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**Datasheet for the decision  
of 1 March 2016**

**Case Number:** T 0563/12 - 3.2.03

**Application Number:** 01927901.7

**Publication Number:** 1185183

**IPC:** A43B9/12, A43B7/08, A43B7/12,  
B29D35/12, B29D35/14

**Language of the proceedings:** EN

**Title of invention:**  
METHOD OF MANUFACTURING A BREATHABLE SHOE

**Patent Proprietor:**  
Geox S.p.A.

**Headword:**

**Relevant legal provisions:**  
EPC 1973 Art. 100(a), 56  
EPC Art. 54, 123(2)  
RPBA Art. 13(3)

**Keyword:**

Novelty - (yes)

Inventive step - main request (no)

Inventive step - auxiliary request 1 (no)

Amendments of auxiliary request 2 - added subject-matter (yes)

Late-filed auxiliary request 3 - admitted (no)

**Decisions cited:**

T 1599/08

**Catchword:**



**Beschwerdekammern**  
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Case Number: T 0563/12 - 3.2.03

**D E C I S I O N**  
**of Technical Board of Appeal 3.2.03**  
**of 1 March 2016**

**Appellant:** Geox S.p.A.  
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**Decision under appeal:** Interlocutory decision of the opposition  
division of the European Patent Office posted on  
3 January 2012 concerning maintenance of the  
European Patent No. 1185183 in amended form.

**Composition of the Board:**

**Chairman** G. Ashley  
**Members:** V. Bouyssy  
E. Kossonakou

## **Summary of Facts and Submissions**

- I. European patent No 1 185 183 (in the following: "the patent") concerns a method for manufacturing a breathable shoe.
- II. The patent had already been granted by the time of the entry into force of the EPC 2000 on 13 December 2007. Where Articles of the earlier version of the EPC apply in accordance with the relevant transitional provisions, their citations are followed by "1973".
- III. The patent as a whole was opposed on two grounds of Article 100(a) EPC 1973, namely for lack of novelty and lack of inventive step.
- IV. At oral proceedings on 21 April 2008, the opposition division decided that Article 100(a) EPC 1973 prejudiced the maintenance of the patent as granted because the subject-matter of claim 1 lacked novelty over E1 (JP 9-140404), but that the patent as amended on the basis of the auxiliary request before it met the requirements of the EPC.
- V. This interlocutory decision was appealed by both the opponent and the patent proprietor. In decision T 1599/08 of 29 January 2010, Technical Board 3.2.04 set aside the decision under appeal and remitted the case to the opposition division to consider inventive step.
- VI. At oral proceedings on 10 November 2011, the opposition division decided that the subject-matter of claim 1 according to the main request before it lacked inventive step in the light of E0 (WO 99/26504 A1), but that the patent as amended on the basis of auxiliary request 1 before it met the requirements of the EPC.

- VII. This second interlocutory decision was appealed by both the patent proprietor and the opponent and is the subject of the present proceedings.
- VIII. By letter dated 11 March 2013, the opponent withdrew the opposition.
- IX. With the summons to oral proceedings, the Board sent a communication pursuant to Article 15(1) of the Rules of Procedure of the Boards of Appeal (RPBA) indicating its preliminary opinion of the case.
- X. Oral proceedings before the Board were held on 1 March 2016.
- XI. Requests

The patent proprietor (here the appellant) requested that the appealed decision be set aside and the patent be maintained as granted (main request) or as amended on the basis of one of the set of claims filed as auxiliary requests 1 and 2 with the grounds of appeal (letter of 14 May 2012) or on the basis of the set of claims filed as auxiliary request 3 during the oral proceedings before the Board.

