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**D E C I S I O N**  
**of 5 October 1999**

**Case Number:** T 0554/98 - 3.2.4

**Application Number:** 90202879.4

**Publication Number:** 0427321

**IPC:** A43B 5/04

**Language of the proceedings:** EN

**Title of invention:**

Inner lining shoe for ski boots having a one piece tongue assembly

**Patentee:**

Tecnica SpA

**Opponent:**

Benetton Sportssystem S.p.A.

**Headword:**

-

**Relevant legal provisions:**

EPC Art. 54, 56, 69, 84, 100(b), 123, 104(1), 107, 114(2)  
EPC R. 64(b)

**Keyword:**

"Admissibility of appeal - yes"  
"Novelty and Inventive step - third auxiliary request - yes"  
"Different apportionment of costs - no"  
"Referral to the Enlarged Board of Appeal - no"

**Decisions cited:**

T 0007/81, T 0631/91, G 0009/92, G 0004/93, T 0002/83,  
T 0005/81, T 0056/87, T 0406/86, T 0295/87

**Catchword:**

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Boards of Appeal

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Case Number: T 0554/98 - 3.2.4

**D E C I S I O N**  
**of the Technical Board of Appeal 3.2.4**  
**of 5 October 1999**

**Appellant:** Benetton Sportssystem S.p.A.  
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**Representative:** Modiano, Guido, Dr.-Ing.  
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**Respondent:** Tecnica SpA  
(Proprietor of the patent) Via Fante d'Italia 56  
31040 Giavera del Montello (Treviso) (IT)

**Representative:** Ferroni, Filippo  
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**Decision under appeal:** Interlocutory decision of the Opposition Division  
of the European Patent Office posted 2 April 1998  
concerning maintenance of European patent  
No. 0 427 321 in amended form.

**Composition of the Board:**

**Chairman:** M. G. Hatherly  
**Members:** R. E. Gryc  
R. E. Teschemacher

## Summary of Facts and Submissions

I. The appellant (opponent) lodged an appeal, received at the EPO on 3 June 1998 against the interlocutory decision of the Opposition Division, dispatched on 2 April 1998, which maintained the patent No. 0 427 321 in an amended form. The appeal fee was paid simultaneously and the statement setting out the grounds of appeal was received at the EPO on 3 August 1998.

II. Opposition was filed against the patent as a whole and based on Article 100(a) and (b) EPC. The Opposition Division held that the grounds for opposition cited in Article 100(a) EPC did not prejudice the maintenance of the patent in the amended version submitted finally as the main request during the oral proceedings of 12 March 1998, having regard in particular to documents:

D1: US-A-4 523 392

D2: FR-A-2 230 155

D3: DE-B-0 106 393 and

D8: US-A-3 668 793.

III. In his statement setting out the grounds of appeal, the appellant alleged that the state of the art disclosed in D1 deprived the subject-matter of Claim 1 as maintained by the Opposition Division of novelty. In particular he contended that this Claim 1 simply recited a succession of trivial assembly steps of the

component parts which were already described in the product Claim 1 as granted and also in the product claims of the first auxiliary request submitted to the Opposition Division. He argued that the respondent had withdrawn said product claims after the Opposition Division had announced that their subject-matter was not novel over D1 and that such a withdrawal was equivalent to an irrevocable admission of lack of novelty by the respondent.

In view of the foregoing, the appellant concluded that the component portions of the inner lining shoe were not novel over D1 and that the steps according to Claim 1 of providing such component portions were also not novel, since they were implicitly and necessarily also provided in D1.

The appellant contended furthermore that it was implicit from D1 that the tongue carrying vamp (6) of D1 was connected to the sole, i.e. at a position remote from the instep, so that all the characteristics described in Claim 1 were already disclosed in D1 either explicitly or implicitly.

The appellant contended further that the subject-matter of Claim 1 lacked an inventive step over D1.

