Letter to client:

Dear Mr Morales

Thank you for your letter of 3 April 2000, further to which I am pleased to report that an opposition has now been filed against EP 0712647 (A1). The nine month deadline for filing the notice of opposition and paying the fee is not until 28 April 2000 however I thought it best to file the opposition as soon as possible.

1) From your letter I note that A1 claims priority of US 163946 which is a continuation application from an earlier US application dated 7.9.89. The requirements for validly claiming priority in a European patent are set out in Article 87 EPC. Article 87(1) states that a person "shall enjoy ... a right of priority during a period of twelve months from the date of filing of the first application. Article 87(4) then states that a subsequent application for the same subject-matter as a previous first application and filed in or for the same state shall be considered to be the prior application on the condition that, at the date of filing the subsequent application, the previous application has been withdrawn, abandoned or refused ... and has not served as a basis for claiming a right of priority.

   In the present case, the application dated 7.9.89 was the first application. US 163946 (the continuation application) must by definition have contained the same subject matter and been directed to the same invention as the first application. Further, as it is a continuation application, the first application served as a priority basis for the continuation application. Consequently, US 173946 cannot be considered to be the first application for the invention under A87(4) EPC. In this regard, the fact that the earlier US application has been withdrawn is irrelevant.

   Further, the first US application was filed on 7.9.89, i.e. A1 was not filed within 12 months of the first application. Therefore, A1 is entitled to no priority and has the filing date of 20.02.95 as it's earliest date of priority.

2) Concerning the question of whether the opposition can be filed in my own name on your behalf, a decision has recently issued from the Enlarged Board of Appeal on this point (G3 + G4/97). As you know, I am a qualified European patent attorney. G3/97 states that an opposition is not inadmissible purely because an opponent is acting on behalf of a third party although it is inadmissible if the "involvement of the opponent is to be regarded as circumventing the law by abuse of process". One specific example which is not to be regarded as an abuse of process given in the decision at point 1(d) of the order, is where a professional representative is acting in his own name on behalf of a client. Consequently, there is no problem with the opposition being filed in my name and so I have done this to retain your anonymity.

3) Under A 14(2) & (4) EPC, an opponent is entitled to file an opposition in the official language of the state in which he has his residence or principal place of business. As I have named myself as opponent and I fulfill the requirements for filing the notice of opposition in Spanish, I have used Spanish as requested. An English, French or German translation of the notice of opposition must be filed by the late of the end of the opposition period (28 April 2000) or a month from filing the notice of opposition.

As I am fluent in English, the cost of preparing this translation will be minimal under R. 6(3), by filing the notice of opposition in Spanish, we are entitled to a reduction of 20% of the opposition fee and so there will be an overall saving in cost to you (although minor).

4) As discussed above, I have not filed the opposition in the name of your company. However, had I done this, your employee could have represented you as your company has its principal place of business in Spain (see A 133(3) EPC). A signed authorisation of the employee would have to be filed - it does not matter that he is Slovakian and interpretation for oral proceedings into the language of the proceedings could be arranged if necessary (see R 2 EPC).

   Even though the opposition has been filed in my name, it might be possible for your employee to speak at oral proceedings if you wish although I also have to be present as opponent. Decision G4/95 sets out that another party can make submissions in oral proceedings when accompanied by a professional representative as long as a request has been made in advance. Although I will be named as the opponent and not a professional representative, I assume that the same conditions apply and suggest that we request permission to your employee to speak at a later date, if you wish, using the requirements set out in the Guidelines of E III, 8.5. However, if you wish to remain anonymous throughout the opposition proceedings, this may not be a good idea.

5) Turning now to the tests of the shoes, Mr Fouquet's letter is a written document which makes it clear that the shoes were worn on a climbing expedition on 14.08.94 and that people saw and commented on the shoes. Thus, I have used this (A6) as evidence of prior use against some of the claims of the patent. As you will see from the opposition as filed, some features of the shoes were readily apparent to Mr. Fouquet's companions and therefore clearly made available to the public whereas other features such as the materials used would not have been made available as the shoes were with Mr. Fouquet and he says that he did not answer any questions.