XII. Claims of the appellant's requests

a) Claim 1 - Main request

Independent claim 1 as granted reads as follows:

"1. A method for manufacturing a breathable shoe consisting of the steps of forming a membrane-including unitary upper assembly (10; 310; 11; 311) comprising a

breathable upper, and at least one membrane (14; 314) made of a material which is waterproof and breathable, a first step consisting of directly attaching said breathable upper to said membrane in a downward region, said assembly wrapping around the foot insertion region and further comprising a protective element (17; 317) made of a material which is resistant to hydrolysis, water-repellent, breathable or perforated, and a second step consisting of mutually attaching said unitary assembly to a sole (16; 216; 316) made of perforated elastomer, such mutually attaching occurring by joining through a perimetrical seal said article of manufacture to said sole, said protective element being arranged below said at least one membrane (14; 314) in a region between the upper part of said sole (16; 216; 316) and its internal part which is adjacent to the ground contact surface."

b) Claim 1 - Auxiliary request 1

Claim 1 differs from claim 1 of the main request in that it comprises the additional limitation that the protective element is "protecting the membrane against external impacts or foreign objects which might penetrate through the perforations provided in the sole".

c) Claim 1 - Auxiliary request 2

Claim 1 differs from claim 1 of auxiliary request 1 in that it comprises the additional limitations that - the (second) step of mutually attaching the unitary assembly to the sole occurs "in order to allow to form a seal of the membrane with the sole"; and

- "the edge of the protective element lies inside the edge of the membrane or the protective element is thinned at its edge".

d) Claim 1 - Auxiliary request 3

Claim 1 differs from claim 1 of auxiliary request 2 by the additional limitation that the protective element is thinned at its edge "if it has the same perimeter as the membrane".

XIII. The arguments of the appellant, and those of the opponent before the withdrawal of the opposition, insofar as relevant for the present decision, can be summarised as follows:

a) Main request - Novelty

Arguments of the opponent:

The opposition division decided that E0 fails to disclose the following feature of claim 1

- i) the step of "directly attaching said breathable upper to said membrane in a downward region".

This decision is incorrect. In the Strobel-stitched construction of E0 where the insole 2 is joined to the non-lasted upper 1 by stitching instead of cementing, the honeycomb 8 extends all the way to the side wall of the outsole 4 (page 9, lines 20 and 25). It is implicit that the membrane, which must be as large or larger than the honeycomb to guarantee waterproofness (page 4, lines 9 and 10 and figures 2 and 5), then overlaps the Strobel seam and directly contacts the folded edges of the upper. This inevitably anticipates feature (i).

Appellant's case:

As ruled by the opposition division, feature (i) cannot be derived from the disclosure of the Strobel-stitched construction in E0. In fact, E0 is silent with respect to the position of the Strobel seam relative to the membrane. E0 only teaches that the membrane is fixed to the insole by means of a glue, which is applied to the border area of the membrane (claim 5).

In addition, E0 does not disclose the following features of claim 1:

- ii) the feature of the unitary upper assembly "comprising a protective element made of a material which is resistant to hydrolysis, water-repellent, breathable or perforated"; and
- iii) the step of mutually attaching the unitary upper assembly to the sole "by joining through a perimetrical seal said article of manufacture to said sole".

In the light of paragraphs 38 and 55 of the patent specification, feature (ii) must be read in the sense that the protective element protects the membrane under any circumstances of the normal use of the shoe, i.e. from external impacts as well as from foreign objects which might penetrate through the perforations provided in the sole. In addition, the wording of feature (ii) clearly implies that the protective element is made of a material which is "resistant to hydrolysis" and is "water-repellent" and is "breathable" or "perforated"; these four properties cannot be read as alternatives as this would run contrary to the proper functioning of the shoe. The honeycomb 8 shown in figure 2 of E0 does not fulfill all these requirements. It has a pumping function to enhance ventilation (page 4, lines 28 to 34)



but it has no protective function. The membrane 3 is protected only by the sole 4 and, where present, the nail shield 24 (page 4, line 34 to page 5, line 2). The honeycomb 8 is a felt having an open, loose structure which can protect the membrane neither from external impacts nor from foreign objects penetrating through the air vents 9. Moreover, the felt-like honeycomb 8 is designed to be used in dry conditions because it requires a long time to dry when it gets wet (page 4, lines 18 and 19 and page 5, lines 4 to 6). Hence, it is neither hydrolysis-resistant nor water-repellent.

