

1.

joint filing

priority

delay - withdraw priority

PCT applications must be filed at with the competent receiving office - A10 PCT.

The EPO is competent for nationals & residents of EPC contracting states (including Germany) - R19.1(a)(i) and (ii) PCT, R157(1) EPC, AG-IP Annex C EP

Therefore EPO is competent receiving office for joint filing by two German applicants.

EPC is a special agreement according to A19 PC - J15/80 - so application EP-B is an application for a patent according to A4A(1) PC.

The period for claiming priority from the earlier application EP-B expired 12 m from filing EP-B - A4C(1) Paris Convention, so on:

10 November 2023 + 12 m (A8(2)(a) PCT, A4(C)1 PC, R80.2 PCT) --> 10 November 2024 (Sunday) (R2.4(b) PCT, R80.5 PCT) --> 11 November 2024. So the PCT application was filed in time to validly claim priority from EP-B.

EP-B was filed solely by applicant B, whereas PCT-AB was filed jointly by applicants A and B. Priority to EP-B may be validly claimed jointly by applicants A and B without the need to transfer rights.

Therefore priority is validly claimed.

The period for entering the regional phase before the EPO expires 31 m from priority - A22(3) PCT, R159(1) EPC:

10 November 2023 (A2(xi) PCT) + 31 m (R159(1) EPC, R131(4) EPC) --> 10 June 2026

The earliest priority date can be withdrawn to delay PCT deadlines, including regional phase entry. Any periods that have already expired will not be recomputed if the priority claim is withdrawn, however - R90bis.3(d) PCT.

At present, the PCT application will publish promptly after 18m from the earliest priority date - A21(2)(a) PCT:

10 November 2023 (A2(xi) PCT) + 18m (A21(2)(a) PCT, R80.2 PCT) --> 10 May 2025 (Sat) R80.5 PCT --> 12 May 2025 (Monday)

So promptly after this date.

Priority claim can be withdrawn at any time prior to expiration of 30 m from priority date - R90bis3(a) PCT, A2(xi) PCT:

10 November 2023 + 30 m (R90bis.3(a) PCT, R80.2 PCT) --> 10 May 2026. So we can withdraw the priority claim now.

Publication can be avoided by withdrawing the priority claim before completion of technical preparations - A21(5) PCT, R90bis.1(c) PCT

These complete 15 days before the scheduled publication date - AG-IP 9.014

12 May 2025 - 15 d --> 28 April 2025.

So we can avoid publication in May 2025 if we withdraw the priority claim before 28 April 2025. This will delay publication until:

11 November 2024 (A2(xi) PCT) + 18 m (A21(2)(a) PCT, R80.2 PCT) --> 11 May 2026

This will delay regional phase entry until:

11 November 2024 (A2(xi) PCT) + 31 m (R159(1) EPC, R131(4) EPC) --> 11 June 2027

All documents cited in the search report are A documents, indicating that the subject matter is novel and inventive. Therefore, it may be beneficial to delay publication to prevent disclosure of the invention.

We should withdraw the priority claim in good time before 28 April 2025.

The notice of withdrawal must be signed by all applicants - R90bis.5 PCT, AG-IP 11.056 - and should be addressed to the EPO as receiving office or the IB (R90bis.3(c) PCT).

2.

References to articles and rules are to the EPC

That IT-1 has not been published does not prevent it from being a basis for a priority claim, so long as a filing date is established.

Invention A has been published in a journal after the filing of IT-1 but before the filing date of EP-1. EP-1 must retain the filing date of IT-1 in order to retain the valid priority claim to IT-1, and thus to avoid the publication becoming prior art under A54(2) and A56 EPC.

EP-2 was erroneously filed with the description and claims of EP-2. The correct description and claims may be filed under R56a EPC.

The correct documents can be filed within 2 m from filing or 2m from invitation by the EPO (but there has been no invitation, so 2 m from filing) - R56a(1), (3) EPC, so:

16 January 2025 + 2m (R56a(1), (3) EPC, R131(4) EPC) --> 16 March 2025 (Sunday) (R131(4) EPC -

-> 17 March 2025 (Monday).

EP-1 claimed priority from IT-1 on filing required by A56a(1) EPC, and the claims and description are completely contained in IT-1.

