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**Datasheet for the decision
of 11 July 2023**

Case Number: T 2352/19 - 3.2.06

Application Number: 05006795.8

Publication Number: 1582453

IPC: B62M25/08

Language of the proceedings: EN

Title of invention:

Apparatus for adjusting a position of a bicycle control device

Patent Proprietor:

SHIMANO INC.

Opponent:

SRAM, LLC

Headword:

Relevant legal provisions:

EPC Art. 54(3), 113

RPBA 2020 Art. 13(2), 12(2)

Keyword:

Novelty - main request (no) - auxiliary request 1 (no)
Late-filed auxiliary request 2 - admitted (no)
Exceptional circumstances without causality between a newly
raised aspect and the Board's final conclusion (no)

Decisions cited:

G 0009/91

Catchword:

If, as in the present case, no causality exists between a
newly raised aspect and the final conclusion of the Board, the
newly raised aspect does not qualify as an exceptional
circumstance according to Article 13(2) RPBA 2020 that could
justify taking a new request into account.
(Reasons 2.5.2)



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Case Number: T 2352/19 - 3.2.06

D E C I S I O N
of Technical Board of Appeal 3.2.06
of 11 July 2023

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Decision under appeal: **Interlocutory decision of the Opposition
Division of the European Patent Office posted on
25 June 2019 concerning maintenance of the
European Patent No. 1582453 in amended form.**

Composition of the Board:

Chairman	M. Harrison
Members:	P. Cipriano
	J. Hoppe

Summary of Facts and Submissions

- I. An appeal was filed by the appellant (opponent) against the interlocutory decision of the opposition division in which it found that, account being taken of the amendments made during the proceedings before the opposition division according to the then pending auxiliary request 4, European patent No. 1 582 453 met the requirements of the EPC.
- II. With the grounds of appeal the appellant requested that the decision under appeal be set aside and the European patent be revoked.
- III. With its reply the respondent (patent proprietor) requested that the appeal be dismissed as a main request or that the patent be maintained in amended form based on the claims of an auxiliary request (hereafter auxiliary request 1) filed with the reply to the grounds of appeal.
- IV. The following document is relevant for the present decision:
O2 EP 1 426 284 B1
- V. The Board issued a summons to oral proceedings and a subsequent communication, in which it indicated *inter alia* that the subject-matter of claim 1 of the main request and of auxiliary request 1 was not novel over O2. In this regard the Board mentioned *inter alia* two questions concerning feature 8: firstly, whether the two levers 43 and 44 already corresponded to an operating member as defined in claim 1, and secondly, whether a skilled person reading paragraph [0079] would

understand that the swing lever was an alternative to levers 43 and 44.

VI. With letter dated 7 July 2023 the respondent filed auxiliary requests 1 and 2, which replaced previous auxiliary request 1.

VII. Oral proceedings were held before the Board on 11 July 2023.

At the close of the oral proceedings the requests of the parties were as follows:

The appellant requested that the decision under appeal be set aside and the European patent be revoked.

The respondent requested that the appeal be dismissed (main request) or as an auxiliary measure that the patent be maintained in amended form based on one of auxiliary requests 1 or 2, filed with the letter of 7 July 2023.

VIII. Claim 1 of the main request and of auxiliary request 1 reads as follows (with the feature breakdown as used by the appellant on pages 2 and 3 of its statement of grounds):

"1. An apparatus (110) for adjusting operating positions (FP; RP) of a bicycle derailleur (97f; 97r) that moves to a plurality of operating positions (FP; RP), wherein the apparatus (110) comprises:

2. a memory (138) that stores a plurality of operating position values corresponding to the plurality of operating positions (FP; RP) of the bicycle derailleur (97f; 97r);

3. an adjustment value providing unit (130b) that provides an adjustment value; and

4. an updating unit (130c);

4.1 wherein the updating unit (130c) provides a first updated operating position value from a first operating position value of the plurality of operating position values based on the adjustment value,

4.2 the updating unit (130c) provides a second updated operating position value from a different second operating position value of the plurality of operating position values based on the adjustment value.

characterized in that

5. the adjustment value providing unit (130b) comprises a position setting unit for the bicycle derailleur (97f, 97r) and a manually operated electrical switch (131f, 131r, 132f, 132r),

6. wherein the adjustment value comprises an adjustment movement value, and wherein the adjustment value is incremented upon operation of the switch (131f, 131r, 132f, 132r), wherein the plurality of operating position values correspond to a plurality of derailleur positions, and wherein the adjustment movement value corresponds to an adjustment movement of the derailleur (97f, 97r),

7. wherein the switch (131f, 131r, 132f, 132r) comprises an operating member (125); an upshift switch (131f, 131r); and a downshift switch (132f, 132r),

8. wherein the operating member (125) moves from a neutral position to an upshift position to operate the upshift switch (131f, 131r); and wherein the operating member (125) moves from the neutral position to a downshift position to operate the downshift switch (132f, 132r)."

