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**D E C I S I O N**  
**of 20 May 1994**

**Case Number:** T 0372/90 - 3.2.4

**Application Number:** 83302279.1

**Publication Number:** 0122985

**IPC:** A43B 7/06

**Language of the proceedings:** EN

**Title of invention:**  
Improvements relating to footwear

**Patentee:**  
CLARKS LIMITED

**Opponent:**  
PUMA AG Rudolf Dassler Sport

**Headword:**  
-

**Relevant legal norms:**  
EPC Art. 100(c), 56

**Keyword:**  
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**Decisions cited:**  
-

**Headnote/Catchword:**



Case Number: T 0372/90 - 3.2.4

**D E C I S I O N**  
**of the Technical Board of Appeal 3.2.4**  
**of 20 May 1994**

**Appellant:** CLARKS LIMITED  
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**Representative:** Brooks-Smith, Fred  
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**Respondent:** PUMA AG Rudolf Dassler Sport  
(Opponent) Würzburger Straße 13  
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**Representative:** Hufnagel, Walter, Dipl.-Ing.  
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**Decision under appeal:** Decision of the Opposition Division of the  
European Patent Office forwarded by Post on  
7 March 1990 revoking European patent  
No. 0 122 985 pursuant to Article 102(1) EPC.

**Composition of the Board:**

**Chairman:** C. Andries  
**Members:** R. Gryc  
M. Lewenton

## Summary of Facts and Submissions

- I. The Appellant (Patent Proprietor) lodged an appeal, (received on 3 May 1990) against the Opposition Division's decision (dispatched on 7 March 1990) revoking European patent N° 0 122 985, at the same time paying the appeal fee.

The Statement of Grounds of Appeal was received on 8 July 1990.

Opposition was filed against the patent as a whole and was based on Article 100(a) and (c) EPC.

The Opposition Division held that the grounds for opposition mentioned in Article 100(a) EPC prejudiced the maintenance of the patent having regard to the following documents:

D1: US-A-4 071 963

D2: DE-B-1 211 091

- II. Independent Claims 1 and 4 as granted were worded as follows:

"1. A sole unit (13) for an article of footwear (10) which sole unit has a sole portion and a heel portion and is moulded from a resilient material, a plurality of cavities (15) formed in the upper surface of the sole portion and heel portion of the unit, a system of channels (16) formed in the upper surface of the unit, which channels inter-connect the cavities, and a bulge (17) formed on the bottom surface of the sole unit at the location of each of said cavities characterised in that the cavities (15) are formed substantially wholly in the general thickness of the sole unit."

"4. An article of footwear (10) comprising an upper (11), a sole unit (13) to which the upper is connected, and a porous insole or sock (12) overlying and bonded to the top surface of the sole unit, which sole unit has a sole portion and a heel portion and is moulded from a resilient material, a plurality of cavities (15) formed in the upper surface of the sole portion and heel portion of the unit, a system of channels (16) formed in the unit, which channels interconnect the cavities and a bulge (17) formed on the bottom surface of the sole unit at the location of each of said cavities characterised in that the cavities (15) are formed substantially wholly in the general thickness of the sole unit (13)."

III. In a communication pursuant to Article 110(2) EPC dated 22 September 1992, the Board pointed out that the Appellant was entitled to introduce the feature forming the characterising part of the claims into independent Claims 1 and 4.

In a reasoned provisional opinion the Board also took the view that when interpreted in the light of the description and drawings the subject-matter of the independent claims seemed to be new and to involve an inventive step having regard to the state of the art.

The Appellant confirmed the Board's interpretation of the subject-matter of Claims 1 and 4, whereas the respondent failed to reply to the communication or to comment on the Board's reasoned provisional opinion.

IV. During the appeal proceedings the Appellant primarily argued that the deformation of the bulges of the sole construction according to Figures 1 to 3 of D1 would

create instability for the wearer and that the sole unit according to D2 had no system of channels within the meaning of the invention.