Therefore we should file the correct parts of the claims and description and request that the late filed parts be based on the claimed priority, to avoid changing the filing date, before 17 March 2025 - R56a(1), (3) EPC.

At the same time file a copy of the priority application and file a translation into one of the EPO official languages (English, French or German) - R56a(4)(b) EPC

Indicate that the claims and description are completely taken from the claims and description of the priority application IT-1 - R56a(4) EPC.

The correct parts will be incorporated into the application while retaining the filing date of 16 January 2024 and the priority claim will remain valid. EP-1 will be able to proceed to grant to protect invention A on this basis.

The erroneous parts will remain part of the application as originally filed and be published with the application - OJ2022 A71, GL-A-VI 1.3, GL A-II 6.4.

Invention B in EP-2 has a filing date of 17 February 2025. The filing (R2(1).1 Rfees) and search fees (R2(1).2 Rfees) for EP-2 are due on filing but can be paid 1 m from filing A78(2) EPC, R38(1) EPC:

17 February 2025 + 1 m (R38(1) EPC, R131(4) EPC --> 17 March 2025 (Monday). So we need to pay these by 17 March 2025.

The erroneously filed description and claims are part of the EP-1 as originally filed. EP-1 will publish after the filing date of EP-2. However, the erroneous description and claims will be citable under A54(3) EPC for novelty only as earlier filed but later published art.

Therefore it is necessary to include a priority claim to EP-1 in EP-2, as EP-1 is the first application disclosing this subject matter.

The priority claim can be added at the latest 16 m from the earliest priority date, so 16 January 2025 + 16m R52(4) EPC, R131(4) EPC --> 15 May 2026

Invention B in EP-2 will have the effective filing date of EP-1 and so be novel.

3.

The examining division is bound by the ratio decidendi of the decision of the Board - A111(2) EPC, T843/91, J27/94.

Additionally, the Board's decision on the version of a patent is binding on the department of first instance, and so this version cannot be amended further in proceedings before the EPO - T2558/18.

Therefore the exact wording of the Board's decision must be complied with - GL E-VII 9 - and

the text is final - T2558/18.

Due to this, the applicant cannot request reasoned amendments to the test under R71(6) EPC - this is the response by applicant D filed in response to the communication under R71(3) EPC. Therefore the request for amendment under R71(6) EPC is inadmissible.

The application was therefore deemed withdrawn under R71(7) EPC because the requirements of R71(3) EPC were not fulfilled by the deadline. The communication issued under R112 EPC has been issued notifying the applicant of the loss of rights.

It may be possible to include the dependent claim only by requesting correction under R139 EPC. Decisions of the Board are binding for the examining division in so far as the facts are the same - GL E-X 4. As corrections have no impact on the facts, they may be allowed. Corrections may also be filed at any time while the proceedings are pending before the EPO - J42/92, GL A-V 3 - and will be considered until the day on which the decision to grant is handed to the EPO internal post service. - G12/91. Therefore, a correction request under R139 EPC may still be filed.

However, the correction must be obvious in the sense that it is immediately evident that nothing else would have been intended than is offered as correction - R139 EPC. There is no evidence suggesting that the inclusion of the additional dependent claim would have been obvious in this sense.

Therefore it is not possible to amend the claims of this application to include this additional dependent claim, such that this patent can be granted with the complete text as decided by the board with this dependent claim additionally.

However it is still possible to file a divisional application in order to obtain a patent with this additional dependent claim, because the present application is still pending - R36(1) EPC, G1/09

Therefore, if it is important to obtain specifically a claim reciting the features of the dependent claim, we can file a divisional application with a sole claim which is identical to the additional dependent claim.

Provided that the requirements of A123(2) EPC are met, this will proceed to grant because the subject matter has already been deemed allowable by the Board.

The claims cannot be identical to those granted in the present application, otherwise they may be refused - G4/19.

4.

a) The AAD apply also for PCT applications - OJ2024 24, 2.1

The AAD apply to all fee payments in PCT proceedings - AAD 3.1 - additional search fees are not excluded by AAD 3.2

The communication from the EPO as ISA sets a 1 m deadline for payment of the further search fees - R40.1(ii) PCT. If no action is taken, the EPO will as from the date of the automatic debit order treat the fees as paid provided that they fall due after the automatic debit order and the deposit account has sufficient funds - AAD 4.1

The payment date will be last date of the 1 m period for paying the fee - AAD 5.1

Therefore we should act before this date by revoking the automatic debit order before this date using the central fee payment - AAD 10.1

b) Automatic debit orders cease to have effect when the PCT proceedings before the EPO are terminated - AAD 11.2.