IX. Claim 1 of auxiliary request 2 is based on claim 1 of the main request but with the following modified feature 8:

"wherein the operating member (125) is formed as a switch lever, wherein the switch lever rotates from a neutral position to an upshift position to operate the upshift switch (131f, 131r); and wherein the switch lever rotates from the neutral position to a downshift position to operate the downshift switch (132f, 132r), and wherein the switch lever is biased toward the neutral position."

X. The appellant's arguments relevant to this decision may be summarised as follows:

Main request and auxiliary request 1 - Article 54 EPC

O2 disclosed all the features of claim 1, including feature 8 (see feature breakdown above). Paragraph [0079] of O2 disclosed that a swing lever could be used as an alternative to the two levers of the embodiment. The only logical interpretation to the skilled person would be to replace the two levers with a swing lever having a neutral position in the middle.

Auxiliary request 2 - Article 13(2) RPBA 2020

There were no exceptional circumstances justifying the filing of auxiliary request 2 after the Board's summons to oral proceedings.

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

Main request and auxiliary request 1 - Article 54 EPC

O2 did not disclose feature 8 of claim 1.

Paragraph [0079] of O2 was not limited to one common swing lever to operate the buttons and could also be interpreted as referring to one swing lever being provided for each button. The swing lever alternative described in paragraph [0079] did not directly and unambiguously disclose how to transfer the setting system of levers 43 and 44 to a swing lever system. It was not disclosed that such a swing lever would have one neutral position ("a neutral position"), i.e. it could also have none (swing freely) or have more than one. A neutral position had to be in the middle between the switches, i.e. not closer to either of them.

Auxiliary request 2 - Article 13(2) RPBA 2020

The Board's preliminary opinion introduced a new aspect by considering that levers 43 and 44 in O2 corresponded to the operating member as defined in claim 1 of the main request which was surprising for the appellant.

Auxiliary request 2 was an attempt to overcome the novelty objection, was filed at the earliest possible time and should therefore be taken into account even if the new aspect was not used for the Board's final conclusion on the novelty objection in the light of O2.

Reasons for the Decision

1. Main request and auxiliary request 1 - Article 54 EPC
 - 1.1 The respondent argued that O2 did not disclose feature 8 of claim 1 of the main request and auxiliary request 1. It was not disputed that O2 disclosed the remaining features of claim 1, and the Board also finds no reason to conclude otherwise.
 - 1.2 Feature 8 of claim 1 reads:

"wherein the operating member (125) moves from a neutral position to an upshift position to operate the upshift switch (131f, 131r); and wherein the operating member (125) moves from the neutral position to a downshift position to operate the downshift switch (132f, 132r)."
 - 1.3 Paragraph [0079] of O2 discloses that "[a]s an alternative to the levers 43,44... two buttons which can be be operated by a swing lever can be provided."
 - 1.4 The respondent argued that paragraph [0079] of O2 was not limited to one common swing lever to operate the buttons and could also be interpreted as referring to one swing lever being provided for each button.

The Board does not agree with this argument. The skilled person reading the description would not interpret the passage in paragraph [0079] as disclosing that one swing lever is provided for each button, since this is the configuration previously disclosed in

paragraph [0078] and Figure 2, in which levers 43 to 46 are provided for each switch, respectively. The skilled person would therefore only interpret the alternative to paragraph [0079] as being one swing lever for operating two buttons, otherwise it would not be an alternative.

- 1.5 The respondent also argued that the swing lever alternative described in paragraph [0079] did not directly and unambiguously disclose any system at all which should be used with the swing lever and buttons, nor (even if that argument was not agreed) how to transfer the setting system of levers 43 and 44 to a swing lever system. It was further not disclosed that such a swing lever would have one neutral position ("a neutral position") as claimed, i.e. it could also have none (swing freely) or have more than one.

