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**Datasheet for the decision
of 25 April 2024**

Case Number: T 2138/21 - 3.2.06

Application Number: 16001035.1

Publication Number: 3085613

IPC: B62M9/132

Language of the proceedings: EN

Title of invention:
FRONT GEAR CHANGER

Patent Proprietor:
SRAM, LLC

Opponent:
Shimano Inc.

Headword:

Relevant legal provisions:
RPBA 2020 Art. 12(3), 12(4), 13(2)
EPC 1973 Art. 123(2), 54, 56

Keyword:

Inventive step - (yes)

Amendment after summons - newly raised objection taken into account (no) - newly filed auxiliary request - exceptional circumstances (yes)

Decisions cited:

Catchword:



Beschwerdekammern

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Case Number: T 2138/21 - 3.2.06

D E C I S I O N
of Technical Board of Appeal 3.2.06
of 25 April 2024

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Decision under appeal: **Interlocutory decision of the Opposition
Division of the European Patent Office posted on
8 October 2021 concerning maintenance of the
European Patent No. 3085613 in amended form.**

Composition of the Board:

Chairman M. Harrison
Members: M. Dorfstätter
D. Prietzel-Funk

Summary of Facts and Submissions

- I. In its interlocutory decision the opposition division found that, account being taken of the amendments made by the patent proprietor during the opposition proceedings, European patent No. 3 085 613 met the requirements of the EPC.
- II. Appeals were filed by the patent proprietor and the opponent respectively. As they are both appellants, they will be referred to as 'patent proprietor' and 'opponent' respectively in the following.
- III. The patent proprietor requested that the decision under appeal be set aside and the patent be maintained as granted,
or, in case the Board regarded claim 1 as granted novel over E4, that the case be remitted to the opposition division for further prosecution,
or that the patent be maintained in amended form according to auxiliary request 1, filed with the patent proprietor's statement setting out the grounds of appeal,
or according to one of auxiliary requests 1a, 1b, 2, 2a, 3, 3a, 4, 5, 5a, 5b, 6, 6a, 6b, 7, 7a or 7b, all filed with the patent proprietor's reply to the opponent's statement setting out the grounds of appeal,
or according to one of auxiliary requests 1', 1a', 1b', 4', 5', 5a', 5b', 6', 6a', 6b', 7', 7a' and 7b', all filed by letter dated 5 April 2024.
- IV. The opponent (appellant) requested that the decision under appeal be set aside and the European patent be revoked.

V. The following documents are relevant for the present decision:

E1 EP 1 693 294 A2
E2 EP 1 818 253 A2
E3 EP 1 568 589 A2
E4 DE 43 40 471 C1

VI. The Board issued a summons to oral proceedings and a subsequent communication, in which it indicated *inter alia* that novelty and inventive step were to be discussed, as well as whether the patent proprietor had, during the entire opposition proceedings, ever alleged that feature F8 was not disclosed by E4. It mentioned that admittance of this potential change of case thus required discussion. It further mentioned that admittance of several auxiliary requests might be discussed and that the main point in the discussion might turn around the question as to whether it would be obvious for a skilled person to apply a biased two-part link instead of the outer link 9 in E4 which is integral with the gear casing 15.

VII. Oral proceedings were held, during which the patent proprietor withdrew all requests apart from auxiliary request 1b'.

Additionally, the patent proprietor withdrew its appeal.

VIII. The opponent confirmed its initial requests.

IX. Claim 1 of auxiliary request 1b' reads as follows (with the feature-by-feature analysis for all features - except for feature F6' - as used by the opponent):

- F1 "An electromechanical front gear changer (30) for a bicycle (300) having a chain (64), comprising:
- F2 a base member (34) attachable to the bicycle (300) and having a pair of spaced apart points located thereon;
- F3 a linkage (54) movably coupled to the base member (34) and including
- F4 a first link pin (72) supported at the pair of spaced apart points and
- F5 an outer link (56) and an inner link (58),
- F6' the outer link (56) being disposed on the first link pin (72) at one end thereof;
- F7 a chain guide (60) movably coupled to the linkage (54) for contacting the chain (64) of the bicycle (300);
- F8 a motor (226) supported by the base member (34);
- F9 characterized in that the electromechanical gear changer (30) further comprises a gear transmission (126) driven by the motor (226) and
- F10 including an output arm (106) for moving the linkage (54),
- F11 the output arm (106) rotatably disposed about the first link pin (72) between the pair of spaced apart points;
- F16 a housing (48) attached to the base member (34) the gear transmission (126) disposed in the housing (48); and
- F15 a first biasing element (112) disposed about the first link pin (72) and biasing the output arm (106) against the outer link (56)."

