

**Internal distribution code:**

- (A) [ - ] Publication in OJ
- (B) [ - ] To Chairmen and Members
- (C) [ - ] To Chairmen
- (D) [ X ] No distribution

**Datasheet for the decision  
of 31 January 2023**

**Case Number:** T 1984/19 - 3.2.06

**Application Number:** 15001925.5

**Publication Number:** 2952346

**IPC:** B41F15/18, A41D31/00,  
B41F16/02, B41F17/00,  
B41J3/407, D06P5/00

**Language of the proceedings:** EN

**Title of invention:**

KNIT ARTICLE OF APPAREL

**Patent Proprietor:**

NIKE Innovate C.V.

**Opponent:**

ADIDAS AG

**Headword:**

**Relevant legal provisions:**

EPC Art. 111(1), 114(2)

EPC R. 111(2)

RPBA Art. 12(4)

RPBA 2020 Art. 11

**Keyword:**

Late submitted material - correct exercise of discretion (no)  
- document admitted (yes)  
Remittal to the department of first instance - (yes)

**Decisions cited:**

G 0007/93, T 1557/05, T 1883/12

**Catchword:**



**Beschwerdekammern**

**Boards of Appeal**

**Chambres de recours**

Boards of Appeal of the  
European Patent Office  
Richard-Reitzner-Allee 8  
85540 Haar  
GERMANY  
Tel. +49 (0)89 2399-0  
Fax +49 (0)89 2399-4465

Case Number: T 1984/19 - 3.2.06

**D E C I S I O N**  
**of Technical Board of Appeal 3.2.06**  
**of 31 January 2023**

**Appellant:** ADIDAS AG  
(Opponent) Adi-Dassler-Strasse 1-2  
91074 Herzogenaurach (DE)

**Representative:** Haupt, Christian  
Bardehle Pagenberg Partnerschaft mbB  
Patentanwälte, Rechtsanwälte  
Prinzregentenplatz 7  
81675 München (DE)

**Respondent:** NIKE Innovate C.V.  
(Patent Proprietor) One Bowerman Drive  
Beaverton, OR 97005 (US)

**Representative:** Müller-Boré & Partner  
Patentanwälte PartG mbB  
Friedenheimer Brücke 21  
80639 München (DE)

**Decision under appeal:** **Decision of the Opposition Division of the  
European Patent Office posted on 26 April 2019  
rejecting the opposition filed against European  
patent No. 2952346 pursuant to Article 101(2)  
EPC.**

**Composition of the Board:**

**Chairman** M. Harrison  
**Members:** M. Dorfstätter  
W. Sekretaruk

## Summary of Facts and Submissions

- I. An appeal was filed by the appellant (opponent) against the decision of the opposition division rejecting the opposition against European patent No. 2 952 346.
- II. The following documents are relevant for the present decision:  
  
D16           JP H10 212644  
D16a          translation of D16 into English
- III. The appellant requested that the decision under appeal be set aside and the European patent be revoked.
- IV. The respondent (patent proprietor) requested that the appeal be dismissed (main request) or, in the alternative, that the European patent be maintained based on the auxiliary request filed on 7 January 2020.
- V. The Board issued a summons to oral proceedings and a subsequent communication, in which it indicated *inter alia* that it was minded not to exclude D16 from the appeal proceedings.
- VI. Oral proceedings were held before the Board during which the respondent further requested that the case be remitted to the opposition division for further prosecution if D16 were to be admitted into the appeal proceedings.
- VII. Claim 1 of the main request reads as follows (with numbering according to the feature-by-feature analysis

as put forward by the appellant in its statement of grounds of appeal):

- 1 "An article of apparel (110; 210; 1210) having
- 2 a tubular knit textile region (112; 312; 1212),
- the tubular knit textile region having an internal side and an opposite external side configured to be exposed during use, characterized in that the tubular knit textile region (112; 312; 1212) comprises:
  - 2.1 a plurality of yarns in an arrangement of interlocked loops;
  - 2.2 a series of parallel rows (990) of loops on the external side formed from the arrangement of interlocked loops,
    - 2.2.1 the rows (990) of loops each having a pair of opposite side portions and a top portion therebetween facing outward from the tubular region (112; 312; 1212) and;
  - 2.3 a plurality of channels (992) on the external side formed between adjacent ones of the parallel rows (990) of loops,
    - 2.3.1 each of the plurality of channels (992) including a base channel portion (994) facing outward from the tubular region (112; 312; 1212) and opposing side portions (996, 998) of the adjacent rows of the loops that form the channel (992); and
  - 2.4 a printed ink design on the external side of the tubular knit textile region (112; 312; 1212) formed from ink (997) applied to the parallel rows (990) of loops and to the channels (992),
  - 2.5 wherein the tubular knit textile region (112; 312; 1212) is expandable in a lateral direction

generally transverse to the plurality of rows (990) and channels (992), and a width of the rows (990) increases as the tubular knit textile region (112; 312; 1212) is expanded in the lateral direction."

