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**Datasheet for the decision  
of 16 December 2020**

**Case Number:** T 1823/18 - 3.2.01

**Application Number:** 12156983.4

**Publication Number:** 2492178

**IPC:** B62K25/04, B62K25/28, B62M25/08

**Language of the proceedings:** EN

**Title of invention:**  
Bicycle suspension control apparatus

**Patent Proprietor:**  
Shimano Inc.

**Opponent:**  
Öhlins Racing AB

**Headword:**

**Relevant legal provisions:**  
EPC Art. 54, 84, 123(2)  
RPBA Art. 12(4)  
RPBA 2020 Art. 13(1)

**Keyword:**

added subject-matter (auxiliary request 5, 7: yes)  
lack of clarity (auxiliary request 6,7, 8, 9: yes)  
novelty (main request, auxiliary request 10, 11, 12 : no)  
admissibility of late filed requests (auxiliary requests 1 to  
4 : no)

**Decisions cited:**

**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 1823/18 - 3.2.01

**D E C I S I O N**  
**of Technical Board of Appeal 3.2.01**  
**of 16 December 2020**

**Appellant:** Shimano Inc.  
(Patent Proprietor) 3-77 Oimatsu-cho  
Sakai-ku  
Sakai City, Osaka 590-8577 (JP)

**Representative:** Flügel Preissner Schober Seidel  
Patentanwälte PartG mbB  
Nymphenburger Strasse 20  
80335 München (DE)

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

**Representative:** AWA Sweden AB  
P.O. Box 665  
831 27 Östersund (SE)

**Decision under appeal:** **Interlocutory decision of the Opposition  
Division of the European Patent Office posted on  
14 May 2018 concerning maintenance of the  
European Patent No. 2492178 in amended form.**

**Composition of the Board:**

**Chairman** G. Pricolo  
**Members:** C. Narcisi  
A. Jimenez

## **Summary of Facts and Submissions**

- I. The European patent No. 2 492 178 was maintained in amended form by the decision of the Opposition Division posted on 14 Mai 2018. Against this decision an appeal was lodged by the Opponent and by the Patentee in due form and in due time pursuant to Article 108 EPC.
- II. Oral proceedings were held on 16 December 2020. Appellant I (Patentee) requested that the impugned decision be set aside and that the patent be maintained as granted (main request) or, in the alternative, that the patent be maintained in amended form according to auxiliary requests 1 to 8, 10 to 14 (filed on 12 September 2018) or according to auxiliary request 9 (filed on 16 December 2019). Appellant II (Opponent) requested that the decision be set aside and that the patent be revoked.
- III. Claim 1 of the main request reads as follows:
- “A bicycle suspension control apparatus configured to control a front suspension (FS) and a rear suspension (RS) of a bicycle in response to operation of an operating device (OP1, OP2), each of the front suspension (FS) and the rear suspension (RS) having a plurality of operating states, the apparatus comprising:
- a receiving means (96) configured to receive information indicating at least one combination of operating states from among combinations of an operating state of the front suspension (FS) and an operating state of the rear suspension (RS);

a storage means (97) configured to store combination information received by the receiving means (96); and a control means (98) configured to control the front suspension (FS) and the rear suspension (RS) based on combination information stored in the storage means (97) when the operating device (96) is operated."

Claim 1 of auxiliary request 1 differs from claim 1 of the main request in that the wording "a receiving means (96) configured to receive information indicating at least one combination of operating states from among combinations of an operating state of the front suspension (FS) and an operating state of the rear suspension (RS);" is replaced by the wording " a receiving means (96) configured to receive a plurality of sets of combination information indicating at least one combination of operating states from among combinations of an operating state of the front suspension (FS) and an operating state of the rear suspension (RS), wherein a set of combination information is a combination of an operating state of the front suspension (FS) and an operating state of the rear suspension (RS);" and the wording "based on combination information stored in the storage means (97) when the operating device (96) is operated" is replaced by "based on the combination information stored in the storage means (97) when the operating device (OP1, OP2) is operated".

