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**Datasheet for the decision
of 31 March 2011**

Case Number: T 0731/09 - 3.2.04

Application Number: 04029221.1

Publication Number: 1541049

IPC: A43C 11/00

Language of the proceedings: EN

Title of invention:

Lace system for footwear

Patentee:

THE BURTON CORPORATION

Opponent:

Deeluxe Sportartikel Handels GmbH
ATOMIC Austria GmbH

Headword:

-

Relevant legal provisions:

EPC Art. 100(c), 123(2)

EPC R. 115(2)

Keyword:

"Main request and auxiliary requests 2 to 10 - added subject-matter (yes)"

"Auxiliary request 1 - not admitted into the proceedings"

Decisions cited:

T 0270/90

Catchword:

-



Case Number: T 0731/09 - 3.2.04

D E C I S I O N
of the Technical Board of Appeal 3.2.04
of 31 March 2011

Appellant: Deeluxe Sportartikel Handels GmbH
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Representative: Popp, Eugen
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Party as of right: ATOMIC Austria GmbH
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Representative: Secklehner, Günter
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Respondent: THE BURTON CORPORATION
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Representative: HOFFMANN EITLE
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Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 26 February 2009
rejecting the opposition filed against European
patent No. 1541049 pursuant to Article 101(2)
EPC.

Composition of the Board:

Chairman: M. Ceyte
Members: C. Scheibling
T. Bokor

Summary of Facts and Submissions

- I. By its decision dated 26 February 2009 the Opposition Division rejected the oppositions against the European patent 1 541 049. On 26 March 2009 the Appellant (opponent I) filed an appeal and paid the appeal fee simultaneously. The statement setting out the grounds of appeal was received on 1 July 2009.
- II. The patent was opposed on the grounds based on Article 100(a) (lack of novelty and inventive step) and 100(c) (added subject-matter) EPC.
- III. Oral proceedings took place on 31 March 2011 before the Board of Appeal.

The Appellant requested that the decision under appeal be set aside and that the patent be revoked.

He mainly argued as follows:

In the application as originally filed the claimed boot comprises a first lace and a second lace, i.e. two laces, one for each lacing zone. However, claim 1 as granted as well as claim 1 of auxiliary requests 2 to 10 cover the use of one single lace for tightening two lacing zones. This contravenes the requirements of Article 123(2) respectively 100 (c) EPC.

Since no new issue was raised during the oral proceedings, there was no reason for filing a new first auxiliary request at the end of these proceedings. Furthermore, claim 1 of this new request does not overcome the objections raised. Therefore, this new request should not be admitted into the proceedings.

The Respondent (patentee) contested the arguments of the Appellant. He mainly submitted that claim 1 as originally filed does not state that the first and second laces are separate. Moreover, it is indicated in the description as originally filed that "In one embodiment, each zone is tightened with a separate lace". This means that in other embodiments two zones can be tightened with one common lace. Thus, when the boot only comprises two lacing zones, it might only comprise one lace.

The new auxiliary request 1 was filed in response to the discussion that took place during the oral proceedings. Only then it became clear that the objection under Article 123(2) EPC might preclude maintenance of the patent. This request should be admitted into the proceedings, since the amendments made in claim 1 are easy to understand, do not delay the proceedings and overcome the raised objection of added subject-matter.

The Respondent requested that the appeal be dismissed or, in the alternative, that the decision under appeal be set aside and that the patent be maintained in amended form on the basis of the set of claims according to the auxiliary request 1, filed during the oral proceedings before the Board or any of the sets of claims filed as auxiliary requests 1 to 9 filed (now 2 to 10) by letter dated 24 February 2011.

Opponent II although duly summoned did not appear at the oral proceedings. The proceedings were continued without him, in accordance with Rule 115(2) EPC.

