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**Datasheet for the decision
of 21 January 2019**

Case Number: T 1244/16 - 3.2.03

Application Number: 10002574.1

Publication Number: 2204146

IPC: A43B1/00, A43B7/14, A43B13/14,
A43B13/16, A43B13/18

Language of the proceedings: EN

Title of invention:
Footwear orthosis

Patent Proprietor:
Salvatelli S.r.l.

Opponent:
Extro Style Di Silvia Abbati

Headword:

Relevant legal provisions:
EPC Art. 123(2), 54, 56, 84

Keyword:

Novelty - main request - (no) - auxiliary request 1 - (no)
Claims - auxiliary request 2 - clarity after amendment (no)
Amendments - auxiliary request 3 - added subject-matter (yes)
- auxiliary request 4 - added subject-matter (yes) - auxiliary
request 5 - added subject-matter (no)
Inventive step - non-obvious solution

Decisions cited:

T 0748/91

Catchword:



Beschwerdekammern
Boards of Appeal
Chambres de recours

Boards of Appeal of the
European Patent Office
Richard-Reitzner-Allee 8
85540 Haar
GERMANY
Tel. +49 (0)89 2399-0
Fax +49 (0)89 2399-4465

Case Number: T 1244/16 - 3.2.03

D E C I S I O N
of Technical Board of Appeal 3.2.03
of 21 January 2019

Appellant: Salvatelli S.r.l.
(Patent Proprietor) Via Monte Amiata, 3
63014 Montegranaro (Ascoli Piceno) (IT)

Representative: Cutropia, Gianluigi
Ing. Claudio Baldi s.r.l.
Viale Cavallotti, 13
60035 Jesi (AN) (IT)

Respondent: Extro Style Di Silvia Abbati
(Opponent) Via Maccantone snc
06025 Nocera Umbra (PG) (IT)

Representative: Marietti, Andrea
Marietti, Gislone e Trupiano S.r.l.
Via Larga, 16
20122 Milano (IT)

Decision under appeal: **Interlocutory decision of the Opposition**
Division of the European Patent Office posted on
8 March 2016 concerning maintenance of the
European Patent No. 2204146 in amended form.

Composition of the Board:

Chairman C. Donnelly
Members: B. Miller
G. Weiss

Summary of Facts and Submissions

- I. European patent No. 2 204 146 relates to a footwear orthosis.

- II. An opposition was filed against the patent, based on the grounds of Article 100(c) EPC and of Article 100(a) EPC together with both Articles 54 and 56 EPC. In the interlocutory decision the opposition division found that the contested patent met the requirements of the EPC, on the basis of the claims of the auxiliary request 3 submitted during the oral proceedings on 15 February 2016.

This decision was appealed by the patent proprietor (the "appellant").

- III. 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 to the parties its preliminary opinion of the case.

- IV. Both parties indicated in their letters dated 20 November 2018 and 12 December 2018 that they would not attend the oral proceedings scheduled on 21 January 2019 and that they intended to continue the proceedings in writing.

- V. With letters dated 3 December 2018 and 21 December 2018 respectively both parties submitted further arguments focusing in particular on the subject-matter of auxiliary request 5.

VI. Oral proceedings were held on 21 January 2019 in the absence of both parties (Rule 115(2) EPC and Article 15(3) RPBA).

VII. At the end of the oral proceedings, the following requests from the written proceedings were confirmed.

The appellant requested in writing that the decision under appeal be set aside and that the patent be maintained as granted or, alternatively, in amended form on the basis of one of the four auxiliary requests submitted with the statement setting out the grounds of appeal or on the basis of auxiliary request 5 as submitted with said letter dated 3 December 2018.

The respondent (the opponent) requested that the appeal be dismissed.

VIII. Claim 1 according to the main request (claims as granted) reads as follows:

- "A footwear orthosis (1) including
- sole member (2) comprising an inner surface (5) and a tread surface (3) which comprises an intermediate flat portion (3c), an outwardly convex front portion (3a) and an outwardly convex rear portion (3b), whereby said tread surface (3) can roll on the ground between a touch down position in which said rear portion (3b) comes into contact with the ground through out said intermediate portion (3c), and a take off position at said front convex portion (3a),
 - a partially open upper member (4) designed to be anchored to said sole member and arranged removably to secure a user's foot thereto,
 - a relatively rigid intermediate insole reinforcing

- member (7) located on said inner surface (5) of the sole member, and
- an insole (10) made of cushioning material located on said intermediate insole reinforcing member (7), characterized in that the sole is an ambidextrous sole and in that said intermediate insole reinforcing member (7) has an upper flat and planar surface."