He questioned whether the expression: "proper tongue (14) integrally formed with a part (16)" recited in the claim 1 defined both a one-piece assembly and a two-piece assembly and whether a one-piece assembly, which was the only alternative capable of avoiding thickenings, was supported by the description. He considered that the one-piece assembly was

insufficiently supported by the patent in suit and that the two-piece assembly could not solve the problem dealt with in the patent and thus lacked an inventive step.

In subsequent statements, the appellant maintained his objections based on Articles 84, 100(a) and 100(b) and requested the referral to the Enlarged Board of Appeal of the question of applicability of the following principle: "The closer to obviousness is the inventive step, the higher should be the clearness and completeness of the European patent application".

Moreover, he submitted a further document (D11: US-A-2 572 050) arguing that it anticipated the subject-matter claimed in Claim 1.

The respondent (proprietor of the patent) argued that the appeal was not admissible under Rules 64(b) and 65(1) EPC since the extent to which amendment or cancellation of the impugned decision was requested was not identified in the notice of appeal.

Furthermore, he opposed the whole argumentation of the appellant and filed a declaration from Mr Andrea Gabrielli, the inventor of the shoe disclosed in D1, explaining how said known shoe was manufactured. Drawings comprising a Figure 3 showing the shoe of D1 were annexed to the declaration.

The Board regarded said Figure 3 as useful for understanding the invention and decided to take it into consideration in the proceedings as document D12.

IV. Oral proceedings took place on 5 October 1999.

After the respondent had submitted a third auxiliary request comprising a new Claim 1 amended in view of the clarity objections, the appellant contended that the protection conferred by this claim was extended because the term "integral" contained in Claim 1 as granted and which limited the protection of the claim to a one piece element had disappeared from the claim. According to him, a preassembled two-piece element could not be considered to be protected by Claim 1 without contravening Article 123(3) EPC.

The appellant was also of the opinion that the invention was totally anticipated by D11, the subject-matter of which belonged to the general technical field of footwear and had the same characteristics as the shoe described in Claim 1. He contended also that the shoe of D1 destroyed the novelty of the subject-matter of Claim 1 since, according to him, it was implicit for the skilled person that a vamp should necessarily be connected to the sole.

The appellant considered that the state of the art disclosed in D11 was the closest to the invention because, in particular, it solved the problem of the invention, i.e. to avoid thickenings at the instep level of the shoe.

The appellant pointed out that the invention did not avoid thickenings per se but only the effect of thickenings, since in particular Figure 2 of the patent clearly showed that thickenings were still present at the instep level.

He considered it also to be usual to provide padding inside a shoe everywhere where a protuberance could hurt the foot, so that no inventive step would be involved in such a measure.

The appellant drew also the attention of the Board to the fact that the term "padding" was cited neither in the application as filed nor in the patent as granted and that to add this word in Claim 1 would introduce new matter since the use of padding was never considered before as a crucial feature of the invention.

The respondent disagreed with the appellant's arguments and contended in particular that padding was clearly disclosed in Figure 2 of the application as filed and of the granted patent, that there was no disclosure in D1 concerning the order of assembling the different parts of the known shoe, and that the shoe disclosed in D11 was a component of a combined shoe and skate construction and not an inner lining shoe for ski boots.

- V. At the end of the oral proceedings the appellant requested that the decision under appeal be set aside and that the European patent No. 427 321 be revoked.

In the alternative, he requested to refer the point of law identified in his letter dated 2 September 1999 to the Enlarged Board of Appeal.

In addition, he requested to apportion the costs, incurred by him for the appeal proceedings, to the respondent.



The respondent requested that the appeal be dismissed and the patent be maintained as granted (main request).

In the alternative, he requested to maintain the patent on the basis of one of the two sets of claims submitted as auxiliary requests in the oral proceedings before the Opposition Division (first and second auxiliary request), or on the basis of the set of claims submitted during the oral proceedings before the Board (third auxiliary request).

