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**Datasheet for the decision  
of 17 August 2022**

**Case Number:** T 2421/18 - 3.2.06

**Application Number:** 13192962.2

**Publication Number:** 2725130

**IPC:** D06F37/20, F16F7/09

**Language of the proceedings:** EN

**Title of invention:**

Shock absorber having an improved friction element

**Patent Proprietor:**

Aksistem Elektromekanik Sanayi ve Ticaret Ltd.  
Sti.

**Opponent:**

SUSPA GmbH

**Headword:**

**Relevant legal provisions:**

EPC Art. 100(c), 123(2)

**Keyword:**

Amendments - added subject-matter (yes)

**Decisions cited:**

G 0003/89, G 0011/91, G 0002/10

**Catchword:**



**Beschwerdekammern**

**Boards of Appeal**

**Chambres de recours**

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Case Number: T 2421/18 - 3.2.06

**D E C I S I O N**  
**of Technical Board of Appeal 3.2.06**  
**of 17 August 2022**

**Appellant:**

(Opponent)

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**Decision under appeal:**

**Decision of the Opposition Division of the  
European Patent Office posted on 23 August 2018  
rejecting the opposition filed against European  
patent No. 2725130 pursuant to Article 101(2)  
EPC.**

**Composition of the Board:**

<b>Chairman</b>	M. Harrison
<b>Members:</b>	P. Cipriano
	J. Hoppe

## **Summary of Facts and Submissions**

- I. An appeal was filed by the appellant (opponent) against the decision of the opposition division rejecting the opposition to European patent No. 2 725 130. It requested that the decision under appeal be set aside and the patent be revoked. It also requested oral proceedings.
- II. With its reply, the respondent (patent proprietor) requested that the appeal be dismissed or, as an auxiliary measure, that the patent be maintained according to one of auxiliary requests 1 and 2 (auxiliary requests I and II) filed therewith.
- III. The parties were summoned to oral proceedings.
- IV. With letter dated 6 May 2022, the appellant announced that it would not attend oral proceedings, withdrew its request for oral proceedings and requested a decision in writing.
- V. With letter dated 30 May 2022, the respondent informed the Board that it would also not attend the oral proceedings and requested a decision based on the written submissions.
- VI. The oral proceedings were duly cancelled.
- VII. Claim 1 of the main request (patent as granted) reads as follows (with the claim breakdown as in annex 2 (Anlage E2) dated 21 December 2016):
1. A shock absorber (11) comprising
  2. a tubular first portion in the form of a shock absorber casing (12)

3. telescopically receiving a tubular second portion in the form of a piston (13),
4. said first portion comprising an alignment member (15)
5. which encapsulates a friction element (17) wrapped around said second portion (13) and
6. which is longitudinally movable in between a first stop bearing (18) and a second stop bearing (19)
7. such that friction occurs in between the friction element (17) and the piston (13) during the oscillatory relative movement of said first and second portions,
8. wherein the friction element (17) is entrapped within a closed volume the outer ends of which are defined by the two stop bearings (18) and (19) characterized in that
9. the friction element (17) has a plurality of tips (25) or protrusions
10. which extend, parallel to the longitudinal direction of said piston (13), towards at least one of the two bearings (18 or 19) and which hit either of said bearings (18 or 19) during the oscillatory back and forth movement of said alignment member (15) during operation, and
11. wherein the inner diameter of the alignment member (15) is larger than the outer diameters of the two stop bearings (18,19) whereby it is ensured that the two stop bearings contact with the tips (25) of the friction element (17) during use of the shock absorber."

VIII. Claim 1 of auxiliary request 1 reads as for claim 1 of the main request with the following additional feature between features 6 and 7:

"said alignment member (15) forcing a friction element (17) radially towards said second portion (13)"

- IX. Claim 1 of auxiliary request 2 reads as for claim 1 of auxiliary request 1 with the following additional feature between features 5 and 6:  
"wherein the friction element (17) does not move with respect to the alignment member (15)"
- X. The appellant's arguments relevant to the present decision may be summarised as follows:

*Main request - Article 100(c) EPC*

The ground of opposition under Article 100(c) EPC was prejudicial to maintenance of the patent, *inter alia* for the following reasons:

According to the disclosure of the application as originally filed on page 7, lines 1 and 2, the alignment member 15 had to move together with the friction element 17 and press the latter against the second portion/piston 13.