IV. Claim 1 of the main request (as granted) reads as follows:

"1. A boot (2) comprising:
a boot body (3) having a lower region (6) adapted to cover a foot of a wearer and an upper region (7) adapted to cover at least a portion of a shin of the wearer;
a first lacing zone (22) comprising a first lacing zone portion of a lace (16) adapted to tighten a first region of the boot, said lace having a first free-end lace portion that is disposed at the upper region; and
a second lacing zone (20) comprising a second lacing zone portion of a lace adapted to tighten a second region of a boot, said lace having a second free-end lace portion that is disposed at the upper region of the boot;
wherein both the first free-end lace portion and the second free-end lace portion are simultaneously or sequentially separately graspable, to bring each lacing zone separately to a desired degree of tightness, and then securable at the upper region of the boot."

Claim 1 of auxiliary request 1 distinguishes from claim 1 as granted by the addition of "first" and "second" so as to read "a first lacing zone portion of a first lace" and "a second lacing zone portion of a second lace".

Claim 1 of auxiliary request 2 differs from claim 1 as granted by the addition of the following features: "the boot body including a tongue opening disposed in a shin-to-toe direction, and a tongue disposed within the

tongue opening and attached at a lower end portion to the boot body".

Claim 1 of auxiliary request 3 specifies that the claimed boot is a snowboard boot.

Claim 1 of auxiliary request 4 is a combination of claims 1 and 6 as granted.

Claim 1 of auxiliary request 5 is a combination of claims 1 and 12 as granted.

Claim 1 of auxiliary request 6 is a combination of claims 1 and 13 as granted.

Claim 1 of auxiliary request 7 is a combination of claims 1, 13 and 14 as granted.

Claim 1 of auxiliary request 8 is a combination of claims 1 and 19 as granted.

Claim 1 of auxiliary request 9 is a combination of claims 1, 19 and 20 as granted.

Claim 1 of auxiliary request 10 is a combination of claims 1 and 8 as granted.

Reasons for the Decision

1. The appeal is admissible.

2. *Added subject-matter*

2.1 Claim 1 as originally filed reads as follows "A boot comprising: a boot body having a lower region adapted to cover a foot of a wearer and an upper region adapted to cover at least a portion of a shin of the wearer; a first lacing zone comprising a first lace adapted to tighten a first region of the boot, the first lace having a portion that is disposed at the upper region; and
a second lacing zone comprising a second lace adapted to tighten a second region of the boot, the second lace having a portion that is disposed at the upper region of the boot;
wherein both the first lace and the second lace are simultaneously securable at the upper region of the boot."

2.2 Thus, claim 1 as originally filed discloses two laces, one for each of the two lacing zones.
In paragraphs [0006] and [0007] which relate to the summary of the invention, the invention is disclosed as being directed to a boot with a first lacing zone comprising a first lace and a second lacing zone comprising a second lace, wherein "both the first lace and the second lace are simultaneously securable at the upper region of the boot."
These passages make clear that a boot according to the invention comprises two lacing regions each provided with a separate lace.

2.3 Claim 1 of the main request and auxiliary requests 2 to 10 no longer comprises first and second laces, but only two free-end lace portions.

This amendment generates the added-subject matter that the first and second lacing zones may be tightened not only with a first and a second lace but with a single lace. This subject-matter is not directly and unambiguously derivable from the originally filed application, taking into account matter which is implicit (not merely obvious) to a skilled person.

In this respect the Respondent submitted that in paragraph [0018] of the application it is stated "In one embodiment, each zone is tightened with a separate lace".

Thus claim 1 as originally filed embraces an embodiment in which each zone is tightened with a single lace but is not limited to this embodiment. The first and second lace in claim 1 as originally filed could be part, or be a portion, of one single lace.

The Board is unable to follow such reasoning: For the purpose of determining whether the amendment made introduces added-subject matter, the question is not whether claim 1 as originally filed embraces the embodiment in which the first lace and the second lace are part, or a portion, of one single lace. The question is whether the embodiment in question has a clear basis in the application as originally filed, that is the description of the claimed invention, the claims and the drawings.