Claims 2 to 5 of the main request relate to preferred embodiments of the footwear orthosis according to claim 1.

Claim 1 of auxiliary request 1 corresponds to claim 1 of the main request wherein the intended use of the orthosis is further defined as follows:

"A footwear orthosis (1) for a user having problems with his foot, following a surgical operation or owing to a foot disease, such as diabetic ulcers, said footwear orthosis (1) including: ...".

Claim 1 of auxiliary request 2 corresponds to claim 1 of auxiliary request 1, wherein the following feature is added:

"wherein the rear portion (3b) has a relatively large radius of curvature, so that during walking the user lower the footwear orthosis at rear portion (3b) which makes it possible for the sole to effect a soft progressive rolling in the forward direction with no abrupt stress being transmitted to the user's foot".

Claim 1 of auxiliary request 3 corresponds to claim 1 of auxiliary request 2, wherein the following feature is added:

"wherein the length of said intermediate flat portion (3c) is shorter than the length of said outwardly convex rear portion (3b)".

Claim 1 of auxiliary request 4 corresponds to claim 1 of auxiliary request 3, wherein the following feature is added:

"and the length of said intermediate flat portion (3c) is about 1/10 the total length of the sole member (2)".

Claim 1 of auxiliary request 5 corresponds to claim 1 of the main request wherein the following feature is added:

"wherein said insole (10) comprises at least two portions (10a, 10b, 10c), each portion having at least an edge with protuberances and cavities so that said portions can be removably connected together in a puzzle-like manner, said portions (10a, 10b, 10c) of the insole being made of different materials, thereby obtaining an insole (10) having mechanical characteristics changing from its rear to its front portion."

IX. State of the art

The following document cited already during the opposition proceedings was also cited in appeal proceedings:

D12: US 4 572 169.

The following documents were cited for the first time in the appeal proceedings:

by the appellant:

B1: affidavit of professor Michael Pinzur;

B2: curriculum vitae of professor Michael Pinzur;

by the respondent:

D13: US 4 557 060.

X. Submissions of the parties

(a) The appellant's arguments, as far as relevant for this decision, can be summarised as follows.

The removeable ankle brace disclosed in D12 was not a "footwear orthosis" and did not comprise a thread surface which "can roll on the ground between a touch down position in the which the rear portion (3b) comes into contact with the ground throughout said intermediate portion, and a take off position at said front convex portion."

Therefore, claim 1 of the main request was novel.

The subject-matter of claim 1 of each of auxiliary requests 1 to 5 was further limited by the specific use of the orthosis and by further features defining the shape of its sole.

The features added to claim 1 as granted were either disclosed in the description of the application as filed or directly and unambiguously derivable from the figures of the application as filed.

None of the added features was disclosed in D12.

The skilled person would not combine the teachings of D12 and D13 in an obvious manner.

(b) The respondent's arguments can be summarised as follows.

The ankle brace disclosed in D12 was suitable as a footwear orthosis as defined in claim 1 of the main request. Moreover, the rolling functionality defined in claim 1 referred to a desired result which was achieved inherently by the ankle brace of D12.

None of auxiliary requests 1 to 5 should be allowed into the proceedings, since it was not the purpose of appeal proceedings to consider new claims and therefore a new case.

The features added to claim 1 as granted concerning the shape of the insole defined in claim 1 of each of auxiliary requests 3 and 4 were not directly and unambiguously derivable from the figures or the description of the application as filed.

The addition of the term "cavities and proturbances" into the wording of claim 1 according to auxiliary request 5 generated a new teaching, which was not derivable from the application as filed.

The use of an insole made from separate parts was known from D13. It was obvious to use the insole known from D13 comprising portions having different mechanical properties in a footwear orthosis disclosed in D12.