VI. Claim 1 of the second auxiliary request reads as follows:

"A process for manufacturing an inner lining shoe for ski boots, characterised in that it comprises the following steps:

- providing a tongue assembly (12) consisting of a proper tongue (14) integrally formed with a part (16) of the upper avoiding thickenings at the instep level, wherein the part (16) of the upper is an extension of the tongue (14) and consists of a fore part of the upper which is adapted to constitute the whole toe portion of the upper of the shoe;
- providing an upper remaining part (20) including a leg part (22), connected to a sole (24);
- connecting the tongue assembly (12) to the upper remaining part (20) and to the sole (24) through fastening means (34, 36), in position remote from the instep."

Claim 1 of the third auxiliary request reads as follows:

"A process for manufacturing an inner lining shoe for ski boots, which comprises the following steps:

- providing a tongue assembly (12) consisting of a proper tongue (14) integrally formed with a part (16) of the upper so as to have an inner padding which extends continuously along said tongue and said part, avoiding inside thickenings at the instep level, wherein the part (16) of the upper is an extension of the tongue (14) and consists of a fore part adapted to constitute the whole soleless toe portion of the upper of the shoe;
- providing an upper remaining part (20) including a leg part (22), connected to a sole (24);
- connecting said extension of the tongue assembly (12) to the upper remaining part (20) and to the sole (24) through fastening means (34, 36), in position remote from the instep."

## **Reasons for the Decision**

### 1. *Admissibility of the appeal (Rule 64(b) EPC)*

Pursuant to Rule 64(b) EPC: "The notice of appeal shall contain ... a statement identifying the decision which is impugned and the extent to which amendment or cancellation of the decision is requested."

In the notice of appeal dated 2 June 1998 the appellant did state that he appealed against the entire decision of the Opposition Division but he did not explicitly identify the extent to which amendment or cancellation of the decision was requested.

However, according to the established case law of the Boards of appeal the extent of the appeal is sufficiently identified if it is stated in the notice of appeal that the first instance decision is appealed in its entirety. In such a case it can be assumed that the appellant adheres to his requests on which the impugned decision was based (see for example decisions T 7/81, OJ EPO 1983, 98 and T 631/91, not published in the OJ).

Consequently, in conformity with said consistent case law, the Board considers that the statement contained in the appellant's request of 2 June 1998 satisfies the requirements of Rule 64 EPC and that the appeal is admissible.

2. *Admissibility of the late submitted documents*

The patent US-A-2 572 050 (D11) was submitted for the first time to the Board with the appellant's letter dated 28 September 1999 and Figure 3 (D12) referred to in Mr Gabrielli's declaration was filed with the respondent's letter of 2 September 1999.

While these two documents were submitted only shortly before the oral proceedings, they are particularly relevant and so the Board has decided that they should be taken into consideration together with the documents discussed in the decision under appeal.

3. *Main request (claims as granted) and first auxiliary request*

The respondent has requested the reinstatement of the

product claims submitted to the Opposition Division.

The Board of Appeal does not accept this request for the following reasons:

During the oral proceedings before the Opposition Division, the respondent submitted a set of process claims as a basis for his main request and the Opposition Division maintained the patent according to said request.

The respondent was thus not adversely affected by the interlocutory decision of the Opposition Division in the meaning of Article 107 EPC.

During appeal proceedings he is therefore primarily limited to defending the patent in the form in which it was maintained by the Opposition Division (see the decisions of the Enlarged Board of Appeal G 9/92 and G 4/93 - OJ EPO 1994, 875) and any amendments he proposes may be rejected by the Board of Appeal if they are neither appropriate nor necessary.

The Board considers that it is the case with the reinstatement of the product claims which does not arise from the appeal and rejects the corresponding request of the respondent (see decisions T 406/86, OJ EPO 1989, 302 and T 295/87, OJ EPO 1990, 470).

