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D E C I S I O N
of 14 October 1994

Case Number: T 0577/94 - 3.2.4

Application Number: 90907672.1

Publication Number: 0471753

IPC: A43D 1/02

Language of the proceedings: EN

Title of invention:
Shoe fitting system

Applicant:
ROSEN, Henri E.

Opponent:
-

Headword:
-

Relevant legal norms:
EPC Art. 111(1)

Keyword:
"Claim 1 allowable"
"Remittal to Examining Division to consider remainder of
application"

Decisions cited:
T 0139/87

Catchword:
-



Case Number: T 0577/94 - 3.2.4

D E C I S I O N
of the Technical Board of Appeal 3.2.4
of 14 October 1994

Appellant: ROSEN, Henri E.
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Representative: Dubois-Chabert, Guy
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Decision under appeal: Decision of the Examining Division of the European Patent Office dispatched on 17 March 1994 refusing European patent application No. 90 907 672.1 pursuant to Article 97(1) EPC.

Composition of the Board:

Chairman: C. A. J. Andries
Members: M. G. Hatherly
J. P. B. Seitz

Summary of Facts and Submissions

I. On 17 May 1994 the Appellant (Applicant) lodged an appeal against the decision of the Examining Division dispatched on 17 March 1994 to refuse European patent application No. 90 907 672.1. The appeal fee was paid on 17 May 1994 and the Statement of Grounds of Appeal received on 4 July 1994.

The Examining Division held that the application did not meet the requirements of Article 84 EPC.

II. The Appellant requests that the decision under appeal be set aside and a patent be granted on the basis of a complete new set of application documents filed on 4 July 1994 with the Statement of Grounds. This new set of application documents consists of:

- Claims 1 to 14;
- Description pages 1 to 9; and
- Drawings sheets 1/4 to 4/4 (Figures 1 to 14).

III. The wording of the present Claim 1 reads as follows:

"A shoe fitting system characterized in that it comprises a shoe containing therein means (66, 80) for generating a signal when a foot inserted in the shoe begins to outgrow the shoe."

Reasons for the Decision

1. The appeal is admissible.
2. The present independent Claim 1 is the only independent claim of the present set of claims and its subject-matter is the same as that of originally filed independent Claim 12. Thus the present Claim 1 does not contravene Article 123(2) EPC.
3. *Article 84 EPC*
 - 3.1 In the Board's view the present Claim 1 is **clear** as required by Article 84 EPC. It is directed to a shoe fitting system i.e. to a system that enables one to know if a shoe fits or not. In the prior art there are shoes and there is separate equipment (e.g. an X-ray apparatus) used to fit them. The characterising portion of the present Claim 1 specifies that the means by which one determines if the shoe fits is in fact contained in the shoe itself, and that the means is a means for generating a signal when the situation arises that a foot inserted in the shoe begins to outgrow the shoe.
 - 3.2 Claim 1 also fulfils the requirement of Article 84 EPC for **conciseness**. No superfluous or undue repetition is present in the wording.
 - 3.3 The present Figures 8, 9, 10, 13 and 14 and the corresponding parts of the description disclose embodiments satisfying the definition given by Claim 1. The remaining Figures do not show the signal generating means but it is clear from the description that these Figures are present to explain the basic construction of the shoe and optional features of the shoe without implying that protection is being sought also for shoes

without a signal generating means. Thus these other Figures and the corresponding parts of the description do not cast doubt on the scope of Claim 1.

Accordingly Claim 1 is considered to be **supported by the description** as required by Article 84 EPC.

- 3.4 Claim 1 therefore fulfils the requirements of Article 84 EPC.
4. The dependent claims are generally clear and do not cast doubt on the scope of Claim 1 (with the exception of the point made in section 7.1 below).
5. It is clear from the decision that the main reason for the refusal of the application was the objection to Claim 1 then on file (with its translucency aspect) for lack of clarity mainly because there were (opaque) constructions in the description which fell outside the scope of the Claim and therefore placed doubt on it.

The Appellant reacted to the decision by filing with the Statement of Grounds a complete new set of application documents whose sole independent Claim refers not to translucency but to signal generating means. The Claim therefore plainly cannot be subject to such translucency/opacity objections as were made in the decision to refuse.

It is not clear to the Board why the Examining Division did not rectify its decision under Article 109 EPC since the present independent Claim 1 does not comprise any reference to a partially translucent portion. In other words the amendments made to the application and more specifically to the independent Claim 1 filed

simultaneously with the Statement of Grounds of Appeal clearly meet the objections on which the contested decision relies.

In such a case the Examining Division is bound to revise its decision (see T 139/87, OJ EPO 1990, 68) particularly since the Examining Division had already stated in its communication of 21 May 1993 that the originally filed independent Claim 12 - which is now the present independent Claim 1 - was novel and inventive (which statement appears justifiable to the Board).

6. Therefore the Board of Appeal deems it necessary to exercise its power under Article 111(1) EPC to remit the case to the Examining Division so that the latter may examine and decide whether the dependent Claims 2 to 14 and the other parts of the application satisfy the remaining requirements of the EPC.

7. *Points which may require attention*

The following points noticed by the Board should be considered during the further prosecution. Page, line and Figure numbers, except where otherwise stated, refer to the present version of the application.

7.1 Claim 8 commences "The shoe according to Claim 1... " whereas Claim 1 is directed to "A shoe fitting system". It seems that the words "fitting system" should be added to Claim 8 and to Claims 9 to 14.

7.2 The word "an" should apparently be added after the word "on" in Claim 8, line 3.

7.3 Claim 10 is a generalisation of original Claim 8. It needs to be considered if the generalisation contravenes

Article 123 (2) EPC and if so whether the Applicant should use the wording of the original Claim 8 (in which case Claim 11 would be redundant).

7.4 Description:

- page 3, line 16 should read "8 and 9";
- page 5, line 10, "40" should read "44";
- page 6, lines 31 to 33, should perhaps read "... This insert is disposed in the shoe shown in the Figs. 1 to 3.";
- page 7, line 26, "10-11" should read "8 and 9";
- page 8, line 1, "8-12" should read "8 - 10, 13 and 14"; and
- page 4, line 30. The original sentence commencing "Alternatively" in lines 1 to 4 of the original page 5 is now deleted. It should be considered whether the following two sentences (commencing "Suitable" and "While" from the present page 4, line 30 to page 5, line 1) referred to the deleted sentence and so would require deletion.

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 for further prosecution on the basis of the application documents

submitted with the Statement of Grounds dated 27 June 1994 and received on 4 July 1994, namely

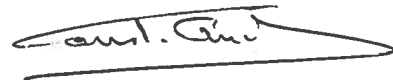
- Claims 1 to 14;
- Description, pages 1 to 9; and
- Drawings sheets 1/4 to 4/4 (Figures 1 to 14).

The Registrar:



N. Maslin

The Chairman:



C. Andries

1896.
Maslin