Therefore a new automatic debit order must be filed for the fees to be automatically debited.

This must be filed before the expiry of the 31-month period for completing the acts under R159 EPC. Otherwise the fees will be deemed not paid and the application will be deemed withdrawn - R160(1), (2) EPC.

c) The account contained 3000 EUR on 28 February 2025

A renewal fee in respect of the 6th year was also due on 28 February 2025 - R51(1) EPC- and would be debited on the due date - AAD 5.1(e)

The appeal fee is debited on the date of receipt of the notice of appeal - AAD 5.1(c)

So the appeal and renewal fee are due on the same day.

The appeal fee will be booked first - AAD 4.5(a) - followed by the renewal fee - AAD 4.5(b).

The appeal fee is 2925 EUR - RFees 2(1).11

So the remaining amount is 75 EUR.

The renewal fee will not be debited because there is a shortfall - the renewal fee is 1155 EUR RFees 2(1).4, AAD 6. No other fees will be debited until the shortfall is remedied - AAD 6.

d) In order for an automatic debit order to be revoked, a party must explicitly revoke the automatic debit order - AAD 10.3. The EPO will therefore continue to debit the fees for EP-3

from company G's deposit account, including the renewal fee due at the end of February 2025, provided that there is sufficient funds. So the renewal fee will have been debited at the end of February 2025, on its due date provided that there is sufficient funds - AAD 5.1(e)

5.

The demand for international preliminary examination must be filed at a competent IPEA - A31 (6)(a) PCT, A32(1) PCT, R59 PCT, A152 EPC. EPO is competent for Swedish IPO - AG-IP Annex C - SE

The EPO will only act as IPEA if international search was carried out by the EPO, or (inter alia) the Swedish patent office (A3(2) and Annex (i) Agreement EPO-WIPO, EPG 4.1.017. As the Swedish IPO are ISA, the demand can be filed at the EPO with EPO as IPEA.

The EPO as IPEA will not perform IPE in respect of claims for which an additional search fee is not paid and therefore for which no ISR was established - EPG 4.2.037.

Therefore it is necessary to have invention D searched first in order for it to be examined:

Option (i):

Pay the additional search fee to have invention D searched by the Swedish IPO. The period for paying this search fee is 1 m from the date of the invitation. -R40.1(ii) PCT, so we have at least 3 weeks to do this. The ISA will then establish the ISR and on inventions C and D - A17(3) (a) PCT.

Because inventions C and D were searched by the Swedish IPO, we can request IPEA by the EPO.

Option (ii):

Don't pay the additional fee to the Swedish IPO, and request the EPO to conduct SISR on invention D. The applicant can indicate that they wish to restrict the SIS to an invention other than the invention searched by the ISA - R45bis.1(d) PCT

The EPO as SISA will take the applicant's wish into account and restrict search to that invention, if it agrees with the ISR - EOG 3.4.019, R45bis.1(d) PCT, R45bis.6 PCT, OJ2010 322, OJ2015 A59

To do this, we need to submit the request for SISR to the IB - R45bis.1(a) PCT - indicating the EPO as SISR - R45bis.1(a) PCT

Indicate that only invention D should be the subject of the search

Pay the SIS handling fee - R45bis.2(a) PCT - the SIS fee - R45bis.3(a) - to the IB

The request should be filed within 22m from the priority date, but we should do this as soon as possible as this is the same deadline for requesting IPE.

The EPO will then issue the search of invention D - R45bis.6(a)(ii)

In either case of option (i) or (ii), we should then:

Demand should be filed at teh EPO -- A31(6)(a) PCT, prior to expiry of the later of the following periods:

3m from date of transmittal of the ISR and 22 m from teh priority date - R54bis.1 PCT.

So the period will expire at teh earliest 08/24 + 22 m --> June 2026..

And we need to pay the fees in the same period - A31(5) PCT: handling fee - R57.1 PCT; and preliminary examination fee - R58.1 PCT.

