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Datasheet for the decision of 29 January 2010

Case Number: T 1599/08 - 3.2.04

Application Number: 01927901.7

Publication Number: 1185183

IPC: A43B 13/12

Language of the proceedings: EN

Title of invention:
Method of manufacturing a breathable shoe

Patentee:
Geox S.p.A.

Opponent:
W. L. Gore & Associates GmbH

Headword:
-

Relevant legal provisions:
EPC Art. 54(1), 111(2)

Relevant legal provisions (EPC 1973):
-

Keyword:
"Novelty (yes) (main, 1st auxiliary requests)"
"Remittal (yes)"

Decisions cited:
-

Catchword:
-

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Beschwerdekammern | Boards of Appeal | Chambres de recours

Case Number: T 1599/08 **-** 3.2.04

D E C I S I O N
of the Technical Board of Appeal 3.2.04
of 29 January 2010

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Decision under appeal: **Interlocutory decision of the Opposition Division of the European Patent Office posted 16 June 2008 concerning maintenance of European patent No. 1185183 in amended form.**

Composition of the Board:

Chairman: M. Ceyte
Members: A. de Vries
C. Heath

Summary of Facts and Submissions

I. Both the Opponent and the Proprietor lodged appeals against the interlocutory decision of the Opposition Division posted 16 June 2008 on the amended form in which European Patent No. 1 185 183 can be maintained.

The appeal of the Appellant-Opponent was received 13 August 2008 together with payment of the appeal fee. The statement setting out the grounds followed on 21 October 2008.

The Appellant-Proprietor filed his appeal on 26 August 2008 together with payment of the appeal fee. The statement setting out the grounds was received 27 October 2008.

II. Oppositions had been filed against the patent as a whole and were based, amongst others, on Article 100(a) together with Articles 52(1) and 54 EPC for lack of novelty, and together with Articles 52(1) and 56 EPC for lack of inventive step.

The Opposition Division held that the subject-matter of claim 1 of the main request lacked novelty but held that the grounds for opposition mentioned in Article 100 EPC did not prejudice the maintenance of the patent as amended according to a first auxiliary request having regard to the following prior art:

E1: JP 9-140404 & English translation
E4: EP-A-0 275 644
E7: EP-A-0 728 424
E8: EP-A-0 915 669
E9: WO-A-93/16612

E11: EP-A-0 910 964

E14: WO-A-97/14326

GO7: Footwear Vocabulary, BSI, BS EN ISO 19952:2005

III. The Appellant-Opponent requests that the decision under appeal be set aside and the patent be revoked in its entirety. He further requests that documents E0 and E15 to E17 be admitted into the proceedings.

The Appellant-Proprietor requests that the decision under appeal be set aside and that the patent be maintained with claims according to the main request, or, in the alternative, in accordance with auxiliary requests 1 to 3, all filed with the grounds of appeal, or in accordance with auxiliary requests 4 to 8 filed with letter of 29 December 2008. He further requests that E0 and E15 to E17 not be admitted into the proceedings.

Both parties request to remit the case to the department of first instance for further prosecution, should the Board find the subject-matter of claim 1 of the main request to be novel over E1.

IV. Oral proceedings were duly held before the Board on 29 January 2010.

At the beginning of the oral proceedings the Board indicated that, should the subject-matter of claim 1 of the main and first auxiliary requests be found to be novel, it would be necessary to discuss inventive step of that subject-matter having regard to E1, the embodiment of figure 2 of E11, and the embodiments of figures 7 and 9 of E14. It considered that figure 9 of

E14 appeared to be a good starting point for the issue of inventive step. With respect to this prior art the claimed subject-matter appeared to differ only in the absence of a filler layer between insole and membrane.

V. The wording of claim 1 of the relevant - main and first auxiliary - requests for this decision is as follows:

Main Request

"A method for manufacturing a breathable shoe consisting of the steps of forming a membrane-including unitary upper assembly (1 0;31 0;1 1311) comprising a breathable upper, and at least one membrane (14;314) made of a material which is waterproof and breathable,

a first step consisting of directly attaching said breathable upper to said membrane in a downward region, said assembly wrapping around the foot insertion region and further comprising a protective element (1 7;31 7) made of a material which is resistant to hydrolysis, water-repellent, breathable or perforated, and

a second step consisting of mutually attaching said unitary assembly to a sole (16;216;316) made of perforated elastomer, such mutually attaching occurring by joining through a perimetrical seal said article of manufacture to said sole, said protective element being arranged below said at least one membrane (14;314) in a region between the upper part of said sole (1 6;21 6;31 6) and its internal part which is adjacent to the ground contact surface."