   The requirements for adequately substantiating evidence of a prior use are set out in the guidelines, D V, 3.1.2. You will note that I have said that further evidence of the prior use will follow and we should try to file statements from Mr Fouquet (if he is prepared to do this) and other members of the climbing expedition so as to strengthen the case. In particular, we should establish as definitely as possible that the shoes he used were the same as those described in A1, that he used them before the filing date of the patent and that the use made certain features of the shoes "available to the public". We must therefore show that Mr Fouquet's companions were under the obligation of confidentiality.

   Please also note that you only received a copy of A6 recently and so it seems unlikely that it was available to the public before the filing date of the patent. It can however still be used as evidence of the prior use having occurred before the filing date. You will see that I have included several different attacks against each of the claims in the opposition. Thus there are some inventive step arguments which may not be needed

if the claims they relate to are held to lack novelty. This is so that we have the best chance of having included the correct grounds in the opposition on filing. However, the prior use arguments will need further substantiation if they are to be successful.

Also, some of the inventive step attacks based on the sole of A4 may be quite weak as these soles are for covering shoes to protect them from dirt and are not intended to replace or substitute for worn out soles as in the patent. Nonetheless, the soles of A4 might function adequately as replacement soles and so I felt that the arguments were worth including.

Yours sincerely,

Signature
José Mellado

Notice of Opposition to a European Patent

Tabulation marks

for EPO use

I. Patent opposed

Opp. No. OPPO (1)

Patent No.	0712647
Application No.	95810113.1
Date of mention of the grant in the European Patent Bulletin (Art. 97(4), 99(1) EPC)	28.07.1999

Title of the invention:
Shoe for mountain climbers

II. Proprietor of the Patent

Hall, John

first named in the patent specification

Opponent's or representative's reference (max. 15 spaces) OREF

III. Opponent

OPPO (2)

Name

Address

MELLADO, José
Avenida Ramón y Cajal 22
E - 28043 Madrid

State of residence or of principal place of business

Spain

Telephone/Telex/Fax

Multiple opponents

☐ further opponents see additional sheet

IV. Authorisation

1. **Representative**
(Name only one representative to whom notification is to be made)

OPPO (9)

Name

Address of place of business

Telephone/Telex/Fax

Additional representative(s)

☐ (on additional sheet/see authorisation) OPPO (5)

2. **Employee(s)** of the opponent authorised for these opposition proceedings under Art. 133(3) EPC

Name(s):

Authorisation(s)

☐ not considered necessary

☐ has/have been registered under No.

To 1./2.

V. Opposition is filed against

— the patent as a whole [X]

— claim(s) No(s).

VI. Grounds for opposition:

Opposition is based on the following grounds:

(a) the subject-matter of the European patent opposed is not patentable (Art. 100(a) EPC) because:

— it is not new (Art. 52(1); 54 EPC) [X]

— it does not involve an inventive step (Art. 52(1); 56 EPC) [X]

— patentability is excluded on other grounds, i. e. Art. [ ]

(b) the patent opposed does not disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art (Art. 100(b) EPC; see Art. 83 EPC). [ ]

(c) the subject-matter of the patent opposed extends beyond the content of the application/ of the earlier application as filed (Art. 100(c) EPC, see Art. 123(2) EPC). [ ]

VII. Facts and arguments

(Rule 55(c) EPC)
presented in support of the opposition are submitted herewith on a separate sheet (annex 1) [X]

VIII. Other requests:

If the request of the opponent cannot be allowed oral proceedings are requested.

IX. Evidence presented

Enclosed = ☐

will be filed at a later date = ☐

A. **Publications:** | Publication date

1

Particular relevance (page, column, line, fig.):

2

Particular relevance (page, column, line, fig.):

3

Particular relevance (page, column, line, fig.):

4

Particular relevance (page, column, line, fig.):

5

Particular relevance (page, column, line, fig.):

6

Particular relevance (page, column, line, fig.):

7

Particular relevance (page, column, line, fig.):

Continued on additional sheet ☐

B. **Other evidence**

Continued on additional sheet ☐

X. Payment of the opposition fee is made

[X] as indicated in the enclosed voucher for payment of fees and costs (EPO Form 1010)

[ ]

XI. List of documents

Enclosure No.		No. of copies	
0	[X] Form for notice of opposition	2 (min. 2)	
1	[X] Facts and arguments (see VII.)	2 (min. 2)	
2	Copies of documents presented as evidence (see IX.)		
2a	[X] — Publications **(A2, A3, A4, A5)**	2 (min. 2 of each)	
2b	[X] — Other documents **(A6)**	2 (min. 2 of each)	
3	[ ] Signed authorisation(s) (see IV.)		
4	[X] Voucher for payment of fees and costs (see X.)	1	
5	[ ] Cheque		
6	[ ] Additional sheet(s)	(min. 2 of each)	
7	[ ] Other (please specify here):		

XII. Signature of opponent or representative

Place Madrid

Date 7 April 2000

(signed)
José Mellado

Opposition is filed against the English text of A1 prior art relied upon:

A2 in English (full prior art under A 54(2) EPC).