Claim 1 of auxiliary request 2 differs from claim 1 of the main request in that the wording "a receiving means (96) configured to receive information indicating at least one combination of operating states from among combinations of an operating state of the front suspension (FS) and an operating state of the rear suspension (RS)" is replaced by "a receiving means (96)

configured to receive a combination information indicating at least one combination of operating states from among combinations of an operating state of the front suspension (FS) and an operating state of the rear suspension (RS)", the wording "a storage means (97) configured to store combination information received by the receiving means (96)" is replaced by "a storage means (97) configured to store the combination information received by the receiving means (96); an operating device (OP1, OP2) wherein the combination of operating states of the front suspension (FS) and of the rear suspension (RS) can be changed by operating the operating device (OP1, OP2) ", the wording "based on combination information stored in the storage means (97) when the operating device (96) is operated" is replaced by "based on the combination information stored in the storage means (97) when the operating device (OP1, OP2) is operated".

Claim 1 of auxiliary request 3 differs from claim 1 of the main request in that the wording "a receiving means (96) configured to receive information indicating at least one combination of operating states from among combinations of an operating state of the front suspension (FS) and an operating state of the rear suspension (RS)" is replaced by "a receiving means (96) configured to receive a combination information indicating at least one combination of operating states from among combinations of an operating state of the front suspension (FS) and an operating state of the rear suspension (RS); wherein the receiving means (96) can be connected to an external device (60) configured to output the combination information", the wording "a storage means (97) configured to store combination information received by the receiving means (96)" is replaced by "a storage means (97) configured to store

the combination information received by the receiving means (96)", the wording "based on combination information stored in the storage means (97) when the operating device (96) is operated" is replaced by "based on the combination information stored in the storage means (97) when the operating device (OP1, OP2) is operated".

Claim 1 of auxiliary request 4 differs from claim 1 of auxiliary request 3 in that the wording "a storage means (97) configured to store the combination information received by the receiving means (96)" is replaced by "a storage means (97) configured to store the combination information received by the receiving means (96); an operating device (OP1, OP2) wherein the combination of operating states of the front suspension (FS) and of the rear suspension (RS) can be changed by operating the operating device (OP1, OP2)".

Claim 1 of auxiliary request 5 differs from claim 1 of auxiliary request 3 in that the wording "wherein the receiving means (96) can be connected to an external device (60) configured to output the combination information" is deleted and the wording "based on the combination information stored in the storage means (97) when the operating device (OP1, OP2) is operated" is replaced by "based on the combination information stored in the storage means (97) when the operating device (OP1, OP2) is operated, wherein the combination of the operating states of the front suspension (FS) and of the rear suspension (RS) can be changed by a single user operation of the operating device (OP1, OP2)".

Claim 1 of auxiliary request 6 differs from claim 1 of auxiliary request 5 in that the wording "wherein the

combination of the operating states of the front suspension (FS) and of the rear suspension (RS) can be changed by a single user operation of the operating device (OP1, OP2)" is replaced by "wherein a plurality of combination information is assigned to one operating device (OP1, OP2) such that a plurality of combinations can be changed with one operating device (OP1, OP2) or wherein one combination information is assigned to one operating device (OP1, OP2) such that different combinations can be selected with a plurality of operating device (OP1, OP2)."

Claim 1 of auxiliary request 7 differs from claim 1 of auxiliary request 6 in that the wording "when the operating device (OP1, OP2) is operated," is replaced by "when the operating device (OP1, OP2) is operated, wherein the combination of the operating states of the front suspension (FS) and of the rear suspension (RS) can be changed by a single user operation of the operating device (OP1, OP2)".

Claim 1 of auxiliary request 8 differs from claim 1 of auxiliary request 1 in that the wording "when the operating device (OP1, OP2) is operated" is replaced by "when the operating device (OP1, OP2) is operated, wherein a plurality of sets of combination information is assigned to one operating device (OP1, OP2) such that a plurality of combinations can be changed with one operating device (OP1, OP2) or wherein one set of combination information is assigned to each operating device (OP1, OP2) such that different combinations can be selected with a plurality of operating device (OP1, OP2)."

Claim 1 of auxiliary request 9 differs from claim 1 of auxiliary request 1 in that the wording "when the

operating device (OP1, OP2) is operated" is replaced by "when the operating device (OP1, OP2) is operated, wherein the combination of the operating states of the front suspension (FS) and of the rear suspension (RS) can be changed by a operation of the operating device (OP1, OP2), wherein a plurality of sets of combination information is assigned to one operating device (OP1, OP2) such that a plurality of combinations can be changed with one operating device (OP+, OP2) or wherein one set of combination information is assigned to each operating device (OP1, OP2) such that different combinations can be selected with a plurality of operating device (OP1, OP2)".