- X. The arguments of the patent proprietor may be summarised as follows:

Auxiliary request 1b' should be admitted into the proceedings. It should always be admissible to delete dependent claims as was done in auxiliary request 1b' in order to respond to an objection which was only recognised with the Board's communication because the opponent had not given any reasons why the dependent claims were not allowable. As this request was based on previous auxiliary request 1b filed with the reply to the opponent's grounds of appeal, this request was also admissible. Since the opposition division had found the higher ranking auxiliary request 1a allowable, there was no need to have filed auxiliary request 1b already in the first instance proceedings.

The subject-matter of claim 1 of auxiliary request 1b' was novel. E3 showed a motor linkage 34 forming a multi-piece connection arrangement that could not be considered an output arm in the sense of the contested patent.

The line of argument that feature F8 established a difference over E4, submitted for the first time in the patent proprietor's statement of grounds of appeal, should be admitted into the proceedings. The Board had discretion to admit this new aspect in the discussion of novelty and inventive step. As novelty had to be examined on the basis of an unambiguous disclosure of all features, there was no reason not to consider also feature F8 of claim 1.

The opponent's objection concerning lack of inventive step based on E4, with the technical problem being to avoid jamming, in combination with E3, should not be

admitted into the proceedings. No such attack had been presented until the oral proceedings before the Board.

The subject-matter of claim 1 of auxiliary request 1b' involved an inventive step.

The inventive step attack starting from E3 should not be admitted into the proceedings. There were no exceptional circumstances as required by Article 13(2) RPBA and even in the Board's communication it was mentioned that E3 did not show all features of claim 1. This attack should thus have been presented earlier and not only during the oral proceedings before the Board.

The subject-matter of claim 1 of auxiliary request 1b' was not rendered obvious for a skilled person when starting from E1 or E2 either.

XI. The arguments of the opponent may be summarised as follows:

Auxiliary request 1b' should not be admitted into the proceedings. Auxiliary request 1b was already late filed, since it should have been submitted in the proceedings before the opposition division. The opponent's objection of extension of subject-matter in auxiliary request 1a had already been presented early on in the opposition proceedings and the patent proprietor should have reacted to that then.

The subject-matter of claim 1 of auxiliary request 1b' was not novel over E3. The saver link 92 constituted an output arm in the sense of the contested patent. Alternatively, the entire motor linkage 34 comprising the saver link 92 and the drive link 91 could be considered as the output arm.

The line of argument that feature F8 established a difference over E4, submitted for the first time in the statement of the patent proprietor's grounds of appeal, should not be admitted into the proceedings. This was never argued as being a difference in the proceedings before and amounted to creating a fresh case upon filing the grounds of appeal.

The objection of lack of inventive step based on E4, the technical problem being to avoid jamming, in combination with the teaching of E3 should be admitted into the proceedings. The objection had already been presented in a general form in the opponent's statement of grounds of appeal and had been developed in further detail during the oral proceedings before the Board.

The subject-matter of claim 1 of auxiliary request 1b' did not involve an inventive step. Starting from E4, a skilled person would combine the teaching of E3 with this in order to avoid jamming and would thereby arrive at the claimed invention.

The inventive step attack starting from E3 should be admitted into the proceedings. It resulted from a development of the novelty attack based on E3 put forward in the statement of grounds of appeal. It should always be possible to elaborate an inventive step attack based on a novelty attack that was eventually found unconvincing.

The subject-matter of claim 1 of auxiliary request 1b' was furthermore rendered obvious for a skilled person when starting from either E1 or E2.

Reasons for the Decision

1. *Admittance of auxiliary request 1b'*

Auxiliary request 1b' is admitted into the proceedings (Article 12(4) RPBA).

