data flows: the actual sag was based on a measured value, and a suggestion (recommended air piston pressure; also: advised sag) that was given based on a rider preference, i.e. on predefined data and not based on a signal representative of an operational characteristic which was processed by the processor. Since the sag as such (a result of the different settings of suspension components) could not be adjusted and was not even a user-adjustable feature, the "advised sag" in D1 did not constitute a suggested adjustment of a user-adjustable feature. The "actual sag" was the only value calculated based on a signal representative of an operational characteristic of the vehicle, but was not a suggestion to adjust anything. The contested patent distinguished between rendition of measured data and a suggestion generated by the processor. The display 950 in D1 showing the advised sag and the actual sag was not a suggested adjustment within the meaning of claim 1 (the actual adjustment being made would be the air piston pressure), but merely a presentation of data for comparison by the user. The advised sag remained unchanged by any operational characteristic later measured about the suspension. Screen 950 in Figure 22 of D1 merely presented information to the rider whether or not he had correctly applied the recommended air pressure of screen 940. If not, this merely notified the rider that

his setting of the air piston pressure seemed not to comply with the recommendation given in screen 950. Screen 950 did not "suggest" or "instruct" anything; the "suggestion" (i.e. recommended air pressure) was determined earlier and remained unchanged.

- 2.5 However, the board agrees with the appellant I that in D1 also the measured operational characteristic (actual sag) is based on the processor processing the signal provided by sensor 315 (see Figure 14) before being displayed. Moreover, by displaying both the actual sag and the advised sag in D1, the user is presented with a suggestion for adjustment (decrease or increase) of the sag in case of a deviation between these values, which the user might follow by increasing or decreasing the air piston pressure in D1 after pressing the REDO-button (see Figure 22 and paragraph [0094] in D1). The processor in D1, by providing both the advised sag and actual sag for display to the user, thus generates a suggested adjustment of the user-adjustable feature, namely whether it is recommended to increase or decrease the air piston pressure.

Admittedly, D1 does not show a recommended air pressure value presented to the user as a definitive value or concrete proposal. The board also follows appellant II in so far that the wording of claim 1 of the main request is clear, so no interpretation taking into account the description of the patent specification is required. However, the board finds that the wording of claim 1 is broad and does not specify the nature of the suggested adjustment. In particular, it does not necessarily require that the suggested adjustment of the user-adjustable feature (air piston pressure) has to be a recommended pressure value as an explicit suggestion value. Claim 1 encompasses embodiments where

the user receives a qualitative indication regarding an adjustment of the air piston pressure, i.e. whether the pressure has e.g. to be increased (in case the actual sag is greater than the advised sag). As a consequence, the board does not follow the narrow interpretation adopted by the opposition division and the arguments of appellant II.

3. *Auxiliary request 1 - admittance*

3.1 The auxiliary request 1 was filed with the letter dated 24 June 2020 as the auxiliary request 15 after the parties had been summoned to oral proceedings. In the present case, the summons to oral proceedings was notified before the date on which the RPBA 2020 entered into force, i.e. 1 January 2020. Thus, in accordance with Article 25(3) RPBA 2020, Article 13(2) RPBA 2020 does not apply to the question whether to admit the appellant's requests filed on 24 June 2020 into the appeal proceedings. Instead, Article 13 of the Rules of Procedure of the Boards of Appeal in the version of 2007 (RPBA 2007, see OJ EPO 2007, 536) continues to apply. As held in some recent decisions (T 634/16 of 10 January 2020, points 7 to 14 of the Reasons; and T 32/16 of 14 January 2020, points 1.1.1 to 1.1.3 of the Reasons), Article 13(1) RPBA 2020 is not excluded by Article 25 RPBA 2020 and applies in addition.

