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**Datasheet for the decision
of 9 May 2019**

Case Number: T 0977/15 - 3.2.06

Application Number: 08755445.7

Publication Number: 2150143

IPC: A41D13/00

Language of the proceedings: EN

Title of invention:

ARTICLES OF APPAREL PROVIDING ENHANCED BODY POSITION FEEDBACK

Patent Proprietor:

Nike International Ltd.

Opponent:

ADIDAS AG

Headword:

Relevant legal provisions:

EPC Art. 108, 84, 123(2), 56, 111(1)

EPC R. 99(2)

RPBA Art. 12(4)

Keyword:

Admissibility of appeal - appeal sufficiently substantiated
(yes)

Claims - clarity - auxiliary requests 1, 3 (no)

Amendments - added subject-matter - auxiliary request 3 (yes)

Late-filed document - justification for late filing (yes)

Remittal to the department of first instance - (yes)

Decisions cited:

T 0101/87, T 0951/91, T 1581/08, T 0145/88

Catchword:



Beschwerdekammern
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Case Number: T 0977/15 - 3.2.06

D E C I S I O N
of Technical Board of Appeal 3.2.06
of 9 May 2019

Appellant: Nike International Ltd.
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Decision under appeal: **Interlocutory decision of the Opposition
Division of the European Patent Office posted on
3 March 2015 concerning maintenance of the
European Patent No. 2150143 in amended form.**

Composition of the Board:

Chairman M. Harrison
Members: M. Hannam
C. Brandt

Summary of Facts and Submissions

I. An appeal was filed by each of the appellant/opponent and the appellant/patent proprietor against the interlocutory decision of the opposition division in which it found that European patent No. 2 150 143 in an amended form met the requirements of the EPC.

II. The appellant/opponent (hereafter simply 'opponent') requested that the decision be set aside and the patent be revoked in its entirety.

The appellant/patent proprietor (hereafter simply 'proprietor') requested that the decision be set aside and the patent be maintained according to a main request or in the alternative according to one of auxiliary requests 1 to 4 filed with its grounds of appeal, auxiliary request 4 effectively being dismissal of the opponent's appeal.

III. In its grounds of appeal, the opponent submitted new documents A9 to A16. In addition to A2 already considered before the opposition division, solely A9 is relevant to the present decision:

A2 EP-A-1 563 748

A9 JP-A-2004 263362, and its English translation A9b

IV. With letter of 2 December 2015 the proprietor filed auxiliary requests 5 and 6 and, with letter of 19 February 2019, further auxiliary requests 7 to 15. It further requested that documents A9 to A16 not be admitted and, if admitted, the case be remitted back to the opposition division for further prosecution with related costs being borne by the opponent.

- V. With letter of 2 December 2015 the opponent requested that the proprietor's appeal be found inadmissible.
- VI. The Board issued a summons to oral proceedings and a subsequent communication containing its provisional opinion, in which it indicated *inter alia* that the proprietor's appeal appeared to be admissible, that claim 1 of the main request appeared to lack clarity, that the subject-matter of claim 1 of auxiliary request 2 seemingly failed to meet the requirement of Article 123(2) EPC and that, at oral proceedings, the admittance of A9 could be a point of discussion.
- VII. Oral proceedings were held before the Board on 9 May 2019, during which the proprietor withdrew its request for apportionment of costs. The final requests of the parties were as follows:

The opponent requested that the appeal of the proprietor be held inadmissible and that the decision under appeal be set aside and the European patent be revoked.

The proprietor requested that the decision under appeal be set aside and the patent be maintained on the basis of the main request or, alternatively, on the basis of one of auxiliary requests 1 to 3 as filed with the statement of grounds of appeal or, that the appeal of the opponent be dismissed or, that the patent be maintained on the basis of auxiliary requests 5 or 6 filed with letter dated 2 December 2015 or on the basis of any of auxiliary requests 7, 10, 11, 14 or 15 filed with letter dated 19 February 2019.