It follows from paragraphs 18, 31 and 41 of the patent specification that feature (iii) must be understood in the sense that the sole is joined to the membrane through a perimetrical seal against the penetration of external moisture and water. Even though E0 mentions a tight joint between the upper and the outsole, this joint does not constitute a waterproof seal, let alone a perimetrical seal between outsole and membrane. The shoe shown in figure 2 of E0 is not waterproof: it is basically worn in dry conditions; should it be worn in humid conditions, water could freely enter the outsole 4 through the air vents 9, by-pass the honeycomb 8 and the membrane 3 and wick through the insole 2 into the interior of the shoe.

b) Main request - Inventive step

Appellant's case:

Contrary to the opposition division's view, the subject-matter of claim 1 involves an inventive step when starting from the Strobel-stitched construction disclosed in E0.

The distinguishing step of "directly attaching said breathable upper to said membrane in a downward region" allows maximising the size of the membrane and thus the breathability of the shoe.

For a skilled person seeking to improve breathability of the Strobel-stitched shoe of E0, there is no obvious hint towards the claimed solution. The skilled person would rather consider attaching the membrane to the insole by spot-gluing and/or by using a breathable glue. The skilled person would not extend the folded edges of the upper towards the membrane because the material of the upper is more expensive and less breathable than that of the insole; this solution would inevitably decrease the breathability of the shoe instead of increasing it. The skilled person has no motivation to extend the membrane towards the folded edges; such a modification would not improve breathability because the insole 2 comprises perforations 5 only in its center area. At any rate, there exists an infinite number of possible positions for the edge of the membrane relative to the Strobel seam, where the membrane would not contact the upper and thus could not be directly attached to it.

Arguments of the opponent:

If the Board were to decide that the Strobel-stitched construction of E0 fails to disclose feature (i), this feature would be an obvious modification for the reasons given by the opposition division. Thus, claim 1 would lack an inventive step over E0.

c) Auxiliary request 1 - Novelty and inventive step

Appellant's case:

The added feature that the protective element is "protecting the membrane from external impacts or foreign objects which might penetrate through the perforations provided in the sole" must be read in the sense that the protective element protects the membrane from external impacts as well as from foreign objects under any normal circumstances. This feature is not disclosed in E0. In particular, even though honeycomb 8 is slightly compressible, it has a very open, loose structure and it is thus not capable of protecting the membrane 3 under all normal circumstances. The claimed subject-matter is novel and inventive for the reasons set out in connection with the main request.

Arguments of the opponent:

The honeycomb 8 of E0 would function to some extent to protect membrane 3 against external impacts and/or foreign objects. The subject-matter of claim 1 is either not novel or not inventive in the light of E0, for the reasons given with respect of the main request.

d) Auxiliary request 2 - Article 123 (2) EPC

Arguments of the opponent:

In claim 1 the appellant has introduced the feature that "the protective element is thinned at its edge". This feature was originally disclosed only in combination with the further features that the protective element has the same perimeter as the membrane and that its edge is thinned so that a sealing adhesive can penetrate

between the membrane and the outsole (see e.g. claim 13). Since these further features have not been incorporated in claim 1, this amendment is an intermediate generalisation that contravenes Article 123 (2) EPC.

Appellant's case:

The amendments made to claim 1 are supported by the teaching in paragraphs 36, 37, 53 and 54 of the patent specification and they thus meet the requirements of Article 123 (2) EPC.

e) Auxiliary request 3 - Admissibility

Appellant's case:

To meet the objection raised under Article 123(2) EPC against claim 1 of auxiliary request 2, claim 1 is further amended to require that the protective element is thinned at its edge "if it has the same perimeter as the membrane". There is no need to incorporate the further feature that the edge is thinned so that a sealing adhesive can penetrate between the membrane and the outsole, because this feature is only a functional feature.