Reasons for the Decision

1. Main request - Article 100(a) EPC, Novelty

1.1 D12 discloses a lower leg brace (10) which is illustrated in detail in figures 2 to 5.

figure 2 of D12

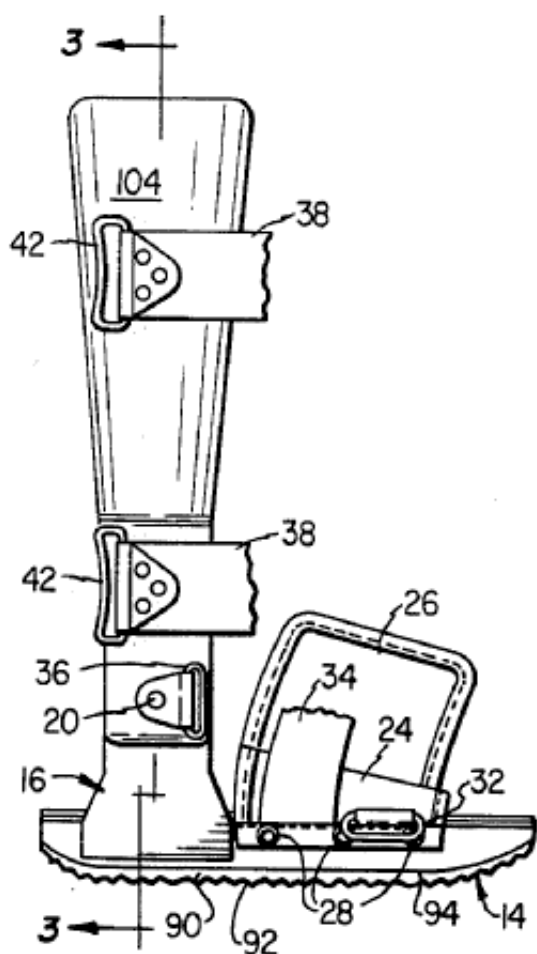
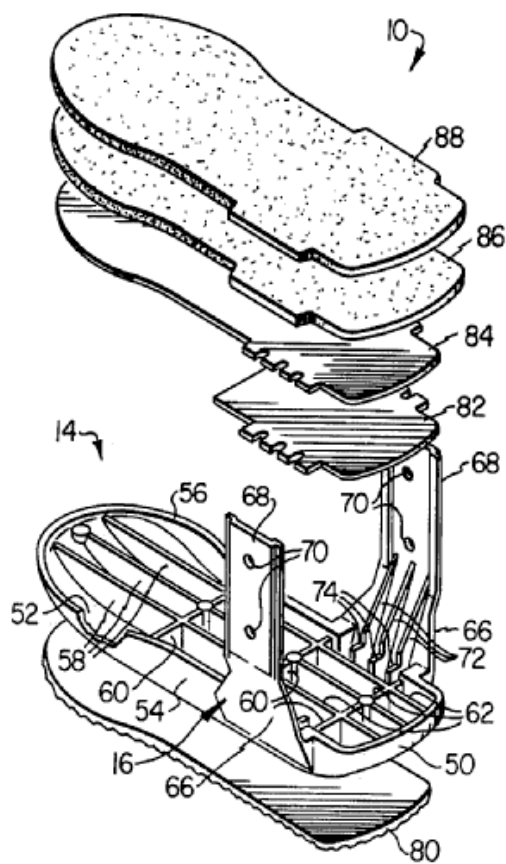


figure 4 of D12



The ankle brace shown in the figures comprises in detail:

- a sole member (50, 80) comprising an inner surface (figures 3 and 4) and a tread (80;

column 4, lines 2 to 5) which comprises an intermediate flat portion (figure 2), an outwardly convex front portion (figure 2) and an outwardly convex rear portion (figure 2).

- a partially open upper member (12, 18, 108) designed to be anchored to said sole member, see e.g. securing means 20 (column 4, lines 43 to 55), and arranged removably to secure a user's foot thereto (column 2, lines 57 to 68),
- a rigid intermediate insole reinforcing member (82, 84; column 4, lines 6 to 19) located on said inner surface (figure 4) of the sole member (50, 80), and
- an insole (86, 88) made of foam material (column 4, lines 20 to 24), which is a cushioning material, located on said intermediate insole reinforcing member (figure 4).

The sole is axially symmetrical (see figures 2 to 4) and therefore an ambidextrous sole. The intermediate insole reinforcing member (82, 84) has an upper flat and planar surface (figure 4; column 4, lines 6 to 19).