It also requested that the Board exercise its discretion not to admit documents A9 to A16 into the proceedings, otherwise that the case be remitted to the

opposition division.

VIII. Claim 1 of the main request reads as follows:

"An article of apparel, comprising:
a garment structure (200) for covering at least a lower back portion of a human torso, wherein the garment structure includes one or more fabric elements (220), and wherein the garment structure is structured and arranged so as to provide a close fit to at least the lower back portion;
and characterised by
a lower back position feedback system (202) engaged with the garment structure at the lower back portion, wherein the lower back position feedback system includes at least a first region (208) in the lower back portion having a higher compressive force application capability than a compressive force application capability of the fabric element making up a largest proportion of the garment structure, and wherein the lower back position feedback system does not substantially impede, alter or affect desired movement."

Claim 1 of auxiliary request 1 reads as claim 1 of the main request except for the wording

"and wherein the lower back position feedback system does not substantially impede, alter or affect desired movement"

being deleted and replaced with

"wherein the lower back position feedback system does not form a movement inhibiting brace structure".

Claim 1 of auxiliary request 2 reads:

"An article of apparel, comprising:
a garment structure (200) having a front and a back for

covering at least a lower back portion of a human torso, wherein the garment structure includes one or more fabric elements (220), and wherein the garment structure is structured and arranged so as to provide a close fit to at least the lower back portion; and characterised by a lower back position feedback system (202) engaged with the garment structure at the lower back portion, wherein the lower back position feedback system includes at least a first region (208) in the lower back portion having a higher compressive force application capability than a compressive force application capability of the fabric element making up a largest proportion of the garment structure, and wherein the lower back position feedback system is only present on the back of the garment structure."

Claim 1 of auxiliary request 3 reads as claim 1 of auxiliary request 2 with the following feature appended:

"and does not form a movement inhibiting brace structure".

Claim 1 of auxiliary request 4 reads as follows:

"An article of apparel, comprising:
a garment structure (200) for covering at least a lower back portion of a human torso, wherein the garment structure includes one or more fabric elements (220), and wherein the garment structure is a shirt structured and arranged so as to provide a close fit to at least the lower back portion;
and characterised by
a lower back position feedback system (202) engaged with the garment structure at the lower back portion, wherein the lower back position feedback system includes at least a first region (208) in the lower

back portion having a higher compressive force application capability than a compressive force application capability of the fabric element making up a largest proportion of the garment structure."

IX. The proprietor's arguments may be summarised as follows:

Admissibility of the proprietor's appeal

The appeal was admissible. The statement of grounds of appeal clearly indicated where the opposition division had erred in its finding with respect to Article 123(2) EPC in the main request.

Main request

Claim 1 was clear. A person in the field of garment design, and with a mind willing to understand, would understand what is meant by a 'desired movement', an example being the movement associated with a golf swing.

Auxiliary request 1

Claim 1 was clear. The term 'brace' was commonly understood to define a device which inherently restricted movement of the body part on which it was fitted. Claim 1 was therefore directed to a lower back position feedback system which did not restrict movement at all.

Auxiliary request 2

The subject-matter of claim 1 met the requirement of Article 123(2) EPC. In addition to Figs. 2A, 2B, 5A, 5B, 6A, 6B, 7A and 7B, para. [23] of the application as filed indicated that not only upper body garments but also leggings, shorts etc. could utilise the lower back position feedback system. Para. [55] further disclosed

that just a single region could be comprised in the body position feedback system and that this single region could extend just to cover a single vertebra.

Auxiliary request 3

Claim 1 was clear for the same reasons as applied to claim 1 of auxiliary request 1.

Auxiliary request 4

The subject-matter of claim 1 involved an inventive step. A2 concerned the storage and subsequent release of energy which was disclosed to be beneficial in areas with opposing muscle groups such as biceps/triceps and would thus find no beneficial application in the lower back region of a garment when it was a shirt.