Claim 1 of auxiliary request 10 differs from claim 1 of auxiliary request 1 in that the wording "a receiving means (96) configured to receive a plurality of sets of combination information" is replaced by "a receiving means (96) configured to receive a combination information", the wording "when the operating device (OP1, OP2) is operated" is replaced by "when the operating device (OP1, OP2) is operated, wherein the combination of the operating states of the front suspension (FS) and of the rear suspension (RS) can be changed by an operation of the operating device (OP1, OP2), wherein the combination information includes at least one of the following: a first combination information configured to set both the front suspension (FS) and the rear suspension (RS) such that they cannot expand and contract; a second combination information configured to set both the front suspension (FS) and the rear suspension (RS) such that they can expand and contract; a third combination information configured to set the front suspension (FS) such that it can expand and contract and set the rear suspension (RS) such that it cannot expand and contract; and a fourth combination

information configured to set the front suspension (FS) such that it cannot expand and contract and set the rear suspension (RS) such that it can expand and contract".

Claim 1 of auxiliary request 11 differs from claim 1 of auxiliary request 10 in that the wording "wherein the combination of the operating states of the front suspension (FS) and of the rear suspension (RS) can be changed by an operation of the operating device (OP1, OP2)," is deleted.

Claim 1 of auxiliary request 12 differs from claim 1 of auxiliary request 10 in that the wording "wherein the combination of the operating states of the front suspension (FS) and of the rear suspension (RS) can be changed by an operation of the operating device (OP1, OP2)" is replaced by "wherein the operating device (OP1, OP2) includes a switch (LSW1, LSW2, RSW1, RSW2), and the combination information includes a plurality of combinations of operating states assigned to one switch (LSW1, LSW2, RSW1, RSW2)".

Claim 1 of auxiliary request 13 differs from claim 1 of auxiliary request 12 in that the wording "a receiving means (96) configured to receive a combination information indicating at least one combination of operating states from among combinations of an operating state of the front suspension (FS) and an operating state of the rear suspension (RS);" is replaced by "a receiving means (96) configured to receive a combination information indicating at least one combination of operating states from among combinations of an operating state of the front suspension (FS) and an operating state of the rear suspension (RS); wherein the combination information is

set by using an external device (60) and wherein the external device (60) is configured to be connected to the receiving means (96) to output the combination information to the receiving means (96)".

IV. The Patentee's arguments may be summarized as follows:

The subject-matter of claim 1 (main request) is new over D4 since it does not disclose feature F3 (i.e. "a receiving means (96) configured to receive information indicating at least one combination of operating states from among combinations of an operating state of the front suspension (FS) and an operating state of the rear suspension (RS)"). In particular, feature F3 defines receiving means apt to change the relationship between a particular actuation of the operating device and the corresponding stiffness settings of both the front suspension and the rear suspension. D4 discloses no such receiving means, as actuation of the manual override switch 50 merely allows to select between different predefined stiffness settings.

Auxiliary requests 1 to 4 (filed with the statement of grounds of appeal) are not late filed, for they were filed at the earliest possible opportunity in response to the Opposition Division's decision and should therefore be admitted into the appeal proceedings. In effect, the Opposition Division did not give a preliminary opinion on novelty of the claimed subject-matter as well as during the oral proceedings, the reasons for lack of novelty in relation to D4 being set out merely in the appealed decision. In addition, these auxiliary requests do not include new subject-matter not having been dealt with in opposition proceedings, only some features having been further specified.

Claim 1 of auxiliary request 5 does not include subject-matter extending beyond the content of the application as filed (see published patent application designated as EP-A), given that feature (i) (i.e. "wherein the combination of the operating states of the front suspension (FS) and of the rear suspension (RS) can be changed by a single user operation of the operating device (OP1, OP2)") is disclosed in EP-A (see [0007], column 2, lines 37-39: "Consequently, the combination of operating states of the front and rear suspensions can be changed easily by operating an operating device"). This is no literal disclosure (which is not required), nevertheless said disclosure is derivable for the skilled person in conjunction with the overall disclosure of EP-A, considering in particular the object of the invention residing in providing settings of the front and rear suspension to be changed easily (EP-A, [0005]), as well as from specific embodiments (EP-A, column 24, lines 34-41).