The additional features compared to claim 1 of auxiliary request 1 are not disclosed in E0 and they render the claimed subject-matter even more inventive. Firstly, it is not inevitable in E0 that the membrane is waterproof sealed with the outsole when the latter is formed by direct injection moulding. Secondly, E0 discloses neither that the edge of the protective element "lies inside the edge of the membrane" nor that it is "thinned". Quite the opposite, E0 requires that the

honeycomb 8 has the same size and shape as the membrane 3 (page 4, lines 9 and 10).

Hence, claim 1 overcomes all outstanding objections and does not introduce any new objection.

### **Reasons for the Decision**

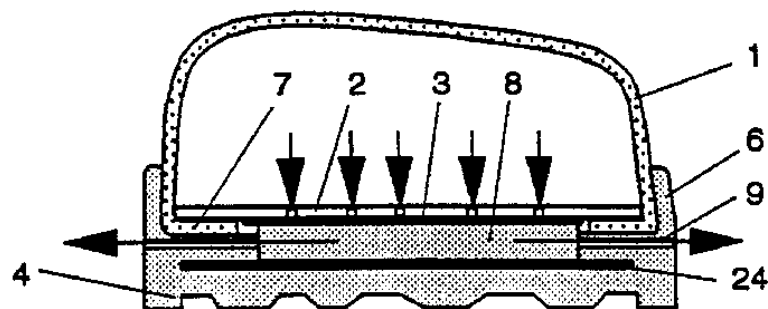
1. Withdrawal of the opposition means that the opponent ceases to be party to the proceedings in respect of the substantive issues. In the context of the patent proprietor's appeal, however, the Board can take into account the facts, arguments and evidence submitted by the opponent prior to the withdrawal of the opposition, when examining the correctness of the decision under appeal (see also Case Law of the Boards of Appeal of the EPO, 2013, IV.C.4.1.2 and IV.E.3.4.1).
  
2. Main request - Novelty
  - 2.1 In the terms of claim 1, E0 discloses a method for manufacturing a breathable shoe (Figure 2, depicting an embodiment of the shoe, is reproduced below), consisting of the following steps:
    - forming an unitary upper assembly comprising a breathable upper (1), a breathable insole (2) and, when waterproofness is required, a waterproof and vapour-permeable membrane (3) preferably made of Gore-Tex®;
    - joining together the upper, the insole and the membrane to form a unitary assembly (page 7, lines 4 to 8), which wraps around the foot insertion region and further comprises a honeycomb (8), and
    - mutually attaching this unitary assembly to a sole (4) made of perforated elastomer (see horizontal air vents 9), the honeycomb being arranged below

the membrane in a region between the upper part of the sole and its internal part which is adjacent to the ground contact surface (page 6, line 32 to page 8, line 18).

The sole is either separately injection-moulded and subsequently glued to the lasted upper assembly, or alternatively is formed on it by direct injection moulding in an injection mould (page 6, line 32 to page 7, line 2; page 7, line 21 to page 8, line 10 with figure 12).

When the shoe is worn, moisture generated within the shoe is discharged through the insole, the membrane and the honeycomb into the air vents in the outsole and from there on to the outside atmosphere.

**Fig. 2**



2.2 E0 discloses two alternative ways of joining the upper to the insole: a cement-lasted construction and a Strobel-stitched construction. These two constructions have to be dealt with separately.

2.2.1 Cement-lasted construction

In figures 1 to 3 the insole 2 is fastened under the lasted upper 1 as follows: the upper 1 is fitted on a

last; the edges 7 of the upper are folded underneath the insole 2 and fastened to it (page 7, lines 4 to 6).

### 2.2.2 Strobel-stitched construction

E0 discloses in page 9, lines 22 to 25, an alternative construction, which differs from the cement-lasted construction in that the insole is attached to the non-lasted upper by stitching. The Board shares the view of the opposition division, the opponent and the appellant that this alternative construction is a commonly known Strobel-stitched construction, where the upper and the insole are stitched edge to edge, i.e. in a butt joint, around the perimeter of the insole, to make a bag, which is later stretched over a last to obtain a lasted upper assembly.