First Auxiliary Request

Claim 1 is as in the main request but for the following amendments (emphasis added by the Board indicates inserted text):

The opening lines now read:
"A method for manufacturing a breathable shoe *having a sole (16;216;316) made of perforated elastomer and* consisting of ..."

The final lines of the first step now read:
"... breathable or perforated, *the protective element (17;317) being adapted to protect the membrane (14;314) from external impacts or foreign objects that might penetrate the perforations of the sole (16;216;316)*, and"

VI. The Appellant-Opponent argued as follows:

While "directly attached" is unclear and fails to distinguish the claimed method over E1, the weave sheet 43 in E1 necessarily also serves to protect the membrane e.g. from impacts. Furthermore, the subdivision of the method into two steps is arbitrary and otherwise unsupported by the application as filed, cf. specification paragraphs [0040] and [0057]. In any case the final attachment step does not exclude sub-steps in which a composite sole is formed and attached to the upper assembly as in E1. The method of claim 1, main and auxiliary request 1, thus lacks novelty.

As for remittal, the emphasis on E11 and E14 is new and requires a two instance consideration.

VII. The Appellant-Proprietor argued as follows:

E1 avoids overlap of membrane and upper, so that these do not abut as understood by "directly attaching". Whereas the coarse weave sheet 43 is for supporting and handling the membrane during assembly, inner material 5 clearly serves to protect the membrane. The final step requires the sole to be a complete sole when attached, with a ground contact surface, the seal being formed between the sole as unit and the membrane. E1 shows attachment of a midsole as part of the sole, which is subsequently completed.

Citation of E11 and E14 opens a new perspective in the discussion of inventive step, which can only be properly addressed in a full two instance procedure.

Reasons for the Decision

1. Both appeals are admissible.

2. *Background of the Invention*

The invention generally concerns a method of manufacturing a breathable shoe in which a unitary upper assembly is first formed by "directly attaching" a breathable upper to waterproof, breathable membrane, the assembly further including a protective element that is "hydrolysis resistant, water-repellent, breathable or perforated". In a second step the resultant assembly is attached to a perforated elastomer sole via a perimetric seal, with the element

below the membrane and between upper and internal parts of the sole.

This assembly method is said to be "simpler" than prior art methods, see specification paragraphs [0018] and [0059].

3. *Novelty: Main, first auxiliary requests*

3.1 Claim Interpretation

3.1.1 The claim outlines the method as "consisting of the steps of forming a membrane-including unitary upper assembly ..., a first step ..., and a second step". This formulation appears awkward in its own right, as it seemingly lists three steps, though (through the use of "consisting of") it is stated to be confined to only two. Moreover, the description makes no explicit mention of a two step idea but rather lists various further steps, e.g. lasting (specification paragraph [0026]), insertion of an insole (paragraph [0039]) or pre-forming of the sole (paragraph [0031]).

3.1.2 The two step formulation however falls into place when manufacture is considered from the point of view of the central feature of the membrane and its element, see e.g. paragraph [0040]. This passage sums up the two steps that are necessary to accommodate the membrane and its protective element within the shoe, namely first forming the upper unitary assembly with membrane and element, and then joining it with the sole. This simple scheme does not in fact exclude that either step involves further sub-steps, such as pre-assembly of the upper part with insole, or, pre-forming of the

perforated single block sole as in the examples; any such sub-steps are implicit in the required provision of these components.

3.1.3 Nonetheless, the wording of claim 1 does require that the attaching step must complete the manufacture of the shoe. This follows from the use of "consisting of" - meaning that second step is also the last step - but equally from the use of the term "sole".

3.1.4 This term "sole" is variously defined as "the bottom part of the shoe which touches the ground (usually not including the heel)"(Cambridge Dictionary) or "the part of an item of footwear on which the sole rests and upon which the wearer treads" (Merriam Webster's Online Dictionary). Together with the term "upper" it allows a shoe to be roughly divided into its two main constituent parts, and it is indeed consistently so used in the shoe making trade, as a quick survey of the cited literature confirms, see E4 (abstract) or E7 (column 2, lines 36 to 37) as well as G07, entry 166. Where necessary other terms allow parts of the shoe to be identified with greater precision: "insole", "outer sole" (also "treadsole", "tread" or "outsole"), "midsole", see G07 for definitions (entries 92, 106 and 115); E7 (column 2, lines 46 to 56), E8 (paragraph [0030]), E9 (pages 8,9) illustrate their consistent use in this manner, in particular also by the Appellant-Opponent. There is no evidence of these specific parts being referred to as a "sole", a term which thus in the trade remains reserved for broader use referring to the bottom part of the shoe in general.