Claim 1 of auxiliary request 6 is clear, since no doubts arise as to the interpretation of feature (ii) (i.e. "wherein a plurality of combination information is assigned to one operating device (OP1, OP2) such that a plurality of combinations can be changed with one operating device (OP1, OP2) or wherein one combination information is assigned to one operating device (OP1, OP2) such that different combinations can be selected with a plurality of operating device (OP1, OP2)"). Specifically, this feature is taken verbatim from the description of EP-A (see [0007], column 2, lines 26-34) and is not ambiguous or unclear, as obviously the terms "changed" and "selected" in the given context are synonymous, meaning that different combinations can be selected with a plurality of operating devices. As to the

further objection relating to the alleged contradiction or ambiguity implied by the feature "wherein one combination information is assigned to one operating device (OP1, OP2) such that different combinations can be selected with a plurality of operating device (OP1, OP2)", the skilled person would evidently understand that "operating information" is assigned to "one" i.e. each operating device, and therefore different combinations can be selected with a plurality of operating devices.

Claim 1 of auxiliary request 7 results from the combination of claim 1 of auxiliary request 5 and 6, therefore in view of the Opponent's objections (in respect of clarity and subject-matter extending beyond the content of EP-A) the same reasons apply as given in relation to claim 1 of these auxiliary requests.

Claim 1 of auxiliary request 8 and 9 is clear as the Opponent's objection concerning clarity is unfounded, this objection being the same as already put forward by the Opponent against claim 1 of auxiliary request 6 and relating to the alleged lack of clarity or ambiguity resulting from using both the term "changed" and the term "selected" in the same feature and context. Hence the same reasons given above apply.

Moreover, this objection is late filed and is not admissible, for in its written submissions the Opponent filed against claim 1 of auxiliary request 8 merely objections based on Article 123(2) EPC (i.e. subject-matter extending beyond the content of the application as filed), not based on lack of clarity (Article 84 EPC).

Claim 1 of auxiliary request 10 is new over D4 since it does not disclose features F3 (i.e. "a receiving means

(96) configured to receive information indicating at least one combination of operating states from among combinations of an operating state of the front suspension (FS) and an operating state of the rear suspension (RS)”) and F4 (“a storage means (97) configured to store combination information received by the receiving means (96)”). Indeed, there is in D4 (in analogy to the discussion relating to the main request) no disclosure of a receiving means capable of changing the relationship between a particular actuation of the operating device and the corresponding stiffness settings of both the front suspension and the rear suspension, and said toggle (see D4, column 4, lines 13-15) does not represent such a receiving means. Consequently, feature F4 indicating storage means operating in conjunction with said receiving means, is likewise not disclosed.

Moreover the objection hereinabove is not admissible since an objection based on lack of novelty with regard to D4 was not substantiated by the Opponent in its statement of grounds of appeal or in its reply to the Patentee’s statement of grounds of appeal.

The same arguments as laid out for claim 1 of auxiliary request 10 apply to claim 1 of auxiliary request 11, given features F3 and F4 included in claim 1 of auxiliary request 10 being likewise included in claim 1 of auxiliary request 11 and being not known or rendered obvious from D4.

The subject-matter of claim 1 of auxiliary request 12 is new over D4, as feature (iii) (i.e. “wherein the operating device (OP1, OP2) includes a switch (LSW1, LSW2, RSW1, RSW2), and the combination information includes a plurality of combinations of operating states assigned to one switch (LSW1, LSW2, RSW1,

RSW2)”) is not known from D4, in addition to features F3 and F4 which were discussed in conjunction with claim 1 of auxiliary request 10, likewise not known from D4. Feature (iii) is not derivable from D4, for no “plurality of combinations of operating states” is assigned to a switch or toggle according to paragraph [0012] of D4, given said switch or toggle permitting only locking or unlocking of both forward and rear suspensions at the same time.

The Opponent’s arguments based on lack of novelty of the subject-matter of claim 1 of auxiliary request 13 in view of D4 are not admissible since these were presented only during the oral proceedings and not filed previously in writing, thus being late filed. These arguments also contain new objections based on paragraphs [0062], [0063] of D4 not having been discussed heretofore, alleging the disclosure in D4 of an external device to be connected to the receiving means (96) to output the combination information to the receiving means. However, this external device is not intended to perform a reprogramming function according to the invention (i.e. to change the relationship between a particular actuation of the operating device and the corresponding stiffness settings of both the front suspension and the rear suspension), as was already discussed in conjunction with the main request. Hence the admission of these new arguments into the appeal proceedings is moreover not warranted on the grounds that they lack relevance.

