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**D E C I S I O N**  
of 12 July 1996

**Case Number:** T 0111/94 - 3.2.4

**Application Number:** 91900093.5

**Publication Number:** 0502923

**IPC:** A43B 7/14

**Language of the proceedings:** EN

**Title of invention:**  
Adjustable foot support system

**Applicant:**  
ROSEN, Henri E.

**Opponent:**  
-

**Headword:**  
-

**Relevant legal provisions:**  
EPC Art. 54, 56, 69(1), 123(2)  
EPC R. 67

**Keyword:**  
"Inventive step - yes"  
"Reimbursement of the appeal fee - no - no substantial  
procedural violation"

**Decisions cited:**  
T 0066/83, T 0098/90, T 0169/83, T 0308/90

**Catchword:**  
-



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Boards of Appeal

Chambres de recours

Case Number: T 0111/94 - 3.2.4

**D E C I S I O N**  
of the Technical Board of Appeal 3.2.4  
of 12 July 1996

**Appellant:** ROSEN, Henri E.  
229 Coolidge Avenue  
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**Representative:** Dubois-Chabert, Guy  
Société de Protection des Inventions  
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75008 Paris (FR)

**Decision under appeal:** Decision of the Examining Division of the European Patent Office posted 13 September 1993 refusing European patent application No. 91 900 093.5 pursuant to Article 97(1) EPC.

**Composition of the Board:**

**Chairman:** C. A. J. Andries  
**Members:** R. E. Gryc  
J. P. B. Seitz

### Summary of Facts and Submissions

- I. The appellant lodged an appeal on 9 November 1993 against the decision of the Examining Division, despatched on 13 September 1993, refusing the European patent application No. 91 900 093.5.

The fee for appeal was paid at the same time and the written statement setting out the grounds of appeal was received at the EPO on 19 January 1994.

- II. The Examining Division held that the application did not meet the requirements of Article 56 EPC, having regard to the embodiments disclosed in the following prior art documents:

D1: CH-A-506 261 and

D2: DE-C-612 088.

In the search report and during the examination proceedings document FR-A-2 203 264 (D3) was cited.

- III. In the statement setting out the grounds of appeal, the appellant argued in particular that the aim of the invention was to improve walking comfort in avoiding pronation for the foot whereas D1 allows more comfort when skiing by correcting the angle of the legs. The appellant denied that the foot supporting member of the shoe having a rigid sole according to D1 could be used in a conventional pliable shoe.

Moreover the appellant drew the attention of the Board to the fact that D2 teaches an adjustable means for supporting the foot at its arch portion rather than for adjusting the cant of the foot by positively inclining a

part of said adjustable means according to the invention. Subsequently he also contended that D3 does not describe how a skilled person should or even could place the adjustment device in any place other than the heel while still forming a flexible shoe and that its position in the heel portion appears to be the only location in the shoe where it can be placed in order to avoid restricting flexing of the sole.

- IV. With a letter dated 24 April 1996, sent in reply to various objections of the Board, the appellant filed a modified description (pages 1 to 3, 3a, 4 to 7 and 9 to 13), five new sets of claims corresponding to a main request (first request) and four subsidiary requests (second, third, and fourth request and an additional fourth request with alternative claims), as well as drawings sheets 1/5 to 5/5.
- V. The appellant requested that the decision under appeal be set aside and that a patent be granted on the basis of the claims of one of these five requests.

The appellant furthermore requested the reimbursement of the appeal fee.

- VI. The wording of Claim 1 of the main request (first request) reads as follows:

"Shoe having a sole which flexes at least at ball region of the shoe, comprising a foot supporting member (22, 24) having a cant and a ball portion, an arch portion, and a heel portion for supporting a foot, characterised in that it further comprises canting means (28, 30, 31) including adjustment means (31, 32) and a flexible part (30) which extends from about the heel portion to about the ball portion in a flexible part of the shoe and is connected to the foot supporting member for adjusting

the cant of at least one of the ball portion and the heel portion of the foot supporting member, thereby adjusting the cant of at least a portion of the foot supported by the foot supporting member."