We should file amended claims to limit the claims under A34 PCT at the same time as filing the demand, limiting the claims to invention D, such that only invention D is examined by the EPO.

Option (i) is less preferable because the EPO as IPEA will not consider the written opinion of the Swedish IPO as a first written opinion of teh IPEA - R66.2(a), R66.1bis(b) PCT.

Option (ii) above is preferable because the written opinion of the SISR will be considered a first opinion of the IPEA, and the demand will be a second opinoin, if any amendments/arguments are filed - R66.1(a)-(d) PCT, R66.3 PCT, R66.4bis PCT.

We should proceed with option (ii) and can file the request for SISA and the request for IPE simultaneously. The EPO examiner will then establish the SISR, and then continue with IPE. We will have the opportunity to comment if any objections are raised - OJ2011 532.

This will provide more opportunity to engage with the EPO examiner and to overcome any objections in the international phase.

1. What is the current patent situation as regards the following subject-matter:

(a) a bicycle saddle connector with damping means in the form of

(i) spheres made from rubber (O),

None of IT-A, EP-B, or EP-ABC relate to this subject matter, so these applications/patents are not relevant.

P-MY

P- MY has a filing date of 28 May 2021 and does not claim priority. P-MY granted in Autumn 2023.

P-MY claims: a bicycle saddle connector comprising damping means in the form of: (i) spheres made from rubber (O) or (ii) pyramids made from rubber (P).

P-MY is the first disclosure of the above subject matter.

We should check if renewal fees have been paid to date for PM-Y in Malaysia.

The period for claiming priority from P-MY has expired (12m from filing, so in May 2022).

P-MY would have published in December 2022 (18 m from filing).

EP-A and EP-ABC published before the filing date of P-MY (in March 2020) but do not disclose relevant subject matter. Therefore P-MY is novel over this subject matter.

The claims in P-MY are novel over the art disclosed in [2] because spheres made from rubber are not disclosed in this traditional prior art.

There is a surprisingly better riding experience, indicating an inventive step. Therefore it appears P-MY is validly granted, although this should be checked with local MY attorneys.

PCT-MY

PCT-MY has a filing date of 26 May 2022 and claims priority from P-MY filed 28 May 2021. PCT-MY was filed within 12 m of the filing date of P-MY (28 May 2021 + 12m --> 28 May 2022 (saturday) --> 30 May 2022. So PCT-MY was filed in time.

The right to claim priority from P-MY was transferred in August 2021 from Mr Sandobike to Bikey. Therefore, Bikey is the successor in title to applicant that filed P-MY, and is entitled to file an application claiming priority from P-MY.

PCT-MY claims:

- (i) bicycle saddle connector with damping means made from rubber
- (ii) bicycle saddle connector with damping means made from rubber, wherein the damping means are in the form of spheres

P-MY discloses the subject matter of (ii) above, and so the filing date for this subject matter in PCT-MY is the filing date of P-MY.

P-MY also discloses the subject matter of (i) wherein the damping means are pyramids.

For the subject matter of (i), except (ii) and further wherein the damping means are NOT pyramids, (i.e. bicycle saddle connector with damping means made from rubber wherein the damping means are NOT in the form of spheres or pyramids), P-MY does not disclose this subject matter. Therefore the filing date of this subject matter is the filing date of PCT-MY.

For (ii), the patentability situation is the same as for this subject matter in P-MY, i.e. it could be validly granted in Europe because there is no novelty destroying prior art, and the claim provides a surprising improvement in riding experience, indicating an inventive step. Therefore, the claims to spheres made from rubber in PCT-MY could have been validly granted.

For the subject matter of (i), with a filing date of the filing date of PCT-MY, the Selle brochure in March 2022 is prior art under A54(2) and 56 EPC. The Selle brochure discloses a bicycle saddle connector with damping means in the form of cubes made from rubber (R). This destroys the novelty of the claim to a bicycle saddle connector with damping means made from rubber (R) in PCT-MY, so this subject matter could not be validly granted.

PCT-MY entered the European regional phase as Euro-PCT-MY. Euro-PCT-MY was on entry into the regional phase to claim only a bicycle saddle connector with damping means made from rubber, wherein the damping means are in the form of spheres.