4. *Second auxiliary request*

Claim 1 of the second auxiliary request has been modified in particular in that the feature in Claim 1 as granted of

"said extension being connectable to the remaining part (20) of the upper"

(see the specification: column 3, lines 29 to 31),

has been replaced by the feature of

"connecting the tongue assembly (12) to the upper remaining part (20)"

(see line 11 of page 2 annexed to the respondent's letter of 5 February 1998).

The new feature is more general than the granted feature since it no longer specifies which part of the tongue assembly is connectable and connected to the upper remaining part of the shoe.

Therefore, the protection conferred by the claim has been extended in contravention of Article 123(3) EPC.

Moreover the subject-matter of Claim 1 of the second auxiliary request is not seen as inventive, for the following reasons.

The shoe rear and front parts shown respectively in Figures 1 and 3 of D3 correspond to the upper remaining part and tongue assembly specified in Claim 1 and this type of shoe construction is well known (see e.g. in D11, the reference to shoes of the Blucher type, column 1, lines 54 to 59).

The sub-assemblies disclosed by D3 and the process of making the shoe of D3 thus differ from the invention

claimed in Claim 1 only in that D3 concerns a normal shoe whereas the process of Claim 1 is for manufacturing an inner lining shoe for ski boots. Claim 1 contains no steps or features to differentiate its process from the known process for making shoes in general and it does not even specify the padding which was put forward by the respondent himself as an essential component of the lining shoe according to the invention.

Therefore Claim 1 cannot be allowed in application of Articles 56 and 123 EPC and the second auxiliary request must be rejected.

5. *Third auxiliary request (based on the claims submitted during the oral proceedings before the Board)*

5.1 Amendments to the claims (Articles 84 and 123 EPC)

5.1.1 Change of category

In the description of the application as originally filed, the invention is described in terms of manufacturing operations such as, for example page 2, line 21: "made integrally"; lines 26 and 31: "integrally formed"; line 27: "shaped as"; - line 28: "which can be connected" or on page 3, line 1: "which can be anchored and secured"; lines 1 and 2: "which can be sewed", etc...

Therefore, the change of category from the granted "product" claims to the claims of the third auxiliary request concerning a "process" for manufacturing the same does not amend the patent in suit in such a way

that it contains subject-matter which extends beyond the content of the application as filed (Article 123(2) EPC).

Since, moreover, a product claim per se confers protection to all processes for making that product, a replacement of said product claim by a process claim directed to a specific method for making that product does not extend the protection conferred thereby (Article 123(3) EPC; cf Case Law of the Boards of Appeal of the EPO, 3rd edition 1998, III.B.3, at page 220).

Therefore, the change of category of the claims of the third auxiliary request from "product" to "process" does not contravene Article 123 EPC and is allowable.

#### 5.1.2 Amendments to the wording of Claim 1

In addition to the change of category, Claim 1 of the third auxiliary request has been made more specific and clarified as follows:

- The location of the "thickenings" cited in Claim 1 as granted (see column 3, line 23 of the specification) has been made more precise by adding the word "inside" before the word "thickenings", based on Figure 2 of the application as originally filed.
- The way of "avoiding inside thickenings" has been specified in the amended claim by adding the wording "so as to have an inner padding which extends continuously along said tongue and said

part".

Also this feature is clearly shown in the cross-section view of Figure 2.

- The erroneous expressions: "foot back" and "back of the foot" used in column 3, lines 24 and 32 respectively of the specification have been replaced by the word "instep" which is more appropriate for specifying the location of the thickenings with respect to the foot of the wearer.
- The phrase: "a fore part adapted to constitute the portion of the upper being the toe of the shoe" (see Claim 1 as granted, column 3, lines 27 to 29) has been replaced by the following phrase:

"a fore part adapted to constitute the whole soleless toe portion of the upper of the shoe".

It is clear from Figure 3 of the application as originally filed that part (16) of the tongue assembly (12) constitutes the whole toe portion of the upper and that it is not preassembled with a sole.