3.2 The appellant II requested to have auxiliary request 1 admitted into the proceedings. Allegedly, claim 1 of this request had been filed in order to avoid an objection under Article 123(2) EPC (as raised by the appellant I against auxiliary request 6 filed with the grounds of appeal). Moreover, the subject-matter of claim 1 included a communication device to make the

suggested adjustment, thus providing a limitation over D1. The auxiliary requests 1 to 11 filed with the grounds of appeal had been filed in order to provide a limitation over document D2, which only became relevant for novelty of claim 1 of the main request during the oral proceedings before the opposition division. The proprietor had cause to file the further auxiliary request 15 on 24 June 2020 because the opponent for the first time with its submission dated 17 December 2019 commented on the relevance of document D1 vis-à-vis claim 1 as upheld by the opposition division. Since the feature differing between claim 1 as upheld by the opposition division and D1 was the same as for claim 1 as granted, the proprietor had a legitimate interest to file higher ranking auxiliary requests based on claim 1 as granted. Filing of this request, which was solely based on granted claims, at this stage of proceedings did not constitute a complex new submission or did not raise questions the board or opponent could not reasonably be expected to deal with without postponing the oral proceedings. Thus, the filing of this request did not constitute a procedural abuse.

3.3 Article 13(1) RPBA 2020 stipulates that any amendment to the case may be admitted only at the board's discretion. This discretion shall be exercised in view of, *inter alia*, the current state of the proceedings, the suitability of the amendment to resolve the issues which were admissibly raised and whether the party has demonstrated that any such amendment, *prima facie*, overcomes the issues raised by another party in the appeal proceedings or by the board and does not give rise to new objections.

3.4 With the grounds of appeal, the appellant II had filed already eleven auxiliary requests which were either

based on the main request or the first auxiliary request as discussed before the opposition division and seemingly did not claim convergent subject-matter, as stated in the board's communication pursuant to Article 15(1) RPBA dated 30 April 2020. As argued by the appellant II itself, the subject-matter of the present auxiliary request 1 deviated from auxiliary request 6 filed with the grounds of appeal in order to avoid an issue under Article 123(2) EPC raised by appellant I. However, this request was not filed within the time limit for filing a reply to the appeal of appellant I and thus constitutes an amendment to the appeal case of appellant II. Admission of this request is therefore subject to the discretion of the board and the criteria as set out in Article 13(1) RPBA 2020.

3.5 Apart from merely asserting that the communication device now included in claim 1 of auxiliary request 1 provided a limitation over D1, the appellant has failed to demonstrate why the subject-matter as specified in claim 1 of auxiliary request 1 provided a limitation over the system shown in D1 in Figure 14 (which had been referred to by the appellant I when discussing the main request) or was at least non-obvious in view of D1 (as inventive step over D1 was a further objection raised by the appellant I).

Moreover, document D1 and objections with regard to novelty and inventive step over D1 had been raised by the appellant I already with its grounds of appeal. Thus, the new request does not constitute a response to a new objection.

Since the appellant II did not demonstrate that the subject-matter of claim 1 of auxiliary request 1, *prima facie*, overcomes the issues raised by appellant I (and

the board had also doubts in this respect) and in view of its late filing not responding to any new issue, the board exercised its discretion under Article 13(1) RPBA 2020 not to admit this request into the proceedings.

4. *Auxiliary request 2*

4.1 The auxiliary request 2 was filed in due time with the grounds of appeal as the auxiliary request 6. It seeks to establish novelty over document D2. Novelty over D2 of the subject-matter of claim 1 of the main request was in dispute for the first time during the oral proceedings before the opposition division. At the end of the oral proceedings, the patent was maintained in amended form on the basis of the first auxiliary request filed during the oral proceedings.

The request of the appellant I to reject this request as late filed for not having been filed during the opposition proceedings, as raised in its letter of reply dated 10 October 2018, was no longer maintained. The board can also see no reason for not admitting auxiliary request 2 into the appeal proceedings.

4.2 The subject-matter of claim 1 according to the auxiliary request 2 is not new over document D1 (Article 54(1) EPC).

4.2.1 As compared to claim 1 of the main request, the modified *features 2', 3' and 5'* which further specify a shock absorber of the vehicle suspension are also known from document D1 (see Figure 14), as admitted by the appellant II. As regards *features 1, 4 and 6*, it is referred to the above analysis in respect of the main request showing that these features are known from D1.