The invitation from the EPO dated 4 April 2024 was not replied to and this resulted in a loss of rights notice from the EPO 6 months ago. This loss of rights was notifying us of the deemed withdrawal of the application under A124(2) EPC for failure to respond to the communication under R141(3) EPC. This period is not excluded from further processing, so it was possible to respond to this communication using further processing until around 4 m ago. However this was missed. Therefore the only possibility to continue with this application is to request re-establishment of rights. However, this is not possible because the deadline for requesting further processing was not missed in spite of all due care. Therefore, Euro-PCT-MY is irretrievably withdrawn.

Therefore it is not possible to obtain protection for spheres made from rubber from Euro-PCT-MY.

EP-DIV

EP-DIV is pending and discloses the subject matter of spheres made from rubber in the description, but does not claim this subject matter.

It is not possible to obtain valid claims to the subject matter spheres made from rubber in EP-DIV because this would result in introducing subject matter into the claims that has not been searched by the EPO (only pyramids made from rubber has been searched).

(ii) pyramids made from rubber (P), or

None of IT-A, EP-B, or EP-ABC relate to this subject matter, so these applications/patents are not relevant.

P-MY

P-MY has a filing date of 28 May 2021 and does not claim priority. P-MY granted in Autumn 2023.

P-MY claims pyramids made from rubber (P). P-MY is the first disclosure of the above subject matter. We should check if renewal fees have been paid to date for P-MY in Malaysia.

The period for claiming priority from P-MY has expired (12m from filing, so in May 2022). P-MY would have published in December 2022 (18 m from filing).

EP-A and EP-ABC published before the filing date of P-MY (in March 2020) but do not disclose relevant subject matter. Therefore P-MY is novel over this subject matter.

The claims in P-MY are novel over the art disclosed in [2] because pyramids made from rubber are not disclosed in this traditional prior art.

There is a surprisingly better riding experience, indicating an inventive step. Therefore it appears P-MY is validly granted covering this subject matter, although this should be checked with local MY attorneys.

PCT-MY

PCT-MY has a filing date of 26 May 2022 and claims priority from P-MY filed 28 May 2021. PCT-MY was filed within 12 m of the filing date of P-MY (28 May 2021 + 12m --> 28 May 2022 (saturday) --> 30 May 2022. So PCT-MY was filed in time.

The right to claim priority from P-MY was transferred in August 2021 from Mr Sandobike to Bikey. Therefore, Bikey is the successor in title to applicant that filed P-MY, and is entitled to file an application claiming priority from P-MY.

PCT-MY did not include a claim to pyramids made from rubber in the international phase. As mentioned above, Euro-PCT-MY is deemed withdrawn and cannot be continued with.

Therefore this subject matter cannot be protected using PCT-MY or Euro-PCT-MY.

EP-DIV

EP-DIV is pending with a filing date of the filing date of PCT-MY - 26 May 2022. EP-DIV claims priority from P-MY. For the same reasons as for PCT-MY above, the priority claim in EP-DIV is valid.

EP-DIV was filed on 30 April 2024, before expiry of the 2m period for filing the search results for P-MY in respect of Euro- PCT-MY. Euro-PCT-MY was deemed withdrawn at expiry of this 2m period (i.e. 4 April 2024 + 2m --> 4 June 2024), so this was the last day that Euro-PCT-MY was pending. Therefore, on 30 April 2024, Euro-PCT-MY was pending and EP-DIV validly filed.

EP-DIV claims a bicycle saddle connector with damping means in the form of pyramids made from rubber (P). This subject matter was disclosed on P-MY, the priority application, so the effective filing date of this subject is 28 May 2021. This subject matter was also disclosed in Euro-PCT-MY, and so EP-DIV does not contain subject matter going beyond the parent application as filed.

For teh same reasons as for P-MY, this subject matter is novel and inventive. The search opinion issued by the EPO on the claimed subject matter is positive, showing that this application is likely to proceed to grant quickly.

The search opinion was published on 18 December 2024. This sets the period for requesting examination and paying the examination fee, and paying the descignation fee - these are due 18 December 2024 + 6 m--> 18 June 2025 (Wednesday). No response to teh search opinion is necessary because the opinion is positive.

(prepare preveious search results copy for filing in exam phase_

(iii) cubes made from rubber (R);

Cubes made from rubber are first disclosed in the Selle Brochure of March 2022. There are no applications/patents with an effective filing date prior to this disclosure that cover this subject matter.