The Board does not find these arguments persuasive. Paragraph [0079] is directed to the replacement of the two lever manual command devices of paragraph [0078] by a system with a swing lever and two buttons. Specifically, paragraph [0079] does not state merely that an alternative is present, but that it is "an alternative to the levers 43, 44 (45, 46)". Hence the presentation of the alternative is made in a specific context of the previously described embodiment. The skilled person reading the description would then immediately understand that this is the only change that is intended to the electronically servo-assisted gearshift, electronic control unit 40 and manual command devices disclosed in Figures 1 and 2 as well as paragraphs [0074] to [0080].

In addition, the Board does concur that a swing lever could implicitly not have at least one neutral position

between the two buttons. In the example given by the respondent for the inexistence of a neutral position, in which the lever serving as the operating member would supposedly swing freely between the two buttons and oscillate with the turns and bumps to which a bicycle is subjected to, even the vertical (plumb-line) position would correspond to the neutral position in terms of the claim. Thus irrespective of whether such a solution is technically unreasonable (as argued by the appellant), a rider simply riding in a straight line on a level surface, would be faced with a vertical lever (i.e. in a neutral position) which could be swung towards either lever to operate the respective button, and to which position (due to swinging freely) it would swing back after changing up or changing down. There is therefore always at least one neutral position.

Following an alternative interpretation of the respondent, according to which the swing lever in O2 could have a neutral position close to each button (i.e. two neutral positions in total, one close to each button respectively), against which it would then be spring-loaded, the Board finds that such a configuration also falls within the wording of feature 8, which does not exclude more than one neutral position. Taking the specific example given by the respondent, in the case where the swing lever is in the neutral position close to the upshift switch, the lever would move (a short distance) from that neutral position to an upshift position to operate the upshift switch (and then return to that neutral position afterwards). Subsequently, the operating member would also move (a greater distance) from the (i.e the same) neutral position to a downshift position to operate the downshift switch. Whether, after having operated the downshift switch, the swing lever would return to the

first or the second neutral position, is not relevant as the claim is not limited in this regard. Thus, even following the interpretation of the respondent, O2 would still disclose feature 8 of claim 1.

- 1.6 The respondent further argued that such positions were not neutral positions, since neutral positions had to be exactly in the middle between the switches as seen in Figures 3 and 4 of the patent, i.e. they could not be closer to one of the switches.

This argument is not persuasive. The only limitation provided by claim 1 as regards a neutral position is that movement is made from that position to an upshift or a downshift position, and is thus a position in which neither the upshift nor the downshift switch is being operated. Whilst it is true that (the schematic) Figures 3 and 4 of the patent in suit show an arrangement in which P0 (which corresponds to the neutral position) is in the middle between P1 and P2, neither the claims nor the description of the patent specification describe anything regarding the specific arrangement of the neutral position or position P0 and the corresponding switches. The Board therefore sees no reason why the neutral position defined in claim 1 should refer to any specific relative distance to the corresponding switches, since no significance is given to it in the patent.

- 1.7 Since O2 discloses all the features of claim 1, the subject-matter of claim 1 of the main request is not novel over O2, contrary to the requirements of Article 54 EPC.

- 1.8 Claim 1 of auxiliary request 1 is identical to claim 1 of the main request such that the same reasoning

applies. The respondent also did not argue that it did not. The subject-matter of claim 1 of auxiliary request 1 is also not novel over O2 for the reasons stated above.

- 1.9 The main request and auxiliary request 1 are therefore not allowable.
2. Auxiliary request 2 - Article 13(2) RPBA 2020
 - 2.1 Auxiliary request 2 is to be qualified as an amendment of the respondent's appeal case as features were deleted and new features taken from the description were added in claim 1.
 - 2.2 Auxiliary request 2 was filed with letter dated 7 July 2023, i.e. after notification of the summons to oral proceedings in 2022 so that Article 13(2) RPBA 2020 is applicable (see Article 25(1), (3) RPBA 2020).
 - 2.3 Under Article 13(2) RPBA 2020 any amendment to a party's appeal case made at the third level of the convergent approach, i.e. after notification to a summons to oral proceedings, shall, in principle, not be taken into account unless there are *exceptional circumstances*, which have been justified with cogent reasons by the party concerned.

Raising an objection for the first time in a communication of the Board may result in acknowledging exceptional circumstances (see e.g. OJ EPO 2021, Supplementary publication 1, "Table setting out the amendments to the RPBA and the explanatory remarks", page 226; Case Law of the Boards of Appeal, 10th edition, V.A.4.5.5.a)).