1.2 The appellant argues that D12 does not disclose

a) a "footwear orthosis"

and

b) a thread (sic) surface which "can roll on the ground between a touch down position in which the rear portion (3b) comes into contact with the ground throughout said intermediate portion, and a take off position at said front convex portion."

1.3 However, the Board does not agree with this argument for the following reasons.

1.3.1 concerning feature a)

According to established case law the purpose of a device is only limiting in as far as the device has to be suitable for the purpose (Case Law of the Boards of Appeal, 8th edition, 2016, Chapter I.C.8.1.5).

According to paragraph [0001] of the contested patent a footwear orthosis is intended for a patient having problems with his foot after a surgical operation or owing to a foot disease. The ankle brace according to D12 may be particularly suitable for tibial fractures since it is provided with extensions (68) secured to side plates of the shoe (see figure 2). However, it is still a footwear which guides, immobilizes and controls a joint or body segment of the the human body and is therefore an orthosis which can be worn by a patient having problems with his foot after a surgical operation or owing to a foot disease.

This analysis is also not put in question by the affidavit B1, which explains on page 1, points 1 to 8 that in case of tibia fractures the orthopaedic shoe has to provide stability during walking and needs a sufficiently long flat and planar portion.

The patients wearing the brace disclosed in D12 may belong to a different group than targeted by the contested patent. However, claim 1 fails to define any technical feature which makes this distinction with respect to the ankle brace disclosed in D12.

1.3.2 concerning feature b)

The term "rolling" has to be interpreted in the context of a shoe sole, which does not have a perfectly round shape such as a ball or wheel.

Any shoe having a convex front and rear portion in combination with a flat intermediate portion enables the person wearing the shoe to make a rolling movement.

The dimensions of the flat portion might have an impact on the stability provided by the shoe during standing and on the ease and smoothness of the rolling movement, as confirmed also by the affidavit B1 on page 1, points 5 to 7. However, claim 1 of the main request merely defines the presence of convex and flat portions without indicating their dimensions or their size relationship.

Therefore, the claimed functionality of supporting a rolling movement does not distinguish the claimed footwear from the shoe described in D12, since during the use of the shoe described in D12 a certain degree of rolling can undoubtedly be achieved, in particular by persons wearing the brace who are in the later stages of recovery from a fractured tibia.

1.4 In summary, the Board concludes that the footwear orthosis as defined in claim 1 cannot be distinguished from the ankle brace disclosed in D12. Hence, the subject-matter of claim 1 as granted is not new.

2. Admissibility of auxiliary requests 1 to 5

2.1 The subject-matter of these requests was not submitted in the opposition proceedings, but presented for the first time with the statement setting out the grounds of appeal. The respondent challenged their admissibility on the basis of Article 12(4) RPBA.

Under Article 12(4) RPBA, the boards have discretion to refuse to admit requests which could have been presented in the opposition proceedings.

2.2 Auxiliary requests 1 to 4 as filed by the appellant do not create a new case, but limit claim 1 by the intended use and the functionality of the shoe which inherently formed the basis of discussion during opposition proceedings.

No unfair behaviour or abuse of the proceedings or any other specific reason is apparent to the Board which would warrant the exclusion of auxiliary requests 1 to 4 from the proceedings pursuant to Article 12(4) RPBA (Case Law of the Boards of Appeal, 2016, 8th edition, Chapter IV.E. 4.1.4 and 4.3.1).

Auxiliary request 5 is essentially based on auxiliary request 2 refused in the impugned decision but in which the term "puzzle-like" has been further clarified and additional features have been added to address the reasoning presented in the contested decision.

Therefore, the Board sees no reason not to take the auxiliary requests into consideration.

3. Auxiliary request 1 - Article 54 EPC

- 3.1 Compared to claim 1 of the main request claim 1 of auxiliary request 1 additionally defines the intended use of the footwear orthosis.

Since neither the surgical operation nor the foot disease is defined in claim 1, no inherent restrictions are generated by the indicated purpose with regard to the shape and the required functionality of the footwear orthosis.

As already discussed above in point 1.3.1, no reason can be identified why the shoe described in D12 is not suitable as a footwear orthosis for a person having foot problems after a surgical operation or owing to a foot disease.