It is implicit that, when waterproofness is required, the honeycomb is also covered with a waterproof and vapour-permeable membrane as shown in figures 1 to 3.

### 2.3 The opposition division decided that E0 fails to disclose

- i) the step of "directly attaching said breathable upper to said membrane in a downward region".

The Board shares this view for the following reasons.

#### 2.3.1 Cement-lasted construction

The membrane 3 is located underneath the insole 2, within the perimeter defined by the folded edges 7 of the upper. It is shown in figure 2 that a gap exists between the membrane and the folded edges. Even if the membrane were to contact or abut the folded edges, there

is no hint that the membrane would indeed be attached, glued or stitched to them.

### 2.3.2 Strobel-stitched construction

For this construction, E0 teaches that the honeycomb can extend all the way to the side wall of the outsole (page 9, lines 22 and 23). It is clear that this "side wall of the outsole" cannot be the outer band 6 of the outsole 4 shown in figure 2, because it is mandatory in E0 that the side edges of the honeycomb interface with the horizontal air vents formed in the outsole. The Board insofar shares the opponent's view that, for waterproofness to be effectively achieved, the membrane must cover the entire upper surface of the honeycomb. However, it is not inevitable that the membrane would then overlap the Strobel seam, still less that it would be directly attached to the edges of the upper. In fact, E0 is silent with respect to the position of the Strobel seam with respect to the edge of the membrane.

### 2.4 The appellant contends that the following features further distinguish claim 1 from E0:

- ii) the feature of the unitary upper assembly "comprising a protective element made of a material which is resistant to hydrolysis, water-repellent, breathable or perforated"; and
- iii) the step of mutually attaching the unitary upper assembly to the sole "by joining through a perimetrical seal said article of manufacture to said sole".

The Board is not persuaded for the following reasons.



#### 2.4.1 "Protective element"

A claim should clearly define on its own the subject-matter for which protection is sought (Article 84 EPC). In the context of claim 1, feature (ii) itself is clear; in view of the disjunctive "or" and in the absence of any other specific indication, it can only be given the meaning that the protective element is made of a material that shows one or more of the listed properties "resistant to hydrolysis", "water-repellent", "breathable" and "perforated". This broad interpretation of feature (ii) is technically sound in the context of the claim. In particular, the protective element does not have to be hydrolysis-resistant, water-repellent as well as breathable/perforated for the manufactured shoe to be breathable; the required breathability may be achieved by virtue of the upper and the membrane being breathable, as required in claim 1. Since the claim itself imparts a clear and technically sound teaching to the skilled reader, there is no reason for consulting the description and the drawings of the patent to give feature (ii) a narrower meaning.

The honeycomb 8 of E0 anticipates feature (ii) when read in this broad manner. Firstly, it is slightly compressed with each downward pressure of foot step and it resumes its original shape subsequently as the foot is lifted (page 4, lines 31 to 33). Thus, the honeycomb 8 would function to protect membrane 3 against external impacts and/or foreign objects to some extent. Secondly, the honeycomb 8 is made of a breathable material (page 9, lines 15 and 16).

Be that as it may, even if feature (ii) were to be read in the narrow manner submitted by the appellant, it could not distinguish the invention from E0. The shoe

with the honeycomb 8 is "basically worn in dry conditions" (page 5, line 4) but it is certainly adapted to be used in humid or wet conditions: in such conditions, waterproofness is guaranteed by the membrane 3. Since honeycomb 8 can get wet and can dry (page 5, lines 5 and 6), it is implicitly hydrolysis-resistant. It may not be water-repellent in the sense of hydrophobic, but it is certainly water-repellent in the broader sense that it allows the passage of water and is capable of drying, albeit after some time. In addition, the honeycomb 8 of E0 is preferably a felt made of synthetic fibres (page 4, lines 16 and 17) and such fibres are inherently relatively hydrolysis-resistant as well as water-repellent. In fact, even if feature (ii) defines the protective element as being made from a water-repellent material, the element itself does not have to be water-repellent. Finally, a felt of synthetic fibres is a particular type of non-woven fabric and the patent itself teaches that the protective element according to the invention is preferably a "nonwoven fabric" (paragraph 34 of the patent specification).