VIII. The appellant's arguments relevant to the decision may be summarised as follows:

The opposition division exceeded the proper limits of its discretion when not admitting D16 into the proceedings. Furthermore, the discretionary decision was not reasoned. It was thus necessary for the Board to reassess the matter on the merits.

D16 was *prima facie* highly relevant for the outcome of the present case. It should thus not be excluded from the appeal proceedings.

The case should not be remitted to the opposition division for further prosecution as this would be detrimental to procedural economy.

IX. The respondent's arguments relevant to the decision may be summarised as follows:

The discretionary decision of the opposition division not to admit D16 into the proceedings should not be set aside. The opposition division applied the right criteria when exercising its discretion and also gave a reasoning in its decision.

D16 was not *prima facie* highly relevant as it did not show the knitting structure. Nor did it show channels, and even less so channels to which ink was applied. The

Board should thus exclude D16 from the appeal proceedings.

In case the Board admitted D16 into the appeal proceedings, the case should be remitted to the opposition division for further prosecution. Given the fact that D16 was not considered at all substantively, the parties should have the possibility to have the questions arising in view of D16 examined by the opposition division to allow the Board to then review the case in a judicial manner.

### **Reasons for the Decision**

1. The reasoning the opposition division gave for its discretionary decision not to admit D16/D16a into the opposition proceedings does not fulfil Rule 111(2) EPC. From the decision and the minutes, the Board is unable to comprehend which considerations led the opposition division to the conclusion that the content of D16 did not go beyond the content of the documents on file and why D16 was considered not relevant for the outcome of the case, be it in view of novelty or of inventive step.
- 1.1 As also argued by the respondent, a Board of Appeal should only overrule the way in which a first instance department has exercised its discretion if it comes to the conclusion that it has done so according to the wrong principles, or without taking into account the right principles, or in an unreasonable way, and has thus exceeded the proper limits of its discretion (see also G7/93, Reasons 2.6). In order to ascertain whether the opposition division has exercised its discretion properly in the present case, it is thus essential for

the Board to know which principles the opposition division took into account and which interests it balanced. The Board cannot however ascertain from the decision why the opposition division found that D16 was not sufficiently relevant to outweigh any other considerations speaking against its admittance, if it had indeed made such considerations at all.

The sparse indication as to why D16 was disregarded, given in the contested decision under Reasons 2.3, can be summarised as follows:

- D16 was filed after expiry of the period for filing an opposition according to Article 99(1) EPC,
- D16 was cited as one of several closest prior art documents,
- in the letter of 1 February 2019 the opponent (now appellant) alleged that D16 did not contain any details with respect to the knitting structure, and
- "during the oral proceedings, (*the opponent*) could not indicate, that D16 discloses more features than D1 or D2" (it being noted here that D1 and D2 are the other documents used as the closest prior art in respective inventive step attacks by the opponent).

1.1.1 That D16 was filed after the expiry of the period for filing an opposition constitutes the basis for considering D16 late-filed, which is a requirement for any discretion under Article 114(2) EPC to disregard evidence provided by an opponent. This statement is thus not part of the reasons for the discretionary decision, but a precondition for the exercise of any discretion.

1.1.2 That D16 was not the only starting point used in one of several inventive step attacks is not considered as



constituting reasoning either. It remains unclear what this statement is supposed to imply in view of how the opposition division has exercised its discretion. If this statement was intended to relate to the relevance of D16, the Board fails to see any connection between the relevance of a particular document and the number of other documents cited.