- 1.1 Auxiliary request 1b' was submitted with letter dated 5 April 2024. It differs from auxiliary request 1b submitted with the reply to the opponent's grounds of appeal (and meanwhile withdrawn) only in that some of its dependent claims have been deleted. Both auxiliary request 1b' and auxiliary request 1b differ from auxiliary request 1a (as found by the opposition division to fulfil all requirements of the EPC and meanwhile also withdrawn) in that claim 1 includes, additionally to feature F15, also feature F16. Thus, in claim 1 of auxiliary requests 1b and 1b', all the features of claim 5 as granted are incorporated into claim 1 (and not just one of the features of claim 5, namely feature F15).

The opponent's objections that claim 1 of auxiliary request 1a introduced subject-matter extending beyond the content of the application as filed, either taken alone or in combination with the dependent claims, are thus rendered moot by auxiliary request 1b'. This was not contested by the opponent.

- 1.2 However, the opponent objected that the patent proprietor did not submit auxiliary requests 1b and 1b' already in the proceedings before the opposition division despite an objection of extended subject-

matter already having been made early in those proceedings.

During the proceedings before the opposition division and with letter dated 30 January 2020, the patent proprietor had submitted auxiliary request 1. In response thereto, the opponent argued in its letter of 27 November 2020 that claim 1 of auxiliary request 1 did not fulfil the requirement of Article 123(2) EPC because only a part of claim 5 as granted (namely feature F15 but not feature F16) had been incorporated into claim 1 of this request. In its submission dated 15 March 2021, the patent proprietor refuted the opponent's attack under Article 123(2) EPC against claim 1 of auxiliary request 1 but did not file an amended request.

During the oral proceedings before the Board, the opponent argued that it was when submitting that letter when the patent proprietor should have filed an auxiliary request with a claim 1 including both features F15 and F16, thereby overcoming the objection in view of Article 123(2) EPC. Auxiliary request 1b was therefore already late filed and should not be admitted into the proceedings. Likewise auxiliary request 1b' should not be admitted as it was based on that inadmissible request.

- 1.3 The Board does not accept this. Nor is it of any relevance for the present appeal proceedings whether the patent proprietor had filed auxiliary request 1b (or 1b') in the proceedings before the opposition division. Since the opposition division found that higher ranking auxiliary request 1a fulfilled all requirements of the EPC, lower ranking auxiliary request 1b (or 1b') would not have been discussed, even

if it had been filed already at the point in time suggested by the opponent. In any case the Board would be confronted with a request which the opposition division had not considered.

With its statement of grounds of appeal, the opponent reiterated its objections against claim 1 and the dependent claims of auxiliary request 1. In response thereto, the patent proprietor submitted several new auxiliary requests, amongst which was auxiliary request 1b. As it was filed together with the reply to the opponent's appeal, auxiliary request 1b forms part of the patent proprietor's complete appeal case (Article 12(3) RPBA).

The Board, however, has discretion under Article 12(4) RPBA not to admit auxiliary request 1b into the proceedings because it was not admissibly raised and maintained in the proceedings leading to the decision under appeal. It is thus regarded as an amendment.

Article 12(4) RPBA sets out that the Board shall exercise its discretion in view of, *inter alia*, the complexity of the amendment, the suitability of the amendment to address the issues which led to the decision under appeal, and the need for procedural economy. It is clear that the objection that claim 1 of auxiliary request 1 contravenes Article 123(2) EPC, due to only a part of granted claim 5 having been incorporated, is rendered moot by the inclusion of all features of claim 5. The opponent argued however that procedural economy was impeded by the need to discuss auxiliary request 1b, if it was admitted into the appeal proceedings.

This is not convincing as the need to discuss it would be the same if auxiliary request 1b had already been submitted in the proceedings before the opposition division. Filing the request only with the reply to the opponent's statement of grounds of appeal does thus not make any difference for the procedural economy of the present proceedings.

The Board can thus see no reason why auxiliary request 1b would not have been admitted into the proceedings. It was of course ultimately not necessary to decide this issue conclusively since this request was withdrawn and replaced by auxiliary request 1b'. Nevertheless, since claim 1 of each of these requests is identical, the aforementioned issues surrounding auxiliary request 1b are relevant to the admittance of auxiliary request 1b'.