Admittance of A9

A9 should not be admitted under Article 12(4) RPBA. It could and should have been presented before the opposition division where an auxiliary request limited to the claimed article of apparel being a shirt was on file more than a year before the scheduled oral proceedings. As regards the relevance of A9, it failed to disclose a lower back feedback system at all, let alone one 'engaged with' the garment since this expression excluded the integrally formed nature of the portions 18A and 18B in the material of the shirt in A9.

If admitted, the case should be remitted to the opposition division for further prosecution.

X. The opponent's arguments may be summarised as follows:

Admissibility of the proprietor's appeal

The proprietor's appeal was inadmissible. Its grounds of appeal failed to indicate reasons why the impugned

decision should be set aside.

Main request and auxiliary request 1

Claim 1 of each of these requests was unclear. The skilled person would not know how to interpret what a 'desired movement' was in the main request nor, in auxiliary request 1, would they understand what degree of movement the claimed brace structure was inhibiting.

Auxiliary request 2

The subject-matter of claim 1 failed to meet the requirement of Article 123(2) EPC. It was not unambiguously derivable that the feedback system was present only on the back of the garment in isolation from several further features disclosed in combination with the feedback system.

Auxiliary request 3

Claim 1 was unclear for the same reasons as claim 1 of auxiliary request 1.

Auxiliary request 4

The subject-matter of claim 1 did not involve an inventive step (Article 56 EPC). With the sole differentiating feature being that the garment was a shirt, the technical problem could be seen as being to provide an alternative garment while maintaining the lower back position feedback system. Para. [0018] directed the skilled person to incorporating the known lower back feedback system into a shirt. This was particularly self-evident as any activity involving a twisting movement would benefit from elastic members in the lower back region. Despite solely the elastic storage of energy being explicitly disclosed in A2, the system implicitly also enabled proprioception through the stretching of the elastic elements 20. Rowing

resulted in a bending motion of the back such that the skilled person would maintain the lower back feedback system even for a rowing shirt.

Admittance of A9

A9 should be admitted. The preliminary opinion of the opposition division gave no indication that something was lacking in the documents already on file. An incitement to carry out a further search for a feedback system on a shirt was therefore missing before the opposition division reached its decision.

The case should not be remitted back to the opposition division; the Board was itself competent to decide on the relevant issues.

Reasons for the Decision

1. Admissibility of proprietor's appeal

- 1.1 Rule 99(2) EPC specifies that 'in the statement of grounds of appeal the appellant shall indicate the reasons for setting aside the decision impugned ... and the facts and evidence on which the appeal is based'. In its grounds of appeal, the proprietor only made relatively brief comments addressing the opposition division's finding that the subject-matter of claim 1 of the main request (before it) failed to meet the requirement of Article 123(2) EPC. This being the sole finding of the opposition division regarding the main request, the question to be answered is whether this manner of addressing the opposition division's finding with respect to Article 123(2) EPC meets the requirements of Rule 99(2) EPC.

1.2 In the section bridging pages 2 and 3 of the proprietor's letter of grounds of appeal, the proprietor states *inter alia* the following:

'The proprietor disagrees with the opponent and the opposition division that this amendment adds subject-matter beyond the content of the application as filed. Basis for this amendment can be found in paragraphs 27 and 55 of the application as filed.'

'Firstly, the presently amended feature is mentioned in separate embodiments of the invention (in paragraphs 27 and 55) and the skilled person would therefore realise that it forms a general part of the invention. Secondly, neither paragraph 27 nor paragraph 55 discloses features which the skilled person would assume to be inextricably linked to the present amendment'.