Therefore, the subject-matter of claim 1 of auxiliary request 1 lacks novelty for the same reasons as claim 1 of the main request.

4. Auxiliary request 2 - Article 84 EPC

Compared to claim 1 as granted claim 1 of auxiliary request 2 has been amended by adding expressions such as "relatively large radius" and "soft progressive rolling". Since the features were taken from the description, their clarity can be examined in the present case.

The expressions "relatively large radius" and "soft progressive rolling" are relative terms which do not have a well defined meaning.

The softness of a progressive rolling during walking depends not only on the shape of the sole but also on its flexibility and the way of walking. Furthermore, the evaluation whether a rolling motion is soft or not depends on the sensitivity and perception of the user and their medical condition.

Hence, it is unclear which radius is sufficiently large to achieve rolling which is considered "soft" and progressive enough.

The wording of claim 1 of auxiliary request 2 therefore does not fulfil the requirements of Article 84 EPC.

5. Auxiliary request 3 - Article 123(2) EPC

5.1 Claim 1 is based on claim 1 as filed in combination with claims 2 and 3 and several passages in the description as filed:

page 1: lines 2 to 4 and 11 to 12,
page 4: lines 4 and 25 to 27,
page 5: lines 15 to 19,
page 6: lines 18 to 19.

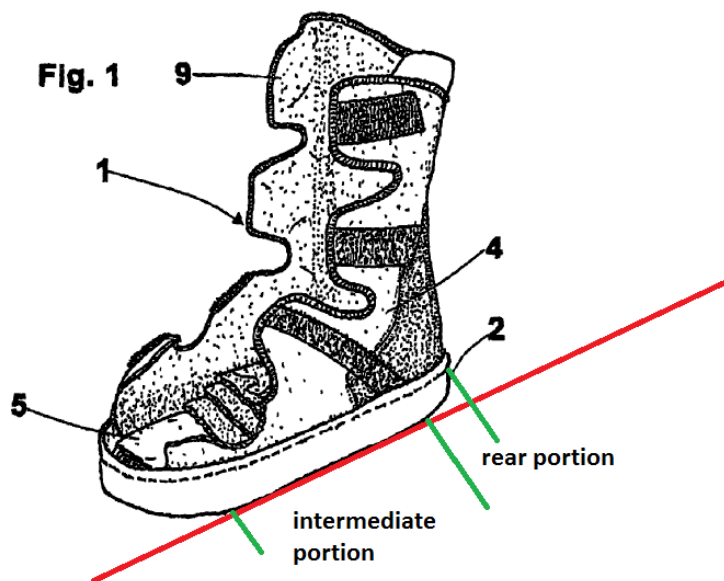
However, the expression "the length of the intermediate flat portion is shorter than the length of the rear portion" introduced into the wording of claim 1 is not explicitly specified in the application as filed.

5.2 The appellant argues that this feature is directly derivable from figure 2 of the application.

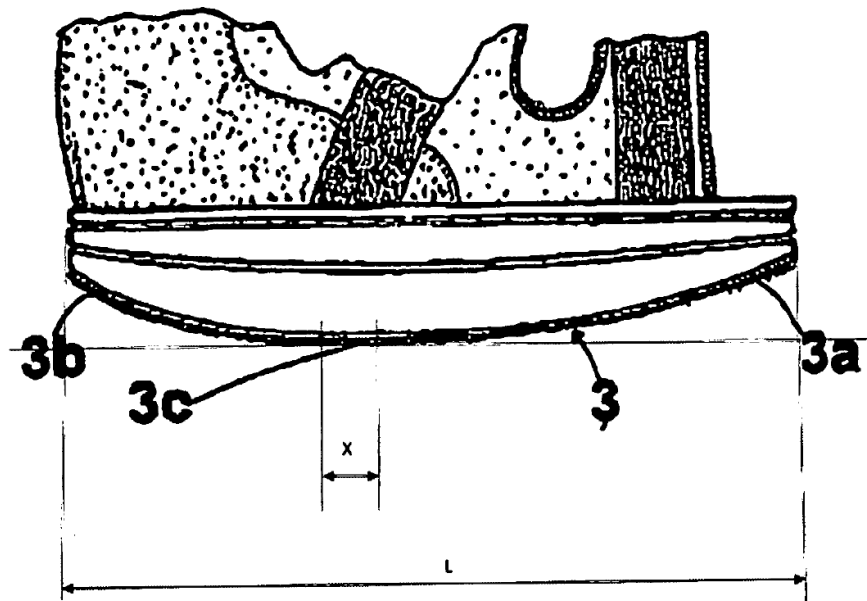
5.2.1 It is established case law, that features such as size ratios can be inferred from a schematic drawing, only if a direct and unambiguous teaching can be derived

therefrom (Case Law of the Boards of Appeal, 2018, 8th edition, Chapter II.E.1.12.1, in particular T 748/91).