The present specification uses the terms no differently: paragraphs [0027] and [0039] use "insole" and "inner sole" for parts 13 and 14, respectively, located in upper assembly, see figure 1, while "sole", see paragraphs [0031], [0032], [0040] and figure 1, denotes the whole bottom part 16 of the shoe, in all embodiments formed of a single block.

3.1.5 In the light of the above the Board concludes that the person skilled in the field of shoe manufacture and familiar with the terminology used in that field, when reading claim 1 against the backdrop of the description and figures, will read its final feature as referring to attachment of the *whole* of what is to be the shoe's bottom part to the upper. In particular this reading includes the single block soles as detailed in the description, but can in principle also extend to composite soles (made of constituent individual parts).

3.1.6 As set out above, he moreover reads the attaching of sole and upper assembly as completing the shoe manufacturing process - as again borne out by the examples in the description. Where he might read the claim as pertaining also to the attaching of composite soles, only the sole as a whole can be meant, which in turn implies that the composite be pre-assembled. In summary, in the understanding of the skilled person, the final feature of claim 1 (both requests) can embrace only single block or pre-assembled composite soles.

3.2 Turning now to E1, paragraphs [0019] to [0020] of the English translation of the description detail how the shoe is completed. According to paragraph [0019] "a

metal foot mold used in the vulcanized construction process or injection molding method is inserted into the upper 7 and the above mold is used to form the midsole 3". During molding the "material of the forming the midsole enters the rough weave of the rough weave sheet 43 and directly bonds with the water-impermeable moisture-permeable sheet 41". It does so in the area of the flange part 3b, shown in figure 1 at the perimeter of both midsole 3 and the sheet 41. Sheet 41 has previously been fastened to the insole 2 (paragraph [0018]) which is lasted to an upper 7 (paragraph [0017]) to effectively form a unitary upper assembly.

In the following paragraph [0020] "inner material 5a is inserted into the hollow part 3a [of] the midsole and the outer sole 6 is attached".

3.3 As follows from the above the completed sole of E1 is a composite sole, but it is assembled in steps following attachment of the midsole to the upper, rather than being joined to the latter as a pre-assembled unit. Such a post-assembly does not correspond to a final attachment of the whole sole which completes the shoe as required by claim 1 of both requests. Leaving aside questions as to whether or not the rough weave sheet 43 of E1 represents a protective element in the sense of claim 1, what that element's properties are required to be, and whether or not sheet 41 is "directly attached" in the sense of the patent, this difference - joining of the sole as a whole vis-à-vis post-assembly of the sole after joining as in E1 - is sufficient to establish novelty of the claimed method. The Board concludes that the method of claim 1 of both the main request and first auxiliary request is novel over E1.

4. *Remittal*

4.1 Both parties have requested a remittal for a first instance consideration of inventive step, should the Board find the method of claim 1 of the main request to be novel. These requests were made in particular in view of the Board's stated intention to discuss inventive step within a new framework of (previously cited) documents.

4.2 The power to remit is a discretionary power afforded the Board under Article 111(1) EPC and jurisprudence has developed various criteria in the exercise of this discretion. Boards will, for example, often remit if the legal and factual framework changes significantly compared to that in which the decision under appeal was taken, but they may be inclined to decide a case themselves if there is an urgent need for legal certainty, see for example the Case Law of the Boards of Appeal, 5th edition, 2006, VI.F.7 and VII.D.9.

4.3 In the present case, the decision under appeal considered inventive step only in relation to auxiliary requests and it did so in the light of different ones of the documents cited than those suggested by the Board; the framework for considering the main (and further) requests proposed by the Board thus differs from that of the decision under appeal. Also there is less urgency to decide the case as previously ongoing national (UK) proceedings have now concluded. More importantly though, the Board is confronted with identical requests for remittal from the parties. In such a case, the Board is of the opinion that the

principle of party disposition, which entitles the parties to direct the course of proceedings through their requests, should weigh heavily. It therefore decides to remit the case to the department of first instance, in particular to consider inventive step of the main and further requests.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.

2. The case is remitted to the department of first instance for further prosecution.

The Registrar The Chairman

G. Magouliotis M. Ceyte