1.3 The Board finds that the requirements to provide the 'reasons for setting aside the decision impugned' and the 'facts and evidence on which the appeal is based' are satisfied through a combination of the proprietor indicating that it disagrees with the finding of the opposition division regarding added subject-matter (see the first paragraph cited above) and by it specifically referring to paragraphs 27 and 55 of the application as filed and arguing that separate embodiments each disclose the amended feature without this being inextricably linked to further features of the embodiments (see the second paragraph above). Whilst indeed not being particularly detailed, the Board has no doubt that the proprietor has indicated where, in its view, the basis for the claimed subject-matter can be found and thus where the opposition division, in its opinion, erred. This finding contrasts with that in the

decisions T1581/08 (see Reasons 3 and 4) and T145/88 (see Reasons 2) cited by the opponent, in which the appeals were rejected as inadmissible due to it not being evident in the grounds of appeal why and on what basis the impugned decisions were regarded as incorrect. This differs to the present case, where the reasons, facts and evidence are clearly discernible.

1.4 There being no concept of partial admissibility of an appeal, the proprietor having addressed the sole ground for non-allowability of the main request before the opposition division with reasoned argument, makes the appeal as a whole admissible.

1.5 The opponent's suggestion that the proprietor's grounds of appeal failed to indicate why the impugned decision should be set aside is thus not accepted. As indicated above, not only is it evident from the proprietor's letter of grounds of appeal that the opposition division's finding with respect to the main request before it was, in its view, wrong but also reasoned argument was provided as to why this was the case.

1.6 The proprietor's appeal thus meets the requirements of Rule 99(2) EPC in conjunction with Article 108 EPC and is admissible.

2. *Main request*

2.1 *Article 84 EPC*

Claim 1 lacks clarity, contrary to the requirements of Article 84 EPC.

2.2 The feature 'and wherein the lower back position feedback system does not substantially impede, alter or

affect desired movement' added to claim 1 as granted does not meet the requirements of Article 84 EPC at least because it is unclear how the term 'desired movement' as claimed is to be understood.

- 2.3 First in this regard, as also argued by the proprietor, the claimed 'desired movement' relates to an athlete wearing the article of apparel, yet the subject-matter of the claim is not directed to the wearer at all, rather simply to the article of apparel. As such, claim 1 lacks clarity because any feature of the garment is limited by features of an unspecified wearer.
- 2.4 How the 'desired movement' of the wearer is to be understood, is also unclear. How would a skilled person know what a 'desired movement' entails? When is a movement to be classified as 'desired' and when not? For example, if some twisting motion of a wearer about the hips were considered to be the 'desired movement', what degree of twisting is then required, 20° or 5°? All of these questions leave the skilled person in a quandary as to how the claim should be understood and in particular to what extent something is desirable or not, such that it lacks clarity.
- 2.5 The proprietor's contention that a person in the field of garment design, and with a mind willing to understand, would understand what is meant by a 'desired movement' is not accepted in such generality. Whilst specific examples of a movement, such as an intended golf swing movement, might be understood as a possible example of a 'desired movement', this does not render the expression clear in its generality, as it encompasses absolutely any, undefined movement of the wearer. It is thus unclear to the skilled person what a 'desired movement' of the wearer necessarily entails or

indeed what it might exclude, let alone what it entails in the claimed article of apparel.

2.6 At least for this reason, therefore, claim 1 lacks clarity, contrary to the requirements of Article 84 EPC. The main request is thus not allowable.

3. *Auxiliary request 1*

3.1 *Article 84 EPC*

Claim 1 lacks clarity, contrary to the requirements of Article 84 EPC.

3.2 The feature 'wherein the lower back position feedback system does not form a movement inhibiting brace structure' added to claim 1 as granted does not meet the requirements of Article 84 EPC at least because the degree of movement inhibition achieved by the brace structure being disclaimed would be dependent upon the user of such a brace and would vary significantly dependent on for example age, sex, physical strength of the wearer or even the type of brace.

