

Candidate's answer

To the director of Axbruch GmbH:

General notes

Your German patent application DE-Ax (filed 30.10.2009) contains a long list of suitable oils and a list of potential additives. The specific selection of silicon oil and a viscosity index improver must be considered 'novel' over DE-Ax, and PCT-Ax can therefore not benefit from the priority of DE-Ax for that subject-matter (cfr. G2/98).

I strongly suggest to add a priority claim to USP-Ax (01.02.2010) to your PCT application to cover that subject-matter. Such a priority claim may be added under Rule 26bis.1 PCT up to 4 months from filing: 2 November 2010 + 4 months = 2 March 2011. That is tomorrow, so we must take urgent action.

The priority claim to DE-Ax is valid, because PCT-Ax was filed within the priority period, which was extended by 3 days due to closing days of the receiving office.

If you don't add the priority claim to USP-Ax, the standardization of 01.02.2010 will become prior art for the application to the extent that its subject-matter doesn't benefit from the priority of DE-Ax, as explained above.

This may not be a problem, if the members of the standardization body are all bound by a confidentiality agreement, but you still risk running into other intervening prior art of which you are currently unaware.

Note that it is perfectly allowed to claim priority from a US provisional application (cfr. Notice Pres. EPO 26.09.1996, OJ EPO '96/81). I assume that the declaration of assignment filed by the inventors for this application includes the assignment of the right to claim priority (at least in Europe). That is not automatically the case (T62/05).

I noted that you are active in standardization. Please make sure to strictly follow the standardization body's regulations on disclosure of intellectual property, because failure to do so may affect the enforceability of your patents in certain countries.

The additional search fee you were invited to pay under R.40.1 PCT with respect to claim 4 of PCT-Ax could have been paid within a period of 1 month from the dispatch of the invitation: 23.01.2011 + 1 month = 23.02.2011.

You paid by debit order automatically upon receipt of the invitation, while there were insufficient funds in your account. Your payments will still be considered in time, if you replenished your account within 1 month from being informed of the deficit (26 January 2011 + 1 month = 26.02.2011) and paid an administrative fee of 30% of the uncovered amount (see ADA 6.5, 6.6) within the same time limit.

Having failed to comply with the latter condition, the invention of claim 4 will remain unsearched, and its subject matter cannot be reintroduced in the European phase (R164(2), R137(5)).

The priority claim in EP-PAN1 to JPU-PAN1 appears valid. Although the claimed invention is also disclosed in the earlier application JPU-PAN2 (not the triangular embodiment), this earlier application was filed by Pankataya Japan K.K., which is neither the original applicant of EP-PAN1, nor its predecessor in title. Hence, at the time of filing EP-PAN1, JPU-PAN1 should be considered the “first application” in the sense of the Paris Convention for the concerned subject matter for the applicant Pankataya Nederland B.V.

The fact that EP-PAN1 and JP-PAN2 were later assigned to Pankataya Japan K.K. does not affect the conclusion.

The fact that one applicant has economic ties with the other is also irrelevant, because both are separate legal persons (T5/05).

- 1) JP-PAN1 and JPU-PAN2 were both published before the priority dates of PCT-Ax, and are therefore comprised in the state of the art (A54(2)).

JPU-PAN2 discloses all the features of claim 1 of PCT-Ax. Although JPU-PAN2 mentions several alternatives for the additives of the silicon based lubricant, the mere selection of one such candidate does not confer novelty to the claim. Hence, claim 1 is not new.

JPU-PAN2 discloses that the axle decreases in diameter towards each end. Hence claim 2 is not new.

JPU-PAN2 discloses that the axle has end sections that are pentagonal in cross-section. Hence claim 3 is not new.

JPU-PAN1 or JPU-PAN2 can be considered the closest prior art for claim 4. Neither JPU-PAN2 nor JPU-PAN1 discloses axle end sections having a cross-shaped cross section.

The technical effect of the cross-shaped cross section is that other components of the bicycle that interact with the axle unit can be made lighter. There is no hint in common knowledge or the available prior art that this effect can be obtained by a cross-shaped cross-section. Hence, claim 4 is novel and presents an inventive step over the available prior art.

As the subject-matter of claim 4 has not been (and will not be) searched in the international phase, I recommend filing a divisional application claiming the subject matter of claim 4. In order to be able to file a divisional application under A76/R36 EPC, the parent application (PCT-Ax) must enter the European phase (GL A-IV 1.1.1.1). Entry into European phase may explicitly be requested at any time before the expiry of 31 months from the earliest priority date (A23(2)PCT), i.e. 30.10.2009 + 31 months = 30.05.2012.

To avoid having the standardization disclosure of 01.02.2010 as prior art, a priority claim to USP-Ax must first be added to PCT-Ax as described above.

- 2) EP-PAN1 appears to contain a valid priority claim to JPU-PAN1. JPU-PAN2, which was published after the relevant priority date, is therefore no prior art for EP-PAN1. There is no point in raising it in a third-party observation under art. 115.