It is well established that a main claim may cover disclosed and undisclosed embodiments. For example a main claim citing "metal" may embrace the undisclosed embodiment "copper". Thus the fact that a claim may embrace an embodiment does not necessarily mean that

the embodiment in question is disclosed in the patent application as originally filed.

In the present case, it cannot directly and unambiguously be derived from the patent application as originally filed that the first lace and second lace may be part, or a portion, of a single lace, even if such an embodiment might be covered by the wording of claim 1.

- 2.4 To illustrate that the amendment in question does not introduce added subject-matter, the Respondent submitted that it would have been possible to add to the set of claims as originally filed a further dependent claim stating that each zone is tightened with a separate lace. The Board agrees that the introduction of such a claim for which the application as filed in paragraph [0018] provides a clear basis would not apparently violate the requirements of Article 123(2) EPC. In contrast thereto a further dependent claim stating that the first lace and second lace are part, or a portion, of a single lace, would have no basis in the application as originally filed, since it relates to an undisclosed embodiment and would therefore be a violation of Article 123(2) EPC.

The first sentence of paragraph [0018] states that in one embodiment the zones may be tightened by pulling on two lace ends. As submitted by the Respondent, paragraph [0018] refers in the first sentence to "one embodiment" and refers in the second sentence to "one embodiment" clearly indicating that the second statement, namely that each zone is tightened with a separate lace, does not apply to the "one embodiment" covered by the first sentence of paragraph [0018].

There are thus two different embodiments, a first one in which the zones may be tightened with two lace ends and a second one in which each zone is tightened with a separate lace. However, it cannot be directly and unambiguously derived from these two different embodiments that two lacing zone might be tightened with one single lace, especially as it is not immediately apparent to a skilled reader how in such a case the tensions of the two independent lacing zones could be separately adjustable by the wearer, as stated in paragraph [0017].

2.5 Consequently, claim 1 as granted and claim 1 of auxiliary requests 2 to 10 contravene the requirements of Article 123(2) EPC. Accordingly, the main request as well as auxiliary requests 2 to 10 must fail.

3. *Admissibility of the late filed auxiliary request 1*

3.1 Article 13(1) of the Rules of Procedure of the Boards of Appeal (RPBA) stipulates that "Any amendment to a party's case after it has filed its grounds of appeal or reply may be admitted and considered at the Board's discretion" and further that this discretion "shall be exercised in view of inter alia the complexity of the new subject-matter submitted, the current state of the proceedings and the need for procedural economy".

An approach frequently adopted by the Boards when exercising their discretion in admitting amendments filed shortly before or in the course of oral proceedings is whether or not good reasons exist for such late filing - this may be the case when amendments

are occasioned by developments during the proceedings - and whether or not a new request appears prima facie allowable, that is to say clearly overcomes the objections raised (see e.g. T 0270/90, OJ EPO 1993, 725).

3.2 In the present case, the auxiliary request 1 was filed towards the end of the oral proceedings. The issue of added subject-matter has been raised with the notice of opposition and maintained throughout the opposition and appeal proceedings. No surprising new aspects have been raised during the appeal proceedings which could have justified such late amendments.

3.3 Claim 1 of auxiliary request 1 adds to claim 1 as granted "first" and "second" so as to read "a first lacing zone portion of a **first** lace" and "a second lacing zone portion of a **second** lace" (emphasis added). The term "lacing zone portion of a lace" is nowhere disclosed in the application as filed. Claim 1 as amended comprises now "a first lacing zone portion of a first lace" and "a second lacing zone portion of a second lace". This means that there must be in addition a "second" lacing zone of the first lace and a "first" lacing zone of the second lace. However, the application as filed only discloses first and second lacing zones but not a first and a second lace having each a first and a second lacing zone portion. Thus the amendments made do not appear to be prima facie allowable under Article 123(2) EPC.

3.4 Furthermore since no sound reasons were given for filing this amendment at such late stage of the proceedings, the Board in exercising its discretion under Article 13(1) RPBA decided not to admit this late filed request into the proceedings.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The patent is revoked.

The registrar:

The Chairman:

G. Magouliotis

M. Ceyte