3.3 The proprietor's argument that the term 'brace' was commonly understood to define a device which inherently restricted movement of the body part on which it was fitted does not address the objection regarding what degree of movement inhibition was disclaimed. If, for example, an adult were provided with a brace to limit knee extension, the design of the brace may result in leg straightening being limited to say 160° rather than the usual 180°. If a child were now to be provided with the same brace, due to inherently weaker muscles in a child's leg, the maximum extension may be only 145°. In other cases, an adult may find movement inhibited but

not entirely prevented, such that an extension of 180° is possible but simply more difficult. This example illustrates how the claimed feature of not forming a movement inhibiting brace structure is unclear as it is not evident what exact movement a brace structure inhibits.

3.4 The proprietor's argument that claim 1 was clearly directed to a lower back position feedback system which did not restrict movement at all is not accepted. Claim 1 is not worded in the restrictive manner interpreted by the proprietor; rather the claim relies on reference to a brace structure and, as indicated in 3.3 above, this introduces a lack of clarity into claim 1.

3.5 At least for this reason, therefore, claim 1 lacks clarity, contrary to the requirements of Article 84 EPC. Auxiliary request 1 is thus not allowable.

4. *Auxiliary request 2*

4.1 *Article 123(2) EPC*

The subject-matter of claim 1 fails to meet the requirement of Article 123(2) EPC.

4.2 The sole basis provided in writing by the proprietor for the amendment to claim 1 that 'the lower back position feedback system is only present on the back of the garment structure' was given as the figures of the application as filed, *inter alia* in Figures 2A, 2B and 5A, 5B. Indeed, the figures are the only location from which the adopted feature could possibly be derived since this adopted wording is not explicitly to be found anywhere in the application as filed.

- 4.3 This adopted feature is however only disclosed in combination with at least further features of the specific embodiments of the figures, such as:
- a. that the article of apparel is an upper body garment;
 - b. that the lower back position feedback system comprises more than a single region; and
 - c. that at least one of the regions extends or wraps around the desired portion of the body.

4.4 As regards feature 'a' above, all of the figures referred to by the proprietor as a basis for the adopted feature in claim 1 clearly relate to an article of apparel in the form of an upper body garment (see both A and B of each of Figs. 2 and 5 to 7). The proprietor's argument at oral proceedings that para. [23] as filed indicated that not only upper body garments but also leggings, shorts etc. could utilise the invention does not persuade the Board that the specific disclosure in these figures can be generally applied to all possible embodiments. The feature adopted into claim 1, that the system is present only on the back of the garment, is only disclosed in the referenced figures and there is thus no direct and unambiguous teaching that, when embodied in for example leggings, the system would remain solely present on the back of the garment.

4.5 Regarding feature 'b', the figures referred to by the proprietor as a basis each disclose three regions 206, 208, 210 of the feedback system. The proprietor's argument at oral proceedings that the sentence in lines 3 to 5 of para. [55] unambiguously indicated that the feedback system could include just one of these regions is not accepted. The sentence immediately before the one referred to by the proprietor discloses that the

feedback system includes three regions 206, 208, 210. Even if the immediately following sentence were read to indicate that just a single region were comprised in the feedback system, this contradiction between the two sentences at least results in there being a degree of ambiguity in the 'single region' disclosure. Moreover, the sentence referred to by the proprietor is not in itself unambiguous in disclosing the feedback system possibly having just a single region; an equally valid interpretation is that just one of the multiple regions of the feedback system has a higher modulus of elasticity (than the remaining material of the garment). The Board thus finds that there is no direct and unambiguous disclosure of just a single region being comprised in the body position feedback system.

4.6 As regards feature 'c' above, para. [55] repeatedly mentions that some portions or regions of the body position feedback system 'extend or wrap around' the desired portion of the body. Not only as a consequence of how the skilled person would understand the expressions 'extend around and wrap around' but also with reference to the embodiments in the figures of the patent, the skilled person would not, contrary to the opinion presented by the proprietor at oral proceedings, consider a mere covering of a single vertebra with a small patch region of the feedback system as being a direct and unambiguously derivable interpretation of such a region extending or wrapping around a portion of the body; a mere localised covering of a vertebra simply fails to reflect an extending or wrapping around of a desired portion of the body. This feature has thus also unallowably been omitted from claim 1 when limiting the feedback system to being present only on the back of the garment.