#### 2.4.2 "Perimetrical seal"

In feature (iii) of claim 1, the term "article of manufacture" implicitly refers to the unitary upper assembly resulting from the first step as defined in claim 1 (see also T 1599/08, point 2 of the reasons).

A skilled reader of feature (iii) in the context of claim 1 would understand that the unitary upper assembly must be joined to the outsole in such a manner that, all the way around the assembly, the joint prevents water from entering through it and wicking into the interior of the shoe. This understanding is technically sensible in the context of claim 1. The description and the

drawings of the patent cannot be relied on to read into this feature the further limitation that the sole must be sealed perimetrically with respect to the membrane, as contended by the appellant.

In E0, the outsole is either glued to the lasted upper assembly or directly injection-moulded onto it. It is inevitable that, in either case, a seal is obtained between the unitary upper assembly and the outsole all the way around them. Firstly, E0 insists that the shoe "should have resistant and extremely tight joints so as to prevent caustic or any other harmful substances from penetrating in-between the sole and the upper, and from there to the inside of the shoe" (page 2, lines 25 to 29). Secondly, E0 teaches that the direct injection moulding technique yields "a tighter joint between the upper and the side wall of the shoe than does the glueing (sic) method", whereby "a tight joint is vital especially in working and safety shoes" (page 6, line to page 7, line 2). Thirdly, E0 mentions that the outer band 6 of the outsole 4 is adhered to the upper 1 (page 4, line 1). Fourthly, E0 refers to the material injected into the injection mould as being a "sealing compound" (page 8, lines 21 and 22).

2.5 In conclusion, the subject-matter of claim 1 differs from E0 only by the step of "directly attaching said breathable upper to said membrane in a downward region". Hence, it is novel.

3. Main request - Inventive step

3.1 The opposition division considered that the Strobel-stitched construction disclosed in E0 forms a relevant starting point for the assessment of inventive step. The Board shares this view.

- 3.2 As already explained under point 2.3.2 above, it cannot be derived from E0 that, in the Strobel-stitched construction, the membrane overlaps the Strobel seam and contacts the folded edges of the upper, let alone that it is directly attached to them.
- 3.3 It is apparent that the additional step of "directly attaching" the membrane to the upper allows a further improvement in the breathability of the shoe. Indeed, when the insole of E0 is perforated over its entire surface (see page 6, line 4 of E0) and the membrane is attached only to the edges of the upper, the insole can be kept free of glue and then the breathability of its entire surface can come into effect.
- 3.4 The objective technical problem can thus be formulated as how to improve further the breathability of a shoe with the Strobel-stitched construction disclosed in E0.
- 3.5 The skilled person knows that, when perforated parts of the insole are covered with glue, they are no longer vapor-permeable (see e.g. page 2, lines 9 and 10 of E0). Therefore, when seeking to solve the problem defined above, it would be an obvious design option for him to extend the membrane beyond the Strobel seam and directly attach by gluing the periphery of the membrane to the folded edges of the upper, instead of gluing the membrane to the insole. He would have no practical difficulties in cutting the membrane to size and gluing it directly to the edges of the upper.
- 3.6 The appellant argued that other possible solutions exist, apart from a direct attachment of the membrane to the upper, such as gluing the membrane to the insole by spot-gluing and/or by means of a breathable glue.

However, the claimed solution is clearly the technically favourable solution because it allows the insole to be kept fully breathable and, in addition, the Strobel seam to be waterproofed.