## Reasons for the Decision

### 1. *Admissibility*

After examination, the appeal was found to be admissible.

### 2. *Main (first) request*

#### 2.1 Amendments (Article 123(2) EPC)

##### 2.1.1 Claim 1

In comparison with Claim 1 of the application as filed, Claim 1 at present on file is now drafted in the two part form according to Rule 29(1) EPC and the designation of the subject-matter of the invention has been changed from:

"An assembly for use in a shoe" to a "shoe" itself which embodies such an assembly. Moreover, the pre-characterising portion of Claim 1 explicitly refers to a "shoe having a sole which flexes at least at ball region of the shoe", so that the protection conferred by the claim is explicitly limited to conventional or "general footwear" in the sense of the description of the application as filed (see page 3, lines 17 and 18).

A shoe containing the canting assembly was already claimed in Claim 12 of the application as filed and, from the original description (see the application, page 3, lines 12 to 22), it is implicit that the invention concerns "general footwear which must flex at least at the ball, during the gait cycle". Furthermore, since according to page 4, lines 1 to 4 of the original description, an object of the invention is to provide means for adjusting the canting of the bottom surface of a foot relative to the walking surface, it is clear that said canting means are for use in walking shoes i.e. shoes having a flexible sole.

Claim 1 has also been amended in order to better define the "canting means" which is said to include "adjustment means and a flexible part which extends from about the heel portion to about the ball portion in a flexible art of the shoe".

The characteristic concerning the extension of the flexible part of the canting means appears clearly from the drawings which 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). As far as the flexibility of the extended part of the canting means is concerned, it makes sense that the sole of the shoe be flexible only if the extended part of the canting means is also flexible.

The above mentioned amendments clarify the subject-matter of Claim 1 without contravening Article 123(2) EPC.

### 2.1.2 Dependent claims 2 to 9

The content of Claim 2 finds a support in Figures 2 to 4a and the description of the application as filed (see page 7, lines 1 to 6).

New Claims 3 to 8 correspond respectively to Claims 2 to 5, 10 and 11 of the application as filed.

The subject-matter of Claim 9 is supported by the content of page 3, lines 36 and 37 and page 11, lines 28 to 31.

Therefore no new matter has been added.

### 2.1.3 Description and drawings

In comparison with the description and drawings of the application as filed, the new description and drawings filed with Appellant's letter of 24 April 1996 differ in that two new prior art documents (i.e. D1 and D2) have been cited according to Rule 27(1)(b) EPC and all the descriptive matter and Figures (i.e. Figures 6 to 9b) related to the second embodiment disclosed in the application as filed has been deleted.

Such amendments do not contravene Article 123(2) EPC.

## 2.2 Interpretation of Claim 1

Taking into account the description and drawings (particularly Figures 1 and 2) to interpret the claims (Article 69(1) EPC), it appears clearly that the area defined by the expression: "from about the heel portion to about the ball portion" includes the heel and the ball portions of the shoe.

### 2.3 Novelty

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

Since this has not been disputed by the first instance, there is no need for further detailed substantiation of this matter and the content of Claim 1 is thus to be considered as novel within the meaning of Article 54 EPC.

### 2.4 The closest prior art

D3 is concerned with the same general problem as that of the invention i.e. to provide orthotic canting means designed for end-user adjustment for use in conventional shoes and it relates likewise to shoes comprising a flexible sole and a foot supporting member with canting means for adjusting the cant of at least a portion of the foot supporting member.

Therefore, the Board considers that the state of the art disclosed by D3 is the closest to the invention. The shoe according to claim 1 differs mainly from this prior art in that the canting means comprises:

"a flexible part which extends from about the heel portion to about the ball portion in a flexible part of the shoe".

### 2.5 Problem and solution

When starting from said closest prior art and taking into account the above-mentioned difference, the problem to be solved by the person skilled in the art is to



provide an improved alternative device to the canting device disclosed by D3 and the Board is satisfied that the solution disclosed in Claim 1 solves the problem effectively.