4.7 The subject-matter of claim 1 therefore fails to meet the requirement of Article 123(2) EPC. Auxiliary request 2 is thus not allowable.

5. *Auxiliary request 3*

5.1 *Article 84 EPC*

5.2 Claim 1 of this request includes the feature 'wherein the lower back position feedback system does not form a movement inhibiting brace structure', found for auxiliary request 1 above not to meet the requirements of Article 84 EPC. The proprietor offered no additional argument in defence of this request and notably did not suggest that the clarity finding was overcome by way of the features in claim 1 of this request additional to those in claim 1 of auxiliary request 1.

5.3 Therefore, for the same reasons as those given with respect to claim 1 of auxiliary request 1, claim 1 of this request also lacks clarity, contrary to the requirements of Article 84 EPC. Auxiliary request 3 is thus not allowable.

6. *Auxiliary request 4*

6.1 *Inventive step - Article 56 EPC*

The subject-matter of claim 1 involves an inventive step when starting from A2 and combining the common general knowledge of the skilled person with this.

6.2 The Board finds, and the parties both concurred, that the subject-matter of claim 1 differs from the disclosure of A2 in that the claimed garment structure

is a shirt.

6.3 Based on this differentiating feature, the objective technical problem to be solved starting from A2 may be seen as being to provide an alternative garment to that in A2 while maintaining the performance enhancing elastic system therein.

6.3.1 The problem formulated by the opponent at oral proceedings reads similarly to this except for it being the 'lower back position feedback system' which should be maintained. In this regard it is noted however that, although the elasticity elements 20 of A2 are interpreted as anticipating the claimed lower back position feedback system of claim 1, when starting from A2 and without knowledge of the claimed invention, the elasticity elements would be understood to function only in the manner disclosed in A2, i.e. as performance enhancing elements (see A2, col. 2, line 56 to col. 3, line 3). Thus, it is the performance enhancing elastic system which the skilled person would try to maintain when starting from A2 and wishing to provide an alternative garment.

6.3.2 The problem formulated by the opponent in its statement of grounds of appeal, reading 'to provide position feedback to the lower back relative to the upper part of the body', is found not to be objective. As indicated above in point 6.3.1, when starting from A2, it would be the performance enhancing elastic system which the skilled person would try to maintain, not position feedback of which the skilled person would be unaware starting from A2 (albeit that it is necessarily present due to the performance enhancing elastic system). Also the reference to 'the upper part of the body' in the opponent's problem already presents, with respect to

available garments, an impermissibly clear hint to the claimed solution of 'the garment structure being a shirt', not least since the term 'shirt' can in almost all cases be generally ascribed to upper body garments in the technical field in question. This is consequently not seen as an objective problem.

6.3.3 The proprietor's formulated problem of 'providing an alternative arrangement of the energy release system in a garment' is also not seen as objective. This problem indicates a wish to change the known energy release system which in fact is precisely that which needs also to be found in the claimed shirt when starting from A2 in order that a feedback system is still present. It thus fails to present a problem which is indeed solved by the features of claim 1, and is thus not objective.

6.4 The Board finds that, starting from A2 and wishing to solve the objective technical problem identified in point 6.3 above, the skilled person would not reach the claimed subject-matter without exercising an inventive step. Whilst the opposition division found similarly regarding inventive step, the Board finds that its reasoning was incomplete insofar as the disclosure in A2 of rowing and throwing-sports, both of which involve upper body exertion, was not addressed. However, in this regard, even if para. [0018] of A2 were accepted as suggesting an upper body garment, the references to rowing or throwing-sports would lead the skilled person solely to providing the disclosed performance enhancing elastic system in relation to the paired muscle groups associated with the wearer's shoulders and arms. Providing this elastic system in the lower back position, as claimed, would not be seen to affect performance of rowers or throwers since the elastic energy stored in this position would be minimal due to

the very limited elongation of any elastic elements positioned in the lower back region as a result of rowing or throwing actions. Positioning the elastic elements in the lower back region of a shirt would thus not be obvious based on the disclosure of A2.