All the amendments made to Claim 1 as submitted during the oral proceedings are supported either by the description or the drawings of the application as filed originally (Article 123(2) EPC). Since, moreover, they clarify the content of Claim 1 on file (Article 84 EPC) and restrict the protection conferred thereby (Article 123(3) EPC, they are admissible.



### 5.1.3 Amendments to the description

The description as granted has been modified to adapt it to the new set of claims on file and no new matter has been incorporated in it. Therefore, all the amendments made are acceptable.

### 5.2 Interpretation of Claim 1

While the word "integral" (see column 3, line 25 of the specification) has disappeared from the text of Claim 1, the questionable expression: "integrally formed" (see column 3, line 22) has been maintained in order to avoid the risk of contravening Article 123 EPC.

Also the inappropriate expression "remote from" (see column 3, line 32) has been retained in Claim 1 for the same reasons.

However, in order to be able to appreciate properly the scope of Claim 1, the Board has interpreted these expressions as follows:

- "integrally formed": Since a tongue assembly in one piece has been neither described nor represented in the application as originally filed, the only interpretation which can be validly given to this expression is that the assembly is formed with two parts permanently secured together so as not to be dismantlable i.e. the proper tongue (14) joined to the fore portion (16) of the upper (see the application as filed, page 3, lines 15 to 18 and Figures 2 and 3).

- "remote from": It is clear from the application as filed (see page 3, lines 22 to 26 and Figures 1 and 2) that the fastening means (34, 36) joining the side edges (26) of the fore part (16) to the corresponding fore edges (28, 32) of the rear part of the upper extend vertically from the sole (24) up to the instep of the upper. The sewings (34, 36) end close to the instep and so the expression "remote from" needs to be interpreted (Article 69 EPC) as meaning that the connection between the tongue assembly extension (16) and the upper remaining part (20) does not interfere with the instep portion of the upper.

### 5.3 Disclosure of the invention (Article 100(b) EPC)

The application as originally filed considered as a whole (i.e. the description, the claims and also the drawings) discloses the invention in sufficient detail for it to be able to be carried out by a person skilled in the art without any difficulty. The conditions of Article 83 EPC are thus fulfilled by the patent taken as a whole.

### 5.4 Novelty (Article 54 EPC)

When examining novelty it should be borne in mind that claimed subject-matter would lack novelty only if this subject-matter were derivable as a whole directly and unambiguously from one document and that it is not justified arbitrarily to take parts of a prior art document from their context in order to derive therefrom a technical information which would differ from the teaching of the document taken as a whole.

In the present case it is not directly and unambiguously derivable from D1 that, as contended by the appellant, the fore part of the upper of the shoe constitutes the whole toe portion of the upper and is connected to the sole. Even if this were so, D1 does not describe at all the order in which the different parts of the shoe are assembled together and there is neither an indication of, nor a hint of, nor a reason for securing the proper tongue to the vamp before the vamp itself is fastened to the sole. Therefore, even if the shoe described in Claim 1 were disclosed by D1, the different steps of assembling together its different parts are not even suggested in D1 and its disclosure cannot anticipate the process claimed in Claim 1.

In his statement setting out the grounds of appeal of 3 August 1998 (see page 5, 3rd paragraph) and also in his written submission dated 2 September 1999 (see page 16, 4th paragraph) the appellant contended that, in the oral proceedings before the first instance, the respondent withdrew his originally filed main and first auxiliary requests and thereby implicitly admitted that the subject-matter of the product claims 1 of these requests was not novel. However, no statement about such an admission could be derived either from the minutes of the oral proceedings before the opposition division or from the decision under appeal where it is only stated (see page 3, end of section I.11) that "the second auxiliary request was to be considered as the main request".

The respondent could change his request without this necessarily being an admission of lack of novelty. Thus the argument of the appellant does not succeed.