Moreover he contended that the sole constructions disclosed in D1 and D2 respectively could not operate on the same general principle and that a combination of D1 and D2 would thus be an improper combination.

V. The Respondent (Opponent) argued in particular as follows:

- The patent specification in suit would not allow the skilled person to recognise which technical problem is to be solved by the measures described in Claim 1;
- in order to arrive to the solution described in Claims 1 and 4 the skilled person would need to take only one step, i.e. to reduce the cavities of the sole of D1 to the size of the cavities according to D2; and - D2 would teach the skilled person that it is possible to provide the sole with cavities smaller than the thickness of the sole.

VI. The Appellant requested that the decision under appeal be set aside and the opposition rejected.

The Respondent requested that the appeal be dismissed.

## Reasons for the Decision

### 1. *Admissibility*

After examination, the appeal was found to be admissible.

2. *Amendments to Claims 1 and 4 before grant  
(Article 100(c) EPC)*

2.1 During the examination proceedings and in order to distinguish the invention from the state of the art disclosed in D1, the subject-matter of Claims 1 and 4 had been characterised by the fact that the cavities were formed substantially wholly in the general thickness of the sole unit.

As the Respondent pointed out, this characteristic was to be found neither in the claims nor in the description of the application as filed and could only be derived from Figures 1 and 3 of its drawings.

2.2 However, in order to be able to judge whether the requirements of Article 123(2) EPC have been met, the content to be taken into consideration is the content of the entire application as filed and not merely the content of its description.

Since the drawings are to be regarded as an integral part of the documents disclosing the invention and must be considered as ranking equally with the description and claims (see T 169/83, OJ EPO 1985, 193, and T 308/90, Reasons point 2.2) features clearly derivable by a person skilled in the art from the drawings as regards structure and function may be used to further define the subject-matter for which protection is sought.

2.3 In the present case, the formation of the cavities substantially wholly in the general thickness of the sole unit is clearly depicted in Figures 1 and 3 of the contested patent specification, and this feature can

thus characterise the subject-matter of Claims 1 and 4 without contravening the requirements of Article 123(2) EPC.

3. *Interpretation of the independent claims*

To allow a true comparison of the subject-matter of the independent claims with the state of the art, the meaning of the following sentences must first be interpreted in the context of the patent as a whole, i.e. including the description and the drawings:

- column 2, lines 14, 15 and 37 to 39 respectively:  
"... which sole unit has a sole portion and a heel portion and is moulded from a resilient material..." means implicitly that the sole unit is formed in a single integral piece as shown in Figure 1, i.e. the sole and heel portions are formed in a single integral moulding;
- column 2, lines 19, 20 and 42 respectively:  
"... which channels interconnect the cavities..." means implicitly that each cavity is connected to at least one other cavity by a channel so that all the cavities are connected together by the channels as shown in Figure 2, and
- column 2, lines 24 and 46, 47 respectively:  
"...general thickness of the sole unit..." refers to the thickness of the flat main part of the sole, the bulges being excluded.

The accuracy of these interpretations was confirmed by the Appellant in his letter of 19 November 1992.

4. *Novelty*

Having examined all the available prior-art documents, the Board is satisfied that none of them discloses either a sole unit or an article of footwear comprising in combination all the features described respectively in Claim 1 or in Claim 4 at present on file.

Since this was never disputed during the proceedings, there is no need for further detailed substantiation of this matter.

The subject-matter as set forth in Claims 1 and 4 is thus to be considered as novel within the meaning of Article 54 EPC with respect to the prior art brought to the consideration of the Board.

5. *The closest prior art*

5.1 In agreement with the parties, the Board considers that the embodiment shown in Figures 1 to 3 of D1 appears to be the prior art closest to the subject-matter of Claims 1 and 4.

Indeed, this embodiment of D1 comprises nearly all the features present in the pre-characterising portions of Claims 1 and 4, except that bulges are not formed at the location of each of the cavities (including the cavities of the heel portion of the sole unit).