5.2.2 However, Figure 1 does not suggest that the flat portion is longer than the convex rear portion as evident from the version below, which has been annotated by the Board.

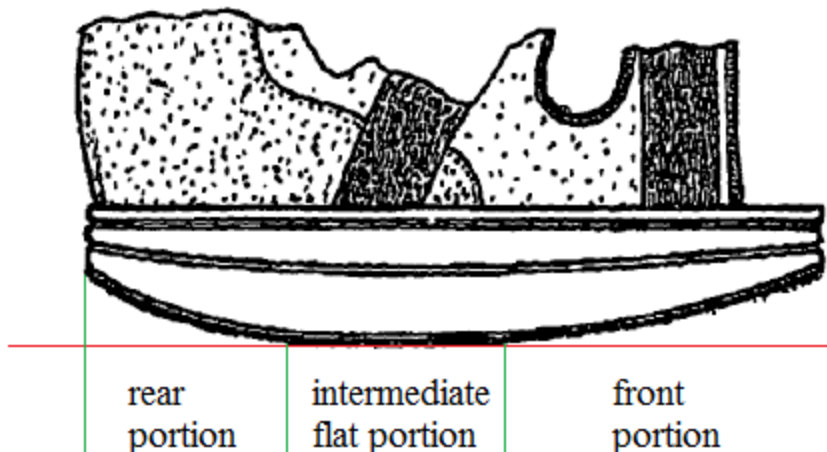


5.2.3 On page 7 of the statement setting out the grounds of appeal, the appellant reproduces figure 2 of the application as filed and indicates the length of the flat intermediate portion with x.



However, the limits of the length x have been arbitrarily chosen, since the length x does not encompass the whole flat portion.

When separating the flat portion from the front and rear portions as indicated in version of Figure 2 below, which has been annotated by the Board, the intermediate portion is not shorter than the rear portion.



5.2.4 It follows that figures 1 and 2 of the application appear inconsistent with respect to the dimensions of the various portions and, in particular, do not provide a clear and unambiguous disclosure concerning the length of the intermediate flat portion and the length of the rear portion.

Therefore, the figures do not provide a technical teaching to support the amendments to claim 1. Hence, the subject-matter of claim 1 of auxiliary request 3 does not fulfil the requirements of Article 123(2) EPC.

6. Auxiliary request 4 - Article 123(2) EPC

Claim 1 of auxiliary request 4 defines the *ratio* of the length of the intermediate flat portion to the total length of the sole.

Concerning the subject-matter of claim 1 of auxiliary request 4 in principle the same considerations as for claim 1 of auxiliary request 3 apply (see point 5 above), since the figures of the application as filed do not provide a direct and unambiguous teaching that the length of the flat portion is 1/10 of the length of the total sole.

The subject-matter of claim 1 of auxiliary request 4 extends beyond the teaching of the application as filed, contrary to the requirements of Article 123(2) EPC.

7. Auxiliary request 5

7.1 Article 123(2) EPC

7.1.1 Claim 1 is essentially based on claim 1 as filed in combination with claims 2 and 3 and several passages in the description as filed:

page 3, lines 1 to 3,
page 4, lines 4 and 25 to 27 and
page 6, lines 19 to 23.

The expression "each portion having at least an edge with protuberances and cavities so that said portions can be removably connected together in a puzzle-like manner" added to claim 1 as filed is not explicitly disclosed in the application as filed.

7.1.2 Article 123(2) EPC requires that an application shall not be amended such that it generates a teaching going beyond the teaching as originally filed. A literal wording for an amendment is, however, not required in the application as filed.

According to a general principle developed by case law for an amendment to be allowable it has to be directly and unambiguously derivable from the application as filed (Case Law of the Boards of Appeal, 8th edition, 2016, Chapter II.E.1.2.1) including, as already indicated above, the teaching of the drawings.