The processor (600) disclosed in D1 (Figure 14) forms part of a main controller (400) which receives inputs from a joystick device (150) and is connected to a display (140), which provides the graphical user interface (GUI) shown in D1 (Figures 15 to 24). Since the display (140) displays data corresponding to an operational characteristic such as the measured actual sag (see Figure 22), provided by the processor (600) after having processed the respective sensor signal, it forms a communication device as required by *feature 7*. Moreover, D1 shows (Figure 22) that the display provides the rider with the option to re-execute the rider setup process by selecting a REDO-button (965), which gives him the possibility to adjust manually the air piston pressure in case of a deviation between the actual sag and the advised sag. Thus, the communication device of D1 is, on the one hand, operable by the rider or user (by pressing the REDO-button). On the other hand, it then allows the user to make the suggested adjustment of the user-adjustable feature (increase or decrease of air piston pressure). Thus, the board takes the view that also *feature 8* of claim 1 of the auxiliary request 2 is known from D1.

- 4.2.2 The appellant II argued that the communication device according to *features 7 and 8* was different from a graphical user interface and required
- a user-interface device communicating with the processor via a wireless coupling (see Figure 4 and paragraphs [0100] and [0117] of the patent specification) and
 - a device operable to make directly the suggested adjustment of the user-adjustable feature.

The REDO-option in D1, allegedly, did not mean that the suggested adjustment was performed by the user.

4.2.3 The argument's of the appellant II in respect of novelty of *features 7 and 8* are not convincing. The wording of claim 1 leaves open how the communication link between the processor and the communication device is established, i.e. whether wireless or by cable or by other means. Therefore, the user-interface (150) known from D1 which exchanges data with the processor (600) of the main controller (400) falls under the wording of claim 1 (*feature 7*). Moreover, the term "*communication device is operable by the user to make the suggested adjustment to the user-adjustable feature*" (*feature 8*) specifies an interaction between the user and the communication device, but is ambiguous in that it does not clearly specify whether the communication device or the user is making the suggested adjustment. D1 shows that the user, after having pressed the REDO-button (965) on the user interface which represents the communication device in D1 (i.e. it is "*operable by the user*"), is free to manually adjust the air piston pressure by re-executing the setup process (i.e. "*to make the suggested adjustment of the user-adjustable feature*"). The board follows the appellant I that *feature 8* only requires a communication device which can be operated by the user such that afterwards he has the possibility to make the suggested adjustment, irrespective of whether the adjustment is actually being performed.

4.2.4 In view of the foregoing, the board comes to the conclusion that D1 takes away novelty of claim 1 of the auxiliary request 2.

5. *Auxiliary request 3 - admittance*

5.1 The auxiliary request 3 was filed with the letter dated 24 June 2020 as the auxiliary request 20. As set out with respect to auxiliary request 1, the provisions of Article 13(1) RPBA 2020 apply in this case.

5.2 The appellant II asked for admission of the auxiliary request 3 into the appeal proceedings in view of the surprising interpretation of claim 1 of auxiliary request 2, presented for the first time during the oral proceedings. The subject-matter of auxiliary request 3 was based on auxiliary request 2 (i.e. auxiliary request 6 as filed with the grounds of appeal), which was further limited in convergent manner by *feature 4a* (taking into account an objection of intermediate generalisation over paragraph [106] of the patent, as submitted by the appellant I in its grounds of appeal) and *feature 6a* (referring to *feature 4a*). Allegedly, these features had not been objected to by the appellant I in its letter dated 11 August 2020 (see page 20). The subject-matter of claim 1 of the auxiliary request 3 was, *prima facie*, limited over D1 (which did not show vehicle suspension product data; moreover, "monitoring" while riding the bicycle was required, different from the setup mode in D1). It was also referred to the arguments presented regarding admittance of the auxiliary request 1.

5.3 However, as observed by the appellant I, claim 1 of auxiliary request 3 does not only combine features of granted claims, but relies on features taken from paragraph [0106] of the description. This has been argued by appellant I in its letter of 11 August 2020 (see pages 18 to 20), in which a novelty objection and an objection under Article 123(2) EPC has already been

raised. In particular, this paragraph distinguishes between a set up mode and a ride mode, which has not been considered in claim 1. In view of the definite article used in *feature 4a* ("*monitor the vehicle shock absorber movement*"), a clarity issue was further raised by appellant I. Moreover, *features 4a and 6a* have been included for the first time in claim 1 of the auxiliary request 17 filed by letter of 24 June 2020. This request formed part of a set of non-converging auxiliary requests 14 to 27, which according to the appellant I had to be rejected for late filing, since D1 was known to the appellant II for a long time.