- 1.4 Auxiliary request 1b' is based on auxiliary request 1b and differs therefrom merely in that two dependent claims are deleted. The opponent did not separately object against the admittance of this request, other than that it was inadmissible because it was based on the allegedly inadmissible auxiliary request 1b. Since the Board found the opponent's arguments with respect to the alleged late filing of auxiliary request 1b unconvincing, they are not a reason to find otherwise for auxiliary request 1b'.

However, the patent proprietor submitted auxiliary request 1b' with its amendments only after the Board had issued its communication under Article 15(1) RPBA. The Board has thus, in principle, discretion not to take it into account under Article 13(2) RPBA if these amendments were considered to be an amendment to the

patent proprietor's appeal case if no exceptional circumstances apply.

The question of whether the deletion of the two dependent claims constitutes an amendment of the party's appeal case can however be left unanswered in the present case, because the Board anyway admits auxiliary request 1b' into the proceedings due to the presence of exceptional circumstances. The deletion of two dependent claims was done to overcome an objection under Article 123(2) EPC. Although this objection was raised by the opponent in its statement of grounds of appeal (see the paragraph bridging pages 4 and 5), the Board can accept that this was only fully recognised as being a separate objection to that made against claim 1 after the Board had mentioned the dependent claims separately in its communication. This was due to the opponent having only made the objection in a very cursory manner at the end of its objection to claim 1. These constitute exceptional circumstances in the present case. Further, the most straightforward possibility to overcome the objection, namely to delete the objected dependent claims, is justified, even if this was done only after receipt of the Board's communication, such that the requirements of Article 13(1) RPBA are also met.

- 1.5 Auxiliary request 1b' was thus admitted into the appeal proceedings.
2. Article 123(2) EPC

Having been asked whether it had any objections against auxiliary request 1b' in view of Article 123(2) EPC, the opponent confirmed that it had none. The Board also finds no cause for objection under Article 123(2) EPC.

The requirement of Article 123(2) EPC is thus fulfilled.

3. *Novelty*

The subject-matter of claim 1 is novel (Article 54 EPC).

3.1 The opponent argued that the subject-matter of claim 1 of auxiliary request 1b' was not novel over E3, in particular with reference to Figs. 10 and 11. It submitted that the saver link 92 constituted an output arm in the sense of features F10 and F11. In this regard, it argued that the gear transmission could include elements which are not gears, such as an arm. An arm could comprise several members, as for example an arm of a human being comprised of an upper arm and a forearm.

The Board does not accept this. The motor linkage 34 depicted in Figs. 10 and 11 of E3 comprises several elements, including an eccentric drive pin 85a of the output shaft 85, drive or motor or link 91 and a saver link 92. It was also argued by the opponent, that all these elements constituting the motor linkage 34 could be seen as a functional unit. However, the Board does not regard this functional unit as being an output arm. Rather, it forms a linkage system comprising several "arms". The drive link 91 and the saver link 92 form part of the linkage system. A skilled person would not interpret the output arm as comprising the whole linkage system but only drive link 91.

3.2 But, even if the drive link 91 and the saver link 92 were considered together as an "output arm" (with which the Board does not concur), these parts would not, as a

whole unit, be rotatably disposed about the first link pin, i.e. pivot pin 47 as required by feature F11. The only part fulfilling this feature would be the saver link 92. Feature F11 clearly refers to the output arm as a whole and not merely to parts thereof. Therefore, the system depicted in Figures 10 and 11 of E3 lacks an output arm for moving the linkage and being rotatably disposed about the first link pin as defined by features F10 and F11.

3.3 The subject-matter of claim 1 is thus novel over E3.

4. *Inventive step*

The subject-matter of claim 1 involves an inventive step (Article 56 EPC).

The opponent put forward several inventive-step attacks, starting from either E1, E2, E3 or E4. In the following, they will be dealt with in the order they were discussed during the oral proceedings before the Board. As explained further below, none of these attacks is convincing.

4.1 *Admittance of new line of defence by the patent proprietor that feature F8 established a distinguishing feature over E4*

The new line of defence, presented for the first time with the statement of grounds of appeal, that feature F8 was not derivable from E4, was admitted into the appeal proceedings (Article 12(4) RPBA).