The inventive step attack based on D1 or D2 in conjunction D5 or D6 was not substantiated in the Opponent’s statement of grounds of appeal, the substantiation being merely submitted during oral

proceedings, these new arguments being therefore not admissible.

V. The Opponent's arguments may be summarized as follows:

The subject-matter of the main request is not new over D4 since feature F3 is known therefrom. Claim 1 has to be construed broadly, being nowhere stated in claim 1 that "receiving means" apt to "change the relationship between a particular actuation of the operating device and the corresponding stiffness settings of both the front suspension and the rear suspension" are provided. In addition, the term "receiving means" in the technical context of claim 1 is likewise very broad and general, e.g. possibly designating a control means, an electrical wire (transferring and receiving information) or a computer memory.

Auxiliary requests 1 to 4 should not be admitted into the appeal proceedings since they could and should have been filed already during opposition proceedings.

Claim 1 of auxiliary request 5, in particular above mentioned feature (i), includes subject-matter extending beyond the content of the application (EP-A) as filed, no "single user operation" being disclosed in EP-A.

Claim 1 of auxiliary request 6 is not clear, aforementioned feature (ii) including the terms "changed" and "selected", which are employed in the same context (i.e. in conjunction with operating the operating device"), these terms having however a different meaning and thus leading to different interpretations of feature (ii). Furthermore, in feature (ii) it is unclear how assigning "one

combination information ... to one operating device" can lead to a possible selection of "different combinations ... with a plurality of operating device (OP1, OP2)".

Claim 1 of auxiliary request 7 results from a combination of auxiliary requests 5 and 6, therefore the same objections apply as submitted in relation to these requests.

Claim 1 of auxiliary requests 8 and 9 lacks clarity, as the same questions arise, which were already discussed in respect of claim 1 of auxiliary request 6 concerning the terms "changed" and "selected".

This objection is not late filed since it was already put forward in the statement of grounds of appeal in conjunction with an objection concerning the inclusion of subject-matter extending beyond the content of EP-A (Article 123(2) EPC) and concerning extended scope of protection (Article 123(3) EPC). Moreover, lack of clarity was also invoked in relation to claim 1 of this request (which corresponds to auxiliary request 4 as upheld by the appealed decision).

The subject-matter of claim 1 of auxiliary request 10 is not new in view of D4, as said features F3 and F4 are disclosed in D4, this ensuing already from the discussion of novelty of the subject-matter of claim 1 of the main request.

This objection is not late filed since it was submitted and substantiated in the reply to the Patentee's statement grounds of appeal (page 14, page 11), where reference is made to the auxiliary request 5, to the main request and to dependent claim 2 being known from D4.

The subject-matter of claim 1 of auxiliary request 11 is not new in view of D4, the same reasons applying as for claim 1 of auxiliary request 10.

The subject-matter of claim 1 of auxiliary request 12 is not new over D4 since said feature (iii) is known from D4 (see [0012], [0060]).

The subject-matter of claim 1 of auxiliary request 13 is not new over D4 and lacks an inventive step over D1 or D2 in combination with D5 or D6. The novelty objection was submitted in respect of granted dependent claims 2, 3, 4 and 5 in the reply to the Patentee's statement of grounds of appeal (page 14) and in the Opponent's own statement of grounds of appeal (page 14, 15). Furthermore, this objection should be admitted by the Board purely on the grounds that it is very relevant.

The objection of lack of inventive step was submitted with the statement of grounds of appeal (pages 13, 14, 15) and is therefore admissible.

## **Reasons for the Decision**

1. The appeals are admissible.
2. The subject-matter of claim 1 (main request) is not new over D4, as this document discloses all features of claim 1 and in particular feature F3 (i.e. "a receiving means (96) configured to receive information indicating

at least one combination of operating states from among combinations of an operating state of the front suspension (FS) and an operating state of the rear suspension (RS)”) which disclosure was contested by the Patentee.

There is no support in claim 1, contrary to the Patentee’s contention, either literally or implicitly, for said receiving means being construed as being apt to change the relationship between a particular actuation of the operating device and the corresponding stiffness settings of both the front suspension and the rear suspension.