In view of the foregoing, the board finds that admission of auxiliary request 3 into the proceedings would raise various issues which had to be discussed for the first time during the oral proceedings, which would run counter the requirement of procedural economy. On a *prima facie* basis, the board also cannot see that the subject-matter of claim 1 of auxiliary request 3 is allowable. Consequently, the board exercises its discretion under Article 13(1) RPBA 2020 not to admit the auxiliary request 3 into the appeal proceedings.

6. *Auxiliary request 4*

6.1 The auxiliary request 4 was filed with the grounds of appeal as the auxiliary request 7 and combines the features of auxiliary request 2 (auxiliary request 6 as filed with the grounds of appeal) with the features of claim 5 as granted.

6.1.1 As admitted by the appellant I, the auxiliary request 4 was filed in due time with the grounds of appeal as the

auxiliary request 7. However, the appellant I raised the issue of lack of convergency of this request as compared to the previously discussed request, since the limitation provided in claim 1 of auxiliary request 3 has been omitted and replaced in auxiliary request 4 by *feature 9*. Allegedly, it was not admissible to develop the subject-matter of claim 1 in a different direction. Moreover, paragraph [0068] of D1 had to be considered.

The appellant II submits that the auxiliary request 4 was filed at the earliest possible moment in appeal proceedings, i.e. with the grounds of appeal, and that Article 13(1) RPBA 2020 did not apply. As compared to claim 1 of the main request, the additional features in claim 1 of auxiliary request 4 were based solely on features taken from dependent claims. Moreover, claim 1 of auxiliary request 4 seemingly provided a limitation over D1 as regards the disclosure discussed so far (Figure 22 and paragraphs [0092] to [0094]), which did not show an operational characteristic represented by a valve position. Allegedly, a fair position of defending the case should be given to the appellant II after having formally rejected auxiliary request 3.

6.1.2 Admittedly, the subject-matter of claim 1 of auxiliary request 4 is diverging from claim 1 of auxiliary request 3 (which was not admitted). However, it clearly narrows down the subject-matter of claims 1 according to the main request and the auxiliary request 2, i.e. of those requests admitted and discussed in substance, but not allowed for lack of novelty over D1. Thus, in the first place, discussion would have to concentrate on whether *feature 9* could establish novelty over D1. In this respect, according to the appellant I, a particular passage (paragraph [0068]) in D1 had to be considered, so no complex discussion was expected.

Moreover, since *feature 9* stems from a granted claim, no further issues under Article 84 or Article 123(2) EPC would arise in view of the amendment according to auxiliary request 4. Finally, the appellant I argued for the first time during the oral proceedings that *feature 8* of claim 1 of auxiliary request 2 (i.e. that a "*communication device is operable by the user to make the suggested adjustment*") was known from D1 based on the rider setup mode shown in Figure 22, whereas in its reply to the appeal of appellant II it relied roughly on a combination of paragraphs [0068], [0057] and [0076] of the description of D1. Filing of the auxiliary request 4 is therefore considered to be a legitimate attempt to overcome the new argument raised by the appellant I, which was filed at the earliest possible moment in appeal proceedings. In particular, it is only fair that the patentee as appellant II be given the opportunity to react in an appropriate manner in order to save its patent.

6.1.3 In these circumstances, irrespective of the divergence between auxiliary request 3 which was not admitted in the proceedings and auxiliary request 4 which was clearly convergent with the previously discussed auxiliary request 2, the board admitted the auxiliary request 4 into the appeal proceedings. It is noted that decisions whether to admit allegedly diverging auxiliary requests on file are discretionary and largely depend on the particular facts of the case.

6.2 The subject-matter of claim 1 according to the auxiliary request 4 does not extend beyond the subject-matter of the application as filed (Article 100(c) EPC, Article 123(2) EPC).