The opponent argued that, by alleging only in a statement of grounds of appeal that feature F8 was a distinguishing feature over E4, the patent proprietor

effectively created a fresh case which should not be admitted.

The Board however exercised its discretion to admit the patent proprietor's new defence that F8 established a difference over E4, when discussing the now withdrawn main request. Feature F8 is easily comprehensible, the opponent had not objected to this defence when filing its reply to the patentee's grounds of appeal and the examination of whether it was known from E4 was important, being potentially the only feature which might establish novelty of the subject-matter of claim 1 of that request (see the Board's communication, point 2).

4.2 *Admittance of attack E4+E3 with the formulation of a new objective technical problem*

The new line of argument, albeit presented for the first time during the oral proceedings before the Board, of lack of inventive step over the combination of E4 with E3 including the technical problem of avoiding jamming, was considered by the Board.

During the oral proceedings before the Board, the opponent presented an inventive-step attack using E4 as the closest prior art. With feature F15 being the only difference over E4, it formulated the objective technical problem as being to protect the gear changer from jamming. The opponent further argued that jamming, and a way to avoid it, was described in E3 such that the skilled person would combine the teaching of E3 with E4 to solve this problem. They would thus arrive at the subject-matter of claim 1 of auxiliary request 1b' without involving an inventive step.

The patent proprietor argued that by making an inventive-step attack starting from E4, during the oral proceedings before the Board, against the subject-matter of claim 1 of auxiliary request 1b', by formulating a new objective technical problem that was never mentioned before in the proceedings, the opponent had changed its appeal case. Such a change of case was not to be admitted into the proceedings.

The Board however concluded that the attack made during the oral proceedings was a development of the opponent's case as presented in the statement of grounds of appeal against auxiliary request 1a (see item 3.5, inventive step, E4 as closest prior art). The opponent had argued therein that feature F15 had "the technical effect that there [was] a connection between the output arm and the link allowing for a certain flexibility to absorb irregular movement caused e.g. by hits during usage of the derailleur, especially when the derailleur is used with a mountain bike" (emphasis added by the Board). It further argued that "the technical objective [could] be defined to provide a derailleur allowing for some degree of irregular movement without the risk of damage."

The Board concluded that the essence of the argument was that the connection between the output arm and the link was flexible to absorb irregular movements and that the "hits" mentioned in the statement of grounds of appeal were merely given as an example ("caused e.g. by hits"). Hence, although not the same, the reformulation of the problem to avoid jamming, was however concluded, in this particular case, to be encompassed by the general idea of dealing with "irregular movements" and sufficiently related thereto so as to be considered.

The new line of argument of a lack of inventive step over a combination of E4 with E3 with the somewhat reformulated problem was thus considered in the oral proceedings.

4.3 *Inventive step - E4+E3*

The Board concludes, however, that the subject-matter of claim 1 of auxiliary request 1b' is not rendered obvious by E4 in combination with the teaching of E3.

4.3.1 The patent proprietor argued that E4 did not show features F1, F6, F8, F11 and F15.

The Board, however, finds that the subject-matter of claim 1 merely differs from E4 by feature F15. The reasoning why the Board has found all other features to be derivable from E4 can be omitted because it is not relevant for the decision taken. In particular, feature F15 alone implies that the output arm and the outer link are constituted by separate members, the one being biased against the other, and this difference already involves an inventive step (Article 56 EPC).

In the following, it is explained why feature F15 (together with its implications on features F10 and F11) involves an inventive step when starting from E4 as the closest prior art.

4.3.2 It was common ground between the parties that, by defining that the output arm is biased against the outer link, feature F15 implied that the output arm and the outer link are separate components. Since feature F15 further defines that the first biasing element is disposed about the first link pin, and since feature

F11 defines that the output arm is rotatably disposed about the first link pin, this means that the output arm, the first link pin and the first biasing element are all arranged about a common axis constituted by the first link pin. This was also not contested by the parties.

- 4.3.3 Whilst the Board finds that both Figures 3 and 4 of E4 show details of a front derailleur, the patent proprietor argued that Figure 4 of E4 related to a rear derailleur.

It is however clear from the numbering of the reference numerals for "Gelenkkopf 106" and "Kopfgehäuse 108" that these refer to parts of a front derailleur. Numbers above "100" are used throughout E4 to indicate parts used for a front derailleur whilst numbers below "100" indicate their use for a rear derailleur.