6.4.1 The opponent's contention that any activity involving a twisting movement would benefit from elastic members in the lower back region is not accepted. According to the teaching of A2, opposing muscle groups benefit from the performance enhancing elastic system disclosed therein due to a first muscle group extending the elastic members and the elastic recovery force subsequently assisting the muscle group opposed to the first in its contraction (see for example para. [0008] of A2). In the absence of the opponent identifying opposing muscle groups in the lower back working on this principle, there is no teaching in A2 how the performance enhancing system of A2 would be oriented in order to benefit a wearer undergoing a twisting movement through energy recovery from the elastic elements. It is further noted that the lower back itself, when undergoing a twisting motion, does not experience significant displacement such that an elastic element positioned in this region and extending with the displacement would not extend to such an extent that appreciable energy recovery could subsequently occur.

6.4.2 The opponent pointing out that rowing resulted in a bending motion of the back changes nothing with respect to the finding that the lower back displaces very little when twisting. A bending motion will also not result in the lower back itself extending significantly such that elastic elements located in the lower back region of a garment would not undergo significant elongation when the wearer is rowing. This contrasts

with the example in para. [0008] and the embodiment of Fig. 3 of A2 in which a runner raising his leg will extend the elastic elements 20 significantly since these extend from the lower back region to the back of the thigh. It thus follows that providing elastic elements for performance enhancement in the lower back region of an upper body garment would not be obvious to the skilled person when starting from A2 and wishing to solve the objective problem.

6.5 In summary, therefore, the subject-matter of claim 1 involves an inventive step (Article 56 EPC) when starting from A2 as the closest prior art and combining this with the common general knowledge of the skilled person in view of the problem to be solved.

7. *Admissibility of A9*

7.1 A9 was submitted for the first time with the opponent's statement of grounds of appeal with the argument that it deprived the subject-matter of claim 1, found by the opposition division to meet the requirements of the EPC, of novelty. That request corresponds to the present auxiliary request 4.

7.2 Having not been presented before the opposition division, according to Article 12(4) RPBA the Board's discretionary decision on whether A9 should be excluded as inadmissible will depend in part on whether the document could have been presented during the first-instance proceedings. If this is not found to be the case, according to established case law, the document's possible exclusion may also depend upon its *prima facie* relevance, i.e. whether it is of such relevance that it would change the outcome of the appeal.

- 7.2.1 The proprietor's reference to T951/91 in support of its argument that A9 was late filed and so should be refused without assessing its relevance is not decisive for the present case. In T951/91 the late filed evidence in question was filed 20 months after filing its statement of grounds of appeal (Reasons, point 6) whereas in the present case A9 was filed at the earliest possible opportunity on appeal i.e. with the statement of grounds of appeal.
- 7.2.2 As regards whether the document could and should have been presented before the opposition division, it is noted that the request found by the opposition division to meet the requirements of the EPC was indeed filed more than one year prior to the scheduled oral proceedings before the opposition division. However, in its preliminary opinion the opposition division gave no indication as to whether the documents already on file might or might not be prejudicial to the maintenance of the patent in this form, and the opponent based its subsequent inventive step objections on these documents already on file. There was thus, prior to the oral proceedings before the opposition division, no indication that the opponent's inventive step objection would be unsuccessful nor that a search for further relevant prior art was in any way necessary.
- 7.2.3 The proprietor's argument that an auxiliary request limited to the feedback system being located on a shirt should have motivated the opponent to carry out a further search is not accepted. The opponent was able to object to the presence of an inventive step based on documents already cited in the proceedings. It also evidently regarded its objections as persuasive and the opposition division's preliminary opinion on the matter was completely open such that there was nothing which

would have reasonably motivated the opponent to carry out a further search prior to the decision announced at oral proceedings. This contrasts with T101/87, referred to by the proprietor, in which the opposition was rejected by the opposition division and new documents were then filed on appeal in the hope that these alternative documents would be more successful against the patent as granted.