A3 in English (prior art under A 54(3) EPC. This document specifically refers to D-EU-8327868 (A4) at line 2, p 2 in relation to properties of materials to be used and so may be combined with A4 for attacking novelty (at least for those properties disclosed in A4. See the Guidelines CIV, 7.1.

A4 in French (full prior art under A 54(2) EPC).

A5 in French (full prior art under A 54(2) EPC).

A6 in English - this document is a letter to the inventor of A1 which provides evidence that a prior use of the invention occurred on 14.08.1994, i.e. before the filing date of A1. Further evidence substantiating this prior use will follow in due course.

The Opposition Division are requested to note that A1 is not entitled to the priority date of 10.03.1994 as claimed. This is because US163946 from which the patent claims priority is a continuation application of an earlier US application filed on 7.9.89. We ask that this be verified from the copy of the priority application on file and that the priority claim then be set aside.

Claim 1 lacks novelty under A 54 EPC over the prior use of the shoe of the invention as supported by A6. In this regard, it is submitted that all of the features of independent claim 1 would have been readily apparent to the climbers accompanying Mr Fouquet on his expedition of 14 August 1994. Thus, the features of claim 1 were clearly made available to the public before the filing date of the patent. In particular, we draw the Opposition Division's attention to the passage of A6 stating that "all were very impressed by the strong grip which was immediately established between the upper part of the shoe and the interchangeable sole".

Clearly claim 1 lacks novelty over this prior use. Claim 1 is directed to "a shoe, in particular a climbing shoe". When claim 1 is not restricted to a climbing shoe, it lacks novelty under A 54 EPC over A2.

A2 discloses a shoe comprising a laced upper part (l 23, p 9) fitting the foot of a wearer (this is at least implicitly disclosed as it is a standard requirement that tennis shoes should fit), a lower part (claim 1 states that the shoe has a sole) fixed to the upper part. It is well known that the grips on the soles of tennis shoes essentially match the footprint and so this feature is also at least implicitly disclosed in A2. A2 discloses an interchangeable sole (20) which is elastic (line 22, p 9) and has an elastic side part (26) which during use surrounds a portion of the upper part (see claim 1) and has a bottom part which rests against the lower part as shown in Figure 2 and line 5 of the claim states that the sole maintains a tight fit with the shoe.

Consequently claim 1 when not limited to a climbing shoe, lacks novelty over A2.

Claim 1 when not limited to a climbing shoe also lacks novelty over A4. This again discloses a sports shoe (line 1, p 1) having a laced upper part (see Fig. 3) which will fit the foot of a wearer as this is known to be the case for laced sports shoes, having a lower part

(line 19, p 33) fixed to the upper part. As in A2, it is implicit in A4 that this lower part will essentially match the foot print in a sports shoe. An interchangeable sole is shown in Fig. 1 and is made of elastic material (line 18, p 33). It has an elastic side part (1) which surrounds a portion of the upper part as shown in Fig. 2. It also has a bottom part which rests against the lower part (it is referred to as a sole). The sole fits tightly against the upper part as is ensured by the Velcro disclosed at lines 14 to 16 of p. 33.

Consequently, claim 1 when not restricted to a climbing shoe also lacks novelty over A4.

When claim 1 is restricted to a climbing shoe, the claim lacks inventive step over A2 when combined with A5. A2 discloses all of the features of claim 1 except that the shoe is a tennis shoe rather than a climbing shoe. The problem showed by the invention as claimed could therefore be stated to be that of providing a sole and shoe having the same characteristics as those of A2 for use in climbing. The skilled person on reading A5 which relates specifically to the grip of the soles of sports shoes and mentions tennis shoes, would realise that as similar type rubber soles are disclosed as being used for both tennis shoes and climbing shoes in A5, the features of A2 could equally well be used in climbing shoes as in tennis shoes. He would therefore combine A2 with A5 to arrive at the invention of claim 1.