The front derailleur of Figures 3 and 4 of E4 thus comprises an outer link 9 ("erster Parallelogrammhebel") which is integral with an output arm 15 ("angeformtes Getriebegehäuse"), both being disposed on the first link pin 11 ("Gelenk").

- 4.3.4 The subject-matter of claim 1 thus differs from the front derailleur shown in Figures 3 and 4 at least in that
- the outer link and the output arm are separate components (this feature is not claimed but implicit from feature F15, see above point 4.3.2), and in that
 - a first biasing element is disposed about the first link pin and biases the output arm against the outer link (feature F15).

- 4.3.5 As stated above (see point 4.2), during the oral proceedings before the Board, the opponent formulated the problem to be solved by the invention as being to protect the gear changer from jamming. It can be left unanswered whether this actually is the objective technical problem, since the Board concludes that an inventive step is involved even if the problem as suggested by the opponent is accepted.
- 4.3.6 The opponent argued that jamming and a way how to avoid it was described in E3. The opponent referred to paragraphs [0016] and [0039] of E3 in which it was described that the non-rigid connection established between the saver link and the derailleur linkage formed a jamming protection arrangement. It further argued that the skilled person would combine the teaching of E3 with E4 and would thus arrive at the subject-matter claimed in claim 1 without the need of inventive skill.

This is not convincing. If anything, E3 teaches to allow a certain flexibility between two links of a multi-part linkage system. However, as also argued by the patent proprietor, E4 suggests a highly rigid but very compact system, in which a single link (i.e. the outer link 9) is directly driven by the output arm ("Getriebegehäuse" 15) with which it forms an integral, single piece. Without knowing the invention, there is no incentive for the skilled person to apply only a specific part of the highly complicated linkage arrangement of E3 to the derailleur of E4. That the skilled person would first separate the integral outer link and output arm in E4 and apply the connection, of the outer link 45 to the separate saver link 92 in E3, to the connection of the two parts so separated in E4, is entirely based on hindsight.

4.3.7 It is noted that the patent proprietor argued that it was not even possible to adapt the integral member of E4 due to constraints in view of sealing of the internal lubrication of drive gear 17. Whilst the Board does not accept this as such, it also does not see an incentive to do so either. There may be a technical way to amend the entire design of E3 and to thereby arrive at something falling under the ambit of claim 1 of auxiliary request 1b', but E3 lacks any hint to apply the spring-loaded jamming protection arrangement in anything else than in the particular position between the saver link and the outer link of E3's entire linkage system with its particular and rather complicated design.

4.3.8 The Board thus concludes that when starting from E4, a skilled person would not arrive at the subject-matter of claim 1 without an inventive step being involved.

4.4 *Admittance of inventive-step attack starting from E3*

The opponent's new objection concerning a lack of inventive step starting from E3 as the closest prior art is not admitted into the proceedings.

During the oral proceedings before the Board and for the first time in the entire proceedings, the opponent presented an inventive-step attack using E3 as the closest prior art. The opponent argued that it had objected to lack of novelty over E3 of the subject-matter of claim 1 of the main request and that the inventive-step attack starting from E3 was just a development of this novelty attack.

This is, however, not accepted. The new attack was presented only during the oral proceedings before the Board. Its admittance is thus governed by Article 13(2) RPBA, ruling that e.g. new objections at this late stage of the proceedings are in principle not to be taken into account. Only if there are exceptional circumstances which are supported with cogent reasons would the Board take such new objections into account. The Board does not see any exceptional circumstances in the present case. Nor did the opponent argue that there were.

The opponent instead argued that it had to be generally possible to elaborate an inventive-step attack based on a novelty attack whenever the latter was found unconvincing.