5.2 The subject-matter of the independent claims differs from this closest prior art in that a bulge is provided at the location of each of the cavities, including those of the heel portion of the sole unit, and in that the cavities are formed substantially wholly in the general thickness of the sole unit.



6. *The problem and its solution*

6.1 According to the established Boards of Appeal case law, the technical problem an invention addresses and solves should be determined in the light of the objectively ruling state of the art, in particular as revealed in the course of proceedings which may be different from the prior art of which the Applicant was aware at the time he filed the application (see decision T 24/81, OJ EPO 1983, 133).

6.2 When starting from the closest prior art known from D1, and taking into account the above-mentioned differences, the problem to be solved by the person skilled in the art could be objectively determined as being to improve the sole unit known from D1 with regard to stability, resistance to wear and absorption of the shocks of impact of the heel with the ground, and the Board is satisfied that the solution disclosed in Claims 1 and 4 solves the problem effectively.

7. *Inventive step (Article 56 EPC)*

7.1 The questions to be answered as regards the inventive step in relation to the modification of the sole unit of D1 as suggested by the Respondent are whether the state of the art seen in the light of the general common knowledge of the skilled person would provide him with enough information and hints for arriving at the invention and whether he would apply this teaching to the sole unit according to D1 considered as a starting point in expectation of the improvement he was searching for.

7.2 The main concern of D1 appears to be the problem of achieving efficient ventilation inside the footwear so that a considerable flow of air be produced whenever the

wearer's weight is applied to the shoe (see, for example, column 1, lines 5 to 13 and 33 to 39 or column 3, lines 41 to 50). The provision of additional measures to increase the resilient deformability of the projections forming the cavities in order to perform the air expulsion and intake functions with great efficiency (see column 3, lines 3 to 9) confirms this concern.

Since according to the established Boards of Appeal case law the disclosure of a document has to be considered as a whole, the skilled person cannot simply ignore the aforementioned main concern of D1. Therefore, when making attempts to improve the sole unit depicted in Figures 1 to 3 of D1 he would normally be reluctant to modify the sole unit to the detriment of its ventilation efficiency; in particular, he would not envisage measures involving a decrease in the volume of the "pumping" cavities and less deformability of the projections forming those cavities.

7.3 Unlike D1, D2 is much more concerned with the gripping capacity than with the ventilation of the shoe, and the sole embodiment depicted in Figure 2 does not comprise a system of channels interconnecting the small cavities located just above each gripping rib or stud. Moreover, in order to perform their gripping function the ribs or studs must not be too easily deformable and the "pumping capability" of the cavities known from D2 is necessarily less than the one of the embodiment according to D1.

7.4 Without a particular hint therefore a skilled person seeking to improve the sole unit according to D1 would have *a priori* no reason for consulting D2, and it is unlikely that the teachings of these two disclosures would be combined. Since moreover, according to the invention, a bulge has been provided at the location of each of the cavities (i.e. also at the heel portion of

the sole) in spite of the fact that it could be logically expected that such a modification would increase the instability of the sole, the Board considers that the modifications made to the sole unit according to D1, taken as a whole, in order to arrive at the invention are not obvious.

7.5 This view is the one taken by the Board as a provisional opinion in its communication to the parties (see III above) and the one on which respondent failed to comment. This opinion not having been rebutted, the Board sees no valid reason for altering it.

7.6 For the aforementioned reasons the Board considers that the subject-matter of Claims 1 and 4 as granted implies an inventive step within the meaning of Article 56 EPC.

8. The patent therefore can be maintained unamended.

**Order**

**For these reasons, it is decided that:**

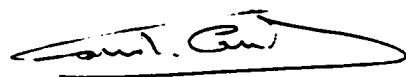
1. The decision under appeal is set aside.
2. The patent is maintained unamended.

The Registrar:



N. Maslin

The Chairman:



C. Andries