6.2.1 The appellant I objected to added subject-matter with regard to the amendments made in the grant procedure (Article 100(c) EPC). It did not maintain its objection under Article 123(2) EPC regarding the replacement after grant of the term "vehicle suspension" by "vehicle shock absorber", and the board sees no problem in this regard either.

(a) The appellant I argued that the general wording of the first part of feature 5 ("*said processor is operable to generate a suggested adjustment*") was not supported by paragraph [0096], [0106] or [0125] of the A-publication (which will be referred to in the following) of the application as filed, which required further features to be included. For example, the specific embodiment described in paragraph [0096], which generally mentioned that the controller 300 processed the data received from the sensors 200, required a transfer of data to a communication device 500 or a computer 400 to adjust the components of the vehicle. The output of the suggested adjustment for indication to the user (*features 5 and 6*) was inextricably linked to the communication device 500, which was able to instruct the user, but not the processor.

Since claim 1 of auxiliary request 4 includes "*a communication device operable to communicate with the processor and display data*" (*feature 7*) and thus the additional feature allegedly required in view of the original disclosure according to paragraph [0096], the objection raised by the appellant I with regard the first part of *feature 5* of the main request, which remains unchanged in *feature 5'* of auxiliary request 4, is overcome. Further text passages, namely paragraphs [0106] and

[0125], disputed between the parties for supporting this amendment therefore need not to be considered in this context. In fact, the objection of lack of disclosure maintained by the appellant I in its letter dated 11 August 2020 in respect of auxiliary requests 14 and 15 (which both include *feature 7*) concern the second and third part of *feature 5/5'* addressed in its grounds of appeal, as discussed further below under points (c) and (d).

- (b) During the oral proceedings, the appellant I further objected to the replacement of the term "setting" (see claim 1 as originally filed: "to suggest an operational setting"; or Figure 12: step 310) by the term "adjustment" in the first part of *feature 5'*. Allegedly, it was only originally disclosed to suggest a state ("setting") to be selected by the user, whereas the granted version of claim 1 specified a suggested adjustment to be made by the user, which was not originally disclosed.

This argument could not be followed by the board in view of the original disclosure in paragraph [0096] of the A-publication. In particular, this paragraph describes that the user is instructed on what adjustments to make, i.e. the user is provided with a suggestion for adjustment. Therefore, the board finds that paragraph [0096] provides a basis for the term "suggested adjustment" in the first part of *feature 5'*.

- (c) The appellant I also objected to the second part of *feature 5/5'* ("*user-adjustable feature based on the processing of said signal*"), which according to the opposition division (contested decision, points 3.4

and 3.5) was not literally but implicitly disclosed in paragraph [0125] of the A-publication. According to the appellant I, this text passage could not be generalised in the way done when amending *feature 5/5'*, because it disclosed a whole procedure requiring plural steps which had to be performed in order to achieve any suggestion. In particular, only based on an analysis of data, i.e. comparing the data to pre-programmed vehicle suspension operational setting that were stored on the processor or controller, the processor output a suggested vehicle setting. Allegedly, the opposition division did not acknowledge this certain procedure, and the arguments provided by the appellant II were not applicable (as argued by appellant I in its letter dated 17 December 2019).

However, the board finds that the opposition division provided the relevant argument in this respect that (see contested decision, point 3.3) paragraph [0125] is the only place in the original application which refers to such a comparison step. Other embodiments described in paragraphs [0096], [0100] and [0106], which suggest an adjustment to the suspension setup, do not provide for a comparison step. A similar argument was put forward by the appellant II in its response to the grounds of appeal of appellant I (see point E.II.1 c) in its letter dated 11 October 2018), albeit in the context of discussing the first part of *feature 5*. As originally disclosed in paragraph [0096], the controller processes data captured from the sensors relating to operational characteristics and may communicate the data to the communication device to instruct the user on what adjustments to make. Paragraph [0100] is even more explicit, as it

discloses that the controller may analyse parameters like sag and communicate such data to the communication device to display to the user, such as suggestions for adjusting air spring pressure (i.e. a user-adjustable feature) to adjust sag. The board follows the appellant II that paragraph [0125] describes "*one process of use with the system 1000 according to the embodiments described herein*", which does not require limiting systems according to the invention, i.e. as specified in claim 1 directed to a system and not to a process. Therefore, the board cannot follow the appellant I that on the basis of the disclosure of paragraph [0125] each process step within the processor has to be defined. On the contrary, the board finds that paragraph [0096] (or also paragraph [0100]) forms a basis of original disclosure for the second part of *feature 5/5'*.