Claim 1 when limited to climbing shoes also lacks an inventive step over A4 when combined with A5. Again as A4 relates to sports shoes and discloses all the features of claim 1 except for the provision of climbing shoes, the skilled person on reading A5 (which relates to sports shoes) would have realised that A4 and A5 could be combined to arrive at a climbing shoe having the features of the sports shoe and additional sole of A4.

Claim 2

Claim 2 is dependent on claim 1.

As discussed above, when claim 1 is not limited to a climbing shoe, it lacks novelty over A4. The use of natural rubber for the sole is disclosed at line 30, p 33 of A4. Thus, claim 2 lacks novelty over A4 when dependent on claim 1 but not limited to a climbing shoe.

When claim 1 is limited to a climbing shoe, it lacks inventive step over a combination of A4 and A5 as discussed above. A4 discloses the use of natural rubber for the sole. Further, A5 also states that climbing shoes having soles of natural rubber were found to give exceptional performance. Clearly therefore, the skilled person when combining the teaching of A4 and A5 as discussed above in relation to claim 1 would have used natural rubber for the interchangeable sole as taught by both documents and so claim 2 lacks inventive step over A4 when combined with A5.

A2 discloses all of the features of claim 1 except for the provision of a climbing shoe. It also discloses that the auxiliary sole is made of a stretchable synthetic material (line 22, p 9). A5 discusses the gripping characteristics of the soles of sports shoes. It states that rubber (i. e. synthetic or natural) should be used for tennis shoes and then states that for climbing shoes, natural rubber should be used for the sole. The skilled person on considering A5 (which is the same technical field of sports shoes as A2) would have realised that the shoe and interchangeable sole of A2 could be used for climbing shoes and that, in this

replaced by natural rubber as taught by A5. Consequently, claim 2 when dependent on claim 1 as limited to climbing shoes also lacks an inventive step over A2 when combined with A5.

Additionally, all the features of claim 1 were disclosed by the prior use. The skilled person when considering which materials to use to make the replaceable sole of the prior use as safe as possible for climbing would have considered the article of A5 (in exactly the same field of climbing safety). From this he would have learnt to use natural rubber and so would have combined the prior use and A5 to arrive at the invention of claim 2. Thus claim 2 lacks inventive step over the prior use and A5.

Claim 3

Claim 3 is dependent on claim 1 only. Both A2 and A4 disclose all of the features of claim 1 except for the shoe being a climbing shoe when claim 1 is limited.

A5 discloses the provision of a sole on a climbing shoe having a Shore A hardness of 64 (see line 9, p 37). This value falls within the range of 58 to 65 of claim 3. Consequently, A5 discloses the feature of claim 3.

A2 relates to tennis shoes and so the skilled person would consider other prior art in the same technical field (i.e. that of sports shoes). The problem solved by claim 3 over A2 is that of providing a shoe for climbing having a suitable material on the sole. On reading A5, the skilled person would have understood that the shoes and soles of A2 could be used for climbing shoes as well as tennis shoes and that, if they were used for climbing, a sole having a Shore A hardness of 64 should be provided. Consequently, claim 3 lacks an inventive step over A2 when combined with A5.

A4 relates to sports shoes and discloses all the same features of claim 1 as disclosed by A2. Further A4 is again in the same technical field as A5 and so the skilled person would have combined A4 with A5 to arrive at the invention of claim 3 in the same manner as outlined above for A2. Consequently, claim 3 lacks an inventive step over A4 when combined with A5. Claim 3 also lacks an inventive step over the prior use, which discloses all the features of claim 1, when combined with A5. The skilled person aware of the prior use would want to know what material to make the sole from and would have found the answer in A5 (an article from a climbing and trekking journal).

Claim 4

Claim 4 is dependent on claim 2 which is dependent on claim 1.
All of the features of claim 1 except for the shoe being a climbing shoe are disclosed in A4.

A4 also discloses the sole being made of natural rubber as claimed in claim 2 (and this is stated to be intended to improve the safety of the person wearing the sole, i. e. to improve the grip). The sole of the shoe (i. e. not the interchangeable sole) is also said to be impregnated with a deodorant (see p. 33, lines 31+32).

Thus, the only features of claim 4 when dependent on claims 2 and 1, not known from A4 are that the shoe is for climbing (when claim 1 is so limited) and that the lower part of the shoe is also impregnated with an antibacterial substance.