PCT-MY included a broad claim to bicycle saddle connector with damping means made from rubber. However, this claim is only partially entitled to the earlier priority date of 28 May 2021 (filing date of P-MY). So this part of the broad claim is not entitled to the earlier filing date, and thus the Selle Brochure is novelty destroying for any claim covering the subject matter (R). This is true also for any such claims in EP-DIV (or any application in this family).

No other applications relate to the subject matter (R). An application filed now would lack novelty over the Selle disclosure.

It is not possible to obtain a valid patent covering this subject matter.

(b) a bicycle gear shift system comprising an electric motor for shifting the gears and a switch to be mounted on the handlebar of a bicycle for selecting the gears

(i) via an electrical wire (A),

This subject matter was first disclosed in IT-A, filed on 6 June 2018. IT-A was withdrawn without publication, and it is not possible to obtain any valid rights through IT-A.

EP-ABC was filed on 14 May 2019 and claims priority to IT-A. EP-ABC was filed in the 12m priority period in respect of IT-A (6 June 2018 + 12m --> 6 June 2019).

IT-A and EP-ABC were both filed by Campagnelli. IT-A is the first application disclosing this subject matter. So, priority to IT-A is validly claimed in EP-ABC. The effective filing date of this subject matter in EP-ABC is 6 June 2018.

EP-ABC granted with a claim directed to this subject matter.

This subject matter is novel because traditional bike systems do not comprise an electric motor. It is inventive because of the advantage that the cyclist can always operate the switch with the same force, irrespective of the gear engaged.

Therefore, this subject matter was validly granted in EP-ABC. It is likely that this subject matter will be maintained in any granted claims resulting from the opposition against EP-ABC. We should check where EP-ABC was originally validated - this claim is likely to remain in force covering this subject matter in those jurisdictions.

No other applications or patents relate to this subject matter.

(ii) via a wireless radio connection (B), or

This subject matter was first disclosed in EP-B filed on 20 September 2018.

EP-B

EP-B was filed by Campagnelli, but was transferred to Alessio Alessi, the inventor, when he left the company. This transfer, including the right to claim priority from EP-B, was made on 2 May 2019.

EP-B is still pending claiming subject matter (B). The subject matter of EP-ABC that has a priority date of the filing date of IT-A (which is limited to subject matter (A)) is citable for novelty only under A54(3) EPC.

The claim in EP-B to subject matter (B) is novel over this disclosure because the subject matter entitled to priority is limited to (A), so not a wireless radio connection, as required by (B). The claim in EP-B is also novel over the traditional bike systems because they traditional do not comprise an electric motor. It is inventive because of the advantage that the cyclist can always operate the switch with the same force, irrespective of the gear engaged.

Therefore, the claim to subject matter (B) in EP-B is novel and inventive, and could be validly granted.

EP-ABC

EP-ABC was filed by Campagnelli on 14 May 2019 and claims priority to IT-A and EP-B discussed above.

EP-ABC includes a claim to subject matter (B), and this claim was granted.

This subject matter is not entitled to the earlier priority date of the filing date of EP-B, because Campagnelli do not represent the applicant (or successor in title) of EP-B. EP-B and the right to claim priority from EP-B was transferred to Alessio Alessi before the filing date of EP-ABC. Therefore, priority for this subject cannot be validly claimed in EP-ABC.

There is a presumption of validity of the priority claim before the EPO however - G1/22, G2/22. Therefore, the EPO will not check the validity of the priority claim. This presumption can be rebutted, however, by evidencing that the transfer took place before the filing of EP-ABC.

The effective filing date of subject matter (B) in EP-ABC is therefore not the filing date of EP-B, but can only be the filing date of EP-ABC.

EP-B was filed earlier than the effective filing date of subject matter (B) in EP-ABC, but was published later (18 m from filing so around March 2020). EP-B discloses the same subject matter as the claim to subject matter (B) in EP-ABC and is therefore novelty destroying for this subject matter.

Therefore, the claim to (B) in EP-ABC is granted but is not valid.

(iii) as such (C);

Subject matter (C) covers the subject matter of (A) and (B).