- 1.1.3 As regards the opponent's statement in its letter of 1 February 2019 that D16 did not contain any details with respect to the knitting structure, this is in line with the inventive step attack presented in that submission under item "g.". The knitting structure was presented as constituting the distinguishing features (see sub-heading "v.) *Inventive step*") over D16. That the closest prior art does not contain details with respect to the distinguishing feature is normally inherent to an inventive step attack and cannot therefore have an impact on its relevance.
- 1.1.4 Finally, as to the opposition division's statement that D16 did not disclose more features than D1 or D2, this might be understood to be referring to the considerations such as those underlying T1557/05 (Reasons 2.4) and T1883/12 (Reasons 3.1.3), both of which were cited by the respondent during the oral proceedings before the Board. Of course, determining whether late-filed documents are *prima facie* more relevant than those already on file is indeed an accepted criterion for assessing procedural expediency. Nevertheless, even if the opposition division had possibly had this in mind, this is only one of several aspects that need to be balanced when taking the discretionary decision to admit or not admit late-filed evidence into the proceedings. Other aspects are, for example, the point in time at which the evidence was

first presented and the amount of time available for the other party to deal with it and prepare a meaningful reply, or the complexity of the new submission and the expected lengthening of the proceedings that its admittance would cause. It is not apparent from the contested decision (nor the minutes of the oral proceedings) whether the opposition division had considered any of these aspects. But even if it did so, neither the parties nor the Board could learn from the reasoning why it found that the aspects against admittance outweighed those in favour.

1.1.5 Although the Board acknowledges that an opposition division must have a certain freedom in admitting or disregarding late-filed evidence, the Board concludes that the reasoning given under item 2.3 in the contested decision is insufficient in view of the requirement that decisions of the European Patent Office which are open to appeal shall be reasoned (Rule 111(2) EPC), here the decision being the discretionary decision taken by the opposition division.

1.2 In this context, the Board further notes that it is not even clear in which sense the opposition division considered D16 as being less relevant than the documents already on file. From the general structure of the minutes and the decision, it appears that admittance of D16 was discussed after the issue of novelty had already been decided, but before a discussion of inventive step has taken place.

The respondent argued that in the proceedings before the opposition division D16 was not used by the opponent to argue lack of novelty, but only inventive step. There were other novelty attacks on file, based on D1 and D2, and a clear inventive step attack based

on D16. As also pointed out in the Board's communication (see item 2), the opponent, having first stated which features were disclosed, had then argued (see submission of 1 February 2019, page 45, first paragraph) that the skilled person would deduce the knitting structure from the loop model taught by D16 without exercise of inventive skill. Still further, on page 47 of the same submission (see last paragraph), the following statement was made:

*"Even if the opposition division were to come to the conclusion that document D16 does not disclose the details of the knitting structure,..."*

Thus, despite the argument appearing under the heading of inventive step, this statement in fact shows that the opponent considered D16 as disclosing all the features of claim 1, thus depriving the subject-matter of claim 1 of novelty, noting that it had also stated from where all the features of claim 1 were derivable by a skilled person.

It can be appreciated that the opponent's submission could have been drafted in a way that would have avoided this initial confusion. Nevertheless, given the relatively short written submissions stating where each feature of claim 1 was to be found or was derivable, these passages should have been considered by the opposition division when examining the relevance of D16. Reasoning in the decision is, however, simply absent as to why those written submissions (i.e. those on pages 45 to 47 of the submission of 1 February 2019) were not found relevant at least on a *prima facie* basis.

- 1.3 It should also be understood that the relevance of a prior art document might be different, depending on whether it is used as evidence for lack of novelty or

for lack of inventive step. Whilst it might be *prima facie* clear that a document is not relevant at all for the question of novelty because at first sight a feature is lacking, the same cannot be concluded for the question of whether an inventive step is involved. Furthermore, even if a document shows the same features as another document, and also lacks the same feature or features, it might still serve as a better springboard for arriving at the claimed invention depending on its whole context.

In a case such as this, a general statement that a document is *prima facie* not found to be relevant is therefore incomplete reasoning. Not only should the reasons as to why it was found irrelevant be given in the decision, but also the issue to which it is found to lack relevance should be stated. In the present case, the decision lacks a statement as to whether D16 was found not relevant for the question of novelty or for inventive step, or for both.

- 1.4 The opposition division's discretionary decision not to admit D16 into the proceedings is thus insufficiently reasoned on several levels. The contested decision is therefore to be set aside.
  