- 3.7 Hence, the Board agrees with the opposition division that the subject-matter of claim 1 lacks an inventive step in the sense of Article 56 EPC 1973 when starting from E0.
4. In conclusion, one of the cited grounds for opposition according to Article 100(a) EPC 1973, namely that of lack of inventive step, prejudices the maintenance of the patent as granted.
5. Auxiliary request 1 - Inventive step
  - 5.1 Claim 1 differs from claim 1 as granted only in that it includes the additional feature that the protective element is "protecting the membrane from external impacts or foreign objects which might penetrate through the perforations provided in the sole".
  - 5.2 This additional feature cannot distinguish claim 1 from E0. The terms "external impacts" and "foreign objects" are undefined. Since the honeycomb 8 is a somewhat compressible layer, it would inevitably protect membrane 3 against external impacts and/or foreign objects to some extent, and thus it forms a protective element in the broad sense of claim 1.
  - 5.3 The claimed subject-matter thus lacks an inventive step for the reasons set out above for the main request.

6. Auxiliary request 2 - Article 123(2) EPC
- 6.1 Claim 1 differs from claim 1 of auxiliary request 1 in that it includes the additional features
  - that the (second) step of mutually attaching the unitary assembly to the sole occurs "in order to allow to form a seal of the membrane with the sole" and
  - that "the edge of the protective element lies inside the edge of the membrane or the protective element is thinned at its edge".
- 6.2 In the application documents as originally filed, the feature that "the protective element is thinned at its edge" has been disclosed only in combination with the further features that the protective element has the same perimeter as the membrane and that its edge is thinned in such a manner that a sealing adhesive can penetrate between the membrane and the outsole (see claim 13; page 5, lines 16 to 19; page 7, line 29 to page 8, line 2; page 10, line 3 to 6). It is clear for a skilled reader that these further features mutually interact to seal perimetrically the membrane to the outsole.
- 6.2.1 Consequently, the feature "the protective element is thinned at its edge" is only disclosed in combination with further essential features, and its introduction into the claim in isolation amounts to a generalisation which is not originally disclosed and which therefore does not meet the requirements of Article 123(2) EPC.
7. In conclusion, neither claim 1 of auxiliary request 1 nor claim 1 of auxiliary request 2 meets the requirements of the EPC.

8. Auxiliary request 3 - Admissibility

8.1 Under Article 13(3) RPBA, amendments made after oral proceedings have been arranged are not admitted if they raise issues which the Board or the other party or parties cannot reasonably be expected to address without an adjournment of the oral proceedings. In addition, it is established case law that amended claims belatedly filed at such a stage, in particular during oral proceedings, must be clearly allowable in order to be admitted into the proceedings.

8.2 The appellant filed auxiliary request 3 during the oral proceedings before the Board, in reaction to an objection under Article 123(2) EPC against auxiliary request 2, which had already been raised by the opponent in a submission dated 28 September 2012. Under these circumstances, the filing of this request was belated.

8.3 Claim 1 apparently still does not meet the objection raised under Article 123 (2) EPC against auxiliary request 2 (see point 6.2 above), because it lacks the further feature that, when the edge of the protective element is thinned, it is thinned in such a manner that a sealing adhesive can penetrate between the membrane and the outsole. This functional feature defines the extent to which the edge must be thinned. The omission of this feature appears to be not supported by the teaching in the application as filed.

8.4 Further, claim 1 still appears to lack an inventive step in view of E0, as was submitted by the opponent. The added feature that "the edge of the protective element lies inside the edge of the membrane" cannot distinguish the claimed invention from E0 because figure 2 shows that the membrane 3 overhangs the honeycomb 8.

8.5 Since amended claim 1 does not *prima facie* meet the requirements of Article 123(2) EPC and Article 56 EPC 1973, the Board decided not to admit auxiliary request 3 into the proceedings.

## Order

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

The appeal is dismissed.

The Registrar:

The Chairman:



G. Rauh

G. Ashley

Decision electronically authenticated