As discussed above, the use of similar types of rubber soles in sports shoes and in particular tennis and climbing shoes is disclosed in A5.

Further, A5 states that it is known common practice to impregnate the interior of sports shoes with antibacterial substances.

Consequently, the skilled person wishing to provide an improved shoe which was capable of disinfecting cuts on a foot in the shoe as well as deodorising the foot would have used this common general knowledge to arrive at a shoe having all the features of claim 4 when claim 1 is not limited to a climbing shoe.

In order to arrive at a climbing shoe having all the features of claim 4, the skilled person would have realised from A5 (a document in the same technical field as A4) that a shoe and sole as disclosed in A4 could be used in climbing shoes. Further, as it was common practice to impregnate the interior of shoes with antibacterial agents, the skilled person would have modified the shoe of A4 to include antibacterial agents as well as deodorant despite the teaching of A5 which states that clinical tests had shown that this might be disadvantageous. The results of these clinical tests would have taken considerable time to prejudice shoe manufacturers against their common practice and there is no indication in A5 that this had occurred.

Consequently, claim 4 lacks an inventive step over A4 when combined with A5.

Claim 5

Claim 5 is an independent claim.

In a similar manner to that discussed in relation to claim 1, the prior use of the climbing shoe and interchangeable sole described in A6 would have allowed all the features of claim 5 to be clearly visible to Mr. Fouquet's climbing companions. Consequently, claim 5 lacks novelty over the prior use.

Further, A2 discloses an interchangeable sole (Fig 1) having an elastic side part (26), a bottom part (the base thereof) and the sole is suitable for being pulled over a sports shoe (it is shown in fig. 2 once it has been pulled over the shoe). Also, a cut-out (the round holes 25) is provided at the heel portion of the sole. Therefore, claim 5 lacks novelty over A2.

A3 is prior art under A 54(3) EPC. It designates all of the states designated in A1 except for Spain and so is prior art for all the other states.

A3 discloses an interchangeable sole (line 20, p 13) it has an elastic side part (the side parts are visible in figure 2 and the sole is a one-piece rubber body so the side walls are elastic). It has a bottom part and is clearly suitable for being pulled over a sports shoe (see fig. 2). Further, a cut-out (the holes 4) is provided at the heel portion of the sole.

Thus, claim 5 also lacks novelty over A3 for all designated states except Spain.

Claim 6

Claim 6 is dependent on claim 5. As discussed above, all of the features of claim 5 are known from A2, A3 and the prior use. A4 discloses a sole made of a material having an elongation at break of 800-1000%. This falls within the claimed range of claim 6 of 400-1200% and so anticipates this feature.

Although A3, which discloses all the features of claim 5, is A 54(3) prior art, it can be combined with the teaching of A4 regarding the properties of the material used for the purposes of novelty. The Opposition Division's attention is drawn in particular to Guidelines CIV, 7.1 where it is stated that if a document refers explicitly to another document as providing more detailed information on certain features, the teaching may be regarded as incorporated in the document containing the reference, if the document referred to was available to the public on the publication date of the document containing the reference. At lines 1+2 of p 14, A3 specifically refers to A4 (DE-U-8327868) as defining the characteristics of the material from which single piece body 3 should be made. Thus, the teaching of A4 that the material used should have an elongation to break of 800-1000% is included in the disclosure of A3.

Consequently, claim 6 lacks novelty over A3 including the relevant disclosure of A4 for all contracting states other than Spain.

In addition, A2 discloses all of the features of claim 5. The problem solved by the invention of claim 6 is to provide a sole made of a material having properties suitable to improve the safety of the wearer. The skilled person would consider other prior art in the technical field of soles for sports shoes to attempt to solve this problem. He would therefore have considered A4 and would have seen that this teaches that the safety of a wearer is improved if the material of the sole (of a similar type to that described in claim 5) has an elongation to break of 800-1000%. He would therefore use a material having this property in the sole of A2, thus arriving at a sole having all the features of claims 5 and 6. Consequently, claim 6 lacks an inventive step over A2 when combined with A4.

Further, a skilled person would similarly considered what material should be used for the sole disclosed in the prior use and, again would have considered teaching in the field of soles for sports shoes thus finding the relevant teaching of A4. Consequently, claim 6 also lacks an inventive step over the prior use when combined with A4.