2. The Board has also considered whether D16 should indeed be considered *prima facie* relevant for assessing whether the subject-matter of claim 1 of the main request is novel and/or for assessing whether it involves an inventive step. Both in the submission of 1 February 2019 before the opposition division and in its statement of grounds of appeal, the appellant has argued where in D16 the features of claim 1 are to be derived (some explicitly, some by a skilled person based on implication). In the Board's view these

submissions give rise *prima facie* at least to serious doubts that the subject-matter of claim 1 is novel over D16.

- 2.1 The respondent disputed the *prima facie* relevance of D16, arguing that it was unknown whether there were any channels in D16 at all since nothing was shown or stated about a material connection between the two vertical rows (i.e. the wales) in Figure 2 lower picture. The Board, however, finds that this argument does not detract from the *prima facie* relevance of D16. It may be necessary to interpret the term "channel" in the sense of claim 1 first to conclude whether D16 discloses any structure necessarily fulfilling the definition of a channel, noting that the structure between the wales is not as such depicted in D16. It seems however *prima facie* that any knitted structure will inevitably include some sort of channels, at least between its wales.

The respondent disputed that D16 necessarily had bases to the channels, if any channels were indeed present. In particular, it argued that in Figure 2 (lower picture) nothing could be seen between the actual stitch shapes such that the "base channel portions" (as in feature 2.3.1) were lacking in D16. The Board however considers that *prima facie* loops connecting the stitches of the wales must be present basically at the back of the knitted structure. Otherwise, the wales shown in Figure 2 of D16 would seemingly fall apart. Whether ink is applied to any such connecting loops in a stretched configuration and to what extent such printing is required in the channels by feature 2.4 of claim 1, are issues to be decided during an examination on the merits. For a *prima facie* assessment of relevance for an alleged lack of novelty it is

sufficient that there is a high level of probability that the structure of D16 might indeed fulfil the wording of claim 1, which the Board considers to be the case.

The Board thus concludes that D16 is *prima facie* relevant to the issue of novelty of the subject-matter of claim 1.

2.2 Should the opposition division conclude that one or more of the features relating to the knitting structure, the channels, their base portions and/or ink applied to the loops and to the channels, is/are not disclosed explicitly or implicitly in D16, D16 would still be *prima facie* highly relevant for the question of inventive step, as it appears indeed to address the same problem of improving the appearance of a printed ink design on a knitted article due to non-dyed vertical strips when it is stretched (see e.g. paragraphs [0009] and [0020]), and appears to solve it by the same means, i.e. by stretching the article while being printed. Whether the use of the loop models in D16 means that ink will necessarily result in an article having ink applied to "the channels" (as in feature 2.4), when considering the definition of the channels (as in feature 2.3.1) may be of importance.

2.3 For these reasons, the Board does not exercise its discretion under Article 12(4) RPBA 2007 to disregard evidence that was not admitted in the proceedings before the opposition division.

D16 (and D16a) are thus in the proceedings (Article 12(4) in conjunction with Articles 12(1) and (2) RPBA 2007).

3. Remittal

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. In the exercise of such discretion, in the present case an important aspect is that D16/D16a is considered to be highly relevant to the questions of whether or not the subject-matter of claim 1 is novel or involves an inventive step.

The respondent argued that, in the circumstances of the present case, it should have the possibility of having its case considered by two instances and that according to Article 12(2) RPBA 2020, the primary object of appeal proceedings is the review of the appealed decision in a judicial manner and that this could only be achieved if the first instance took a decision on the matters to be dealt with in appeal. Since the opposition division has entirely disregarded D16 both for the question of novelty and for the question of inventive step, and since this is a central issue of the present case, this object could not be achieved if the Board were to deal with these questions on its own for the first time.

The appellant requested that the case not be remitted to the opposition division and argued only that doing so would be detrimental to procedural economy. This argument is, however, unconvincing. Procedural economy may always be negatively affected when remitting a case. However, it may or may not be outweighed by other interests, not least the interest of the parties to have their case heard by two instances as outlined

above, and in particular for both parties to be able to fully develop their arguments concerning this newly found prior art during the administrative proceedings before the opposition division. In the present case, the duration of the proceedings to date has also not been such as to justify the loss of a procedural instance by not remitting the case. The aspect of procedural economy therefore does not outweigh the legitimate interests of the respondent.

In light of the foregoing, which is also considered to constitute "special reasons" under Article 11 RPBA 2020, the Board avails itself of its power under Article 111(1) EPC to remit the case to the opposition division for further prosecution.



**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:



D. Grundner

M. Harrison

Decision electronically authenticated