Specifically, no basis can be found in claim 1 for the Patentee’s arguments relating to said receiving means permitting “reprogramming” of the bicycle suspension control apparatus (or in particular of the operating device), such that functioning of the operating device can be changed/reprogrammed. Such a technical feature is disclosed merely in specific embodiments described in the description of the patent specification (hereinafter designated as EP-B) (see e.g. [0007], lines 33-36), however not in claim 1.

Consequently claim 1 has to be interpreted broadly, the receiving means e.g. possibly constituting a wire (as disclosed also in EP-B, [0079]: “the receiving means 96 is realized by, for example, including an electric power line connecting ... the electric power line communication unit (90)”), a (portion of ) a control unit or a (a portion of) a storage means (as submitted by the Opponent). Indeed, an electrical wire, a control unit, a storage means (which are all features disclosed in D4, see e.g. [0059], [0065]) are all configured to receive information about said one combination of operating states as input or defined at

least once (at a given point in time) by the user, i.e. by means of the signal generating device 50. This can be inferred from D4 (see e.g. [0063]: "... for example the signal generating device 50 may permit the user to remotely set a shock (i.e. the amount that the intensifier valve is open/closed) at one of a number of predefined indexed positions between locked and unlocked, or may permit the user set the shock at substantially any position between those two limits"; see also [0014], [0015], [0058] expressing similar concepts), the cited passages clearly indicating that the device of D4, as argued by the Opponent, permits the user through said receiving means to input or set parameters. These parameters include combination information concerning front and rear suspensions (see e.g. paragraph [0012]: " as an example a bicycle may include a signal generating switch having a toggle for selecting between the front and rear shock absorbers or for selecting both (thereby allowing the signal to trigger the actuator in each with only one operation of the switch); see also [0060]), which have to be predefined before use. Therefore, feature F3 is known from D4, the same holding true for feature F4 ("a storage means (97) configured to store combination information received by the receiving means (96)"), e.g. the controller 65 comprising a memory (see D4, [0059]) for storage of said combination information values which are used by the switching circuit of the controller to control the front and rear suspensions (see e.g. reference sign 511 in figure 3).

3. The Board decided not to admit auxiliary requests 1 to 4 in the appeal proceedings under Article 12(4) RPBA (Rules of Procedure of the Boards of Appeal) 2007 for the following reasons.

These requests were filed with the statement of grounds of appeal, whereas they could and should have been filed during opposition proceedings. Indeed, the Opponent's arguments against granted claim 1 leading to the main request not being allowed (i.e. based on D4) were already submitted with the notice of opposition. No new or surprising and unexpected arguments were submitted by the Opponent during the oral proceedings before the Opposition Division, and such an allegation was also not made by the Patentee. Furthermore, there is no statutory requirement under the EPC for the Opposition Division to issue a preliminary opinion on substantive issues of patent law relating to the pending requests, it being within the discretion of the Opposition Division depending on the specific circumstances of the case to decide whether to give such a preliminary opinion. Therefore, the Opposition Division omitting to file a preliminary opinion is no reason for submitting further auxiliary requests in appeal, in addition to ten auxiliary requests already submitted during opposition proceedings. Thus, it is concluded that auxiliary requests 1 to 4 are late filed.

In addition, the Board considered that the specific circumstances of the case did not warrant admitting these requests. In particular said requests are not convergent (i.e. lower ranking requests being not necessarily more limited than higher ranking requests), they include amendments almost exclusively based on the description, thus giving rise to questions relating to formal allowability (i.e. clarity and extended subject-matter), as well as to new issues and questions relating to novelty and inventive step, which were not discussed during opposition proceedings. In addition, it is not apparent in which way, if at all, these

auxiliary requests address the reasons given in the appealed decision not allowing the main request (identical with pending main request) and auxiliary requests 1 to 3 (identical with pending auxiliary requests 5 to 7).

Consequently these requests were not admitted, the appeal proceedings being no mere continuation of the opposition proceedings.

4. The subject-matter of claim 1 of auxiliary request 5 does not meet the requirements of Article 123(2) EPC, for aforementioned feature (i), implying that said operating states "can be changed by a single user operation of the operating device (OP1, OP2)", was not originally disclosed in the application as filed (EP-A). The passages cited by the Patentee only mention "operating" an operating device or a switch. However, the specific disclosure that only a "single" operation of said operating device or switch is needed or suffices, is not derivable from EP-A, either explicitly or implicitly. In particular, EP-A does not include any details about the number of operations or steps necessary to select a specific combination of operating states (of the front and rear suspensions) by operation of said operating device OP1, OP2.
  