In order for the friction system to work it was also directly and unambiguously disclosed on page 6, line 6 that the bearings 18 and 19 were fixed to the housing 12 and formed in one piece with the lock ring 16.

*Auxiliary requests 1 and 2 - Article 123(2) EPC*

Claim 1 of auxiliary requests 1 and 2 did not fulfil the requirement of Article 123(2) EPC since the amendments made did not overcome the objections made with regard to the main request and even gave rise to further objections.

The necessary structural features to achieve the friction defined in claim 1 of auxiliary request 1 had been omitted.

The amendment in claim 1 of auxiliary request 2 left open the way of achieving the claimed immobilisation whereas the application as originally filed only disclosed the use of a circumferential protrusion (26) as described on page 7, lines 16 to 18, to achieve this immobilisation.

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

*Main request - Article 100(c) EPC*

The respondent referred to II. 13 of the impugned decision.

Features 7 and 8 were disclosed on page 5, lines 15 to 17 and page 7, lines 9 and 10 as well as in Figures 1 and 2 of the application as originally filed.

The original application did not disclose any specific relationship between the bearing 19 and the lock ring 16. The lock ring 16 was not essential for the occurrence of friction and thus did not need to be defined in claim 1.

Also, the second paragraph of page 9 was in an almost literal agreement with the features 4 to 8 of claim 1 and thus provided a basis for features 7 and 8.



*Auxiliary requests 1 and 2 - Article 123(2) EPC*

The basis in the disclosure of the feature added in claim 1 of auxiliary request 1 was found on page 9, second paragraph, lines 10 to 13.

The basis in the disclosure of the feature added in claim 1 of auxiliary request 2 was found in the first paragraph on page 7.

**Reasons for the Decision**

1. Main request - Article 100(c) EPC

1.1 The following features were added to claim 1 during examination:

Feature 7 - such that friction occurs in between the friction element (17) and the piston (13) during the oscillatory relative movement of said first and second portions,

Feature 8 - wherein the friction element (17) is entrapped within a closed volume the outer ends of which are defined by the two stop bearings (18) and (19).

1.2 As the respondent argued, these features have a respective basis in the text on page 5, lines 15-17 and on page 7, lines 9-10, of the description as originally filed.

However, they belong to a disclosure where the friction relative movement is described more specifically. As pointed out by the appellant in items II.1.c) and II.2 of its grounds of appeal, the skilled person would

derive from the disclosure of the application as originally filed that the friction element alignment member 15 not only "encapsulates" (as already defined in features 4 and 5 claim 1) but also exerts some kind of force on the friction element 17 radially towards the surface of the piston for the friction as defined in feature 7 to occur (see page 5, lines 14-19, and page 7, lines 1-14). For example, and as pointed out by the appellant in item II.1.b) of its appeal grounds, the bearing 19 is part of the lock ring 16, as disclosed on page 6, lines 6 by the wording "the bearing (19) within the lock ring (16)" and also as shown in Fig. 1 where lock ring 16 and bearing 19 are shown in uniform hatching, thus, as a single piece.

- 1.3 The argument from the respondent that the original application did not disclose any specific relationship between the bearing 19 and the lock ring 16 and that the lock ring 16 was not essential for the occurrence of friction does not alter the Board's conclusion.

According to the so called "gold standard", an amendment can be made only within the limits of what the skilled person would derive directly and unambiguously, using common general knowledge, and seen objectively and relative to the date of filing, from the whole of the documents as filed (see G 3/89, G 11/91 and G 2/10). Thus, the opposition division basing its conclusions mainly on the argument that the omitted features were not essential, did not use the correct criteria and ignored the structural relationship between the omitted features.

Contrary to the arguments of the respondent and of the opposition division, it is thus irrelevant whether the

lock ring being a part of the stop bearing is regarded as essential or not.