As regards D11, it is clear that this document does not describe an inner lining shoe for ski-boots but an assembly of a shoe and an ice-skate element, i.e. a construction quite different from a lining shoe for ski boots. Moreover, the tongue assembly of the shoe of D1 has no inner padding and, apparently, it is provided with the toe portion (26) already connected to a sole (29)(see D11: Figure 2).

Consequently, the subject-matter of Claim 1 is not disclosed by D1 and D11. The only other documents cited during the proceedings which concern an inner shoe for ski boots are D2 and D7.

The tongue of the inner shoe of D2 is not integrally formed in the meaning of the invention (see section 5.2) with a part of the upper (cf D2: Figure 2) and there is no indication about providing separately either a tongue assembly or an upper part connected to a sole.

In D7, a tongue assembly is neither mentioned nor illustrated and there is no indication about providing separately either such an assembly or an upper part connected to a sole.

Therefore, it can be seen from the above analysis that the subject-matter of Claim 1 is new in the meaning of Article 54 EPC.

#### 5.5 The closest state of the art

During the oral proceedings, the parties agreed that D12 presented further information about the inner shoe

for ski boots described in D1 and they also agreed to consider the process of manufacturing this known shoe as being the closest to the invention.

The process of Claim 1 differs from this closest prior art process at least in that:

- the tongue assembly is preassembled with an inner padding extending continuously along the tongue and the fore part of the upper so that inside thickenings are avoided, and
- the extension of the tongue assembly constituting the toe portion of the upper is provided without a sole.

#### 5.6 Problem and solution

Starting from the inner lining shoe of D1, disclosed more in detail by D12, and taking into account the above-mentioned differences, the objectively determined problem to be solved can be seen to be to provide a method for manufacturing a lining shoe avoiding the formation of thickenings in the inside of the shoe at the instep level (see the patent specification: column 1, lines 40 to 44).

The Board is satisfied that the invention as claimed in Claim 1 solves this problem.

#### 5.7 Inventive step (Article 56 EPC)

5.7.1 The questions to be answered regarding the inventive step are not only whether the skilled person, starting

from the closest state of the art process and examining the prior art in the light of his general common knowledge, would be provided with enough information that he could arrive at the solution claimed in Claim 1, but also whether he would find hints or clues leading him to modify said closest state of the art process in a way leading to the claimed process in expectation of the improvement he was searching for (see decision T 2/83, OJ EPO 1984, 265).

Also, when assessing inventive step, an interpretation of the prior art documents as influenced by the problem solved by the invention while the problem was neither mentioned nor even suggested must be avoided, such an approach being merely the result of an a posteriori analysis (see decision T 05/81, OJ EPO 1982, 249).

Moreover, it should be borne in mind that the technical disclosure in a prior art document should be considered in its entirety, as would be done by a person skilled in the art, and that it is not justified arbitrarily to isolate parts of such document from their context in order to derive therefrom technical information which would differ from the integral teaching of the document (see decision T 56/87, OJ EPO 1990, 188).

- 5.7.2 Some of the components used to manufacture the lining shoe made according to the process of Claim 1, such as a tongue assembly having an inner padding extending continuously along the proper tongue and the toe portion of the upper, are not disclosed per se in the prior art.

Also some of the steps of the process of Claim 1, such as the provision of a preassembled tongue assembly having an inner padding and a soleless toe portion, are also new per se.

Moreover, in the state of the art disclosed in D1 to D12, the skilled person would find neither a clue nor a hint nor an indication which could even suggest to him the idea of using, for manufacturing a lining shoe, a preassembled tongue assembly having an extended inner padding.

Moreover, the problem of avoiding the effect of inner thickenings at the instep level was neither mentioned nor even suggested in D1 (or D12) which concerned the problem of providing a lining with a shell structure comprising an easily interchangeable padding (see D1, from line 65 of column 1 to line 11 of column 2) i.e. a completely different problem to solve as that according to the invention.