7.1.3 Figures 9 and 10 of the application as filed show an insole having different portions which can be connected in a puzzle-like manner, wherein the portions have edges forming "protuberances and cavities".

In this regard, the term "puzzle-like" on page 3, line 3 of the application as filed does not exclude the possibility that the various portions of the insole could be overlapped or superimposed such as in jig-saw type puzzles as long as the separate portions have edges forming protuberances and cavities.

The same teaching is provided by claim 1 of auxiliary request 5, since the expression "connected in a puzzle-like manner" has not been replaced by a new, broader definition, but has been further limited and clarified in line with the teaching of the figures as filed.

The subject-matter of claim 1 of auxiliary request 5 therefore fulfils the requirement of Article 123(2) EPC.

7.2 Article 54 EPC

D12 discloses in figures 2 to 5 an ankle brace which is suitable as a footwear orthosis (see point 1 above).

The subject-matter of claim 1 of auxiliary request 5 differs from the brace of D12 in that the insole (10) comprises at least two portions (10a, 10b, 10c), each portion having at least an edge with protuberances and cavities so that said portions can be removably connected together in a puzzle-like manner, said portions (10a, 10b, 10c) of the insole being made of different materials, thereby obtaining an insole (10) having mechanical characteristics changing from its rear to its front portion.

Hence the subject-matter of claim 1 is novel.

7.3 Article 56 EPC

7.3.1 D12 can be considered as the closest prior art, since it relates to an orthopedic shoe and therefore has a similar purpose as the footwear orthosis according to claim 1.

7.3.2 The use of a number of portions made of different materials provides an insole element having mechanical characteristics changing from its rear to its front portion. Such an insole makes it possible to adapt a footwear orthosis to specific needs of the person wearing the shoe (see paragraph [0036] of the contested patent).

7.3.3 The objective technical problem can be regarded as providing an orthosis which can be adapted to specific user needs.

7.3.4 D12 discloses in column 4, lines 20 to 21 that two foam layers are placed on the rigid insole in order to improve the comfort of the user whilst maintaining the rigid nature of the shoe.

However, D12 on its own does not provide a hint that the foam layers can be replaced or further covered by an insole comprising portions having different properties.

7.3.5 The respondent argues that the skilled person would use an insole comprising separate portions having a shape of a puzzle piece, since they are known in the prior art such as D13.

D13 describes an insole comprising recesses for resilient members having a different durometer hardness

(claim 1) which can be connected in a puzzle-like manner by protuberances and cavities at the edges of the portions of the sole (figures 1 to 3). By using different resilient members the sole properties can be adapted to particular requirements for different types of sport (claim 2; col. 2, lines 4 to 6).

Therefore, D13 describes an insole for sport shoes which offers good shock absorption and elasticity during vigorous activity (column 1, lines 5 to 10), whereas D12 discloses an ankle brace which is tailored to patients having tibial fractures which is intended to provide a high level of stability and rigidity to avoid any movement of the foot (col. 1, lines 48 to 50; col. 2, lines 57 to 67; col. 3, lines 56 to 61).

The purpose of the rigid shoe according to D12 is therefore not compatible with the purpose of the flexible insole proposed by D13. Therefore, the skilled person would not take into account the teaching of D13 with respect to sport shoes for improving certain properties of an ankle brace as disclosed in D12.

- 7.3.6 Even if D13 would be considered by the skilled person, no incentive can be found in either D12 or D13 why the skilled person would modify the orthopedic rigid ankle brace as disclosed in D12 by adding an elastic insole for a sports shoe.

Therefore, the subject-matter of claim 1 of auxiliary request 5 is not obvious when starting from D12 and considering in addition D13.

- 7.4 In summary, the ground of opposition pursuant to Article 100(a) EPC in combination with Article 56 EPC does not prejudice the maintenance of the patent in

amended form on the basis of claim 1 of auxiliary request 5.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the opposition division with the order to maintain the patent in amended version on the basis of claims 1 to 4 submitted with letter dated 3 December 2018 as auxiliary request 5, a description to be adapted thereto and drawings, sheets 1/1 and 2/2 of the patent specification.

The Registrar:

The Chairman:



C. Spira

C. Donnelly

Decision electronically authenticated