5. The subject-matter of claim 1 of auxiliary request 6 is not clear (Article 84 EPC), given said feature (ii) including the terms "changed" and "selected", which are employed in the same context (i.e. in conjunction with operating the operating device"), these terms having however a different meaning and thus leading to different interpretations of feature (ii). Indeed, the term "selected" (in the context of feature (ii)) is understood as referring to the user choosing a specific combination among predefined different combinations of

operating states (of the front and rear suspensions) stored in the storage means. By contrast hereto (in the context of feature (ii)) "changed" can be understood as referring to the fact that "by changing the combination information stored in the storage means, settings defining combinations of the front and rear suspensions can be changed" (see EP-B, e.g. [0007], lines 33-36). Thus, in the first case only a selection between predefined stored combinations of operating states is implied, whereas in the second case modifying or altering said predefined stored combinations of operating states is implied. The claim's wording is therefore ambiguous.

Additionally, in feature (ii) it is unclear how assigning "one combination information ... to one operating device" can possibly lead to a selection of "different combinations ... with a plurality of operating device (OP1, OP2)". Hence, the requirement of clarity is contravened.

6. The subject-matter of claim 1 of auxiliary request 7 is a combination of the features of claim 1 of auxiliary request 5 and 6 respectively. Therefore, for the aforesaid reasons, it infringes Article 123(2) EPC and Article 84 EPC.
7. The subject-matter of claim 1 of auxiliary request 8 and 9 does not comply with the requirement of clarity (Article 84 EPC), as both these claims include the terms "changed" and "selected" in the same feature and the same context, analogously to the discussion in relation to aforementioned feature (ii). Therefore the same reasons apply.

This objection was not late filed, for in the first place an objection of lack clarity had already been raised by the Opponent against claim 1 of auxiliary request 8 (corresponding to auxiliary request 4 forming the basis for maintaining the patent in amended form according to the appealed decision) and auxiliary request 9 (see statement of grounds of appeal, pages 3-4; letter dated 11 February 2019, page 13), albeit for different reasons. Secondly, the above mentioned feature (i.e. including the terms "changed" and "selected") had been objected to on the grounds of Article 123(2) and (3) EPC (both in auxiliary request 8 and 9), the objection likewise originating from the ambiguous and equivocal (as discussed above) use of the terms "changed" and "selected" in the same context (i.e. relating to the effect produced by operating said operating device OP1, OP2), thus inherently and implicitly encompassing the same clarity objection as discussed hereinabove in relation to said feature (including the terms "changed" and "selected") of claim 1 of auxiliary requests 8 and 9 and in relation to aforementioned feature (ii) of auxiliary request 6.

Consequently it is considered that this objection does not constitute an "amendment" to a party's case within the meaning of Article 13(1) RPBA (Rules of Procedure of the Boards of Appeal) 2020 and is therefore not late filed.

8. The Opponent's objections against the admissibility of auxiliary requests 10 to 13 were not reiterated during oral proceedings, as was explicitly confirmed by the Opponent during oral proceedings. At all events, the Board sees no basis for questioning their admissibility, these requests having been submitted

already during opposition proceedings and subsequently with the statement of grounds of appeal.

9. The subject-matter of auxiliary request 10 is not new (Article 54 EPC) over D4. In effect, features F3 and F4, as discussed in connection with the main request, are known from D4. The further added features (corresponding to the features of granted dependent claim 2) are likewise known from D4, stating that "the device includes, in addition to the signal generating trigger switch, a selector switch for designating a channel or mode corresponding to the immediately desired suspension unit or units. As an example a bicycle may include a signal generating switch having a toggle for selecting between the front and the rear absorber or for selecting both (thereby allowing the signal to trigger the actuator in each with only one operation of the switch)" (see D4, [0012], lines 10-18, see also a similar concept being expressed in D4 [0060], lines 5-10). In conclusion, the subject-matter of claim 1 of auxiliary request 10 is not new over D4. The above objection was sufficiently substantiated by the Opponent in its statement of grounds of appeal (page 14, last paragraph) and in its reply to the Patentee's statement of grounds of appeal (page 14, page 11), in accordance with Article 12(1), (2) RPBA 2007. In these submissions the Opponent substantially indicates that the subject-matter of claim 1 of auxiliary request 10 lacks novelty over D4, for the same reasons as claim 1 of the main request and of auxiliary request 5 (lack novelty over D4), considering that the features of granted dependent claim 2 are also known from D4. These arguments are plainly understandable and allow everyone to verify. Moreover they are sufficiently substantiated, in the same way as are Patentee's arguments, stating that "the subject-