In order for the friction system to work and the shock absorber piston 13 to move within the casing 12 ("The movement... is enabled...") it is directly and unambiguously disclosed on page 6, lines 1 to 8 that, among other things, the casing bearing 18 and lock ring bearing 19 have to be within the shock absorber casing 12 and the lock ring 16, respectively. There is thus a functional and structural relationship disclosed between the lock ring 16 and the bearing 19 and the original application does not directly and unambiguously disclose any other construction that could lead the skilled person reading the disclosure to consider this arrangement between the bearing 19 and the lock ring 16 as merely an optional (or even a "non-essential") possibility. It thus forms an integral part of the disclosure of the structural relationship of the parts necessary for the friction to occur.

- 1.4 The respondent also argued that the second paragraph on page 9 disclosed that the friction element was wrapped around the second portion and encapsulated by an alignment member and therefore provided a basis for features 7 and 8 as it was in almost literal agreement with features 4 to 8 of claim 1.

The Board does not accept this argument. The paragraph on page 9 is not in literal agreement with the features 4 to 8 of claim 1 but rather describes a more specific arrangement, just as the passages cited in item 1.2 above. For example, the paragraph also describes "a friction element alignment member (15) forcing a friction element (17) radially towards said second portion (13) such that friction occurs...". Thus, this

passage also discloses more specifically that the friction element alignment member 15 exerts some kind of force on the friction element 17 radially towards the surface of the piston in order that the friction as defined in feature 7 occurs. This aspect is however not reflected in claim 1.

The respondent's argument that the friction element is wrapped around the second portion and encapsulated by an alignment member, however, does not mean that the encapsulating member forces the friction member into contact with the piston. Thus, the respondent's argument is not persuasive.

1.5 The amendments made before grant to claim 1 (now forming claim 1 of the main request) do therefore result in subject-matter which extends beyond the content of the application as originally filed, such that the ground for opposition under Article 100(c) EPC is prejudicial to maintenance of the patent. Thus, the main request is not allowable.

2. Auxiliary requests 1 and 2 - Article 123(2) EPC

2.1 Claim 1 of auxiliary request 1 has been amended with regard to claim 1 of the main request by the introduction of the feature "said alignment member (15) forcing a friction element (17) radially towards said second portion (13)".

2.1.1 The respondent argues that the basis for this feature is to be found on page 9, second paragraph, lines 10 to 13.

The Board does not accept this argument since the specific structural features that allow the alignment

member to force the friction element radially towards said second portion such as the circumferential protrusion 26 and the lock ring 16 are still missing from claim 1 (see also items 1.2 and 1.3 above). Thus, the respondent has only included some of the features which are disclosed in combination in that section of the description, without any basis for omitting the others.

2.2 The amendment in claim 1 of auxiliary request 1 does therefore (at least) not overcome the objections under Article 100(c) EPC discussed above against the main request and thus fails to meet the requirement of Article 123(2) EPC.

2.3 Claim 1 of auxiliary request 2 has been amended with regard to claim 1 of auxiliary request 1 by the introduction of the feature "wherein the friction element (17) does not move with respect to the alignment member (15)".

2.3.1 The respondent argues that the basis for this feature is found in the first paragraph on page 7.

However, page 7, lines 10 and 11, from which this feature has been extracted, belong to a disclosure of a more specific arrangement of a friction member and of an alignment member comprising further structurally and functionally linked features for achieving the immobilisation now defined in claim 1 of auxiliary request 2. For example, the circumferential protrusion 26 described on page 7, lines 16 to 18, to fix the friction element 17 with respect to the alignment member 15 is omitted.

- 2.4 The amendment to claim 1 of auxiliary request 2 thus not only fails to overcome the objections discussed above but also introduces a new objection under Article 123(2) EPC.
- 2.5 The subject-matter of claim 1 of auxiliary requests 1 and 2 therefore does not fulfil the requirement of Article 123(2) EPC. Auxiliary requests 1 and 2 are therefore not allowable.
- 2.6 In the absence of any request which meets the requirements of the EPC, the patent has to be revoked (Article 101(3) (b) EPC).

## Order

### For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The patent is revoked.

The Registrar:

The Chairman:



C. Rodríguez

M. Harrison

Decision electronically authenticated