This is not accepted. Novelty and inventive step attacks are two separate attacks. Lacking novelty requires a disclosure of all features of a claim in the prior art. When novelty is established, this implies that an entirely separate analysis is necessary if inventive step is then to be considered and involves an appreciation of the knowledge of the skilled person and why such person would conclude that an inventive step is not involved. This should have been done much earlier in the proceedings since an opponent must always be prepared that an attack made by them may be found unconvincing. It must therefore present its arguments for a situation that could have been expected at least in theory also in the present case a long time before. In addition, that E3 did not deprive the subject-matter of claim 1 of novelty was also the preliminary opinion of the Board expressed in its communication in preparation for the oral proceedings. Furthermore, the opponent has submitted other

inventive-step attacks starting from several other documents but - willingly or not - not from E3. The attacks made are to be seen as the opponent's complete case and are, to a large extent, its fallback position for the situation that the novelty attacks are unsuccessful. Indeed, in the present case, where the opponent appealed against the form of the patent found allowable by the opposition division and had already made a novelty objection based on E3 which was unsuccessful, such an inventive step attack should have been made with its grounds of appeal. No reason is apparent as to why the attack based on E3 as the closest prior art was withheld until the oral proceedings.

The Board thus exercised its discretion under Article 13(2) RPBA not to take the inventive-step attack starting from E3 into account.

4.5 *Inventive step - starting from E1*

The opponent relied solely on its written submissions on this issue, where it argued that the subject-matter of claim 1 was rendered obvious by E1 and common general knowledge, based on the premise that the only distinguishing feature is the link pin being fixed to the base member, instead of the link pin 47 rotating with the saver link 86 as discernible in Figure 14 of E1. This was argued to be only one of two equally obvious alternatives.

This is not accepted. As also stated in the Board's communication (see item 2, second paragraph), an output arm according to feature F10 is considered to be an element of the gear transmission and not just of the electromechanical gear changer as a whole, thus

including the linkage system. The saver link 86 of E1, identified by the opponent as the output arm in the sense of feature F10, cannot thus be considered as being included in the gear transmission as defined in feature F10. In E1, this applies only to the drive arm 82 which is considered as an "output arm" of the gear transmission in the sense of the patent.

There are therefore further differences between the subject-matter of claim 1 and the front derailleur of E1 than the single one identified by the opponent. In particular, and similar to E4 above, the output arm when considered as being constituted by the combination of the drive arm 82, the first link pin 49 (see Fig. 11) and the saver link biasing element 88 are elements which are not all arranged about a common axis. Clearly, the saver link biasing element 88 is not even disposed about the first link pin (i.e. pivot pin 49) of the outer link 48, but about pivot pin 47 of the inner link 46.

The output arm (i.e. the drive arm 82) is not rotatably disposed about the first link pin (pivot pin 49) either. Instead, it rotates about the output shaft 80 (see E1, Fig. 11).

The Board thus concludes that the skilled person has no incentive and even no teaching whatsoever to change the design of E1 in order to make the three different axes of output shaft 80, pivot pin 49 and pivot pin 47 coincide.

The opponent's argument that a skilled person would arrive at the subject-matter of claim 1 starting from E1 is thus based on hindsight.

The Board thus concludes that E1, even in combination with the general knowledge of the skilled person, does not render the subject-matter of claim 1 obvious.

4.6 *Inventive step - starting from E2*

Also only in writing, the opponent argued that the subject-matter of claim 1 was rendered obvious by E2 and common general knowledge. Since the main design features of the front derailleur of E2 are identical to the one of E1 (compare Fig. 5 of E2 and Fig. 12 of E1) and the derailleurs merely differ in aspects concerning the gear housing, the Board cannot but conclude the same way as with respect to E1. Nor did the opponent put forward a different line of argument for E1 and E2.

The Board thus concludes that starting from E2, even in combination with the general knowledge of the skilled person, does not allow the skilled person to arrive at the subject-matter of claim 1 without involving an inventive step.

5. *Remittal*

The Board considers that the required amendments to the description are not of inconsiderable scope, e.g. paragraphs [0014] to [0026] relating to optional features of the 'second aspect' of the invention need to be amended such that it is clearly understandable which features are considered part of the invention as defined in claim 1 and which remain optional. The same applies for the non-claimed first, second and fourth aspects. Under these circumstances, the Board avails itself of its power under Article 111(1) EPC to remit the case to the opposition division for the description to be adapted to the amended claims.

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 with the following documents:
 - claims 1 to 5 according to auxiliary request 1b' filed with the letter dated 5 April 2024 and a description to be adapted thereto.

The Registrar:

The Chairman:



D. Grundner

M. Harrison

Decision electronically authenticated