Subject matter (C) was first filed in EP-ABC (but covers (A) and (B), so only the part that is (C) NOT (A) or (B) is actually first filed in EP-ABC).

As discussed above, priority to (B) cannot be claimed in EP-ABC. The priority claim to (A) is

valid. Therefore the claim to (C) can be conceptually divided into two parts:

- (i) subject matter (A), entitled to the effective filing date of IT-A; and
- (ii) the remainder of (C), entitled to the effective filing date of EP-ABC.

For the same reasons as for subject matter (B) in EP-ABC, EP-B represent prior art under A54(3) EPC for this subject matter. EP-B discloses a bicycle gear shift system comprising an electric motor for shifting the gears and a switch to be mounted on the handlebar of a bicycle for selecting the gears, wherein the switch is connected via a wireless radio connection to the motor. This anticipates part (ii) of the claim to subject matter (C). Therefore, the claim to subject matter (C) in EP-ABC lacks novelty. It has been granted but is invalid.

(c) a bicycle gear shift system comprising an electric motor for shifting the gears and means for selecting the gears, the means including a GPS sensor (D).

This subject matter was first disclosed in DE-GPS filed on 22 March 2024.

This subject matter has also been disclosed to the public, as of the Bike & Gravel show on 8 and 9 March 2025. Therefore any application filed now that does not claim priority to DE-GPS will lack novelty over this disclosure.

DE-GPS is a German application, so is limited in scope to Germany.

An application claiming priority from DE-GPS should be filed within 12m of filing DE-GPS (so 22 March 2024 + 12m --> 22 March 2025 (saturday) --> 24 March 2025) for a valid claim to priority.

The prior art includes the publications of EP-A, EP-ABC, P-MY and PCT-MY. None of these disclose a means including a GPS sensor, therefore this claim is novel. By including the GPS sensor, the overall effort by the cyclist is reduced enormously, as the cyclist always rides in the optimal gear. The claim is therefore also likely inventive.

Therefore, it appears that applications claiming priority to DE-GPS and claiming the subject matter D can be validly granted.

2. As the situation currently stands:

(a) are we free to produce and sell bicycle gear shift systems according to our two prototypes?

There are two prototypes:

(i) one without a handlebar switch

This prototype does not fall within the claims of EP-ABC, which require the presence of a handlebar switch.

No other granted claims cover this subject matter, so we are free to produce and sell this prototype.

(ii) one with a handlebar switch connected via a wireless radio connection

This prototype falls within the scope of granted claim 1 of EP-ABC. EP-ABC is under opposition but the claims are currently granted and in force in the jurisdictions in which EP-ABC was validated (and renewals are being paid). Therefore, we are not free to produce or sell this prototype, as doing so would infringe EP-ABC.

(b) is Selle S.A. free to produce and sell their existing and planned lines of bicycle saddle connectors?

The only granted claims covering bicycle saddle connectors are those in P-MY. This patent granted with claims directed to a bicycle saddle connector comprising damping means in the form of either:

(i) spheres made from rubber (O) or

(ii) pyramids made from rubber (P).

Selle's current line is: bicycle saddle connector with damping means in the form of cubes made from rubber (R). Selle's current line does not fall within the scope of any granted claims. Therefore, Selle are free to produce and sell their existing line.

Selle's planned line is: bicycle saddle connector with damping means in the form of spheres made from rubber. This falls within the scope of the claim granted in P-MY (part (i) above). Therefore, Selle are not free to produce or sell their planned lines in Malaysia (provided that renewal fees are up to date).

3. What can we do to improve our position?

Opposition against EP-ABC

We should as soon as possible file the evidence showing that the priority right to EP-B was transferred away from the applicant of EP-ABC before EP-ABC was filed. The EPO may disregard late-filed facts or evidence, however, the evidence is prima facie relevant to the

novelty of the application and therefore should be admitted.

The priority application EP-B is already part of the proceedings, so does not need to additionally be introduced as new evidence showing a lack of novelty.

Lack of novelty has not been raised as a ground of opposition, but this is again likely to be admitted because the fresh ground, prima facie, prejudices the maintenance of EP-ABC.

The result of this will be that claims 1 and 2 of EP-ABC will be deemed to lack novelty over EP-B. It is likely that granted claim 3 will be maintained as granted, covering subject matter (A).

