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**Datasheet for the decision  
of 18 January 2017**

**Case Number:** T 1994/13 - 3.2.03

**Application Number:** 08425472.1

**Publication Number:** 2145554

**IPC:** A43B17/02, A43B17/14, A43D8/36

**Language of the proceedings:** EN

**Title of invention:**  
Insole for shoe

**Patent Proprietor:**  
Valfussbett S.r.l.

**Opponents:**  
Fratelli Pellegrino Suoletificio S.R.L.  
Insole S.r.l.

**Headword:**  
Admissibility of Intervention (yes), Remittal to the first  
instance (yes)

**Relevant legal provisions:**  
EPC Art. 105  
EPC R. 89

**Keyword:**

**Decisions cited:**

G 0001/94

**Catchword:**



**Beschwerdekammern**  
**Boards of Appeal**  
**Chambres de recours**

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Case Number: T 1994/13 - 3.2.03

**D E C I S I O N**  
**of Technical Board of Appeal 3.2.03**  
**of 18 January 2017**

**Appellant:** Fratelli Pellegrino Suolettificio S.R.L.  
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**Party as of right:** Insole S.r.l.  
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**Decision under appeal:** **Decision of the Opposition Division of the European Patent Office posted on 15 July 2013 rejecting the opposition filed against European patent No. 2145554 pursuant to Article 101(2) EPC.**

**Composition of the Board:**

**Chairman**            G. Ashley  
**Members:**            C. Donnelly  
                          M.-B. Tardo-Dino

## **Summary of Facts and Submissions**

- I. The appeal lies from the decision of the opposition division dated 15 July 2013 rejecting the opposition against the European Patent no. 2 145 554.
  
- II. The grounds of opposition under Article 100(a) EPC regarding lack of novelty and inventive step were the only ones raised by the opponent. In its decision the opposition division held that the subject-matter of claim 1 of the patent was novel and also involved an inventive step with respect to US 5 632 103 (E1), Community design 00320213-0001 (E2), Italian dictionary of 1971, definition of an insole (E3), "use of insoles by Azienda Zacchini s.r.l." (enclosure 2) (E4) since none of the cited documents discloses or suggests side projections on the perimeter of the insole.
  
- III. The opponent (hereinafter: "the appellant") lodged an appeal against this decision in due form and time on 18 September 2013. The patentee (hereinafter: "the respondent") replied to the appeal by letter of 2 April 2014.
  
- IV. The intervener filed a notice of intervention on 20 April 2015 and paid the required opposition fee. The first act of the legal proceedings for alleged infringement of European Patent no. 2145554 occurred on 20 January 2015 with the official notification of the summons writ to the intervener (see Annex A0 in the file).

In its notice of intervention the intervener raised objections under Articles 100(a), (b) and (c). In support of its allegations of lack of novelty and

inventive step under Article 100(a) it referred to the following documents:

D1: US2004/0250450;

D2: WO 2004/012548;

D3: US 5 632 103 (same as E1);

D4: US 5 722 186;

D5: AU 6 5235/80;

D6: JP 2002-142806;

D7: CN 2599959Y;

D8: extract from the magazine "Tecnica Calzaturiera", published in November 2000,

D9: Application form and figure 7 to 9 of Italian design application V120000000039 filed on 4 May 2000 and granted on 20 November 2003 with no. 82471

D10: extract from the magazine "Tecnica Calzaturiera", published in January 2000.

V. In a communication dated 18 October 2016 the board invited the parties to comment on the question of remittal to the first instance in view of decision G1/94.

VI. By letter of 2 December 2016 the intervener stated that it had no objections to the case being remitted to the opposition division for further prosecution. Neither the appellant nor the patentee-respondent replied within the given time limit of two months.

## **Reasons for the Decision**

### *1. Admissibility of the intervention*

The requirements of Article 105 and Rule 89 EPC are met since the intervention was filed in a written reasoned statement and the opposition fee paid within three months of the date on which proceedings referred to in Article 105 EPC were instituted.

### *2. Remittal to the first instance, G1/94*

2.1 In its notice of intervention of 20 April 2015, the intervener raised fresh grounds of opposition under Articles 100(b) and 100(c) EPC, as well as contesting the novelty and inventive step of the subject-matter of the patent under Article 100(a) EPC using additional documents to those dealt with in the contested decision. According to the decision of the Enlarged Board G0001/94, point 13 of the reasons, an intervention under Article 105 EPC in pending appeal proceedings may be based on any ground for opposition under Article 100 EPC. However, in application of the principles set out in G 10/91 for the exceptional situation of the introduction of new grounds in ordinary appeal proceedings, if a fresh ground is raised by the intervener, the case should be remitted to the first instance for further prosecution, unless special reasons present themselves for doing otherwise, for example when the patentee himself does not wish the case to be remitted.

2.2 The board can see no special reasons which would prevent the case from being remitted to the first instance for further prosecution, in particular the

patentee has not expressed any objection to this course of action.

## Order

### For these reasons it is decided that:

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

The Registrar:

The Chairman:



C. Spira

G. Ashley

Decision electronically authenticated