matter of claim 1 of auxiliary request 10 is novel and inventive. The remarks made in conjunction with the main request as well as auxiliary request 5 equally apply in conjunction with auxiliary request 10" (see statement of grounds of appeal, page 39).

10. The subject-matter of claim 1 of auxiliary request 11 is not new over D4 (Article 54 EPC), this subject-matter omitting one feature as compared to the subject-matter of claim 1 of auxiliary request 10, thus lacking novelty in the same way as the subject-matter of claim 1 of auxiliary request 10 (see above).
  
11. The subject-matter of claim 1 of auxiliary request 12 is not new over D4, as feature (iii) (i.e. "wherein the operating device (OP1, OP2) includes a switch (LSW1, LSW2, RSW1, RSW2), and the combination information includes a plurality of combinations of operating states assigned to one switch (LSW1, LSW2, RSW1, RSW2)") is known from D4. In effect it is evident from D4 (see [0012], [0060] cited above) that the operating device includes a "signal generating switch having a toggle for selecting between the front and the rear absorber or for selecting both (thereby allowing the signal to trigger the actuator in each with only one operation of the switch)" (see D4, [0012], lines 10-18). An entirely analogous and equivalent concept is literally derived from [0060] in D4, i.e. "the signal generating device 50 may cause both front and rear shocks to lock/unlock together, or it may permit the user to lock/unlock each shock independently". Therefore the signal generating device 50 explicitly allows to select at least two combinations of operating states (of the front and rear suspensions), namely operating states locked-locked and unlocked-unlocked, thus representing a "plurality of combinations"

according to the wording of claim 1. As to features F3, F4, these are known from D4 as was already discussed hereinbefore (see main request and auxiliary request 10).

12. The Board did not admit the Opponent's objections based on D4 in respect of claim 1 of auxiliary request 13 into the appeal proceedings pursuant to Article 13(1) RPBA 2020.

The allegation of lack of novelty over D4 is late filed, since it was submitted only during oral proceedings, the feature implying "wherein the combination information is set by using an external device (60) and wherein the external device (60) is configured to be connected to the receiving means (96) to output the combination information to the receiving means (96)" having not been objected to heretofore in the written proceedings based on D4 (only based on D5 and D6 in relation to granted dependent claim 3 (see statement of grounds of appeal)). The Board decided to exercise its discretion not to admit this objection, given that the Patentee was not prepared to deal with this objection and it being taken by surprise. In addition, based on the current state of the proceedings, admitting said objection would have been detrimental to procedural economy, the Patentee necessarily and fairly being given the opportunity to submit further auxiliary requests. Finally, the Board also considered that no unambiguous, evident and compelling prima facie case, supporting the relevance of the new Opponent's submissions, actually emerged from the Opponent's arguments and that further discussion was necessary.

The objections based on lack of inventive step in view of D1 or D2 in conjunction with D5 or D6 were not sufficiently substantiated in view of Articles 12(1), (2) and 12(4) RPBA 2007. In the statement of grounds of appeal, the Opponent merely states that "it would be obvious for the skilled person to combine any of those teachings with e.g. D1 or D2". Therefore the board did not take this objection into consideration and no additional arguments relating to this line of argument were admitted during oral proceedings by the Board.

The Opponent had no further objections against the claims according to auxiliary request 13.

The Board thus considers that the claims according to auxiliary request 13 form the basis for the maintenance of the patent in amended form.

Further, considering the agreement of the parties in this respect, the Board considers it as appropriate to remit the case to the Opposition Division for the adaptation of the description.

## **Order**

### **For these reasons it is decided that:**

The decision under appeal is set aside.

The case is remitted to the Opposition Division with the order to maintain the patent with the following claims:

Claims 1 to 4 according to auxiliary request 13 filed with the statement of grounds of appeal;

and a description to be adapted thereto.

The Registrar:

The Chairman:



D. Magliano

G. Pricolo

Decision electronically authenticated