- (d) Finally, the appellant I objected to the third part of *feature 5/5'* ("*which suggested adjustment would change the performance of the vehicle shock absorber*"), since paragraph [0096] of the application as published did not support this general wording but clearly stated that the purpose of the suggested amendment was to improve the vehicle suspension setup. Allegedly, changing the vehicle suspension setup did include a worse setup, i.e. the opposite of an improvement, and also an equivalent setting, so the verb "change" was broader and not originally disclosed. Basically, the appellant I objects to the quality of the suggested adjustment and thus to the internal processing within the processor, which according to paragraph [0096] should generate an instruction to improve the suspension setup.

First of all, the board notes that a shift or broadening of the scope of protection is allowable in respect of amendments before grant of a patent, as long as there exists a basis for the amended subject-matter. As stated in the board's preliminary opinion, paragraph [0106] of the application as published contains a literal disclosure of the term "change" (namely: "*to suggest changes to the suspension set up*") in the same context the term "improve" is used in paragraph [0096] ("*to improve the vehicle 100 suspension setup*"). Thus, the board cannot see that the third part of *feature 5/5'* as amended during the grant procedure would present the reader with any new technical information as compared to the application as filed.

6.2.2 In view of the above, the board holds that the ground for opposition according to Article 100(c) EPC, put forward in respect of amendments during the grant procedure, does not prejudice maintenance of the patent as amended according to auxiliary request 4.

6.3 The subject-matter of claim 1 of the auxiliary request 4 is new over document D1 (Article 54(1) EPC).

6.3.1 As compared to claim 1 of the auxiliary request 2, claim 1 of the auxiliary request 4 was amended by adding *feature 9*, which introduces a damper valve and specifies the operational characteristic (according to *feature 3'*) as a position of the damper valve between a full open and a full closed setting.

6.3.2 According to the appellant I, a damper valve was known from D1 (see paragraphs [0003], [0055] and [0057]). As

further described in paragraph [0068] of D1, the main controller 600 was connected to various sensors and compared operational parameters, such as valve position, to predetermined variances. If the predetermined variance was exceeded, an alarm or message was indicated to the rider on display 140, thus prompting the user to make an adjustment with respect to the valve. Additionally, as an option, an automatic control was initiated, such as changing the operational state of the valve, to compensate for the out of variance operating parameter.

Furthermore, as argued by the appellant I in respect of auxiliary request 2 (former auxiliary request 6), paragraph [0076] disclosed that the display allowed the rider to change operating characteristics of the suspension. Allegedly, these passages disclosed that the communication device (display 140) was operable to make the suggested adjustment (adjust orifice size of valve 300) to the user-adjustable feature of the vehicle suspension (shock absorber 135).

- 6.3.3 This line of argument (in order to show that *feature 9* was known from D1) starts from a sensor measuring a valve position (the operational characteristic required by *feature 3'*) and a user-adjustable feature relating to the valve for adjusting performance of the vehicle suspension (*feature 2*), allegedly the orifice size of the valve. Moreover, it assumes that the user can make a suggested adjustment to the user-adjustable feature (*features 5' and 8*). However, the board agrees with the appellant II that paragraph [0068] of D1 does not disclose clearly and unambiguously that the alarm or message mentioned therein indicates or suggests any adjustment with respect to the valve, which the user can make by operating the communication device (as required by *feature 8*). The cited paragraph in D1

explicitly states that proper operation of the valve is monitored ("Main controller 400 also accepts data from motor control 310, indicating, for example, whether the motor 305 or valve 300 is operating correctly"). The alarm or message then generated in D1, in case a predetermined variance of valve position is exceeded, therefore might only indicate a defective valve which has to be replaced or repaired. This is not considered to be an adjustment to a user-adjustable feature (of the valve) suggested to the user so that he can make the suggested adjustment. Moreover, paragraphs [0055] and [0057] referred to by the appellant I relate to an adjustment of the orifice size of the valve performed by the control system 190 which transmits a valve command to the motor controller 310 to actuate the valve. Thus, these passages relate to an automatic control of damping characteristics during a ride mode, but not to an user-adjustable feature as required by claim 1.