Also, it should be noted that instead of avoiding inside thickenings, the process for manufacturing the shoe known from D1 or D12 multiplies the number of panels to be sewn together in the instep area and therefore the number of sewings and of thickenings inside the shoe (see D1: column 1, lines 9, 10; column 2, lines 60 to 63; Claim 1, lines 15 to 17 and Figures 1, 2 and 4).

Consequently, when D1 and D12 are considered in their entirety, which is the practice of the Boards of appeal, to interpret their teachings while being influenced by the problem solved by the invention would

be the result of an a posteriori analysis (see above), if the person skilled in the art would have no reason to envisage manufacturing the lining shoe described by said documents according to the succession of steps recited in Claim 1.

5.7.3 For the foregoing reasons, the Board considers that to improve the process for manufacturing the lining shoe disclosed in D1 and D12 in order to arrive at the teaching of Claim 1 does not follow plainly and logically from the cited prior art and that the reasons given by the appellant do not prejudice the maintenance of the patent in its amended version submitted as the respondent's third auxiliary request at the oral proceedings.

6. *Referral of questions to the Enlarged Board of Appeal*

The appellant contended that, if the inventive step is close to obviousness, the skilled person who is supposed to be unable to attain the almost obvious inventive step must have low mental capabilities and so, in order to enable him to carry out the invention, the disclosure of the patent should be particularly clear and complete (Article 83 and 84 EPC).

The appellant has requested that the Board refer to the Enlarged Board of Appeal the question of applicability of the following statement:

"The closer to obviousness is the inventive step, the higher should be the clearness and completeness of the European patent application".



The appellant's view was apparently based on the assumption that: "the inventive step referred to in Article 56 EPC may be close to obviousness or may be far away from obviousness" (see the penultimate paragraph of page 2 of the appellant's letter dated 2 September 1999).

The Board emphasizes that such an assumption is not in conformity with the EPC and not in conformity with the way of examining inventive step at the EPO where inventive step is viewed as being "there or not" with no in between stage, in the same way as the criterion of novelty is examined. Only the existence or the non-existence of an inventive step is taken into consideration and not the level of inventivity.

Therefore, the Board does not consider it appropriate to submit this principle to the Enlarged Board of Appeal.

7. *Apportionment of costs (Article 104 EPC)*

The appellant requested that the costs of the appeal proceedings including the appeal fee and the attorney fees of the appellant be apportioned onto the respondent if the respondent failed to provide evidence that the respondent did not deliberately attempt and did not succeed in deceiving the good faith of the opposition division during the oral proceedings before said instance.

It is pointed out that, according to Article 104(1) EPC, the Board could only order a different apportionment of the costs incurred during taking of

evidence or in oral proceedings but not the apportionment of the fees or of any other expenses.

Further, the Board cannot see how an attempt to deceive, if any, could have involved additional costs as regards oral proceedings since these were requested by both parties and thus would have taken place in any case.

Moreover, as acknowledged by the appellant himself, in his letters of 3 August 1998 (see page 13, 4th paragraph) and of 2 September 1999 (see page 14, 7th paragraph), the appellant advised the Opposition Division at the oral proceedings that the respondent was attempting deception but the Opposition Division was not convinced of this. Neither in the appealed decision, nor in the minutes of the oral proceedings before the first instance, is this question mentioned. The appellant has thus failed to prove that such an attempt was actually made by the respondent, still less that this attempt succeeded.

Therefore, from the foregoing the Board cannot detect any reasons of equity for ordering an apportionment of costs different from what is usual i.e. each party meets the costs that he has incurred (Article 104(1) EPC).

The corresponding request of the appellant is accordingly rejected.

## 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 maintain the patent as amended in the following version:

**Claims:** 1 to 3 and description columns 1 to 3 as submitted during the oral proceedings before the Board,

**Drawings:** Figures 1 to 4 as granted (third auxiliary request).

3. The request to refer a point of law to the Enlarged Board of Appeal is rejected.
4. The request for apportioning costs to the respondent is rejected.

The Registrar:

The Chairman:

G. Magouliotis

M. G. Hatherly