- 2.4 The respondent argued that the Board's preliminary opinion contained a new interpretation of the feature "operating member" that led to a new objection regarding lack of novelty. Auxiliary request 2 was therefore an attempt to overcome this new objection at the earliest possible stage and should therefore be taken into account.
- 2.5 This argument is not convincing, as the mere fact that the Board raised a new aspect in the preliminary opinion is not sufficient by itself to acknowledge exceptional circumstances and to admit a new request into the appeal proceedings, if this aspect is ultimately not relevant for the Board's final conclusion.
- 2.5.1 The Board stated in item 1.1 of its preliminary opinion merely that it might require discussion whether the two levers mentioned in O2 (i.e. levers 43 and 44) already corresponded to an operating member as defined in claim 1 and that it did not seem to be excluded from the wording of claim 1 that they did. It is correct that this specific feature's interpretation had not been discussed before. However, the Board's communication continued in item 1.2 of its preliminary opinion where the Board also considered the appellant's objection made in its statement setting out the grounds of appeal (i.e. that the alternative embodiment with a "swing lever" also appeared to disclose feature 8), such that all the features of claim 1 appeared to be disclosed in O2.

Indeed, the Board's final conclusion in the oral proceedings as regards the objection of novelty in the light of O2 was solely based on the appellant's objection and feature comparison which had already been

assessed in the impugned decision (see point 6.2) and which was part of the appellant's appeal case from the beginning of the appeal proceedings. The Board simply confirmed its preliminary opinion that the "alternative" embodiment with a "swing lever" disclosed feature 8 of claim 1 and thereby agreed with the appellant's corresponding objection.

Thus, the other aspect of a possible interpretation of the two levers in O2 corresponding to an operating member of claim 1 as presented by the Board in item 1.1 of its preliminary opinion, never became decisive for the Board's final conclusion and decision.

- 2.5.2 If, as in the present case, no causality exists between the newly raised aspect and the final conclusion of the Board, the newly raised aspect does not qualify as an exceptional circumstance according to Article 13(2) RPBA 2020 that could justify taking the new request into account.

The term "exceptional circumstances" needs to be interpreted in the light and in application of the principles underlying the EPC and the rules of procedure. In this context it should be kept in mind that Article 13(2) RPBA 2020 provides a fair balance between the need for procedural economy on the one hand and the right to be heard, guaranteed by Article 113 EPC, on the other hand, in order to ensure fair proceedings.

Exceptional circumstances can justify the admittance of a new request if a causal link exists between the new aspect raised by the Board and the Board's final conclusion, because the right to be heard requires the possibility of providing a defence against it. If, on

the other hand, the Board's conclusion is not based on the newly raised aspect, there is no need for such defence. As a consequence, the parties' right to be heard is not affected and there is no reason for exceptions to be applied.

The mere fact that the filing of the respondent's request was triggered by the Board's preliminary opinion, i.e. that the raising of the new aspect was causal for the *filing* of the request, does not necessarily result in this request being taken into account. The request might well have been submitted as a legitimate attempt to address the newly raised aspect but the legitimacy of the attempt ceases to exist if the newly raised aspect does not become relevant for the decision.

- 2.6 The respondent contested the necessity for a causal link to exist between the amended request and the Board's conclusion and argued that, if this were the case, the question whether the request would be admitted would then depend on the order chosen by the Board for the assessment of the objections and aspects during the oral proceedings.
- 2.7 Whilst the order of assessment chosen by the Board in the oral proceedings may indeed become decisive for the question of admittance, this is only an ancillary consideration, as the order of assessment lies within the discretion of the Board. If the Board chooses an assessment that is based on those aspects that have been on file since the beginning of the proceedings and thus serves to preserve the parties' interests and procedural economy, the parties do not suffer any disadvantage. Therefore, the respondent's argument is

not apt to question the need for causality between the new aspect and the Board's conclusion.

Moreover, the decision whether a request is to be admitted (or taken into account) or not, is advantageously only taken at the stage when the request becomes relevant and not in advance. Assessing admittance at this stage ensures that the entire preceding circumstances are considered when balancing e.g. the conflicting interests of procedural economy and the right to be heard.

2.8 The Board therefore exercised its discretion and did not take auxiliary request 2 into account (Article 13(2) RPBA 2020).

2.9 Absent any set of claims complying with the requirements of the EPC, the patent has to be revoked.

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:



D. Grundner

M. Harrison

Decision electronically authenticated