2.6 Inventive step (Article 56 EPC)

2.6.1 The questions to be answered regarding inventive step in relation to the modification of the canting device of D3 as suggested in Claim 1 are whether the state of the art seen in the light of the general common knowledge of the skilled person would provide him with the information about the elements which are essential and necessary to reconstitute the invention and whether, having these means at his disposal, he would assemble them in a conventional shoe in replacement of the system according to D3 in expectation of the improvement he was searching for.

2.6.2 As already stated in section 2.4, D3 is concerned with the problem of providing shoes having a flexible sole with canting means designed for end-user adjustment.

Therefore, the skilled person who wishes to equip the conventional pliable shoes of D3 with an alternative canting means would normally not consult documents like D1 referring specifically to rigid shoes comprising a sturdy foot supporting member (see column 2, lines 26 to 28). Even if he did so, he would not be led to the invention since the canting means of D1 includes no flexible part extending from the heel to the ball portion of the shoe.

The skilled person has also no reason to consult D2 which does not disclose a shoe having a canting means but only adjustable means for supporting the arch portion of a foot. Moreover, the flexible part of the

supporting means according to D2 extends just between the heel and the ball portion of the shoe (see Figures 1, 2 and 9) and cannot be used for adjusting the cant of at least one of said portions.

- 2.6.3 Therefore, at the priority date, the state of the art as illustrated by D1 and D2 failed to provide the skilled person with the essential means of the invention i.e. canting means comprising an elongated flexible part extending in a portion of the footwear which must flex during the gait cycle.

Moreover, D1 and D2 would give him hints leading in a different direction from the solution according to the invention (for example hints to use a rigid insole or an insole limited in length to the arch portion of the shoe).

- 2.6.4 For the foregoing reasons the Board is convinced that improving the shoe known from D3 according to the teaching of Claim 1 does not follow plainly and logically from the prior art illustrated by D1 and D2 but implies an inventive step within the meaning of Article 56 EPC.

- 2.7 Therefore a patent can be granted based on the amended claims of the main (first) request.

### 3. Subsidiary requests

Since the board has acknowledged the main request as allowable, there is no need to consider the appellant's auxiliary requests.

4. *Reimbursement of the appeal fee*

According to Rule 67 EPC, the reimbursement of the appeal fee shall be ordered if, where the Board deems an appeal allowable, such reimbursement is equitable by reason of a substantial procedural violation. However, such a violation cannot be detected by the Board in the present case.

Indeed, neither a misinterpretation of prior art documents, nor an inaccurate assessment of the inventive step are held to be a substantial procedural violation in the consistent jurisprudence of the Boards of Appeal as (see T 98/90, section 8.2).

Moreover, the rejection of the application in the present case, after the first communication of the Examining Division and after the applicant, in its reply, only added reference signs to Claim 1 and divided the wording of that claim in a two-part form without however changing the claims technical content, is considered by the Board, following the decision of the Boards of Appeal in case T 66/83 (section 6), as being within the discretion of the Examining Division. According to the Board, that discretion was exercised properly, in view of the above-mentioned facts of the present case, so that the Board cannot detect a substantial procedural violation in the Examining Division's approach.

**Order**

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

1. The decision under appeal is set aside.
2. The case is remitted to the first instance with the order to grant a patent with the following claims and drawings and a description to be adapted according to Rule 27(1)(c) EPC:

**Claims:** 1 to 9 according to the first request filed with the letter dated 24 April 1996;

**Description:** pages 1 to 3, 3a, 4 to 7 and 9 to 13 filed with the letter of 24 April 1996;

**Drawings:** Sheets 1/5 to 5/5, (Figures 1 to 12) filed with letter of 24 April 1996.

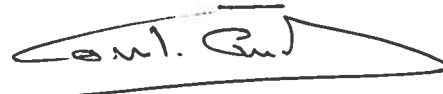
3. The request for reimbursement of the appeal fee is refused.

The Registrar:



N. Maslin

The Chairman:



C. Andries