- 7.2.4 The Board thus finds that the circumstances of the case do not suggest that A9 could and should have been submitted before the opposition division in the particular circumstances of this case.
- 7.2.5 As regards the *prima facie* relevance of A9, Fig. 2 discloses a shirt 10 with an X-shaped region (18A, 18B) of higher contractive force on its back. At least part of the lower half of this X-shaped region (18B) is seemingly located in the lower back portion of the shirt and, with its elastic properties, will implicitly provide lower back position feedback to the wearer.
- 7.2.6 The proprietor's argument that A9 failed to disclose a lower back feedback system is not accepted. Lacking a definition of how exactly 'lower back' is to be understood, the Board sees the rear of the depicted garment in Fig. 2 as disclosing an upper back and a lower back portion, the separation of the two occurring essentially at the depicted intersection point of the arms of the cross. The region 18B of higher contractive force is thus considered *prima facie* to be positioned in the lower back region of the garment.
- 7.2.7 The proprietor's contention that A9 failed to disclose the lower back feedback system being 'engaged with' the garment is also at least *prima facie* not accepted.

Para. [0023] of the patent itself indicates that the inventive feedback systems may be 'integrated into articles of apparel' such that the claimed expression 'engaged with' can, without further qualification, seemingly include an integral incorporation of the feedback system into the garment e.g. through being woven into the structure of the garment. This also corresponds with how a natural reading of the expression 'engaged with' would be understood. At a first glance both paragraphs [0019] and [0025] of A9 disclose the integration of elastic elements to form the regions of strong contracting force into the material used for the garment which thus, at least *prima facie*, anticipates the claimed feedback system being 'engaged with' the garment. Although the proprietor argued that its own patent had been divided up in the description to describe arrangements which were either described as 'engaged with' or 'integrally formed', this alone cannot be seen as providing an overriding definition that elements integrally formed with the remainder of a garment would exclude elements differently engaged with the remainder of the garment.

7.2.8 It thus follows that A9 is *prima facie* highly relevant. The Board thus did not exercise its discretion under Article 12(4) RPBA to hold A9 inadmissible.

8. *Remittal according to Article 111(1) EPC*

8.1 According to Article 111(1) EPC, when deciding on an appeal, the Board may either exercise any power within the competence of the department which was responsible for the decision appealed or remit the case to that department for further prosecution.

- 8.2 In the exercise of such discretion, in the present case an important aspect is that A9 appears *prima facie* highly relevant with respect to the allowability of present auxiliary request 4 both with regard to novelty and inventive step. If the relevance were substantively confirmed, this would take away the entire basis for the opposition division's decision and require the proprietor to consider its requests in the light of A9 being in the proceedings. Remittal would allow both parties to develop their arguments with respect to the changed factual situation and further provide the parties the opportunity of having an examination of any new requests before two instances.
- 8.3 Regarding the opponent's argument that the Board was competent to substantively decide the relevance of A9 with respect to the requests presently on file, this is not denied. The Board however holds that this consideration is outweighed by the proprietor being given adequate opportunity to consider its requests and both parties having the chance to develop their arguments in view of the changed case relative to that decided upon by the opposition division.
- 8.4 The Board thus avails itself of its power under Article 111(1) EPC to remit the case back to the opposition division for further prosecution.
- 8.5 For the avoidance of doubt, the Board has not decided on the allowability of claim 1 of auxiliary request 4, but merely that A9 appears to be *prima facie* highly relevant in this regard.

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 for further prosecution.

The Registrar:

The Chairman:



A. Pinna

M. Harrison

Decision electronically authenticated