EP-DIV

EP-DIV is pending and claims a bicycle saddle connector with damping means in the form of pyramids made from rubber (P). The search opinion was published on 18 December 2024. This sets the period for requesting examination and paying the examination fee, and paying the designation fee - these are due 18 December 2024 + 6 m--> 18 June 2025 (Wednesday). No response to the search opinion is necessary because the opinion is positive.

So, before the 18 June 2025, we should request examination, pay the examination fee and pay the designation fee.

It is also likely that the EPO will request a copy of the search results for the priority application P-MY in the examination phase. We should therefore prepare this copy ready for filing upon invitation, to avoid the possibility of the application being deemed withdrawn due to the lack of filing.

Further divisional

EP-DIV is pending and contains the same description as PCT-MY. EP-DIV therefore describes subject matter (O) i.e. covering a bicycle saddle connector comprising damping means in the form of either spheres made from rubber.

It is possible to file a divisional application directed to this subject matter. We should do this as soon as possible, in order to obtain a granted claim that can be used to prevent Selle from launching their planned line.

We should: file a divisional application from EP-DIV (EP-DIV2) claiming a bicycle saddle connector with damping means in the form of spheres made from rubber. Pay search and filing fees on filing (this is a second generation divisional, so additional divisional filing fees are due). As for EP-DIV, prepare a copy of the search report prepared for P-MY for filing in examination upon invitation.

We should obtain rights as quickly as possible, so we should:

- request early publication to obtain provisional protection
- request examination on filing (and pay examination fee)
- waive invitation under R70(2)

- request PACE as soon as the European search report is received.

As discussed above under q 1(a)(i) this subject matter will proceed to grant. We should then validate it in particular in France, where Selle manufacture their goods.

File further PCT and TW application

We should file a PCT application before 22 March 2025 claiming priority from DE-GPS (PCT-GPS).

At the same time, in order to obtain protection in Taiwan (TW), we should file a national application in TW claiming priority from DE-GPS, because TW is not a WTO or PCT state.

PCT-GPS should claim the same subject matter as DE-GPS. The subject matter in PCT-GPS is novel and inventive, as discussed above under the question 1(c).

EP-B

Offer to buy EP-B from Alessio and prosecute this application to grant. We will then be able to prevent Campagnelli from producing and selling shift systems comprising a wireless radio connection (subject matter (B)).

4. After the improvements:

(a) will we be free to produce and sell bicycle gear shift systems according to our two prototypes?

Of the claims in EP-ABC, only granted claim 3 will be maintained. There are two prototypes:

(i) one without a handlebar switch

This prototype does not fall within the granted (or maintained) claims of EP-ABC, which require the presence of a handlebar switch. No other granted claims cover this subject matter, so we are free to produce and sell this prototype.

(ii) one with a handlebar switch connected via a wireless radio connection

Granted claim 3 of EP-ABC is likely to be maintained and covers a bicycle gear shift system comprising an electric motor for shifting the gears and a switch to be mounted on the handlebar of a bicycle for selecting the gears switch is connected via an electrical wire to the motor. Our prototype does not fall within the scope of this claim, so we will be free to produce and sell the bicycle gear shift systems according to this prototype for now.

However, we should be aware that EP-B is likely to grant and covers a bicycle gear shift system comprising an electric motor for shifting the gears and a switch to be mounted on the

handlebar of a bicycle for selecting the gears, wherein the switch is connected via a wireless radio connection to the motor. Our prototype (ii) above falls within the scope of this claim that could grant from EP-B, so we should attempt to obtain this application and /or obtain a license to it.

(b) will Selle S.A. be free to produce and sell their existing and planned lines of bicycle saddle connectors?

Selle's current line is: bicycle saddle connector with damping means in the form of cubes made from rubber (R). This does not fall within the scope of any claim that will validly grant. Therefore, Selle are free to produce and sell their existing line.

Selle's planned line is: bicycle saddle connector with damping means in the form of spheres made from rubber. This falls within the scope of the claim granted in P-MY (part (i) above). Therefore, Selle are not free to produce or sell their planned lines in Malaysia (provided that renewal fees are up to date).

This also falls within the scope of the claims that will grant from the second divisional application (EP-DIV2). Therefore, Selle will not be free to produce and sell their planned line in the European countries we validate EP-DIV2 in.