Paragraph [0076] in D1, which was also referred to by the appellant I, relates to a third mode of display illustrated in Figures 17 - 22, which allows the user to select a ride mode, a fork setup and a rider setup, i.e. a dedicated setting. However, there is no indication in this paragraph that the processor in D1 generates a suggested adjustment of any valve feature. Other than argued above regarding lack of novelty of the main request, in view of the rider setup according to Figure 22 in D1 showing a processor which generates a suggested adjustment of the sag by displaying an advised sag and an actual sag, D1 fails to disclose any recommendation for adjusting a valve feature (such as its orifice) by the user by operating the display as required by features 5' and 8. As set out above, D1 only shows an automatic control of the valve orifice.

6.3.4 In arguing lack of novelty of claim 1 of the main request, the appellant I also referred to different suspension modes and respective damping curves (depending on the velocity of the bicycle, measured by one of the sensors) provided by the system of D1, which were selected by the user during an initial setup mode. Allegedly, the system of D1 was operable to generate suggestions, i.e. the respective damping curves, depending on measured sensor signals. In addition, by choosing one of the riding modes, the user had the possibility to make a kind of fine adjustment (see Figures 17, 18 and 20) between a more or less comfortable suspension in a spectrum of -5 to 5 grades, i.e. providing this range was a further suggestion by the system to the user.

However, the board cannot see that thereby *feature 5'* (in combination with *feature 3'*), namely a processor generating a suggested adjustment of a user-adjustable feature based on the processing of a sensor signal measuring an operational characteristic, would be disclosed in D1. Admittedly, the damping curves depend on the vehicle's velocity, i.e. on an operational characteristic measured by a sensor, and might be considered as a user-adjustable feature. However, the user is not provided with a suggested adjustment of the damping curve, such as a recommendation to select a different damping curve or to modify a given damping curve, based on the processing of a velocity signal, as required by the wording of claim 1. In fact, the user in D1 is only presented in advance (before riding the bicycle) in a manual setup mode with suggestions for selecting a specific damping curve depending on the expected terrain, and for further fine adjustment of associated damper characteristics, without there being

any suggestion based on a measured operational characteristic on what adjustment to make.

6.3.5 Therefore, the board concludes that the disclosure of D1 is not novelty-destroying to the subject-matter of claim 1 of auxiliary request 4.

6.4 The subject-matter of claim 1 of auxiliary request 4 also involves an inventive step (Article 56 EPC).

6.4.1 Starting from document D1 as the closest prior art, the sole objection of lack of inventive step put forward by the appellant I relied on paragraph [0068] in D1, which allegedly provided at least a hint to arrive at the claimed solution.

6.4.2 The board agrees with the appellant I that D1 represents the closest prior art. However, as set out above with respect to novelty, paragraph [0068] relates to the ride mode and the automatic control of the damping characteristic by providing operating signals to motor control 310 that operates valve 300. There is no indication in D1 that based on processing of the valve position (i.e. on the operational characteristic according to *features 3' and 9*) a suggested adjustment of a user-adjustable feature of the valve is generated so that the communication device is operable by the user to make the suggested adjustment (as required by *features 5' and 8*). In fact, there is no indication at all in D1 that a feature of the valve (such as the valve orifice) can be manually adjusted by the user. The only suggestion provided in D1 to the user for manual adjustment by the user is an adjustment of the sag, i.e. a static parameter depending on the rider's weight and the air piston pressure (see Figure 22), as set out further above in respect of the main request.