As no earlier prior art is known to us, we must conclude that Pankataya will obtain patent protection in Europe for the invention, as disclosed in JPU-PAN1:

(1) – axle unit with seal S, the axle decreasing in diameter toward each end

(2): 1+ axle unit with lubricant comprising silicone oil with an additive from the group of viscosity index improver, emulsifier, and anti-foaming agent

(3): 1+ axle has pentagonal end sections.

The broadest forms of the invention (1 and 2 above) clearly pose a threat to your business, your invention (present claim 4 of PCT-Ax) is a dependent invention. You will thus have to obtain a license from Pankataya to commercialize your invention.

However, since your invention is technically superior and will be standardized, Pankataya will probably be interested in obtaining a license from you as well.

This may be an interesting cross-licensing opportunity.

- 3) Yes, you should appeal.

The main request (rejecting the opposition) was not allowed because the claimed brake lever and/or the claimed brake system were anticipated by EP-PAN2.

On the basis of the available information, it seems justified to consider the lever anticipated by EP-PAN2. However, EP-PAN2 does not contain an enabled disclosure of a brake system. The brake system describes in EP-PAN23 is impossible to make. It is not allowed to base a novelty objection on a non-enabled embodiment (T206/83, T26/85). In my opinion, a claim to a bicycle brake system including the brake lever of the invention must be considered novel over EP-PAN2, even without the disclaimer. As EP-PAN2 is state of the art under art 54(3) EPC, inventive step doesn't come into play.

The objection that the subject matter of the claim of EP-Ax is insufficiently disclosed may not be raised in appeal against the claim mentioned above without your permission, because it constitutes a new ground (G10/91).

However, if the objection of insufficiency is addressed, it may be¹ necessary to limit the claim to brake systems of the type having at least one disc brake, a limitation for which there is explicit support in the description. The fact that there

¹ This is not necessarily the case, because the inclusion of non-working embodiments in a claim is of no harm if there is a large number of conceivable alternatives and the disclosure provides criteria to find appropriate alternatives with reasonable effort (T238/88, T292/85, T301/87)

I assume that it is straightforward for a skilled person to combine the lever of the invention with a variety of known brakes and to find out if it works. This straightforwardness can excuse the lack of elaboration on the brake system in the description.

is no picture in the application is not relevant.

Although it would be ideal if you could simply disclaim brake systems with hydraulic rim brakes and the brake lever, such a limitation is not disclosed in the application as filed. The case law of the Boards of Appeal allows undisclosed disclaimers only in a very limited number of situations and avoiding non-workable embodiments is not among them. (G1/03).

Note that if you don't appeal, you will be a party as of right in the appeal proceedings (A107). In that case, the opponent and sole appellant will be protected by the prohibition of "reformatio in peius", and can only keep the patent as amended or be worse off. If you want to have a chance to defend the patent as granted, you must file a separate notice of appeal and statement of grounds. (G9/92)

4) The following types of brake systems are mentioned:

A – DISC BRAKES with MECHANICAL ACTUATION

- not anticipated
- disc brakes are explicitly mentioned in the description
- mechanical actuation is not mentioned

B – DIS BRAKES with HYDRAULIC ACTUATION

- not anticipated
- disc brakes are explicitly mentioned in the description
- hydraulic actuation is not mentioned

C – RIM BRAKES with MECHANICAL ACTUATION

- not anticipated
- not explicitly mentioned in the application

D – RIM BRAKES with HYDRAULIC ACTUATION

- disclosed in EP-PAN2 (non-working disclosure)
- impossible to make

The broadest possible claim would be the original system claim (A + B + C + D). This claim covers the non-working embodiment D.

A sensible fall-back position (auxiliary request) would be a claim limited to systems with disc brakes. This limitation is disclosed in the application. The resulting claim covers A+B and can be carried out by a person skilled in the art.

EXAMINATION COMMITTEE III

Candidate No.

Paper D 2011 - Marking Sheet

		Maximum possible	Marks awarded	
			Marker 021	Marker 054
Part I	Question 1	4	3,5	4
	Question 2	6	5	5,5
	Question 3	5	4,5	4
	Question 4	5	5	5
	Question 5	3	2,5	2,5
	Question 6	6	5,5	6
	Question 7	4	2,5	3
	Question 8	7	3,5	4
Part II	Question 1	35	28	27,5
	Question 2	11	8,5	7,5
	Question 3	10	9	10
	Question 4	4	2,5	2,5
Total Part I + II		100	80	81,5

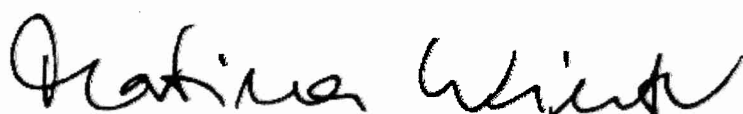
Examination Committee III agrees on 81 marks and recommends the following grade to the Examination Board:

☒ **PASS**
(50-100)

☐ **COMPENSABLE FAIL**
(45-49)

☐ **FAIL**
(0-44)

29 June 2011



M Winter - Chairman of Examination Committee III