The board cannot see any incentive in D1 that the skilled person would contemplate a similar adjustment option for the user based on a measured characteristic of the valve, such as the valve position, which is only controlled automatically in D1 while riding the vehicle. The velocity measured in D1 only determines the damping force for the expected terrain and thus the orifice size of the valve according to a given damping curve during operation of the bicycle (see paragraph [0079]), i.e. the operational characteristic "velocity" does not form a basis for suggesting an adjustment of the damping curve or its characteristics in D1.

Moreover, the board cannot see that it would be obvious for the skilled person to consider measuring the actual sag in Figure 22 in D1 (for which a specific sensor responsive to the rider's weight is foreseen) on the basis of a valve position of the damper valve (which is dependent on the actuation through an electric motor and regulates the rate of fluid flow through the valve and thus the amount of damping provided by the suspension system, see paragraph [0055]) in order to arrive at the subject-matter of claim 1.

6.4.3 Finally, even assuming that the message indicated in D1 to the rider that a predetermined variance of the valve position is exceeded (see paragraph [0068]) might indicate an inappropriate setting of the damper valve as selected by the user (e.g. a bad damping curve or damping parameter selected during initial setup), D1 only shows that such a defect might be compensated by initiating a control method that adapts the operation of the control system such as changing the operational state of the valve (last sentence in paragraph [0068]). The board cannot see that the skilled reader, in view of this disclosure in D1, would be prompted to modify

the control system so as to generate and output a suggested adjustment of the user-adjustable feature (in this case: of the damping curve or damping parameter) so that the user can make the suggested adjustment, as required by *features 5', 6 and 8*. In the board's view, these features would require indicating to the user a recommended change with regard to the damping curve or parameter, either in form of a quantitative or concrete proposal (i.e. suggesting directly a damping parameter or a specific damping curve), or at least by providing an instructing to the user on what adjustment to make (i.e. whether to increase or decrease a damping parameter). Such indication is given in D1 only for the user-adjustable feature "air piston pressure" based on the evaluation of the static parameter sag as measured and advised during the rider setup (see Figure 22, as argued above in respect lack of novelty of the main request and auxiliary request 2). Setting of damping characteristics, as influenced by the motor-controlled valve position, is in D1 merely a choice of the rider based on the expected terrain and, furthermore, his personal preferences by adjusting parameters of the selected ride mode. Indicating an alarm or message with respect to a valve position which is out of variance, as disclosed in D1, does not yet provide a hint to the person skilled in the art that the processor of D1 should be modified to suggest an adjustment of a pre-selected damping curve or damping parameter to the user (as required by *features 5' and 6*) so that he is provided with a suggestion on what adjustment to make to its initial setup settings of the damping characteristics by operating the communication device (as required by *feature 8*).

6.4.4 As a consequence, and in the absence of further attacks against the presence of an inventive step, the board

finds that the subject-matter of claim 1 of the auxiliary request 4 is not rendered obvious over the disclosure of document D1 (Article 56 EPC).

7. The board therefore concludes that the subject-matter of claim 1 according to auxiliary request 4 does not extend beyond the content of the application as originally filed and is patentable under Article 52(1) EPC. Similar considerations apply also in respect of dependent system claims 2 to 11 and claims 12 to 14 requiring a system as claimed in any of claims 1 to 11.

8. The claims according to the auxiliary request 4 can therefore form the basis for the grant of a patent. However, it remains necessary to adapt the description to the allowable claims.

In view of the substantial limitation of the subject-matter of claim 1, the board considers it expedient to exercise its discretion under Article 111(1) EPC and to remit the case to the department of first instance for adaptation of the description, as agreed by both parties during the oral proceedings. As regards the new Article 11 RPBA 2020, it is noted that remittal of a case for adaptation of the description is not a remittal for "further prosecution" (see CA/3/19, page 30, explanatory remarks to Article 11 RPBA 2020, second paragraph), such that no "special reasons" need to be present (see T 32/16, point 5 of the Reasons).

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the opposition division with the order to maintain the patent in amended form with the following claims and a description to be adapted thereto:

Claims No. 1 to 14 according to new auxiliary request 4 filed as auxiliary request 7 with the grounds of appeal.

The Registrar:

The Chairman:



A. Vottner

W. Marx

Decision electronically authenticated